

Law Lore & Practice

PTMG



Pharmaceutical
Trade Marks Group

Sept 2023



Editorial: The art of rhetoric

As schoolchildren and students around Europe pack their bags and head back to the classroom in the midst of a mini-heatwave, thoughts turn to education, and inevitably to teachers. We all have memories of a teacher who inspired us, not necessarily to head into our current profession, but whose performance in front of the class captured our interest

and made us want to learn more about their subject.

For teaching is surely the most challenging dramatical performance of them all. On 'stage' in front of an openly critical audience, especially in those middle school years, at times of the day when pupils would rather still be asleep or who are busy digesting their lunch. Not for teachers the luxury of learning their lines over a few weeks, a comfortable dressing room and a bouquet of flowers after a particularly successful performance.

Inspiring teachers embody the principles as defined by Aristotle in his 4 B.C. book *Rhetoric*. Establishing their legitimacy on day 1 (ethos), presenting their course in a clear and precise manner that builds credibility (logos) and creating an emotional response from their pupils (pathos), who then remain attentive throughout the year. A school of thought argues that educational systems today no longer allow teachers the luxury of the often forgotten final principal - kairos, 'the opportune moment'. Too much emphasis on grades and performance inhibits the importance of setting and time for optimal learning.

As delegates head to Athens, the home of ancient theatre, we can be sure that the stage will be set for perfect performances by our speakers, and we may even have time to visit the theatre of Dionysus - but not during the conference of course!

I look forward to seeing many of you there.

Vanessa

US Update

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

The US District Court case of *Ascendia Pharmaceuticals, Inc. v Ascendis Pharma A/S*, 2023 WL 3721003 (D. N.J.), offers helpful guidance into how pharma companies might avoid the need to defend against a federal court lawsuit brought under the Declaratory Judgment Act (DJA). A Declaratory Judgment (DJ) action usually arises from cease-and-desist letters, inter partes proceedings before the Trademark Trial and Appeal Board (TTAB), or occasionally even settlement discussions in a trade mark dispute.

The Danish company Ascendis Pharma (Ascendis), held service mark registrations ASCENDIS and ASCENDIS PHARMA for scientific research within the medical, pharmaceutical, and bacteriological fields. Asserting likely confusion with these marks, Ascendis successfully petitioned the TTAB to cancel the registrations of a New Jersey company (Ascendia) for the marks ASCENDIA PHARMA and ASCENDIA PHARMACEUTICALS. Ascendia's marks covered research and development in the pharmaceutical and biotechnology fields.

Ascendia then filed an action before the District Court of New Jersey seeking (a) a declaratory judgment that its ASCENDIA marks were unlikely to cause confusion with the ASCENDIS marks, (b) an order reversing the adverse TTAB decision, and (c) an order requiring the USPTO to cancel the ASCENDIS registrations on grounds of abandonment. In response, Ascendis moved to dismiss Ascendia's claims seeking a declaratory judgment and cancellation.

Filing a declaratory judgment action is a bold defensive move, echoing the strategy that the best defense is a strong offense. It can be tactically advantageous because, as the plaintiff in the case, the moving party takes the initiative, gains greater control over the case, and might secure a more favorable venue. Here, for example, it clearly benefitted the New Jersey-based Ascendia to litigate in the New Jersey federal court. However, under the DJA, a District Court may entertain such a declaratory judgment action if – and only if – an 'actual controversy' exists.

Thus, the key issue here was whether an 'actual controversy' exists, based on all the facts and circumstances surrounding Ascendis' threatening actions and statements.

Within this context, the Court examined:

- (1) Correspondence in 2016 and 2017, in which Ascendis expressed concerns about likely confusion and requested that Ascendia cease and desist its use;
- (2) Ascendis' reference in 2017 to considering 'alternative legal remedies' if certain evidence were not provided within a specific timeframe;
- (3) Ascendis' filing of the cancellation proceeding in 2017; and,
- (4) Ascendis' 'vague' comments during settlement negotiations in 2020, which Ascendia viewed as threatening litigation.

In reviewing the state of the law under the Declaratory Judgment Act, the court first noted that correspondence or settlement negotiations in a trade mark dispute do not automatically satisfy the 'actual controversy' requirement. Likewise, the court stated 'In general, a dispute before

Continued on next page



Dear members of PTMG,

As those of us in the Northern hemisphere approach the summer break, I wanted to take a moment to reflect on the importance of resourcing and regenerating as IP lawyers. Our work can be demanding and challenging, and it is essential that we take the time to recharge our batteries and come back to our practice with renewed energy and focus.

Looking ahead to our next event in Athens, I am excited to announce our program under the title of 'PTMG at the Birthplace of Ethics – Time for Some Principle Reflections on Pharmaceutical Trade Marks.' This theme draws a connection between ancient Athens and the intellectual property landscape of today, highlighting the importance of ethical principles in our industry.

The ancient Greeks were pioneers in philosophy, ethics, and democracy, and their legacy continues to influence our modern world. In the same way, our industry is constantly evolving, and we must stay true to our principles and values as we navigate these changes.

I believe that our time in Athens will provide us with an opportunity to reflect on the importance of ethical principles in our work, and to draw inspiration from the birthplace of democracy and philosophy.

So, as we take this summer break to resource and regenerate, let us also reflect on the importance of ethical principles in our work and the legacy of ancient Athens in shaping our modern world.

I look forward to seeing you all in Athens, and to another successful and fulfilling year with PTMG.

Best regards,

Myrtha Hurtado Rivas

Members News

Moves and Mergers

There have been several moves since our last edition;

Rembert Niebel has left Baker McKenzie and is now with SKW Schwarz in Frankfurt, Germany. Rembert can be contacted at r.niebel@skwschwarz.de

Jenevieve Maerker has left Foley Hoag LLP to join Finnegan Henderson in Boston, USA. Jenevieve can be contacted at jenevieve.maerker@finnegan.com

Rik Minoodt formerly with Darts-ip, is now with Fovea IP in Brussels, Belgium. Rik can be contacted at rik.minoodt@foveaip.com

Karol Gajek formerly with Sołtysiński Kawecki & Szlęzak, is now with ViaMarca IP in Poland. Karol can be contacted at karol.gajek@viamarca.pl

Emily Ellis formerly with Ellis Terry, has joined Catalyst Intellectual Property in Auckland, New Zealand. Emily can be contacted at Emily.ellis@catalystip.co.nz

Aira Apivala has left Novartis to join Nestlé in Vevey, Switzerland. Aira can now be contacted at aira.apivala@nestle.com

