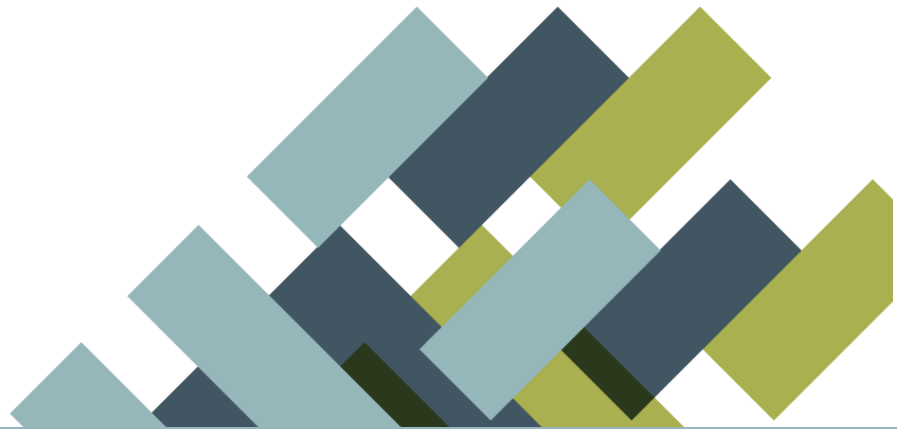


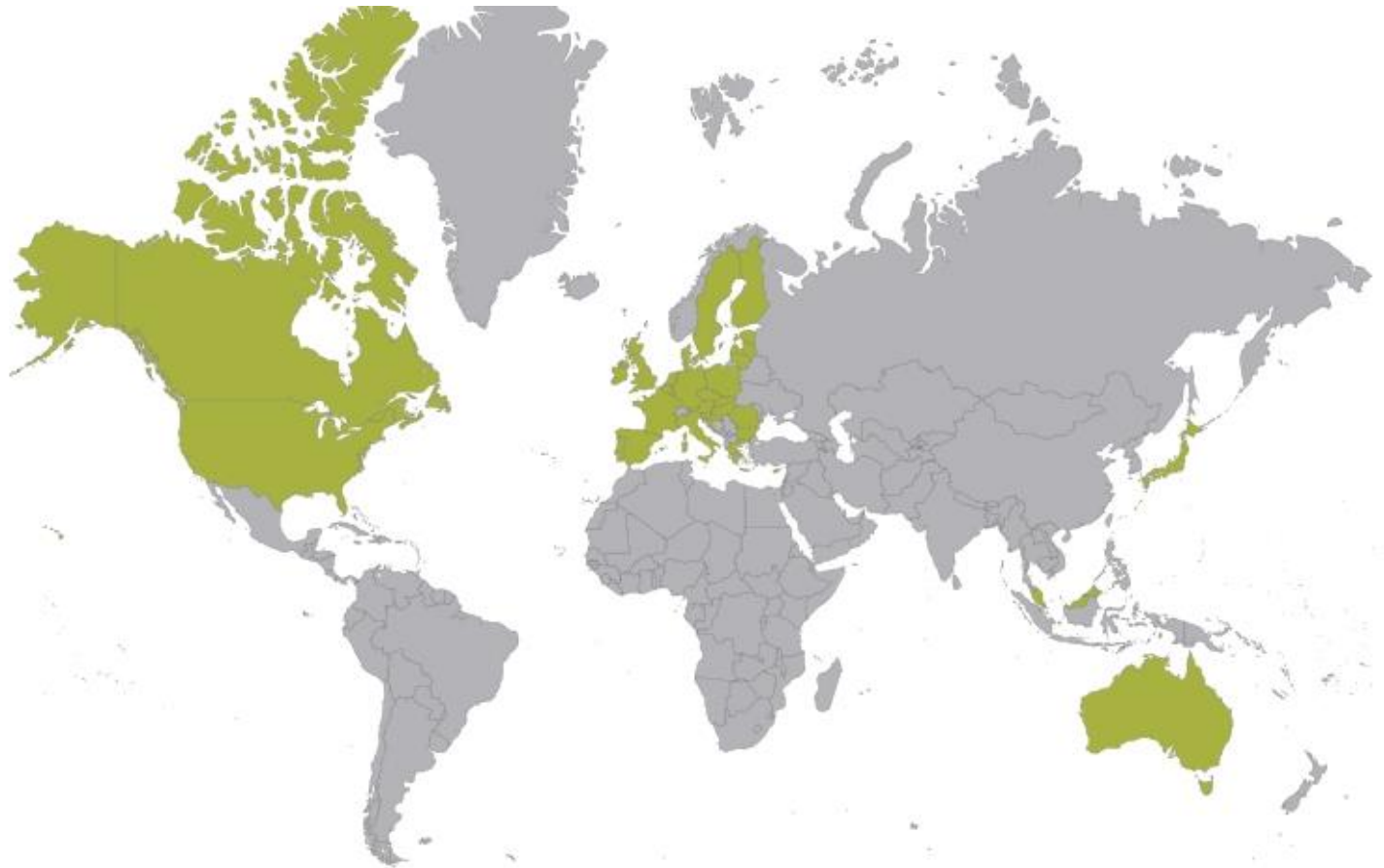
WILLIAM FRY III

International Case Round-Up with Laura Scott

Pharmaceutical Trade Marks Group
92nd Annual Conference



Trade Mark cases around the world



EU (OHIM) - Absolute Grounds

Mark	Case No./Date	Status	Class(es)	Outcome
RNAI-CAP (word)	26 January 2015	Decision of the Office. Not appealed	1; 5; 42	Refused
HEALTHY MAMA (word)	27 February 2015	Decision of the Board of Appeal. Not appealed	32	Refused
T-CELL FACTORY (word)	14 July 2015	Decision of the Office. Awaiting decision by the Board of Appeal	1; 5; 9; 42	Refused (under appeal)
XENON (word)	7 September 2015	Decision of the Office. Not appealed	5	Refused

EU (OHIM) - Absolute Grounds

RNAI-CAP (word)

- Message delivered by mark will be obvious for specialised relevant public
- RNA interference (RNAI) and 'cap' structure have meanings within the field of molecular biology known to the target market
- Mark cannot constitute badge of origin – does not contain any additional element which confers minimum degree of distinctiveness

EU (OHIM) - Absolute Grounds

T-CELL FACTORY (Word)

- Given descriptive nature of 'T-CELL' question is whether the additional term 'FACTORY' is sufficiently distinctive in order to render mark distinctive as a whole
- Applicant argued T-Cells are not assembly lined manufactured, therefore 'factory' results in scientifically illogical meaning that will provoke further reflection
