Law Lore & Practice

PTMG Pharmaceutical Trade Marks Group

May 2015

Editorial: The joy of languages

Once again, attendance at the 90th PTMG Conference was the opportunity to exchange with delegates from very many countries, all expressing themselves in the English language. The level of English spoken during the sessions but also during the social functions is witness to the necessity we all have to share a common language to facilitate both professional and personal contact. However, international conferences are also the moment when you find yourself surrounded by conversations taking place in every language.

Secretly, for some, it is an occasion to try out some schoolboy (or schoolgirl!) foreign language and Venice for me was a chance to wind the clock back more years than I care to count to the days when I crammed an Italian subsidiary course at London University. It is immensely rewarding but also a little frustrating, to hear a learnt language, albeit it within a limited context such as a hotel or a restaurant and feel that, if only one could spend a little longer in the country, all that learning would come rushing back.

Trade mark law is of course anchored in a deep understanding of languages. One would be foolhardy to imagine that a perfunctory knowledge of four or five European languages could suffice to provide in-depth advice regarding the risks and perils of adopting a particular term as a brand name, particularly in the pharmaceutical industry. Nevertheless, a love of languages and a desire to better understand their relationship to each other, whether these are European or otherwise, has always seemed to me a prerequisite for a happy professional life in so-called soft intellectual property.

Against this background and the ever distant dream of European integration, the French Education minister announced recently that as of 2016 all secondary school pupils will now only be taught English in their first year of study, with the possibility of adding another European language the following year but only if said second language has been previously offered in the corresponding primary school. Critics are up in arms claiming that these amendments to the current system will ultimately end the teaching of any foreign language other than Spanish and German whilst almost immediately sounding the death-knoll for ancient languages such as Latin and Greek.

As a native English speaker, I applaud all attempts to enhance the teaching of English within the French school system but fear that any tinkering of the curriculum will bring about few improvements if class sizes remain high and resources remain low. After all, teaching any language in the classroom can be a thankless task. Thinking back, I doubt very much that my French teacher, who was a self-confessed frustrated Spanish opera singer, would ever have guessed that one of his tongue-tied pupils in 4th form would find so much pleasure from analysing words in all languages as her future career.

Therein of course lies our challenge for the future: encouraging youngsters to embrace the learning of languages by whatever means is surely the key to offering them a more harmonized future based on improved communication skills and a greater understanding of each other.

Vanessa

Obituary: David Butler, GSK

Eulogy read at the close of Day 1 of the 90th PTMG Conference in Venice.

Despite the scale of the pharmaceutical industry, its trade mark community has always been a close-knit one, and that goes right back to the days when this group, the PTMG, was founded. So it's all the more keenly felt when one of its members passes away, especially when that happens long before time. Sophie has asked me to say a few words in memory of David Butler of Glaxo Smithkline whose sudden death at the age of 41 last month came as an enormous shock to all those who knew him. David was, of course, a frequent attendee and past speaker at the PTMG, as well as a colleague, client and friend of many of us here.

David was a UK pharma industry stalwart of nearly 20 years, almost the whole of his career - quite a rare thing in these days of frequent job-hopping. He joined SmithKline Beecham back in 1996 after completing his solicitor's training and stayed on with the company following the merger with Glaxo Wellcome a few years later. After that, he rose to become one of the lead trade mark attorneys in what developed into a multi-national department at GSK spanning three different continents and looking after an ever increasing number and diversity of brands.

For many, David was first and foremost GSK's anti-counterfeiting guru. He combined a real passion for the cause with a sense of adventure that took him all over the world - most recently to China where he had been based for the past 2 years. He certainly couldn't have got much closer to the centre of the counterfeiting world.

For those who worked with him, David was always interested and engaged, taking the time to explain things clearly, and also not shy of getting involved in the hurly burly of the action. An English colleague who worked with David over the last year in China said to me: "David was one of life's good guys. Smart, positive, fair, kind, honest, understanding and always a pleasure to work and socialise with".

I can't think of a better way to sum him up. David will be sorely missed, both now and for a long time to come. I am sure that the deepest condolences from all of us here at PTMG go out to David's wife Deborah and his two young daughters.

Rupert Ross-Macdonald, Rouse

Words from the Chair

Those who were lucky enough to be attending the PTMG Conference in Venice will already know that it was my last Conference as Chair of the PTMG. It has been a fantastic experience for me to be leading this unique organisation and I had a great time getting to know many of you better. I am really thrilled we have been able to change the fees structure for our Conferences, to make them more attractive for our Industry members and I am sure everyone would agree that the excellent attendance level from the Pharmaceutical companies in the last few years is a great outcome for all of us. It has been nice to see the organisation evolving, while keeping with its nice traditions.

I hope we have been able in the last three years to share with you some interesting topics and that we have provided you with interesting food for thought. The Committee will continue to work hard to come up with relevant topics and excellent speakers at forthcoming conferences.
Furthermore, I am convinced that our new Chair, Frank Meixner, will do a great job guiding the organisation. I wish him all the very best.

I look forward to seeing many of you at our next Conference in Warsaw. In the meantime, I wish you a nice, relaxing and refreshing summer.

Sophie Bodet

Bio: Similar Trade Marks? Novartis AG v OHIM

Thomas Hannah, GSK

On 10 December last year, the General Court of the CJEU issued its decision on a long-running trade mark dispute between Novartis AG and a UK company, Dr Organic Ltd.

The dispute began in April 2009 with an opposition by Novartis against Dr Organic's CTM application for BIOCERT in Class 5 on the basis of Novartis' earlier Austrian registration for BIOCEF, also in Class 5, which dated from 1991 and is in use as an oral cephalosporin antibiotic.

By a decision of April 2010, OHIM dismissed the opposition in its entirety. It was of the view that the relevant public would be able to distinguish between the signs at issue due to the elements cef and cert. This verdict was appealed by Novartis and the Fourth Board of Appeal of OHIM issued its decision in September 2011. In this, it supported the original decision primarily on the basis that both marks contain the element bio but that this is a common abbreviation for biological in German. Accordingly, the relevant public would pay less attention to this descriptive element and focus their attention on the suffixes of the signs, thereby being aware of the differences between them.

Novartis was not satisfied and appealed against OHIM to the General Court. It argued that OHIM had incorrectly assessed: (1) the level of attention of the relevant public; (2) the similarity between the signs; and (3) the likelihood of confusion.

Level of attention of the relevant public

It is well established (and not disputed in this case) that the relevant public is professionals from the medical and pharmaceutical fields and general end consumers. The Board of Appeal had found that this public would pay an enhanced degree of attention to the signs at issue since the use of those products affects health. Novartis argued that this level of attention should be reduced given that BIOCEF is often sold without prescription in drugstores and supermarkets and also on the internet or by phone; an environment, it submitted, that would cause the consumer to be distracted and therefore pay less attention.

