

# Law Lore & Practice

PTMG



Pharmaceutical  
Trade Marks Group

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## Editorial: Things can only get better...

At the time of writing, the old continent appears to be descending into chaos. France has just survived its fourth Saturday of social unrest and struggles to come to terms with the impact of closing down all tourist attractions and major shopping arteries in the capital, thus reversing the positive economic trend that had slowly begun after the terrorist attacks of 2015. Britain awaits

with baited breath the parliamentary vote on Tuesday, with little or no idea what the political landscape will look like on Wednesday. Falling off the cliff-edge is starting to feel like a viable alternative to the stock piling of medicines, vaccines and essential foodstuffs which the port authorities are now advocating.

In Greek mythology, Chaos or Khaos is the primeval state of existence from which the first gods appeared. In other words, the dark void of space. It is made from a mixture of what the Ancient Greeks considered the four elements: earth, air, water and fire. Eris was the Greek goddess of chaos, strife and discord; her

Roman name was Discordia. My teenage son uses an on-line chat service for gamers known as Discord to communicate with his peer group, thereby underscoring my current feeling that the world is slowly descending into an uncontrolled state! Or as Eddie Izzard, the UK stand up comedian once said in an Australian accent 'Armeggedon, short for Ahm a geddin' out of here'.

One wishes one could actually 'get out of here', if only for a short while but the omnipresent global media of all forms renders such aspirations mere pipe dreams. Short of living in a vacuum, itself a dark void of space, one must navigate a personal path through the chaos to maintain sanity. Thankfully, PTMG continues to offer stability for the year ahead – our Spring and Autumn conferences will take place in Rome and Berlin whatever and your Committee will work hard to ensure the continuing high standards of speakers and content that has earned our conferences' their well deserved reputation. It remains for me, on behalf of the Committee, to wish you all a happy holiday season and a healthy 2019.

Vanessa

## US Update

by Jonathan S. Jennings Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP

A federal court decision in New Jersey underscores some of the difficulties and frustrations brand owners face in combating unauthorized internet pharmaceutical sales. In a suit brought by Celgene Corporation against Distinct Pharma of Mumbai, India, (Celgene Corp. v Distinct Pharma, 2018 WL4251848 (D.N.J. 6 September, 2018)), the court refused to enter a default judgment in Celgene's favour, because it was not clear if Distinct had been properly served with the complaint and summons in accordance with US constitutional due process requirements. The dispute involved the allegedly unauthorized use of Celgene's REVLIMID trade mark in connection with unapproved internet sales to US customers of lenalidomide, the active ingredient of Celgene's REVLIMID cancer treatment drug. To protect its REVLIMID mark and to address potential health and safety issues, Celgene sued Distinct for trade mark infringement, unfair competition, and false designation of origin under the Lanham Act, as well as for a

violation of a relevant New Jersey statute.

The Hague Convention governed service of the complaint and summons in this case, as Celgene knew of Distinct's address and India and the US were both contracting parties to the Convention. Celgene had properly sent the complaint to the Indian Central Authority (the office charged with making service), but had heard nothing from the Central Authority for over a year despite sending two written follow-up requests in the interim. The court examined the Hague Convention provisions that allow for a grant of default judgment even where there was no proof of actual service. (Article 15).

Despite finding that Celgene had met these Hague Convention requirements, the court determined that Celgene had failed to establish that the efforts at service in India also had met US constitutional due process dictates. That is, the court ruled that meeting Hague Convention requirements was not enough

for Celgene to establish proper service of process necessary for the entry of a default judgment. The court noted that this 'is a frustrating situation, to be sure' for Celgene, and did not explain what Celgene could do to meet the constitutional test in the wake of over a year of silence from the Indian Central Authority.

As luck would have it, after the court decision, Celgene finally received a reply and proof of service from the Indian Central Authority. With this evidence in hand, and no word from Distinct, last month it renewed its motion for default judgment, which is now pending before the court.

Despite Celgene's eventual receipt of proof of service, this case demonstrates that pharma companies suing foreign-based companies in the US must be prepared in some cases for significant delays – and the problem is not limited to India. See *Subotich v Travelers*

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To Brexit or not to Brexit, that is the question: Currently, the EU and the British Government desperately try to reach a contractual deal on the conditions of the Brexit. It seems that Brexiteers have by far underestimated the complexity of this exercise. Last week we heard that there is a deal, but now it seems rather unlikely that the current British Government will get the necessary support for the deal in the House of Commons. The risks of a hard Brexit without a deal are tremendous and frightening. On the European continent we are watching the latest developments in London in a state of agony and despair. This has been going on for far too long. Christmas is approaching and I have a very personal wish (that most likely will not be fulfilled): Let's call the whole thing off!

Another year has passed. Time to look back and forth: In Spring we went to beautiful Porto for our Spring conference. What a beautiful city! And in October we enjoyed sunny Dubrovnik at our Autumn conference. I am really looking forward to 2019 which will take us to Rome and Berlin.

I wish all PTMG members, your families and friends a Merry Christmas and a Happy New Year!

**Frank Meixner**

# Members News

## New Members

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

**Dominic Murphy** from HGF, Birmingham, UK [dmurphy@hgf.com](mailto:dmurphy@hgf.com)

**Kristof Neefs** from Inteo, Mechelen, Belgium [kristofneefs@ip.be](mailto:kristofneefs@ip.be)

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## Moves and Mergers

**Thomas Tresper** has moved to Wegnerpartner, Berlin, Germany. He can be contacted at  
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**Mark Kramer** has left Stephenson Harwood and is now with Shoosmiths LLP, London, UK. Mark can be contacted at  
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**Fernando Strubing Gomes** has left RCF to join Ipan Group in Munich, Germany. Fernando can be contacted at  
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## Obituary

It is with great sadness that we report the passing of Barbara Vogt who had been Head of Trade Marks at Grünenthal for 17 years before her retirement in 2017. Barbara was very active for many years in the Trade Mark Committee of EFPIA and was a very long standing member of our Group who regularly attended our conferences. She will be greatly missed by her many friends at PTMG.