- Argument rejected – engineering T-Cells outside body clearly requires manufacturing facility/process and to manufacture something generally means to make /produce in a factory

EU (OHIM) - Absolute Grounds

XENON (word mark)

- Requested limitation of Class 5 goods to “except gases used in medicine” does not assist
- OHIM cannot register mark only in so far as goods concerned do not possess a certain characteristic as to do so would lead to uncertainty over scope of protection
- Rejected as irrelevant arguments that:
 - Naturally occurring xenon is not used in medicine & only its isotope can be used in nuclear medicine
 - Xenon not suitable for use in non-gaseous pharmaceuticals such as pills/syrups
 - Earlier application for XENON in 2000 accepted for publication and registrations in national offices
 - Applicant’s products have no connection with xenon

EU (GC) - Absolute Grounds

Mark	Case No./Date	Status	Class(es)	Outcome
	Case T - 654/13 16 June 2015	Decision of General Court	3; 5; 10	Refused
	Case T - 611/13 15 July 2015	Decision General Court	3; 5	Partially registrable
GREASECUTTER (word)	Case T-610/13 30 September 2015	Decision of General Court	3; 5	Partially refused
	Case T-610/14 10 September 2015	Decision of General Court.	3; 5	Partially refused
	Case T- 359/12 & T- 360/12 21 April 2015	Decision of General Court.. T-359/12 appealed to CJEU	18	Refused (under appeal)
	Case T-411/14	Decision of General Court.	6; 21; 32	Refused

