

Law Lore & Practice

PTMG



Pharmaceutical
Trade Marks Group

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Editorial

These last months have been filled with international events which in turn have marked several anniversaries. From nuclear accidents to royal weddings, each of us internalises these dates by a personal memory of where we were or what we were doing on that day. For most French people May 1981 is marked by memories of the arrival of the first

socialist President under the Fifth Republic, whereas for most English people July 1981 was the last royal wedding, which incidentally I also watched in France!

Another personal date for the diary this Spring was my invitation from the serving French President to attend a symposium entitled 'What future for local hospital care?' Heaving with local dignitaries and health care professionals from the region, not to mention the press, it was with much interest that I listened to the question and answer session which dealt with matters ranging from encouraging young medical students to become rural General Practitioners to end-of-life care in the community. Our area had been chosen for this national event because

Fontainebleau is soon to see a brand-new public/private funded hospital which is an innovative approach for this country.

One of my lasting personal memories when I first moved to France was the importance in both size and content of every self-respecting French home's medical supplies. These were kept in a cabinet which reminded me of the sports cupboard under the stairs at home which overflowed with pony riding and cricket gear!

Over the past twenty years mentalities have been changing here and no one expects to emerge from the chemists weighed down with a shopping bag of remedies any more. Herein, of course, lies a challenge for the pharmaceutical industry. Nevertheless, medical costs per capita in every country will continue to rise in the future. If I may be allowed to loosely paraphrase Mr. Sarkozy, longer lifespans, increased costs in advanced treatments and our lack of resistance to pain will all be factors which will drive national health care budgets. This, of course, will vary depending on the continent we live in and national specificities but as a race our health is our future and none of us have a more important date with history than the one ahead of us.

Vanessa

US Law Update

James A Thomas, Troutman Sanders LLP

In a decision that reminds trade mark owners that they should not ignore quality control when licensing US marks, the US Court of Appeals for the Ninth Circuit held that a trade mark owner who had failed to exercise sufficient quality control had as a result abandoned its marks. In so finding, the Court found that the trade mark owner failed to prove sufficient quality control because it '(1) did not retain express contractual control over [its licensee]'s quality control measures, (2) did not have actual controls over [its licensee]'s quality control measures, and (3) was unreasonable in relying on [its licensee]'s quality control measures.' Licensors taken note. *Freecycle sunnyvale v. The Freecycle Network*, 626 E 3d 509 (9th Cir. 2010).

Trade mark owners and advertisers using their marks in keyword-triggered ads in online searching tools continue to square off in US courts. A few recent cases bear mention. In *-800 Contacts, Inc. v. Lens.com, Inc.*, 2010 U.S. Dist. LEXIS 132389 (D. Utah Dec. 14, 2010), the US District Court in Utah found that although purchase and use of a mark as a keyword

was 'use' for purposes of trade mark law, the fact that the plaintiff's mark did not appear in the text of defendant's ads weighed most importantly against likelihood of confusion. In *Binder v. Disability Group, Inc.*, 2011 U.S. Dist. LEXIS 7037 (C.D. Cal., Jan. 25, 2011), the US District Court for Central District of California found that the defendant's use of the plaintiff's marks in keywords to trigger the appearance of ads for the defendant constituted infringement and passing off. The court's finding was based on a survey that showed some users believed that they were at the trade mark owner's website when in fact they had clicked onto the defendant's site. And in *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 2011 WL 815806 (9th Cir. Mar. 8, 2011), the US Court of Appeals for the Ninth Circuit overturned a preliminary injunction issued by the lower court involving use of trade marks in keywords to trigger the appearance of defendant's ads in search results. In so holding, the court warned against a strict application of the three-factor test for confusion previously used in prior domain

name and internet advertising decisions, often called the 'internet trinity', i.e. similarity of the marks, relatedness of goods or services, and the use of the internet as a marketing channel. The Court of Appeals held that courts must still apply the traditional factors for likelihood of confusion and sent the case back to the lower court for further proceedings.

Finally, the US Patent and Trademark Office (USPTO) has decided to end the traditional practice of assigning design codes to newly registered trade marks based on its old paper search designations; instead it will only assign codes based on the International Classification of the Figurative Elements of Marks (76 Fed. Reg. 11,432). In a separate notice, the USPTO is also seeking comment about the extent to which the Trademark Trial and Appeal Board should become more directly involved in settlement discussions between parties in *inter partes* proceedings, including oppositions, cancellation cases, and concurrent use cases (76 Fed. Reg. 22,678).

Members News

I am delighted to announce that we have finally published a new edition of the *Member's Directory*. You should have received your copy by now but please let me know if you haven't. Inevitably there are a few errors (please remember to keep us updated with your movements!) but there is one in particular for which I make an especial apology. The membership status for our Honorary President, Derek Rossiter, indicates that he is an Associate member when, of course, it should indicate Full member. Sorry Derek.

Now that we, at PTMG, have moved firmly into the electronic age and are sending out *LL&P* via e-mail, I thought it would be appropriate to provide the e-mail address of new members rather than their postal address.

New Members

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

Ibrahim Tuncel of Aksan Law Office, Istanbul, Turkey (ituncel@aksan.av.tr)

Tim Meyer-Dulheur of Dr. Meyer-Dulheur & Partner, Frankfurt am Main, Germany (tmd@legal-patent.com)

Catherine Bidet of Roche Diagnostics GmbH, Mannheim, Germany (Catherine.bidet@roche.com)

Joel Leviton of Fish & Richardson, Minneapolis, USA (Leviton@fr.com)

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Ranjan Narula of Ranjan Narula Associates, Gurgaon, India (marula@indiaiprights.com)

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John Colbourn of Redd Solicitors LLP, London, UK (john.colbourn@redd.eu)

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Moves and Mergers

Bret Parker has now joined Elizabeth Arden in New York
(Bret.Parker@ElizabethArden.com)

Ian Starr and **Tamsin Holman** have left Ashurst LLP to join the London office of D Young & Co LLP. Their new contact e-mail addresses are ics@dyoung.co.uk and tph@dyoung.co.uk

Giulio Martellini, formerly with SJ Berwin in Italy has joined Notarbartolo & Gervasi S.p.A. in Turin
(g.martellini@ngpatent.it)

Manja Epping has left Ashurst in Germany to join Taylor Wessing in their Munich office
(m.epping@taylorwessing.com)

Magdalena Cybulska is now with Clifford Chance Janicka, Kruzewski, Namiokiewicz, i wspolnicy sp.k. in Warsaw, Poland
(Magdalena.Cybulska@cliffordchance.com)

Teresa Hechmer Anzalone has joined the Symbus Group LLC in Bryn Mawr, Pennsylvania, USA
(tanzalone@symbus.com)

