

Overcoming Unique Issues Regarding Trademark Searching and Filing for the Pharmaceutical Industry

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ROTHWELL FIGG

Trademarks

“The ideal trademark is one that is pushed to its utmost limits in terms of abstraction and ambiguity, yet it is still readable. Trademarks are [...], in a certain sense, thinking made visible.”

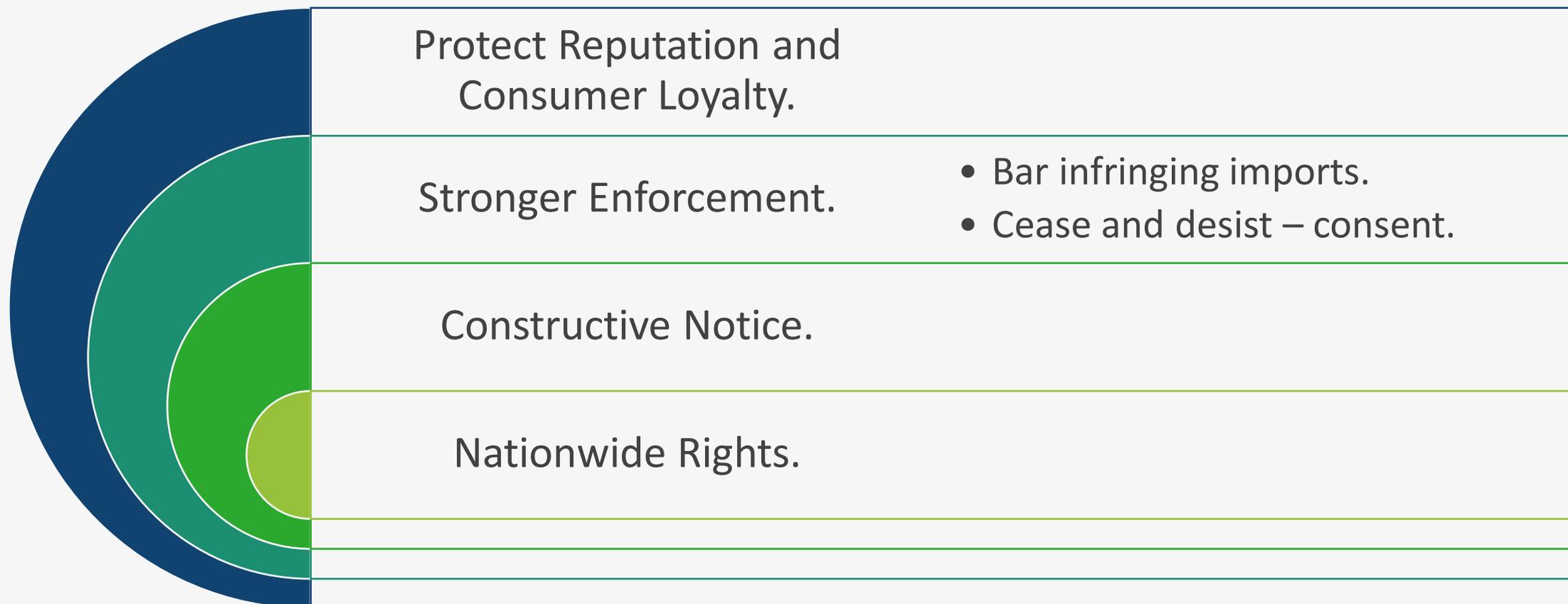
- Saul Bass

Trademarks in the pharma industry are important not only as part of a company's intellectual property portfolio, but also as a matter of public health.

Many considerations when selecting a new product name.

- FDA
- Competitors
- Attractiveness of name
- Not too descriptive

Why Register a Trademark?