EU (GC) - Absolute Grounds



- No significant divergence from the norm or customs of the sector concerned
- Any differences are simple manufacturing variations
- Red and white colour customary in the field

EU: (GC)- Absolute Grounds

GREASECUTTER

- Neologism – only descriptive if no perceptible difference between the term and the mere sum of its parts
- Held descriptive of “*pharmaceutical and veterinary preparations; ...dietetic substances adapted for medical use..*” in Class 5 as some of these goods are intended to specifically address a health issue characterised by the excessive production of sebum by the skin, excess weight or obesity, or other conditions requiring the use of medical or dietetic good which have the effect of eliminating or reducing fat or grease
- BOA’s decision not undermined by not taking account of US registration

EU (GC) – Absolute Grounds

(Louis Vuitton)



Lack of Inherent Distinctiveness

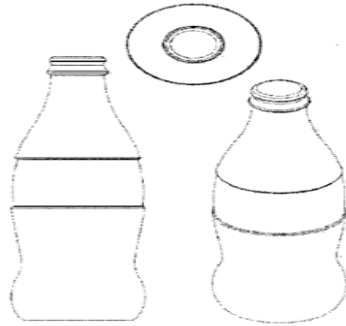
- Mark coincides with appearance of product / part of a product
- Consumers perceive those signs as commercial origin identifiers with some difficulty if they do not bear any graphic or word elements, unless they depart from the norms and customs of the sector

Lack of Acquired Distinctiveness

- CTM a unitary right - must have distinctive character throughout the EU (the member states as at date of filing)
- Test for acquired distinctiveness different to the test for proving a mark has acquired reputation to qualify under A. 8(5) and 9(1)
- Evidential issues

EU General Court – Absolute Grounds

(Coca-Cola)

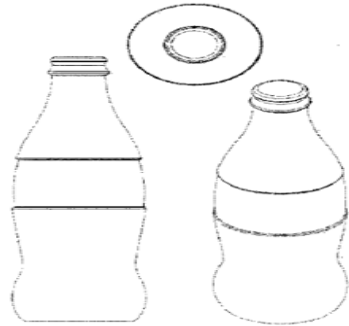


Lack of Inherent Distinctiveness

- Mark consisting of appearance of goods – *“only a mark which departs significantly from the norms of the customs of the sector and thereby fulfils its essential function of indicating origin”*
- *“The mark applied for must be assessed ...without assuming that that public would make a direct and immediate connection between that sign and the contour bottle with fluting for which the applicant is recognised worldwide”*

EU General Court – Absolute Grounds

(Coca-Cola)

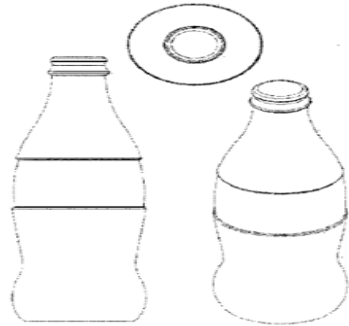


Lack of Acquired Distinctiveness

- A 3D mark “*may, in certain circumstances, acquire distinctive character even if it is used in conjunction with a word or figurative mark*”
- “*The mark ...is not used in combination with the mark it is alleged to be a part of but absorbs that mark or, inversely, is itself absorbed by it to the extent that the silhouettes of the mark applied for and the mark it is alleged to be part of overlap. In those circumstances, it is necessary to ascertain whether the evidence proves that, in the eyes of the relevant public, the mark ...can be perceived as an indicator of origin of the goods at issue*”

EU General Court – Absolute Grounds




(Coca-Cola)



Lack of Acquired Distinctiveness

- Survey evidence from 10 Member States not sufficient to prove the mark had acquired distinctive character throughout the European Union in respect of a significant part of the relevant public
- Applicant has to prove surveys are comparable/could be extrapolated to those Member States where surveys not conducted

