

# Law Lore & Practice

PTMG



Pharmaceutical  
Trade Marks Group

May 2016

## Editorial: BREXIT, what else?



As a British passport holder living in France for more than 25 years, I am, as you might imagine, more than a little concerned by the upcoming United Kingdom referendum on the 23rd of June. Despite the appeal lodged by a British WWII army veteran living in Italy, all those of us who left the UK more than 15 years ago are not eligible to vote, even though our lives will be directly affected by the outcome of the vote. Losing European Union citizenship

should the leave campaign be successful, like two million other British citizens living in Europe, I will have to re-apply to reside in the country my children call home.

It begs the question: where have all the dreams gone? The student enthusiasm of my generation, embodied by the fall of the Berlin wall in 1989, our desire to continue to better integrate with our neighbours and the naïvety that the advantages we could see would be appreciated by all. For trade mark practitioners of course, the European Union trade mark (formerly the CTM) was just one such ambitious goal. Harmonisation and a structure which enabled new member states to continue to join the system on an equal footing did not seem utopian at the time. This mechanism continues to evolve

and remains much admired around the globe as a positive example of a level playing field for competitive activity.

The deeply anguishing times we live in today are no worse than those my grandparents knew: millions of displaced people throughout the continent and beyond, more migrants than we have recently witnessed. And yet, having lost so much and so many loved ones, they all, whatever their nationality, wanted to rebuild something anew and to aim for an ideal. How is it that today, sharing what we have with others has become nigh-on impossible? How can we reverse this tendency for those that come behind us? Thankfully, the PTMG family continues to build the bridges that politicians seem incapable of doing and our shared common interest overrides all other individual considerations.

Nonetheless, within the PTMG committee, we have our own Brexit to adjust to as we say good-bye to Rosina Baxter of Benckiser, a long standing committee member whose first meeting took place on 28 September 2005. I understand that we shall have the pleasure of her company in Oslo and who knows, we may even be able to continue to pick her brains for the catchy conference titles she has penned in the past. Meanwhile, I know I speak for all in wishing her a happy, healthy and well-earned retirement.

Vanessa

## US Update

Jonathan S. Jennings, Pattishall, McAuliffe [1]

On 23 March 2016, the 4th Circuit issued an opinion in *Belmora LLC v Bayer Consumer Care AG & Bayer Healthcare LLC*, holding that brand owners need not own or use a trade mark in the United States in order to have standing to bring a federal suit for unfair competition in cases involving misrepresentation.

This case involved Bayer Consumer Care's sale of a pain reliever in Mexico under the trade mark FLANAX. Bayer does not own a US trade mark registration for FLANAX and does not sell FLANAX products in the US. Instead, Bayer markets a comparable naproxen sodium pain reliever in the US under the trade mark ALEVE. Without Bayer's authorization, Belmora LLC began selling a naproxen sodium pain reliever in the US under the FLANAX mark in the same trade dress as Mexican FLANAX and registered the FLANAX mark with the USPTO. Belmora marketed its product to Mexican-Americans and implied through advertising to its distributor and retail customers that Belmora's FLANAX was the same as Bayer's Mexican FLANAX. Bayer objected

to Belmora's use and registration of FLANAX as a misrepresentation of source and petitioned to cancel Belmora's registration.

After the Trademark Trial and Appeal Board of the USPTO granted Bayer's petition to cancel Belmora's trade mark registration for FLANAX, both parties brought suit in federal court. The District Court granted Belmora's motion to dismiss Bayer's claims and reversed the USPTO's cancellation of the US registration for FLANAX, essentially finding that a brand owner must use a mark in the US to protect its rights. The Fourth Circuit in turn reversed the District Court and found that Bayer did state a claim against Belmora for passing off, unfair competition and false advertising, as well as for cancellation of the registration for misrepresentation, even though Bayer did not sell FLANAX in the US.

Relying on the Supreme Court's 2014 landmark decision in *Lexmark v Static Control*, the Fourth Circuit held Bayer's claims fell within the Lanham Act's zone of

interest and that Bayer had alleged injuries that were proximately caused by Belmora's actions. The court noted that a defendant who passes off its products as the plaintiff's is liable under Section 43(a) of the Lanham Act, regardless of whether the plaintiff actually owns a US trade mark. The Fourth Circuit indicated hesitance to hold for hypothetical brand owners in the future who may assert an unfair competition claim when only "a few isolated consumers . . . confuse a mark with one seen abroad," clearly attempting to draw some boundaries on the scope of its holding.

Brand owners who use different marks in the US and other countries now have support for policing cases of misrepresentation and passing off in the US. It remains to be seen how far this precedent will extend, for example, in situations where the use of the marks is in countries that are not as close to the US as Mexico or Canada.

[1] Members of the author's firm represented Bayer in this case.



The year 2016 has started with another great PTMG Spring Conference at the legendary Savoy hotel in London. It was a pleasure to see so many of you in this splendid environment. I personally liked very much the combination of presentations looking at IP from different perspectives. The presentations we got again were fascinating and creative. It is nice to see that our major topic of trade marks has not lost its appeal over time. On the contrary!

Now, while we were enjoying our conference in London, OHIM has undergone some kind of a metamorphosis and is now known under the much more obvious and catchy title EUIPO. More practical changes are to be expected from Alicante due to the enactment of the so-called Trademark Package. I guess this will be worth a presentation at one of our future conferences.

Finally, I have to announce that Rosina Baxter of Reckitt Benckiser is retiring. She was one of the most active PTMG Committee members with a great sense of humour and so many creative ideas. Well, dear Rosina, I am confident that you will enjoy your well-deserved retirement, but you should know that we will really miss you!

**Frank Meixner**

## Obituary Ingrid Desrois

24 November 1940 - 14 April 2016

Ingrid Desrois was known by so many throughout our profession and the news of her sudden passing after a short battle with leukaemia has shocked us all, as the hundreds of testimonies flooding in bear witness. To quote Peter Müller who wrote her INTA Volunteer profile back in 2011: "If there is anything such as a "well-known trademark" in the field of IP personalities—one that has enhanced distinctiveness because of long-term use, has high recognition in the market and is valued by consumers—it would be Ingrid Desrois". She was first and foremost a woman who made it to the very top of her profession through sheer hard work and determination. However, Ingrid is remembered by most for her human qualities of generosity and advice, no matter the subject and situation.

As many will know, I had the privilege of working in her team for more than 10 years when the Europe, Middle East and Africa Trade Mark Department of Procter & Gamble was based in Paris and grew from strength to strength under her leadership. After growing up in Munich, Ingrid moved to Paris in the mid-1960s, where she first became active in trade marks through an acquisition by Richardson-Vicks. Like many of us, her expertise in languages underscored the enjoyment that she found working in our specialised field. She was a demanding boss, expecting the same commitment to excellence that she herself demonstrated.