Tara Aaron-Stelluto has left Aaron I Sanders PLLC to join Barton LLP in

Nashville, USA. Tara can now be contacted at tstelluto@bartonesq.com

Inès Garlantezec has left Dennemeyer & Associates to join Marks & Clerk in Luxembourg. Inès can now be contacted at igarlantezec@marks-clerk.com

Heather Williams has left Meissner Bolte (UK) Limited to join Daneel Williams LLP in Leeds, West Yorkshire, UK. Heather can now be contacted at heather@daneelwilliams.co.uk

Alida Guariso is now with Questel in Turin, Italy. Alida can be contacted at aguariso@questel.com

Emma Orman-White is now with GSK in Brentford, London, UK. Emma can be contacted at emma.8.white@gsk.com

Enrico Panza formerly with Ipan GmbH, is now with RightHub, London, UK. Enrico can be contacted at epanza@righthub.com

Please remember to let us know of any changes to your contact details. You can notify me either via the PTMG website www.ptmg.org 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

US Update cont

the TTAB is insufficient to establish an actual controversy for purposes of a declaratory judgment action.' All such actions and statements must be analyzed in a broader context to determine if they constitute an 'actual controversy.' And TTAB proceedings – which are limited to the right to register and not the right to use – can contribute to grounds for a declaratory judgment action if combined with explicit or implicit claims of infringing use, in demand letters, negotiations, or in the TTAB pleadings themselves.

Based on the facts of this case, the court found no immediate threat of litigation and, consequently, no 'actual controversy' between the parties. The court said 'Ascendia's subjective fear of litigation cannot establish jurisdiction' under the Act. The court further observed that referring to 'alternative legal remedies' probably meant the TTAB cancellation proceeding, and was not an explicit threat of federal court litigation. Perhaps most importantly, the court also relied upon

Ascendis' consistent and express desire to achieve an amicable resolution—'and specifically one allowing the continued use and registration of a mark that includes the 'Ascendia' designation.' In sum, the court dismissed Ascendia's declaratory judgment action for lack of an 'actual controversy.' All that remained in the suit going forward was the appeal of the TTAB decision.

Looking ahead, pharma companies should be careful not to threaten litigation or explicitly allege trade mark infringement unless they are prepared to defend a DJ action in federal district court. The courts will evaluate the totality of the circumstances to determine if an 'actual controversy' exists to support a DJ action. In this instance, Ascendis' statements evidencing a desire to seek a compromise helped to reduce the intensity level below the threshold for an 'actual controversy.' Therefore, pharma companies should keep a measured eye on how their threats might be perceived by their adversary, and a judge in an unfavorable venue.

Dietary Supplements: a round up of recent UK & EU trade mark decisions

Fiona Timms, Mishcon

The dietary supplements market is rapidly growing, as consumers increasingly seek out dietary supplements, herbal products and nutraceuticals to support their health and wellbeing. A number of recent decisions has given some key insights into how the UK and EU trade mark registries and courts are navigating the particular issues that may arise in this sector.

Assessing similarity of dietary supplements v pharmaceutical preparations

Whilst dietary and food supplements fall within Class 5, there has been some consideration as to their interplay with pharmaceutical products (and also Class 3 goods) when assessing similarity. In particular, such products are often sold in pharmacies and their manufacturers promote their use in relation to the health of people and animals.

The below decisions are illustrative of the approaches adopted by the UK and EU registries / courts to date and are a good reminder for applicants and proprietors alike to reflect carefully on their specifications to ensure their trade mark coverage accurately reflects their business activities.

In OMEGOR VITALITY¹, the EUIPO Board of Appeal considered that dietary supplements / natural remedies and pharmaceutical products (in the form of Omega-3 fatty acids targeted at heart conditions) were identical or similar, to an average degree. This was on the basis that the contested goods might be interchangeable or used in combination depending on the consumer's medical condition (e.g., Omega-3 fatty acids in the form of nutritional supplements or dietetic food in combination with goods in the form of pharmaceutical preparations). The Board of Appeal further considered that the goods targeted the same public, shared the same distribution channels (mostly pharmacies), and may be produced by the same manufacturers.

Whilst the applicant argued that dietary supplements were distinguishable from pharmaceutical products, because they were available over the counter whereas the opponent's pharmaceutical preparations were prescription only, this line of argument was rejected as arbitrary

given professionals commonly prescribe or recommend dietary supplements and dietetic preparations, particularly in relation to high lipid levels or cardiovascular diseases.

In HYALERA² the Board of Appeal found dietary supplements similar to medical preparations on the basis that the goods had the same purpose of protecting and promoting health, and were sold through the same distribution channels and targeted the same relevant public.

Interestingly in L'AMARA³ the Board of Appeal, in the context of assessing the reputation of the earlier mark, considered there to be a proximity between the opponent's Class 3 goods for 'skin care preparations (not for medical purposes)' and the contested goods in Class 5 for 'non-medicated homeopathic medicines and supplement preparations for treating various ailments despite such products differing in their specific purposes. In considering whether there was a link between the marks, the Board of Appeal considered that, as the goods were generally aimed at personal care and supporting health and well-being, the products may coincide in their nature and method of use, and be offered in the same or similar shapes of packaging, such as a cream tube, jar pot or press pump container. They may also consist of the same active ingredients, including those of herbal origin. In addition, they could be distributed via the same commercial channels such as pharmacies, drugstores or body care shops.

In the UK, the UKIPO Appointed Person in PURITY HEMP COMPANY⁴ confirmed the approach adopted by the Hearing Officer in finding that the applicant's Class 5 goods for 'dietetic and nutritional food supplements' were of medium similarity to the opponent's 'non-medicated beauty products' in Class 3. The assessment of medium similarity of the goods was on the basis that it is common for supplements to be taken or marketed as a beauty treatment stemming from improved health.

Meanwhile, in BEE BALTIC⁵ the UKIPO Appointed Person upheld the Hearing Officer's finding that the opponent's Class 30 goods for 'raw honey' had a medium

degree of similarity to the applicant's Class 30 goods for 'honey substitutes'. The Appointed Person rejected the opponent's argument that these goods were highly similar by pointing out that 'substitutes' are by their nature comprised of such vastly different constituent parts to the item being substituted that they cannot be conflated by default. Whilst this decision does not directly relate to dietary supplements per se, it has potentially interesting ramifications in the world of supplements in acting as substitute elements for health or dietary benefits.

Use in relation to food supplements

In NATURCAPS⁶, a case concerning an invalidity challenge based on an earlier mark, the EU General Court confirmed that, since food supplements are designed to complement the nutritional value of a normal diet, and do not have as their main purpose the treatment or prevention of illnesses, they are not to be classified as 'pharmaceutical products'. The General Court considered they were more likely to fall within 'dietetic substances adapted for medicinal use', intended for the treatment of a specific nutritional deficiency. In this case, the earlier mark was registered in respect of 'pharmaceutical products'. Whilst the applicant for invalidity provided extensive use of its earlier mark in relation to dietary supplements in an attempt to establish the proof-of-use requirement, the General Court held this was insufficient to prove genuine use in relation to pharmaceutical products.

