

# Law Lore & Practice

PTMG



Pharmaceutical  
Trade Marks Group

May 2021



## Editorial: A Legacy

April 26th is World Intellectual Property Day - an appropriate moment to sit down and compose this Editorial. This Spring 2021 edition of LL&P is dedicated to Derek Rossiter, our late Honorary President who passed away peacefully last month. The tributes inside this edition bear testimony to his ongoing encouragement of all that the Committee has put in place over the

past 51 years to pursue his vision for PTMG. I am honoured to have been able to count on his support over the years following my appointment as Editor in 2007.

Derek's original proposal back in 1970 to bring together members of the pharmaceutical industry to 'exchange ... our ideas and experiences by regular gatherings' has been eerily mirrored these past twelve months as pharma companies of all shapes and sizes, along with increased inward investment, have come together to make the Covid-19 vaccination 'miracle' happen. As those of you who joined our recent PTMG@home

event found out, the usual timeline to bring a vaccine to market was slashed and regulatory authorities worked round the clock alongside the scientists, breaking business models and decades-old working practices to achieve that goal.

So does human nature need a pandemic to break a routine? One would certainly hope not! This week is also World Immunization Week and the World Health Assembly's Immunisation Agenda 2030 is officially launched today. 15% of the world's children are not routinely vaccinated against measles and nearly 20 million infants have insufficient access to vaccines. The challenge to ensure that other diseases benefit from the same 'out of the box' thinking as we have seen during these past 16 months is a real one, along with fighting complacency and a lack of scientific understanding.

PTMG lives on as Derek's legacy. May all of us, in our own way, continue Derek's vision of reaching out to others in a manner that improves everyone's lives.

Vanessa

## Founder's Lecture

The first Founder's Lecture was given at the 2012 Autumn conference in Barcelona.

Created to honour Derek Rossiter, it offers up and coming in-house lawyers the chance to talk on a fundamental trade mark related topic.

Speakers since its creation have included Christina Scobie of Merck, Christopher Hanes and Tom Hannah of GSK, Nicolas-David Lair of Sanofi, Wojciech Kreft of Novartis, Max Wenger of Bayer and Lori Mayall of Gilead.



Barcelona October 2012, presenting to Isabelle Dini - Norgine



Liverpool March 2010, Optional Dinner  
© Grace Horne

# Memories of Derek

Dear Derek,

We are all so sad to hear of your passing. You have always been a true gentleman, and a truly gentle man. Without you there would be no PTMG. You are, and always will be, the Founding Father and Honorary President. No one can ever fill your shoes – nor should they even try.



On a personal note, you gave unfailing support to me from the time I first joined the PTMG Committee all those years ago, and you were a source of constant strength during my years in the PTMG Chair when, perhaps, I did not always do what had always been done before. Your PTMG creation enabled me to build a store of the most wonderful memories – I cannot thank you enough for those people and those times.

One of your favourite sayings was 'in my Father's house there are many mansions'. Your PTMG was built on those foundations of diversity and inclusion, long before that phrase became corporate-speak. Being a family man to your core, you used those values to create and build PTMG. Through your love of all aspects of the world of trade marks and the people in it, you gave us what we now know as 'The PTMG Family'.

We will love you always. From the bottom of our hearts we thank you a thousand, thousand times.

## Sue Evans, former PTMG Chair

I have so many memories of Derek, many of him recounting stories of his past. He was always able to paint such vivid pictures of the tales he told. When I first joined the PTMG Committee, which must have been nearly 30 years ago, Derek welcomed me with his customary warmth. I recall being quite terrified to speak at my



first few meetings, surrounded as I was by the great trade mark luminaries of the day but Derek was always interested in my views as a then young person. Whilst often forthright in his own views he was always interested in listening to others, especially

the young. This is why, a few years ago, we chose the Founder's Lecture as a way to honour Derek. It reflects his interest in the development of young people by giving them the floor and thereby honing their skills as public speakers.

At conferences Derek was often accompanied by his wonderful wife, Isobel ('mother of the Group'). They, alongside Reg and Margaret Grogan, represented the PTMG 'old guard' and were loved and appreciated by all our members. Derek will always be remembered for his 'tour des tables' at the Gala dinner, a tradition which he upheld until he retired from conferencing. Members loved this somewhat eccentric English tradition which contributed to the PTMG family feeling. Whilst we have lost Derek the man his legacy lives on in PTMG.

## Lesley Edwards, PTMG Secretary



Derek has always been so nice to me, when I was attending my first PTMG conferences and was kind of anonymous, to when I took over the Chairperson role. That's what I like in people, when they are treating you the same whatever your seniority is.

## Sophie Bodet, former PTMG Chair

I have so many memories of Derek over the 35 years I've been involved with PTMG, it's very hard to single out just one or two but I will always remember the numerous Committee Meetings I hosted at Unilever House between 1992 – 2010 and just once, in June 2009 it happened to coincide with Derek's 85th Birthday. I mentioned this to our dedicated Catering Staff and one loyal member of the team – Carlos, originally from Argentina, insisted that we use the Chairman's Private Dining Room on the roof of Unilever House, which has uninterrupted views of the London skyline from St Paul's Cathedral over Derek's beloved Middle Temple Gardens to the Palace of Westminster, and moreover that the event be celebrated with a full Silver Service Champagne lunch complemented with a 1988 Vintage Premier Cru Pomerol – one of Derek's favourite red wines – and finished with a specially baked cake, suitably decorated by Carlos himself, who was another great fan of Derek. Just one of a lifetime of memories I will always hold of Derek until it's my time 'to meet the choir invisible.'

## Richard Heath, PTMG Treasurer

PTMG – Committee and conference – has always been the friendliest of places. When I joined the Committee, I was immediately struck by the efficient, humorous and courteous way that the meetings were conducted. I soon realised that was the legacy of Derek, founder of and force behind PTMG.

It takes an exceptional person to gather people working at competing businesses and to see that cooperation and courtesy makes life better for everyone without ever having to compromise independence and proper competition. Yes, there are always disputes that have to be conducted in legal forums, but PTMG, at Derek's instigation, showed that humanity had a place.

Derek's contributions at Committee meetings when he was Honorary President were invaluable. Invariably genial and modest, his intelligence and frequently blue sky thinking always opened the door to fresh ideas. He always welcomed people new to PTMG: the new generations of practitioners as well as non-practitioner partners and spouses at conference. His example made PTMG a happy and relaxed environment where learnings were shared and new friendships were formed and flourished.

Of course, Derek's talents were not limited to trade marks. After retirement he wrote novels and a super collection of poetry, *The Greedy Pigeon* and *the Hungry Porcupine and Friends*, which he subtitled as for 'children Younger and Older'. As always, keen not to exclude anyone, he added 'and perhaps for Other People as well'.

Derek will be much missed by all involved with PTMG in years past and to come. He will be remembered with huge affection via the collegiality, warmth and professionalism of the PTMG that he created and shaped.

## Georgy Evans, former Editor, LL&P

My oldest memory from Derek goes back to my first conversation with him during one of those memorable Committee lunches at Unilever House. This was probably around 2002 or 2003. I remember him telling me that, as a young boy, he had gone with his mother to welcome Chamberlain who had just returned back from Germany after negotiating 'peace' with Hitler. Well, after the fact we all know that those negotiations led into one of the biggest tragedies of human history. To me, born and raised in another hemisphere in the late 60's these characters were as far away from me as Cleopatra or Napoleon. I was fascinated at hearing this tale from someone who had, in fact, attended history. It triggered in me a huge interest for European history, Europe having become my homeland, and I certainly owe this to Derek.

## Maria Fernandez Marques, PTMG Committee Member

# DEREK ROSSITTER (1923 to 2021)

## An appreciation

A name which was widely and well known throughout the world of Trade Marks was that of Derek Rossitter, Founder and Chairman for more than 30 years of the Pharmaceutical Trade Marks Group, and the Group's Honorary President from 2004.

Born in 1923 in Johannesburg, Derek then attended the Royal Masonic School in Bushey, Herts. where he was a School Prefect and Head of House Athletics. Following active service during the Second World War from 1942 to 1945 (serving in North Africa, Italy & Sicily), Derek worked in Hull for the Distillers Group (as they were then known). The pharmaceutical industry had begun to grow rapidly following the Beveridge Report and the creation of the National Health Service in 1948, and in 1951 he was given the responsibility for the supervision of their trade mark interests. Previously 'generic' prescribing of drugs had been the norm; the use of trade marks to identify the products of a particular company and to distinguish between the products of different companies had been virtually unknown. These developments led to an increase in the number of patent and trade mark agents devoting much of their time in assisting pharmaceutical companies in protecting their rights, which included the registration of their trade marks.