The General Court disagreed: the lack of a prescription and/or use of the internet did not mean the consumer's attention would be lowered. They would still be equally concerned as to the drug they were purchasing. It was not necessarily put forward, but it could conceivably be argued that consumers would pay more attention when purchasing in these channels, as they would not have the safety net of an expert's prescription to rely on. It is well established in case law that consumers have a heightened degree of attention to some extent when purchasing pharmaceutical products, but it is interesting to see the General Court maintaining this stance even in light of very particular and modern channels.

Similarity between the signs

While the General Court agreed that the bio elements of the signs were of weak distinctive character, it departed from the Board of Appeal by stating that they should still be taken into consideration. Indeed, given that the marks share the first five letters, it stated that visually there should be an average degree of similarity despite the differences in the endings. The same applied phonetically, regardless of particular Austrian pronunciation evidence to the contrary. Conceptually, there was held to be a certain degree of similarity. These were all contrary to the Board of Appeal's findings, which considered the similarity to be lower in each instance.

Likelihood of confusion

The goods in question were held to be identical or similar and so this could offset to some extent a lower degree of similarity between the signs (T-81/03 Mast-Jägermeister v OHIM). This, combined with the importance of considering the overall impression as highlighted in point 2 above, meant that the General Court was able to find a likelihood of confusion between the marks at issue, "even if the public has a heightened level of attention".

Conclusion

OHIM's decision was accordingly annulled in Novartis' favour and OHIM was ordered to pay costs. This is an interesting decision in the sense that the General Court is insisting that due attention should still be paid to very descriptive elements of marks. This does seem to be a sensible position given the importance of overall impression, and the judgment presents interesting analysis of how to approach such weak descriptive elements and also the level of attention paid by the average consumer to pharmaceutical products in the modern age.

Major Changes to Canadian Trademark Legislation

Susan J Keri and Tamara Céline Winegust - Bereskin & Parr LLP

In June 2014, Bill C-31, the Economic Action Plan 2014 Act, No. 1, received Royal Assent. Among other things, the Bill contained significant amendments to Canada's Trademarks Act that will fundamentally change Canadian trade mark law and practice. Expected to come into force in late 2016 or 2017, the amendments also facilitate Canada's accession to the Madrid Protocol, Nice Agreement, and Singapore Treaty.

Other amendments to the Trademarks Act contained in the Combatting Counterfeit Products Act, and implemented in early 2015, created new border measures designed to provide registered trade mark owners with additional tools to stop the import and sale of counterfeits.

The following represents a brief summary of some of the most notable changes and their impact on the pharmaceutical trade mark field.

(i) No Filing Grounds; No Declarations of Use; No Registration Fees

Current applicants must claim at least one filing ground in a trade mark application—use, made known, use and registration abroad, or proposed use—and, if used, identify the date of first use. Use is of fundamental importance under the current regime. Applications based on proposed use cannot issue to registration without the filing of a Declaration of Use attesting to use of the mark in Canada with the goods and/or services. Trade mark use in Canada must be in the normal course of trade; hence, sample shipments of pharmaceuticals or use of the mark in clinical trials, will not ordinarily constitute use (a small exception may exist for unapproved drugs sold as part of Health Canada's Special Access Program). Current applicants must therefore carefully assess how the mark is used to identify proper filing grounds and avoid filing a false Declaration.

The amended Act will eliminate application filing grounds altogether. Applicants need only be using or propose to use, and be entitled to use the mark applied for. Applications will also automatically issue to registration upon expiry of the opposition period, even without use anywhere, and will not be subject to a registration fee.

Pharmaceutical products cannot be sold in Canada until the drug is approved by Health Canada, which can take years. Current practice, therefore, is to apply for a pharmaceutical trade mark and obtain extensions of time to file the Declaration of Use until the product is approved for sale in Canada.

Under the new regime, trade marks will issue to registration simply upon the expiry of the opposition period, even without use. Accordingly, trade marks covering pharmaceutical products could issue to registration long before the products are approved by Health Canada for sale here. Further, without a use requirement, trade mark applications may issue to registration for virtually all pharmaceutical products and/or services. Indeed, pharmaceutical companies with currently pending applications filed on the basis of proposed use may want to consider obtaining extensions of time to file the Declaration of Use pending the implementation of the new legislation, at which time, the application would issue to registration for all of the goods and/or services contained in the application—without any use.

The elimination of use as a prerequisite to registration will bring both advantages and new challenges for the pharmaceutical field. Overclaiming— including virtually all pharmaceutical products/services in an application— is of strategic advantage to pharmaceutical companies since such registrations, obtained without use, can conceivably block similar applications covering overlapping goods or services.

However, overclaiming is also likely to lead to additional expense and uncertainly. Without use information on the Trademarks Register, and with registrations potentially covering virtually all pharmaceuticals, marketplace investigations will become increasingly necessary (and expensive) for clearance purposes. Office actions are also anticipated to increase as examination for confusingly similar marks will be difficult with lengthy listings of goods and services, and Examiners are likely to issue more citations. More oppositions are also likely to be filed, if only to give prospective opponents time to investigate and determine whether there are prior rights on which to oppose.

Registrations will still be vulnerable to non-use cancellation beginning three years after the registration date under the amended Act. Because registrations will issue without proof of use, a pharmaceutical trade mark registration could become vulnerable to attack prior to Health Canada approval of the drug. However, the inability to market a product due to a pending regulatory approval process may be considered a special circumstance excusing non-use, permitting the registration to be maintained. Moreover, even if the registration is cancelled for non-use, a fresh application could be filed and, subject to an intervening right, a new registration would issue, without use, and be immune from a non-use cancellation attack for a further three years.

(ii) Adoption of Nice Classification for Goods and Services

Currently, trade mark applications can include any number of goods and services in a single application with no additional government filing fee. Once the amendments are implemented, however, applicants will be required to classify the goods and services in the application according to the Nice Classification system. While class fees have not yet been adopted and will be the subject of further consultation, the adoption of Nice classes will likely be accompanied by class filing fees, thereby increasing the cost of filing a multi-class application in Canada. Pharmaceutical companies wanting to cover lengthy listings of products and services may want to file these applications before the implementation of the class based system, with a view to avoiding the payment of multi-class filing fees.

(iii) New Non-Traditional Marks and Examination for Distinctiveness

The amendments expand the definition of trade mark to include many non-traditional marks such as colour, shape, as well as so-called sensory marks (smell, taste and texture). This will be useful for pharmaceutical companies wanting to protect colour and shape of pharmaceutical tablets or capsules. However, the amendments also permit the Trademarks Office to request evidence establishing the distinctiveness of the mark during examination, which is not currently permitted. Examination for distinctiveness will likely increase the cost of securing registration for non-traditional marks and accordingly, pharmaceutical companies wishing to secure registration of non-traditional marks may want to file the application before implementation of the new legislation.

continued from page 3

(iv) Renewal Term

Registrations are currently valid for renewable terms of 15 years. This will be reduced to renewable periods of 10 years by the amended Act. It is not clear yet whether renewal fees will be reduced as a corollary.