The relevant consumer

The perception of the marks in the mind of the relevant public in relation to the relevant goods or services will play a decisive role in conducting the global assessment of likelihood of confusion.

It is long established that medical professionals pay a high degree of attention to pharmaceutical trade marks and the general public will also likely pay an above average degree of attention given the direct impact of such products on their health⁷. For both pharmaceutical and medical preparations, together with their associated devices, the involvement of professionals is typically a pre-requisite,

Continued on next page

Continued

whether as the direct administrators of the products in hospitals and clinics, or the prescribers and distributors of products for patients to take under instruction.

For dietary supplements, however, the line may be blurred as, while there are points at which professionals are involved (as mentioned by the Board in OMEGOR VITALITY above), it is more common for consumers to browse these products and self-administer. As explained by the Board of Appeal in HYALERA⁸, when a section of the relevant public is made up of both professionals with a higher level of attention and the public at large, the public with the lowest level of attention must be taken into consideration for assessing the likelihood of confusion.

However, in relation to dietary products and vitamins in AHA⁹, the Board emphasised the high degree of attention paid by both the public at large, as well as professionals in the medical and nutrition fields due to the health-related implications and effect on physical well-being.

Given the rapid growth in the dietary supplements industry and the health connotations associated with such products, on balance there seems to be the same default high standard applied for the perception of the relevant professional consumer as for pharmaceutical preparations. However, there remains scope for arguing that the general public has a lower degree of attention given the ability to browse and purchase such products on shop floors, as was held by the UKIPO Appointed Person in BEE BALTIC¹⁰ who found that the relevant public had an average degree of attention for dietary food supplements specifically in relation to bee pollen. This illustrates the Board of Appeal's reminder in AHA that the average consumer's degree of attention is likely to vary according to the category of goods or services in question.

1 U.G.A Nutraceuticals Srl v. Basf AS – Case R 1200/2021-4

2 Vorwarts Pharma Sp. z.o.o. v Fidia Farmaceutica S.p.A. – Case R 230/2023-5

3 Laverana GmbH & Co. KG v Nature's Sunshine Products, Inc. – Case R 2134/2022-4

4 Purity Wellness Group Ltd v The Stockroom (Kent) Ltd – Case BLO-115-22

5 Beebaltic Ltd v Marius Kempelis – Case BLO/0113/23

6 Hasco TM v EUIPO – Case T-12/22

7 UGA Nutraceuticals Srl v Vitae Health Innovation – Case T-149/21

8 Vorwarts Pharma Sp. z.o.o. v Fidia Farmaceutica S.p.A. – Case R 230/2023-5

9 Worwag Pharma GmbH & Co. KG – Case R 1985/2022-1

10 Beebaltic Ltd v Marius Kempelis – Case BLO/0113/23

Delhi High Court upholds the principle of prior use rights

Omesh Puri, LexOrbis

The Delhi High Court recently dismissed an appeal filed by Vee Excel Drugs and Pharmaceuticals Pvt. Ltd. against Hab Pharmaceuticals and Research Limited concerning the registration of the trade mark VEGA ASIA. In a judgment dated 1 June 2023, the court upheld the Intellectual Property Appellate Board's (IPAB) decision to remove the trade mark VEGA ASIA from the register.

Vee Excel Drugs and Pharmaceuticals Pvt. Ltd., the appellant, applied for the registration of the trade mark VEGA ASIA in 2002, while Hab Pharmaceuticals and Research Limited, the respondent, applied for the trade mark VEGAH TABLETS in the same year. Both marks were registered in Class 5 for pharmaceuticals and medicinal preparations. Disputes arose when both parties filed applications for rectification of the trade marks and subsequent lawsuits against each other.

The IPAB's decision, issued on 31 July 2013, allowed both rectification applications and ordered the removal of the trade marks VEGA ASIA and VEGAH TABLETS from the register. The board found that the appellant's claim of prior use was baseless since it had applied for registration on a 'proposed to be used basis' in 2002. Additionally, the IPAB determined that the respondent, Hab Pharmaceuticals and Research Limited, had established prior use and adoption of the VEGA mark since 2001. The board concluded that the trade marks were deceptively similar, and the prior user had a stronger claim. The respondent challenged the IPAB order in so far as it relates to the removal of the trade mark VEGAH TABLETS from the register before the High Court of Bombay which is pending.

With regard to trade mark VEGA ASIA and against the IPAB's decision, Vee Excel Drugs and Pharmaceuticals Pvt. Ltd. challenged it by filing a writ petition before the High Court of Delhi. However, the Single Judge of the High Court dismissed the petition, leading to the present appeal.

The appellant argued that the learned Single Judge had erred in considering the trade mark application of VEGA ASIA as proposed to be used and neglecting the rights acquired through an agreement with Ma Gayatri, who transferred all rights in the VEGA trade mark to the appellant. The appellant claimed that its use of the mark preceded the respondent's use.

On the contrary, the respondent argued that it was the original adopter and user of the VEGA mark. To support its claim, the respondent submitted documents such as export permissions dated 12 August 2001, under the VEGA mark, as well as invoices dating back to 2001. Furthermore, the respondent presented a letter from the Food & Drugs Administration of Maharashtra, India (FDA) that responded to the appellant's complaint and stated that no action could be taken because the respondent had adopted the VEGA mark prior to the appellant (in 2001). Additionally, the respondent relied on a bill from Mr. Kishore Mathkar in 2001, which confirmed the artistic work for the respondent's VEGA mark. The respondent argued that the appellant was a subsequent adopter and failed to explain the adoption of an identical mark for identical goods.

After hearing arguments from both parties, the division bench of the Delhi High Court dismissed the appeal, affirming the IPAB's decision. The court found no merit in the appellant's contentions and held that the respondent had established prior adoption and continuous use of the VEGA mark since 2001. The court also rejected the appellant's claim of acquiring rights through the agreement with Ma Gayatri, stating that it was a non-exclusive license agreement rather than a valid assignment.

This judgment reinforces the principle of prior adoption and use in trade mark disputes, emphasizing the importance of providing substantial evidence to support a claim against a registered trade mark based on prior use.