When Distillers was taken over by Eli Lilly in 1963, Derek was appointed to take charge of their trade mark interests in Europe, much of Africa, and the Middle East. He was an active member of the ABPI, as the Lilly representative. In 1970 he founded the Pharmaceutical Trade Mark Group, which has since provided great support for the interests of pharmaceutical companies in the area of trade marks. He continued to participate in events of the Group, including conferences, until 2016.

Meanwhile, having undertaken the necessary legal studies, he had been called to the Bar by the Middle Temple in 1968, following which he became Counsel for his company, which changed its name to Lilly Industries Ltd. Although Derek never undertook any advocacy work in court, it was said that he could well have been

imagined arguing a case in court. Back in 1975, he had also been awarded the degree of Bachelor of Arts in Humanities by the Open University. Derek retired from Eli Lilly in 1987 but continued to work part-time as a consultant for Compu-Mark (UK) until 1996.

Derek always valued his membership of the Middle Temple, where many events of the Pharmaceutical Trade Marks Group have been held over the years. He was also a member of the Bar Association for Commerce, Finance and Industry (BACFI) in which he remained an active participant in a number of their committees. As a barrister, he was a member of the Joint Intellectual Property Working Group of the Senate of the Inns of Court and the Law Society. In every way he was highly regarded in his profession and in particular in the field of trade marks.

I first met Derek as a comparatively young barrister. I had started in the late 1960's to specialise in intellectual property, trade marks becoming a major part of my practice. I do not recall precisely when I first met Derek, which was as a client in some trade mark matters. This is now history but as sometimes happened with clients, Derek became a friend and we enjoyed many good times together, the last occasion being at a dinner of the Pharmaceutical Trade Marks Group at Middle Temple Hall in 2016.

Already the author of Trade Marks in

Business (published by the ABPI in 1971), in his retirement Derek turned to writing other books, including two novels and a book of comical children's rhymes. He had also been an active member of a variety of Committees relevant to his field of work. Among the many organisations with which Derek was involved, which are too numerous to mention in full, he was a member of The Wimbledon Literary and Scientific Society, giving a number of erudite talks.

Always a family man, Derek married Isobel Marion Gentle in 1957, a Scottish lass whom he had met at the English Speaking Union when playing bridge. A huge sadness was Isobel's untimely death from cancer in March 2005. Derek leaves behind him their three daughters, Jane, Valerie and Victoria, and nine grandchildren.

I consider myself exceptionally fortunate in having known Derek and to have enjoyed his friendship. By good chance, I was contacted by his daughter Jane shortly before his death, and was then able to communicate with him by email, learning about his more recent activities, such as playing 'Scrabble' online and doing numerous codeword puzzles. This gave me great pleasure. In spite of his deteriorating health he had not really changed. He will not be forgotten.

**Christopher Morcom Q.C.**



## Words from the Departing Chair



After two terms of office (in other words 6 years) I am stepping down as Chairman of PTMG and leave the floor to my wonderful colleague and friend Myrtha Hurtado-Rivas who was elected as my successor during the AGM conducted in the context of our PTMG@home event on March 15, 2021. Originally it was planned that I should chair the PTMG@home event in March and I would have loved to use this opportunity to personally say good-bye to you all. However, for whatever technical reasons I had problems establishing a stable connection with the Airmeet platform so Myrtha had to take over spontaneously. I apologize for that, but I know from many sources that Myrtha did a wonderful job. Thank you so much, Myrtha, this is highly appreciated. I know you will be a wonderful Chairperson.

Since 2015 we have had successful conferences in the wonderful cities of Warsaw, London, Oslo, Paris, Toronto, Porto, Dubrovnik, Rome and Berlin. Most of the venues were outstanding and presentations excellent. It was a great pleasure and honour for me to chair the PTMG organization during this period. Honestly I enjoyed sitting on stage and moderating the sessions and discussions. You all were a great audience. PTMG as an organization is continuously growing while keeping its family like touch. This happy feeling of seeing colleagues and friends again when you arrive at the lobby of the PTMG conference hotel is probably unique (at least I have never had this feeling of returning home with any other conference). The sudden and abrupt lockdown in spring 2020 and subsequent conference cancellations due to the pandemic was and still is quite a nightmare for us as an organization. But I am confident that by next year the pandemic will be under control and we will be back with live conferences. I do hope that I will see many of you again during one of those live conferences ahead.

Until then stay healthy and safe and take care!

**Frank Meixner**

## Members News

### New Members

We are delighted to welcome the following new members to the Group:

**Bénédicte Linden** from Linden & De Roeck, Brussels, Belgium  
[benedicte@ldip.eu](mailto:benedicte@ldip.eu)

**Annemarie Malkmes**  
[annemarie@bomhardip.com](mailto:annemarie@bomhardip.com)  
**Florica Rus** [florica@bomhardip.com](mailto:florica@bomhardip.com)  
both from BomhardIP, Alicante, Spain

**Geetika Chawla** from United IPR, Delhi, India  
[geetika@unitedipr.com](mailto:geetika@unitedipr.com)

**Maria Pava** from OlarteMoure, Bogota, Colombia  
[maria.pava@olartemoure.com](mailto:maria.pava@olartemoure.com)

**Swetlana Frese**  
[swetlana.frese@mewburn.com](mailto:swetlana.frese@mewburn.com) and  
**Dydra Donath**  
[dydra.donath@mewburn.com](mailto:dydra.donath@mewburn.com) both from Mewburn Ellis LLP, Munich, Germany

**Loretta Lau** from Deacons, Hong Kong  
[loretta.lau@deacons.com](mailto:loretta.lau@deacons.com)

**Harry Rowe** from Mathys & Squire, London, UK  
[hjrowe@mathys-squire.com](mailto:hjrowe@mathys-squire.com)

### Moves and Mergers

**Nancy Globus** has left Global Med Safety, LLC to join Addison Whitney. Nancy can be contacted at  
[Nancy.globus@syneoshealth.com](mailto:Nancy.globus@syneoshealth.com)

**Jan Peter Heidenreich** has left Harmsen Utescher to join Preu Bohlig & Partner in Hamburg, Germany. Jan Peter can be contacted at [jph@preubohlig.de](mailto:jph@preubohlig.de)

**Carina Gommers** has left Hoyng Rokh Monegier LLP to join Wiggin LLP in Brussels, Belgium. Carina can be contacted at [carina.gommers@wiggin.eu](mailto:carina.gommers@wiggin.eu)

**Catherine Muyl** has left Foley Hoag to join Squire Patton Boggs in Paris, France. Catherine can be contacted at  
[Catherine.muyl@squirepb.com](mailto:Catherine.muyl@squirepb.com)

**Alberto R. Berton-Moreno, Jr.** is now with Berton Moreno IP Law in Buenos Aires, Argentina and can be contacted at  
[abmj@bertonmoreno.com.ar](mailto:abmj@bertonmoreno.com.ar)

**Mark Kramer** has left Shoosmiths LLP to join Potter Clarkson LLP in London, UK. Mark can be contacted at  
[mark.kramer@potterclarkson.com](mailto:mark.kramer@potterclarkson.com)

Please remember to let us know of any changes to your contact details. You can notify me either via the PTMG website [www.ptmg.org](http://www.ptmg.org) or directly to [Lesley@ptmg.org](mailto:Lesley@ptmg.org) or by writing to me at Tillingbourne House, 115 Gregories Road, Beaconsfield, Bucks, HP9 1HZ

**Lesley Edwards**  
PTMG Secretary

## Words from the Chair



It now has been a year without in-person meetings. While we are hopefully nearing the end of this dry spell, I want to recall the importance of PTMG for me personally – and surely many others.

Adapting to the world of the pharmaceutical industry is not always easy. But for me, one defining moment was my first PTMG meeting: I fondly remember the immediate sense of community and belonging in such an international, diverse and interesting group, allowing me to fully immerse in discussions among highly skilled professionals in beautiful locations. I have since always looked forward to PTMG meetings, which signify many of the reasons for cherishing the pharmaceutical trade marks community.

It is therefore my honour to chair an organization as reputable and respected as PTMG. I am immensely thankful to my peers in the Management Committee for their trust and support and look forward to seeing all members at future events.

Unfortunately, as with many other aspects of our lives, the unexpected force and duration of the pandemic have affected our meetings. It is all the more inspiring to see the PTMG@home events having turned out to be such great successes. So many of you joined these events as listeners or presenters, allowing for enlightening presentations and discussions, and again creating the communal atmosphere of PTMG.

While we are hopeful about the ongoing efforts to overcome the pandemic, vaccination campaigns are not progressing with equal speeds around the world. To allow as many as possible to participate and allow for diverse exchanges with colleagues around the globe, our next meeting will once more be held virtually. So as we await our next in-person meeting, I thank you all for being part of PTMG and making it the community it is.