To take advantage of the longer term of protection, owners of allowed pharmaceutical trade mark applications based on proposed use should file Declarations of Use as soon as possible. However, if it is more important to secure registration for the broadest possible goods/services, not all of which may be used, a trade mark owner may wish to delay the deadline for filing a Declaration until the amendments are implemented, when the application will automatically register without use, although this will result in a shorter 10 year term of protection.

(v) New Border Measures

On 1 January, 2015, Canada implemented its Request for Assistance (RFA) border measures program—the cornerstone of the Combatting Counterfeit Products Act (CCPA). Under the program, registered trade marks can be recorded with the Canada Border Services Agency, permitting customs officials to detain suspect imported counterfeit goods bearing such marks at the border for up to ten days (five for perishable goods). During detention, the trade mark owner may be provided with samples of the goods and can request information to help to identify the source of the counterfeit products and facilitate a civil claim against the importer.

The new program complements provisions of the Customs Act, Trademarks Act, Copyright Act and Criminal Code generally governing the import and sale of counterfeit products, as well as the new criminal sanctions and an expanded definition of infringement in the Trademarks Act that came into force in December 2014 when the CCPA received Royal Assent.

While the border measures regime does not apply to grey goods, pharmaceutical preparations cannot be sold in Canada without prior Health Canada approval or without complying with Canada-specific labelling requirements. Consequently, parallel import of pharmaceutical preparations is illegal, and importers of such products would be subject to prosecution, even if not under the Trademarks Act.

International Update

Czech Republic

PETOSEVIC

As of 1 January, 2015, the Czech Republic introduced a new set of rules regulating customs measures intended to combat counterfeiting on the internal market. The new regulations are in line with the external border measures regulated by Regulation (EU) No 608/2013 of the European Parliament and Council of 12 June 2013. The new Czech regulations have introduced forms and requirements for applications for action similar to those in the EU Regulation No. 608/2013, including detailed information on genuine goods (as with Article 6(3)(g)(h)(i) of the EU Regulation No. 608/2013).

For the Czech Customs to be able to detain any suspected counterfeits within the country's borders, trade mark holders should file a separate application for the intra-border customs watch. Once such customs watch application is in place, the customs will detain the goods ex officio within the period of one year, which can be extended each year before the expiration date. Once the goods suspected of infringing IP rights are detained by the customs, a similar procedure to the one regulated on the EU level for border measures is envisaged by the intra-border customs regulations, which also includes a simplified procedure for the destruction of the goods, following the expressed or implied consent of the holder of the infringing goods. However, unlike the EU Regulation No. 608/2013, the small consignment procedure is not possible under the Czech intra-border customs watch system.

The new set of rules introducing the intra-border customs watch measures is a welcome novelty that will enable IP right holders to combat counterfeiting more effectively on the internal market in the Czech Republic. The Czech Customs are very efficient in their anti-counterfeiting actions and this new set of rules similar to the ones introduced at EU level will most likely make a strong impact on the trade with counterfeits and other infringing goods

Hungary

PETOSEVIC

On 1 January, 2015, a significant addition to the Hungarian Act 95 of 2005 on Medicinal Products for Human Use entered into force — paragraph 20/A called "Temporary inaccessibility of electronic data".

The amendment allows the National Institute for Quality and Organizational Development in Healthcare and Medicines to combat counterfeit drugs sold online faster and more effectively. Namely, the Institute can order the removal of online content on fake or prohibited medicines and require the website owner to comply with the order for up to 90 days. The website owner has to remove the content within one working day or pay a fine ranging from EUR €315 — 3,150 (USD $357-3,570). If the website owner fails to comply, the court may order that the fine be paid several times.

The authorities may report intellectual property infringement at the same time, and if the court decides to make the electronic data permanently inaccessible, this decision would override the one on temporary inaccessibility.

If the website owner does not challenge the Institute's decision on temporary inaccessibility, the names of infringing websites may be displayed on the Institute's website for up to 90 days.

Montenegro

Gordana Pavlovic and Maruska Bracic, CABINET PAVLOVIC

With its decision of 10 April 2014, WIPO Arbitration Center accepted the complaint filed by Novartis AG (Novartis) that the domain name dailies.me was registered and used in bad faith and that it should be transferred to Novartis.

.ME top level domains are very attractive and presence in Montenegro is not required for registration.

Adam Strongbow from Boston, USA registered the domain name dailies.me. The website resolved to pay-per-click (parking site) which contained links to other websites offering contact lenses of Novartis, as well as its competitors.

Novartis (which acquired Alcon) filed a complaint with WIPO Arbitration and Mediation Center which is in charge of resolving conflicts regarding .ME top-level-domain names. Novartis argued that the subject domain name is identical to its trade marks DAILIES, registered in numerous countries around the world, including Montenegro, as well as that they own and operate a website www.dailies.com.

Novartis further argued that the holder of the domain name dailies.me does not have any rights or legitimate interests to the subject domain and that this domain name was registered and used in bad faith.

The holder of the domain name, Adam Strongbow, failed to respond to Novartis' complaint. The WIPO Arbitration Center reviewed Novartis' complaint and decided to accept it, establishing that:

- the domain name is identical to Novartis' trade mark DAILIES;
- the holder of the domain name does not have rights or legitimate interests to the subject domain name, i.e., he is not known by this domain name, he is not the authorized reseller of Novartis' products and Novartis has not authorized him to use the domain name or its trade marks;
- the holder of the domain name has registered and used the domain name in bad faith; i.e., he was likely aware of Novartis' trade mark when registering the domain name and he has used the domain name to intentionally attract, for commercial gain, Internet users to his website www.dailies.me by creating a likelihood of confusion with Novartis' trade mark.

Adam Strongbow failed to challenge the above Decision of the WIPO Arbitration Center before the US Court and the domain name dailes.me was transferred to Novartis.

Phillipines

Gladys Mirandah & Jennifer Fajelagutan, Mirandah Asia - Singapore

Westmont Pharmaceutical, Inc. (Westmont) filed an opposition against the registration of the mark OMEZOLE in the name of Platinum Pharmaceuticals (PVT), Ltd. (Platinum) for use on pharmaceutical preparations for the treatment of duodenal ulcer, gastric ulcer, gastro-oesophageal reflux disease (GERD) and management of Zollinger-Ellison Syndrome. In September 2014, the Bureau of Legal Affairs of the Intellectual Property Office of the Philippines (BLA-IPOPHIL)) found the trademark OMEZOLE to be similar to the generic drug name OMEPRAZOLE and ruled that the mark was not distinctive for registration.