Delhi High Court upholds Mayo Foundation's rights in the trade mark MAYO

Samta Mehra and Shrabani Rout, Remfry and Sagar, India

The Delhi High Court, in a recent case titled Mayo Foundation for Medical Education & Research v Bodhisatva Charitable Trust & Ors. CS(COMM) 920/2022 restrained the Defendants operating health care centres under the names Mayo Medical Centre, Mayo Institute of Medical Sciences, Mayo School of Nursing, and Mayo Hospital from using the trade mark MAYO in any manner, in relation to healthcare and medical education services.

Mayo Foundation is a well-recognised and highly acclaimed American academic medical centre recognised for, inter alia, providing medical care through a diverse physician-led team of people involved in offering clinical, educational, diagnostic and research services in a unified multi-campus system. They are also proprietors of the trade mark MAYO and MAYO formative marks worldwide including a registration for the mark MAYO dating back to 1992 in India in class 16.

Bodhisatva Charitable Trust & Ors. (Defendants) were using the trade mark MAYO in relation to health care centres, clinics, hospitals and medical colleges. They had also filed a trade mark application for the mark in Class 41, however,



the same was opposed by the Plaintiff and subsequently abandoned by the Defendants.

The Plaintiff contended that they became aware of the Defendants' unauthorized adoption of the MAYO mark in 2014, whereafter they issued a legal notice to them and opposed the Defendants' applications to register the MAYO mark at the Trade Marks Registry. In 2020, the Plaintiff filed an application for pre-litigation mediation but the Defendants did not respond to the same and the mediation proceedings were closed as 'non-starter'.

In 2021, the Plaintiff engaged an investigator whose report revealed the extent of use of the mark MAYO by the Defendant on display boards, prescription slips, OPD slips, invoices etc. Subsequently, the Plaintiff filed a suit seeking permanent injunction against the Defendants.

The Defendants challenged the validity of the suit on multiple grounds, including, lack of territorial jurisdiction (since the Defendants' facilities were located in Uttar Pradesh, India and the suit was filed in Delhi), delay, laches and acquiescence (the Plaintiff claimed to be aware of the adoption since 2014 but had filed the suit only in 2022), as well as on the grounds that the trade mark MAYO is a common word in India, and that the Plaintiff had failed to prove its goodwill and reputation in India. Notwithstanding the same, the Defendants, without prejudice to their rights, offered to add the prefix Dr. Kailash Narayan to their existing name so as to distinguish the same from Plaintiff's trade mark.

The Court analysed the submissions made and noted that the website of the Defendant clearly mentioned that 'With an inspiration from Dr. William Mayo of Mayo Clinic, USA; Mayo School of Nursing was established in 2000 with a mission to serve the society'. This shows that the founder of the Defendant institutions was not only aware of the Plaintiff but drew inspiration from Dr. William Mayo, the founder of Mayo Clinic, USA. Therefore, the dishonest adoption by the Defendants was apparent.

The court observed that 'hospitals' and 'medical education' are allied and cognate to 'medical journals and periodicals', the goods covered by the Plaintiff's registration in India. Accordingly, the Defendants' use of the MAYO mark amounts to trade mark infringement. Lastly, the Court observed that the fields of healthcare and medicine have an international character, and since the Plaintiff was able to prove its global reputation, it was evident that the

Defendants' adoption of the MAYO mark was with mala fide intentions. On the issue of delay and laches, the court observed that it is a settled principle of law that if the adoption of the mark is dishonest, delay alone cannot be a ground for denying an injunction. The court did not go into the issue of jurisdiction in detail but based on the above, passed orders to restrain the Defendants from using the MAYO mark till the disposal of the suit.

The ruling holds significance as it reaffirms the crucial role of building goodwill and reputation in establishing the acquired distinctiveness of any trade mark. Furthermore, through judgments of a similar kind, the court has guaranteed the protection of trade marks that have established a distinct repute. The widespread and unabated usage of an infringing mark by the Defendants in the mentioned case also serves as a cautionary tale for esteemed brands, reminding them to stay watchful to safeguard their Intellectual Property and take timely action.



Turkish Court of Cassation's Comparison of Goods in Different Subclasses

Dicle Doğan and Ayşenur Çıtak Bozdağ, Gün + Partners

During 2022, the 11th Civil Chamber of the Turkish Court of Cassation (the CoC) issued several decisions regarding trade marks covering goods in class 5. The CoC formed its evaluation on the likelihood of confusion by comparing the subclasses of class 5. The details of the decisions are provided below:

Aster v Paster

A cancellation action was filed against the Office's decision rejecting the opposition filed against the trade mark PASTER in class 5 relying upon the plaintiff's trade mark ASTER in class 5.

The IP Court stated that the trade marks are confusingly similar and there is a likelihood of confusion for 'Medicines for human and animal health, chemical products for medical purposes, chemical elements. Dietary supplements for medical and veterinary purposes, herbs and herbal beverages adapted for medicinal purposes. Dental products (excluding instruments/devices). Detergents for medical purposes.' in class 5 and accepted the case partially for those goods.

Upon appeal, the matter was reviewed by the Regional Court of Appeal (RCA). The RCA confirmed that there is likelihood of confusion regarding the goods 'Medicines for human and animal health, chemical products for medical purposes, chemical elements' by comparing the scope of the trade marks. However, the RCA underlined that the plaintiff's trade mark ASTER only covers 'medical preparations' which is listed in the first subclass of class 5 whereas the disputed trade mark PASTER covers the remaining subclasses of class 5. Since those subclasses appeal to different consumers, have different distribution channels and purpose of use, there is no likelihood of confusion for the goods listed in the other sub-classes of class 5. As a result, the RCA reversed the IP Court's decision and accepted the case partially for 'Medicines for human and animal health, chemical products for medical purposes, chemical elements only. Upon further appeal by the office, RCA's decision was upheld by the CoC.

Nepton v Hepton

A cancellation action was filed against the Office's decision which rejected the opposition filed against the trade mark NEPTON in class 5 relying upon the plaintiff's trade marks HEPTON and BEPTON in class 5.

The IP Court stated that the trade marks are confusingly similar but there is no likelihood of confusion between the trade marks for several goods listed in the subclasses 5-1, 2, 3, 4 and 7, considering the high attention level of the relevant consumers. The IP Court decided that there is likelihood of confusion between the trade marks for 'Preparations for destroying vermin, fungicides, herbicides and rodents. Dietary supplements, nutritional supplements, food for babies. Diapers made of paper and textiles for children. Deodorants, other than for human beings or for animals, air fresheners and air deodorising preparations. Disinfectants, antiseptics' in class 5 and accepted the case partially for those goods.

Upon appeal by the parties, the matter was reviewed by the RCA. The RCA stated that the trade marks do not refer to an active ingredient or a disease, nor do they result from a generic phrase, therefore there is likelihood of confusion, even for the informed consumers. As a result, the RCA reversed the IP Court's decision and accepted the case in total. Upon further appeal of the parties, the RCA's decision was upheld by the CoC.

