



Editorial: Milestones

Each and every one of us has our own personal milestones, some small some huge and whilst few of us are subject to the scrutiny the United Kingdom monarch was subjected to yesterday as she reached her own milestone, it is a common feeling that we are all clocking up events which have just as much value in our lives as the years go by.

Next month will see an important event for Intellectual Property specialists as the 20th anniversary of the implementation of TRIPS Agreement comes around. Younger members of the profession will have few memories of the beginnings of these crucial steps to enhanced co-operation and harmonised goals whereas for some, 1995 feels like yesterday. Without wanting to appear too long in the tooth myself, the buzz back then when pan-European rights were in their infancy is long gone. Cynics feel justified as the dreamed of level playing field still remains far off on the horizon.

And yet, remaining positive that more can still be done is

an essential part of the human condition and provides the drive that is to be found in every walk of life, embodied both by heroes and ordinary people. Medical research and advances therein are the epitome of pushing back the boundaries. Epilepsy sufferers may well be the first to access pills created using the so-called 3D printing technology following the US Food & Drug Administration approval last August.

Intellectual property law must be able to adapt in such a changing environment. The planned trilateral symposium at the end of October will allow the World Health Organisation, the World Trade Organisation and the World Intellectual Property Organisation to share data with the intention of maintaining focus on the twin challenges of innovation and access in the medical domain.

Between now and then, the Warsaw conference will no doubt provide delegates with an opportunity to take share PTMG milestones as we look forward to our first conference under the Chairmanship of Frank Meixner. I look forward to seeing many of you there.

Vanessa

US Update

New FDA Guidance Implicates Trade Dress Rights

Jonathan S. Jennings, Pattishall, McAuliffe

The U.S. Food and Drug Administration (FDA) may have inadvertently created potential intellectual property disputes with its 18 June 2015 release of its final Guidance "Size, Shape, and Other Physical Attributes of Generic Tablets and Capsules."

(<http://www.fda.gov/downloads/Drugs/GuidanceComplianceRegulatoryInformation/Guidances/UCM377938.pdf>).

This Guidance instructs generic drug manufacturers to minimize physical differences between a generic drug and its corresponding reference listed drug (RLD). The consequence of this Guidance may be to create more tension between branded and generic manufacturers over trade dress rights.

In implementing this Guidance, the FDA worried "differences in physical

characteristics (e.g., size and shape of the tablet or capsule) may affect patient compliance and acceptability of medication regimens or could lead to medication errors." Guidance, 1. The main concern is that these differences make tablets and capsules more difficult to swallow.

According to the FDA, more than 16 million Americans have difficulty swallowing, a condition known as dysphagia. The size and shape of a drug tablet or capsule can affect the ease of swallowing a drug. If the physical characteristics of a tablet or capsule make it more difficult to swallow, then the FDA fears consumers may be less willing to take their prescribed dosages.

To combat this problem, the FDA recommends that generic drug manufacturers consider a tablet or

capsule's size, shape, and other physical attributes during development. In terms of size, the FDA "recommends that generic oral tablets and capsules intended to be swallowed intact should be of a similar size to the corresponding RLD." Guidance, 4. In terms of shape, generic tablets and capsules should "have a similar shape or have a shape that has been found to be easier to swallow compared with the shape of the RLD." Guidance, 5. Finally, the FDA recommended that generic drug manufacturers also consider "tablet coating, weight, surface area, disintegration time, and propensity of swelling" when developing a generic drug tablet or capsule. Guidance, 6.

This Guidance applies only to new drug applications and does not apply to generic drugs already on the market. As is always



Many of you will know by now that I was elected as PTMG Chairman during the Spring conference in Venice earlier this year. I feel highly honored to have been elected by my fellow PTMG Committee Members and really look forward to this new role. At the same time I would like to pay tribute to my wonderful predecessor Sophie Bodet who made such a good job as our previous PTMG Chair in the last three years. It will be quite a challenge to succeed her, but I promise to do my very best!

After a nice summer we are all back to work again. A lot of current developments will most probably require our attention in the months to come such as the draft of a European Trade Secrets Directive, the last revision of the Chinese trademark law, OHIM's Convergence Paper 5 etc. But do not worry: A lot of interesting ongoing topics will be covered in our PTMG Autumn Conference in Warsaw at the end of this month. Again we are fully booked for this event. So I hope to see many of you there!

Frank Meixner

Belgium - Parallel Imports Update

Christian Dekoninck and Judith Bussé, **CROWELL & MORING** Brussels

The repackaging of pharmaceutical products by parallel traders continues to be a topic of discussion before the various European courts. According to the well-known Bristol-Myers Squibb case, trade mark holders cannot prevent the import of their repackaged products on the basis of their trade mark rights if (among other conditions) the parallel trader can establish that repackaging is “necessary” to market the product in the country of importation. This condition is met if, without repackaging, effective access to the markets of the importing member state is hindered. However, if repackaging is only an attempt to secure a commercial advantage, the parallel importer can be prevented from repackaging the products.

In a recently published case, the Brussels Court of Appeal had to decide whether differences in pack sizes between member states made it necessary to repackage the pharmaceutical products. The case concerned losartan, which is marketed in Belgium and Poland under the trade mark Cozaar. In Poland, the country of export, this product is marketed in packs of one size only (containing 28 tablets) whereas in Belgium various pack sizes are marketed (of 28, 56 and 98 tablets). The question arose as to whether it was “necessary” for the parallel trader to repackage the Polish product into packs of 98 tablets.

The parallel trader argued this was indeed the case, as the 98-tablet packs were the most sold in Belgium, whereas the 28-tablet packs were clearly less successful. The trade mark holder on the other hand argued that there was no legal obligation and thus no “objective necessity” to market the 98-tablet packs. The parallel trader still had access to the Belgian market when using the 28-tablet packs, and these could, if necessary, be bundled to make 56 or 98-tablet packs. There was therefore no need for repackaging. According to the trade mark holder the parallel trader was merely trying to secure a commercial advantage

by using a new 98-tablet pack size. Referring to the ECJ case law, the Brussels Court of Appeal ruled in favour of the parallel trader and decided that the differences in pack sizes used by the trade mark holder in the countries of export and import made it necessary to repackage the pharmaceutical products. To decide otherwise would have contributed to the artificial partitioning of the markets between member states. The Court moreover established that the mere bundling of smaller packages was in this case not a valid option or solution for the parallel importer, as the Belgian authorities would have objected to such bundling. The Court saw no need to refer a new question to the ECJ in this regard.

