

INN Stems in Trade Marks - Objections in Australia

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The Australian Trade Marks Office has adopted a practice of automatically objecting to trade mark applications for pharmaceuticals, veterinary preparations or pesticides in class 5 that contain an INN stem on the basis that such marks are considered likely to deceive or cause confusion.

What are INN stems?

International Nonproprietary Names (INNs) identify pharmaceutical substances or active pharmaceutical ingredients. Each INN is a unique name that is globally recognized, public property and is approved by the World Health Organization (WHO). For example, in respect of PANADOL® paracetamol, paracetamol is the global INN for the pharmaceutical substance, while PANADOL is the brand name for the particular paracetamol product originating from the GlaxoSmithKline group of companies.

The names of pharmacologically related substances share a common INN "stem" which assists medical practitioners, pharmacists and others to recognise that the substance belongs to a particular group of substances having similar pharmacological activity. Some stems are relatively inherently distinctive (eg. -gliflozin), whereas others are arguably not (eg. -ine).

What is the basis for objection to trade marks containing INN stems?

A trade mark application will receive an objection if, because of some connotation of or within the trade mark, the use of the trade mark in relation to the applied for goods or services would be likely to deceive or cause confusion (section 43 of the *Trade Marks Act 1995*).

Unless the following applies, the Trade Marks Office will, as a matter of practice, object under the section 43 ground to a trade mark in respect of pharmaceuticals, veterinary substances or pesticides which contains an INN stem:

- the INN stem is not contained within the mark in "a meaningful way". This has a very narrow application. The Office considers INN stems are contained in a meaningful way unless they form part of an ordinary English word. For example, the stem –AST would be objectionable in an application for SIMIANAST but not in an application for FAST. The Office also gives the example that the presence of 'aj' in the term 'Sansajabendorastine' would not warrant objection given the length of the name and other competing references, but current experience suggests that slightly less extreme examples will warrant objection; and/or
- the goods covered by the specification are restricted to substances belonging to pharmacological group pertaining to the INN stem.

The Office considers that marks which do not comply with the above conditions will automatically be likely to give rise to deception or confusion.

How to overcome the objection relating to use of an INN stem within a trade mark

The Office will issue an adverse report stating that the objection may be overcome by agreeing to a condition of registration agreeing to limit the use of the mark to the relevant pharmacological group. The Office will suggest the following endorsement: "It is a condition of registration that any use in respect of (relevant goods) will be in relation to such goods containing substances belonging to the pharmacological group designated by the International Non-Proprietary Name stem (stem)."

To date, the Office is reluctant to consider surrounding circumstances which may rebut its assumption that the mark is likely to mislead or cause confusion, such as evidence of the widespread adoption of marketed product names incorporating the stem which belong to a variety of pharmacological groups.

Lesson for pharmaceutical companies

The current Office practice does not appear to recognise that some stems are not likely to be associated with a particular pharmacological group, for instance because the stem has not been used for several decades or because the relevant consumers are accustomed to seeing a high number of products on the market with trade marks containing the stem but which relate to a range of pharmacological groups. In such cases, arguably there is no connotation and no real likelihood of deception or confusion occurring.

Clearance in class 5 is already difficult for pharmaceutical companies and others seeking to clear global product names given the crowded state of the register. Unless the current practice can be successfully overturned, it will cause further headaches for companies trying to roll out global product names in class 5 to Australia.

In the meantime, trade mark owners in the pharmaceuticals, veterinary and pesticides field should consult the list of INN stems when clearing names and be wary of selecting names in Australia containing an INN stem unless the product is destined for the relevant pharmacological group.

Davies Collison Cave is currently in discussions with the Trade Marks Office to try to encourage a change of practice.

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Carly specialises in all aspects of trade mark law, and is experienced in managing large global trade mark portfolios for local and overseas clients. Carly advises in relation to conducting trade mark

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Carly has particular experience in the pharmaceutical industry, and international protection, having practised as global in-house trade mark counsel at one of the world's largest global pharmaceutical companies, based in the UK, for close to 5 years. Prior to that, Carly was a Senior Associate practising in trade mark law at a large Australian national law firm for 6 years.