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

# US Update Continued

Property Casualty Company of America, 2017 WL 2912457 (E.D. Wis. 7 July, 2017) (one-year delay for service in China). Where countries, such as India, do not allow for alternative postal delivery service under the Hague Convention, the prospect for a delay is particularly acute. See generally, Theodore J. Folkman, 'International Judicial Assistance For Massachusetts Lawyers' MCLE (2012). The requirement to also conform with constitutional due process in the US adds another layer of difficulty for litigants, who may face constitutional challenges to the adequacy of service even after it does occur. Grupo Famsa v Eighth Jud. Dist. Ct., 371 P.3d 1048 (Nev. 2016) (Nevada Supreme Court reversed a lower-court decision and ordered an evidentiary hearing to determine whether service of process on a lower-level employee of a company based in Mexico complied with US constitutional due process obligations, even though service had met Hague Convention requirements).

As internet-based companies from outside the US continue to infringe the trademark rights of pharma companies, brand owners must factor in potentially significant delays in simply serving the complaint and summons before considering what relief might be attainable. Where the Hague Convention does not apply, there may be speedier options for service (such as by e-mail), but there will still be a requirement that a plaintiff establish that service meets constitutional due process.

**PTMG is preparing an anniversary book for its upcoming 100th conference.**

**Do you have any photographs taken at previous PTMG conferences?**

**If so, please contact the Editor.**

# International Update

## EUROPEAN UNION

**Suzanne Power, AA Thornton & Co.**

A recent decision from the EUIPO's Board of Appeal (the Board) confirms that preparations used for medical and pharmaceutical purposes can still be found to be similar to one another, where one is available over the counter and the other can only be obtained by prescription.

The Board's decision of 26 November 2018 stemmed from a successful opposition by Takeda Pharmaceutical (Takeda) to an EU trade mark application for KENZEN of Nikken International (Nikken). Takeda had opposed the mark's registration for goods in class 5, which included nutritional supplements and weight management powders, on the basis of a likelihood of confusion with its identical earlier mark KENZEN, registered in respect of cardiovascular agents in class 5.

Nikken appealed the opposition decision, on the primary basis that the earlier registered goods targeted a different public from the goods of its application. In this regard Nikken argued inter alia that Takeda's goods are aimed at 'patients', and the consumers of its goods would not be considered as such; rather, they are simply 'consumers wishing to improve and maintain their overall health and wellbeing'. Nikken also argued that the conflicting goods are sold via completely different trade methods, with the earlier goods available via prescription only, and its own goods distributed via network marketing.

The Board was unconvinced by Nikken's submissions and held that the Opposition Division was correct to find that the conflicting goods were similar, such that there existed a likelihood of confusion. According to the Board, the goods of both parties are all 'chemical or biological compositions [...] used to enhance the functioning, health and wellbeing of the human body' and so they have a similar nature and intended purpose. Moreover, the earlier and contested goods could all be available for purchase in pharmacies, even if the former required a doctor's prescription. The fact that Nikken had opted to distribute its products via network marketing for the time being was irrelevant, as it could choose to alter this strategy in the future.

The Board accordingly dismissed the appeal in its entirety, upheld the refusal of Nikken's application, and made an award of costs in favour of Takeda.

## KAZAKHSTAN

**PETOSEVIC**

The information on all pending trade mark applications in Kazakhstan recently became available on the National Institute of Intellectual property (NIIP) website, in Russian and Kazakh languages only.

On 3 July 2018, various intellectual property legislation amendments came into force in Kazakhstan aimed at simplifying the administrative procedures related to obtaining IP rights protection. Further to the recently adopted laws, in November 2018 Kazakhstan adopted new regulations defining in greater detail certain provisions related to the administrative procedures, among other things allowing the NIIP to publish pending trade mark applications online.

The applications are published online within five working days after the formal examination is completed. This will simplify the monitoring of potentially infringing applications, enabling rights holders to file observations and oppositions before such applications become registrations.

Although observations and oppositions against pending trade mark applications are not explicitly provided for in the legislation, we had positive experience with filing informal observations and oppositions with the NIIP. The NIIP pays attention to materials filed against pending applications and may use them when it issues its decisions. Informal observations must be filed before the Examiner issues a decision on the pending application, i.e., within seven months from the trade mark application filing date.

An appeal against the NIIP's decision on refusal of a trade mark application is considered by the Board of Appeal within three months from the date of the issue of the final refusal.

Apart from pending trade marks, applications for plant variety protection are now also published on the NIIP website, as well as all other registered IP rights starting from the Official Gazette No. 37 dated 8 October 2018.

## MYANMAR

**Denise Mirandah, miranda asia**

Whilst the long awaited landmark changes to IP laws in Myanmar are yet to be finalised, the Deed Registration Law 2018 has been enacted by the Union Parliament of Myanmar. The salient features under this law are enumerated herein below:

- The language of the documents filed must be in the Myanmar Language.
- Documents filed in a foreign language must be accompanied by a translation which must be notarised in Myanmar together with the requisite certification from a Myanmar Notary Public.
- The trade mark application must be accompanied by a Declaration stating that the Applicant is the creator of the trade mark and that the trade mark in question does not copy in part or in its entirety, a trade mark owned by a third party. In addition, the Declaration must also state that the Applicant is unaware of use of the said trade mark by any other entity or entities in respect of any goods or services.
- The trade mark being applied for registration must be used on the goods/services that the Applicant is currently offering to consumers.

However, it remains to be seen if this new law will be enforced exactly in the manner enacted by the Registry.

