Exelon Patch (+)

TURKEY

Turkish Patent Institute, decision of January 25, 2014 in Case 2013-G-374027

The product appearance of a transdermal plaster is eligible to protection as a figurative mark for pharmaceutical preparations for the treatment of Alzheimer type dementia in class 5.

Background

Novartis AG ("Novartis") obtained an IR registration before the OHIM and national registrations in Japan, Germany and Benelux for a device trademark in relation to "pharmaceutical preparations for the treatment of Alzheimer-type dementia" in Class 5. The device trademark in question is the 2D shape of the relevant Alzheimer product called Exelon Patch consisting of a round shaped beige patch surrounded by fifteen light gray dots on a square transparent layer. The Exelon Patch is used by Alzheimer patients as the only product developed in the form of a patch to be applied on skin instead of oral route.

In 2013, Novartis sought to register the appearance of the Exelon Patch as a device trademark in Turkey by designation under the Madrid Protocol. The Turkish Patent Institute ("TPI") granted an ex officio refusal decision on the basis of Article 7(1)(a) of the Decree Law Regarding Protection of Trademarks. Article 7(1)(a) sets forth that signs which do not fall within the scope of Article 5 cannot be registered. According to that provision, a trademark may consist of all kinds of signs capable of being represented graphically or in similar means, published and reproduced by printing such as words (including personal names), designs, letters, numerals, shape of the goods or their packaging provided that the sign is capable of distinguishing the goods and services of one undertaking from those of another.

Novartis appealed the ex officio refusal decision before the Re-Examination and Re-Evaluation Board ("REEB") of the TPI, thereby mainly arguing that the subject trademark fell within the scope of Article 5 on the basis of both inherent and acquired distinctiveness.

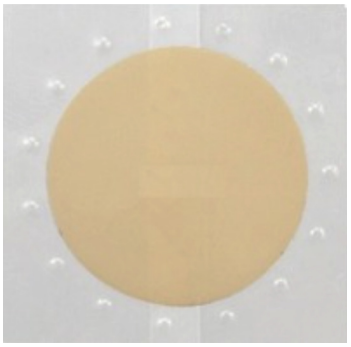
Decision

In the appeal proceedings, Novartis initially discussed that the appearance of the Exelon Patch constitutes a sign capable of being represented graphically beyond any doubt. Furthermore, inherent and acquired distinctiveness of the sign in question was argued in light of various supporting documents and means of evidence.

Novartis put forward that the appearance of the Exelon Patch was inherently distinctive as the first and at the time only product developed in the form of a patch for treatment of Alzheimer. Neither in Turkey nor in other countries, there was at the time the application was filed a second product in this therapeutic field offered to patients in this form and route. Moreover, the design of the Exelon Patch was particularly unique with its sun-like shape which could not be compared to any other regular patch let alone any Alzheimer treatment product.

The second argument Novartis strongly developed was the acquired distinctiveness attributed to the patch. Considering the memory problems caused by Alzheimer, this transdermal system that delivers the medicine in a patch through the skin was immediately considered as a highly innovative and distinctive product for the relevant public. Novartis submitted various documents such as press news to REEB for consideration of the unique features of the design and appearance of the Exelon Patch.

Among the evidence submitted by Novartis, two surveys conducted in Spain and Germany were significantly important and arguably influential on the decision of REEB. The targeted audience of the survey in Spain consisted of specialized healthcare professionals and a patient association whereas the survey in Germany was only directed to healthcare professionals. In both surveys, only a picture of the Exelon Patch product, in other words the sign applied for trademark registration, was showed to the



participants without any reference to Novartis or the product name. The surveys evidenced that the majority of the healthcare professionals and caretakers directly associated the picture showed to them with Exelon Patch product or Novartis and/or identified that the patch in the picture is used for treatment of diseases related to dementia. In both surveys, even approximately 40% of the healthcare professionals not specialized in the relevant therapeutic field recognized the patch and associated it either with Novartis or the Exelon Patch product. In line with the approach of OHIM, Novartis argued that the TPI should take into account the perception of a limited group of targeted audience including physicians, pharmacists and patients association of the relevant therapeutic field.

Finally, Novartis relied on Article 6^{quinquies} of the Paris Treaty and Article 15 of TRIPS in challenging the ex officio refusal decision of the TPI. It is argued that the device trademark sought to be registered in Turkey should not have been refused on the basis of Article 7(1)(a) of the Decree Law Regarding Protection of Trademarks since the distinctive character thereof had already been accepted by registrations in other countries party to the aforesaid treaties.

Upon examination of the appeal, REEB reversed the ex officio refusal decision and decided that the trademark application cannot be rejected on the basis of Article 7(1)(a).

Comment

Novartis successfully challenged the ex officio refusal decision and registered the appearance of its Exelon Patch product as a device trademark in Turkey. The decision puts forward that inherent and acquired distinctiveness can be accepted by TPI on the condition that the applicant provides proof thereof by well-designed, comprehensive and meaningful evidence such as the field surveys.

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Burcu Gürel is an associate of the NSN Law Firm. She is qualified as a trademark and patent attorney in Turkey and has been advising on intellectual property, life science and health-care regulations. She is the co-author of the Turkey chapter of the Life Sciences Review.

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