This decision is in line with earlier decisions of the Brussels Court of Appeal, confirming that differences in pack sizes between the member states can be considered to hinder access to the Belgian market. In such circumstances the repackaging of pharmaceutical products may be justified according to the Brussels Court of Appeal, even if the parallel trader would still have retained access to the Belgian market through its use of one of the other pack sizes.

The recent referral to the ECJ by the Danish Sø-og Handelsretten may however impact this case law. In this case the question arose whether the trade mark holder may oppose the repackaging if he markets the medicinal product in the same volume and pack sizes in all the relevant countries where the medicinal product is sold. The Danish court also asked whether it is relevant in such circumstances that the parallel importer purchased the product in one pack size in the country of export and repackaged them in another pack size before marketing the products in the country of import. The decision of the ECJ may clarify the thorny issue of parallel imports and pack sizes. Unfortunately a decision is not to be expected any time soon.

Germany - Parallel Import of Medical Devices

Christian Hertz-Eichenrode, FPS

By a decision of 30 April 2015, the German Federal Supreme Court referred a case to the European Court of Justice in order to get more guidance on the interpretation of European directive 98/79/EC relating to in-vitro diagnostic medical devices (diabetes test strips). Roche Diagnostics GmbH is a manufacturer of different blood glucose metre systems. For their Accu-Chek Aviva and Accu-Chek Compact devices Roche distributes separate test strips in order to ensure the accuracy of the blood tests. The defendant is a reseller and importer of medical devices who imported these test strips from EU Member States to Germany. The importer affixed a product label in German and added a German translation of the user manual. The German text was identical to Roche's German user manual. The sole difference was that the importer's translation of the user manual gave only the UK measure units mmol/l without the German equivalent mg/dl, while both were given in Roche's original user manual in the German language.

Devices for self-diagnosis including blood sugar measurement devices are qualified as medical devices by the directive (annex II, list B). Their marketing is only allowed when they have received, in one of the Member States, an EC declaration of conformity which covers a full quality assurance and a production quality assurance (the CE-marking). The CE-marking, the German label and a German translation of the user manual are prerequisites for the marketing of these products in Germany to accord with the Medical Devices Act (MPG) implementing the directive 98/79/CE.

Roche was of the opinion that the relabeling of the product packaging and reprinting of the user manual in the German language requires a new CE conformity assessment procedure according to annex IV of the directive, because the CE conformity procedure includes the product label and the user manual (in the respective languages). Any relabeling and reprinting comprises the risk of errors and therefore a

reassessment of the EC conformity is necessary.

The German Federal Supreme Court seems to follow this argument considering that the CE marking is intended to give the security to the patient that the information on the product and the instructions how to apply it are accurate. The present case demonstrates the risk of inaccurate information to a patient when a wrong measure unit is given in the manual of a self diagnosis device; this wrong measure unit would make it impossible for German users to check the accuracy of their blood sugar self-test. But the Court had itself some doubts on this harsh interpretation of art. 16 of the directive 98/79/EC as the German text of the importer was identical to Roche German text (except the measure units) and therefore asked the European Court of Justice for interpretation. If in such circumstances where the product itself (test strips) had successfully passed all conformity tests and where the German translation was identical to the approved German text, must the importer first obtain a fresh CE conformity declaration before he is allowed to start marketing the parallel imported medical device.

It should be noted that a second assessment of EC conformity can be based on the results of the first assessment so that only the new elements (label and translation of the user manual in this case) must be examined which is a more formal examination.

The legal issue of the question to CJ of the EU does not seem to be very difficult, but the economic impact could be very important for parallel imports of all types of medical devices which need a technical or other examination before being marketed within the EU. This decision of the German Federal Supreme Court is too recent in order to know a reference number of the CJ, but it is definitely worth following up.

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US Update

the case, compliance with the Guidance is not legally required - the Guidance acts merely as a recommendation to generic drug manufacturers. Nonetheless, a failure to comply may lead to the rejection of an Abbreviated New Drug Application (ANDA) application. As stated on the FDA website, "An Abbreviated New Drug Application (ANDA) contains data which when submitted to FDA's Center for Drug Evaluation and Research, Office of Generic Drugs, provides for the review and ultimate approval of a generic drug product."

This Guidance raises potential trade dress (and patent) concerns. ANDA applicants will look to adopt a similar shape and size for their drugs under the Guidance, but should remain mindful of avoiding the trade dress rights of branded drug owners. See *Ross-Whitney Corp. v Smith Kline & French Labs.*, 207 F.2d 190 (9th Cir. 1953) (holding heart-shaped orange and pink drug capsules were eligible for trade dress protection). The tension will be in adopting functional characteristics of a drug's shape or size, while avoiding distinctive characteristics protected by trade dress law. The new Guidance does not discuss the colouring of generic drug tablets and capsules, probably the most important trade dress element. See *SK & F, Co. v Premo Pharm. Labs., Inc.*, 625 F.2d 1055 (3d Cir. 1980) (holding a maroon and white drug capsule was eligible for trade dress protection). Therefore, this source of differentiating trade dress remains available to generic drug manufacturers.

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EU trade mark law reform – important changes for brand owners in the pharmaceutical industry

Robert Guthrie, Osborne Clarke

Trade mark law and practice in the European Union will be revamped over the next few years as final compromise texts have been agreed for:

- (a) a new replacement Trade Mark Directive (the TMD), which partially harmonises trade mark law and practice across the EU's member states; and
- (b) revisions to the Community Trade Mark Regulation (the CTMR), which governs the law and practice of the EU wide Community trade mark.

The new TMD and the revisions to the CTMR are an evolution, rather than a revolution, of the EU's trade mark system. However, there are still a number of substantive changes to EU trade mark law and practice that will have a significant impact on trade mark owners, including those in the pharmaceutical sector.

Name changes

The Community trade mark or CTM will be renamed the European Union trade mark. The Office for Harmonization in the Internal Market or OHIM (the European Union's trade mark and design registry) is also being renamed and will in the future go by the rather more prosaic moniker of the European Union Intellectual Property Office.

Substantive law changes

Key changes to note, particular for brand owners in the pharmaceutical sector, are:

Counterfeit goods in transit

At the moment EU trade mark rights are not infringed by goods that are merely transiting through the EU, even if those goods are counterfeits. This means brand owners and customs authorities can find it difficult to seize counterfeit goods in transit and stop them from entering other jurisdictions (where they may not be identified and detained). It also makes it

easier for counterfeit goods to be diverted to the EU market.

The compromise texts provide that goods in transit will infringe trade mark rights where they bear without authorisation a trade mark which is identical to a trade mark registered for the goods concerned (Article 9(5) of the revised CTMR and Article 10(5) of the new TMD). However, the trade mark owners' right to take action will lapse if the holder of the goods provides evidence that the trade mark owner cannot prevent the sale of the goods in the intended final destination.