In February 2018, the Upper House of the Myanmar Parliament passed the Trade Mark Bill but the Bill is now pending before the Lower House. There appear to be indications that the Bill may be approved in 2019. Once approved, Myanmar's trade mark laws will conform to a greater degree with international standards and will offer a broader scope of protection to IP owners.

## RUSSIA

**PETOSEVIC**

Russia has recently amended its customs legislation. The new Federal Law 'On customs regulations in the Russian Federation' was adopted on 3 August 2018 and entered into force on 4 September 2018. While certain transitional provisions will not enter into force until December 2018 and February 2019, those related to the protection of intellectual property rights are already in effect.

The main novelty concerns the maximum customs watch protection period, which has been extended from two to three years. Rights holders can now choose between a one-, two- or three-year protection term when filing or renewing customs watch applications. As before, the customs watch may be renewed for an indefinite number of times.

# International Update

## SERBIA

### PETOŠEVIĆ

On 12 July 2018, the Serbian Supreme Court of Cassation issued a decision confirming that parallel imports constitute trade mark infringement, revoking the first and second instance decisions of the Commercial Court and the Commercial Appellate Court. This ruling is significant because even though parallel imports have been prohibited since amendments to the Serbian trade mark law entered into force in 2013, court decisions against parallel importers have been very rare and inconclusive.

PETOŠEVIĆ Serbia represented the rights holder, a well-known Swiss fashion label, in court proceedings against a Serbian company that was distributing apparel items bearing the plaintiff's trade marks without the plaintiff's consent. First, the request for securing evidence was filed with the Commercial Court in Belgrade, and after securing evidence, an attempt was made to settle the matter out of court. The defendant refused to comply with the plaintiff's demands and a lawsuit was filed with the Commercial Court. The court held that the evidence provided was inconclusive and ruled in favor of the defendant on 28 January 2016. The Commercial Appellate Court confirmed the first instance decision on 10 October 2017. However, the Supreme Court eventually overturned lower court decisions ruling that the evidence was sufficient to prove parallel import.

While lower courts in Serbia are not obliged to follow the opinions and decisions of higher courts, in practice they rarely rule contrary to higher courts stance. To our knowledge, this is the first time that a parallel import case reached the Supreme Court of Cassation and the ruling is significant because it will allow rights holders to invoke it in their struggle against this type of trade mark infringement.

## SINGAPORE

### Denise Mirandah and Aditi Pranav Desai, miranda asia

A geographical indication (GI) can be understood to be a sign which, when applied to products, corresponds to a particular geographical origin attributing certain essential and peculiar qualities or reputation to such products. In essence, a GI performs the function of being an indicator of certain characteristics or reputation or certifying adherence to traditional/distinctive methods of

production of such goods. On account of such geographical origins and corresponding history, products bearing a GI enjoy special reputation.

Singapore is presently augmenting the scope of protection afforded to GIs, in particular to comply with its obligations under the recently signed European Union-Singapore Free Trade Agreement (EUSFTA). Upon ratification of the EUSFTA by Singapore, The Geographical Indications Act 2014 (GI Act 2014) passed by the Parliament of Singapore on 14 April 2014, will come into force.

Applications for the registration of GIs in relation to certain categories of wines, spirits and selected categories of agricultural products and foodstuffs, which originate from and have obtained protection as a GI in countries and territories that are party to the World Trade Organisation or the Paris Convention, will be permitted to be filed by GI products' producers, associations affiliated with such producers and the relevant authorities that govern GI producers.

An important feature of the Act includes the establishment of the new Registry of Geographical Indications (GI Registry) which will regulate GI applications and registrations in Singapore.

The Act and the proposed GI Rules will administer the Registry's operational aspects with respect to GIs. They are analogous to the Trade Marks Rules in Singapore and bear structural similarity to it. In fact, a public consultation on the proposed rules has also been conducted by the Intellectual Property Office of Singapore.

Once an application for the registration of a GI has been filed, it will first be examined to ensure compliance with formalities and criteria for registration. Pursuant to the substantive examination, the application will be published for potential third party oppositions.

Key provisions of the proposed GI Rules include:

- (a) Preliminary general provisions;
- (b) Registration of a GI;
- (c) Qualification of rights;
- (d) Setting up and maintenance of a Register for GIs;
- (e) Renewal of registration of GIs;
- (f) Cancellation of GIs;
- (g) Evidence and procedure and costs; and

(h) Extension of time and continued processing.

Once registered, a GI would enjoy a 10 year protection which is renewable every 10 years upon the payment of the requisite renewal fees. The proposed Act and Rules also provide for the cancellation of GIs in line with the trade mark law and grounds of cancellation must be specified by the party requesting the cancellation.

Registered GI owners can also place reliance on additional protection afforded by enhanced border enforcement measures, pursuant to the proposed Act and Rules. Registered GI owners would then enjoy a higher degree of protection against third party infringers engaging in unauthorised exploitation of their GI rights. This will further enhance Singapore's position as a country at the forefront of protecting IP rights.

## UKRAINE

### PETOŠEVIĆ

On 1 August 2018, the Ukrainian IPO started publishing information on pending trade mark applications in its online database immediately after sending a confirmation of the trade mark application filing date to the applicant.

The information on pending applications is now published online within two months from the moment a trade mark application is filed. Until recently, the IPO did not publish the information until at least six months after the filing.

Trade mark owners are now able to monitor new applications soon after they are filed, ensuring timely enforcement of their prior rights.

## UZBEKISTAN

### PETOŠEVIĆ

Uzbekistan's president signed a decree on 22 June 2018 abolishing the requirement to examine the safety, quality and effectiveness of medicines authorized in countries with high regulatory requirements. Previously, no medicines registered abroad were eligible for marketing authorizations under the simplified procedure in Uzbekistan.