Christine Graser has left Merck KG in Germany to join Spitz Legal in Munich
(cgraser@spitzlegal.com)

Karolina Marciniszyn is now with Kochanski Zieba Rapala & Partners, Warsaw (kmarciniszyn@kochanski.pl)

Abida Chaudri has recently left the Museum of Brands in London and has now joined Grant Spencer
(Abida.Chaudri@grantspencer.com)

As mentioned above, 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 or directly to Lesley@ptmg.org or by writing to me at Tillingbourne House, 115 Gregories Road, Beaconsfield, Bucks, HP9 1HZ

Lesley Edwards

PTMG Secretary

Use of independent internet research by OHIM (Ineos Healthcare Ltd v OHIM, Case T-222/09, 9 February 2011)

Jenny Barker, Supervising Associate, Simmons & Simmons LLP, London

The issue

In a comparison of the goods for which a trade mark is applied for and those for which the earlier trade marks are registered, to what extent can the Office for the Harmonization of the Internal Market (OHIM) and the Board of Appeal conduct their own research in addition to basing their conclusions on the evidence submitted by the parties?

This issue was recently considered by the European Union General Court.

The facts

Ineos had applied to register the word ALPHAREN as a Community trade mark in Class 5 in respect of:

- pharmaceutical and veterinary preparations containing magnesium iron hydroxy carbonate or hydrotalcite or derivatives of these compounds (Category A);
- pharmaceutical and veterinary preparations for use in renal dialysis and in the treatment of renal diseases and kidney ailments (Category B); and
- phosphate binders for use in the treatment of hyperphosphataemia (Category C).

As is often the case for Class 5 trade mark applications, Ineos had therefore included both a more general category of goods, the category B goods, in addition to more specific categories of goods, the category A and C goods.

The application was opposed by Teva Pharmaceutical Industries Ltd. Teva succeeded in its opposition, relying on its prior national registrations of the word

mark ALPHA D3, all of which were registered in Class 5 for broadly the same goods, namely 'pharmaceutical preparations for regulating calcium'.

The Board of Appeal had concluded that there was a likelihood of confusion and based its decision, in part, on the definition of hyperphosphataemia which it had found in the online dictionary of medical terms. It had also searched on a US Government internet site devoted to clinical trials for therapeutic indications of magnesium hydroxyl carbonate or hydrotalcite. Finally, the Board of Appeal had relied on information which it had found on the internet site of a company distinct from the applicant but part of the same group

Ineos argued that, in conducting its own research, OHIM had breached Article 74 of Regulation 40/94 which provides that in proceedings relating to relative grounds for refusal of registration, it must restrict its examination to the facts, evidence and arguments provided by the parties and the relief sought. The EU General Court referred to earlier cases in which it has been held that the Board of Appeal was not precluded 'from taking into consideration, in addition to the facts expressly put forward by the parties to the opposition proceedings, facts which are well known, that is, which are likely to be known by anyone or which may be learnt from generally accessible sources' (Case T-185/02 *Ruiz-Picasso and Others v OHIM*).

Whilst the websites were accessible to the public, the Court held that this was not sufficient for it to be considered that

well-known facts were involved. In fact, the Court stated that the case involved 'a description of pharmaceutical preparations and their therapeutic indications which, having regard to their highly technical nature, cannot in any way be regarded as information constituting well-known facts'. Importantly, it was found that the Board of Appeal could not have reached the conclusion that there was similarity between goods in Category A and the goods in Category C on the one hand and goods covered by the earlier marks on the other, without the benefit of the disputed research.

The Court therefore upheld the appeal and dismissed the opposition in respect of the Category A and C goods.

Conversely, the Court held that the disputed research merely confirmed the conclusion of the Board in respect of the Category B goods and therefore the opposition in respect of Category B goods was upheld.

Comment

This decision of the EU General Court is to be welcomed since it helps to clarify an area on which the law was previously uncertain. Indeed, it would have been inequitable for the EU General Court to have come to the opposite conclusion, given that the applicant was not given any opportunity to comment on the research conducted by the EU General Court. The decision does not, however, provide in depth guidance on when, precisely, facts can be regarded as facts which are of a highly technical nature as opposed to facts which are well-known.

International Update

Australia: Raising the bar for intellectual property

Frances Drummond and Jessica Selby, Freehills, Sydney

The Australian government recently released the Exposure Draft of the Intellectual Property Laws Amendment (Raising the Bar) Bill 2011. The Bill proposes amendments to the Trade Marks Act 1995, the Patents Act 1990, the Copyright Act 1968, the Designs Act 2003 and the Plant Breeder's Rights Act 1994, with the goal of improving Australia's Intellectual Property rights system in order to encourage investment in research and technology and support innovation.

The Bill proposes to improve the quality of granted patents by raising the thresholds set for the grant of an Australia patent. Other key changes include the streamlining of trade mark and patent opposition proceedings and the introduction of the Federal Magistrates Court as a forum to hear certain Intellectual Property matters.

Additional reforms include extending attorney-client privilege to communications with foreign attorneys and some third parties and amending legislation to permit companies to describe themselves as patent or trade mark attorneys.

Additionally, the proposals aim to improve trade mark and copyright enforcement mechanisms by simplifying customs seizure provisions, granting the court the power to award exemplary damages in flagrant trade mark infringement cases and introducing stronger penalties and more flexible offence provisions.

The deadline for filing submissions regarding the Bill concluded in early April. It is expected that the Bill may be amended in light of the submissions and that it will be introduced to Parliament in the winter session 2011. This would likely see most of the provisions in force by mid 2012.

China: Criminal law amendments abolish criminal threshold on counterfeit drugs

August Zhang, Rouse

Under Chinese law, criminal prosecution against counterfeiters is possible only if the prescribed monetary or quantitative threshold is satisfied. For example, to establish the crime of trade mark counterfeiting for general consumer goods, it is necessary to prove that the value of counterfeit goods is RMB 50,000 (approx US\$7,575) or more. Brand owners have wanted to abolish this threshold for years.

New criminal law amendments, effective as of 1 May 2011, have made progress in abolishing the criminal threshold for

counterfeit drugs. Under the old law, an infringer of counterfeit drugs could be prosecuted only if it was proven that the counterfeit drugs 'may cause sufficient harm to human health', which required substantial evidence. The criminal law amendments have abolished this requirement provided that anyone who produces and/or sells counterfeit drugs is sentenced to imprisonment of not more than three years. If the counterfeit drugs have caused death or any serious injury to human health, the court is allowed to impose longer imprisonment or even the death penalty.

The abolition of the criminal threshold will be welcomed by drug companies who suffer counterfeit problems in China. However, the criminal threshold for other products or Intellectual Property infringements will remain and there is no sign that law makers intend to abolish it in the near future.