These new provisions proved to be somewhat controversial. In particular, there was a concern that these provisions could be used to inhibit the transit of generic medicines through the EU. To deal with these concerns, a number of recitals have been added that make it clear that these new provisions are intended to be compatible with the EU's GATT obligations and, as regards generic medicines, the 'Declaration on the TRIPS Agreement and Public Health' adopted by the Doha WTO Ministerial Conference on 14 November 2001 – which provides that the TRIPS Agreement does not and should not prevent members from taking measures to protect public health.

Furthermore, what is currently Recital 19e of the revised CTMR and Recital 22d of the new TMD states that:

"Appropriate measures should be taken with a view to ensuring the smooth transit of generic medicines. With respect to international non-proprietary names (INN) as globally recognized generic names for active substances in pharmaceutical preparations, it is vital to take due account of the existing limitations on the effect of [European Union] trade mark rights. Consequently, the proprietor of a [European Union] trade mark should not have the right to prevent any third party from bringing goods into the [Member State/Union]

without being released for free circulation there based upon similarities between the INN for the active ingredient in the medicines and the trade mark."

It is not entirely clear how the new provisions on goods in transit could inhibit the transit of generic medicines based on similarities between the INN and the trade mark, as they only apply when the goods bear a trade mark which is identical to the registered trade mark. However, the recitals are clearly designed to inhibit this new right being used against the transit of generic medicines.

Use of mark on packaging and other means

Pharmaceutical brand owners will also be pleased that trade mark owners have been given a new right to prohibit use of the same or similar trade marks on "packaging, labels, tags, security authenticity features or devices or any other means on which the mark may be fixed" where there is a risk that such packaging, labels or other means will be used to infringe the trade mark owner's rights (Article 9a of the revised CTMR and Article 11 of the new TMD).

This new provision should make it easier for customs authorities to take action when such materials are imported into the EU with the intention of affixing them to counterfeit products within the EU.

Graphic representation

The requirement that trade marks must be capable of graphic representation will be removed. This will remove some of the practical obstacles to the registration of non-traditional marks, such as sound, smell and dynamic marks. However, the removal of the graphic representation requirement does not mean that such marks will be any more likely to avoid an objection on the grounds that they are non-distinctive.

Trade marks that cover Nice class headings can be extended

Owners of CTMs filed before 22 June 2012 that cover one or more of the Nice class headings will be given a six month period during which they can expand the list of goods and services covered by their marks (Article 28(8) of the revised CTMR).

This provision follows on from the Court of Justice's judgement in *IP Translator*, which ruled that the use of the Nice class headings in trade mark specifications did not mean that all goods or services within that Nice class were covered. This ruling was contrary to OHIM's practice at the time, so it has been felt desirable to give trade mark owners the opportunity to add in other goods and services from the Nice classification.

Provisions have been included in the new CTMR to ensure that these additional indications cannot be asserted against third parties who have obtained trade marks or commenced use prior to the amendment of the register.

Brand owners in the pharmaceutical sector and related industries who filed CTMs for the Nice class headings prior to 22 June 2012, may wish to note that:

- (c) the Nice class heading for class 5 covers Pharmaceutical and veterinary preparations but not, for example, diagnostic preparations;
- (d) the Nice class heading for class 10 covers surgical, medical, dental and veterinary apparatus and instruments but not, for example, medical clothing and medical furniture; and
- (e) the Nice class heading for class 42, covers medical services but not pharmaceutical services or other human healthcare services.

Increased harmonization

The new TMD also provides for a much greater level of harmonization, partly of substantive law but mainly of registry practice and procedure. These include mandatory administrative procedures for revocation and invalidity actions, which

will require changes to the law in a number of Member States, including Italy and Spain.

Fee changes

The practice of the basic CTM filing fee covering up to three classes has been scrapped. OHIM's fees will be reduced slightly from EUR €900 to EUR €850 for one class applications; will effectively stay the same for two class applications; and will increase by EUR €150 for applications covering three or more classes. Whilst this means that application fees are broadly increasing, it is obviously good news for those pharmaceutical companies who only wish to cover class 5 and will perhaps also help to reduce the cluttering of the register.

Most other fees, including renewal fees, are being reduced – renewal fees for a three class mark, for example, are being reduced from EUR €1,350 to EUR €1,050.

Timeline

The expectation is that the new TMD and the revisions to the CTMR will be adopted towards the end of 2015. Most of the substantive legal changes that arise from the revisions to the CTMR will come into force 90 days after its publication in the Official Journal, which will be shortly after the revisions are adopted. However, the removal of the graphic representation requirement and many of the procedural changes are not due to take place until 18 months after its adoption.

The time scale for transposition of the TMD is longer, with Member States being given three years to put in place most of the necessary legal and administrative changes to comply with the new TMD (the exception being the requirement for administrative cancellation procedures, which Member States will have seven years to comply with). The substantive changes to trade mark law, including the rights enjoyed by trade mark owners, will not apply to national marks until the day after that deadline expires. The consequence of this is that there will be a period of almost three years in which there are significant differences between the rights enjoyed by holders of CTMs and holders of national trade marks.

Members News

New Members

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

Clare Jackman of Norton Rose Fulbright LLP, London, UK
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Aurelie Boissaye of Biofarma, Suresnes, France
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Matias Noetinger of Noetinger & Armando, Buenos Aires, Argentina
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Ezgi Baklaci of Moroglu Arseven Law Firm, Istanbul, Turkey
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Moves and Mergers

John Ward is now working for Alcon (part of the Novartis Group) in Geneva, Switzerland. John can be contacted at john.ward@alcon.com

Jonathan Day has left Arnold & Porter LLP and is now with Carpmaels & Ransford LLP, London, UK. Jonathan can be contacted at jonathan.day@carpmaels.com

Birgitte Waagepetersen has left Horten to join Budde Schou A/S in Copenhagen, Denmark. Birgitte can be contacted at bwa@buddeschou.dk

Fabio Pezzolato has left Chas Hude to join Zacco A/S in Copenhagen, Denmark. Fabio can be contacted at Fabio.pezzolato@zacco.com

Jacob Bremer is now with BarentsKrans N.V. in The Hague, The Netherlands. Jacob can be contacted at jaap.bremer@barentskrans.nl

Chris McLeod has left Squire Patton Boggs to join Elkington & Fife in London, UK. Chris can be contacted at chris.mcleod@elkfife.com

Rebecca Lawrence formerly with Powell Gilbert, will join Redd Solicitors LLP in London, UK, as a partner, on 27 September 2015. Her email address will be rebecca@redd.eu.

