

European Intellectual Property Review

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KEVIN DUGAN

FDA's Trade Mark Review: A First Amendment Issue 130

The United States Food and Drug Administration (FDA) has the authority to approve the marketing of pharmaceutical products. As part of its review, the FDA will evaluate the sponsor's proposed trade mark from both safety and promotional aspects. Often the FDA will object to the submitted trade mark, thereby denying the sponsor the right to use its trade mark. This is true even if the trade mark is registered in the United States Patent and Trademark Office. A question that needs to be answered is whether the FDA in denying a right to use a trade mark could in some instances be violating the constitutionally protected free speech right of the sponsor.

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Access and benefit-sharing was a key objective of the United Nations' Convention on Biological Diversity (CBD). Implementing this objective in Australia has seen the adoption of a contract model where the terms and condition and price of access are negotiated between the bioprospector and the resource holder. Patents are a part of the price. This article assesses the place of patents in theory and in practice through the examples of the Craig Venter Institute contract and the Griffith and AstraZeneca Partnership agreement(s) in Australia. The article concludes that there is little evidence that benefits flow to conservers and curators of in situ biodiversity (such as protected areas) and that uncertain property and use rights from patents may be further reducing the value bioprospectors are likely to pay to access and use biodiversity.

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The expression "the terms of the claims" is traced to its origins in the negotiations leading up to the 1963 Strasbourg Convention, which paved the way for the European Patent Convention of 1973. In its original formulation, the purpose of the expression was indeed to denote the "English" approach to claim construction and distinguish it from that prevailing in Germany, but the draft article in which the "terms of the claims" occurred specifically intended to rule out the literal English approach, in favour of using the claims as a signpost towards the general inventive concept, which was to be definitive.

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"Exhaustion of intellectual property rights" means that right holders lose the right to control the resale of the protected goods. Without an exhaustion doctrine IPR holders would perpetually exercise control over the sale, transfer or use of the relevant goods, and would have a grip on commercial relations. Article 6 TRIPs leaves WTO member countries free to adopt national, regional or international exhaustion regimes. After highlighting the benefits and costs stemming from the different types of exhaustion, the author argues that only international exhaustion is consistent with the spirit, provisions and targets of the WTO multilateral trading system and should therefore be imposed on all WTO countries.

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In *Marico Ltd v Agro Tech Foods Ltd*,¹ it was decided that LO-SORB, a registered trade mark for edible oil, was not infringed since prima facie it lacks distinctiveness on the date of registration, being a tweaked version of LOW-ABSORBE, which characterises low absorption of fat in the edible oil. Use of LOW-ABSORBE by the defendant as sub-brand to indicate its low absorption quality when used for frying, falls within permissible exceptions to infringement. The court examining the plea of infringement can go into the prima facie issue of validity of registration for determining the plea of preliminary injunction.

Book Reviews

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