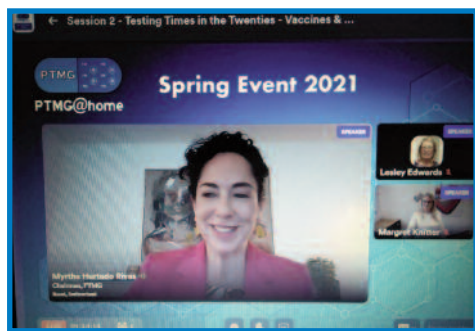
E-see you in October!

**Myrtha Hurtado-Rivas**

# PTMG@home 15th and 16th March 2021

## Testing Times in the Twenties - Vaccines & Brexit

Barbara Dollstadt, BKM Berkemeyer



2021 began with a general feeling of hope, a sentiment reinforced by the launching of a series of vaccines against COVID-19, and also as different governments around the world began announcing and putting into force their immunization plans. We also started the year with lessons learned. Last year's experience with the pandemic re-educated us in many ways: we now have a new and increased appreciation for health, family and work. Today, things that seemed simple and common in the past have transformed into valuable and exceptional events, as is the case of having a conference followed by tea with our dear PTMG colleagues from around the world. As we remain hopeful that we will soon be able to meet again, we must now adapt to new technologies, new work tools and new methodologies so that we can go back to the so-desired 'normal' as soon as possible. It is within this context that I would like to share with you the following appraisal of what was discussed during the PTMG virtual Spring Conference held in March 2021, regarding the efforts and challenges faced by the pharmaceutical industry during the COVID-19 pandemic.

This was PTMG@home 2nd virtual encounter and took place over the course of two days, March 15 and 16. Normally it is our colleague Frank Meixner who chairs the session, but unfortunately, due to technical issues, he was unable to do so. Following the announcement at the AGM, Myrtha Hurtado-Rivas stepped in, doing an excellent job as the new PTMG Chair.

Mr. Nick Redfearn, Deputy CEO and Enforcement Head at Rouse & Co started off the first session on March 15 with the

topic: anti-counterfeiting during the COVID-19 pandemic. He explained the pandemic had led to a rise in the demand for health products, which in turn caused an increased risk of being exposed to or purchasing counterfeit products. Most pharmaceutical IP owners have a number of suppliers in China and India, which are the largest source markets.



**Nick Redfearn**

They also happen to be the 'usual suspects' who adopt the classic pattern of counterfeit goods (including counterfeit masks, PPE kits, hand sanitizers, fake testing kits, unregulated medicines and regulated medicines), made on several key markets and shipped through trans-shipment ports into target markets in the US, South East Asia, Africa and Europe. Although challenging, Mr. Redfearn believes that Customs is the only place where we might find a solution for this issue. His recommendation for colleagues was that IP owners should get more involved by dutifully filing customs records, having extensive customs programs in China, training customs authorities and lobbying for more seizures at import markets.

In the second half of his presentation, he mentioned how the pandemic also resulted in a huge boom in e-commerce and online transactions. This has resulted in an increase in sales of counterfeit products, illicit websites, illegal activities such as phishing, etc., as well as the dark web. The sheer volume of platforms is a problem, as platforms struggle to cope. Platforms are working on this, but the software is still developing, and while

some platforms are using Artificial Intelligence (AI) tools, others prefer to simply wait for notices to come in so as to take products down. All of this has exposed the weakness of global IP enforcement infrastructure, including the challenge of traditional enforcement programs and online pharmacy, as well as the complex blend of illegalities. Mr. Redfearn recommends that organizations such as PTMG work with regions where customs are weaker and collaborate in order to find solutions.

With this, Mr. Nick Redfearn closed an excellent presentation, in which he not only presented current challenges IP owners face, but also possible solutions that could be applied, that would not only benefit IP owners, but consumers, clients and communities.

Ms. Zuzana Hecko, Senior Associate at Allen & Overy and leader of its Intellectual Property Practice in Slovakia was in charge of presenting the second topic of the first day: Legal and Ethical implications of Artificial Intelligence in healthcare. She started by providing a useful division of categories in which we



**Zuzana Hecko**

can find AI in healthcare: 1) diagnostics, 2) software that accompanies medical devices, and 3) lifestyle and wellbeing apps. Also, as Ms. Hecko noted, we are living in times where smartphones are replacing diagnostic devices, and remote healthcare has been accelerated by the pandemic. The legal issues related to AI are plenty: regulatory, certification, privacy, cybersecurity, copyright, contracts, to name a few.

*Continued on next page*

And with the European Union Medical Devices Regulation (MDR) being postponed from 2020 to 2021, one key question is: will software be included as a medical device? Lifestyle and wellbeing apps are not considered medical devices, but the definition states that software can be a medical device if: 1) it is intended by the manufacturer to be used by human beings for medical purposes, 2) the intended purpose as described by the manufacturer is relevant for the qualification and classification. This has resulted in some challenges. Despite the MDR being delayed, many Notified Bodies (NBs) stopped accepting devices seeking renewal MDD certificates, and although products with a valid certificate can continue to be marketed after the MDR as long as there are no significant changes, requirements around technical documentation have tightened. This is definitely something to note and observe as the MDR process continues to develop.

With regards to AI and Ethics, Ms. Hecko remarked that what is considered to be an acceptable use of data is fluid and changing. Ethical AI in healthcare is comparable to other sectors. This includes privacy and surveillance, bias and discrimination, as well as the role of human judgment. Ethical principles are closely tied to privacy laws and this implies a complex risk management challenge. Regulators also seem willing to use legislation to penalize organizations that fail to process data in an ethical matter. This is particularly sensitive since data is the lifeblood of AI, as it is needed to train the algorithm. If its collection is deficient, the data used to train the algorithm can also lead to poor quality output. She ended her presentation by suggesting that company board members become involved in ethical questions. She also recommended that data ethics principles be developed with regular reviews, and ethical considerations be embedded into the DNA of products and services.

I fully agree with Ms. Hecko's wise recommendation of engaging board members into ethical questions, instead of simply deriving them to lawyers and compliance teams. Ethical questions and decisions are too important to

compartmentalize and often are business pillars that guide companies both in their daily work as well as their future plans.



**Julius Stobbs**

The third and final topic for the first day was presented by Mr. Julius Stobbs, founder of Stobbs, who spoke about the implications of Brexit with respect to falsified medicines. He explained how the EU has the Falsified Medicines Directive (FMD), which was implemented to heighten security in the region, making it difficult for falsified medicines to enter the legal market. Its main features include: obligatory safety features like a Unique Identifier (UI) and Anti Tampering Device (ATD), a common EU-wide logo to identify legal online pharmacies, tougher rules on the import of active pharma ingredients, and strengthening record-keeping requirements for wholesale distributors along the supply chain. With Brexit, the FMD no longer applies to the United Kingdom, where the legal framework reverted to the Human Medicines Regulation 2012, which does not have the equivalent safety features of the FMD. This has resulted in parallel imports, with a one-way exhaustion. Although not perfect, Mr. Stobbs thinks that the FMD protected the UK better, and that now there may be a higher risk as counterfeit producers may choose to send their products where controls are less strict. There is also a heightened risk of products being re-sold by third parties within the EEA in a parallel market, usually with the purpose to exploit price differences among EEA states. He closed his presentation with an analysis of possible scenarios occurring in the UK now that the FMD will not apply. It could either go under the old regime, which seems looser and riskier, it could stay under the EU position, which would be simple if not unlikely, or it could apply a new, UK-specific system.

It will be interesting to see what UK policymakers will come up with, as well as what the European Union's reaction will be. Whatever they choose, they should keep in mind that a parallel market in falsified medicines has more serious implications as they involve human life and health.

The second session of the virtual conference took place on Tuesday, March 16, and began with Mr. Michael Watson of Mevox Ltd.'s presentation of how the pharma industry tackled the challenge of COVID-19.



**Michael Watson**

He started by explaining that COVID-19 did not just show up spontaneously, the risk of a pandemic was always very high. Coronaviruses have been around for a while as seasonal, epidemic and pandemic diseases in man. This specific coronavirus, SARS-CoV-2 virus, is an RNA virus, which means that it is prone to mutating into new variants. Mr. Watson then went into describing what we already know: that it attacks older adults more than younger populations, that it is worse in colder seasons, and why 'flattening the curve' strategies were adopted by the great majority of countries. Pharma knew that it would not be able to develop a vaccine before that first peak, but it also knew that it had 12 months to get the job done before the next large peak hit. Pharma also had to target the vaccine to the population that was most at risk, which studies showed were the elderly and male patients. Vaccine development for this coronavirus was carried out in record-breaking time, with some technologies developing faster than others. This shortened timeframe resulted in people having different attitudes towards vaccine

*Continued on next page*

options, with percentage efficacy, durable effect, fewer side effects, source, and endorsement being the most influential factors on their opinions. He stated what we now know is key: it is imperative to get herd immunity as soon as possible, so that we stop transmission and prevent more variants from developing. Should we be successful in achieving this, COVID-19 will probably turn into a less serious disease like the flu, where less people will die from it.