EU (General Court) – Relative Grounds

Mark	Earlier Mark	Case No./Date	Status	Class(es)	Outcome
	CERCON (word)	C-420/14P 5 February 2015	Decision of CJEU	5; 10; 40	Confusingly similar
ZEBEXIR (word)	ZEBENIX (word)	T-366/11 3 March 2015	GC decision quashed by the CJEU. Decided again, <i>de novo</i> , by GC	3; 5	Confusingly similar
KORAGEL (word)/	CHORAGON (word)	T-169/14 13 May 2015	Decision of General Court.	5	Not confusingly similar
AKTIVAMED (word)	VAMED (device) 	T-551/13 26 March 2015	Decision of General Court	5; 11; 44	Confusingly similar
ANGIPAX (word)	ANTISTAX (word)	T-368/13 10 February 2015	Decision of General Court	5	Not confusingly similar
PENSA PHARMA & 	PENTASA (word)	T-544/12 & T-546/12 3 June 2015	Decision of General Court. Appeal case before the CJEU.	5; 44	Confusingly similar
ELMA (word)	ELMEX (word)	T-309/13 22 October 2015	Decision of General Court	5	Confusingly similar

EU (GC) – Relative Grounds

KORAGEL / CHORAGON

- Level of attention of relevant public
 - principle upheld that medicines (whether on prescription or not, and those for treating minor complaints) receive high degree of attention
- Comparison of goods to pharmaceutical products and substances:
 - Herbicides not similar
 - Preparations for destroying vermin and fungicides are similar
 - Food for babies are similar
- Global Assessment - specific features of marketing of goods do not justify giving more importance to aural comparison than to visual comparison
 - Prescription products – since the trade mark written is on a prescription by the prescribing doctors, consumers are necessarily confronted with a visual representation of the mark before ordering them
 - Must be assumed that a pharmaceutical preparation will generally be subject of a visual inspection by consumer when professional presents it to him
 - Remainder of goods generally available on self service basis

EU (GC) – Relative Grounds

AKTIVAMED / VAMED

- Even if relevant public understood that the suffix MED alludes to medicine, does not mean this element will be given less weight
- Fact that VAMED is completely included in AKTIVAMED sufficient to render marks confusingly similar even though MED an obvious allusion to medicine

EU (GC) – Relative Grounds

ANGIPAX / ANTISTAX

Visual

- Despite undeniable similarities, there are differences

Aural

- Not highly similar despite identity of first syllable and last two letters. Neither BOA nor parties broke earlier mark into traditional three syllables which emphasises that in mind of public it is made up of two elements ‘ANTI’ and ‘STAX’. Second and third syllables different.

Conceptual

- Conceptual meaning of first part ‘Angi’ and ‘Anti’ immediately perceived & enables them to be distinguished
- Where compared as a whole, meaningless, so no similarity

EU (GC) – Relative Grounds

PENSA PHARMA & PENSA / PENTASA

Consent / Co-existence

- Applicant alleged consent as intervener had withdrawn opposition before filing invalidity action – rejected
- Applicant alleged consent by virtue of co-existence agreement for different representation of ‘PENSA’ mark – rejected
- Fact of peaceful co-existence in Italy / Spain does not mean that there is no likelihood of confusion in another Member State sufficient for invalidity

EU (GC) – Relative Grounds

PENSA PHARMA / PENTASA

- Addition of ‘Pharma’ element
 - Visual & Phoenetic – ‘pharma’ element although descriptive would not be disregarded by relevant public. Gives rise to a difference (but dominant element is PENSA and presence of ‘ta’ not sufficient to affect similarity)
 - Conceptual – no effect conceptually because of descriptiveness
 - Even though adds element of differentiation does not dislodge likelihood of confusion. Descriptive & does not contribute to essential function of mark
- Difference in therapeutic indication
 - Applicant argument of no likelihood of confusion on basis of above rejected
 - Comparison of goods must relate to the description of the goods of earlier mark/mark applied for (unless challenge under genuine use means more limited). Analysis of likelihood of confusion cannot be dependent on marketing intentions of the proprietors of the marks

EU (GC) – Relative Grounds

PENSA PHARMA & PENSA / PENTASA

- Point of Interest
 - Applicant pointed out that even if they did not succeed in registering the mark, it would still have to use 'Pensa Pharma' on the goods as a compulsory regulatory requirement
 - Held not something to be considered– role limited to comparison of marks and applicant did not show how this would reduce likelihood of confusion
- Under appeal to CJEU