Her particular brand of leadership was based on learning by doing coupled with natural mentoring skills. "Inspirational" is the word that stands out in all the testimonials received from those who were lucky enough to work with Ingrid, no matter what they have gone on to do subsequently. No problem was too small for Ingrid's time - be it professional (a minute detail in a file could reverse a legal situation) or personal. Working together on a Saturday morning to beat the administrative backlog or sharing a seven hour flight back from Cincinnati provided many opportunities to simply look, listen and learn.

Richard Heath, former adversary at



Unilever remembers Ingrid's "gracious geniality coupled with steely resolve, which are admirable negotiating traits, whether in a commercial situation involving high stakes but apparently mundane products like toothpaste and laundry detergent, or in a policy situation when talking to Governments". In addition to being a PTMG Committee member until 2002, she also devoted much time to lobbying through other professional organisations such as AIM, ECTA and of course Board membership of INTA. She was elected the first female Honorary member of APRAM in January 2014.

With her passing, the trade mark profession has lost a "grande dame", a committed European who from its very outset believed in the European Union trade mark. Hundreds of priority claim applications and of course the controversial BABY-DRY decision are witness to her supreme efforts to see the then OHIM office succeed in its aim of harmonisation. It was no surprise to anyone when the then President of OHIM invited her to become his special advisor, an industry ambassador rôle which she held for the past twelve years. Many practical and pragmatic improvements to the system, such as the user satisfaction surveys and specified Examiner training, are the embodiments of her approach to trade mark practice.

She is survived by her husband, her son and daughter and four grandchildren to whom she devoted much of her time after retiring from P&G in 2003. To respect the family's wishes, PTMG has made a donation to Bloodwise.

**Vanessa Parker**

# **BARRIER is no barrier to registration of DNA Barrier**

**Chris McLeod, Elkington and Fife LLP, London**

In Case O-123-16 Mölnlycke Health Care AB v Mologen AB (7 March 2016), the UK Intellectual Property Office (IPO) has rejected an opposition by Mölnlycke to an application to register the word mark DNABARRIER in classes 1 and 5.

Mologen filed its application on 17 June 2014 as a designation of a WIPO registration. On publication for opposition purposes in October 2014, Mölnlycke filed opposition on the basis of several earlier UK and EU trade mark registrations of BARRIER covering goods in classes 5, 10 and other classes, arguing that the marks were visually, phonetically and conceptually similar, that the respective goods were similar and that its earlier mark had enhanced distinctive character through use in the UK. Mölnlycke detailed its use in its evidence, claiming use in the UK in relation to surgical drapes for at least 40 years and total sales of over GBP £280 million from 2004 to 2014.

The IPO's hearing officer held that Mölnlycke's claim that the respective goods could be used in "close proximity" lacked specificity. He was therefore unable to detect any similarity other than in relation to the earlier registration covering goods in class 5 and the goods covered by the application. Considering first the class 1 goods covered by the application - chemicals, proteins, enzymes, nucleic acids etc. - the hearing officer held that these did not compete with and were not complementary to Mölnlycke's class 5 goods, namely plasters, dressings, compresses, swabs and the like. Turning to the class 5 goods covered by the application, the hearing officer held that these were either identical or similar.

The hearing officer then considered the average consumer. On the basis of the General Court judgment in

Mundipharma AG v OHIM, there were two groups of relevant consumers, namely members of the public and professionals. Members of the public would display a low degree of care when selecting inexpensive goods such as disposable pads, and a high degree of care when selecting goods for use on the person or for ingestion. Professionals would pay a high degree of attention in relation to all goods due to the necessary elements of the selection process.

Comparing the marks, the hearing officer concluded that they had a medium degree of visual and aural similarity because the earlier mark was contained as an identifiable element in the later mark, but that the DNA element of the later mark reduced the conceptual similarity to "medium at best".

Turning to the evidence of use, the hearing officer held that most of this was in relation to goods in classes 10 and 25 and that none of it was in relation to goods in class 5, adding that the word BARRIER must have a very low degree of inherent distinctiveness for class 5 goods which may act as a barrier.

In conclusion, the hearing officer held that the medium degree of similarity between the marks resulting from a shared element which, at best, had very low distinctive character, was insufficient to lead to direct or indirect confusion. He therefore rejected the opposition and awarded costs to Mologen.

This decision is not surprising when considering the facts and in particular the use of the earlier marks, in relation to which the evidence enabled the hearing officer to find in favour of Mologen in relation to marks which on first sight might well appear sufficiently similar.

## **International Update**

### **India**

#### **Ms. Samta Mehra, Remfry & Sagor**

It is common practice in the pharmaceutical industry to derive names of drugs from their chemical compounds and this often results in co-existence of similarly named medicines. At the same time, it is well-established that trade mark law envisages stricter examination of marks in respect of medicinal and pharmaceutical preparations as infringement/passing off here not only causes economic loss but can also have hazardous health consequences. Extreme caution has to be exercised in such cases, more so, in a polyglot nation like India where diverse scripts are used and a significant segment of consumer base is uneducated. The recent judgment of Win-Medicare Private Limited (plaintiff) v Galpha Laboratories Limited (defendant) highlights these issues, amongst others, and emphasizes that public interest is paramount.

The plaintiff, registered proprietor of the trade mark BETADINE in India in relation to pharmaceutical preparations, was manufacturing and selling a Povidone-Iodine combination since the year 1990 under a distinctive trade dress comprising of a white background with dark blue lettering prominently featuring a two stripe mark accompanied by the trademark BETADINE appearing on the label. When it learnt that the defendant had filed a deceptively similar mark BECTODINE-M in Class 5, the plaintiff opposed the application in 2013 upon its advertisement. Subsequently, on noticing use of the mark BECTODINE by the defendant with a similar get up as that of the plaintiff's products, the plaintiff instituted a suit for permanent injunction asserting its prior and well-established rights in the trade mark, trade dress and copyright.

An order of ex-parte ad interim injunction was granted by the Delhi High Court on 14 November 2014. Thereafter, an application was filed by the defendant for vacation of the ex-parte interim injunction and the said application along with the application for interim injunction was argued before the High Court at length.

*Continued on next page*



# International Update Continued

The defendant submitted that BECTODINE was honestly coined by taking prefix BECT from BACTERIA and suffix ODINE from the generic molecule IODINE. It countered that ODINE was a publici juris word and no one could claim exclusivity thereon, as was also evident from over 700 trade marks with the suffix DINE subsisting on the Trade Marks Register. The defendant also pressed for having acquired rights over their mark by continuous use since 2006 on which basis it sought co-existence with BETADINE.