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

International Update

Australia

**Georgina Hey and Alyson Poole
Norton Rose Fulbright Australia**

By their very nature, intellectual property rights create monopolies. This can prompt concerns for competition and the public interest. Striking the correct balance between these dichotomies is a difficult task, and one which jurisdictions have varying approaches toward. The question is often posed whether intellectual property rights and the monopolies they create lead to increased innovation, or whether more free markets and increased competition is preferable.

In Australia, this topic is currently up for review, after Treasurer Joe Hockey and Minister for Small Business, Bruce Billson released a joint media statement on 18 August 2015, announcing that the Productivity Commission would commence an inquiry into Australia's intellectual property arrangements. The inquiry was the result of a key recommendation of the Competition Policy Review released on 31 March 2015 (the Harper Review).

Despite noting the difficulties in such a task, the Harper Review commented that "an appropriate balance must be struck between encouraging widespread adoption of new productivity-enhancing techniques, processes and systems on the one hand, and fostering ideas and innovation on the other." The main concern for the Panel of the Harper Review was the fact that "Australia has no overarching IP policy framework or objectives guiding changes to IP protection or approaches to IP rights in the context of negotiations for international trade agreements."

In accordance with the Harper Review recommendations, Mr Hockey and Mr Billson described the purpose of the Productivity Commission inquiry, stating that "the Australian Government wishes to ensure that the intellectual property system provides appropriate incentives for innovation, investment and the production of creative works while ensuring it does not unreasonably impede further innovation, competition, investment and access to goods and services" [emphasis added]

The inquiry will have a particular focus on how Australia's current intellectual property arrangements effect investment, competition, trade, innovation and consumer welfare, with a specific examination of the scope and duration of intellectual property protection in Australia. The Productivity Commission will be consulting with both government and

non-government stakeholders, and public consultation is also ensuing.

Intellectual property rights and the opening up of competition has been felt particularly in Australia in the pharma industry, as the Government has a financial policy of encouraging the greater use of generics (once pharmaceuticals are off patent) through certain financial schemes under the Australian Pharmaceutical Benefits Scheme. It will be interesting to see what effect this government approach has on the Productivity Commission report, which has been driven by a key recommendation of the Harper Review.

The inquiry will also pay regard to trading partner arrangements and experiences of past advanced economy intellectual property reform. These kinds of considerations could be influential to Australian reform, particularly where similar approaches are taken to that in European jurisdictions. For example, competition rules in the European Union can have significant effects on the ability of owners of intellectual property to exploit their rights, including circumstances where intellectual property licensing arrangements can be found to be unenforceable. Such restrictions are implemented in accordance with the Treaty on the Functioning of the European Union.

In Australia, all businesses where intellectual property is of key relevance, including the pharma industry, will be interested to see the Productivity Commission's report on how to balance intellectual property monopolies granted as a reward for innovation, with the need to encourage competition.

Crimea

PETOSEVIC

The deadline for filing revalidation requests for IP rights originally registered in Ukraine and owned by the parties permanently residing or located in Crimea has been moved from 1 January 2015 to 1 July 2016.

On 22 July 2014, Russia's President Vladimir Putin signed a law regulating IP protection on the territory of the Crimean Peninsula, i.e., the Federal law on the additional amendments to the Federal Law on the introduction into effect of Part IV of the Civil Code of the Russian Federation.

According to the law, Russia recognizes the exclusive rights to inventions, utility models, industrial designs, trade marks, service marks and appellations of origin that were originally registered in Ukraine and owned by the parties permanently residing or located in Crimea,

provided that the rights are re-registered on the basis of applications submitted to the Russian PTO by IP right owners who had become citizens of the Russian Federation or by former Ukrainian legal entities that had been re-registered as legal entities in the Russian company register. In case they have pending Ukrainian applications, the above-mentioned persons can re-file the applications in Russia in order to maintain prior rights from Ukrainian applications.

Macedonia

**Gordana Pavlovic, Cabinet
Pavlovic, Brussels and Belgrade**

At its session of 26 May 2015, the Parliament of the Former Yugoslav Republic of Macedonia enacted a new law on customs measures for the enforcement of IP rights, which was published in the Official Gazette on 28 May, 2015 and came into force on 5 June 2015. The implementing regulations were enacted on 25 June 2015 and published in the Official Gazette on 26 June 2015 and came into force the following day.

The new legislation is modelled after EU Regulation 608/2013 concerning customs enforcement of IP rights and represents an effort on Macedonia's part to harmonise its customs legislation with that of the European Union. Trade mark owners must now provide more information in order to establish a customs watch, but the procedure to obtain the destruction of counterfeit goods is simpler and more straightforward.

Several changes to the procedure for establishing a customs watch have been introduced. First, an application can now cover several trade marks belonging to the same trade mark owner; in the past, trade mark owners had to file a separate application for a customs watch for each of their trade marks. Further, it is no longer necessary to provide a liability declaration as a separate document, as such declaration is now included in the application form. On the other hand, it is expected that the preparatory work will take more time, as trade mark owners are now required to provide more details about genuine goods and their channels of trade. It remains to be seen how this will work in practice.

In addition, certain deadlines have been changed. For example, an application for customs watch renewal must be filed 30 working days before the date of expiry of the customs watch (in the past, this deadline was less strict). Further, in case of ex officio seizure of suspected counterfeit goods, the trade mark owner has four working days to

establish a customs watch (in the past, the deadline was three working days). Moreover, under the simplified procedure, the destruction of the goods at the trade mark owner's expense must be requested within a deadline of 10 working days, which cannot be extended (in the past, an extension was possible).

As under the previous legislation, filing a lawsuit is necessary only if the owner of the goods explicitly objects to the seizure. The deadline is 10 working days from the date of receipt of the customs notification, extendible for another 10 working days. Failure to file a lawsuit or to request the destruction of the goods under the simplified procedure when the conditions for such destruction are fulfilled will result in the release of goods. In addition, Customs has the right to cancel the customs watch and to refuse to re-establish it for a period of one year.

Finally, the new law introduces a special procedure for the destruction of small consignments containing suspected counterfeits - that is, postal or express courier consignments that contain three units or fewer, or weigh less than two kilos. Customs will destroy such consignments without sending a prior notification to the rights holder, at the rights holder's expense, provided that:

- the goods are not perishable;
- the rights holder has explicitly requested this procedure in its application for customs watch; and
- the declarant or the holder of the goods does not explicitly object to the destruction of the goods within a 10 working-day deadline.

If the declarant or the holder of the goods objects, Customs will inform the rights holder, who then has 10 working days to institute civil proceedings.