CJEU Decisions

Iron & Smith Kft v Unilever NV (C-125/14) 3 September 2015

- Hungarian trade mark application - BE IMPULSIVE
- Opposition under Article 4(3) based on earlier CTM for IMPULSE
- Hungarian IPO – refused application - Unilever had market share in UK & Italy under IMPULSE and therefore reputation proved in substantial party of EU
- Applicant appealed
- Four questions referred to CJEU

CJEU Decisions

Iron & Smith Kft v Unilever NV

(1) Is it sufficient, for the purposes of proving that a CTM has a reputation within the meaning of Article 4(3)..., for that mark to have a reputation in one Member State, including, where the national trade mark application which has been opposed on the basis of such a reputation has been lodged, in a country other than that Member State?

(2) May the principles laid down by [the CJEU] regarding the genuine use of a CTM be applied in the context of the territorial criteria used when examining the reputation of such a mark?

(3) If proprietor of earlier CTM has proved that that mark has a reputation in countries other than the Member State in which the national trade mark application has been lodged - which cover a substantial part of the territory of the EU - may he also be required, notwithstanding that fact, to adduce conclusive proof in relation to that Member State?

(4) If answer to Q3 is no,...may a mark used intensively in a substantial part of the EU be unknown to the relevant national consumer and therefore the other condition for the ground precluding registration in accordance with Article 4(3) not be met, since no likelihood of detriment to, or unfair advantage being taken of, a mark's repute or distinctive character? If so, what facts must CTM proprietor prove in order for that second condition to be met?

CJEU Decisions

Iron & Smith Kft v Unilever NV

Questions (1) – (3)

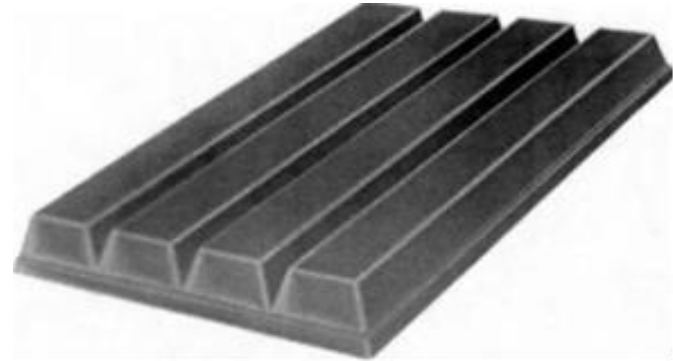
- Article 4(3)... if the reputation of an earlier CTM is established in a substantial part of the territory of the EU, which may, in some circumstances, coincide with the territory of a single Member State, which does not have to be the State in which the application for the later national mark was filed, it must be held that that mark has a reputation in the EU
- Criteria laid down by the case-law concerning the genuine use of the CTM not relevant, as such, re existence of a 'reputation' within the meaning of Article 4(3)

Question (4)

- If the earlier CTM has already acquired a reputation in a substantial part of the territory of the EU, but not with the relevant public in the MS in which registration of the later national mark concerned by the opposition has been applied for, the proprietor of the CTM may benefit from the protection introduced by Article 4(3) where it is shown that a commercially significant part of that public is familiar with that mark, makes a connection between it and the later national mark and that there is, taking account of all the relevant factors in the case, either actual and present injury to its mark or a serious risk that such injury may occur in the future

CJEU Decisions

Societe des Produits Nestle SA v Cadbury UK Ltd (C-215/14) 16 September 2015



UKIPO

- 3 Essential Features of the Mark:
 - Basic rectangular 'slab' shape
 - Presence, position & depth of grooves
 - Number of grooves
- Mark consisted of functional shape, devoid of distinctiveness & no acquired distinctiveness

Appealed to UK High Court (Arnold J)– three questions referred to CJEU

CJEU Decisions

Societe des Produits Nestle SA v Cadbury UK Ltd

Questions 2 & 3 (interpretation of Article 3(1)(e) (i) and/or (ii))

- Where a shape consists of three essential features, one of which results from the nature of the goods themselves and two of which are necessary to obtain a technical result, is registration of that shape as a trade mark precluded by Article 3(1)(e)(i) and/or (ii)?
- Should Article 3(1)(e)(ii) be interpreted as precluding registration of shapes which are necessary to obtain a technical result with regard to the manner in which the goods are manufactured as opposed to the manner in which the goods function?