The court applying the anti-dissection rule held that the marks BETADINE and BECTODINE when compared in entirety are confusingly similar. Further, it held that the defendant adopted the mark BECTODINE being fully aware of Plaintiff's trade mark BETADINE which is evident from the similar packaging and trade dress. Given the malafide adoption, the court was of the view that no amount of subsequent use would protect the defendant's rights in the dishonestly adopted mark. The court also upheld plaintiff's rights in the color scheme and layout not only as a trade dress but also as a novel and unique artistic work and held that the defendant also infringed the plaintiff's copyright.

The order of ex-parte interim injunction was confirmed by the High Court vide order dated 4 January 2016.

## Serbia

### PETOSEVIC

Serbia is drafting a new trade mark law, which aims to introduce the opposition system. If adopted, the main changes that the new law would bring are as follows:

#### Observations

Under the current law, the Serbian IPO can consider the written observation of any interested party that objects to the registration of a trade mark on both absolute and relative grounds for refusal. Although trade mark examiners are not required to take written observations into consideration, they have generally seriously considered them. Under the draft law, any natural or legal person can file a written observation, only on absolute grounds, within three months from the trade mark application's publication date. This person does not

become party to the proceedings. The IPO must take the written observation into consideration and send it to the applicant, who may then submit a written response within 15 days.

#### Oppositions

According to the draft law, the IPO will conduct formal and substantive examinations on absolute grounds. The substantive examination on relative grounds (earlier rights) will be conducted only if an opposition is filed. Namely, the holder of an earlier trade mark or a well-known trade mark (regardless of the list of goods/services), the licensee, or the holder of the earlier right to an individual's name or image, copyright or industrial property right, can file an opposition based on relative grounds for refusal within three months from the application's publication date. The trade mark will not be refused if the holder of the earlier trade mark or earlier right explicitly consents to the registration of the later mark. Therefore, the draft law clearly separates the absolute and the relative grounds for refusal.

#### Registration Certificates

Obtaining a trade mark registration certificate is optional under the new draft law. The certificate is issued at the request of the trade mark holder and upon filing the proof of payment of the prescribed fee.

## Ukraine

### PETOSEVIC

The Ukrainian law to ratify the Protocol amending the TRIPS Agreement (Agreement on Trade-Related Aspects of Intellectual Property Rights) entered into force on 12 March 2016.

The Protocol will take effect upon its acceptance by two-thirds of the WTO members, in accordance with the provisions of paragraph 3 of Article X of the Marrakesh Agreement Establishing the World Trade Organization (WTO). According to a decision of the WTO General Council of 30 November, 2015, the period for acceptance was extended to 31 December 2017.

The Protocol aims to make it easier for developing member countries to receive more affordable, generic versions of

patented medicines, as it allows exports of medicines made under compulsory licenses to countries that are unable to manufacture them. Originally, compulsory licensing was to be authorized primarily for supplying the domestic market.

Therefore, Ukraine will be able to issue compulsory licenses both to export drugs to other countries as well as to import the drugs it needs. Most likely Ukraine will act both as an exporter and an importer. The adoption of domestic regulations implementing the details related to compulsory licensing will follow later, closer to the date when the Protocol is expected to take effect.

## Ukraine

The draft law on amendments to the Customs Code of Ukraine has recently entered the parliamentary procedure. It aims to harmonize the local customs legislation, particularly the provisions of Part XIV (IPR protection during the movement of goods across the customs border of Ukraine) with the corresponding EU regulations.

If adopted by the parliament and signed by the president, the draft law will enter into force on 1 January 2019, three years after the entry into force of the Ukraine–EU Association Agreement (1 January 2016).

The draft law aims to:

- Expand the list of protected IP rights;
- Expand the list of persons who may seek IPR protection;
- Provide new definitions of terms and concepts such as “goods that infringe IP rights”, “counterfeit goods”, “pirated goods”, etc.;
- Establish a procedure for preventing IPR abuse during foreign economic activities, namely during the movement of protected goods across the customs border (export / import / transit of such goods);
- Introduce a destruction procedure for small batches of goods suspected of IPR infringement, in line with the small consignment procedure (EU customs enforcement regulation No. 608/2013).

# Vitabiotics loses fight over LIPODERM

Rachel Conroy, Boulton

This case involves a UK trade mark application for LIPODERM by Professional Compounding Centers of America, Inc. (the applicant), an opposition thereto by Vitabiotics Ltd (Vitabiotics) and an application for revocation of Vitabiotics' earlier registration of LIPODERM by the applicant.

The applicant applied for the mark LIPODERM for "pharmaceutical and medicated preparations for topical, transdermal and skin care use; base cream for use with or in the manufacture of pharmaceutical preparations; lipophilic liposomic cream used as a base in preparations for transdermal delivery of pharmaceutically active ingredients" in Class 5.

Vitabiotics opposed the application on the basis of likelihood of confusion with its earlier UK trade mark registration for LIPODERM for "pharmaceutical preparation, dermatological products for medical conditions, all for human use" in Class 5.

The applicant filed an application for revocation of the earlier registration on the grounds that the trade mark had not been put to genuine use for any of the registered goods, which included "tonics and balms for the hair; all for human use" in Class 3 as well as the goods in Class 5 set out above, within two five year periods since registration.

Vitabiotics filed a defence on the basis that it had proper reasons for non-use being that it had a significant plan for the trade mark in relation to a patented product due for launch shortly, that the product had been in extensive ongoing research and development and formulation refinements, and that the launch of the product had been delayed by further technical problem solving and

complex clinical studies and patent applications.

## Decision

The Hearing Officer considered the law surrounding proper reasons for non-use within section 46(1)(a) of the Trade Marks Act 1994. In particular, she considered case law which states that only obstacles having a sufficiently direct relationship with a trade mark making its use impossible or unreasonable, and which arise independently of the will of the proprietor of that mark, may be described as proper reasons for non-use of that mark.

The Hearing Officer held that there was no reason for Vitabiotics to have applied for or secured a patent and that the clinical trials were tied to the desire to state that the products were clinically proven, but this was unnecessary prior to bringing the product to market: it was a marketing choice, and therefore both the patent(s) and clinical trials were outside of the scope of being factors which are "independent of the will of the proprietor". Vitabiotics had control of whether it filed patents or undertook clinical trials; it was its choice to pursue these avenues.

Technical problem solving was characterised as a normal R&D issue, which is an ordinary commercial activity, and therefore not a proper reason for non-use.

The Hearing Officer considered that there is a balance to be struck between encouraging and rewarding innovation and trade and promoting healthy marketplace competition and owning a perpetual monopoly in a trade mark. If a mark is not used within five years of registration, it becomes the antithesis of innovation and healthy trade competition

because it clutters the trade mark register, reducing the scope of choice of marks for those who are ready to trade.