Westmont argued that OMEZOLE was similar to the generic drug name OMEPRAZOLE and as such could not be registered as it was in violation of Sec. 123.1 (h) and (j) of the Intellectual Property Code of the Philippines, which states that a mark cannot be registered if it:

(h) Consists exclusively of signs that are generic for the goods or services that they seek to identify;

(j) Consists exclusively of signs or indications that may serve in trade to designate the kind, quality, intended purpose, value, geographical origin, time or production of the goods or rendering of the services or other characteristics of the goods or services.

The BLA issued a Notice to Answer to Platinum, however, no response was filed.

Based on the pleadings submitted, it was observed that both terms began and ended with identical letters, namely O, M, E and Z, O, L, E. The only noted difference was the absence of the middle letters P, R and A which were removed to arrive at OMEZOLE. As such, the mark used by Platinum was found to be non-distinctive for registration as it was a mere abbreviation of OMEPRAZOLE, an official generic name identified by WHO.

In view of the substantial similarity between OMEZOLE and OMEPRAZOLE, the BLA ruled that the mark OMEZOLE lacked distinctiveness and that allowing its registration would be in violation of Sec. 121.1 of the Intellectual Property Code of the Philippines which defines a mark as any visible sign capable of distinguishing the goods (trademark) or services (service mark) of an enterprise.

The BLA further ruled that the similarities were so obvious that the purchasing public could be misled into thinking that OMEZOLE and OMEPRAZOLE are one and the same, and as such, the registration of OMEZOLE was akin to permitting the registration of the generic term OMEPRAZOLE.

Pharmaceutical companies formulating trade marks should be cautious not to take a name which is identical or similar to a generic term. Otherwise, the proposed mark will not be allowed registration for lack of distinctiveness.

Romania

Nicolae Muresan, Andra Musatescu Law & Industrial Property Offices, Bucharest

The official fees which are to be paid to the Romanian State Office for Inventions and Trademarks for the registration of industrial property rights in Romania are established in the Government Ordinance no. 41/1998 on the official fees for the protection of industrial property rights.

According to art. 4 of the said Government Ordinance, the level of official fees for the registration of the industrial property rights can be upgraded every year by a Government Ordinance according to the fluctuation of the exchange and inflation rates.

Law no. 31/2015 for suspension of the provisions of art. 4 of Government Ordinance no. 41/1998 on the official fees for the protection of industrial property rights and the use thereof was published in Official Gazette of Romania, Part 1, no. 169 dated 11 March, 2015.

The normative act suspends, until 31 December 2016, the appliance of the provisions of the Government Ordinance no 41/1998 on upgrading the official fees in lei owed by natural and legal persons in the field of industrial property protection.

Russia

PETOSEVIC

Russia has recently amended its Federal Law no. 311-FZ On customs regulations in the Russian Federation of 27 November, 2010. The new Federal Law No. 73-FZ, adopted on 6 April, 2015 will enter into force on 8 May, 2015.

The amendments concern the rules for the entrance of protected intellectual property rights into the customs register.

In the previous version of the law, the IP rights were entered into the register if the IP rights holders provided a written liability declaration that they will provide compensation for any damage suffered by the goods' declarant, owner, recipient or other specified persons due to the unjustified suspension of the goods. However, the rights holders were only entitled, but not obliged, to submit the bank insurance contract covering their liability for any property damage caused to the specified persons.

Under the new rules, the protected IP rights will be entered into the customs register only under the condition that the rights holders submit the bank insurance contact. The sum insured should amount to at least EUR €5,230 (USD $5,620).

Members News

New members

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

Giuliana Caldarera of CPA Global, Munich, Germany gcaldarera@cpaglobal.com

Michalis Christodoulou of NJQ & Associates, Amman, Jordan m.christodoulou@qumsieh.com

Fabienne Schlup of Bohest AG, Basel, Switzerland schlup@bohest.ch

Joo-Young Moon of Kim & Chang, Seoul, South Korea jymoon@ip.KimChang.com

Alex Apelbaum aapelbaum@brandinstitute.com **Nakos Balamotis** nbalamotis@brandinstitute.com and **Barry Shortt** bshortt@brandinstitute.com all of Brand Institute Inc., Miami, Florida, USA

Nurcihan Weiland of Thomson Reuters – CompuMark, Munich, Germany nurcihan.weiland@thomsonreuters.com

Giovanni Orsoni of De Simone & Partners, Rome, Italy gorsoni@desimonepartners.com

Santiago Ortuzar of Beuchat Barros & Pfenniger, Santiago, Chile sortuzar@bbp.cl

Cristina Carvalho of J. E. Dias Costa, Lisbon, Portugal Cristina.carvalho@jedc.pt

Zsofia Klauber of Sar and Partners Danubia, Budapest, Hungary zsofia.klauber@sarandpartners.hu

Alison Shurell of TrademarkNow, New York, NY, USA alison.shurell@trademarknow.com

Dirk De Cort of Corsearch, Mechelen, Belgium dirk.decort@wolterskluwer.com

Marina Smirnova of Papula-Nevinpat, Helsinki, Finland m.smirnova@papula-nevinpat.com

Jeroen Lallemand of Knijff Trademark Attorneys, Weesp, The Netherlands j.lallemand@knijff.com

Oren Weiner of Luzzatto & Luzzatto, Tel Aviv, Israel orenw@luzzatto.co.il

Gerry Tahsin of Norgine Limited, Uxbridge, Middlesex, UK gtahsin@norgine.com

Gábor Germus gabor.germus@germus.hu and **Csaba Dedinszky** csaba.dedinszky@germus.hu both of Germus & Partners, Budapest, Hungary

Gavriel Cohen of Dr. Shlomo Cohen & Co., Tel Aviv, Israel Gavriel.cohen@shlomocohen.co.il

Mark Holah of Bird & Bird, London, UK mark.holah@twobirds.com

Nein-Chin Liao of Lee and Li, Taipei, Taiwan nc@leeandli.com

Daniele Petraz of GLP Srl, Milan, Italy glp@glp.it

Disha Dewan of R K Dewan & Co., Pune, India disha@rkdewanmail.com

Dawn Richford of Lysaght & Co, St Helier, Jersey, Channel Islands dawn@lysaght.co.uk

Elise Melon of EFPIA, Brussels, Belgium elise.melon@efpia.eu

Timo Goetting of Sandoz International GmbH, Holzkirchen, Germany timo.goetting@sandoz.com

Vera Eunwoo Lee of Lee&Ko, Seoul, South Korea ewl@leeko.com

Imogen Fowler of Hogan Lovells, Alicante, Spain Imogen.fowler@hoganlovells.com

Boriana Guimberteau bguimberteau@ftpa.fr and **Antoine Gautier-Sauvagnac** agsauvagnac@ftpa.fr both of FTPA, Paris, France