Mr. Watson's presentation was an insightful summary of what has happened backstage in the pharma industry during the pandemic, and his experience working as part of Moderna's team definitely provided him, and in turn us, with an insider's view of vaccine development.



**Margret Knitter**

The last topic of the day and session was Margret Knitter's (of SKW Schwartz) International Case Round up. Margret presented fascinating case studies from around the world, with both absolute and relative grounds. A couple of relative grounds cases she mentioned were Genetic Nutrition GN Laboratories (GN) v General Nutrition Investment Co (GNC) and Kerry Luxembourg Sarl (TasteSense) v Dohler GmbH (Multisense). For the first case, the General Court of the EU decided that they were the same, based on the general rule that consumers always focus on the first part of the word. However, this case stood out because letter words are not generally used for this principle. In the second case, the part in controversy was the word 'sense', which was argued as being common and related to flavour. Surveys were carried out in countries where they thought the population has the least knowledge of English (Poland and Spain, in this case), to see if this could

be contested. However, the court ruled that it was similar, as it did not pass the test in Spain.

Margret then went on to present case studies regarding absolute grounds. Of the many examples provided, two were of most interest to me due to the singularity of the courts' decisions. One, involving Voco GmbH v EUIPO on 3D Shapes under Class 5: Dental preparations and articles and Class 16: Packaging materials; Blister packs for packaging. The principle for 3D Shapes is that only if the shape significantly varies from other designs in the industry, can it indicate origin. The examiner of the Board of Appeals decided to 'google' shapes in the dental sector and arrived at the conclusion that the shape was different enough to grant the trade mark objection. This was one of the rare examples where 3D marks are accepted. The second case I wanted to share with you was the case of Santa Conte v EUIPO for Cannabis Store Amsterdam, regarding trade marks contrary to public policy. The court ruled against Cannabis Store Amsterdam, stating that it went against legislation in other EU countries despite cannabis tolerance in Europe, and was rejected.

Margret's presentation exhibited numerous and noteworthy case studies from which all of us can learn and use as references to protect our IP owner's marks. And with this last presentation, PTMG@home concluded.

While it would have been infinitely more pleasant to meet, reunite with colleagues and get to exchange opinions in person, technology has once again allowed us to carry out this very fruitful encounter. We must not forget to thank our sponsors: Baker & McKenzie, Corsearch, Fross Zelnick Lehrman and Zissu, SMD Group, United Trademark and Patent Services and Womble Bond Dickinson (US) LLP.

## Feedback on TEA & TALK, the new PTMG@home feature

*'It was great to see ... regular PTMG attendees at the virtual meeting. It all worked out very well, and, as per PTMG tradition, the talks were very informative. I really enjoyed the virtual table chat and I just wished more of the attendees could have been encouraged to join in – maybe that is the goal for the next virtual meeting.'*

**Gavan Ferguson, F R Kelly**

*'The virtual conference was nice. It was great to see some colleagues again inspite of not having a chance to see each other face to face. Thank you for your work.'*

**Gökçe Izgi, LL.M. Moroglu Arseven**

*'...it was so good to see you at least virtually. This made a big difference with the October virtual webinars last year, when we did not have a chance to interact. I found the platform easy to navigate and user friendly - once I realized I had to disconnect from my office VPN. It was also great to be able to send messages to other attendees. Just a shame that not many people stayed for the tea and talk...'*

**Iris Quadro, Marval O'Farrell Mairal**

*'I certainly qualify as one of the 'old brigade' since my first PTMG was the meeting on the Baliwick of Guernsey in 1994, and I am a survivor of the famous Berlin meeting of October 1996.... I approached the recent PTMG@home meeting with interest in seeing how the spirit of PTMG would persevere given the true international composition of the attendees and the logistical difficulties inherent in a remote meeting.*

*Congratulations to Lesley, Vanessa, Bev and our new Chair for putting together a great virtual meeting. Tough duty for the speakers since it was matinee day for them, but you could not tell. I agree that the 'tea & talk' tables were fun, and informative. While a virtual meeting is no replacement for the real thing, PTMG carried it off. Congratulations.'*

**William Hansen, Powley Gibson**

# US Update

Jonathan S. Jennings Pattishall, McAuliffe, Newbury,

Hilliard & Geraldson LLP

The Trademark Trial and Appeal Board (TTAB) recently rejected Gilead Sciences' opposition to the registration of GILEAD marks for investment advisory and management services in *Gilead Sciences, Inc. v. Gilead Capital LP*, 2021 WL 1592674 (TTAB April 20, 2021)(non-precedential).

<https://ttabvue.uspto.gov/ttabvue/v?pno=91233311&pty=OPP&eno=89>

Among other things, this decision illustrates the importance of strictly following the TTAB's rules in an opposition.

In this long-running dispute, the applicant, Gilead Capital had applied to register on a use-basis the word mark GILEAD CAPITAL, and the composite mark GILEAD CAPITAL LEADERSHIP INVESTING, for hedge fund, investment advisory and management, and related financial services. The word 'capital' was disclaimed apart from both marks as a whole, as were the words 'leadership investing' in the composite mark.

Gilead Sciences (Sciences) opposed based on likelihood of confusion grounds, as well as on the basis that Gilead Capital's (Capital) marks falsely suggested a connection with Sciences. Sciences relied upon its prior registrations of GILEAD for pharmaceutical products, health insurance consultation, and event sponsorship. Sciences also asserted that it was 'well-known in the investment communities for its active investing in start-up companies and funding.' Sciences further alleged it had become known to investors and the investment community for identifying, financing and investing in emerging companies and technologies related to new and innovative therapeutics.

While the TTAB found that Sciences' GILEAD mark was inherently strong and famous in connection with pharmaceutical products, it stopped short of finding that this fame extended to the financial field. Significantly, the TTAB determined that Sciences had not properly pleaded its common law trade name and trade mark rights in this area and therefore had not provided Capital with sufficient notice that such claims were at issue in the opposition. As a result, the TTAB found that Sciences could attempt to prove only that relevant consumers perceived the manufacture and sale of pharmaceuticals as including Sciences' financial or investment-related activities, and not that Sciences was directly involved in the financial and investment fields. Even with this disadvantage for Sciences, the TTAB

found that the parties' goods and services, even restricted as noted above, were related. Ultimately, however, this ruling would have repercussions for Sciences' position. The TTAB would find that the parties did not have market overlap and did not share the same class of customers.

Sciences submitted a survey that showed 15.3% confusion between the parties' marks. This percentage is low by the standards of the case law on what survey percentages are accepted to show appreciable confusion. In a departure from prior precedent, the TTAB criticized the survey for failing to replicate market conditions. That is not something a survey in an opposition usually needs to do as only registration, and not use in the marketplace, is at issue. Apart from the survey, the TTAB also rejected Sciences' assertion that there were instances of actual confusion between the parties' marks in the marketplace, because of insufficient detail submitted about them. In particular, the TTAB noted that Sciences had not called as witnesses the individuals involved in these instances of alleged confusion.

After rejecting likelihood of confusion, the TTAB considered whether the applied-for marks falsely suggested a connection with Sciences. This claim turned on whether the relevant public understood Capital's marks as pointing uniquely and unmistakably to Sciences. The TTAB found that 'Gilead' was not uniquely associated with Sciences because it also identified a geographic region in Jordan (formerly, Palestine), a medicinal treatment originating from Gilead, and a village in Nebraska. In addition, the TTAB noted that Sciences' survey found that only 6.7% of the respondents thought that 'GILEAD CAPITAL is the same company as GILEAD SCIENCES.' Thus, Sciences' survey evidence in this instance actually hurt its own position.

Overall, this decision underscores the importance of carefully following TTAB rules, case law, and procedures. In opposition cases like this, where the parties' goods and services do not clearly overlap, brand owners should also consider including an anti-dilution claim. Sciences did not bring one here. If Sciences appeals this TTAB decision to a district court instead of the Federal Circuit, some of the issues concerning evidence and claims may be revisited as new claims and evidence may be submitted in that forum.

# International Update

## AUSTRALIA

### Bill Ladas, King & Wood Mallesons

Combe International Ltd and Dr August Wolff GmbH are engaged in a worldwide battle in respect of their respective VAGISIL and VAGISAN brands.

In one of the latest decisions, noted in Margret Knitter's International Case Round-Up at the PTMG@home Virtual Spring Conference, Australia's Full Federal Court (FFC) has held that VAGISAN is deceptively similar to the earlier registered mark VAGISIL. The FFC overturned the decision of Stewart J that the marks were sufficiently dissimilar given the descriptive nature of the prefix in each case. The FFC was swayed by the perceived dominance of the first five letters of each mark and evidence as to the taboo or awkward nature of the subject matter.