The evidence put forward by Vitabiotics did not prove that there were obstacles which were independent of its will. It accepted that its patents and clinical trials were its choice, which means the delays caused by them were also its choice. The technical problem solving was an inherent part of R&D which, for a manufacturer, forms part of the normal risk landscape of bringing a product to market (in terms of resources and changing objectives).

## Comment

It was noted in the decision that the lack of explanation in the evidence as to the reasons for the problems, their impacts and when they occurred meant that the Hearing Officer was unable to assess them objectively. If a party is going to seek to rely on proper reasons for non-use in a revocation action, it must ensure that it has evidence in place that proves obstacles to use of the trade mark which are independent of its will, or it will struggle to succeed.

## 93rd PTMG Conference

Oslo

5th - 8th October 2016

Registration will open mid June

# Members News

## New Members

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

**Simon Gray** of Tomkins & Co., Dublin, Ireland [sgray@tomkins.com](mailto:sgray@tomkins.com)

**Safir Anand** of Anand and Anand, Noida, India [safir@anandandanand.com](mailto:safir@anandandanand.com)

**Bolaji Olowofoyeku** of Bolaji Olowofoyeku & Co., Lagos, Nigeria [bolaji@bocsolicitors.com](mailto:bolaji@bocsolicitors.com)

**Ryan Lynch** of Aves Brands, c/o Bird & Bird LLP, The Hague, The Netherlands [ryan.lynch@avesbrands.com](mailto:ryan.lynch@avesbrands.com)

**Jérôme Coulonvaux** of Office Kirkpatrick, La Hulpe, Belgium [j.coulonvaux@kirkpatrick.eu](mailto:j.coulonvaux@kirkpatrick.eu)

**Jeong Won Lee** [jwlee@firstlaw.co.kr](mailto:jwlee@firstlaw.co.kr) and **Hyun Sil Lee** [hslee@firstlaw.co.kr](mailto:hslee@firstlaw.co.kr) both of FirstLaw P.C., Seoul, South Korea

**Felipe Gutierrez** of Panamericana de Patentes y Marcas S.C., Mexico City, Mexico [felipe\\_gutierrez@ppm.com.mx](mailto:felipe_gutierrez@ppm.com.mx)

**Aron Laszlo** of Oppenheim Law Firm, Budapest, Hungary [aron.laszlo@oppenheimlegal.com](mailto:aron.laszlo@oppenheimlegal.com)

**Güldeniz Doğan** of Gun + Partners, Istanbul, Turkey [guldeniz.dogan@gun.av.tr](mailto:guldeniz.dogan@gun.av.tr)

**Florian Bottenschein** of Bayer Intellectual Property GmbH, Monheim am Rhein, Germany [florian.bottenschein@bayer.com](mailto:florian.bottenschein@bayer.com)

**Roger Staub** of Froriep, Zurich, Switzerland [rstaub@froriep.ch](mailto:rstaub@froriep.ch)

**Ioana Sturza** of Cabinet Oproiu Srl., Bucharest, Romania [office3@oproiu.ro](mailto:office3@oproiu.ro)

**Kirsty Brummell** of Reckitt Benckiser Group plc, Slough, Berkshire, UK [Kirsty.brummell@rb.com](mailto:Kirsty.brummell@rb.com)

**Antje Ehrlich** of Merck KGaA, London, UK [antje.ehrlich@gmx.net](mailto:antje.ehrlich@gmx.net)

**Thomas Treutler** of Tilleke & Gibbins Consultants Limited, Hanoi, Vietnam [Thomas.t@tilleke.com](mailto:Thomas.t@tilleke.com)

**Mark Ghobry** [mghobry@brandinstitute.com](mailto:mghobry@brandinstitute.com) and **Thomas Painter** [tpainter@brandinstitute.com](mailto:tpainter@brandinstitute.com) both of Brand Institute Inc., London, UK

**Barbara Gerber** of Addison Whitney, London, UK [Barbara.gerber@addisonwhitney.com](mailto:Barbara.gerber@addisonwhitney.com)

**Il Hee Bahn** of Lee&Ko IP, Seoul, South Korea [ilhee.bahn@leekoip.com](mailto:ilhee.bahn@leekoip.com)

**Ying Ji** of GSK, Beijing, China [ying.yji@gsk.com](mailto:ying.yji@gsk.com)

**Lucy Nicols** [Lucille.x.nichols@gsk.com](mailto:Lucille.x.nichols@gsk.com), **Lale Kemal** [lale.x.kemal@gsk.com](mailto:lale.x.kemal@gsk.com) and **Mireille Giesen-Onclin** [Mireille.a.giesen-onclin@gsk.com](mailto:Mireille.a.giesen-onclin@gsk.com) all of GSK, Brentford, Middlesex, UK

**Charles Atkinson** of GSK, Philadelphia, USA [Charles.m.atkinson@gsk.com](mailto:Charles.m.atkinson@gsk.com)

**Marcelo Goyanes** of Murta Goyanes Advogados, Rio de Janeiro, Brazil [marcelo.goyanes@murtagoyanes.com.br](mailto:marcelo.goyanes@murtagoyanes.com.br)

**Barbara Gilson** of Markides, Markides & Co. LLC, Nicosia, Cyprus [info@markides.com.cy](mailto:info@markides.com.cy)

**Roseline Okpete** of Allan & Ogunkeye, Lagos, Nigeria [admin@allanogunkeye.com](mailto:admin@allanogunkeye.com)

**Vladimir Trey** [treyv@gorodissky.ru](mailto:treyv@gorodissky.ru) and **Evgeny Alexandrov** [alexandrove@gorodissky.ru](mailto:alexandrove@gorodissky.ru) both of Gorodissky & Partners, Moscow, Russia

**Laurene Fassler** of Biofarma, Suresnes, France [laurene.fassler@servier.com](mailto:laurene.fassler@servier.com)

**Viktor Lisovenko** of Patentica, Saint Petersburg, Russia [victor.lisovenko@patentica.com](mailto:victor.lisovenko@patentica.com)

