

GLOBAL BRAND PROTECTION

オンラインセミナー 世界的なブランド保護

FEBRUARY 19/20, 2025



知の空は、もっと高い。

NGB

TOPIC

1ST WEBINAR: December 20, 2024

◆ U.S. Trademark Updates

(Ms. Tiffany D. Gehrke, partner at Marshall, Gerstein & Borun LLP)

◆ Gist of Mexican Brand Protection

(Mr. Esteban Santamaria, partner and founder of SADIMAVI, external advisor at Inter American Development Bank)

◆ For Realization of Brand Protection in Line With Brand Value Management

(Mr. Kouji Mizushima, Mazda Motor Corporation)

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TOPIC

2ND WEBINAR: February 20, 2025

◆ Coexistence Agreement Negotiation in Japanese

(Ms. Miki Minakata, NGB Corp.)

◆ The Use and Acquisition of Biopharm Trademarks in Japanese

(Mr. Ryuichi Honda, NGB Corp.)

◆ The Differences between Patents and Trademarks in English

(Ms. Kumiko Kitaoka, International Arbitration Center in Tokyo, Brown Neri Smith & Khan LLP)

◆ Usefulness of Trademarks in Biopharm, US v EU in English

(Ret. Judge Randall Rader, Chair, International Arbitration Center in Tokyo, Rader PLLC)

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TOPIC

3RD WEBINAR: March 5, 2025

◆ The Difficulties And Solutions Against Counterfeits

(Mr. Taishi Goto, JETRO Dubai)

◆ The EU Policy For Brand Protection

(Mr. Akira Yoshimori, JETRO Dusseldorf)

◆ Powerful Measures For Brand Protection in Europe

(Mr. Fabian Kunkel, Noerr Germany)

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COMPARISON PATENT V. TRADEMARK



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KUMIKO KITAOKA
INTERNATIONAL ARBITRATION CENTER IN TOKYO

Why obtain trademarks?

1. **No registration required.** To be clear, it is recommended to obtain a federal registration.
2. **Famous marks and well-known marks have leverage in the U.S. system.**
3. **Eliminate counterfeits and gray market goods**
4. **Strengthen exclusivity**
5. **Can expand business** into other businesses/sectors and keep a customer base.
6. **Marketplaces** like Amazon have an “almost-instantaneous” trademark enforcement system built in it. Basically, no legal cost

Unregistered trademarks?

1. No registration required for common law trademark rights.
2. Some shops only transact inside one state, not crossing state borders. A federal law regulates interstate commerce.
3. Trademarks are relative and can be divided into segments of geographical areas/markets.

If Tracy Musk and her father runs a local jazz bar called “X” in Virginia since 1955, Tracy Musk has a right to “X” under common law without registration. However, it is limited to the place and type of her business.

4. Foreign marks that have not been registered in the United States or in any state may be protected.

Well-known trademarks?

Well-known trademarks are protected and can exclude other businesses using a similar mark.

1. Both domestic and foreign origin.
2. Owners can block use or registration by unauthorized parties.
3. The Lanham Act is a framework to protect a trademark against infringement or registration by another party's similar mark for goods or services that are the same, similar, related, or even unrelated if there is a likelihood of confusion, whether or not the senior mark is registered. 15 U.S. Code § 1125 - False designations of origin, false descriptions, and dilution forbidden.

PATENTS AND TRADEMARKS US BIOPHARMA

	Patent	Trademark
Timing	When an invention is made (and have resources)	An important product or a new business arises.
Requirement	Discovery of a useful, novel, and non-obvious art. And disclosure. <div style="border: 1px solid black; border-radius: 10px; padding: 2px; display: inline-block;">First inventor to file jurisdiction</div>	Use of a mark in commerce. Other restrictions can apply. “Trump Too Small”
Application costs	May cost a significant amt of money	Usually, not so high as patents
Difficulty	Shifting examination guidelines re: eligible subject matter, written description, obviousness-type double patenting etc. The claims of a patent, may be difficult to enforce. 3 rd Party submission, reexamination, IPR may quash a patent (application)	Evidence of Use may be tricky. Uncertainties as to senior marks even allowed. <div style="border: 1px solid black; border-radius: 10px; padding: 2px; display: inline-block;">First to use jurisdiction</div> Sloppy management of trademark right → Abandonment and latches

