

Law Lore & Practice

PTMG



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Editorial: In praise of cooperation

To paraphrase Aristotle, human beings are social animals. Adjustments have always been made within families and organisations to accommodate varying personalities and needs, but by living together and sharing moments of exchange, individuals build collective memories from which to draw strength and go forth.

From one day to the next, this centuries-old social behaviour model has been brutally brought to a halt. Meeting, travelling, sharing, sporting and cultural activities all brought to a standstill. We have adapted; we have had to. And after the initial shock of the global lock-down, we have learnt to keep in touch in other ways – through small acts of generosity and caring in our close

communities and thanks to technology throughout our wider family and professional circles .

The cornerstone upon which we have survived the past months and upon which we shall re-build the essence of our humanity, must be cooperation. Only then shall we truly beat this invisible enemy.

Whilst we shall not meet in Amsterdam this Autumn, the PTMG family will continue its own special brand of cooperation, led by our dedicated Board and Committee, who join me here in thanking Lesley Edwards, for all her tireless efforts on behalf of the Group.

May you & your loved ones stay safe.

Vanessa

US Update

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

In a recent case, the USPTO's Trademark Trial and Appeal Board (Board) provided lessons for brand owners who may encounter a merely descriptive objection, including the importance of avoiding damaging statements in marketing materials. In re SV Life Sciences Managers LLP, 2020 WL 1873062 (TTAB April 1, 2020)(non-precedential).

SV Life Sciences Managers LLP (SV Life) applied to register DEMENTIA DISCOVERY FUND for pharmaceutical and medical preparations and substances for the prevention and treatment of dementia, among other related goods and services. The Examining Attorney rejected the application to register the mark as merely descriptive. SV Life appealed this finding to the Board.

Following the Federal Circuit's precedents for evaluating descriptiveness, the Board analyzed consumers' likely understanding of each word in SV Life's mark, as well as the impression of the mark as a whole, since the whole can theoretically be more distinctive than the sum of its descriptive

parts. Here, SV Life had conceded the mere descriptiveness of 'dementia' by disclaiming the exclusive right to use this word (apart from the mark as a whole) during prosecution of the application. For the second word, 'discovery' which was not subject to a disclaimer, the Board considered SV Life's argument that 'discovery' had no single meaning in the pharmaceutical and medical fields and that the word in the context of the mark constituted a 'a [c]lever juxtaposition of two antonyms 'DEMENTIA' (suggesting losing person's mechanisms of acquiring information) and 'DISCOVERY' (suggesting owning person's mechanisms of acquiring information)...'. To bolster its point, SV Life also had submitted many third-party registrations of marks incorporating 'discovery' without disclaimers in the medical and pharmaceutical research fields.

The Board did not look at the word 'discovery' in isolation, but considered the other words in the mark to assess its meaning. It found a link between

'discovery' and the word 'fund' such that 'Discovery Fund' had a clear meaning in the pharmaceutical and medical research industry. The word 'dementia' in its analysis served to describe the particular field of research for the 'Discovery Fund'.

The Board then turned to SV Life's press releases and website, pointing out descriptive uses of the mark in those materials. It also concluded that multiple meanings of 'discovery' in third-party marks were not controlling, as just one descriptive meaning is enough to bar registration. Finally, SV Life had disclaimed the word 'fund' so it was also merely descriptive, although the Board noted that industry uses supported this finding.

After analyzing the individual words and finding them merely descriptive, the Board considered the impact of the mark as a whole, and focused on statements on SV Life's website, including the statement that its Dementia Discovery Fund is 'a venture capital fund created to facilitate the

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Turkish average consumers: healthcare professionals or end users?

Dicle Doğan and Ayşenur Çıtak, Gün + Partners

In December 2019, the Court of Appeal issued two decisions in which the nature of consumers has been scrutinized while assessing likelihood of confusion between pharmaceutical trade marks.

Infantum v Infanta

A trade mark application INFANTUM was filed before the Turkish Patent and Trademark Office (the Office) covering goods in classes 3 and 5, against which an opposition was filed based on the prior registered trade mark INFANTA covering the same classes. The opposition was accepted in its entirety by the Office based on the likelihood of confusion.

The applicant filed an action for the cancellation of the Office's final decision by arguing that there is no likelihood of confusion between the trade marks since the target consumers of the medical goods should be considered as well-informed and highly educated.

The first instance IP Court (the IP Court) determined that the basis of the parties' trade marks is INFANT and questioned the meaning of it. It stated that INFANT is commonly used in medical goods although it is not derived from a name of an active ingredient. Therefore, the IP Court decided that the additional letters sufficiently differentiate the subject trade marks especially for medical goods.

As a result of the above assessment, the IP Court determined that there is likelihood of confusion between the trade marks for all the goods in class 3 and 'dietary supplements (including dietary supplements and animal feed additives for non-medical purposes, pollen as dietary supplement). Sanitary preparations (pads, tampons, plasters for medical purposes, materials for dressing, diapers made of paper and textile for children)' in class 5 since their end consumers are not medical professionals.

Overall, the IP Court decided the partial acceptance of the case and for the partial cancellation of the Office's decision with regard to 'medicine for human and animal health, chemical products of medical purposes, chemical elements, dietary supplements for medical purposes; preparations for slimming purposes, for food babies, preparations and herbal beverages for medical purposes, dental products (excluding instruments/devices),

disinfectants, antiseptics, detergents for medical purposes.' in class 5 since their end consumers are medical professionals.