Rembert Niebel of Baker & McKenzie, Frankfurt, Germany Rembert.niebel@bakermckenzie.com

Monica Novac of Zivko Mijatovic and Partners, Alicante, Spain admin@zm-p.com

Mark Kramer of Stephenson Harwood, London, UK mark.kramer@shlegal.com

Ceren Aral of Gun+ Partners, Istanbul, Turkey ceren.aral@gun.av.tr

Katie Smith of Potter Clarkson LLP, Nottingham, UK Katie.smith@potterclarkson.com

Carlos Cucurella of Fross Zelnick Lehrman & Zissu, New York, NY, USA ccucurella@fzlz.com

Maria Angeles Moreno Nogales of Herrero & Asociados, Madrid, Spain amoreno@herrero.es

Moves and Mergers

Following a merger between Heumann, Benz and VS Intellectual Property **Juergen Heumann** is now with Heumann Intellectual Property Law and can be contacted at **j.heumann@heumannlaw.com**

Linda Wang has left Tay & Partners to join Zaid Ibrahim & Co., a member of ZICOlaw, in Kuala Lumpur, Malaysia. Linda can now be contacted at linda.wang@zicolaw.com

Constantin Kletzer has left Fiebinger Polak Leon & Partner to join Geistwert Attorneys at Law in Vienna, Austria. Constantin can be contacted at constantin.kletzer@geistwert.at

Eleni Papacharalambous and **Coralia Papacharalambous** are now with Koushos Korfiotis Papacharalambous LLC in Nicosia, Cyprus and can be contacted at elenip@palaw.com.cy and coraliap@palaw.com.cy respectively.

Kirsten Peter has left IPAN GmbH to join CPA Global Deutschland GmbH in Munich, Germany. Kirsten can be contacted at kpeter@cpaglobal.com.

Following a change in name of firm, **Ralph Gauger** is now with MGM Patentes y Marcas in Madrid, Spain. Ralph can be contacted at rgauger@mgm-ip.es

Following a change in name of firm, **Malene Fagerberg Rosendahl** is now with Njord Law Firm, Copenhagen, Denmark and can be contacted at maf@njordlaw.com

Christopher Rennie-Smith has left Collyer Bristow and is now working as a consultant based in London, UK. Christopher can now be contacted at Christopher@renniesmith.eu

Verena von Bomhard has left Hogan Lovells to establish her own firm, BomhardIP, in Alicante, Spain. Verena can now be contacted at verena@bomhardip.com

Grant Lynds has left Gowling Lafleur Henderson LLP to join Marks & Clerk in Ottawa, Canada. Grant can now be contacted at glynds@marks-clerk.ca

Bob Boad has recently left Joshi & Welch Ltd. in London and can now be contacted at boadrobert@hotmail.com

Pierre Konings has left NLO Shieldmark to establish his own firm, Konings Trademarks, in Geffen, The Netherlands. Pierre can now be contacted at pierre@koningstrademarks.nl

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

Lesley Edwards

PTMG Secretary

PTMG Spring Conference Report

Venice, 23 and 24 March 2015

Paddling Through the Pressures on Pharmaceutical Trade Marks

Rob Jacob and Mark Kramer, Stephenson Harwood LLP

Venice in the spring sunshine made a wonderful venue for the 90th PTMG conference. Just getting to the conference venue, a beautifully refurbished flour mill on the banks of Giudecca Island, gladdened the soul, and those who arrived on Sunday were treated to a private tour of Saint Mark's Basilica.

Despite the fabulous sunshine and the pull of the most romantic city in the world, the delegates somehow managed to restrain themselves and the afternoon session was well attended.

Sophie Bodet

Sophie Bodet opened the conference, her last as chair, on Monday afternoon by telling the attendees what a 'pleasure and honour' it had been for her to oversee PTMG over the last 3 years. She also reminded the conference that PTMG's membership continued to grow and that the conferences were oversubscribed so, as the spaces at conferences remains capped, members need to book early if they want to guarantee their place.

Domenico de Simone

The opening presentation is always a difficult one as it sets the scene for the rest of the conference. However, Domenico de Simone giving the Alan Cox Memorial Lecture did not disappoint. Following a short prologue from Giovanni Orsoni who informed us that the Venetian Republic had been the first jurisdiction to introduce patent legislation to the world, Domenico dived into his

Giovanni Orsoni

topic of Harmony without Harmonization discussing the benefits and difficulties of harmonisation of IP laws and practice. Whilst, language and market differences are perhaps the more obvious areas of dispute, Domenico also explained that there are other issues, ranging from the re-filing of non-used trade marks, the lack of a single priority date for worldwide recordal programmes to how OHIM deals with insolvent earlier right holders. To Domenico, PTMG and other IP associations are the NGOs of the IP world, with a responsibility to lobby hard against poor procedures on behalf of ourselves and our clients. He passionately suggested that such IP associations should join their voices together in an overarching 'super association' which would be better heard by IP authorities around the world.

Morton Douglas

Next up was Morton Douglas with an international case law round-up. Morton's presentation used three topics (OHIM decisions, national EU decisions and non-use) to flag his concerns regarding the quality and consistency of decisions being made within Europe and therefore implicitly lend his voice to Domenico's call for harmonization. Morton explained that whilst OHIM is getting stricter on absolute grounds, there is a growing trend at OHIM to be more generous to trade mark owners when it comes to relative grounds. Morton also raised the inconsistent approach by OHIM when it comes to stylised elements of a mark – whilst OHIM is unlikely to give such elements much weight when considering whether two pharmaceutical marks are confusingly similar, it does appear that such elements are more important when considering non-use. Morton concluded his insightful talk by predicting a re-emergence of the importance of national registrations in the European Community as practitioners struggle to predict how OHIM will decide issues.

The first day ended on a sad note, as we remembered David Butler of GSK who passed away unexpectedly earlier this year. Rupert Ross-Macdonald beautifully encapsulated the thoughts of attendees who had known and worked with David over the years. An amazing talent that will be understandably missed now and for years to come. Our thoughts go out to David's family.

Dinner in the amazing thirteenth century Scuola Grande San Giovanni Evangelista (and some post dinner drinks and networking in the hotel's top storey bar) did not dampen the attendees' enthusiasm for day two of the conference. The day took us on a world tour of trade marks, starting in Italy before moving to Iran, Iraq, Lebanon, Libya, Syria, Sudan, South Sudan, Mexico, Indonesia, Nigeria, Turkey, and the United Kingdom before we were returned to Italy for the finale.

Julia Holden

Julia Holden kicked the morning session off with an Overview of the Pharmaceutical Regulatory Environment in Italy. Julia gave us a useful summary of the European legal and regulatory position before focussing on the Italian market, moving from name safety considerations though legal clearance, litigation strategy to advertising. Whilst acknowledging that counterfeit pharmaceuticals are more concerning than most counterfeit products due to the patient safety dangers, she raised a good point that husbands bringing back counterfeit

handbags could equally find their health at risk from their unimpressed wives!