PATENTS AND TRADEMARKS US BIOPHARMA

	Patent	Trademark
Expiration	20 years	Forever?
Multinational	To receive licensing revenues or dominate markets	To exclude counterfeits or passing-off, enforce price differentiation.
Allowance	Varies. Allowance may be difficult if the applicant is in a tag war for broad protection with an examiner.	Generally, the examination is not too complicated. Opposition may arise.
Remedy	Can obtain damages. Might obtain enhanced damages & attorneys' fees, and potentially injunctions.	Can obtain injunctions. May also obtain profits or damages, enhanced damages, plus enforcement costs. <i>Daimler AG v. A-Z Wheels LLC et al.</i> , No. 16-cv-875, 2020 WL 6395592 (S.D. Cal. Nov. 2, 2020)
Key	Quality patent in view of risks.	Select a good mark and a good counsel.

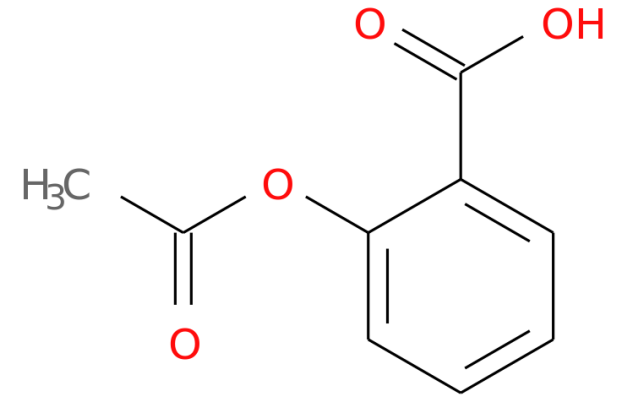
TRADEMARKS US BIOPHARMA: Brand vs. Generic

Bayer Co. v. United Drug Co., 272 F. 505, 512 (S.D.N.Y. 1921)

Bayer owned a patent and a trademark covering a drug called Aspirin.

Aspirin is used for:

Angina, Angina Pectoris Prophylaxis, Ankylosing Spondylitis, Antiphospholipid Syndrome, Aseptic Necrosis, Back Pain, Fever, Heart Attack, Ischemic Stroke, Ischemic Stroke Prophylaxis, Juvenile Rheumatoid Arthritis, Kawasaki Disease, Lupus, Myocardial Infarction, Prophylaxis, Niacin Flush, Osteoarthritis, Pain, Pain/Fever, Prevention of Thromboembolism in Atrial Fibrillation, Prosthetic Heart Valves - Thrombosis Prophylaxis, Prosthetic Heart Valves, Mechanical Valves - Thrombosis Prophylaxis, Revascularization Procedures, Prophylaxis, Rheumatic Fever, Rheumatoid Arthritis, Sciatica, Spondyloarthritis, Thromboembolic Stroke Prophylaxis, Transient Ischemic Attack,



TRADEMARKS US BIOPHARMA: Brand vs. Generic

Bayer Co. v. United Drug Co., 272 F. 505, 512 (S.D.N.Y. 1921)

Bayer owned a patent and a trademark covering a drug called Aspirin.

Initially, aspirin was sold as a prescription medication. Bayer packaged aspirin in bottles and sold them to pharmacies and physicians. The bottles generally were labeled “Aspirin” but did not contain Bayer’s name.

In 1904, Bayer began selling aspirin directly to consumers in a tablet form. No explicit reference to “Bayer” in relation to drugs. Users remember the name aspirin, not connected to Bayer.

In 1915, two years before the expiration of Bayer’s patent, Bayer began putting its name on its bottles of Aspirin. The labels stated “Bayer – Tablets of Aspirin.”

After the expiration of the patent, United Drug Company (defendant) began selling acetylsalicylic acid under the name “Aspirin.” Bayer brought a common-law trademark infringement suit against United.

TRADEMARKS US BIOPHARMA: Brand vs. Generic

Bayer Co. v. United Drug Co., 272 F. 505, 512 (S.D.N.Y. 1921)

Bayer sued a generic for using a trademark “**Aspirin**” after its **patents had expired**.

“There was ample notice upon the bottles and boxes that the striking part of the label read, ‘Bayer— Tablets of Aspirin— **acetyl salicylic acid**. But, consumers buying **OTC Aspirin** as a cold mediation or a pain drug.