The 20 countries, determined by another presidential decree dated 24 September 2018, are the following:

Australia;  
Belgium;  
UK;  
Germany;  
Denmark;  
Israel;

## International Update continued

Ireland;  
Spain;  
Italy;  
Canada;  
South Korea;  
Netherlands;  
Norway;  
Slovenia;  
USA;  
Finland;  
France;  
Switzerland;  
Sweden; and  
Japan.

Uzbekistan will also apply the simplified procedure to medicines registered by the European Medicines Agency (EMA), an EU agency for the evaluation of medicinal products.

The simplified procedure was established by the Resolution of the Cabinet of Ministers No. 862, dated 24 October 2018. The competent authority is the State Center for Expertise and Standardization of Medicines, Medical Devices and Medical Equipment under the Ministry of Health.

The following are eligible for accelerated approval:

- medicines authorized in one of the countries with high regulatory requirements;
- new combinations of medicines already authorized in Uzbekistan; and
- medicines already authorized in Uzbekistan but produced in new forms, dosages or packages, with a different label or by other manufacturers.

Under the simplified procedure, once the applicant submits the required documents and pays the EUR €1,082 (USD \$1,237) application fee, the State Center has 15 working days to reach the decision on granting a marketing authorization and one working day to notify the applicant. Approved medicines are recorded into the State Register of Medicines, Medical Devices and Medical Equipment and are initially valid for a period of five years. After this period, the holder can apply for renewal and after the renewal, the marketing authorization will remain valid for an unlimited period.

An application may be refused if it contains incomplete or invalid information, but applicants can re-apply within 15 working days upon receipt of a notification of refusal.

The authorization can be terminated if:

- the medicinal product is banned in Uzbekistan or in the country where it was originally authorized;
- the medication causes serious side effects not specified in the instructions for use; or
- the applicant requests termination.

### UNITED KINGDOM

#### Chris McLeod & Luke Ingleton, Elkington + Fife LLP

The United Kingdom Intellectual Property Office (UK IPO) has rejected an application to register LECIPHOL in class 5 on the basis of an opposition filed by probiotic supplement manufacturer, Probiotics International Limited (PIL).

#### Background

In October 2017, Conella (Holdings) Limited (Conella), filed a UK application to register LECIPHOL in relation to food supplements, dietetic preparations, vitamins and minerals in class 5. On publication, PIL opposed the application on the basis of its registered and unregistered rights in the mark LEPICOL.

PIL argued that there was a likelihood of confusion between its registered LEPICOL marks and the LECIPHOL mark. PIL also asserted that it had a reputation in its LEPICOL marks and that it had use-based rights in the LEPICOL marks.

Conella filed a counterstatement denying all of the grounds of opposition.

#### Decision

The UK IPO's Hearing Officer (HO) first considered the registered marks. As Conella had admitted in its written submissions that the goods covered by its application were identical or similar to the class 5 goods covered by PIL's earlier LEPICOL marks, the HO turned to a comparison of the marks.

As LEPICOL and LECIPHOL start with the letters LE, end in the letters OL and as all of the letters in the earlier LEPICOL marks are present in LECIPHOL, the HO found that there was a high degree of visual similarity between the LEPICOL word mark and LECIPHOL and a medium degree of visual similarity between the LEPICOL figurative mark and LECIPHOL. The HO also held that there was a high degree of aural similarity between the respective marks but that there was no conceptual similarity. Having considered all of the relevant factors, the HO concluded

that there was a likelihood of confusion between the marks and therefore this ground of opposition succeeded.

In support of the claimed reputation of its registered marks, PIL filed evidence which established a reasonable reputation in its LEPICOL marks through use in the United Kingdom in relation to nutritional and dietary supplements. Given the visual and aural similarity, the HO held that the public would make a mental link between the respective marks. The HO also found that Conella's use of LECIPHOL would take unfair advantage of the reputation that PIL enjoyed in its LEPICOL marks. The opposition therefore succeeded on this ground.

The HO was also satisfied that the essential requirements of the law of passing off, namely goodwill in the United Kingdom, a misrepresentation leading to deception or a likelihood of deception and damage resulting from the misrepresentation, were all present. As there was a high degree of similarity between the marks and they were to be used in the same sector, the HO decided that damage to PIL's business through diversion of sales and a loss of control of its reputation were easily foreseeable. Accordingly, the opposition also succeeded on this ground.

As the opposition succeeded on all grounds, the HO found in favour of PIL and ordered Conella to pay costs of GBP £1,500.

#### Comment

Although the UK IPO's decision was not wholly surprising, it demonstrates the value of conducting a clearance search prior to filing an application. Perhaps if Conella had been aware of the earlier LEPICOL marks, it may have chosen not to file the application or adopt an alternative mark.



# PTMG 97th conference report, Dubrovnik

## Pearls of Trade Mark Wisdom from the Pearl of the Adriatic

Ozlem Fütman, Ofo Ventura, Turkey and Vanessa Parker, Editor LL&P

The Welcome Reception took place on Wednesday evening and with the mild weather, attendees came together around the pool of the hotel.

The Chairman's opening remarks the following morning extended a warm welcome to all new attendees and reminded delegates that we were approximately 400 participants from 70 countries, the majority of whom had chosen to take up the PTMG conference App this time round.

The first speaker was David Lossignol, Sandoz, INTA President Elect. While brand value is growing globally, so are brand restrictions rising, said



**David Lossignol**

David. Plain packaging is now becoming a threat for brand owners in many sectors. INTA's initiatives against it, the WTO file regarding Australian Plain Packaging Law and a survey showing that the number of smokers has increased since the law was put into force were part of David's speech. He questioned the approach 'INNs are safer than brands' with a potential impact on patients and discussed how restrictions in different jurisdictions impose upon the industry. He recommended that the pharmaceutical industry be engaged to IMSN, use ISMP data, use PhRMA, EFPIA and the Medicines for Europe platforms.