Hungary: Hungary toughens regulations on counterfeit drugs

Petosevic, Macedonia

A new amendment to the Hungarian law on counterfeit medication which increases the fine for production, distribution and trade of unlicensed medicines entered into force on 1 March 2011. The amendment prescribes a fine of EUR 367 (US\$510) for unlicensed production and distribution of drugs and authorises law enforcement officers to confiscate the drugs immediately. The new regulations also prescribe fines and seizures for anyone found in possession of medicines withdrawn from the market, unlicensed medicines or prescription drugs exceeding a single patient's needs.

Kingdom of Saudi Arabia: Update on Trade Mark Enforcement

Edward Hardcastle, Rouse

Enforcement action against identical marks on identical goods using the administrative authorities in the Kingdom of Saudi Arabia has been available for many years. Previously the Quality Control Inspection Department of the Ministry of Commerce had responsibility. That responsibility was then passed to the Anti-Commercial Fraud Department in the Ministry. The main ACFD office is in Riyadh. There are branches in each of the provinces in Saudi Arabia. The ACFD handles many thousands of complaints a year on a variety of commercial fraud issues, of which counterfeiting is one.

Many can hardly have failed to notice the announcements by King Abdullah since February 2011 of the injection into the Saudi economy of an estimated US\$129 billion. Many of the projects are large and high profile – the building of 500,000 new

homes for example. One small part of those announcements was the intention to recruit up to 500 extra inspectors for the ACFD. This is a significant increase in the resources in the department and one that will bring cheer to many brand owners. Clearly, such large numbers of people cannot be recruited overnight. However, the intention to protect the interests and safety of consumers is clear.

Malaysia: Amendments to the Trade Marks Regulations

Su Siew Ling, Tay & Partners

The Malaysian Intellectual Property Office (MyIPO) recently introduced and implemented the new Trade Marks Regulations 2011. The new Regulations came into operation as of 15 February 2011 with relatively short notice to Intellectual Property owners, practitioners and other stakeholders.

Changes brought about by the new Regulations include notably the increase in official fees and introduction of reduced official fees for online filing. Online filing will now officially be an alternative and encouraged or preferred mode of filing applications given the discount in official online filing fees. MyIPO has set up a new online filing system to facilitate this. Online filing for trade mark applications had been available for almost 3 years now though there was no discrimination of fees between manual and online filing. Problems are still encountered from time to time with online filings as MyIPO continues to iron out technical glitches.

There has generally been a 30–50% increase in official fees and new fees have also been imposed on filing of certain requests or documents, such as a request for ex-parte hearing before the Registrar. Official fees had not been revised by MyIPO for some time, and the last revision of trade mark filing fees was back in 1997.

Other than the fee increase, the new Regulations are aimed at expediting the registration and grant of trade marks. There is now for the first time an avenue in which an applicant for a trade mark may apply for an expedited examination of the trade mark within a prescribed time frame from the date of filing. There is no automatic grant of approval to a request to expedite examination and an application to expedite examination must be accompanied by cogent reasons in the form of a sworn declaration, amongst others.

Acceptable grounds for an expedited examination of a trade mark include national or public interest, infringement proceedings (actual or prospective) and disbursement of governmental or institutional funds where registration or

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grant of the respective right is a prerequisite.

If the request for expedited examination is approved, a trade mark that faces no adverse examination report or opposition is supposed to be registered just under 7 months from the date of filing. However, if an objection is raised by the Examiner, the expedited examination will no longer be applicable and the application will fall within the normal examination process.

MyIPO has further truncated the time frame in which the trade mark owner must pay the advertisement/gazette fee, from the initial two-month period to a mere one month. This will prove to be challenging for foreign trade mark owners, especially if instructions on filing are routed through their agents. There remains the possibility of extending time to submit and pay the gazette fee, subject to payment of the requisite extension fee.

The amendments will affect all applications filed after 15 February 2011. There are bound to be teething problems and uncertainties on the implementation of some of the new provisions. It remains to be seen if Malaysia can achieve a system that purports to register trade marks and in the shortest time frame, without sacrificing quality, a virtue upon which most trade mark owners place an equal if not greater emphasis.

Slovenia: Slovenian IPO issues statements of grant of protection for International Registrations

Petosevic, Macedonia

The Slovenian Intellectual Property Office (SIPO) is to start issuing statements of grant of protection for International Registrations (IRs) designating Slovenia with application dates of 1 January 2011 or later. When all procedures regarding

IRs have been completed before SIPO, SIPO will send official statements to WIPO that registrations have been granted protection in Slovenia. SIPO will start issuing the statements in April 2011, following the three-month opposition period, or at the latest within the prescribed 12-month period.

This change is particularly favourable to international trade mark owners who were not previously informed about the status of their IRs in Slovenia. In the past, the IR became valid in the territory of Slovenia, or any other designated country, if the Intellectual Property Office had not sent a notification of provisional refusal to the WIPO within the 12-month period.

Taiwan: Keyword advertising does not constitute trade mark infringement

Ruey-Sen Tsai, Lee and Li, Taipei

Whether using another's registered trade mark in keyword advertising constitutes trade mark infringement is a controversial question around the world. However, neither the Taiwanese Trademark Act nor the Fair Trade Act explicitly addresses keyword advertising.

In a recent civil case (98-Ming-Shang-Shang-No. 11), the Intellectual Property Court determined that because keyword advertising does not use registered trade marks for marketing purposes and given that users who entered the search terms would not become confused, keyword advertising is not use of trade mark, and therefore does not constitute trade mark infringement.

Notwithstanding this decision, the Fair Trade Commission decided in the case of Gong-Chu-098133 that a business enterprise's use of keyword advertising may adversely affect the economic

interests of other enterprises if the enterprise purchases keyword advertisements that make use of other enterprises' trade marks, names, or other business symbols in order to increase the number of visitors to its own website, and to redirect potential customers to its website. The Commission determined that such use of keyword advertising is in violation of Article 24 of the Fair Trade Act. On appeal, the Executive Yuan upheld the Commission's interpretation of Article 24.

United Arab Emirates: Update on trade mark enforcement in free trade zones

Sara Holder, Rouse

Enforcement of trade marks and against counterfeits in the UAE's many free trade zones has traditionally been problematic. Although there have been a number of successes over the years, there has been a lack of clarity over which authority (Customs, Police, Free Zone authorities and/or other administrative authorities) would be able to take actions. Brand owners generally needed to have substantial patience to set up an action. The issue is further complicated by the fact that the UAE is a federation of seven Emirates and each has their own procedures and authorities for enforcement.

