

OCTOBER 2009 Thailand: A guide to pharmaceutical trade marks

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When creating trade marks, pharmaceutical companies often choose words that are similar to the generic names of the International Nonproprietary Name (INN) system administered by the World Health Organization (WHO). These marks frequently incorporate the first or last syllables of the relevant INN. The chart below provides samples of trademarks registered in Class 5 for pharmaceutical products that are similar to an INN.

Trade mark International nonproprietary name

Tamofen tamoxifen

Vinelbine vinorelbine

Gliride glimepiride

Fexodin fexofenadine

In examining trade mark applications for pharmaceutical products in Class 5, the trade mark registrar will compare the applied-for mark with the INN designated by the WHO to ensure that the mark is not confusingly similar or identical to the INN. This comparison is in accordance with the Ministry of Commerce Announcement Number 5 (BE 2543, AD 2000) Re: Trade Marks which Are Prohibited for Registration, which states that any mark which is similar or identical to an INN as designated by the WHO cannot be registered. Under current practice, however, the registrar does not actually reject the registration of marks which are confusingly similar to an INN. The registrar will reject the registration of such marks only when they are identical to the INN.

Nevertheless, the Board of Trademarks disagrees with this practice of the registrar. In 2005 and 2006, the Board rejected the registration of pharmaceutical marks that were similar to an INN in four separate cases.

International nonproprietary name	Registered trade marks filed by various pharmaceutical companies
Atorvastatin	Atoravil Atorsan Atorlip Atormex Atorvin
Clopidogrel	Clopine Clopixol Copidel
Celecoxib	Biocoxib Cencoxib Mediccoxib Sucoxib Coxib
Omeprazole	Omepral Lanprazole Nexprazole Orazole Ulprazole
Fexofenadine	Fexotine Fexof
Metoprotol	Metrotop Metrolol Metoblock Metoral Metro Metrozone

Applications for the trade marks Tamofen, Vinelbine, Gliride, and Fexodin were filed for pharmaceutical products in Class 5 (as shown in the table above). All four marks were accepted for registration by the registrar. However, when they were published for opposition, each mark was opposed on the ground that it was confusingly similar to an INN, namely tamoxifen, vinorelbine, glimepiride, and fexofenadine respectively. The Board rendered its unfavourable decisions rejecting the registration of the four marks due to their confusing similarity to each INN.

A pharmaceutical mark which is similar to an INN is not likely to enjoy a smooth registration process given the Board's tendency to find the similarity confusing and therefore objectionable.



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