**Gonzalo Diaz Sacco** of Zacarias & Fernandez, Asunción, Paraguay [g.diaz@zafer.com.py](mailto:g.diaz@zafer.com.py)

**Elisabetta D'Amore** of Societa Italiana Brevetti S.p.A., Florence, Italy [Firenze@sib.it](mailto:Firenze@sib.it)

**David Rose** of King & Wood Mallesons, London, UK [david.rose@eu.kwm.com](mailto:david.rose@eu.kwm.com)

**Robert Litowitz** of Kelly IP LLP, Washington, DC, USA [rob.litowitz@kellyip.com](mailto:rob.litowitz@kellyip.com)

**Lin Jinchu** of King & Wood Mallesons, Beijing, China [linjinchu@cn.kwm.com](mailto:linjinchu@cn.kwm.com)

**Agustin Mayer** of Ferrere, Montevideo, Uruguay [amayer@ferrere.com](mailto:amayer@ferrere.com)

**Ryan Hickey** of Corsearch, London, UK [ryan.hickey@wolterskluwer.com](mailto:ryan.hickey@wolterskluwer.com)

**Charlotte Stirling** of J.A. Kemp, London, UK [cstirling@jakemp.com](mailto:cstirling@jakemp.com)

**Dannika Samuel** of Norgine Limited, Harefield, Middlesex, UK [dsamuel@norgine.com](mailto:dsamuel@norgine.com)

**Kate Giannini** of Cerberus Investigations Limited, London, UK [kate@cerberusip.com](mailto:kate@cerberusip.com)

**Dale Carter** of Rouse IP Limited, London, UK [carter\\_dale@me.com](mailto:carter_dale@me.com)

**Claire Palmer** of MBM Intellectual Property Law, Ottawa, Canada [cpalmer@mbm.com](mailto:cpalmer@mbm.com)

**Natalie Ellerby** of Linklaters LLP, London, UK [natalie.ellerby@linklaters.com](mailto:natalie.ellerby@linklaters.com)

## Moves and Mergers

**Thomas Tresper** has left Merck KGaA to establish his own firm, Tresper Rechtsanwalt, in Darmstadt, Germany. Thomas can now be contacted at [ttresper@tresper.de](mailto:ttresper@tresper.de)

**Thorbjorn Swanstrom** has left Awapatent to join Chas. Hude A/S in Copenhagen, Denmark. Thorbjorn can be contacted at [ts@chashude.com](mailto:ts@chashude.com)

**Cecilia Tholse Rogmark** has left Setterwalls to join Advokatbyran Gulliksson AB in Lund, Sweden. Cecilia can be contacted at [ctr@gulliksson.se](mailto:ctr@gulliksson.se)

**Barbara Müller** has left Meyerlustenberger Lachenal to join Wild Schnyder AG in Zurich, Switzerland. Barbara can be contacted at [Mueller@wildschnyder.ch](mailto:Mueller@wildschnyder.ch)

**Tina Rees-Pedlar** has left Marks & Clerk to join Bryers LLP in Bath, UK. Tina can be contacted at [treespedlar@bryerlaw.com](mailto:treespedlar@bryerlaw.com)

**Mariia Koval** has left Nevinpat-Ukraine to join Ilyashev & Partners in Kiev, Ukraine. Mariia can be contacted at [koval@attorneys.ua](mailto:koval@attorneys.ua)

**Ulla Wennermark** has left OHIM after 10 years at the Boards of Appeal to establish her own firm, Wennermark Law Firm AB, in Gothenburg, Sweden. Ulla can be contacted at [ulla@wennermark.eu](mailto:ulla@wennermark.eu)

**Bob Boad** has left Joshi & Welch to join Marlow IP Recruitment Ltd in Harrogate, Yorkshire, UK. Bob can be contacted at [bob@marlowiprecruit.com](mailto:bob@marlowiprecruit.com)

**Boudewijn van Vondelen** has left NautaDutilh to join Knijff Trademark Attorneys in Weesp, Netherlands. Boudewijn can now be contacted at [b.vanvondelen@knijff.com](mailto:b.vanvondelen@knijff.com).

Please note that the email address for **Sylvain Rousseau** of IPSO S.r.l. has changed to [rousseau@ipsoitaly.com](mailto:rousseau@ipsoitaly.com)

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

**Lesley Edwards**  
PTMG Secretary



# PTMG 92nd Conference - March 14th - 15th 2016

## Pharmaceutical Trade Marks on a London Stage

Kathy Wright, Astellas Pharma Europe Ltd.

Back in London for the 2nd time in two years, the prestigious Savoy Hotel was the meeting point for PTMG Spring 2016.

As delegates old and new entered the auspicious Ballroom for the opening of the conference our Chairman's remarks were delightful and lighthearted with a reiteration of continuing to keep the conference intimate. The conference continues to prove very popular and, attracting high levels of attention, can become oversubscribed. Frank Meixner has quickly settled into his role and we can be confident that his guidance at the forefront of the organisation will be nothing but promising.

Professor Dinwoodie, Oxford University kicked off the conference with the Keynote presentation on the topic of Territoriality in European Trade Mark Law.



**Graeme Dinwoodie**

With his fluid and witty style the professor was able to - using various trade mark cases to emphasis his points - show how territoriality is still very much practiced within the EU in spite of the

fact that this practice should well be on the wane.

The unitary nature of the EUTMR (the CTM name changed on 23rd March 2016) has been used as model to other foreign regions, eg the Eurasian Customs Union (Russia-Belarus-Kazakhstan) or the Trans-Tasman (Australia/New Zealand) and even the African Unions (OAPI/ARIPO) to name a few. However, Lusophone marks for Portugese speaking countries was generally unheard of by the audience.

In spite of these unitary type trade mark systems individual country trade mark disputes were, under their own national trade mark laws, seen to be superseding this unitary nature and pulling towards territoriality in the decisions that would eventually be handed down.

The continued social changes within the EU therefore makes this territorial pull relatively outdated with the professor emphasising and highlighting that the higher decisions in favour of trade marks that are used only in one territory should not necessarily be dictated to the rest of

the region.

Next up was Laura Scott of William Fry who brought us the International Case round-up. Personally, it felt like there was not as many pharmaceutical cases as



**Laura Scott**

would have been preferred but of the cases highlighted was the case of acquired distinctiveness in the KIT KAT™ 4-fingered bar. Many in the UK would consider this iconic chocolate bar to be highly distinctive but in the eyes of the law, under the ruling of Arnold J to be precise, the trade mark proprietor has not been able to prove this is so. Another interesting case was the so called David & Goliath court of appeal action between Fox TV of America and the Glee Club (UK) regarding use of the trade mark name GLEE. The 'David' in this case, the Glee Club, had already won a trade mark infringement case two years' prior and has just won the appeal filed against them by 'Goliath', Fox TV. Cases from Australia, Canada, Japan and the US rounded out this always welcome item on the agenda.

This reporter had to miss the cocktail reception due to her son's milestone celebration of 13 years on this earth and therefore can only rely on the reports heard the following morning in which the following phrases were used, eg: 'excellent dinner'; 'lovely vegetarian option'; 'amazing atmosphere'; 'the bar' and '2 in the morning!' and of course, 'Paris, Spring 2017' - ahhh!

The new day brought fresh presentations and the first one was a firm favourite by David Gilat of Gilat, Bareket & Co. It opened with a video showing well known brands that were being used in a supposed non-trade mark manner which immediately captured and held the audience's attention. Fittingly titled "Brand



**David Gilat**

Infringement without Actual Trade Mark Use" this was all about the well known NESPRESSO™ television advertisements using George Clooney as their star and a little known Israeli company's - Espresso Club - send up of the ad whilst trying to promote their own coffee maker.