Brand owners will therefore be heartened by a recent announcement that the Dubai Department of Economic Development now has authority to conduct inspections and seize infringing goods in several but not all of Dubai's free trade zones. This is an important development as it provides an easy-to-use administrative procedure in some of the most notorious counterfeit markets in the UAE such as DragonMart.

The Max Planck Study: A Personal Speed Read for the Pharmaceutical Industry

Michael Hawkins, Senior Associate, Hogan Lovells, Alicante

On 8 March 2011, the European Commission made public the 'Study on the Overall Functioning of the European Trade Mark System' (the Study), carried out on its behalf by Munich's Max Planck Institute. The Study, a magnum opus of the most talked-about issues affecting trade marks and trade mark proprietors in the European Union today, forms part of the Commission's overall evaluation of the functioning of the trade mark system in the European Union, an evaluation that will ultimately culminate in legislative and non-legislative proposals for change being announced towards the end of 2011. This article

will address the pharmaceutical industry's key concerns with the existing system and the Study's corresponding recommendations.

Why change? What issues/concerns does the pharmaceutical industry have with the current system?

In compiling the Study, the Max Planck Institute consulted with a number of industry groups and user organisations, of which the European Federation of Pharmaceutical Industries and Associations (EFPIA) was one. In its position paper, the EFPIA expressed that

more work was needed to fully harmonise the legislation and practices of different Member States and OHIM. One particular issue highlighted was classification and the use of class headings. The EFPIA also observed the need for predictability in the co-existing Community and national systems, and called for considerably more investment in the development of inter-compatible electronic tools, databases and systems.

The EFPIA also addressed the manner in which the Office for the Harmonization of the Internal Market (OHIM) examines

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the similarity of pharmaceutical trade marks. OHIM's current opposition practice is considered to be too liberal, allowing registration of similar trade marks because they cover different therapeutic categories. According to the EFPIA, this practice makes it notably more difficult for pharmaceutical companies to secure a valid trade mark from a safety perspective.

On the other hand, the EFPIA considered that some elements of the present systems should not be changed. These include the duality of Community and national systems, the 'first-to-file' principle, the possibility to claim seniority, and the absence of the requirement to prove 'intent to use' for registration or upon renewal.

In relation to the vexed question of use of a CTM in the Community and in order to ensure greater legal certainty, the EFPIA called for a statement to be added to the CTM legislation to the effect that genuine use in one Member State constitutes genuine use in the Community.

Conscious of the public health threat posed by counterfeit medicines, EFPIA believes it important to apply sanctions to counterfeit goods in transit in the EU but originating from and destined for non-EU countries. Such sanctions are currently (at the date of writing) very difficult to obtain, requiring proof that the goods are likely to be brought into free circulation in the EU.

How does the Study deal with these points?

The Study recognises that the co-existence of the Community and national systems is a fundamental tenet of the present system, that it is beneficial to users and should be maintained and strengthened. The proper functioning of this co-existence model requires, however, the correct balance between the parallel systems. In this balance, respective fee levels play a role, as do substantive issues such as the territorial requirements for proving genuine use.

In relation to fees, the Study concludes that existing CTM application fees appear appropriate and could, if anything, even be increased. With an eye on reducing congestion in the registers, it also recommends that both CTM and national applications be subject to the payment of additional class fees beyond the first class in contrast, for example, to the existing basic application fee for CTMs, which covers up to three classes.

The Study also recommends that renewal fees should be set at twice the

level of application fees. Controversially, it recommends that seniority claims should be subject to official fees, taking into account the work of OHIM and national offices and the potential loss of fee income to the national offices. One of the key aims of seniority is to save on national renewal fees, so this recommendation has the potential to put the whole seniority project in jeopardy.

When it comes to disputes in relation to pharmaceutical trade marks, the Study recognises that particular principles come to play but that it would not be possible to write a special rule for such goods. It does, however, call for OHIM and the European Courts to re-orient their practice in such cases, in particular in the finding that end users are particularly attentive for pharmaceutical goods. According to the Study, this leads to unfortunate consequences, including co-existence of similar trade marks which ultimately results in a very high rejection rate by the European Medicines Agency (EMA). OHIM and the EMA are, further, encouraged to establish working relations to align their respective practices.

In relation to the issue of use, the Study proposes to maintain the current five year grace period, rather than reduce it to three years as had been called for in some quarters. It rejected, however, the introduction of 'intent to use' or declarations of use. It also proposes to reject any approach that would require use of CTMs in more than one Member State, but prefers this principle to be developed by case law rather than legislative change.

To avoid abuse of overly broad monopoly rights, the Study makes an interesting proposal regarding permitting the registration and use of subsequent national trade marks in a Member State 'remote' from the part of the Community in which a conflicting earlier CTM – which had been registered for a period of at least 15 years – has been used, allowing co-existence in such cases in circumstances to be narrowly defined.

In relation to classification and class headings, the Study rejects the assumption that all class headings automatically cover all goods or services within the class, and calls for OHIM and the Member States to discuss and adopt a common approach in this regard.

There is also a call for the creation of digital platforms operated jointly by OHIM and the national offices. An example of one such current cooperation is OHIM's ongoing TMView project, which aims to integrate national

trade mark databases within a single, user-friendly, platform.

A number of recommendations to improve (but not necessarily complete) the harmonisation between Member States' laws and practices are also made. These include the introduction of mandatory office opposition or invalidity proceedings (without, unfortunately, explicitly referring to the need also for office-based non-use revocation actions). Another recommendation is to make the defence of non-use mandatory in opposition and infringement proceedings, as well as to allow for a defence of intervening rights, that is rights arising during a time when an earlier mark was vulnerable to revocation for non-use. The Study also proposes that Member States be obliged to provide extended protection against dilution and unfair advantage for national trade marks, whether registered or not, that benefit from a reputation.

Finally, in relation to counterfeit goods 'in transit', the Study recommends that these be capable of being seized where the trade mark at issue is infringed in the territory of transit as well as in the country of destination. Precise detail as to how this would work in practice is not provided.

Evolution, not revolution

The findings of the Study – only a small number of which are summarised above – will likely weigh heavily but will not be binding in the impact assessment and proposed legislative and non-legislative changes due from the European Commission later this year.

Judging by the Study's findings, however, it is very likely that any changes to the existing systems will be evolutionary, rather than revolutionary.

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Changes in a new decade

Sara Ashby and John Colbourn, Redd Solicitors LLP

The conference officially began on Monday 21 March, but the excellent dinner on Sunday evening deserves mention. It was well attended by early arrivals and shameless socialites. In the Brighton Pavilion we were treated to some insight into the lavish past of the Prince Regent (later King George IV) and his extravagant taste for all things Chinese, Indian and otherwise exotic compared to good old Blighty. After a thoroughly interesting guided tour, dinner

Day 1

The conference proper started at 1pm on a gloriously sunny day in Brighton. The conference was held in the Brighton Grand hotel, which had majestic views of the mill-pond calm sea and golden pebble beach. The delegates were pleased to note that the coffee rooms had doors to the front steps of the hotel and most of the meeting and greeting during the daytime was done in the sunny spring air outside.