The court allowed **limited injunction** banning the defendant druggists, pharmacies (cartons containing bottles of the drug) from attaching “Aspirin” to bottles.

Judge Lerner Hand found that “aspirin” is in public domain

Nonetheless, Judge Lerner Hand granted injunction

Trademarks are relative, can be divided into multiple geographical areas/markets.

TRADEMARKS US BIOPHARMA: Brand vs. Generic

- Basically, the name was “Genericized” because Bayer did not adopt smart trademark measures against genericization.
- After the United States entered the war against Germany in April 1917, the Alien Property Custodian, a government agency that administers foreign property, seized Bayer’s U.S. assets. Two years later, the Bayer company name and trademarks for the United States and Canada were auctioned off and purchased by Sterling Products Company, later Sterling Winthrop, for \$5.3 million.
- Eventually Bayer reacquired the trademark from SmithKline Beecham in a deal for the price of \$1 billion.



12
Bayer-Tablets
OF
Aspirin
(5grs. each)



The Bayer Company, Inc.
117 Hudson St. N.Y.





PATENTS AND TRADEMARKS US BIOPHARMA

Edwards Lifesciences Corp. et al. v. Meril Life Sciences Pvt. Ltd. et al., No. 19-cv-6593, 2021 WL 4281336 (N.D. Cal. Sept. 21, 2021) *aff'd Edwards Lifesciences Corp. v. Meril Life Scis. Pvt. Ltd.*, 96 F.4th 1347 (Fed. Cir. 2024), *cert. denied*, No. 24-428, 2025 WL 76453 (U.S. Jan. 13, 2025)

Edwards owns a **patent over the heart valve** and **trademark for the word “Partner.”**

Meril, an Indian medical device company imported two samples of its transcatheter heart valves in order to show at a medical conference in California. The samples were then handed over to another employee, who was traveling to Europe.

Sometimes, patent owners lose.

J. Gilliam granted a summary judgment for Meril finding that the importation was exempted from patent infringement under the safe harbor 35 U.S.C. § 271(e)(1). Found it was reasonably related to recruiting investigators for clinical trial to support Food and Drug Administration (FDA) approval. Federal Circuit affirmed.

Meril used “partner the future” in its product promotion materials.

Trademark infringement remains.

J. Gilliam refused to grant summary judgment. Meril’s trademark infringement goes to trial.

PATENTS AND TRADEMARKS EU BIOPHARMA

- Edwards Lifesciences Corporation's European patent 3,646,825 (EP'825) was partially invalidated in Europe.
- However, Edwards brought a patent infringement action against Meril (the claim in amended form), in Unified Patent Court.
- The Munich Local Division (LD) issued its infringement decision in favor of Edwards on November 15, 2023. The UPC considered the public interest and third parties when issuing an injunction and broadly interpreted the safe harbor provision, which could allow more activities to be shielded under the safe harbor.

IACT

- ❑ IACT is an international IP-focused center for alternative dispute resolution. Established in September 2018 under the auspices of Japan Patent Office.
- ❑ In June 2018, global IP leaders showed a simulated arbitration involving Standard Essential Patents at University of Tokyo.
 - IACT's chair is Judge Randall Rader, the former Chief of the Federal Circuit.



模擬国際仲裁の様子と登壇者



Why Alternative Dispute Resolution in IACT

- 1. Global coverage:** Arbitrators and mediators are selected from major jurisdictions around the globe.
- 2. 1-Year Time Limit:** Each case will proceed with a one-year time limit.
- 3. Cost efficiency:** Streamlined processes cut down time and costs. Parties pay for the hours that arbitrators actually spent on the dispute.
- 4. Distinguished arbitrators/ neutrals:** Many of IACT's arbitrators are retired judges and/or patent officials.

SUMMARY

- i. Trademarks are an important asset for any company. Unregistered trademark rights may be protected.
- ii. Extend exclusivity beyond 20 years.
- iii. May deter counterfeits and gray market products.
- iv. Trademarks are relative, may be segmented into multiple areas and markets. Thus, They are more amenable to Negotiations and Mediations. Judges are very experienced in contract interpretation as well as statute interpretation.
- v. However, high-stakes trademark disputes involve multiple continents. Piecemeal litigation is cost prohibitive. Arbitration is a great option.