David's clever opening video generated a message of what brand can mean. Brands/TM's are a means of communication between the market and the end user; bridging a gap between the two whilst playing on emotions using a myriad of promises, assurances and messages. In this new possible landmark case is there actual trade mark infringement where the trade mark (NESPRESSO) has not been used? The implication is there and the entire Israeli ad alludes to the NESPRESSO ad but is it classic trade mark infringement or infringement based on the Gestalt principle, where one might be seen to be trespassing on the brand in a broader sense, the goodwill generated from the brand. David concluded that under this Gestalt principle there is infringement, however what will the law decide? Watch this space ...

Terry Dixon of GSK brought alive all that encompasses the transition of a prescription only product to the OTC (over the counter) world. From the industry perspective the question of rebranding or revival of a brand is a subject that has to commonly be considered. If we think of SNICKERS (formerly Marathon), or STARBURST (Opal fruits) - firm favourites on the UK sweet market - the brand owners would have had to consider the equity in the old brands and then move forward, or not, with the need to reinvigorate the equity.



**Terry Dixon**

Of course, this journey would not be without its trade mark challenges: clearance, finding an adequate global brand with the required coverage and the challenges from pre-existing 3rd party rights. These challenges in themselves opened the door to unique collaborative opportunities for web designers,

campaigns & slogans. All of this giving a sense of excitement and freshness for the brand. Terry did mention a few negatives, infringements and the almost obligatory online problems from China.

Terry also spoke about the allergy medicine FLONASE™ that has a similar success story to ALLI. Its life cycle has expanded into the paediatric market with advertising to match including a licensing arrangement with the Weather Channel™ in the US.

“Are IP Courts in the EU unified?” That’s the question that Rob Jacob of Stephenson Harwood was jointly asking with Ian



**Ian Hiscock**

Hiscock of Novartis after the morning coffee break. Presented in a court-case style where each presented their arguments to the Judge (the delegates) Ian provided Applicant’s arguments

from a patent perspective. Very informative, the Applicant succeeded in showing how much more the so called Unified Patent Court still needed to instil confidence in its abilities. It was felt that there was no harmony within the Patent world of IP, no unification within the EU. There was a call for more engagement with the Commissioner on IPR enforcement and that case-law needed more consistency.

Similar arguments were presented by Rob for the Opponent. It was felt that there was a lot of conflict in the trade mark world: national laws v the Directive; inconsistent case law decisions; conflicting unregistered rights provisions; conflicting procedure –

judges, timings, costs, evidence – the overarching effect was that there was, again, no harmony within the Trade Mark world of IP. Very similar to the Applicant’s arguments



**Rob Jacob**

there was a call for more harmonisation with regard to unregistered rights, quicker guidance from the CJEU and procedural harmonisation.

Simmons & Simmons, in the guise of Frédérique Potin, brought the

technological aspect to the Conference. Wherever we turn it is technology that is driving everything and it is well that Pharma gets on board. However technology in the pharma world can bring its own regulatory and branding challenges especially for applications (apps) or for web-based platforms.



**Frédérique Potin**

- e-health - health resources and healthcare are managed by electronic means;
- m-health - made up of the world of immaterial objects, the internet of things and connected devices;
- quantified self - practices that enable individuals to measure and compare info relating to life habits such as diet, age, physical activity, quality of sleep
- 3-d printing - reproduction of objects by binding successive layers of material.

The first 3-d printed tablet SPRITAM™ was authorised by the FDA in August 2015 and is adapted to the patient (for use in epilepsy). Frédérique spoke about two other drugs, one that can be ingested and then vital information gathered from the patient by using the means mentioned above and the other that records information that is linked to the patient’s pharmacy. How are these technological advances qualified from a trade mark perspective - are they medical devices or are they manufactured items for medical purpose or even software? Data protection needs to be considered, consents need to be obtained. There is a public interest yet security measures need to be implemented to avoid unauthorised access. There is no doubt: the pharmaceutical world is evolving towards personalised care which brings exciting yet challenging change to the soft IP aspect of it all.

How does one enforce a non-existing trade mark? Split between the US and Germany delegates were first enlightened by Jeffrey Gitchel of Bayer who spoke to the case in the US of the trade mark FLANAX™ which was registered in Mexico by Bayer. 3rd party Belmora owned the trade mark rights in the US. Belmora relied on confusingly similar marketing tactics and traded on the goodwill of the Mexican product (owned by Bayer) to rely on promotion for their US product. Although Bayer did not own a US trade mark they were able to get the

Belmora trade mark cancelled on the grounds that their Mexican mark was being misrepresented in the US. Unfortunately this decision was overturned by the US District Court and the US trade mark re-instated. The owner of a foreign mark cannot use the rights in that mark to assert priority rights over a mark that is registered in the US. This case is ongoing as the District Court’s decision is being appealed by Bayer.



**Jeffrey Gitchel**

The German part of the question was adequately answered by Morten Petersenn of Hogan Lovells. Morten spoke of the Hard Rock Café, Germany and the Hard Rock Café, London. The German establishment had started life a few years prior to the larger well known global London chain.

Using an identical name and a similar type logo it was found that although they had been established prior to the London global chain it had not made much



**Morten Petersenn**

attempt to differentiate between the two brands thus duping customers into believing that when in Heidelberg they were having an experience based on that of the well-known chain. Unfair competition was considered. This protects competitors and consumers and trade mark owners can use this law to sue 3rd parties where appropriate. The conclusion of the Supreme Court of Germany was that there was a definite intent on the part of the German entity to mislead consumers. After five years the Heidelberg entity will be asked to pay damages to the trade mark owners in a well won victory.

On that victorious note, our gracious Chariman then eloquently summarised the Conference, praising the venue, the organisers and bidding everyone ‘adieu’ with a nod to Oslo in Autumn 2016. Well done PTMG! Onward and upward.



# Designs: a lesson in the protection of designs and specifically, shapes

Clare Jackman, Norton Rose Fulbright LLP

## PMS v Magmatic “Trunki”

On 9 March 2016 the UK Supreme Court handed down its judgment in an appeal concerning the alleged infringement of Magmatic’s Community Registered Design (RCD) for a ride-on suitcase, known in the market as the “Trunki”.

The Supreme Court dismissed Magmatic’s appeal against the Court of Appeal’s earlier decision which found that PMS’ allegedly infringing “Kiddee” ride-on suitcase did not in fact infringe the RCD. It further held that the Court of Appeal was justified in overturning the original decision of Arnold J in the High Court, which had found in Magmatic’s favour, since the judge had misdirected himself and made errors in his approach to the issue of infringement. Ultimately, the Kiddee suitcase creates a different overall impression on the informed user and for that reason, the Kiddee did not infringe the Trunki. Finally, the Supreme Court held that there were no points of EU law requiring reference to the CJEU. This case solely concerned the interpretation of particular images of a particular RCD.