While it was not impermissible to consider the different elements of the VAGISAN and VAGISIL marks, including whether those elements were descriptive, his Honour's analysis appears to have led the primary judge to assign less significance to the common VAG, VAGI or VAGIS element of the two marks than was appropriate having regard to the association with the word 'vagina'. Where, as here, the dominant aspect of the VAGISIL mark is the first five letters, in our view that is also the part of the mark that the consumer is likely to recall. Indeed, the consumer is more likely to recall the VAG or VAGI component because it carries connotations as a reference to the vagina or the vulva and is a word that represents a topic regarded with some awkwardness amongst consumers. Having noted the central idea conveyed by VAG or VAGI, the primary judge did not consider whether that part of the mark was more likely to be fixed in the consumer's mind than the whole of the VAGISIL mark. In our assessment, that was an important consideration because, to the extent that VAG or VAGI is associated with vaginas, this is likely to be a striking feature of the trade marks for consumers who are relatively unused to the mention of that intimate and internal

*Continued on next page*



# International Update continued

female body part in public discourse.

The decision of the Full Federal Court brings the position in Australia into line with the latest New Zealand decision, in which the NZ High Court also held that VAGISAN is likely to be confused with the earlier mark VAGISIL.

The decision show-cases the difficulties in determining what is acceptable use of a descriptive element such as a prefix, and what is not, in a field in which brands often pose unique issues due to their invented nature (overall), even if they incorporate an integer with descriptive significance. The descriptive element will often provide the only conceptual hook that a consumer would recall, which might tend to increase the risk of confusion at a factual level. Indeed, in this case, the very fact that the prefix was descriptive has been seen (counter-intuitively) by the FFC as giving it distinctiveness due to the lack of evidence of third party use of a similar naming convention. On the other hand, as with the decision of Stewart J, this means that policy-based judgment-calls are sometimes needed.

It is important to note that these findings were made in a notional opposition context (in respect of broad specifications), rather than infringement proceedings which require an assessment of any allegedly infringing use in context.

For completeness, at the time of writing this note, the US Court of Appeals Fourth Circuit affirmed a district court finding that VAGISIL is likely to be confused with VAGISAN (the district court had overturned the TTAB, which had dismissed the opposition).

## BELARUS

### PETOSEVIC

The Belarusian President signed the Law on Ratification of the Agreement on the Eurasian Economic Union Trade Marks, Service Marks and Appellations of Origin on 4 January 2021. The law entered into force on 18 January 2021, making Belarus the second EAEU member state to ratify the EAEU Trademark Agreement, following Russia's ratification in November 2020. The Russian President signed the Law on Ratification of the Agreement on the Eurasian Economic Union Trade Marks, Service Marks and Appellations of Origin

on 9 November 2020. The law entered into force on 19 November 2020.

The Agreement was signed on 3 February 2020 by all EAEU members states – Armenia, Belarus, Kazakhstan, Kyrgyzstan, and Russia. The Agreement will enter into force once all member states bring their registration procedures and official fees in line with the Agreement and deposit their instruments of ratification to the Eurasian Economic Commission (EEC).

Under the unified system, right holders will be able to obtain legal protection simultaneously in all EAEU member states by submitting one application to any of the national offices, i.e., they will be able to choose a 'receiving office'. Each trade mark application will undergo preliminary (formal) and substantive examination, with the entire registration procedure estimated to take approximately one year. The EAEU trade mark will be kept in a single register administered by the EEC.

## INDIA

### Denise Mirandah, mirandah asia

Due to the COVID-19 pandemic, the use of N95 masks has proliferated exponentially. Research scientists from the Indian Space Research Organisation (ISRO) carried out studies and found the N95 masks to be the most effective at reducing the horizontal spread of infectious diseases, including COVID-19. Indeed, the term N95 has now become commonplace. In that context, the following interesting case (Sassoon Fab International Pvt. Ltd. v Sanjay Garg) came up for consideration before the Intellectual Property Appellate Board (IPAB).

A person named Sanjay Garg (the Respondent) had filed a trade mark application for the mark N95 in class 10 (in relation to 'surgical, medical, dental and veterinary apparatus and instruments; artificial limbs, eyes and teeth; orthopedic articles; suture materials; therapeutic and assistive devices adapted for persons with disabilities; massage apparatus; apparatus, devices and articles for nursing infants; sexual activity apparatus, devices and articles') on 14 April 2020. Rather surprisingly, the said application proceeded to registration and the certificate of registration was issued on 11 November 2020.

An entity named Sassoon Fab International Pvt. Ltd. (the Petitioner) filed a Rectification Application for removal of the registration from the Trade Marks Register, along with a Miscellaneous Petition before the IPAB seeking stay of operation of the registration until the said Rectification Application is finally decided. Bearing in mind the larger public interest, the said Miscellaneous Petition for stay was considered first, on an expedited basis. In that regard, the IPAB observed and held as follows:

(a) It is an established principle that a generic expression can never be granted registration and/or protection as a trade mark under the trade mark laws, except under limited circumstances when it has acquired a distinctive character in the minds of the relevant members of the target audience.

(b) The term N95 has been in use since the early 1970s, and refers to a single respirator face mask which was designed to filter 95% of the dust particles from entering the nose or mouth, and was initially designed by the famous 3M Company for industrial use. Indeed, the term N95 serves as an indicator in the trade to designate the kind, quality, intended purpose and other characteristics of the particular product which is non-proprietary in nature.

As the term N95 is prima facie a generic term in the mask industry, the same is neither capable of being registered or protected as trade mark (on the basis of inherent distinctiveness) nor can the same be appropriated by any one entity.

Registration of the impugned mark ought to therefore be barred under the absolute grounds of refusal under Section 9(1)(b) of the Trade Marks Act, 1999 (as amended). Further, the Respondent cannot monopolize the use of the said mark.

(c) The IPAB found that the Respondent is a squatter and has obtained registration for the mark N95 as a trade mark with mala fide intent.

(d) For inter alia the said reasons, given the current public sentiment during this global public health crisis and bearing in mind the dishonesty factor on the part of the Respondent, the IPAB stayed the operation of the trade mark registration No. 4487559, pending final disposal of the said Rectification action.

*Continued on next page*

# International Update continued

## KAZAKHSTAN

### PETOSEVIC

The amendments to the Kazakh customs legislation entered into force on 16 January 2021, introducing an online application system expected to significantly reduce the average timeframe for preparing and filing a Customs Watch Application (CWA).

Applicants have long been required to submit CWAs in paper form, along with a USB flash drive containing all the information included in the paper application. According to the amendments, CWAs and other related documents will soon have to be submitted exclusively via the electronic system and all communication with the customs authorities will also have to be conducted electronically.

The electronic filing system and the integrated e-contract system for insurance agreements are still under development and are expected to be launched by the end of March 2021. For the time being, the customs authorities still ask for the submission of applications and insurance agreements in paper form, along with a USB flash drive.

On another important note, rights holders are no longer required to submit documents confirming the illegal import of goods bearing their trade mark into the Eurasian Economic Union, such as court decisions, customs detention notifications, and other documents issued by state authorities. It is also no longer necessary to file original documents; scanned copies are now sufficient.

Insurance agreements should be arranged in the form of an e-contract between the right holder and the insurance company and submitted through the electronic system, which is integrated with the National Bank of Kazakhstan's database.

## PAKISTAN

### Vikrant Rana, S.S. Rana & Co.

On 24 February 2021, the Government of the Islamic Republic of Pakistan deposited its instrument of accession to the Madrid Protocol with WIPO's Director General. The Madrid Protocol will enter into force

for the Islamic Republic of Pakistan on 24 May 2021. By signing the accession of instrument, Pakistan becomes the 108th member of the Madrid System, which now covers 124 countries. Pakistan also becomes the fourth SAARC country, after India, Afghanistan and Bhutan, to join the Madrid Protocol.

Foreign applicants could now obtain trade mark protection for their marks by designating Pakistan in their Madrid Application along with other member countries. From 24 May 2021, using WIPO's online subsequent designation service, foreign companies and trade mark owners can expand their trade mark protection through the Madrid System to include the consumer market of Pakistan.

## ROMANIA

### PETOSEVIC

On 10 December 2020, the Romanian IPO enabled the electronic submission of documents for the following procedures related to trade marks:

- Trade mark withdrawals/renunciations;
- Oppositions;
- Observations;
- Limitations;
- Real security rights.

The electronic submission of documents for other trade mark related procedures was already available in Romania, namely for changes related to the right holder (name and address), changes related to the representative, transfer of rights, licenses and renewals. The online filing of trade mark applications has been available in Romania since 2014.

In late October 2020, the Romanian IPO enabled the electronic submission of documents for post-grant procedures related to industrial designs.