Tio-Relax v Bio-Relax

This decision relates to a cancellation action filed against the Office's decision which had rejected the opposition filed against the trade mark BIO-RELAX relying upon the plaintiff's mark TIO-RELAX.

The IP Court stated that the similarity condition is satisfied for the goods 'medicines for human and animal health, chemical products for medical purposes, chemical elements. Dietary supplements for medical and veterinary purposes, preparations for slimming purposes, food

for babies, herbs and herbal beverages adapted for medicinal purposes' in class 5 covered by the plaintiff's TIO-RELAX trade mark as those products do not only appeal to healthcare professionals but also to patients and pharmacy technicians. Therefore, the IP Court partially accepted the case for those goods.

Upon appeal by the defendants, the matter was reviewed by the RCA. The RCA underlined that the nature, distribution channel and use of 'medical preparations' within the scope of the plaintiff's trade mark and 'Dietary supplements for medical and veterinary purposes, preparations for slimming purposes, food for babies, herbs and herbal beverages adapted for medicinal purposes' are different. Therefore, the RCA stated that the similarity condition is not satisfied for those goods. Furthermore, the RCA stated there is no likelihood of confusion even for the goods listed in subclass 5-1, since 'relax' has a settled meaning and informed consumers would not confuse the trade marks beginning with Tio and Bio despite the limited similarity between the trade marks. Upon further appeal by the plaintiff, RCA's decision was upheld by the CoC.

Comment

It is a settled principle that informed consumers should be taken into account during the similarity evaluation of goods in class 5, especially when comparing the goods with medicines. This principle has been strictly applied by the Courts, and in many cases it has been decided that healthcare professionals would not confuse the trade marks.

However, in recent decisions, it is remarkable to see that the Courts do not automatically apply this principle to all goods in class 5 and conduct a detailed examination by comparing the goods carefully, even for the specific ones listed in different subclasses. It is also striking that such scrutiny is made in cases where only one letter is different between the trade marks.

International Update

CHINA

Ms. Haiyu Li and Ms. Haoyu Feng, Chofn IP

On 23 April 2023, the Supreme People's Court (SPC) of China released the 43 issues on the application of Chinese IP laws it summarized from the IP cases concluded in 2022. We would like to introduce two trade mark-related cases in the pharmaceutical field with our comments as follows.

Distinctiveness of English trade marks

In the case of administrative dispute over the rejection of trade mark application of the applicant NAOS, # 2022 SPC XingZai 4, the SPC pointed out that the distinctiveness of an English trade mark should be judged according to the relevant Chinese public general understanding of the designated goods or services. Whether a trade mark can be used to distinguish the source of its designated goods or services, comprehensive consideration should be given to such factors as the overall constituent elements and meaning of the logo, and the extent to which the trade mark itself is associated with the goods or services it is intended for.

In this specific case, the applied-for mark BIODERMA consists of the root words BIO and DERMA. Although BIO has the meaning of biology and DERMA can be interpreted as skin, according to the facts ascertained by the retrial, DERMA is not a commonly used root word. Given the general cognition level and ability of the relevant Chinese public to English trade marks, BIODERMA will not be generally understood as 'biological skin'. As an entirety, the applied-for mark is designed to be used on 'pharmaceutical preparations, pharmaceutical preparations for skin care, and pharmaceutical preparations for skin disease', which are not easy for the relevant public to understand as a direct description of raw materials, functions, uses and other characteristics. The distinctiveness of the applied-for mark should be judged mainly from its overall constituent elements and meaning, whereas the combination of interpretation of the separated root words cannot be simply and mechanically regarded as the basis for identifying the inherent meaning of BIODERMA. Accordingly, there is no legal or factual basis to recognize the applied-for mark as indistinctive.

Comment:

In practice, where a trade mark is composed of root words with meanings associated with its designated goods or

services, rejection for indistinctiveness often occurs. On the one hand, this case can be cited as a favourable precedent. On the other hand, pharmaceutical brand owners, if faced with such provisional rejections, should try to appeal, particularly when the mark is very important to the business.

Influence of administrative regulations

In the retrial of administrative dispute between the applicant Hebei Huatuo Pharmaceutical Chain Co., Ltd. and the respondents Huatuo Chinese Medicine Co., Ltd. and the China National IP Administration (CNIPA) over trade mark invalidation, # 2021 SPC XingZai 76, the SPC clarified that, when judging whether goods and services are similar, influence of administrative regulations concerning the production and sale of goods, and the relevant services shall be considered. Where the sales channels, service modes and consumer groups are influenced by such regulations, and a long-term and stable market order resulting from such norms has been formed, such influence of administrative regulations shall be considered as an important factor in judging the similarity of goods and services.

In this retrial case, the disputed mark is used on 'retail or wholesale service for pharmaceuticals', and the approved goods item of the cited mark is 'drugs'. As drugs relate to human health, China adopts stricter regulations on their distribution. According to the relevant administrative regulations, the sales behaviour of drug manufacturers has such characteristics as 1) the sales are self-produced medicines with limited types, and 2) the targets of sales are basically pharmaceutical trading enterprises and medical institutions. By contrast, wholesale or retail enterprises of pharmaceuticals deal in a wide variety of drugs from different manufacturers, and the target groups are patients and general end consumers. For a long time, the special regulations of drug production and administration have formed a relatively stable and clear market pattern. The related public can have a clear understanding of drug manufacturers and sellers. Based on the above, 'retail or wholesale service for pharmaceuticals' covered by the disputed mark are dissimilar to the goods 'drugs' of the cited mark in respect of trading modes, providers, etc., and the disputed mark shall be maintained.

Comment

Although the SPC conclusion is theoretically self-consistent, we should

also note that the parties in this case are both reputable and famous enterprises in their respective business fields. That is why the SPC tends to maintain the long-term and stable market order. In some other cases where the applicant of the disputed mark has a history of bad faith in pirating others' marks or the prior mark is very famous, there are also precedents where the 'retail or wholesale service for pharmaceuticals' and the goods 'drugs' are recognized as similar, due to the inherent connection.

EUROPEAN UNION

Sophie Leppington, Mishcon de Reya LLP

The EUIPO Board of Appeal has recently given its decision on an appeal by Mendes SA (Mendes), against the cancellation of its EU mark LACTOBACILLUS PARACASEI DSM24733, registered in class 5 for 'Lactic bacteria for use as drugs and/or food/dietary supplements; compositions based on lactic bacteria for use as drugs and/or food/dietary supplements' (the Mark).