The RCD in question was represented by a number of greyscale computer aided design (CAD) images of a Trunki. The products’ shape and contours were represented by different shades of grey. The wheels, the strap and a central rubber seal were shown in a contrasting colour.



Two images of the Trunki RCD (above) and of two Kiddee cases (below).



The judgment was hotly anticipated since clarification was badly needed as to how a court should interpret computer generated design drawings used for registered design representations. Was the RCD in respect of the shape of the Trunki

alone? Or was it for the shape of the article, but with a positive absence of surface decoration, since none was shown on the drawings? And what was the effect of showing the wheels, strap and a central rubber seal in a contrasting colour? While the Supreme Court has given some guidance, it did not rule on whether the RCD in question was one which included, as a feature, a positive absence of surface decoration.

In the High Court, Arnold J had decided that the RCD was for shape alone and therefore the colours and surface decoration of the Kiddee case should be ignored. He also found that Trunki was a truly novel design when it was created and therefore enjoyed a commensurately wide scope of protection. Arnold J concluded that the Kiddee case produced the same overall impression as the Trunki and therefore infringed.

The Court of Appeal found errors of principle in Arnold J’s decision which the Supreme Court reiterated as follows: (1) the judge failed to give proper weight to the overall impression of the RCD as one which evoked an animal with horns (2) that he failed to take into account the effect of the lack of ornamentation on the surface of the RCD and (3) that the colour contrast between the body and the wheels etc. had been ignored.

The Supreme Court agreed with Court of Appeal’s application of the law and it’s criticisms of the decision of the High Court. On the first issue, the Supreme Court concluded that the horns are a significant element of the RCD. On the second, the Court has left the arena open to debate somewhat and whilst it did not conclude that the absence of ornamentation was a feature of the RCD, it did agree with the Court of Appeal that it would be wrong to eliminate the decoration on the accused design entirely “because it significantly affects how the shape itself strikes the eye, and the overall impression it gives”. On the third point, the Court of Appeal was right to conclude that the RCD claimed not merely a specific shape, but a shape in two contrasting colours. The Kiddee case wheels notably had the same colour wheels as the body of the suitcase.

As the Court of Appeal had correctly applied the law, the Supreme Court

refrained from interfering with its decision of non-infringement, having assessed that the Kiddee case did not give a different overall impression from the RCD.

## Comment:

The effect of the finding that the representations of Magmatic’s design were not just for shape alone, meant that that the court could not assess the Kiddee case a mere shape, devoid of any surface decoration (as per *Procter & Gamble v Reckitt Benckiser*).

The Supreme Court made obiter comments along the lines that the positive absence of surface decoration could be a positive feature of a design, as in the case of the “cooler than Samsung” Apple tablet computer design in *Samsung v Apple*.

It is notable that in both those earlier cases, the design representations comprise simple line drawings.

How design representations are interpreted, which in turn defines the scope of protection, means that designers will need to take great care when applying for protection for designs in future. Attention is required to ensure that the broadest protection is achieved for a design as a whole and also for any features of that design with individual character. We will likely see designers filing a number of applications to protect individual products in future, in preference to relying on just one. Unfortunately, for those who have already registered their designs using CAD images rather than simple line drawings, they may find that they do not in fact enjoy the scope of protection over the simple shape of their product that they might have presumed at the time of filing. Another concern in reaction to the judgment is that copycats may be able to escape infringement by adding distracting details on a similar shaped product to give a different overall impression

It is clear that when seeking to obtain protection for shapes of products and shape alone, the broadest design protection is achieved by simple line drawings showing the contours of the design. CAD images may have the unfortunate effect of narrowing the scope of protection given that a sense of surface texture and material can be conveyed via these media.

# Turkey Merges Previous IP Related Decree-Laws into a Single Code

Güldeniz Doğan Alkan, Gün + Partners

The Turkish Patent Institute (TPI) shared the new Draft Industrial Property Code (the Draft Code) with the public at the end of February, collected remarks of the relevant stakeholders on it and the Draft Code has been sent onto the Parliament recently.

The Draft Code was introduced to the Turkish domestic law on 24 February 2016. The TPI shared it and allowed the stakeholders to convey their opinions within ten days. The period of consultation finished on 4 March 2016, there have been a few changes to the draft after this stage and very recently the Draft Code has been transmitted to the Parliament. It is expected that it will come into force within 2016.

Twenty years ago, Turkey was in the process of becoming a part of the Customs Union and one of its liabilities was to adapt its national IP law with EU legislation. For that purpose, Turkey rapidly constituted Decree Laws relating to IP rights in 1995. Decree Laws were preferred since they require less procedure and can be brought into force faster and they have also the power of law. Normally, they should have been transformed into laws when the urgency lifted, but they never did and even today, they still remain in force as Decree Laws. In Turkish Constitutional Law practice, decree laws have always been a questionable subject. According to Article 91 of the Turkish Constitution, property rights cannot be regulated by decree laws and should instead be regulated by a code constituted by the Parliament. The Turkish Constitutional Court revoked some provisions of the IP Decree Laws which regulate property rights by taking into consideration Article 91 of the Turkish Constitution. In the presence of cancellation decisions, the Parliament integrated cancelled provisions into the present Decree Laws rather than repealing them and bringing into force new laws related to IP rights.

The Draft Code unites all kind of industrial property rights, namely trade marks, designs, patents and geographical indications. In the general preamble of the Draft Code, it is stated that it was prepared to achieve following aims:

- To comply with recent developments in EU IP Law;
- To bypass the cancellation decisions of the Turkish Constitutional Court;
- To ensure the current regulations are clearer, more understandable and systematic.

The Draft Code contains five chapters and

approximately 200 provisions. Most of the provisions in the current Decree Laws are inserted into it and revisions are made in line with the latest Draft Law numbered 1/756 which has thus become caduceus. This article aims to provide information to the readers regarding the amendments foreseen in the Turkish trade mark law. Firstly, the name of the Draft Code is “the Draft Industrial Property Code” and compatibly with its name, it uses the term industrial property. We believe that the term intellectual property is more thorough and also in line with international texts, but the draft has been transferred to the Parliament as Industrial Property Code.