Philippines

Jennifer D. Fajelagutan and Denise Mirandah mirandah asia (Philippines) inc

Pediatrica Inc. (Pediatria) filed an Opposition to the registration of Trade Mark Application MYCOFORM filed in the name of Realvet Incorporated (Realvet) in Class 5. Pediatria based the Opposition on its registered mark MYCODERM registered in Class 5 as well. While Realvet's mark had been applied for veterinary products, Pediatria's mark covered topical corticosteroid.

The Opposition was based on Section 123.1 (d) of Republic Act No. 8293, also known as the Intellectual

Property Code of the Philippines (IP Code), which states that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- (i) the same goods or services; or
- (ii) closely related goods or services; or
- (iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion.

Pediatrica's mark had been filed on 30 March 2012 while Realvet's mark was filed on 19 September 2012, qualifying Pediatria's mark as the earlier mark. Realvet had failed to respond to the Notice to Answer. Under the Rules, in the event the Respondent fails to Answer, the Respondent will be considered in default and the Hearing Officer will resolve the issues based on the pleadings and evidence submitted.

It was held that the two marks were almost identical, and that the difference was merely in the fifth letter of both marks. Thus, the marks were deemed to look and sound alike to each other. It was further held that merely adding, removing or changing some letters of a registered trade mark is not enough to avoid causing confusion. Such close similarity was held to cause confusion and would deceive the ordinary consumers.

Serbia

Gordana Pavlovic, Cabinet Pavlovic, Brussels and Belgrade

At a session held on 5 March 2015, the Serbian government enacted a decree on the conditions and procedures for the application of measures for customs enforcement of IP rights, replacing the 2010 decree. The new decree was published in the Official Gazette No 25 of 13 March 2015. It came into force on 21 March 2015 and will be applicable from 1 September 2015. The decree is modelled after EU Regulation 608/2013 concerning customs enforcement of IP rights and reflects Serbia's efforts to keep its customs legislation harmonized with the EU legislation.

It is important that IP rights holders take the time to establish a customs watch in Serbia without waiting for goods to be seized ex officio, because the deadline for establishing a customs watch in ex officio cases is only four working days. A liability declaration is no longer required as a separate document, as it is now integrated in the application for customs watch. On the other hand, the new decree requires IP rights

holders to provide more information and materials about genuine goods in order to enable customs officials to detect counterfeits. This includes technical information about genuine goods and distribution channels. It remains to be seen how much details Customs will request in practice and whether this will apply to all goods covered by the trade mark registration, or only those which are of main interest to the IP rights holder.

Further, the new decree provides for the destruction of goods under a simplified procedure, without a court order, provided that the holder of the goods consents to the destruction (explicitly or tacitly) within a deadline of 10 working days (three working days for perishable goods). The IP rights holder must confirm that the goods are counterfeits and request their destruction within a deadline of 10 working days. This deadline can no longer be extended, except if the IP rights holder decides to file a lawsuit. The old decree allowed for a deadline extension of 10 working days, both for the request for destruction of the goods under the simplified procedure and for the lawsuit.

Finally, the new decree introduces a special procedure for the destruction of small consignments (ie, postal or express courier consignments that contain three units or fewer or weigh less than two kilos). Customs will destroy such consignments without sending a prior notification to the rights holder, at the latter's expense, provided that the goods are not perishable, that the rights holder has explicitly requested this procedure in its application for customs watch, and that the declarant or the holder of the goods has not explicitly objected to the destruction within 10 working days. If there is an objection, customs will inform the IP rights holder, which will then have 10 working days to institute civil proceedings. Dealing with small consignments requires certain technical adjustments which Serbian customs has yet to implement, so it is expected that it may take some time before this procedure starts to work in practice.

Slovenia

Gordana Pavlovic, Cabinet Pavlovic, Brussels and Belgrade

The Slovenian IP Office reversed its initial refusal of the trade mark SOFTFIT with respect to goods in Class 10 and sent a Statement of Grant of Protection to WIPO on 12 May 2015.

On 15 October 2014 the office had provisionally refused protection of

Pensive General Court provides useful guidance for practitioners

John Colbourn, Redd

Introduction

On 3 June 2015, the General Court of the EU issued judgment in a long running battle between Pensa Pharma SA and Ferring BV and Farmaceutisk Laboratorium Ferring A/S.

The case is interesting because it covers a number of points of relevance for trade mark practitioners, and some specific points of interest for pharmaceutical trade mark practitioners in particular. Many of these points may sound like familiar arguments, especially to earlier rights holders, but it is always useful to find authority for the familiar arguments enunciated in a decision of the courts.

Background

According to the judgment, in 2000 the parties agreed a co-existence agreement under which Pensa Pharma SA (PPSA) was permitted to maintain and use a particular CTM registration for the blue figurative mark shown below. It is not clear what, if



any, other terms governed use of and making applications for registrations of the word marks or other devices.

In 2006, PPSA applied for two Community trade marks, for the two marks shown below, in relation to goods in classes 3, 5 and 44:

PENSA PHARMA 

Ferring BV and Farmaceutisk Laboratorium Ferring AS (Ferring) initially opposed the applications, but withdrew the oppositions in December 2008. The applications proceeded to register and, in September 2009, Ferring filed applications for invalidity of the two registrations, based on its rights in the mark PENTASA. The invalidity was ultimately directed at goods in classes 5 and 44 only.

The OHIM Cancellation Division upheld the applications for invalidity in their entirety and the Board of Appeals upheld that decision. PPSA appealed to the General Court on a number of grounds, all of which were dismissed.

Brand PHARMA

PPSA argued that the Board of Appeal had not taken sufficient account of the presence of the element PHARMA in the word mark PENSA PHARMA. The Court noted the established principles of law, including in particular that: the global assessment of a likelihood of confusion must, so far as the visual, phonetic or conceptual similarity of the signs at issue, be based on the overall impression given

by the signs bearing in mind, in particular, their distinctive and dominant elements; the average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details; that only if all other components of a mark are negligible should the assessment of the similarity be carried out solely on the basis of the dominant element.

The Court held that the consumer would nevertheless break the sign down into word elements which suggest a specific meaning or which resemble words known to the consumer, and weak distinctive character of one element does not necessarily mean that the element will not be taken into consideration.

In this case, while the relevant public would not disregard the element PHARMA, as it could not be considered negligible (at least visually), aurally the public will not necessarily pronounce the element as it would be considered “superfluous” because of the nature of the goods and services, and conceptually the element would have no effect because it was descriptive for the goods and services at issue. As a result, in the global assessment of whether there would be a likelihood of confusion, the element PHARMA would not “contribute to the essential function of a trade mark” because it is a well-known abbreviation designating companies that belong to the pharmaceutical industry. As such, it would not enable the relevant public to distinguish the goods and services in question from one undertaking or another and therefore, in a global assessment of all the relevant factors, the element PHARMA was not capable of affecting the assessment of a likelihood of confusion with the earlier marks.