Nina Osseiran

The most impressive presentation of the Spring conference came from Nina Osseiran who was discussing the difficult topic of trade mark protection in embargoed countries. Not only was her presentation full of incredibly helpful advice, she managed to engage the entire audience from start to finish. After giving some general advice on how to deal with embargoed countries generally, Nina gave brief insights into the specific challenges in Iran, Iraq, Lebanon, Libya, Syria, Sudan and South Sudan. From the startling fact that 90% of pharmaceuticals in S. Sudan are suspected counterfeit to considering whether Libya will once again delete the entire trade mark register resulting in companies having to reapply afresh for all of their marks. However, despite there being challenges in these countries Nina urged delegates not to give up on them, the rewards for sticking with them can still be fruitful. All of the conference presentations will be made available on the PTMG website and this is one we thoroughly recommend you look at.

Following Nina's talk was a tough task, but the panel discussion, this year focussing on the MINT countries (Mexico, Indonesia, Nigeria, Turkey) - four emerging markets that have been earmarked as being ripe for significant economic growth over the next 10 years, was both interesting and engaging. Vanessa Parker expertly choreographed the discussion, with representatives on each MINT country highlighting the challenges and opportunities that their country presented.

Alejandro Gonzalez Rossi

Alejandro Gonzalez Rossi discussing Mexico noted that the landscape for pharmaceuticals was changing rapidly in Mexico, with developments to trade mark law flowing from Mexico acceding to the Madrid Protocol, the opportunity for pharmaceutical companies presented by the increase in the provision of 'free at delivery' medical services and the impact of changes in the national diet which have lead to a significant increase in the onset of diabetes and related illnesses.

Andrew Diamond

Andrew Diamond illustrated the significant opportunities presented by Indonesia, the 4th most populated country in the world with the 16th largest economy and a strong claim to the title 'social media capital of the world'. However, he also ably set out some of the challenges including the border control and counterfeiting issues flowing from being a country relatively near China formed of 17 thousand islands.

Samantha Copeling

Samantha Copeling flagged why Nigeria will be such an important market going forward, noting that in addition to the advantage of having English as one of its official languages, it shared the advantages of the other MINT countries in having a large, young population creative domestic enterprise and being well positioned geographically.

However, it also shares some of the challenges including a tendency to self medicate and high 'suitcase sales' of pharmaceuticals.

Selma Unlu explained that in Turkey good trade mark law is in place, largely in line with the EU, but that implementation of the law remains a concern. This included concerns regarding the Turkish Patent Institute's decisions and the surprising acknowledgement that the majority of

Selma Ünlü

pharmaceuticals in Turkey can be purchased in pharmacies without prescription.

Jonas Kolle

After lunch, we were treated to the delights of Jonas Kolle from Merck who discussed the difficulties of dealing with national trade marks in our ever increasing global online market place. Having nailed his introduction (the part of his talk he was most concerned about after some nerve generating conversations during breakfast), Jonas highlighted that it is important for pharmaceutical companies to regulate access to national websites to ensure that licensing co-existence agreements and known third party trade marks in other countries are not infringed. He also advised that swift action should be taken against brand infringers (either directly against the infringer or via the ISP or domain name registrar) – the difficulty of course is that habitual infringers will simply register a new domain name and continue infringing as soon as the old one is shut down.

Simon Chapman

Following Jonas, Simon Chapman, provided us with a behind the scenes look at the recent UK High Court case, Amazon. A case Simon knew very well

having represented the claimants, Lush. The case itself reinforces the decisions of Google France, L'Oreal, Interflora and Datacard. In addition to providing a useful and interesting summary of the law in this area, including helpful guidance on what is and what is not permissible in Adwords and related adverts, Simon provided a fascinating insight into both the approach and priorities of Amazon.

Andrea Klein

The conference concluded back in Italy with a presentation by Andrea Klein on Pharmaceutical Thefts. Andrea promised that we would all be in a position to setup our own illegal pharmaceutical business by the end of the presentation and he did not disappoint! Also, the revelation that counterfeiters do not need to go to the extent of manufacturing drugs when they can simply steal them was truly frightening. The theft of pharmaceuticals for parallel import into high price member states can be incredibly lucrative, especially if the pharmaceuticals are diluted with filler products. However, all was not doom and gloom with the announcement that the Italian government have taken the lead on an information sharing initiative that allows member states to check lot numbers of stolen products.

Frank Meixner

Venice was an excellent conference and a fitting end to Sophie Bodet's successful time as chair of PTMG. We join incoming chair Frank Meixner in thanking Sophie for all of the work she has done over the last 3 years and wish Frank the best of luck in Warsaw and beyond.

Editor's footnote:

Upon invitation of the Italian Medicines Agency (AIFA), Andrea Klein attended the International Conference on the Fakeshare project, which took place in Rome on 24 April, 2015. As explained during his presentation, Fakeshare is a European project, led by the Italian Medicines Agency and co-funded by the "Prevention of and Fight against Crime Programme of the European Union" aimed at coordinating investigation activities and police forces, targeting the illegal web distribution of medicines, sharing information on illegal distribution of medicines via a web platform. Representatives of European National Medicine Agencies and Police forces attended the conference which was hosted by AIFA.

Confusion with INNs under German jurisdiction

Margret Knitter, LL.M., SKW Schwarz

Particularly in the pharmaceutical sector it is common to form trade marks from descriptive terms, especially from international non-proprietary names (INNs). One advantage of such trade marks is the easier linkage for users to the medication's field of application. But INNs are excluded from trade mark protection because they are merely descriptive and as such not distinctive. Under German jurisdiction, however, only small changes to the INN make it a registrable sign. For example, Roxymycin was accepted as a trade mark, where the INN is Roxythromycin.

At the same time these trade marks only have a limited scope of protection under German case law. According to settled case law, the likelihood of confusion is greater, the greater the distinctive character of the prior trade mark. This means at the same time that trade marks inspired by descriptive elements only have a narrow scope of protection.

For example, the German Patent Court rejected likelihood of confusion of the marks PANTOPREM and PANTOPAN (Decision of 16.01.2014, 25W(pat)72/12). The court held that PANTO as the opposing mark's beginning syllable refers to pantoprazole, a proton pump inhibitor active ingredient mainly used in gastrointestinal preparations. This would also be recognized by the relevant public. The presumption is that attention would not mainly be placed on the mark's beginning, but particularly also on the additional word components or endings. In the case at issue, differences of the compared marks within the endings in aural and typographical overall impressions would not go unnoticed.

That does not mean however, that any reference to INNs automatically leads to a lower than average distinctiveness of the mark and therefore a reduced scope of protection, as shown by the following decisions by the German Patent Court.