**Gordana Pavlovic**

After David, Gordana Pavlovic from Cabinet Pavlovic gave a thorough presentation covering the whole Western Balkan countries

including topics such as the international agreements each country is a member of, trade mark prosecution systems on a country by country basis, the situation of well-known marks backed with case law and use requirements. She also talked about enforcement from the Courts' and Customs' perspectives. Considering the geographical location of the Balkans, goods in transit was an important point during her speech in addition to parallel imports.

During the coffee break, attendees enjoyed the great weather on the terrace of the hotel. Most of the attendees agreed that this was one of the most beautiful places during PTMG meetings where people could share a fantastic view under the Croatian sunshine.

The Founders Lecture was delivered by Lori Mayall from Gilead. Pharmaceutical Buyers Clubs claim that they are the 'Robin Hoods' of the pharmaceutical industry, mere facilitators between



**Frank Meixner and Lori Mayall Founders Lecture Presentation**

manufacturers and purchasers. Lori expertly argued, with examples from her own company, that the very negative advertising that these Clubs use masks the damage that they themselves are creating in the supply chain by diverting the medicines from developing markets and returning them to developed markets such as the US. This pithy, well illustrated presentation concluded with a call to action for all pharmaceutical companies and their representatives to get involved in the name of patient safety.

The Chairman then made the usual presentation to Lori Mayall and all agreed that she had indeed fulfilled the remit of this now regular feature at the Autumn conference.



**John Colbourn**

Finally before lunch, John Colbourn from Wiggin LLP provided delegates with the International case round-up, which as ever is a much appreciated slot. John introduced recent case law including but not limited to the European Union, Canada, USA, Brazil and India regarding absolute grounds, goods and services, oppositions and cancellations, infringement, co-existence and exhaustion. There were some well-known cases such as Louboutin v Van Haaren and Kit Kat but John's presentation also enabled attendees to fill the gaps in their minds as to other recent cases.

After lunch, Ruth Burstall from Baker & McKenzie certainly did not allow any time for a siesta by comparing the Blockchain Revolution to



**Ruth Burstall**

teenage sex – everyone's talking about it but no-one is actually sure how it works! Ruth filled us in as to what blockchain is; how it can be applied in the pharmaceutical industry - even though the industry is staying a bit far from it for now - why blockchain can be chosen in tracking goods in the supply chain, how does it work and what problems there are, how it allows us to follow up counterfeit products - identify them and trace the origin and finally how it may help parallel import issues. She also talked about its impact on IP lawyers' lives. We learned about WIPO and EUIPO's interest in seeking how they can possibly use it. She mentioned the negatives of blockchain and the need to regulate by pointing to solutions that are being developed.



**Norbert Hebeis**

The final presentations on Thursday afternoon were a double-slot on INNs and INN stems as obstacles for pharmaceutical trade marks and both Norbert Hebeis from Friedrich Graf von Westphalen & Partner and Bruce Longbottom, PTMG committee member from Lilly certainly spoke with knowledge and passion on this often discussed topic. Norbert explained common points and differences of INNs and INN Stems with Pharma trade marks. He examined cases for absolute grounds for refusal of pharma marks based on INNs and INN stems and in a hypothetical case he focused on what would happen if we were to mix INN stems in pharma marks as stem and the negatives of such uses. He addressed INNs from EUIPO guidelines by backing up with scenario cases. He concluded his presentation by recommending not to file Pharma trade marks with INN stems in stem position and encouraging brand owners to file invalidity actions against such marks.



**Bruce Longbottom**

Bruce examined how the Novolimus EUIPO case would be decided by the patent offices in Canada, US, Switzerland and India in light of case law regarding INN/INN Stem in these jurisdictions. He touched on the issue regarding what Health Authorities do to protect INNs against pharma trade marks. He voiced the opinion that INNs are already protected enough and giving additional protection to INN stems increases risks and invited us to think about whether INNs cause more confusion or if they protect consumers from confusion more than the trade mark.

We then adjourned to tea and many people enjoyed a walk along the Cavtat beach area before dressing for our casual evening at Banje Beach where the buffet

food, delightful setting and fun ambiance allowed us all to unwind.

Frank Meixner welcomed us all back into the conference hall on Friday morning and without further ado, passed the floor to Raffaella Balocco from the World Health Organisation who began by telling delegates that as a scientist she came 'as a friend'. As the Group Leader of the INN Program in WHO, Raffaella's speech gave an insight into the workings of this Group. She explained WHO's structure and with examples, provided information why INNs are needed, how to name and define them and how naming them has turned out to be a more complex and difficult issue over time. 600 nomen for biologicals so far and many advanced therapies still to come. She concluded by reminding delegates that it was Leonardo de Vinci who is reputed to have said 'simplicity is the ultimate sophistication'.



**Raffaella Balocco**

Questions from two committee members, Alan Hunter and Tapio Blanc respectively, underscored the point that moving forward, the situation will only get worse and queried whether the time has not come to clear out the INN registry? No doubt we shall be discussing this topic again in a future conference but the Chairman moved us onto the next presentation by Tina Bond of Takeda who spoke about 'Tablet identifiers – just another pharmaceutical trade mark?' Tina's presentation focused on imprints on the drugs, why they are created from both a business and a legal perspective and compared regulatory situations between the US and the EU. Further, Tina provided information about imprinting techniques and technologies and using case law she discussed registrability of imprints. At the



**Tina Bond**

end of her speech she introduced future perspectives in imprinting.

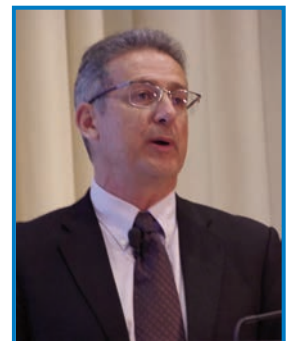
After the coffee break, delegates were whisked off to Latin America for a full session about News and Burning Issues covering Argentina, Brazil, Mexico and Venezuela.