Mr Justice Arnold

- it is my opinion that both these questions should be answered in the affirmative

CJEU disagreed

CJEU Decisions

Societe des Produits Nestle SA v Cadbury UK Ltd

Question 1 (Acquired distinctiveness)

Re Article 3(3)....

- is it sufficient for the applicant for registration to prove that at the relevant date a significant proportion of the relevant class of persons recognise the mark and associate it with the applicant's goods in the sense that, if they were to be asked who marketed goods bearing that mark, they would identify the applicant;

or

- must the applicant prove that a significant proportion of the relevant class of persons rely upon the mark (as opposed to any other trade marks which may also be present) as indicating the origin of the goods?

Mr Justice Arnold:

- it is my opinion that ... the correct answer to the question is the latter

CJEU Decisions

Societe des Produits Nestle SA v Cadbury UK Ltd

CJEU– reformulation of Question 1

“In order to obtain registration of a trade mark which has acquired a distinctive character following the use which has been made of it within the meaning of Article 3(3)regardless of whether that use is as part of another registered trade mark or in conjunction with such a mark, the trade mark applicant must prove that the relevant class of persons perceive the goods or services designated exclusively by the mark applied for, as opposed to any other mark which might also be present, as originating from a particular company”

Mr Justice Arnold (Judgment of 21 January 2016)

“If a referring court asks whether the answer to a question is A or B, the [CJEU] is perfectly entitled to say that the answer is neither A nor B, but C. ... The problem in the present case is that the [CJEU] has said that the answer is not A, but C. Since the Court has not explicitly addressed B, however, it is not clear whether C is different from B”

CJEU Decisions

Societe des Produits Nestle SA v Cadbury UK Ltd

Mr Justice Arnold (Judgment of 21 January 2016):

- Article 3(1)(e) - Registration of the mark not precluded because neither subsection (i) nor (ii) applied to all three elements of the mark
- Article 3(3) - acquired distinctiveness:

“the applicant or trade mark proprietor must prove that, at the relevant date, a significant proportion of the relevant class of persons perceives the relevant goods or services as originating from a particular undertaking because of the sign in question (as opposed to any other trade mark which may also be present)”

In this case Nestle failed to do so

Societe des Produits Nestle SA v Cadbury UK Ltd (C-215/14)

16 September 2015

Separately:

- Opposition to Nestle CTM for same mark (narrower specification)
- Cancellation by OHIM reversed by BOA
- BOA decision appealed to General Court
- Proceedings before General Court stayed pending CJEU decision

UK Decisions

Case Name	Issue	Court	Date
Flynn Pharma Ltd v Drugsrus Ltd & Tenolol Ltd [2015] EWHC 2759 (Ch)	Parallel Imports	High Court	6 October 2015
Comic Enterprises Ltd v Twentieth Century Fox Film Corporation [2016] EWCA Civ 41	Wrong Way Round Confusion	Court of Appeal	8 February 2016
The Sofa Workshop Ltd v Sofaworks Ltd [2015] EWHC 1773 (IPEC)	Genuine Use	Intellectual Property Enterprise Court	29 June 2015
Starbucks (HK) Limited and anor v British Sky Broadcasting Group plc and others [2015] UKSC 31	'Foreign' Goodwill	Supreme Court	13 May 2015

UK Decisions

Flynn Pharma Ltd v Drugsrus Ltd & Tenolol Ltd

Core Facts:

- Phenytoin sodium product sold by Pfizer under EPANUTIN brand
- UK Marketing Authorisation for capsules acquired by Flynn Pharma from Pfizer
- Thereafter marketed by Flynn Pharma in UK as 'PHENYTOIN SODIUM FLYNN' for particular regulatory reasons.
- Suite of agreements with Pfizer for manufacture/supply of product
- Defendants parallel imported EPANUTIN from Ireland into UK and sought to re-label as PHENYTOIN SODIUM FLYNN