The Board found that the Mark was invalid in its entirety due to its descriptive character, because the mark consisted of the combination of a name of a bacterial strain in Latin and its corresponding depository designation, without any additional element that could render it distinctive. The respective bacterial strains had been deposited with the Leibniz Institute DSMZ-German Collection of Microorganisms and Cell Cultures, Deutsche Sammlung von Mikroorganismen und Zellkulturen (DSMZ) and had the DSM depository number 24733.

Bad faith allegations were also raised, stemming from the breakdown of the parties' relationship though these were not considered.

Background

Claudio De Simone discovered the lactic bacteria that the Mark described. He had previously worked for the predecessor company of the Cancellation Applicant (Actial Farmaceutica), which produces probiotics containing lactic acid bacteria. Whilst working at Actial, De Simone had founded Mendes and later applied for the Mark.

The Cancellation Proceedings

On 22 December 2020, Actial filed a request for a declaration of invalidity of the Mark. The Mark had been listed on the packaging of Actial's probiotic; it argued that the scientific name of the bacterial species belonged with its DSM code meaning the mark was descriptive. Mendes argued that, because the bacteria was

Continued on next page

International Update continued

deposited in a 'safe deposit' with the DSMZ, the public were not aware of the characteristics of the strain and therefore, 'DSM24733' was not descriptive. Further, if meaning was given to 'DSM', it would be to the De Simone name.

The Cancellation Division concluded that the relevant public (the professional public in the dietetic and medical field) would understand the Latin term to be the name of a bacteria, and 'DSM' was the international code for bacteria strains deposited with the DSMZ, with '24733' indicating the deposit number. The confidential nature of the deposit was irrelevant; the DSM code would be understood by the relevant public as descriptive of the goods and the Mark had been listed on the packaging of probiotics. There was no evidence DSM was an acronym for 'De Simone'.

The Appeal

On appeal, Mendes argued that, as probiotics are not prescribed, the general public should also form part of the relevant public. It submitted that it was highly unlikely that the relevant public perceived DSM as a code indicating a deposit strain at the DSMZ.

However, the Board concluded that, as probiotics are goods that impact human health, the relevant public would display a high degree of attention, irrespective of the degree of knowledge they may have in relevant fields. It also did not matter that DSM could have other meanings; at least one of the possible meanings of the Mark designated a characteristic of the goods concerned. It was significant that names of bacterial strains followed by DSM and a number were commonly listed as ingredients on the packaging of probiotics. The general public would perceive DSM as describing an ingredient, regardless of whether or not they understood the exact meaning.

Interestingly, the examiner had raised objections to the Mark which had been waived following Mendes' response, and the Cancellation Applicant had also filed third party observations during the registration process, but the Mark had gone forward to registration.

INDIA

Omesh Puri, LexOrbis

In a recent legal development regarding a trade mark dispute in India, an important judgment dated 7 August 2023 has been rendered by the Delhi High Court in a case involving Mankind Pharma Ltd. (hereinafter referred to as plaintiff) and Novakind Bio Sciences Private Limited

(hereinafter referred to as defendant). The plaintiff, a prominent pharmaceutical entity in India, raised allegations of trade mark infringement against the defendant's use of the mark NOVAKIND for various pharmaceutical products.

Mankind Pharma, having incorporated the trade mark MANKIND as an integral part of its trading identity since 1986, particularly emphasized its use of the KIND suffix across diverse pharmaceutical preparations collectively termed as the 'KIND family of marks.' On the other hand, the defendant Novakind Bio Sciences, used the mark NOVAKIND for pharmaceutical goods. The plaintiff contended that the impugned use, particularly the incorporation of the KIND element, infringed its registered trade mark. The main issue was whether the defendant's use of the NOVAKIND mark constituted trade mark infringement and whether the defendant's mark merely constituted an element of its corporate name.

The court examined the defendant's presentation of the NOVAKIND mark on its pharmaceutical products. It observed that the defendant prominently displayed Novakind Biosciences Private Limited alongside its address, in a manner surpassing the prominence of the drug name itself. The court deduced that this use goes beyond the use of a corporate name and instead qualified as a trade mark, owing to its distinctive character and its function as an indicator of origin.

The court notably highlighted the presence of the KIND element, a salient feature of the plaintiff's marks, which heightened the potential for consumer confusion. The court posited that an average consumer might potentially associate the defendant's products with the plaintiff's 'KIND family of marks.'

The court decreed that the marks NOVAKIND and MANKIND, particularly when used for pharmaceutical preparations, are phonetically deceptively similar due to the shared KIND suffix. This similarity, coupled with the distinctiveness of the plaintiff's mark and the likelihood of consumer confusion, prompted the court to ascertain that the defendant's use amounted to trade mark infringement.

Furthermore, the court dismissed the defendant's assertion that the plaintiff's non-registration of the KIND mark weakened the claim of infringement. It determined that the plaintiff's well-established reputation and registration of the MANKIND mark sufficed to substantiate its rights.

In light of the foregoing examination, the court issued an interim injunction in favour of the plaintiff, restraining the defendant from using the mark NOVAKIND or any similar mark encompassing the KIND element for pharmaceutical products. The court emphasised that in the case of pharmaceuticals / medicine sector, there is no room for even the slightest hint of confusion. As a result, pharmaceuticals, especially prescription drugs, must clearly demonstrate absolute distinctiveness from one another.

KAZAKHSTAN

PETOSEVIC

The Kazakh Intellectual Property Office recently introduced amendments to certain official fees, which entered into force on 10 July 2023.

The following fees have increased by 45%:

- The fee for filing a trade mark application increased from EUR €132 to EUR €192; the fee for each additional class over three increased from EUR €37 to EUR €54;
- The trade mark renewal fee increased from EUR €212 to EUR €308; the fee for each additional class over three increased from EUR €37 to EUR €54;
- The fee for filing a response to a provisional refusal and for filing an opposition against a pending trade mark application increased from EUR €39 to EUR €57;

The fees for conducting all types of trade mark searches have increased by up to 40%, for instance:

- Availability search in one class for a word mark or a simple device mark increased from EUR €25 to EUR €34;
- Availability search in one class for a combined mark increased from EUR €49 to EUR €69;
- Owner name search increased from EUR €52 to EUR €73.

Finally, the fee for registering an assignment agreement or license for all types of IP rights, including patents, utility models, industrial designs and trade marks, has increased from EUR €98 to EUR €119, a 21% increase, while the fee for each additional IP right in the same agreement increased from EUR €20 to EUR €29.

In contrast, plant variety right annuity fees have been reduced by 5% to 15% per annual fee. For instance, the annuity fee for years 1-3 decreased from EUR €24 to EUR €20 and the annuity fee for years 41-45 decreased from EUR €247 to EUR €222.