**Juan Lopez Manan**

Thanks to the presenters, this section started and continued full of Latin American energy! First off, Juan Lopez Manan's speech centralized on the 2018 Argentinian Trademark Law. He explained the new opposition system and had practical strategic advice on opposition proceedings; the introduction of partial non-use cancellation actions and mid-term declaration of use, the PTO's new role as to deciding non-use cancellations and certain invalidity cases, and finally the new fees regime were a few important points of his speech. He said that in the first two years practitioners do not expect to see the results but then he believes it will be working effectively.

Next up, Eduardo Machado announced the good news that Brazil is probably joining the Madrid Protocol in 2019 which would cause some welcome changes in PTO procedures. Meanwhile Brazil needs to solve the backlog problem beforehand said Eduardo. He gave practical tips how to expedite trade mark application examination. He agreed that pharma patent applications take the longest time and mentioned some proposed solutions. Practical tips in IP litigation were part of his speech too.



**Eduardo Machado**

Laura Collada reminded delegates that Mexico joined the Madrid system in 2013 and is now the number 10 filer! Laura explained differences in paper and online filings in national applications and what their advantages to Madrid filings are. She



# PTMG 97th conference report continued

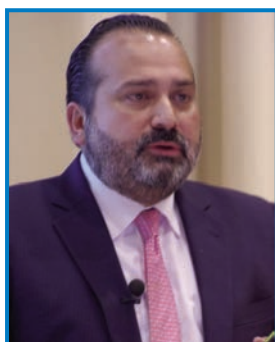


**Laura Collada**

overviewed the August 2018 amended IP Law with a focus on the introduction of a declaration of use system, consent letter practice where she underlined that if such

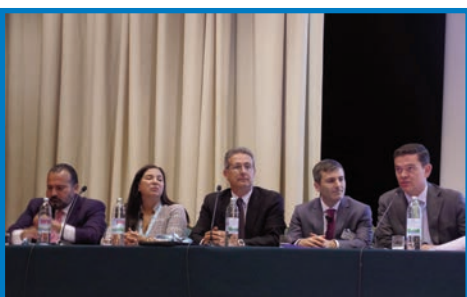
declaration is not filed either on the third or the tenth anniversary, the registration will be deemed cancelled. She recommended brand owners check their portfolio since class headings are not accepted anymore but specific lists of goods and services are required. She said that the Mexican PTO is now obliged to indicate grounds as to why an opposition is accepted or refused.

Finally, the morning's sessions finished with a deeply disturbing presentation from Ricardo Alberto Antequera H. about the current situation in



**Ricardo Alberto Antequera H**

Venezuela. He gave us a passionate overview about the dynamics of the pharma industry and the historical background of legal changes in Venezuela. He underlined the importance of border measures in infringement, recommended process patent applications instead of product patents - if at all possible for the pharma industry, and instead of opposition, he said, try mediation whenever possible.



**LA panel and the Chairman**



**Evrard van Zuylen**

Lunch followed, during which conversation flowed as delegates hunted out committee members to try to find out the destination of our next

Autumn conference. Are we going to be jobless soon due to Artificial Intelligence? Evrard van Zuylen from Darts IP says 'No, get relaxed!' What is AI and how machine learning works, ingredients which fuelled AI growth and how AI evolved, examples how AI operates for instance in GDPR and for legal analyses of decisions were some parts of his speech. In a nutshell he said: AI is faster and we need legal people with a scientific background. Machines are complementary to humans, human beings still decide on the risk or course of action he/she is willing to take but the future will be a collaboration between humans and machines, less time spent on predictions, more time spent in decision making!

Jason Jones from Fross Zelnick Lehrman & Zissu gave delegates an update about What's New at the USPTO and introduced the two new USPTO



**Jason Jones**

programmes. A 'Proof of use audit program' started in 2017 by randomly auditing proof of use requirements on two additional goods and/or services chosen by the USPTO per class. It detects the non-used marks more effectively and the fraudulent registrations. He explained the concept of 'fraud' in light of the Bose case and how the audit works by giving practical tips. The 'specimen protest email pilot program' allows third parties emailing the USPTO to inform that the mark in question has not been used, even though a use specimen has been submitted. As Jason said 'Be careful, be honest, be accurate; USPTO is watching you!'



**Fran Jagla**

Finally, Fran Jagla kept almost all the delegates in the room with her fun and colourful presentation entitled Up in smoke exploring the

pipeline. The chemical compounds of cannabis, a brief history of the plant in the pharma industry and where it is legalized globally and under which restrictions were the first part of Fran's speech. She then went on to highlight how Epidiolex was approved by the FDA and how it became possible to have Epidiolex legally sold in the US by reclassification. She examined the cannabis situation in Canada, Israel, Argentina and Australia. In her inimitable way, she drew the audience's attention to the growing cannabis industry.

To end yet another highly successful conference, the Gala Dinner was held in the historical Revelin Fortress in downtown Dubrovnik. The event started with a cocktail reception on the terrace illuminated with candles before moving downstairs to take our seats for the dinner. The Chairman thanked the speakers and the sponsors and made a presentation to Wolfgang Feiler who has retired from Takeda and thanked him for his active participation as a PTMG committee member. Then, following tradition, the Chairman gave delegates four clues as to the conference destination for Autumn 2019. We will be returning to Berlin! As part of another of our traditions, PTMG delegates ended the evening on the dance floor by showing off the latest dance figures! While adjourning, all of us had the same idea in our minds; we should come to Dubrovnik again!

# Getting up hard to predict in get-up cases

Alyson Poole and Helen Macpherson, Norton Rose Fulbright Australia

As anyone in charge of the weekly supermarket run for their household will tell you, there are multitudes of brands, packaging and advertisements in every aisle you wander down. The same is true when shopping for health care products. This is particularly so given that many OTC consumer health care products are sold in supermarkets or in large supermarket-style or warehouse pharmacies. To distinguish their products from those of their competitors, brand owners will use trade marks, colouring, shapes and images in their product's get-up. In some cases, however, different brands may have common or similar elements in their product's get-up.