The court had to determine the level of distinctiveness of the opposing mark DORZOTIM. It was determined that an abbreviation of the INN Dorzolamid could be seen in the part DORZO, and an abbreviation of the INN Timolol could be seen in the part TIM. This however did not result in the presumption of an inherent weak (below-average) distinctiveness. The disputed mark was said to combine a new artificial word in combining the abbreviations of two INNs, giving it a normal level of distinctiveness (Decision of 23.01.2014, 30W(pat)90/13 – DORZOTIM confusingly similar to Dorotim-Ophtal).

In another decision, the German Patent Court decided on the distinctiveness of the opposing mark VERAMEX. Here too, the court certified that the opposing mark had an average level of distinctiveness. The word element VERA was in fact descriptive of the INN Verapamil for the relevant public. In case of slight references to INNs, the German Federal Supreme Court had affirmed a below-average level of distinctiveness. A decreased scope of protection would however only be considered if the unhindered use of the INN or a similar term has to be guaranteed. Such term would have to be kept free for certain reasons. If the descriptive part was combined, as in the case at issue, with a non-descriptive part relating to a fantasy term, nothing would stand in the way of assuming above-average distinctiveness. Therefore, the court held that the word combination VERAMEX overall was an imaginative word formation, which was given average distinctiveness by itself (Decision of 17.09.2014, 29W(pat)117/12 – VERAMEX confusingly similar to Besamex for part of the goods).

Trade mark owners must be clear that although such descriptive marks are attractive, enforcement may turn out to be difficult. The rule of thumb is that the greater the deviation from the actual INN, whether through abbreviation or combination with other word elements, the higher the level of distinctiveness.

Re-branding of pharmaceutical products essential for effective access to the UK market

Nina O'Sullivan, King & Wood Mallesons

The Court of Appeal has upheld an appeal by Doncaster Pharmaceuticals, finding that it was objectively necessary for it to re-brand imports of trospium chloride into the UK with the relevant UK trade mark in order to gain access to the UK market. In particular, the Court of Appeal considered that it was unrealistic to have expected Doncaster to adopt its own brand in order to compete in that market.

Background

Speciality European Pharma (SEP) is the exclusive UK licensee of a pharmaceutical product with the active ingredient trospium chloride, manufactured by Madaus GmbH. The patent for trospium chloride expired in 2009. The patent for an extended release version expires in 2024.

Trospium chloride is sold under the trade mark Regurin in the UK, Céris in France and Urivesc in Germany. It is sold in two forms: ordinary release 20mg tablets and 60mg extended release capsules. The evidence was that 88.65% of prescriptions in the UK for the 20mg product are written generically, with only 8.61% written by reference to the Regurin brand. However, as the Court noted, with some surprise, a significant proportion of generic prescriptions are filled with the branded product. As it is still subject to patent protection, all of the 60mg product is dispensed under the brand Regurin XL (68% of prescriptions being written by reference to the generic name).

Doncaster has, for many years, imported Céris (the 20mg product) into the UK from France, over-stickered with trospium chloride. However, after the trospium chloride patent expired in 2009, it began importing Céris into the UK re-branded with the trade mark Regurin. In 2011, it began importing Urivesc (the 60mg product) into the UK from Germany re-branded with the trade mark Regurin XL.

Free movement of goods and enforcement of trade marks

Article 34 of the Treaty on the Functioning of the European Union (TFEU) underpins the fundamental objective of the European single market of free movement of goods: quantitative restrictions between Member States on imports and measures having equivalent effect are prohibited. There is a carve out in Article 36 TFEU which provides that prohibitions or restrictions on imports which are justified on the grounds of protection of intellectual property rights are legitimate, provided that those prohibitions or restrictions do not constitute a means of arbitrary discrimination or a disguised restriction on trade between Member States. Accordingly, a trade mark owner cannot enforce its rights where this will lead to an 'artificial partitioning of the market'.

In Pharmacia & Upjohn SA v Paranova A/S, the Court of Justice of the European Union (CJEU) considered the conditions under which a parallel importer could replace the trade mark used in the country of export with that used by the brand owner in the country of import (subject also to it complying with the five Bristol-Myers Squibb (BMS) conditions). It decided that the relevant enquiry was: do the prevailing circumstances at the time of marketing in the Member State of import make it objectively necessary for the parallel importer to re-brand the product with the trade mark used in that Member State so that it can market the product? The necessity condition will be satisfied if the prohibition against the importer re-branding hinders effective access to the importing state's market. The CJEU gave as an example where using the exporting state trade mark is forbidden in the importing state. In contrast, it would not be objectively necessary where the parallel importer was, by replacing the trade mark, solely attempting to secure a commercial advantage.

In Boehringer Ingelheim v Swingward, the CJEU gave further guidance as to what could hinder effective access, including strong resistance from a significant proportion of consumers to relabelled pharmaceutical products. It also confirmed that a relevant impediment to access could exist where the barrier to entry was to a substantial part of the market or to a significant proportion of consumers. When assessing this question, a court can consider the parallel importer's alternatives and whether they are realistic (e.g. trying to eliminate label-resistance).

The trial Judge's decision

Asplin J had concluded that it was not objectively necessary for Doncaster to re-brand trospium chloride with Regurin in order to gain effective access to the trospium chloride market in the UK: it was effectively seeking to achieve greater margins and "piggy back" on SEP's investment and marketing strategy.

In particular, the Judge considered the following to be important:

- Doncaster had immediate access to that part of the market where trospium chloride is prescribed generically (90% for the 20mg product and 68% for the 60mg product);
- There was no significant resistance by consumers or pharmacists to a product other than Regurin or an over-stickered product;
- The fact that only 8.62% of prescriptions specified Regurin 20mg was an objective indicator that effective access to the market was not hindered;
- The presence of the generic product Flotros on the market suggested effective access was not hindered unless use was made of Regurin;
- There were no "rules or structures" in the market creating a hindrance to effective access unless Regurin was used. In fact, NHS policy was strongly in favour of generic prescribing;
- In relation to the 60mg product, Doncaster could adopt a brand of its own to compete with Regurin XL (the Medecines & Healthcare products Regulatory Agency - MHRA requires the 60mg product to be dispensed under a brand name);
- As 70% of prescriptions for the 60mg product are written generically, Doncaster could compete for that 70% (which constituted effective access).

Court of Appeal Decision

The Court of Appeal, in a decision given by Floyd LJ, decided that, for both the 20mg and 60mg product, Doncaster was hindered from reaching a substantial part of the market for trospium chloride in the UK, at both the prescribing doctor and pharmacist level.