Henry Carr QC



Robert Macdonald



Christian Archambeau



David Stone

was taken in the banqueting room (where else?) of the former Royal Palace.

The welcoming speech was from Honorary President, **Derek Rossitter**, appropriately recalling the time when he lived in Brighton as a schoolboy before the war, and how this experience inspired him to seek promotion of collaboration rather than conflict, which led ultimately to his forming PTMG. A sound message for the world at any time, and of course a good footing for this international conference.

mark protection, the final of which Henry believes is the basis of trade marks according to the Court of Justice.

The first philosophy was 'consumer protection', or avoidance of confusion. The argument is that the (essential) function of a trade mark is to guarantee origin. Where there is confusion, the rights in the trade mark are infringed. Where there is no confusion, the consumer's decision is not impaired in any way: there is no harm caused to the owner of the trade mark. But, this does not fit with many infringements.

The first speaker was **Henry Carr QC** from 11 South Square chambers, in London, who gave the Alan Cox Memorial Lecture. The title of Henry's talk was '*The philosophical basis of Trade Marks*'. Henry suggested that we may be able to better understand the thinking of the European Court of Justice and at least some of the judgments which it gives on the subject if we consider the underlying philosophy of trade marks. Henry began by explaining that the rationale for other intellectual property rights is based on encouragement of creativity and innovation, by reward, but that this approach does not fit well with trade marks. Henry outlined three philosophies of trade

The second philosophy was a moral argument: analogous with a concept that traders should not 'reap where they have not sown'. This has resonance with some Court of Justice decisions, such as *L'Oreal v. Bellure* (which will be referred to in more detail below).

The third philosophy is that of 'protection of an acquired asset from impairment'. This theory fits because it does not require confusion. This also reflects the other 'functions' of a trade mark which the Court of Justice has espoused: the 'communication' function is to protect the message conveyed by a trade mark in advertising; and the 'investment' function is to protect the money invested in the mark. Henry's submission is this philosophy is balanced by the Court of Justice with other legitimate rights and interests, including freedom of speech, (fair) competition and avoidance of perpetual monopolies in functional shapes.

Robert Macdonald, partner at Gowlings, Ottawa, followed Henry. Robert gave an international case round-up and acknowledged that for him the EU is 'international' even if it was 'home turf' for this conference. Robert broke down his talk into themes and referred to no less than sixteen cases in all. Ranging from distinctiveness, confusion, genericness and descriptiveness, the examples were varied and pertinent.

Turning to use of marks in comparisons, Robert referred to *L'Oreal v Bellure*, and the judgment of Lord Justice Jacob in particular. The judgment had highlighted dangers of the Court of Justice's decision, which may prevent pharmaceutical generics referring to well known trade marks to identify their equivalent products. Henry Carr QC commented that he thought this was Jacob LJ highlighting a potential 'mad consequence', and doubted that a judge would find infringement in such a situation: the key with *Bellure* is that the defendants' activities were deeply parasitic, rather than informative. This question leads interestingly to Oscar Benito's talk, reported below.

Tea was then taken in the glorious sunshine, and the delegates retired to their rooms while the conference facility was transformed into a ballroom for the cocktail reception and gala dinner. At the dinner, music was provided by a string quartet, accompanying a very British and marvellously tasty menu of roast beef.

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Delegates then led themselves to the hotel bar until the earlier hours, before getting up to more glorious sunshine and the next day of talks.

Day 2

Opening the second day was **Christian Archambeau**, the recently installed Vice-President of OHIM, giving the conference a vision for the future of the Office. Christian began by thanking PTMG for the invitation to OHIM to speak. OHIM recognises the pharmaceutical sector as a vibrant and important industry, essential for the wellbeing and healthcare of society – and, of course, one of OHIM's most valued customer bases! The invitation to speak came at an appropriate time for OHIM, with the Max Planck Institute report hot off the press. Before any changes are put into effect there will be consultations on any proposals from the EU. OHIM realises, however, that in order to change for the better, it needs to listen to its stakeholders: national IP offices, international associations, the EU bodies and of course the customers. OHIM's forward planning is based on clear principles: change will be an evolutionary approach, not a revolution.

With this principle in mind, OHIM's aims for the future are: (1) to drive towards excellence; (2) to optimise its operation; (3) to work on common platforms of processes; and (4) to work with national offices to seek harmonisation. OHIM sees its future role not only as an administrative IP office, but as a knowledge base for IP in the EU. This will provide opportunities to build relationships with international offices and for stakeholders to work with a more efficient and improved system and to benefit from it as well. Christian's talk was very encouraging, positive and full of vision for the future of OHIM and we look forward to seeing what proposals are forthcoming from the EU for the first stages of this evolutionary process.

Following on from Christian appropriately was **David Stone**, a partner at Simmons & Simmons in London, with a talk on Community design law for the pharmaceutical practitioner. David explained that his talk would explain why Community registered designs ('CRDs') are an important part of a pharmaceutical practitioner's IP assets.

David took us through the requirements for validity: that the design must be new, and have individual character. Other aspects of design protection include that, contrary to trade marks (as referred to by Henry Carr, above), a CRD which has a technical function can be protected. David explained how there is an uncomfortable juxtaposition between these rights: where a trade mark is registered for certain goods or services,

but a CRD is registered absolutely – and therefore could be used to prevent use in any context. David summarised that CRDs are an important arrow in the quiver of protection for pharmaceutical products and packaging.

After coffee, the delegates were given an informative insider account and update on the status of comparative advertising using pharmaceutical trade marks from **Oscar Benito**, legal counsel for GlaxoSmithKline. Oscar began by showing us some examples of comparative or reference uses made to pharmaceutical trade marks. These included references in lists on websites and in marketing material and in general sale advertisements online. Oscar then outlined the comparative advertising case in the French courts after Laboratoires G GAM advertised their products as 'Generique de DEROXAT' (generic of DEROXAT).

Oscar explained the history of the case: the claim was issued in June 2003, based on trade mark infringement and unfair competition laws, and the case is now pending before the Supreme Court in France for the second time! The

comparative advertising questions will turn on the court's interpretation of the *L'Oreal v Bellure* case referred to above. Oscar explained that a decision is expected in May/June 2011 and that the French Supreme Court may provide interesting guidance following the English Court of Appeal's warnings of the effect of that case. As Oscar explained, a generic drug is, by definition, a replica of the original product. It is still possible that a referral will be made to the Court of Justice, to seek clarification on the application of that case to a trade which is built on replica or bio equivalent products.