Continued on next page

International Update continued

KUWAIT

JAH CO. IP

As of January 2023, it became possible to conduct official searches with the Kuwaiti Trademark Office subject to payment of the official fees and to obtain the official search report on the availability of the trade mark or not, along with the complete particulars of any allocated similar or identical trade mark.

QATAR

JAH CO. IP

Qatar has officially adopted the Gulf Cooperation Council (GCC) Trademark Law which was published in the [Official Gazette No. 09](#) dated 9 July 2023. The Trademarks Office released an official statement No. 2/2023 on 13 July 2023 and confirmed subsequently that the said law will be put in force as from 10 August 2023. Until then, the current law and fees will be maintained.

By way of background, Qatar approved the said law through decree No. 7 of 2014 dated 8 June 2014 which was later published on 30 June 2014. Meanwhile, the GCC trade mark is a set of provisions that will be applied uniformly across all the GCC states with regard to the prosecution and enforcement of trade mark rights, even if it does not offer a unitary registration system. The Trademark Offices of each GCC country will remain as the receiving office and will register trade marks on a national basis. Registering a trade mark across the six GCC countries will still require filing six separate national trade mark applications.

Key changes:

- A significant increase in the official fees, which will also be applied retroactively on pending trade mark cases that are currently maturing to registration.
- The publication period has changed from four months to 60 days.
- The publication and registration fees are to be settled within 30 days from the date of receiving the respective notification from the trade marks office.
- multiclass trade mark applications will be allowed based on the approval of the respective registry.

SOUTH SUDAN

JAH CO. IP

It is now possible to 'reserve' trade mark applications in South Sudan with the Ministry of Justice so that by the time the Trademark Bill (the Bill), which is currently pending approval by the Parliament has

passed into law, owners of reserved trade marks will have prior rights. Said prior rights that will thus debar third parties from filing and registering a similar or identical mark when South Sudan reopens for trade mark applications again.

By way of background, the Ministry of Justice in South Sudan started accepting trade mark applications in 2014 under the Sudanese Trade Mark Law No.8 of 1969 (the Sudanese Act), but this has since been stopped until 2023 wherein the Ministry allowed MTN Group (mobile telecommunication company) to 'reserve' one of their trade marks.

UKRAINE

PETOSEVIC

The Law on Amendments to Certain Legislative Acts of Ukraine on Strengthening the Protection of Intellectual Property Rights entered into force on 15 April 2023, amending several IP-related laws and the Civil Procedure and Commercial Codes. The law aims to further align Ukrainian legislation with that of the EU by implementing certain articles of the EU-Ukraine Association Agreement and relevant provisions of the Directive 2004/48/EC.

Remedies for IPR Infringement

The law now stipulates that remedies such as removal from public circulation and destruction of counterfeit goods and the materials and tools used for their manufacturing must be done at the expense of the infringer. It was previously unclear which party should bear these costs.

The law also introduced an alternative remedy in the form of a one-time cash reimbursement, which may be applied upon the defendant's request, only if the infringement was unintentional and if applying the abovementioned remedies would be disproportionate to the damage caused. The imposition of the alternative remedy and the amount of the one-time cash reimbursement are to be decided by the court.

Information concerning IP right infringement and the respective court decisions may now be published in the media or disseminated in another way at the expense of the infringer, if the court issues such an order upon the plaintiff's request.

Reimbursement of Losses Caused by IPR Infringement

While losses caused by IPR infringement could previously only be compensated by means of reimbursement of economic harm or lost profits, the amended IP laws

now also provide for compensation in the form of a lump sum, which may serve as an alternative in cases where proving lost profits or unfair profits made by the infringer might be difficult. The amount of the lump sum cannot be less than the amount of compensation that would have been paid for the permission to use the respective IP rights. Moral damages can now also be awarded as compensation for non-material harm, e.g. infringed moral rights.

Additional Procedural Means for Collecting Evidence in Infringement Cases

Upon the request of any of the parties, the court may now order a suspected infringer (or any other person believed to have offered, received, owned and/or used infringing goods or provided infringing services for commercial purposes, or a person involved in the production, manufacturing and distribution of infringing goods or services) to provide information on the origin of goods and distribution networks.

Using 'Ukraine' in Trade marks

Granting the authorization to use the name Ukraine, the UA/UKR international country code or the Ukrainian coat of arms in a trade mark is now under the jurisdiction of the special Collegial Body created by the Ukrainian Intellectual Property Office.

With the adoption of these amendments, Ukraine has implemented all IPR enforcement-related provisions under the EU-Ukraine Association Agreement. According to the interactive system Pulse of Agreement, developed by the Ukrainian government to monitor the Agreement's implementation, 98% of the IP-related part of the Agreement has been implemented.

UKRAINE – WIPO

PETOSEVIC

On 1 July 2023, the WIPO Arbitration and Mediation Center resumed its domain name dispute resolution services under the .UA Domain-Name Dispute-Resolution Policy (UA-DRP) with certain adjustments in view of the martial law in Ukraine, currently in force until 15 November 2023.

Following its consultations with Ukrainian UA domain operator Hostmaster, WIPO had suspended UA-DRP proceedings on 27 April 2022 due to the war and the resulting difficulties for Ukrainian registrars and parties to participate in arbitration proceedings.

The UA-DRP proceedings have been resumed with the following adjustments:

Continued on next page

International Update continued

Extension of Terms

- The deadline for Ukrainian registrars to submit information about the respondent once they receive a verification request from the WIPO Centre may be extended up to 14 calendar days, in addition to two business days. The deadline for confirming domain name blocking cannot be extended.
- The deadline for respondents to file their response may be extended up to 14 calendar days, in addition to 20 calendar days.
- The deadline for respondents to file a court action in a Ukrainian court against the implementation of a decision may be extended up to 14 calendar days, in addition to 10 business days.

Administrative Proceedings

- For administrative proceedings to commence, all factual circumstances must be taken into account, including the respondent's location and last known address and the location of the Ukrainian registrar. Depending on the circumstances, Hostmaster may instruct the WIPO Centre not to initiate proceedings.
- The Ukrainian registrar should provide all available information about the respondent, including their place of residence or location, as long as this disclosure does not contradict the applicable legislation on personal data protection.
- After considering the facts of the case and the principle of balance of probabilities, the Administrative Panel may, on its own initiative, suspend the proceedings if it concludes that the respondent is unable to defend themselves, and if it is objectively impossible to consider the dispute without the respondent's participation.

Hostmaster's decision to resume UA-DRP proceedings with the above-mentioned adjustments will remain in force as long as martial law continues and for 90 days following its termination.