UK Decisions

Flynn Pharma Ltd v Druggsrus Ltd & Tenolol Ltd

Key Issues & findings

- Does use of word 'FLYNN' amount to trade mark use? Yes
 - FLYNN is an indicator that product originates with Flynn Pharma
 - Accurate disclaimer on label would not be sufficient for patient clarity
- Are Flynn Pharma's trade mark rights exhausted by the EPANUTIN placed on market in other member states by Pfizer? No
 - It is not the same entity that placed the goods on the market in the exporting state
 - Agreements between Flynn Pharma & Pfizer – Flynn Pharma has no power to control quality of product supplied in other Member States / Pfizer has no power to control specification of product supplied in UK
 - Flynn Pharma entitled to prevent re-labelling
- However, had Flynn Pharma's rights been exhausted, principles in BMS v Paranova, would have meant it would have been necessary for defendants to re-labelling

UK Decisions

Comic Enterprises Ltd v Twentieth Century Fox (“Glee Case”)

Core Facts:

- Claimant operates a number of entertainment venues in the UK & owns a UK series trade mark (registration date 2001)



- Action for TM infringement & passing off re defendant’s use of word GLEE as the name of a musical comedy TV series launched in 2009 in US & UK

Issues:

- Are series marks permissible?
- Passing Off – distinction between confusion & misrepresentation
- Wrong-way round confusion

UK Decisions

Comic Enterprises Ltd v Twentieth Century Fox (“Glee Case”)

Wrong –way round confusion

COA - “ *whether a particular instance of confusion is “right way round” or “wrong way round” may be a consequence of nothing more meaningful than the order in which the consumer happened to come across the mark and the sign*”. In either case “*the consumer thinks that the goods or services come from the same undertakings or economically linked undertakings and they may be equally damaging to the distinctiveness and functions of the mark*”

Section 10(2)

- Defendant alleged “*wrong way round confusion*” can only occur when a defendant has an established reputation in the jurisdiction which the Defendant would not have had at the date of its launch
- COA did not accept this submission –infringement analysis involves an element of looking forward and assessing whether there is a likelihood of confusion in light of the Defendant’s actual and threatened activities. Evidence which comes to light after the date of the Defendant’s launch may assist Court.

Section 10(3)

- Defendant argued that the “*wrong way round confusion* ” should be excluded as it alleged that Section 10(3) is based on the reputation of the earlier mark rather than the later mark
- COA did not accept.

UK Decisions

Sofa Workshop v Sofaworks

Validity of CTM word marks for SOFA WORKSHOP

Acquired Distinctiveness:

- Acquired distinctiveness demonstrated in UK but not demonstrated in other Member States where widespread use of English

Genuine Use

- Interpretation of CJEU decision in ONEL re territorial extent of use:
 - Generally there must be genuine use in more than one Member State
 - An exception arises where the market for the relevant goods or services is restricted to the territory of a single Member State
 - Correct?

UK Decisions

Starbucks v BSKyB – (the “NOW TV” case)

Core Facts:

- Starbucks provide an internet based subscription television service based in Hong Kong under the name NOW TV. Known to select group of people living or working in the UK but the service was not sold in UK, nor was it available in UK.
- BskyB to launch subscription based television service in the UK named NOW TV

Passing Off – Goodwill

Lord Neuberger:

- Claimant must show customers in the jurisdiction, as opposed to people in the jurisdiction who happen to be customers when they are abroad
- Not necessary that the claimant has an establishment or office in the UK
- If people in the jurisdiction who, by booking with or purchasing from an entity in UK, obtained the right to receive the claimant's services abroad, this could be enough to establish goodwill. The entity need not be a branch or part of the claimant