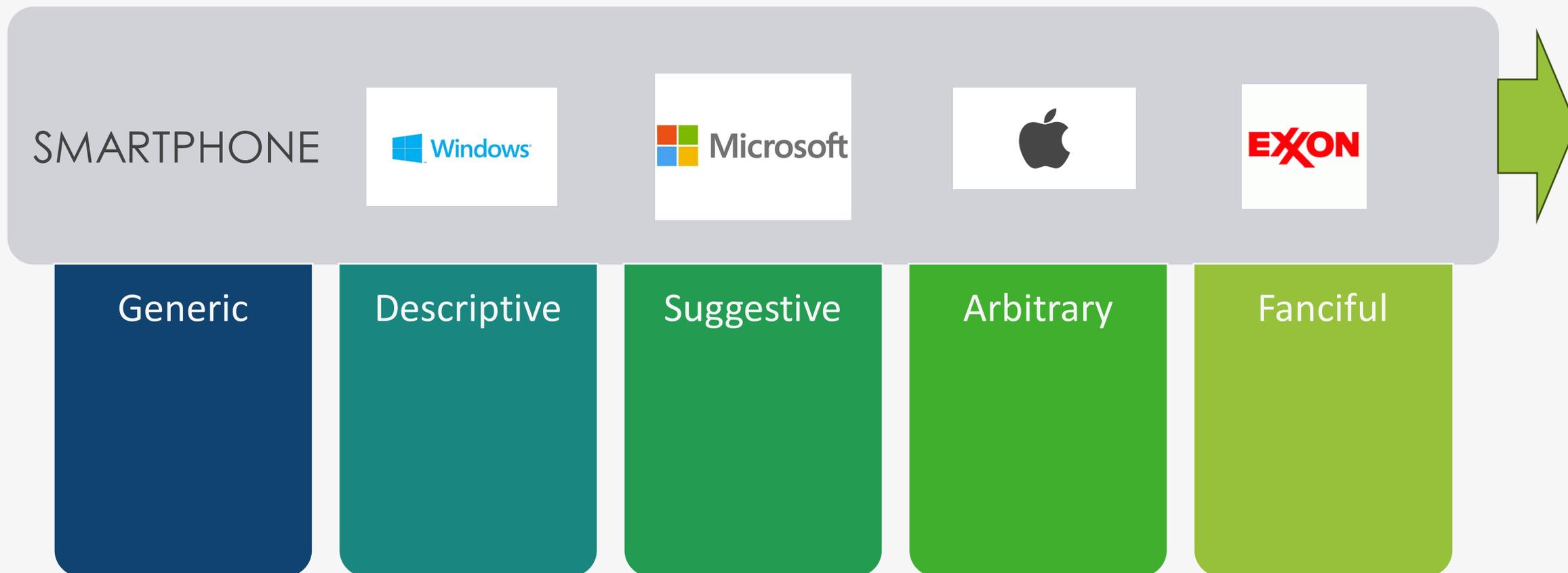
Initial Considerations

Understand the spectrum of trademark strength

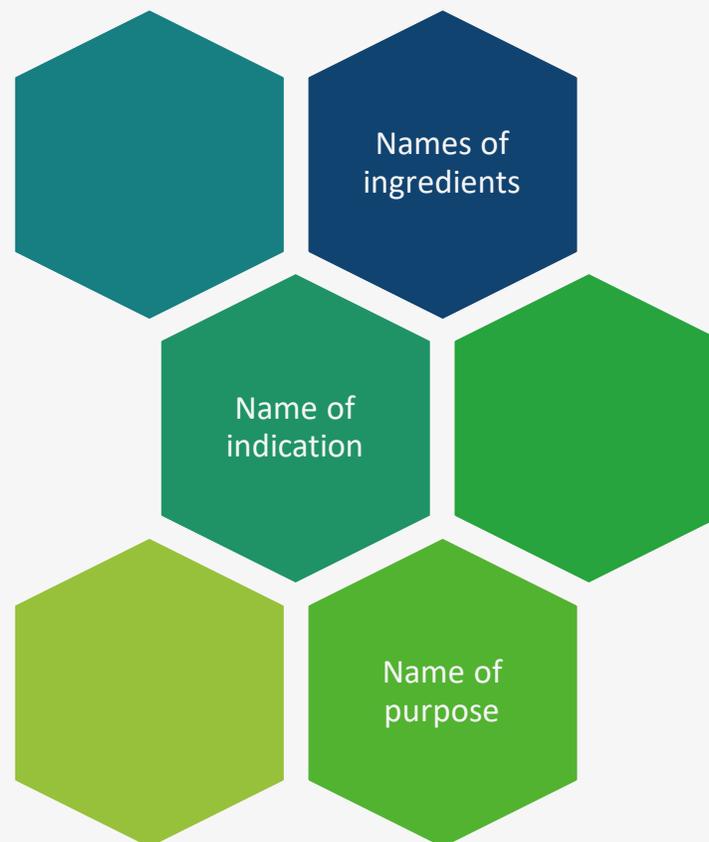
Avoid including literal elements/words in connection with ingredients, as this is considered descriptive

Avoid any similarity with existing trademarks/brands

How to pick the strongest trademark?



Avoid Including Literal Elements



Avoid Any Similarity with Existing Trademarks/Brands

Search

Issues with USPTO and third parties

Availability Searches

Conduct an Availability Search

- Determine scope of protection
- Assess risk of conflicting marks

Types of Searches

- Federal
- Comprehensive

Federal

- Principal Register
- WIPO Extension of Protection

Comprehensive

- Principal register
- State registers
- Common law
- Domain names
- Business names
- Web pages
- WIPO Extension of Protection

Availability Searches – Pharma Specialty Search

U.S. Pharmaceutical Search

- PDUFA sources (Orange book; POCA rankings; FAERS; VAERS; USAN names)
- Industry databases (IMS; WHO)

USFDA POCA Search

- FDA OrangeBook
- Drugs@FDA; RXNorm

Risk: How to Interpret Results

Infringement/Third Parties

- Likelihood of confusion
- Balance DuPont Factors
- Entity assessment

Registered Marks

- Principal Register
- State Registers

Common Law

- Snapshot of use in commerce
- Marketing/Advertisement

How to Minimize Formality Refusals

Tailor Description of Goods and Services

- Use Trademark Manual of ID
- Provide specific examples of use
 - e.g., skin condition (namely, acne, rashes, etc.)

Classes

- Cannot add after filing
- Use requirements

How to Address Substantive Refusals - Likelihood of Confusion

DuPont Factors

- Number of marks with similar wording
- Term weakness
- Consumer sophistication
- Regulated industry

Descriptiveness

- Feature, function or ingredient
- Directly convey idea of product
- Consumer uses mental gymnastics
- Descriptiveness spectrum (suggestiveness)

Likelihood of Confusion – DuPont Factors

- Balance of 13 factors (*In re E.I. Dupont de Nemours & Co.*)
- Senior mark takes precedence



Third Party Challenges

Challenges from third parties during publication

- Narrowing of goods
 - Exclusion of treatments or indications
- Coexistence agreements
 - Agreements not to challenge

Filing Proof of Use at the USPTO

Most pharma applications are based on intent to use.

Last step before registration.

Must file proof of at least one product per class.

What is use?

- Sale of transport in U.S. commerce
- Shipping branded products within U.S. ok
- Packaging
- Product itself (e.g., pill or capsule)
- Advertisements not generally accepted

What if specimen refused?

Guidance on Use of Artificial Intelligence (AI)

April 2024 – USPTO issues guidance on use of AI in trademark prosecution

- Importance of using AI responsibly
- Reviewing content before submission
- Instructed to mitigate risks in using AI

Questions? Thank you!



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