## THAILAND

### Denise Mirandah & Puwin Keera, mirandah asia – Singapore

The Department of Intellectual Property (DIP) in Thailand recently announced the implementation of a Fast Track system for (1) trade mark registration and (2) trade mark renewal, which took effect from 23

February 2021.

### Trade Mark Registration Fast Track System

The usual timeframe for a trade mark application is about 16 months. Under the new Fast Track system, trade mark applications that meet the two conditions below will automatically be reviewed in 6 months for approval:

- The total number of goods / services must not exceed 30 items.
- Goods / services must be selected from a pre-set list as per the DIP.

### Mark Renewal Fast Track System

The usual timeframe for a trade mark renewal is between 3-6 months. Under the new Fast Track system, it is envisaged that the examination of renewal application and grant of the Certificate of Renewal will be completed within 45 minutes, provided the renewal application meets the required conditions as follows:

- The total number of goods / services must not exceed 30 items.
- No changes have been made to the particulars of the trade mark registration, i.e., change of name or address, re-classification of goods etc. which will render the mark ineligible for fast tracking.
- The renewal application must be filed at the DIP by either the (1) owner, (2) an appointed local attorney; whereby, in the latter case, the Power of Attorney (POA) must clearly authorise the attorney to (1) file the renewal application and (2) collect the Certificate of Renewal on the owner's behalf.
- Fast Track examination must be requested with the DIP Officer at the time of filing the renewal application.
- All the required official fees of the renewal application are fully paid.

These announcements are viewed as a positive step towards a more streamlined process, but its practical effect remains to be seen, especially with trade mark applications, which can remain pending for an extended period of time.

# Overview of the Turkish Court of Cassation's Decisions on Pharmaceutical Trade Marks in 2020

Dicle Doğan and Ayşenur Çıtak, Gün + Partners

The Turkish Court of Cassation (the CoC) issued several decisions regarding pharmaceutical trade marks during 2020. This paper aims to provide the details of the CoC's several finalized decisions on pharmaceutical trade marks and to remark on their importance.

## Samumed v Sanimed

Decision No: 2020/273 K., 1 January 2020

A trade mark application SAMUMED covering all goods in class 5 was filed before the Turkish Patent and Trademark Office (the Office) and was rejected upon a third party's opposition based on SANIMED trade mark covering the same goods in class 5.

The applicant filed a cancellation action against the Office's decision by arguing that there is no likelihood of confusion between the trade marks since MED is commonly used in the sector as an abbreviation of medical, the main elements of the trade marks are SAMU and SANI, SAMU does not refer to the goods within the scope of the application whereas the trade mark which is the basis of the rejection is weak considering that SANI is an abbreviation of sanitary.

The first instance Civil IP Court (the IP Court) determined that the trade marks are confusingly similar and due to the high similarity level between them, average consumers may purchase them mistakenly especially for over-the-counter products since these products can technically be sold on the same shelves. As a result of this assessment, the IP Court rejected the case.

Upon appeal of the plaintiff, the matter was reviewed by the Regional Court of Appeal (the RCA). The RCA stated that pharmaceuticals are prescribed by physicians and sold in pharmacies, therefore healthcare professionals should be taken as the average consumers. The RCA also stated that even for purchasing over-the-counter pharmaceuticals, average consumers' attention would be above

normal. Therefore, the RCA concluded that trade marks are not confusingly similar considering the high-level attention of pharmaceuticals' consumers. As a result, it partially revoked the IP Court's decision and partially cancelled the Office's decision for 'pharmaceuticals'.

Upon further appeal of the defendants, the CoC upheld the RCA's decision and the SAMUMED trade mark has been registered only for pharmaceuticals.

## Zinco v Zincoral PEDIATRIK Şurup

Decision No: 2020/2599 K., 3 June 2020

A cancellation action was filed against the Office's decision which rejected the opposition filed against ZINCORAL PEDIATRIK ŞURUP (zincoral pediatric syrup in English) trade mark based on ZINCO trade mark.

The IP Court stated that the trade marks are confusingly similar and there is a likelihood of confusion between the trade marks since doctors and pharmacists are not the only concerned consumers but also pharmacy technicians working in pharmacies and consumers may also purchase paediatric syrups without a prescription.

Upon appeal of the defendant, the matter was reviewed by the RCA. The RCA stated that goods in class 5 concern informed consumers and the term ZINCO may be used for dietary supplements containing Zinc. As a result, the RCA reversed the IP Court's decision and rejected the case. RCA's decision was upheld by the CoC.

## Atromax v Aromax

Decision No: 2020/2976 K., 17 June 2020

A cancellation action was filed against the Office's decision which partially rejected the application ATROMAX for 'Medicines for human and animal health, chemical products for medical and veterinary purposes, radioactive chemicals' because of an opposition based on AROMAX trade mark.

The IP Court stated that ATRO refers to an active ingredient of ATROPIN and ARO is associated to aroma, therefore the trade marks are not confusingly similar and there is no likelihood of confusion between them. As a result, the IP Court accepted the case and cancelled the Office's disputed decision. Upon appeal of the defendants, the CoC reviewed the matter and upheld the IP Court's decision.

## Tripam v Triplixam

Decision No: 2020/4954 K., 11 November 2020

A cancellation action was filed against the Office's decision which rejected the opposition filed against TRIPAM trade mark in class 5 based on TRIPLIXAM trade mark in class 5.

The IP Court stated that TRIPLIXAM is distinctive and TRIPAM is not derived from the name of an active ingredient. Considering the common/similar goods within the scope of the trade marks, the IP Court partially accepted the case.

During the appeal phases, the matter was finally reviewed by the CoC and the CoC upheld the IP Court's decision.

## Importance of these recent decisions

In general, the Office, the first instance IP Courts and the RCA's decisions are in line with the CoC's decisions. However, these decisions reveal that courts may adopt contrary opinions even if there is a strict approach for evaluating pharmaceutical trade marks. Some details of the trade marks such as the etymology and the nature of the products being mostly sold under prescription are significantly taken into consideration by the CoC. In future 2021 decisions, we will see whether the Courts' approach will bring any further developments or discussions for pharmaceutical trade marks.

# MONOPOLY et al. - News from the EU General Court January – April 2021

Verena von Bomhard, Bomhard IP

In the first four months of 2021, the EU General Court (GC) issued five judgments concerning pharma marks, four of which were about likelihood of confusion and one about distinctiveness. Moreover, on 21 April 2021, the anxiously awaited judgment in the MONOPOLY case came out concerning re-filing of trade marks.

## Re-filing: the MONOPOLY case

Starting with the MONOPOLY case, the hopes for more clarity as to the legitimacy of re-filing of trade marks in the EU being provided by the GC were quashed. The judgment of the GC, while lengthy, did not do more than rehash the general rules and confirm the observations of the EUIPO Board of Appeal. These, in turn, were mostly based on the statement by Hasbro's representative at the oral hearing before the Board that the MONOPOLY marks were re-filed because this had 'administrative advantages', and, when pressed on the point, continuing to explain that Hasbro did not have to prove use in opposition proceedings when relying on the recent filing, rather than the older registrations for the same mark. For further details on the Board's decision of 22 July 2019, see the December 2019 edition of LL&P, pages 10/11, Rachel Wilkinson-Duffy - [https://ptmg.org/llp/llp\\_issues/llp\\_dec19.pdf](https://ptmg.org/llp/llp_issues/llp_dec19.pdf)

As such, one could say that MONOPOLY is less about a circumvention of the (substantive) use requirement applying to trade mark registrations in the EU than a circumvention of the procedural consequences thereof – namely, the need to provide evidence of use when relying on trade marks registered for more than five years in inter partes proceedings.

In MONOPOLY, the Board assumed bad faith also for those goods for which the mark was clearly used (and even famous), including board games. Bad faith therefore did not lie in an attempt to illegitimately protect an unused trade mark, or registering a mark with no intention to

use. It was assumed to lie in the intention to obtain an instrument for enforcing trade mark rights with greater ease. That also explains why the registration was not invalidated for goods that were not covered by earlier registrations, even though some of those were quite clearly beyond Hasbro's intentions to use, for example, fire extinguishing apparatus in class 9: the case was not about an absence of intention to use, and the Court did not even discuss the actual use by Hasbro. Nor did the Court pay much attention to the argument that re-filing a mark years after the earlier registration has become subject to use requirements effectively means that third parties were to 'squeeze in' laying their hands on the mark if indeed the mark was unused. These valid arguments have saved re-filed marks from invalidation in other cases before the EUIPO Boards of Appeal (e.g. R 758/2019-5 – s.O. – and R0351/2020-4 – Hamilton).