The matter was finally reviewed by the Court of Appeal upon both of the parties' appeals. The Court of Appeal first explained that pharmaceutical trade marks which originate from non-distinctive phrases or are the name of an active ingredient can be registered if they have distinctive characteristics.

The Court of Appeal further explained that subject trade marks are not derived from the name of a treatment or an active ingredient. Therefore, the professional nature of the end users (being healthcare professionals such as doctors, pharmacists and dentists) does not eliminate the high level of confusing similarity between the trade marks.

Hence, the Court of Appeal concluded that the case should also be dismissed for all the goods even if their end consumers are healthcare professionals. As a result of the above assessment, the Court of Appeal rejected the appeal of the plaintiff and overturned the IP Court's decision for the benefit of the defendant. The case was sent back to the IP Court. As to the next steps, a case will be re-recorded and a trial will be opened where the IP Court will decide whether to comply with the Court of Appeal's ruling or not.

Certican v Septican

The trade mark application SEPTICAN was filed before the Office covering goods in class 5, against which an opposition was filed based on the prior registered trade mark CERTICAN covering the same goods. The opposition was rejected in its entirety by the Office.

The opponent filed a cancellation action against the Office's decision before the IP Court. In its decision, the IP Court determined that even though pharmaceuticals shall be prescribed by doctors and sold in pharmacies, pharmacists may not have the same level of medical knowledge as a physician. The IP Court added that pharmacy technicians are also working in pharmacies and helping customers. Since there is similarity between SEPTICAN and CERTICAN and these products can technically be sold on the same shelves, the IP Court decided to partially accept

the case with respect to the pharmaceuticals in class 5.

The decision was initially upheld by the Court of Appeal. Upon the Applicant's second appeal, the Court of Appeal re-examined the case and pointed out that the knowledge level of the target consumer is important while evaluating similarity and likelihood of confusion between trade marks and determined that the relevant consumers of the goods covered by these trade marks are doctors and pharmacists and that CER- and SEP- prefixes are highly different. Therefore the Court of Appeal ruled that there is no confusing similarity, no likelihood of confusion between the trade marks and overturned the IP Court's decision which decided for the partial acceptance of the case.

Importance of these recent decisions

The Office and first instance Courts had a very strict approach to the evaluation of trade marks covering goods in class 5, which were in line with many of the Court of Appeal's decisions. In Turkey, the majority of pharmaceuticals are in principle subject to a prescription and can only be sold in pharmacies. Therefore the Court of Appeal opined that end consumers do not have any influence during the prescription and purchase of pharmaceuticals. Thus healthcare professionals should be taken as the average consumers while assessing likelihood of confusion for pharmaceutical trade marks. This interpretation has been strictly applied and in many cases Courts decided that healthcare professionals would not confuse the trade marks in question.

The above-mentioned proceedings show that the Courts and the Court of Appeal consider the professional nature of pharmaceutical trade marks' relevant consumers as a factor decreasing the likelihood of confusion where there is no high level of similarity between the trade marks. However, we can assume that based on its recent decisions, the Court of Appeal does not ignore the high similarity between the pharmaceutical trade marks while evaluating likelihood of confusion, even if the relevant consumers are healthcare professionals.

PROFILE: Gunnel Nilsson

Gunnel worked for twelve years as an in-house trade mark attorney at Pharmacia and became head of the Global Trademark Department, a position held for thirteen years until the company was acquired by Pfizer. For the last fifteen years she has worked at the IP law firm Groth & Co as a trade mark attorney, and most of these years as deputy head of the Law & Trademark Department.

She has a particular focus on pharmaceuticals.



Where were you brought up and educated?

In Uppsala, Sweden, a town well known for its old university.

How did you become involved in trade marks?

By coincidence. I saw an advert for a 10 months temporary post in the trade mark department at Pharmacia. It should suit me well I thought while I was studying to become a teacher. 25 years later I left.....

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

Become a teacher.

Which three words would you use to describe yourself?

Cheerful, optimistic, energetic.

Complete the following sentence:

"I wish that ..."

this horrible pandemic COVID-19 to disappear so that we can all go back to our normal lives"

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

Swedish literature, English and German.

What was your worst experience in the world of work?

When I had to inform my colleagues at Pharmacia that we were all redundant and thus lost our jobs because of the acquisition of the company.

What do you do at weekends?

I play with my grandchildren and dine with family and friends.

Complete the sentence: If I have time to myself

I read a good book, take a bike ride, or go for a long walk.

Complete the sentence:

I'm no good at waiting in a queue.

What's the best thing about your job?

My colleagues! That every day is different and that the work is global which gives us all a chance to travel and meet wonderful IP people from all over the world.

What did you want to be as a child?

A singer! And as you can imagine my career would have been an extremely short i.e., non-existent.

What does all your money get spent on?

Good food, travel and, I must confess, dresses!

What would be your ideal night out?

A nice dinner with family and friends and a good red wine..

Who was your mentor or role model?

My first boss and General Counsel at Pharmacia, Eric Spetze. He trained and mentored me, and I owe a lot to him!

Which book or books are you currently reading?

Scandinavian crime stories

What is your favourite food dish?

Italian food, although the best dinner I have ever had was in Reykjavik.

What is your favourite holiday destination

Gotland, an island in the Baltic Sea, Iceland, and Greece.

What's the best invention ever?

Antibiotics because it has saved so many lives.

Which modern convenience could you not live without?

My smartphone.