In the slot before lunch was a talk by **Eoin O'Shea** from Lawrence Graham in London, on risk management and anti-corruption, in the face of the new Bribery Act in force in the United Kingdom. Eoin began with a word of comfort – that much of what has been written in the press about the Bribery Act is not accurate: the new law does not prohibit normal corporate hospitality. Eoin explained that the effort against bribery and corruption is international – and the Bribery Act is an amendment to UK laws to follow an OECD convention. The Act has jurisdiction not only over UK nationals and residents of the UK but also

to all businesses registered in the UK (irrespective of whether they trade here) and also to businesses which carry out any business or part of it in the UK; and the Act applies not only to acts committed within the UK. This creates a risk for many international businesses. The pharmaceutical industry, by the nature of its many interactions with regulatory and other official bodies, both nationally and internationally, and through use of local agents, and other bodies such as joint ventures or local subsidiaries, is a high risk industry.

Eoin explained that the manner of dealing with potential risks cannot be generic: responses should be thorough and based on the particular facts. Eoin reminded us that the key is whether there is an



Bill Hansen



Christie Bertoline

intention to induce something improper: to cause someone to do something that they would not or should not be doing, or to do it faster than it would otherwise be done.

After another excellent lunch, featuring more quality local fare, we returned for the final instalment of talks, beginning with two talks on updates on FDA practice in the USA, first from Bill Hansen, and then from Christie Bertoline.

Bill Hansen, a member of the Executive Committee of Lathrop & Gage in that firms' New York office, gave a talk on 'The FDA Affect' on trade mark law in the US. Bill explained the evolution of the FDA, which began with concerns to prevent the expansion of 'patent medicine' in the 19th century, often with questionable quality and efficacy – commonly referred to as 'quack remedies'. Through a series of acts and regulations, begun in 1906, the FDA was born. The laws required proof of efficacy as well as safety before marketing but, of most interest to this talk, there is also a requirement that labelling must not be 'false or misleading in any particular'. The FDA has taken this to determine suitability of trade marks applied to

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pharmaceuticals but the main difficulty for trade mark practitioners is that the FDA applies a different standard. The FDA has also promised to issue guidance, which was due in 2010, but now intended for 2011. Bill's view is that it will be a matter for Congress to intervene if there is to be a change to or clarification of this practice.

Next up was **Christie Bertoline**, Global Head, Name Creation & Regulatory Strategy, from Novartis. Christie talked



Bob Boad



Sue Evans

about brand name creation in light of recent changes at the FDA. Christie explained that her role involves trying to

get clearance from the FDA for the names of proposed pharmaceuticals, through the difficulties Bill previously described. Christie explained the differences with the FDA system, e.g. that while two names can be filed, only one will be looked at at a time, compared to EMEA, where up to four can be submitted and will be assessed together.

The FDA has been conducting a pilot, like a consultation, which has been voluntary. Christie explained this has been a good opportunity for dialogue but it is more expensive and is not a validated process so business has been reluctant to take part.

The key 'takeaways' from the talk were that, at least predictable uncertainty is better than unpredictable uncertainty! It may help to 'show your working' in your submission for a name review, as it is

likely to be your only shot: appeals have a very low probability of success. Be ready with a back-up naming strategy, as well as back up names themselves. Just because submitting a name review in a particular manner may have worked before does not mean it will be successful again! Finally, Christie particularly welcomed the increasing dialogue and sharing of information from the

FDA, including (eventually) copies of the software system used to review a name proposal, which will assist businesses to make more efficient approaches to the FDA and ultimately in more certainty for all.

The final speaking slot was taken by **Bob Boad**, from Joshi & Welch, and representing the Authentics Foundation. Bob's talk had three sections: first, a summary of recent trends in counterfeiting; secondly, a resume of

work of The Authentics Foundation; and thirdly, some examples of good work of others to combat counterfeiting.

Some alarming recent trends in counterfeiting include: the ever-increasing presence of fake goods made available online; the use of 'small packages' for sending consignments of counterfeits, whether from outside the EU to inside, or within the EU (smaller packages in the postal systems are harder to detect than containers of goods being emptied at a shipping yard); a concerning increase in 'purse parties' (which are like Tupperware parties, but for selling fake designer hand-bags and other counterfeit branded goods); also, the increase in online counterfeiting has led to an increase of 'clone' websites, which replicate genuine sites of brand owners. One organisation trying to raise awareness is The Authentics Foundation. This is a global not-for-profit organisation backed by many major brand owners. Examples of others' work included Pfizer, who have used advertising to highlight the dangers of counterfeit medicines, including an advert where a man pulls a dead rat from inside his mouth, and a roadshow with a mock-up of a counterfeit workshop in action, featuring a cement mixer used in the process of manufacturing fake pharmaceuticals.

Sue Evans then drew the conference to a close and noted that the conference always starts and finishes so quickly!

Sue also announced, to much anticipation, that the next Spring conference would be held in... Brussels. In the meantime, we all look forward to the 83rd Conference meeting in Prague in the Autumn from 12 to 15 October 2011.

Significant Court of Justice decision on Polish marketing authorisations

Karolina Marciniszyn, Trade Mark Attorney, Kochanski, Poland

On 22 December 2010, the Court of Justice of the European Union issued a judgment in Case No. C-385/08 which is interesting for both generic and innovative pharmaceutical companies operating on the Polish market. The judgment allowed the complaint brought by the European Commission against the Republic of Poland in connection with maintaining in force marketing authorisations of generic medicinal products.

The case dates back to when Poland had negotiated terms of accession to the European Union, in particular provisions of the Treaty of Accession. The Treaty

granted Polish producers, under certain conditions, a transitional period to adapt to the rules of marketing authorisation of medicines applicable in the EU. Producers could use the transitional period if their products had been entered into the so-called register attached as Annex A to the Treaty and had been granted marketing authorisation before Poland's accession to the European Union on 1 May 2004.

Between January and May 2004, there was a significant increase in the number of medicinal products with marketing authorisation entered in the official register of drugs. During this period, the

Polish Minister of Health passed a number of decisions on the marketing authorisation of medicinal products, so long as the applicant had met specific recommendations or had conducted relevant tests. In other words, the decisions of the Minister of Health authorised medicinal products for marketing beyond 1 May 2004 provided that the applicant gathered any missing documentation, conducted additional clinic tests and filed an application within a fixed time limit. Therefore, the decisions of the Minister of Health on marketing authorisation of certain

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medicinal products were conditional. Nevertheless, it is noteworthy that at the time of the decision, the Minister of Health acted on the basis of national legislation, which allowed additional time for an applicant to update their documentation.