As a comparison of two recent judicial decisions will tell you, the decision of whether one product's get-up is impermissibly too close to that of another is fact-specific and not always predictable. And while these two cases are in the context of skin care and hair care, the lessons from these cases are equally applicable to consumer health care products, particularly those sold in supermarkets or in large supermarket-style or warehouse pharmacies, but also those sold in the smaller pharmacy setting.

## The founding principles

The 1937 High Court decision in *Australian Woollen Mills Ltd v F S Walton & Co Ltd* provides one of the founding principles for Courts when comparing the get-up of two trader's products. Dixon and McTiernan JJ eloquently stated in their judgment:

'The rule that if a mark or get-up for goods is adopted for the purpose of appropriating part of the trade or reputation of a rival, it should be presumed to be fitted for the purpose and therefore likely to deceive or confuse, no doubt, is as just in principle as it is wholesome in tendency.'

A simple guideline in theory. But as Dixon and McTiernan JJ went on to state 'the practical application of the principle may sometimes be attended with difficulty.' This is because each case of get-up comparison requires the Court to undertake an assessment as a question of fact, deciding whether there is a reasonable probability of deception or confusion occurring. Today, section 18 of Schedule 2 to the Competition and Consumer Act 2010 (Cth) is the legislative

framework, prohibiting conduct in trade or commerce which is misleading or deceptive or likely to mislead or deceive.

## The practical realities

This article will consider two recent decisions with very different outcomes, both of which involved a comparison of get-up: *Homart Pharmaceuticals Pty Ltd v Careline Australia Pty Ltd* [2017] FCA 403 (*Homart v Careline*) which has recently been upheld on appeal by the Full Federal Court in *Homart Pharmaceuticals Pty Ltd v Careline Australia Pty Ltd* [2018] and *Moroccanoil Israel Ltd v Aldi Foods Pty Ltd* [2017] FCA 823 (*Moroccanoil v Aldi*). The decisions highlight the factual assessments which judges must undertake and provide insight into why the ultimate decision in get-up cases is not always predictable.

*Homart v Careline* centred on two competitors trading in the manufacture, distribution and sale of cosmetic products in Australia. Careline offered a skin repair product advertised as containing 'bio-placenta', being a sheep placenta extract. The product was sold under CHANTELLE branding from 2014. In 2016, Homart launched a product, also containing 'bio-placenta', under the branding CHERI. Careline claimed and was successful in establishing that Homart was engaging in misleading and deceptive conduct on the basis of a 'get-up' argument, relying on similarities between the products in respect of almost all of the significant and distinctive features.

Here is the packaging of the two products:



*Moroccanoil v Aldi* involved a number of claims and cross-claims, but for the purpose of this article the claim relating to 'get-up' will be the focus. Moroccanoil offered haircare products under the MOROCCANOIL branding from around 2009. From 2012, Aldi periodically offered for sale and sold hair treatment products containing argan oil under the branding PROTANE with the words 'Moroccan Argan Oil'. Moroccanoil alleged unsuccessfully that Aldi had engaged in misleading and deceptive conduct (and also passing off), based on the 'get up' of the Aldi products.

Here are examples of packaging for some of Moroccanoil's and Aldi's hair care oil products:



The two cases resulted in different outcomes on the point of 'get-up', highlighting the importance of factual considerations which judges must make when get-up is being assessed.

## The necessary factual assessment

The decision in *Homart v Careline* centred on the general impression left by the products. Although this process involved an assessment of the individual elements of the two products, it was the overall impression which was the focus. As Justice Burley stated, 'it is erroneous and artificial to take an unduly analytical approach to the consideration of the question of misrepresentation'. The concept of imperfect recollection is also relevant.

Justice Burley was persuaded by evidence that consumers often referred to the CHANTELLE product as 'the gold box' without reference to the actual branding. The combined effect of the size, shape and internal arrangement of the box and lid of

continued on next page

# Getting up hard to predict in get-up cases continued

the products, as well as the bronze-gold colour utilised in the 'saturated' form, was therefore given considerable weight. In this case, the name of the product was given less weight than might otherwise have been the case. Justice Burley held that consumers would note and remember the CHANTELLE product by the eye-catching combination of features. This was determined to be separate from the name, and provided an indication of origin, quality and type of goods to consumers quite aside from the branding. Justice Burley was also persuaded by evidence that, in stores, often the products may be placed in a way where the trade mark is not seen. The similarities in get-up were accordingly not held to be overcome simply through use of the distinct CHERI name.

As a point of comparison, Justice Katzmann in *Moroccanoil v Aldi* considered the factual differences between Moroccanoil and Aldi's hair care oil products, holding that 'the get-up of the MIL and Aldi Oil Treatments are similar, but not deceptively so'. Although Justice

Katzmann found that Aldi had unquestionably modelled its product on the Moroccanoil product, her Honour held that the claim of misleading or deceptive conduct was not made out.

On the facts of the case, Justice Katzmann held that, in viewing the Aldi product as a whole, there were a number of differences in the get-up when compared with the Moroccanoil product. These included that Aldi's product prominently used 'house brands' known to be Aldi brands, sold in Aldi stores and promoted in Aldi catalogues and television advertisements. Further, Aldi's product did not include the large orange M which was distinctive of the Moroccanoil product; Aldi's brand placement was horizontal, while Moroccanoil's was vertical; and Aldi's product was sold in a plastic, as opposed to glass, bottle. The fact that Moroccanoil's product was a 'salon only' brand which is not available in mainstream supermarkets (such as Aldi), the differentiated promotion of the products, the distinct target markets, and the disparity in price between the products

were all also persuasive to Justice Katzmann's finding.