Other Decisions Worldwide

Country	Case Name	Court	Date
UNITED STATES	B&B Hard ware Inc v Hargis Industries Inc	Supreme Court	24 March 2015
	Belmora LLC v Bayer Consumer Care AG (the “FLANAX” case)	US District Court for Easter District of Virginia	6 February 2015
CANADA	Reckitt Benckiser LLC v Jamieson Laboratories Ltd	Federal Court	20 February 2015
JAPAN	Kowa Inc v various parties (7 cases)	Various	2014 - 2015
AUSTRALIA	Telstra Corporation Limited v Phone Directories Company Australia Pty Ltd	Federal Court	4 November 2015
	Winnebago Industries Inc v Knott Investments Pty Ltd (No 4)	Federal Court	2 December 2015
	Scandinavian Tobacco Group Eersel BV v Trojan Trading Company Pty Ltd	Federal Court	9 October 2015

United States

B&B Hardware v Hargis Industries (US Supreme Court)

- Issue preclusion in context of trade mark law
- Decisions of Trade Mark Trial and Appeal Board (TTAB) could, in certain situations, later be considered binding on a federal court

The “FLANAX” case

- Full session by Jeffrey Gitchel (Bayer) tomorrow

Canada

Reckitt Benckiser LLC v Jamieson Laboratories Ltd

- Reckitt Benckiser:
 - Registered trade mark MEGARED since 2011
 - Krill Oil Omega -3 supplements launched late 2013

- Jamieson Laboratories:
 - Krill Oil & Fish Oil Omega -3 supplements launched early 2013

- Rare Interlocutory Injunction granted

- Finding of fact as to motive of Jamieson Laboratories

JAPAN

The PITAVA cases*

- Kowa Inc filed 7 actions for infringement of registered trade mark PITAVA in class 5
- Use of 'PITAVA' on pills, tablets or blister packages
- Non- infringement
 - 'PITAVA' merely describes abbreviation of ingredients of medicine, "pitavastatin calcium"
 - Main consumers (doctors & pharmacists) will recognise this
 - Other indications of origin which function as trade mark on PTP sheet
- TM for goods in class 5 'other than pitavastatin calcium' invalid as likely to mislead consumers

*(with special thanks to Shunji Sato, TMI Associates)

Australia

Telstra Corporation Limited v Phone Directories

- 12 year battle – Telstra applied to register YELLOW word mark in 2003
- Full Federal Court upheld trial judge's conclusion that mark lacked any inherent capacity to distinguish print or online directories

Winnebago Industries v Knott Investments

- Compensation under “user principle” could and should be adopted – plaintiff may not have suffered actual loss/wrongdoer may not have derived actual benefit but still reasonable sum to be paid for wrongful use
- Damages for passing off only where acted with fraud

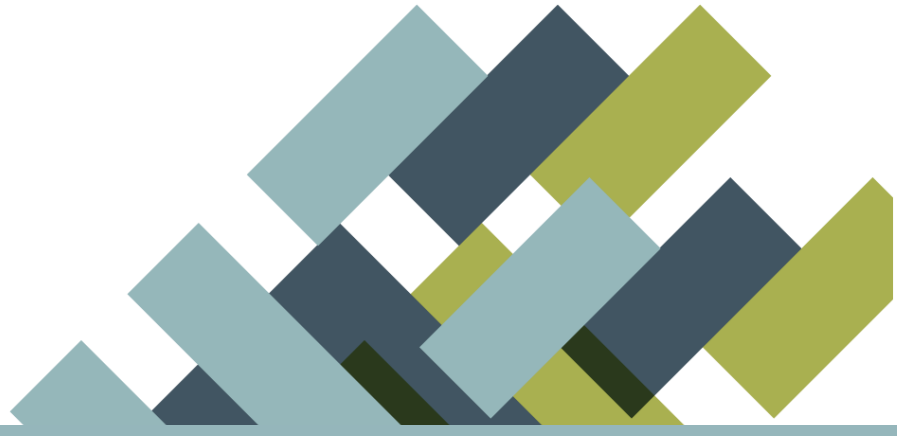
Scandinavian Tobacco v Trojan Trading*

- Parallel importation of cigars – plain packaging rules required re-packaging
- No infringement - held that the mark had been applied to the goods originally with the consent of the TM owner and this was enough - it was this original application, not the re-application of the mark at the time of re-packaging, which had to be authorised

*(with special thanks to Katrina Crooks, Shelston IP)

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Questions & Answers



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