Comparison of goods and services for which the marks would be used?

PPSA tried to argue that the Board of Appeal should have taken account of the assertion that PPSA intended to use the signs in issue only for a subset of the products in question, and that Ferring itself only used the earlier rights for a subset of pharmaceuticals too. The Court rejected that as a matter of law – the comparison is not with the goods for which the proprietor envisages using the mark - it is the specifications which are to be compared, subject only to a proof of use requirement for the earlier marks. Even though PPSA filed a limitation to its specification, it did not specifically put Ferring to proof of use and so the limited specification was still identical to the specification protected by the earlier rights.

The Court also made some interesting

observations that the following goods were to be considered similar to pharmaceutical preparations on the basis that they have the same purpose or intended use (medical care), are aimed at the same consumers (end consumers and professionals in the health sector) and use the same distribution channels: sanitary preparations for medical purposes; dietetic substances adapted for medical use; materials for dressings, plasters and disinfectants. It might have been interesting to see whether a finding of similarity of goods would have followed had PPSA successfully challenged Ferring on proof of use resulting in a narrower specification for the earlier rights.

Level of attention of the average consumer of pharmaceutical goods and related services

The Court made a useful observation that, even though the level of attention of the relevant public for pharmaceutical goods and services may be considered to be high, it does not necessarily follow that differences between the marks will negate a likelihood of confusion. In this case, given the similarity between the goods, services and signs at issue the level of attention was not such as to exclude the possibility that the public might believe that the goods or services came from the same undertaking or an economically connected undertaking. Even with high attention, the key principle of law remains that the average consumer rarely has the chance to make a direct comparison between the marks and must rely on an imperfect recollection of them.

Registrations by consent? Co-existence on the market, withdrawing oppositions and prior co-existence agreement

PPSA argued that Ferring had consented to the registration of the two registrations, relying on apparent peaceful co-existence in the Spanish market, the fact that Ferring had withdrawn the oppositions against the applications, and in reliance on the terms of the co-existence agreement from 2000.

The relevant provision, Article 53(3) of the CTM Regulation 207/2009, provides that a CTM shall not be declared invalid where the proprietor of the earlier right “consents expressly” to the registration before submission of the application for invalidity.

Even if accepted as a fact, the alleged peaceful co-existence did not satisfy the requirement for consent to be ‘express’, which is perhaps not surprising.

Health Canada Guidance on Drug Brand Name Assessment: Now in Effect

Jennifer McKenzie and Amy Dam, Bereskin & Parr LLP, Toronto, Canada

Of more interest is the clear statement by the General Court that “there is no provision in Regulation 207/2009 that provides, at least expressly, that the withdrawal of an opposition entails the renunciation of the right to file an application for a declaration of invalidity. That withdrawal does not therefore, in law, have any effect on the lawfulness of the filing of a future application of invalidity”. This is a useful confirmation of the potential ‘gap’ left by the decision in *Budweiser* (I645/2001), which had made clear that an unsuccessful opposition did not create *res judicata* on the basis that “opposition proceeding before the Office constitute a particular expression of the so called “right of opposition”... if the opponent fails in his attempt, he can nevertheless file a cancellation action before the Cancellation Division or bring a counter claim in an infringement action before a national court”. This approach was also adopted by the English Court of Appeal in *L’Oreal v Special FX* in 2007 in relation to oppositions in the UK IPO, which stated that “the decision of the Registry on opposition proceedings, or more generally a decision to register despite opposition, is not a final decision so as to be capable of being the basis for an issue estoppel”. In this case, at the time of withdrawing the oppositions, Ferring had expressly stated that it intended to bring an application for invalidity of the registrations at a later date, which further demonstrated a lack of express consent on the facts.

PPSA also argued that Ferring had consented to the registrations by virtue of the co-existence agreement referred to above. According to the judgment, the co-existence agreement applied only to the blue logo shown above and, therefore, could not be interpreted as amounting to express consent for Article 53(3).

Practice points for co-existence agreements to keep in mind include:

- whether it is in the client’s interests to have a broad definition of sign in the co-existence agreement (or not);
- including clear expressions of consent to future applications and registrations if the agreement is intended to do that; and
- ensuring the marketing and branding teams are aware of any restrictions agreed to in any co-existence agreement as to use (creative freedom) and future trade marks and logos.

According to Curia, the CJEU website, an appeal was filed on 12 August 2015 – it will be interesting to see which points are argued on appeal and how the CJEU responds to them.

Sponsors filing a drug submission must also provide a brand name assessment as part of the drug safety and effectiveness evaluation. The objective of this assessment is to evaluate the potential for a proposed drug name to be confused with other authorized products in Canada with the aim of preventing medication errors.

The Health Canada Guidance Document for Industry – Review of Drug Brand Names¹, first released on 2 July, 2014 came into effect on 13 June, 2015. The guidance replaces the 2013 Draft Revised Guidance Document for Industry – Review of Drug Names for Look-Alike Sound-alike (LASA) Attributes.

Notable changes in the guidance include the following: non-prescription products and natural health products are not included in the scope of the guidance 2; raw data to be submitted is limited to database search results (although Health Canada reserves the right to request additional material when deemed necessary); the orthographic and phonetic similarity threshold is lowered from 65% to 50%; and psycholinguistic tests are no longer required.

Brand Name Assessment Process

The sponsor must first carry out (1) an initial brand name review to determine whether the name is misleading with respect to the composition, effectiveness or safety, and then provide (2) a Look-alike Sound-alike (LASA) brand name assessment to determine the likelihood of confusion between the proposed name and authorized product names (3).

The testing of LASA attributes involves a multi-step approach.

The **Search** step involves searching relevant drug name and medication error databases (the Drug Product Database and the Licensed Natural Health Products Database) and identifying drug names with a combined orthographic and phonetic similarity score of 50% or more.

The **Simulate** step involves assessing the confusability of a proposed name by

inserting it into a variety of prescribing, transcribing, dispensing and administration scenarios and documenting the resulting failures, as well as developing a process map that outlines where and how the proposed drug will be used and who in the medication use system will come into contact with the product.

Finally, the **Synthesize** step involves synthesizing the evidence obtained from the database search results and the simulations, and completing a Failure Mode and Effects Analysis to make a decision on the likelihood of confusion with the proposed name.

Health Canada will review the information submitted by the sponsor and may reject a name and request a name change if it considers that the name is likely to cause confusion with other products or is misleading. If safety concerns remain, Health Canada may refuse to issue a Notice of Compliance for new drugs or a Drug Identification Number for existing drugs.