Currently, the TPI makes preliminary examination on trade mark applications ex-officio when a trade mark application is filed and rejects the application if it is in the scope of one of the absolute grounds for refusal. Article 7/1(b) of the Decree Law numbered 556 Pertaining to the Protection on trade marks is one of the absolute grounds of refusal and it prevents registration of trade marks which are identical or indistinguishably similar with an earlier dated trade mark/trade mark application. Such provision does not exist in many other jurisdictions and in the jurisdictions where it exists, this obstacle is lifted by submitting letters of consent or co-existence agreements. Yet Turkish Trade mark Law does not foresee such a solution and the present ex officio refusal authority of the TPI blocked the registration of many foreign trade marks. The draft code at last enables the implementation of the co-existence principle and removes the ex officio refusal authority of the TPI if a notarised letter of consent from the senior trade mark owner is submitted to the Institute. Even though such ex officio refusal is not totally excluded, it is still a positive amendment.

Another important amendment is foreseen in the opposition proceedings. Accordingly, if a trade mark application has been filed and the trade mark shown as ground for opposition has been registered in Turkey at least five years before the filling date of the application, the TPI will demand evidence from the opponent party to show genuine use of the trade mark in Turkey or justified reasons for non-use. If the opponent party cannot submit evidence to prove the genuine use in Turkey, the opposition will be refused. Accordingly, the TPI may refuse an opposition if the use of the ground trade mark in Turkey cannot be proven. It is also regulated that this request can be used as a defense in an infringement action. If a trade mark has not been used without

justifiable reason for the goods or services within the scope of the registration within five years following the publication of registration, or its usage has been suspended for an uninterrupted period of five years, the right to repeal a trade mark due to non-use belongs to the competent court. As a result of the opinions of the stakeholders, this right is given to the TPI with a provision added to the draft; however, the enforcement date of this provision will be postponed for seven years with a provisional article in the Code.

Other minor amendments are that the terminology for signs to be registered as trade marks was changed to “A trade mark, provided that it is capable of distinguishing the goods and services of one undertaking from the goods and services of other undertakings and can be shown in the Registry ensuring that the subject of the protection provided to the trade mark owner is clearly and explicitly understandable, may consist of all kinds of signs such as words, including personal names, designs, colors, letters, numerals, sounds and shape of the goods or their packaging”. The protection of well-known trade marks in the meaning of Paris Convention has been regulated as a relative opposition and invalidation ground. This is one of the regulations cancelled by the Turkish Constitutional Court recently. Bad faith claim is foreseen as a separate opposition and invalidation ground and a sign which contains geographical indication cannot be registered as a trade mark.

Regarding durations, the opposition period has been shortened to two months from three months and the five-year term for filing a cancellation action has been regulated within a separate provision. A trade mark/patent/design right holder cannot allege its registered right as a defense in an infringement action filed by a priority right holder. Consequently, having a registration does not naturally mean that there is no infringement. In the first version of the Draft Code, the principle of exhaustion of trade mark rights was limited to the products released within Turkey. Accordingly, national exhaustion principle was accepted. However, upon receiving opinions of the stakeholders, the relevant article was amended and an international exhaustion principle was inserted in the draft before being sent to the Parliament.

The Draft Code is now before the Parliament and is expected to be voted within the next few months. Once it enters into force it will greatly influence and change the Turkish IP Law practice.

# PROFILE: Susan J. Keri

Susan J. Keri is a barrister, solicitor, registered trademark agent and partner with Bereskin & Parr LLP. She has practiced exclusively in the area of trademark law since her call to the Ontario Bar in 1986. Susan's practice extends to all areas of trademark law, and mostly relates to the protection and management of large trademark portfolios for multi-national corporations in all industry sectors, with particular expertise in the pharmaceutical field. Susan is a frequent speaker on trademark law at various national and international organizations and has written extensively in various publications and contributed the Canadian chapter on Pharmaceutical Trademarks in the World Trademark Review Global Guide for the past several years.

Susan is an active member of numerous organizations involved in trademark law and practice including the Intellectual Property Institute of Canada (IPIC), Intellectual Property Owners Association (IPO), Pharmaceutical Trademark Group and the Canadian Bar Association. She is also a member of the International Trademark Association and currently serves as an editor on the Trademark Reporter Committee.

Susan is fluent in the Hungarian language and has a sound working knowledge of French.



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

I was born and raised in Canada (Montreal and Toronto), and graduated from the University of Toronto with a Bachelor of Arts degree in International Politics, and from Queen's University with a degree in law. Both of my parents, however, came to Canada from Hungary just before I was born and, as a result, I had a very traditional European upbringing. In fact, Hungarian is my mother tongue. Typical of many first generation Canadians, I feel as connected to my Hungarian/European roots as I do to my Canadian nationality.

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

Trade mark law was not taught when I attended law school, and was very much a "niche" speciality at that time. It was precisely because of its "niche" status, and also its growing global relevance, that I was drawn to the field, and was fortunate to have been offered a trade mark associate position in an international law firm after completing my articling year. Much of my practice involved the protection and management of large trade mark portfolios for many national and international companies, which made for a very challenging and exciting start to my legal career, and I have practised exclusively in the field of trade mark law ever since.

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

If I had the luxury of choice, I would probably have worked at an animal sanctuary somewhere in Africa.

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

Meticulous, perceptive, epicurean.

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

Literature and languages. I particularly loved studying languages - it's the key to understanding a culture.

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

I spend quality time with friends and family, try to take long walks with my dogs, cook good food and enjoy nice wines.

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

The incredible people I have met along the way from all over the globe, many of whom have become my dearest friends.

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

Las Meninas by Diego Velázquez. I first saw this painting as a young girl with my family when we visited the del Prado museum in Madrid, and am mesmerized by it to this day.

## **What is a common misperception of you?**

Some people see me as being reserved or even distant, when in fact, I am really quite shy.

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

The best age to be is the age that you are now. We need to live in the present – not the past or the future.

## **What is your philosophy in a nutshell?**

Everything in the world is replaceable - except people. Take time to appreciate the people you love.

## **What is your weakness?**

Dogs!

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

I just completed Fifteen Dogs by André Alexis, winner of the Giller Prize – the most prestigious Canadian literary award. It's a very insightful and original piece of literature - more about human behaviour than dogs.

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

Charlotte's Web by the American author E.B. White. I've since had trouble eating pigs and never step on spiders.

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

Vivaldi's Four Seasons.  
**What is comfort eating for you?**  
Some of the Hungarian foods my grandmother would make, like chicken paprika with nokedli (known as spätzle in German), and palacsinta (those wonderfully thin, sweet, cheese filled, crepes).

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

A very dry vodka martini, with extra olives.

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

Southern Spain is near and dear to my heart, having spent many summers there with my family. I also love to eat and drink my way through Tuscany.

## **Where do you see yourself in 10 years' time?**

Exactly the same place I am now!

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

Printing. I am ashamed to say it, but I really do prefer to read from paper.

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Editor: Vanessa Parker

Tel.: +33 679 316 860 email: vparkercordier@wanadoo.fr