Referring to this procedure for granting marketing authorisation, the Court of Justice of the European Union (CJEU) described it as 'a contested administrative practice'. The Court rejected the arguments of Polish representatives that Poland was not obliged to apply Community law before the EU accession, and therefore the marketing authorisations should be verified on the basis of the Polish law. The Court noted that the breach of Community law

consisted in maintaining authorisations in force after 1 May 2004, when Community law was already binding upon Poland.

Simultaneously, the Court explained that a medicinal product granted marketing authorisation within the meaning of the Community law may be marketed and sold immediately, without having to fulfill any additional recommendations or conditions. The Court noted that the marketing authorisation may only confer an unconditional right to market the product.

Therefore, in the Court's opinion, by introducing and maintaining medicinal products that were not granted marketing authorisation in accordance with Article 6 Paragraph 1 of Directive 2001/83 on the

market after 1 May 2004, Poland had failed to comply with its obligations and had breached the aforementioned Directive.

The present judgment is interesting as it may initiate a battle aimed at recovering damages arising from the inappropriate marketing authorisation of certain drugs, both by innovative and generic companies. Nevertheless, given the complicated legal proceedings in such cases, the Polish State Treasury which would be the addressee of damages does not appear to need to worry for the time being. However, pharmaceutical companies would do well to monitor the legal and business consequences and outcomes of the Court's decision.

BOTOX judgment induces wrinkles

Cases T-345/08 and T-357/08 Helena Rubinstein SNC v OHIM (16 December 2010)

Chris McLeod, Squire Sanders Hammonds, London

The General Court has upheld OHIM's Board of Appeal decisions in favour of Allergan, Inc.'s two applications for declarations of invalidity of Helena Rubinstein SNC's CTM registration of BOTOLIST and L'Oreal SA's CTM registration of BOTOCYL covering goods in Class 3. The applications were based on earlier Community and national figurative and word registrations for BOTOX covering goods in class 5.

BOTOX v BOTOLIST

In May 2002 Helena Rubinstein SNC (HR), filed a CTM application for BOTOLIST for 'perfumes, eau de toilette; bath and shower gels and salts not for medical purposes; toilet soaps; deodorants for personal use; cosmetics among other creams, milks, lotions, gels and powders for face, body and hands, sun-tanning and after-sun milks, gels and oils (cosmetics); make-up preparations; shampoos; gels, mousses and balms, preparations in aerosol form for hairdressing and haircare; hair lacquers, hair dyes and preparations for bleaching hair; permanent waving and curling preparations; essential oils' in class 3. The application was registered in November 2003.

In February 2005, Allergan, Inc. (Allergan), filed an application for a declaration of invalidity in respect of all goods covered by the HR CTM. The application was based on the aforementioned BOTOX marks, registered for 'pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles, hyperhidrosis, sports injuries, cerebral palsy, spasms, tremors and pain' in class 5.

The application for a declaration of invalidity was rejected. Allergan appealed and the Board of Appeal allowed the appeal: it held that although there was no likelihood of confusion between the marks BOTOLIST and BOTOX, the application for a declaration of invalidity on the basis of Article 8(5) was well founded because the BOTOX marks had a reputation.

BOTOX v BOTOCYL

In July 2002, L'Oreal SA filed a CTM application for BOTOCYL covering 'perfumes, eaux de toilette; bath and shower gels and salts not for medical purposes; toilet soaps; deodorants for personal use; cosmetics, in particular creams, milks, lotions, gels and powders for the face, body and hands; sun-tanning milks, gels and oils and after-sun preparations (cosmetics); make-up preparations; shampoos; gels, mousses and balms, preparations in aerosol form for hairdressing and haircare; hair lacquers; hair-colouring and hair-decolourising preparations; permanent waving and curling preparations; essential oils' in class 3. The application was registered in October 2003.

In February 2005, Allergan filed an application for a declaration of invalidity of the BOTOCYL registration. The action was based on the same grounds and BOTOX registrations as those covered in the proceedings against the BOTOLIST registration. The Cancellation Division rejected the application for a declaration of invalidity. Allergan appealed and the appeal was allowed for the same reason as the other appeal. HR and L'Oreal both appealed and the cases were joined.

Action at the General Court

HR and L'Oreal (HRL) appealed to the General Court requesting that both Allergan appeals be dismissed.

Infringement of Article 8(5)

HRL argued that there was no evidence that the mark BOTOX had a reputation at the time of filing of the disputed applications. It was extremely unlikely that a reputation had been built up, as it was only a matter of months between the registration of the CTM application for the figurative BOTOX mark on which the cancellation division had based its decision and the filing of the BOTOLIST and BOTOCYL applications.

HRL also claimed that some of the evidence filed was outside the relevant period, that translations had not been provided and that Allergan's prior UK invalidity proceedings against the word mark BOTOMASK did not strengthen the case. OHIM argued that the evidence confirmed that Allergan had a huge reputation, at least in the UK, at the application date of both CTM registrations.

The similarity of the marks at issue

HRL argued the marks were not sufficiently similar to create the link necessary to establish infringement of Article 8(5). HRL believed that the marks differed, the only similarity being the syllable 'bot' or 'boto', which referred to the active ingredient in the pharmaceutical product, botulinum toxin. They stated that the common element of the earlier mark did not have any distinctive character and was descriptive.

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OHIM argued that the strength of the earlier marks, their distinctive character acquired through use and the similarity of the goods offset the lower degree of similarity between the marks.

The effect of the use without due cause of the disputed marks

HRL argued that the likelihood of detriment had not been proved and that there was no evidence that either of them had acted without due cause.

OHIM submitted that use of the marks BOTOLIST and BOTOCYL would take unfair advantage of the earlier marks' repute because the public would establish a link between the marks and the goods they covered. OHIM claimed that the 'link' between the marks was sufficiently close such that the earlier marks' repute could be misused in the field of cosmetics.

OHIM added that, as BOTOX was known to a large section of the UK public, the association with the earlier marks would suggest that the applicants' products had an effect comparable to that achieved with BOTOX, and that the risk of dilution would be heightened if the CTMs remained registered for cosmetics. Consumers could presume that the anti-ageing effects similar to those obtained with injections of BOTOX could be achieved without medical supervision and in ways that were possibly less expensive, less hazardous and less painful, by applying cosmetics sold under the BOTOLIST and BOTOCYL marks.

Additionally, the Board of Appeal had found in the contested decisions that there was a lack of due cause within the meaning of Article 8(5) and no evidence was submitted by HRL to establish the contrary, thus weakening their case.