In selecting a drug brand name, sponsors must also be mindful of the trade mark registration process under the Trade Marks Act which focuses not on the confusability on a safety perspective, but on the likelihood of confusion as to the source of manufacture of the product.

(1) Available at: http://www.hc-sc.gc.ca/dhpmpps/pubs/medeff/_guide/2014-review-examen_drug-medicament_names-marques/index-eng.php.

(2) The guidance applies to innovative and generic drugs for human use in which a brand name is proposed (pharmaceutical drugs, Schedule D and Schedule C products, behind-the-counter drugs and drugs sold directly to healthcare professionals for professional use).

(3) Brand names that contain the proper of common name(s) in final dosage form in combination with a modifier, the manufacturer name or an acceptable abbreviation of the manufacturer name are exempt from the LASA Brand Name Assessment.

CTM case law review on pharma marks from April to July 2015

Verena von Bomhard, Bomhard IP

During the four months April to July 2015, the Boards of Appeal of OHIM and the General Court of the European Union issued roughly 140 decisions concerning trade marks that cover goods in classes 5 or 10, and services in class 44. About 50 decisions addressed substantive issues relating to goods or services of interest to the pharmaceutical industry. This article provides an overview of those decisions, trying to highlight tendencies. If anything of relevance has been overlooked, the author apologizes.

Absolute Grounds

There were 20 decisions concerning absolute grounds for refusal. The examiner's objection was overcome in six cases.

- NAPANT had been refused as similar to the INN BIRINAPANT. The Board held, however, that the mere similarity between an INN and a pharmaceutical trade mark did not justify the refusal of the latter.
- MTB EXPLORER referred to services, namely the identification of microorganisms, in class 44. The first instance examiner had considered that MBT would be understood as standing for microbiotechnology; the Board, however, did not consider that to be proven.
- In the case PROBAR, the Board took issue with the examiner's dissection of the mark, which concerned dietetic supplements, into the elements PRO and BAR, reading the mark as meaning bars for professionals. The Board therefore annulled the examiner's decision but remitted the case back to it for further examination, as the examiner had not considered the Spanish meaning of PROBAR which is simply to try.
- SYSTALA, even though similar to the Czech word systola, was not found descriptive for pharmaceutical goods, contrary to the examiner's finding.
- As regards GENESTAT, the examiner considered this to indicate statistics regarding genes, which led to the refusal of the mark for molecular diagnostic platform devices in class 10. The Board, in turn, found that the mark was a fanciful neologism and allowed the applicant's appeal.
- Finally, the rejection of the word mark

GUIDE for a wide list in class 5 was annulled as the Board did not think the examiner had explained why the fact that a guide was a book containing explanations made the mark descriptive for goods in class 5. The case was remitted for further examination.

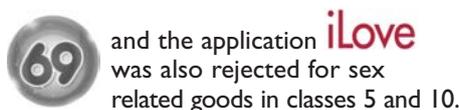
In ten cases, the Board maintained the refusal of figurative or stylized marks. The first group of marks in this respect concerns signs where the verbal element is entirely descriptive or non-distinctive and where the figurative elements even increase the non-distinctive impression. Note that Qualitätsmarke – Das Plus in der Pflege is German for quality mark - the plus in care, and APOTEKE is extremely similar to the Danish, German, and Croatian words for pharmacy (APOTEK, APOTHEKE, APOTEKA respectively).



The second group of marks fell victim to the increasingly strict criteria applied in the examination of figurative marks that contain non-distinctive words. These marks were all applied for in relation to, inter alia, dietetic supplements.



Similarly, the circle around the number 69 did not help to make the following sign distinctive for condoms:



The third group, finally, contains marks that were considered non-distinctive by reason of their simplicity and potentially decorative nature. The first concerned oral care, the second nutritional supplements.



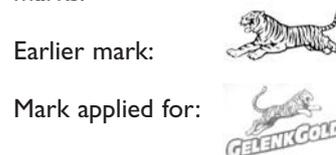
The following mark, however, was considered registrable in class 5 (and many other classes), although not in class 28:

Other marks that were refused were (without claim to completeness) the shape of a container (white plastic with red cap), RIBOTRANSPORTER, SCIENCE BEHIND BEAUTY, BasenCitrata, all in class 5, and POROSTRAP and Swingjaw for goods in class 10. Swingjaw, applied for in relation to instruments for use with medical and surgical endoscopes, was defined as "a pair of hinged or sliding components of a machine or tool designed to grip an object that moves rhythmically to and fro or moves in a curve forceps" and, as such, descriptive.

Relative Grounds

Phonetic comparison for figurative marks

Of the decisions concerning likelihood of confusion, the most notable is that of the General Court concerning the following marks:



OHIM's Opposition Division and the Board of Appeal had found these marks to be confusingly similar. The Court, however, disagreed, holding that there was only a low degree of visual and conceptual similarity, and that the marks were phonetically dissimilar. While the Board had assumed that there could be no aural comparison, the Court considered that consumers would "pronounce" the earlier figurative mark as tiger. The case will now go back to OHIM's Boards of Appeal for a new decision on the merits.

High attention level

Likelihood of confusion was found or denied in about the same number of cases. The assumption of a high level of attention on the part of the relevant public is now ubiquitous and had an impact on many cases, in two cases explicitly so. In the case THEA v ATHEA, the Board of Appeal found likelihood of confusion in respect of goods in class 3 but not in classes 5 and 10, due to the higher level of attention. Also in the case



the Board held that the high level of attention helped to exclude a likelihood of confusion – in that case in respect of nutritional supplements.

Similarity of marks

Other cases that turned on the similarity of the marks, as the goods were identical, and where likelihood of confusion was denied, concerned the following pairs – all in class 5: KORAGEL v CHORAGON (judgment of the General Court); SENSIGEL v GENGIGEL; TITANIA v VIVANIA; EG LABO v IGLAB; UROL v DISSOLVUROL,



v Abco.

In this latter case it was held that the visual, phonetic and conceptual differences between ABC and Abco clearly ruled out a likelihood of confusion.

Also in the case concerning HOMP v OOMPH - trade marks for medical services in class 44 – the low similarity of the marks was found to avoid any confusion on the part of the – attentive – public.

On the other hand, the following marks were considered to be sufficiently similar for creating a likelihood of confusion in respect of identical goods: SKINTRO v SIXTRO, both for pharmaceutical goods (in particular with a view to the non-English speaking public who would not recognise skin or six as part of the marks); APOVIT v ATOVIT A Z (contrary to the Opposition Division who had focused on the difference in the first syllables and the weakness of -vit standing for vitamins); LARYVOX v LARYMEX, both for identical goods in class 10;



and for (inter alia) pesticides, fungicides and herbicides in class 5.