There is a way around the MONOPOLY case. MONOPOLY does not say that the re-filing of a trade mark previously registered for identical goods must necessarily be considered to have been done in bad faith. There can very well be sound legal or commercial reasons for the re-filing including a commercial need for legal certainty regarding the (absence of) vulnerability of a trade mark. That said, just 'having a new registration' won't do – and the onus of proof as to these legal or commercial reasons will likely shift to the trade mark proprietor once the invalidity applicant makes a case of re-filing.

The story may not be entirely over in that Hasbro could try to bring an appeal to the Court of Justice by the end of June 2021. However, since separate admission of such appeals became necessary on 1 May 2019, not a single appeal from GC judgments in IP cases has been allowed to be even heard – so a CJEU judgment on the substance of this case would be rather sensational.

## Absolute Grounds: medical beauty research not registrable

Turning now to other GC decisions in the first quarter of 2021, there was one absolute grounds case that concerned an invalidity action against the word mark 'medical beauty research' in classes 3, 5, and 44 (Case T-98/20). The invalidity action was largely successful in the first instance and entirely successful before the Board of Appeal. Not surprisingly, the GC sided with the EUIPO that the term 'medical beauty research' could be understood as referring to beauty enhancement through medical means. It therefore agreed that the term was descriptive for all goods and services that were in some way related to personal care, whether medicated or not. However, the Board's decision was annulled in respect of 'baby food', as the Board had not established a sufficiently close relationship between the nutrition of babies and medical enhancement of beauty. That issue will have to be reconsidered by the EUIPO Boards of Appeal.

## Relative grounds cases





As mentioned, there were four GC rulings on likelihood of confusion. Remarkably, all of these concerned the impact of weak elements in trade marks on the assessment of similarity of signs and of likelihood of confusion. In all cases, the GC endorsed the Board's findings, despite the opposite outcomes. Some judgments also contained interesting statements regarding the similarity of goods and services.

## Similarity of signs: the impact (or not) of weak elements

The four GC judgments concerned the following marks: (**SEE NEXT PAGE**)

In three of these cases, namely, in discount-apotheke.de, OptiMar and SANOLIE, the marks were found to be dissimilar, or similar to such a low degree

*Continued on next page*

Case	Earlier mark(s)	EUTM at issue
T-844/19 20 January 2021	 APODISCOUNTER APO	
T-261/19 20 January 2021	MAR	
T-817/19 27 January 2021	Hylo-Vision	
T-175/20 24 March 2021	SANODIN	SANOLIE

that there was no likelihood of confusion even in respect of identical goods or services. Only in Hydrovision, the similarities were considered to outweigh the differences and the weakness of 'Vision' for anything to do with eyes.

In discount-apotheke.de, the GC made complex considerations whether the relevant consumers understood APO or APOTHEKE (pharmacy in German) or DISCOUNT or both – but the outcome was plainly determined by the visual differences of the marks. These outweighed the fact that the marks shared 10 letters and that they were conceptually very similar for those consumers that understood both discount and Apo(theke). Precisely those consumers would also consider the word elements of both marks to be relatively weak. Taking into account the high attention level in respect of health-related goods and services, these consumers would not be confused.

In OptiMar, the earlier mark was again a German mark. As discussed by Margret Knitter during International case round-up at the recent PTMG@home event, the German consumers were considered to understand MAR as referring to the sea, and further to be aware that nasal sprays, for which the earlier mark enjoyed protection, are mainly made from sea water. This rendered the element MAR weakly distinctive, so that the visual and verbal differences to the trade mark applied for OptiMar sufficed to exclude confusion.

Similarly, SANODIN and SANOLIE were held not to be confusingly similar, as the common prefix SANO would be immediately understood by the relevant Spanish consumers (the earlier mark was a Spanish word mark) as meaning 'healthy', and is a frequent term in the context of health care in Spain.

Yet, the applicant for Hydrovision was less lucky. Here, the GC upheld the Board's findings that also weak (or descriptive) elements had to be taken into account when comparing trade marks. The term 'vision' present in both marks was therefore far from irrelevant. Also the hyphen in the earlier mark (Hylo-Vision) and the graphics of the mark applied for did not exclude likelihood of confusion. After dedicating 25 paragraphs (three and a half pages) to the assessment of the two marks' distinctive and dominant elements, the Court concluded that 'vision' would not be disregarded by the consumer, despite being the second element, because it was longer than the prefixes (Hydro and Hylo-), which, moreover, were not 'original or fanciful' so as to 'attract the public's attention' (§72). This conclusion does appear somewhat at odds with the other decisions, in particular SANOLIE and SANODIN where the prefixes were effectively disregarded in the comparison of marks. It is, however, in line with the earlier GC ruling in MUNDIPHARMA v MULTIPHARMA. Also in that case, the clearly different meanings of MULTI and MUNDI and the descriptiveness of PHARMA did not suffice to rule out a

likelihood of confusion.

It must be concluded that the descriptiveness of the common elements of trade marks is a valid point but will not always be successful, especially where the other elements also have important similarities.

## Similarity of goods and services

The recent GC rulings also contained some interesting notes on similarity of goods and services:

In discount-apotheke.de, the GC confirmed that retail services relating to pharmaceuticals (i.e., services of a pharmacy) were similar to an average degree to pharmaceutical products. The Board had also found there to be similarity, but only to a low degree.

In OptiMar, the GC held that medicated nasal sprays were similar to medicated dental rinses, contrary to the Board, which had considered them dissimilar (§§ 28, 29). The Board's further findings that medicated nasal sprays were similar to, inter alia, ophthalmological preparations and to medical apparatus and instruments in class 10 were undisputed before the GC.

Finally, in SANOLIE the GC dealt in extenso with the similarity of skin care products in class 3, as comprised by the opposed mark, and the goods in classes 1 and 5 covered by the earlier mark. The GC concluded – unsurprisingly – that chemical goods and skin care are not similar; indeed, the mere fact that the former are used to make the latter does not make the goods complementary (§ 30). Pharmaceutical preparations and skin care, in turn, are similar, because both can be applied to the skin; however, the similarity is only to a low degree (§ 44). That said, disinfectants in class 5 were found dissimilar to skin care, although both can be applied to the skin (§§ 50 et seq.). The latter two statements are at odds with earlier GC case law and indeed the EUIPO practice: in T-363/13 (CLEANIC intimate) the GC held expressly that both pharmaceuticals and disinfectants were similar to cosmetics to a normal degree (at § 42) and that is also reflected in the 'Similarity Database' of the EUIPO.

# Argentina – Navigating the new trade mark opposition system.

By Iris V. Quadrio and Juan López Mañán, partners of Marval, O’Farrell & Mairal

## Background

In early 2018, the Argentine government issued a wide-ranging emergency decree to modernize the federal administration and reduce red tape. This resulted in the amendment of over 50 laws, including the Argentine Trade Mark Law, the Patent Law and the Industrial Designs Law. In May 2019, the legislative amendments were formally approved by the Argentine Congress under Law No. 27.444.

The most relevant amendments in the field of trade mark law include:

- The administrative prosecution and decision of oppositions, non-use cancellations and invalidations (except based on bad faith), which are now handled by the Trade Mark Office (TMO).
- The filing of a mid-term declaration of use between year five and six of registration.
- The introduction of partial non-use cancellation actions in respect of unused goods and services as from June 2023.
- The possibility to renew trade mark registrations 6 months prior to the renewal deadline and 6 months after the expiration of the renewal term.

The implementation of the new law required additional regulations to set the rules of the administrative opposition procedure (Resolution No. 183/18); administrative non-use cancellation actions and invalidation proceedings (Resolution No. 279/19). Regulations on mid-term declarations of use were issued as well (Resolution 123/19).

The amendment of the opposition system has been one of the biggest game changers in the Argentine trade mark system since, for over 140 years, it was not the TMO but the Federal Courts who

were the competent authority to decide on trade mark opposition cases.

Given the significant impact of this change in local practice and considering that the TMO has already issued the first batch of decisions, we shall analyze the key aspects of the new administrative opposition system and will briefly comment on the most relevant cases involving trade marks in class 5.

## Trade mark Oppositions – The shift from judicial to administrative decisions.

Under the former law, once a trade mark application was opposed, the prosecution of the mark was blocked unless the applicant settled the opposition or otherwise took the case to court. A one-year negotiation phase was granted by the TMO, which in practice extended to over two years, for the applicant to reach a friendly settlement with the opponent. In the absence of an agreement within such term, the opposed application was declared abandoned unless the applicant completed mandatory pre-trial mediation and, if unsuccessful, filed court action before the Federal Courts.

The former opposition system was an effective tool for opponents to block trade mark applications, in particular bad faith applications. However, the system was extremely balanced in favour of opponents as it also permitted many speculative oppositions where an opponent would simply block an application, refuse to negotiate, and force the applicant to take the matter to court.