Findings of the Court

The Court made the following preliminary observations:

It recognised that the applications for declarations of invalidity were based on a number of national and Community figurative and word marks for BOTOX which constituted 'earlier marks'. However, the Cancellation Division had based its decisions on prior figurative and word mark CTM registrations of the mark BOTOX, whereas the Board of Appeal had found that a reputation had been acquired in respect of the BOTOX figurative and word mark registrations which were registered before 6 May 2002, whether they were Community or national trade marks. With that in mind the Court examined the case based on the earlier national marks registered in the United Kingdom for the treatment of wrinkles, because most of the evidence submitted related to the UK.

The reputation of the earlier marks

The Court found that Allergan had established its reputation through extensive sales, survey evidence, witness statements and articles published in scientific journals and the national press. Some articles submitted as evidence were dated after the application dates of the CTMs but the Court accepted them, stating that the evidential value of a document varies, depending on whether the time period covered is close to or far from the relevant date.

Interestingly, the Court took the view that articles which were not translated into French, the language of the proceedings, still constituted a relevant factor in establishing the reputation of the products marketed under the trade mark BOTOX with the general public, irrespective of the positive or negative content of those articles. The Court's view was that translation may prove useful where there is doubt regarding the content of the article, but that it could not be a condition of admissibility of a document provided as evidence.

In addition, the Court did not accept HRL's arguments that market survey evidence and witness statements should be disregarded because they did not concern the relevant period. The Court deemed them relevant and admissible and held that they could be viewed with discretion.

The similarity of the marks at issue

The Court found that there was no likelihood of confusion between the marks. As such, it had to be established whether there was sufficient similarity between the marks that the relevant public would make a link. The Court wholly disagreed with HRL's argument that the first syllable 'bot', was descriptive and a clear reference to the active ingredient of the pharmaceutical preparation botulinum toxin. The Court found that the syllable 'bot' had no meaning and therefore could not be descriptive.

The Court added that even if BOTOX referred to the active ingredient, it would then be necessary to break it down, first, into 'bo' for 'botulinum' and, secondly, into 'tox' for 'toxin'. Even if it was broken down, it would then have to be shown to have distinctive character in the UK, at least. No evidence to this effect had been provided.

The Court then looked at the market share of BOTOX in the UK, its overall reputation and the degree of similarity between the goods and found that the public would establish a link between the marks.

The effects of use of the disputed marks

The Court first pointed out that HRL did not establish that they had due cause to use the marks. It referred to the Board of Appeal's view that the only reason given by HRL for using the prefix 'boto' was that it alluded to 'botulinum'. This argument failed, as botulinum began with 'botu'. In addition, HRL had not provided any valid reasons for registering marks with identical prefixes to a trade mark with an extensive reputation. In fact, the registered marks reproduced almost all of the trade mark. The only element which was not part of the later marks was the last letter, 'X'.

The Court noted at the hearing that HRL had admitted that, even though their products did not contain botulinum toxin, they intended to take advantage of the image which was associated with that product, which was found in the unique trade mark BOTOX.

As a result, the first plea was rejected in its entirety.

Infringement of Article 73 of Regulation No. 40/94

The Board of Appeal's decision had stated that the earlier mark BOTOX had a reputation and, that the use of the disputed marks took unfair advantage of and was detrimental to, the distinctive character and repute of the earlier marks. HRL argued that the facts or legal arguments which resulted in this decision were unclear.

As such, HRL claimed that they were not in a position to defend themselves and the Court was not in a position to judge whether the conclusions reached by the Board of Appeal were indeed supported by findings of fact. OHIM believed that sufficient information had been provided.

Findings of the Court

The Court found that, although the Board of Appeal's decisions were concise, they contained the necessary facts and legal analysis. As such, the second plea was rejected and both actions were dismissed.

Conclusion

This decision reveals that the Court can use its discretion regarding evidence which is not translated into the language of proceedings and evidence which does not fall into the relevant time period. In addition, it shows the clear advantages of owning a mark with an extensive reputation and having evidence to hand which confirms the existence of such a reputation.

PROFILE: Pascale Lambert

Pascale Lambert is Founder and Managing Director of Cabinet Pascale Lambert & Associés, a IP law firm with offices in Paris, Le Mans and Perpignan. An IP attorney specialized in trade marks, designs and copyrights, she has a degree in IP law and in international commercial law. She founded the firm in 1985 after three years at la Spadem a company dedicated to the defence and exploiting of copyright. She served as APRAM President from 1998 to 2000 and Vice President of CNCPI (the French Institute of Patent and Trade mark Attorneys) from 1999 to 2001.

She is still very active in the APRAM board as head of the admissions committee. She is a member of PTMG, INTA, AIPPI, ASIPI.



Where were you brought up and educated?

Paris, France.

How did you become involved in trade marks?

When I was young I wanted to be a lawyer to defend 'the widow and the orphan'; however my mother said I should add another area in case the widow and the orphan didn't enable me to pay the rent. So I chose Intellectual Property to defend the 'poor authors'. During my first job I worked on trade marks and loved it.

What would you have done if you hadn't become involved in Intellectual Property?

I would have gone into writing and the theatre.

Which three words would you use to describe yourself?

Clever, funny, beautiful... more seriously: lively, positive and with a good sense of humour (critical thinking).

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

To be honest, I would say none. Until I went to law school, I was a very unruly pupil. My father had to visit the headmaster on a regular basis to keep me from getting expelled for indiscipline.

What was your worst experience in the world of work?

Two months after I started my first job, I was given a trade mark infringement case

involving two identical trade marks. I thoroughly prepared my case but instead of sending my conclusions to my client I addressed everything to the other party. I didn't know what to do... Luckily my boss had a good sense of humour and at the hearing he turned my mistake into a joke by saying: 'The two trade marks are so similar that even my junior lawyer got mixed up!' From this experience, I learned two very valuable lessons: (1) that anyone can make mistakes and (2) that all situations can be turned to one's advantage.

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

I will pamper myself by going to a spa.

What is the best thing about your job?

The opportunity to meet a lot of different people and the diversity of work and situations

What is your biggest regret?

Not being Penelope Cruz... but only because I'm blonde and she's brunette.

What is your favourite work of art?

Guernica, by Pablo Picasso.

What do you wish more people would take notice of?

That life is short.

What is the most surprising thing that ever happened to you?

My children.

What is your weakness?

Not being able to say 'no'.

Which book or books are you currently reading?

The Hitchhiker's Guide to the Galaxy, by Douglas Adams.

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

My friend's amazing rock band KING KURT.

What is your all-time favourite film?

Annie Hall, by Woody Allen.

Which word or sentence do you most often say?

Are you sure?... followed by 'the client is king'.

What piece of advice would you give a visitor to the area in which you live?

First visit the English-language web magazine www.francerevisited.com because it gives great insights and information about Paris and France.

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

Being French I should probably say the Eiffel Tower, especially at night because it's magical when lit. But I think the Taj Mahal might beat it.