Similarity of goods

A likelihood of confusion was furthermore found in cases where the goods were not identical. Across different classes of the Nice Classification, in the three cases XEROX DENTAID v xerospray, xerorinse, and xerogel (all figurative marks), the Board held that drawing the line between mouth care preparations in class 3 and pharmaceutical preparations in class 5 was difficult, and that there was a significant overlap. This is a reminder to applicants to limit their applications to the pharmaceutical preparations of interest, at least in view of an opposition. And in the

case  v FARMIO wolne od GMO

(which translates to FARMIO free from genetically modified organisms) the Board

found likelihood of confusion, and in particular, that goods in class 29 and food for babies in class 5 were similar. In ESSENS v ESSENTIX, the Board held that dietary supplements for medical purposes were similar to pharmaceutical products for the treatment of the central nervous system. The similarity of dietetic substances for medical use on the one hand and pharmaceutical preparations on the other was further confirmed in the case REVIDOX v REBIDOSE, essentially because these products share the purpose of improving a patient's health problem. A likelihood of confusion was found to exist.

Further, in BLISSEL v SISSEL, likelihood of confusion was confirmed for goods that were found similar to a normal degree. The earlier mark was protected for gynecological products and the junior mark covered goods in classes 5 and 10. The goods in class 5 were considered to be similar, those in class 10 not, or not sufficiently.

Similarly, the Board found likelihood of confusion between marks that covered different apparatus or instruments in class 10 in two cases. One case concerned the marks PICCO v PICO (apparatus for monitoring physiological parameters in intensive medicine v portable electronic devices for providing negative pressure wound therapy), the other the marks

IMAGIO v  (opto-acoustic imaging apparatus for diagnosis of breast cancer v surgical and medical operating tables and instruments).

On the other hand, the Board of Appeal found no likelihood of confusion, due to the differences in the goods, between PRIM v EYEPRIM for orthopedic articles and treatments for conjunctivitis. The Board emphasized that the healthcare sector is vast and that goods cannot be considered similar merely because they are related to it.

Weak elements

Finally, in one case, the Board of Appeal took into account the weak nature of the common element of the marks at issue. The opposition was based on a number of marks consisting of or containing the element medi and the allegation of a family of marks based on that element. Yet the Board found no likelihood of confusion with the trade mark

applied for,



because of the weakness of the element medi. The evidence did not show use of a variety of marks allowing the conclusion of a family of marks or an otherwise enhanced distinctiveness of this inherently

weak element.

This tour d'horizon shows that, in the microcosmos of pharmaceutical marks (in the widest sense) at OHIM, all discussions of general interest to the trade mark community in the EU are reflected, with some specificities, such as the general assumption of a higher level of attention, which may exclude confusion where it would be found for other types of goods.

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International Update

Novartis's trade mark SOFTFIT based on Article 43, paragraph 1, points b) and c) of the Slovenian IP Law, i.e., due to the alleged descriptiveness and lack of distinctiveness with respect to the goods covered in Class 10 of the Nice Classification namely, surgical, medical and ophthalmic apparatus and equipment.

Novartis responded to the provisional refusal by arguing that the mark is not descriptive of the goods covered in Class 10 and that it has at least minimum distinctiveness necessary to obtain protection. Novartis argued that SOFTFIT is a fanciful term, which is not featured in dictionaries and which does not have a meaning in the Slovenian language or in any other language. Novartis pointed out that the mark had passed the examination on absolute grounds in numerous countries, including in Ireland and in UK, where English is the official language, i.e., that the respective IP Offices obviously did not consider SOFTFIT to be descriptive or to lack distinctiveness. Novartis further argued that the distinctiveness of the mark must be examined taking into account the goods at issue and that the manner of use and purpose of ophthalmic, medical and surgical apparatus and equipment (e.g. scissors, tweezers, pliers, mirrors, hooks, etc.) is not to provide a "comfortable fit" to the user. Novartis also invoked the judgement of the Court (Second Chamber) of European Union No. C-329/02 of 16 September 2004 in SAT. I v OHIM, whereby the Court held that registration of a trade mark is not subject to finding a specific level of linguistic or artistic creativity or inventiveness on the part of the proprietor of the trade mark.

The Slovenian IP Office accepted Novartis' arguments and granted protection to SOFTFIT in entirety. The above decision shows that the Slovenian IP Office is willing to reverse its initial refusal based on absolute grounds if the trade mark holder provides a well-argued response in favour of distinctiveness of the mark in relation to the designated goods.

PROFILE: Dominique Marloye

I joined GEVERS in Belgium in 1989 where I specialized in trade marks and designs, in particular on Benelux, International and European matters including prosecution, absolute grounds and oppositions. I qualified as a BMM certified attorney in 1994 and have been appointed as a member of the Board of Directors of GEVERS Legal S.A. in Belgium since 1997.

Before joining GEVERS and shortly after my law studies, I moved to Pretoria in South Africa where I worked at Spoor and Fisher and discovered the world of IP.



Where were you brought up and educated?

In Belgium.

How did you become involved in trade marks?

By chance! In fact when I moved to South Africa I worked at Spoor and Fisher where I did trade mark searches and company work as well as registration of copyright in cinematograph films. After eight years, I returned to Belgium where I started working at GEVERS.

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

I would have worked in the legal field anyway.

Which three words would you use to describe yourself?

Dedicated, perfectionist and curious.

What was your best subject at school?

Chemistry.

What's the best thing about your job?

I really like the fact that I am closely connected to business development: new products or new technologies.

What did you want to be as a child?

A nurse.

What is the most surprising thing that ever happened to you?

When I found out that I was expecting twins!

What is your philosophy in a nutshell?

Enjoy the present time and always look on the bright side of life.

What is the toughest thing about your job?

Filling in timesheets.

What is your weakness?

A "merveilleux" which is a Belgian pastry made of meringue, cream and chocolate flakes.

Which book or books are you currently reading?

I read "The Kite Runner" by Khaled Hosseini during my last holiday.

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

Any record by Carlos Santana.

How do you relax?

By spending time with my family.

Which sport do you play and/or enjoy?

Active walking.

What is your all-time favourite film?

Something's Gotta Give with Jack Nicholson and Diane Keaton.

What is your favourite holiday destination?

Any sunny seaside destination.

Where do you see yourself in 10 years?

Enjoying my 'fourth life' with my grandchildren.

What is the best invention ever?

The washing machine.

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

The "Casa Milà" by Gaudi also known as la Pedrera in Barcelona, for its astonishing wavy facade and its imaginative and fascinating ideas and realisation.