First, the UK rule that a branded prescription could only be filled by the branded product meant that it was necessary to re-brand in order to get access to that part of the market. Further, whilst the Court rejected Doncaster's submission that it was legitimate to look at the percentage by value of the prescription market, it accepted its argument that the percentages of prescriptions for the branded product were underestimates, given the persistent practice of filling generic prescriptions

with Regurin. In particular, given this meant that pharmacists were foregoing significantly increased profits, Floyd LJ concluded that this suggested there was strong resistance to brands other than Regurin.

The crucial question is whether Asplin J was entitled to decide that, through adopting its own (putative) brand for the 60mg product, Doncaster could realistically compete for the whole of the market by persuading doctors to prescribe by reference to that brand. This was a factual assessment for the trial Judge and Floyd LJ recognised that there were very limited circumstances in which the Court should intervene with it. However, he concluded that there was no evidence entitling the Judge to come to the conclusion that she reached. In particular, he accepted that Doncaster could not compete for sales prescribed as Regurin because UK pharmacists could not substitute another product where the prescription is written for the brand. Further, Doncaster submitted that it was unrealistic to expect a parallel importer to brand its product (which was exactly the same as Regurin XL) and market it to doctors. Doncaster's CEO had said in evidence that it would be a "fool's errand" to seek to generate demand associated with a brand when selling parallel imports. Floyd LJ recognised this as an aspect of interstate trade rather than a commercial decision by Doncaster. For Doncaster, adopting its own brand was not a "real world alternative": indeed, on the basis that regular interruptions in supply occur in respect of parallel imports, Floyd LJ suggested it would have been "verging on the irresponsible to encourage a doctor to prescribe a Doncaster brand". He concluded therefore that the Judge should not have dismissed this evidence without giving some reason for doing so.

Comment

This decision will not be welcomed by pharmaceutical manufacturers. However, the decision should also not be perceived as presenting unlimited opportunity for parallel importers to re-brand products with the registered trade mark that applies in the Member State of import. In all cases, it will be necessary to consider whether otherwise effective access to the market would be hindered, which will require a careful assessment of that market and the practices applying in that market. In this case, the Court of Appeal was persuaded that there was strong resistance to brands other than Regurin at the dispensing level, and that it would have been unrealistic for Doncaster to adopt its own brand name (and market that brand to prescribing doctors) for imported Regurin XL. It is unusual however for the Court of Appeal to interfere with the lower Court's assessment of the factual position.

Famous trade marks as key words

Frédérique Potin, Simmons & Simmons, Paris, France

In a recent decision, the French Supreme Court has again confirmed its reluctance to find a search engine liable as an editor capable of controlling the use and publication of infringing content and, in particular, the use of famous trade marks as key words. In this particular case, the French national railway company, the SNCF, filed proceedings for unfair use of a trade mark having a reputation, against a web provider which hosted the tuto4pc.com website that used some of the SNCF's most famous trade marks as key words to point to competing travel agencies' websites.

Before deciding on the famous trade mark unfair use issue, the Court had to determine whether the web provider was acting as a mere "hosting company" or had an active role in the choice of the contents published on the tuto4pc.com website.

Indeed, pursuant to the French Loi pour la Confiance en l'économie numérique of 29 June 2004 (LCEN) which implements the directive on electronic commerce, web hosting companies benefit from a limited liability regime in respect of infringing contents published on websites that they host, i.e. they may only be found liable if they fail to remove infringing content after being put on notice of the infringement by the right holder.

In our case, the Court of Appeal had considered that the reproduction of the trade mark SNCF on the first page of the site (and its subsequent removal after service of the first instance decision) together with the creation of a commercial advertising system, constituted sufficient elements to establish the defendant's active role in the choice of contents published and, therefore, its full liability. These arguments were, however, rejected by the Supreme Court who considered that it was not established that the defendant had knowledge and control of the data stocked by advertisers, and confirmed, once again, its reluctance to admit the full liability of web hosting companies.

On the trade mark unfair use front, the Supreme Court quashed the Court of Appeal's decision, considering that stocking the sign SNCF, and other famous trade marks as key words and organizing the publication of advertising using such key words did not constitute use of a trade mark in the course of trade, as the defendant did not directly benefit from such use. This approach is based on the CJEU decisions in cases C-236/08 to C-238/08 Google France of 23 March 2010 which established the principle that use of famous trade marks as key words does not constitute use of a trade mark in the course of trade.

On the basis that the defendant did not have an active role in the choice of contents published on the tuto4pc.com site, it was not possible to find the web provider liable for unfair use of the famous trade marks as keywords.

As regards the pharmaceutical industry, although the online sale of pharmaceutical products is strictly regulated, using famous medicines' brands as key words is no doubt tempting when trying to sell generics or counterfeits and the pharmaceutical industry should be particularly watchful.

PROFILE: Frank Meixner

After leaving school Frank wanted to see the world and first worked for the German Diplomatic Service dreaming of postings to New York, London and Paris. But he ended up in interesting countries like Zaire, Benin and Somalia for 5 years. So he then decided to quit and study law. He started his career working as an attorney specialized in patent litigation with Rospatt Osten Pross in Düsseldorf, Germany for 3 years. After a short intermezzo with L'Oréal in Germany he was hired by Bayer in October 2001 where he became Head of Trade Marks in 2007.

Where were you brought up and educated?

In Pforzheim/Germany which is in the northern part of the Black Forest.

How did you become involved in trade marks?

Actually by chance. After having passed my law exams I was looking for a first job and only knew which subjects I would not really like. I then found a job advertisement of an IP boutique in Düsseldorf and was just curious what intellectual property really means. I took the job and entered the fascinating world of IP.

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

I would have become a judge for civil law.

Which three words would you use to describe yourself?

Friendly, curious, impatient.

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

French, history, music.

What do you do at weekends?

Cook Italian or Asian food and enjoy eating it with good friends.

What's the best thing about your job?

Working with people from all over the world which really broadens your horizon.

What does all your money get spent on?

Books, musical instruments.

What is your biggest regret?

Not to have practised enough in order to become a professional violinist.

What is the soundtrack to your life?

The Four Seasons by Antonio Vivaldi.

What is your philosophy in a nutshell?

Treat everyone the same way you wish to be treated.

What is your all-time favourite film?

The BBC adaptation of Pride and Prejudice.

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

The current Pope.

What is your favourite drink?

A Gin & Tonic with Monkey 47 (a gin from the Black Forest).

What is your favourite holiday destination?

The Dordogne in France.

Do you have any unfulfilled ambitions?

Oh yes, I would love to publicly perform a violin concert as soloist (but I am just not good enough).

Where do you see yourself in 10 years' time?

Still working in trademarks and still enjoying it.

If you could save only three things from your burning home, what would they be?

My violin and my viola, but of course I would rescue my sweetheart first!

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

The Alhambra in Granada because for me it symbolizes perfect harmony between architecture and nature.

What's the best invention ever?

The printing press since it helped to spread knowledge and a bit of wisdom.

Which modern convenience could you not live without?

My kindle and my iPad.

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