## Lessons learnt

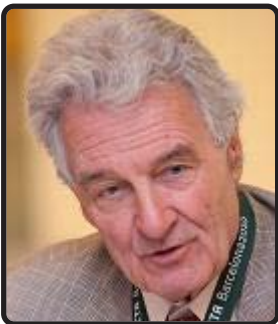
The two cases highlight the factual assessment which must be undertaken before a claim on the basis of misleading or deceptive conduct will be made out. And as stated above, importantly, the lessons which come out of these cases apply equally in the closely related context of consumer healthcare products.

While there may be clear similarities between two products, it is necessary to more deeply assess not only the similarities, but the differences as well (as Justice Katzmann reminds us), before a decision can be made.

It is also relevant to note that it is not just the products themselves which must be part of the assessment. It is also necessary to consider elements such as trade channels, price points, likely consumer interpretations and reputation held.

## In memoriam

### Florent Gevers



Born on July 14, 1934 and passed away on October 23, 2018.

Florent Gevers was a leading figure in the field of intellectual property, both in his home country of Belgium and at international level. He was a European Trade Mark and Patent attorney, and amongst others past President of the Official Advisory Group of the Belgian Government on Industrial Property,

founder member, President and Honorary President of ECTA, President of the Belgian Group of AIPPI, Founder member and President of LES Benelux and founder member and President of BMM.

During his career, Florent placed strong emphasis on delivering a high-quality service and actively promoting IP awareness and importance. He played a leading role in preparing for both the European Patent, the Benelux Trade Mark and he was a driving force behind other important changes, including the implementation of the Community Trade Mark and defending Geographic Indications

He was a man of firm ideas and strong views, but he was always willing to engage in respectful discussion and his dedication and commitment made a valuable contribution to the world of patents and trade marks in the European Union.

He strongly believed in sharing his

knowledge with others including as a visiting professor at the Universities of Alicante (Spain), Strasbourg (France), Fordham (New York, USA), and K.U.B. (Brussels), as well as extensively lecturing worldwide (Belgium, France, Greece, Hungary, Nairobi, Spain, Germany, Great Britain, Japan, Australia, US, amongst others) and mentoring his junior colleagues in Belgium. Though a senior expert and authority figure at the office, he could also be counted on to share a humorous tale to lighten a stressful day, even popping into the office after retirement.

While less active in daily office work with his official retirement in 2012, he continued to speak and present when possible, including at the annual ECTA conference in Alicante 2014.

He will be sadly missed by all his family, friends and former colleagues.

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# PROFILE: Jean McIvor

Jean has been with the African firm Spoor & Fisher for 35 years and is an attorney, Notary Public and partner in the firm's Pretoria office. Her practice has evolved through many areas but is now exclusively to do with trade mark clearance, filing, prosecution and portfolio management, and work for South African clients outside South Africa. For several decades she has been a lecturer/examiner/moderator on the International Trade Mark Law course for the South African Institute of Intellectual Property Law. As for PTMG, in the early days Jean attended many Spring meetings in places such as Glasgow, Liverpool, Cambridge and Brighton, before graduating to the Autumn meetings in the more exotic destinations. Her favourite PTMG memory is of the late Alan Cox, in kilt and with sword, 'addressing' the Haggis in Glasgow.



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

My entire schooling was at St Mary's Diocesan School for Girls in Pretoria, and I then studied English and law degrees at Natal University, The University of South Africa and Clare College, Cambridge.

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

By accident – after I had qualified at a general law firm, the father of a friend suggested I consider trade mark law at his firm, Spoor & Fisher, and so I began, knowing absolutely nothing about IP, as it wasn't even offered as a University course in those days.

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

Probably teaching – my grandmother and mother were teachers, and one of our sons is training to be a teacher, so it's in the blood.

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

Restless, resolute and resourceful.

## **What was your worst experience in the world of work?**

On my first business trip for the firm having, as a vegetarian, to pretend to eat a lamb chop at a small lunch hosted by an important client, because I did not wish to offend the client!

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

Being part of a global community of invariably nice trade mark lawyers who

share special camaraderie, and getting to travel to great destinations to meet them, has been enriching and has made work more meaningful.

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

An architect

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

Whistlejacket by George Stubbs in the National Gallery in London. It's not deep or meaningful but its simple beauty and scale always amazes.

## **What is the soundtrack to your life?**

Lenny Kravitz 'I want to get away. I want to fly away. I wish that I could fly into the sky so very high just like a dragonfly'.

## **What do you wish more people would take notice of?**

William Blake said it best: 'To see a world in a grain of sand / and a heaven in a wild flower, / hold infinity in the palm of your hand / and eternity in an hour'.

## **What is the best age to be?**

The early 40's because the tortured angst of youth has gone, any children are probably not yet teenagers, and your parents are still well, so 'all's right with the world'.

## **What would be your ideal night out?**

Champagne and a symphony concert.

## **Whom do you most admire and why?**

The late Wangari Maathai, the tree woman of Kenya who founded The Green Belt Movement and was the first African woman to win the Nobel Peace Prize.

## **Which famous historical person would you like to have been and why?**

Julius Caesar – perhaps it was all those years studying de Bello Gallico in Latin made it seem very glamorous to be the charismatic General commandeering Gaul and invading Britain, even though he came to a sticky end!

## **Which book or books are you currently reading?**

Warlight by Michael Ondaatje.

## **Which music recording would you take with you to a desert island?**

Handel's Messiah – The King's College Choir recording.

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

The Killers.

## **How do you relax?**

Take a mug of tea into the garden and weed or water pot plants.

## **What is your all-time favourite film?**

Forrest Gump – an epic tale of humanity, history and hope.

## **If you could enact one law, what would it be?**

A law banning all billboards. I get violent thoughts involving bazookas when I see a billboard spoiling natural or architectural beauty.

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

Waterborne sewerage systems.

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