Over time, the system became costly and time consuming. However, since its inception, the Argentine Federal Courts became highly specialized in trade mark matters and developed a high reputation in the region due to its rich body of decisions.

Under the new system, the TMO decides on oppositions and its decisions can be appealed before the Federal Court of Appeals.

One of the main objectives of the new system was to reduce the length of the opposition process. To achieve this goal, the negotiation phase was reduced from one year to three months. In addition, the burden of prosecuting an opposition shifted to the opponent, who must now ratify the opposition to keep it active if the case is not settled within the three-month negotiation phase.

Failure to ratify the opposition by the opponent converts the opposition into an informal objection to be decided by the TMO with no further intervention of the opponent. The new administrative opposition procedure resembles the main stages of litigation. In a nutshell, after expiration of the 3-month negotiation term, the TMO will notify the opponent who will have 15 working days to ratify the opposition, pay an additional official fee (currently USD \$120) and submit additional arguments and evidence, if any. The applicant will then have the opportunity to respond to the opposition and submit evidence, within a 15 working days term. After the production of evidence by the parties, there is an option to submit closing arguments. The TMO will then decide on the merits of the opposition.

## A look at the TMO decisions

At first, local practitioners had serious doubts whether the TMO had sufficient capabilities to effectively implement the new changes, both in terms of infrastructure and human resources. In early 2020, the TMO issued its first decisions but this was halted due to the suspension of terms following the Covid pandemic. In 2021, the TMO got back on track and resumed the issuance of

*Continued on next page*

# Argentina – continued

decisions in opposition cases, which at the time of writing this article, exceed 750. The decisions are shorter than a regular court decision but still well-structured and, most importantly, they follow the criteria and principles of the existing case-law of the federal courts, in topics such as legitimate interest to oppose an application, rules to appropriately compare trade marks, recognition of well-known trade marks, direct and indirect confusion, among others.

So far, the TMO has admitted clear cut oppositions involving identical or confusingly similar trade marks. It now remains to be seen how the TMO will resolve more complex opposition cases that are not based on local trade mark rights but on, for example, prior use and registration in other countries, unregistered rights, copyright, or other IP rights.

Specifically referring to pharmaceutical products, in the past, the courts applied a strict criterion to decide on the similarity of class 5 marks. Over the years, they started to apply a more flexible approach whereby decisions were taken on a case-by-case basis, depending on the circumstances of each case. The TMO followed the criteria adopted by the courts in class 5 conflicts, as shown by the decisions that have been recently rendered in the most relevant cases involving trade marks in class 5:

- **TOMEX (applicant) v TOBEX (opponent):** the opposition was admitted. The TMO considered that the trade mark application was confusingly similar to the earlier registration, both visually and phonetically. The TMO also argued that the likelihood of confusion conclusion was supported by the fact that both products would likely be sold in the same channels of trade.
- **XATERON (applicant) v ASOTERON (opponent):** The opposition was dismissed. In the examiner's view, the marks in conflict are not confusingly

similar in any of the different fields of comparison (visual, phonetic and conceptual). In addition, the examiner sustained that the products of interest to each party were sold under prescription which reduced the likelihood of confusion.

- **IRRITAN (applicant) v IRRICUTAN (opponent):** the opposition was admitted. The TMO considered that the trade marks in conflict were visually and phonetically similar, that both were wordmarks without any other elements that could add distinctiveness, and that there was overlapping of products as the trade mark application had been filed broadly.
- **OXIDAN (applicant) v ZIDAN (opponent):** the opposition was admitted. Although the TMO considered that the trade marks in conflict were not visually confusingly similar, the TMO found likelihood of confusion when comparing the marks from a phonetic perspective. The TMO also took into consideration the fact that the application had been filed broadly in class 5.
- **TYKOSIN (applicant) v NICOZINC (opponent):** the opposition was dismissed. The application was filed to cover a 'cardiac antiarrhythmic', while the opponent's trade mark covered a 'vasodilator'. The TMO did not find similarity and understood that each trade mark would be used to treat specific diseases and that the degree of care by both physicians and patients removed any likelihood of confusion. In the TMO's view, the average consumer does not usually self-medicate and generally looks at the packaging, information leaflets etc that differ depending on the manufacturing laboratory.

Only very few TMO decisions have been appealed before the Federal Courts, and the decisions are still pending.

## Final Comments

The overall amendments to the Argentine Trade Mark Law have certainly brought the local legislation in line with international standards. Whilst the TMO faced the implementation with limited resources, they have successfully been able to train a new body of examiners, and the results so far have been very positive.

The new rules have had a significant impact on the prosecution of trade mark oppositions. With the burden of proof shifted to the opponent who has now a more active role, it is expected that the number of speculative oppositions will decrease.

On the other hand, the new system favours the applicant, whose failure to respond to additional arguments and evidence submitted by the opponent are not interpreted by the TMO as a lack of interest in the application. This results in the inefficient assignment of resources to the resolution of an increasing number of oppositions where the applicant may have presumably lost interest.

Although the length of the opposition process has been significantly reduced, if compared with the previous system, high expectations have been placed on the TMO to streamline the opposition process. It is therefore hoped that the TMO continues making efforts to maintain an agile and dynamic system and keeps working towards building a new robust administrative case-law.

# PROFILE: Laura Pedemonte

Laura has been in practice for over 20 years and in 2010 joined Barzanò & Zanardo, Milan (Italy) where she is a Senior Trade Mark Counsel and heads the Trade Mark Department.

She has developed specific expertise in the pharmaceutical field and has significant experience with portfolio management including strategy, protection and enforcement.

She regularly lectures at professional seminars and IP Courses organized by EUIPO, University of Alicante (Spain), University of Milan (Italy). In particular she had the privilege of speaking to her PTMG colleagues at the recent Spring conference in Rome.



## **Where were you brought up and educated?**

I was born in the coastal town of Genoa (Italy), where I was brought up and graduated in law. After University, I moved to Milan (Italy) and joined the team of a well-known IP firm and studied to be admitted to the Italian Bar of IP Consultants.

## **How did you become involved in trade marks?**

While at university, I got particularly interested in IP law, so I decided to join a law firm focusing on this aspect.

## **What would you have done if you hadn't become involved in intellectual property?**

I would have liked to become a physician. When considering my academic choice, I seriously thought about studying medicine. It is an interesting discipline and the medical profession allows you to help others.

## **Which three words would you use to describe yourself?**

Friendly, enthusiastic, determined.

## **Complete the following sentence.**

**"I wish ...."**

I wish the pandemic problem would be resolved as soon as possible so that everyone can return to the life he/she wants to live..

## **What was (were) your best subject(s) at school?**

Foreign Languages, Philosophy and History.

## **What do you do at weekends?**

Enjoying family life and meetings with friends, hiking, reading, gardening, cooking, listening to music, visiting nice exhibitions, travelling whenever possible.

## **Complete the sentence: If I have time to myself ...**

I spend it with my beloved ones and friends, I like to study a new foreign language.

## **What's the best thing about your job?**

Collaborating and getting in touch with people from all over the world, which is very enriching and stimulating. Moreover, this job allows you to come into contact with different clients, sectors and cases, so every day is different from the other and exciting.

## **What did you want to be as a child?**

A teacher, like my father.

## **What is your favourite work of art?**

I love the Italian Renaissance period, in particular I would mention the frescos in the Sistine Chapel (St. Peter's Basilica, Vatican City) and the Pietà sculpted by Michelangelo (St. Peter's Basilica) for their complexity, perfection and breathtaking artistic beauty.

French impressionism and the special light of those paintings also touch my soul.

## **What do you dream of?**

Travelling more often.

## **What is your weakness?**

Chocolate!

## **What is your favourite children's book?**

The Adventures of Pinocchio by Carlo Collodi (which has become even more famous thanks to the Walt Disney movie). This book is impressive for its amazing fictional story, which makes children dream, and its educational aspect.

## **What music is in the CD player in your car / what is your iPod set to at the moment?**

Pink Floyd, Leonard Cohen

## **Which one person would you invite to dinner (other than a family member or relative)?**

Architect Renzo Piano: I would really love to meet him once, it would be an unforgettable conversation.

## **What is your favourite food dish?**

I love fish.

## **What is your favourite drink?**

A glass of good red wine or Porto wine.

## **What is your favourite holiday destination?**

Preferably any place where beautiful landscapes mix with historical sites.

## **What is your favourite item of clothing?**

Handbags and shoes.

## **What is your favourite item of jewellery?**

Necklaces, I always wear one.

## **What is your favourite building / piece of architecture and why?**

The town of Venice, which is an open-air architectural museum.

The magic of the pyramids.

## **What's the best invention ever?**

Especially these times have taught us that inventions in the medicine sector (I mean vaccines, antibiotics) and surgery have been and still are fundamental for humanity.

## **What do you like, even though it's not fashionable?**

Vinyl records.