UZBEKISTAN

PETOSEVIC

Uzbekistan has recently adopted amendments to its competition law which will enter into force on 4 October 2023. While the amendments are aimed at reducing anti-competitive and unfair practices, provisions related to the protection of IP rights have been entirely excluded.

Removal of IP Provisions

The previous version of the law included the provisions which prohibited:

- Sale of goods with illegally used IP rights including the illegal use of a designation identical or confusingly similar to a trade mark or trade name by placing it on goods, labels or packaging, or otherwise using it in relation to goods that are sold or put into circulation, as well as by using it in a domain name;
- Misleading consumers with products that resemble the original products of other companies by imitating their design, shape, names, labels, packaging, colours, trade marks, promotional materials or other elements;
- Registration of IP rights in bad faith.

Change of Competent Body

The Anti-Monopoly Committee (AMC) will transition into the Competition Promotion and Consumer Protection Committee (CPCC). Unlike the AMC, the CPCC will have no authority to review and decide on IP-related cases. AMC decisions have represented an important legal basis for seeking trade mark invalidation before the courts or for taking legal action against infringers before the Uzbek Intellectual Property Office. It appears that now there are no effective statutory mechanisms or governmental institutions to rely on when dealing with infringements based on unfair competition grounds.

New Law v Paris Convention

The amendments are apparently not in line with the Paris Convention for the Protection of Industrial Property, to which Uzbekistan is party. In accordance with Article 10bis (1) of the Convention, every member of the Union is bound to ensure effective protection against unfair competition. Particularly, section 3 (i) of the same Article states that acts in the course of trade that create confusion as to the goods or the industrial or commercial activities of a competitor are to be prohibited. The amended law no longer complies with this section. However, this issue can perhaps be overcome by citing the principle of prevalence of international treaties embedded in the Constitution of Uzbekistan and the amended competition law itself.

Alternative Ways to Protect IP Rights

Given the limitations of the amended law, facts of infringement may still be based on

the grounds of misleading the public as to the nature, the manufacturing process, the characteristics, the purpose or the quantity of goods (Article 10bis (3) (iii) of the Paris Convention). Conducting public surveys, for instance, could be helpful in confirming confusing similarity between counterfeit and original products. In this case, however, IP owners would not be able to base their claims against infringers on the IP rights they own in Uzbekistan, but rather on the actual evidence that infringers are misleading local consumers.

Conclusion

Despite the potential issues mentioned above, Uzbekistan intends to accede to the World Trade Organization (WTO) in the near future and if it joins the WTO, it will have to align its legislation with all of the WTO's agreements, including the Paris Convention.

What is more, in accordance with the recent President's Decree No.108 dated 6 July 2023, a new resolution aimed specifically at determining unfair competition acts will be adopted and used as a guide when dealing with such cases. Once this bylaw is adopted, it might be used to protect the interests of IPR owners in Uzbekistan.

YEMEN

Saba IP

In a significant stride towards modernizing its intellectual property framework, Yemen has taken a commendable step by adopting the 10th edition of the Nice Classification. This update marks a leap from the outgoing 8th edition.

With Yemen's transition to the 10th edition of the Nice Classification, it is important to note that certain items are still excluded from registration in line with cultural and legal considerations:

1. Class 33: Alcoholic beverages fall within Class 33 of the Nice Classification. However, in accordance with Yemen's regulations, trade mark registration for alcoholic goods will not be permitted.
2. Class 32: Class 32 encompasses non-alcoholic beverages, including beers and other beverages. However, the registration of trade marks related to beer, which might conflict with cultural sensitivities, will not be allowed.
3. Class 29: While Class 29 pertains to meat, fish, poultry, and game, trade mark applications for pork meat within this category will also be ineligible for registration in Yemen.

PROFILE: Laura Collada, Dumont

With more than 30 years of experience in the IP field and as the Managing Partner of the firm since 2008, Laura is a dedicated strategist and has acted on several milestone cases. Laura leads most of the firm's large and complex cases. Furthermore, Laura has a high profile, both locally and internationally. She is regularly invited to speak for MARQUES, UIA, ASIPI, FICPI, ABPI, and INTA and is a renowned teacher at several Law Schools. Laura is a three-time recipient of the Best IP Lawyers in Latin America Awards of Euromoney's America's Women in Business Law. She also continues to design strategies for clients as well as litigating.



Where were you brought up and educated?

I've lived in Mexico City all my life. I attended a school that was both bilingual and bicultural (American English/Spanish). My parents sent me to Canada to improve my English. I went to Law School also in Mexico City and I have taken courses abroad.

How did you become involved in trade marks?

While attending law school, I was in the urgent need of a paid job. I became an intern at an IP boutique firm without knowing what a trade mark was. I fell in love with the field.

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

Probably a teacher. I wanted to study History, Philosophy or Literature (in addition to Law). Years later, I developed a passion for cooking, so probably I would be a chef with a great conversation.

Which three words would you use to describe yourself?

Outgoing, hardworking, friendly.

Complete the following sentence. "I wish"

I wish I could travel the world.

What was your worst experience in the world of work?

Visiting a firm abroad and the Managing Partner – a hard old school guy – discriminated me for being a woman. He never spoke to me, he just addressed my male business partners.

What was your biggest work or career mistake and what did you learn from it?

The first case I was in charge of, I filed the documents with a different Court ... First, I cried my eyes out, and then did magic to solve it.

What do you do at weekends?

Be with my family and friends, cook, and watch TV series.

Complete the sentence: I have time to myself ...

I would try to write a novel.

What's the best thing about your job?

The opportunity to meet people from all over the world.

What does all your money get spent on?

Travelling and spoiling my nieces and nephews.

What is your biggest regret?

Not speaking more languages.

What is your favourite work of art?

Girl with a Pearl Earring by Johannes Vermeer.

What is the soundtrack to your life?

Fame.

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

Literally bumping into the Dalai Lama. I was running late for a meeting, the lobby

of the hotel was packed and I tried to walk between people and suddenly the Dalai Lama was holding my head.

What is the best age to be?

Forties are great, enjoying my fifties.

What is your philosophy in a nutshell?

Need sharpens your senses.

What's the toughest thing about your job?

I don't like all the administrative tasks that I have to supervise as a Managing Partner.

Who was your mentor or role model?

I have two. A law school professor Denis Kaye who taught me well and challenged me to be better. He recently passed away and he was one of the best teachers I ever had. Jose Dumont, my friend, my boss and then my partner, who taught me to always be a team player.

What is your weakness?

I care too much about the people I love.

Which book changed you?

Steppenwolf. I very much enjoy reading Hermann Hesse.

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

Spanish Pop or Queen.

Which modern convenience could you not live without?

Electricity at home, nothing works without it.