

Trademarks for the Pharmaceutical Sector in Turkey

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Pharmaceutical trademark owners consider many factors when selecting a trademark. As it assists consumers' decision-making process, a trademark often contains the product's International Nonproprietary Name (INN) code and refers to the indication or feature.

Regulatory requirements also apply when selecting a trademark. Despite the sector's special needs and characteristics, it is disappointing that the similarity examination for pharma trademarks is still not yet settled in Turkey.

In recent years, the Appeal Court and the Turkish Patent Institute (TPI) have at times applied a two-stage reasoning process during similarity examinations on pharma trademarks:

- (1) The consumers of the intended trademarks (doctors and pharmacists) pay a high level of attention; and
- (2) Therefore, since pharma preparations are sold only with a prescription, small changes might be enough to overcome similarity or the likelihood of confusion.

However, this reasoning has not been universally accepted by the TPI, or the courts. In many cases, examination of similarity for pharma trademarks has simply involved applying the TPI's general guidelines. Recent decisions by the TPI and Appeal Court show the reasoning above is applied to trademarks which contain the INN code or make reference to the active ingredient.

Many Appeal Court decisions hold that the earlier trademark owner which registers a trademark very similar to the active ingredient or INN code should tolerate the use of similar trademarks derived from the same active ingredient or INN code.

For example the Appeal Court allowed the trademark 'Amreks' by finding it not similar to the earlier trademark 'Ambridex', despite both trademarks being derived from the same active ingredient, ambroxol. The Appeal Court allowed the later trademark on the basis that both trademarks are intended to be used on prescription drugs. Accordingly, it reasoned they both appeal to a consumer group with a high level of attention.

Uncertainty for pharma

However, the reasoning is not applied for trademarks which do not have any reference to the active ingredient or INN code. This creates uncertainty for pharma companies, which already face many regulatory and commercial challenges specific to the competitive pharma sector.

For instance, the Appeal Court found the trademarks 'Nimo' and 'Rimo' confusingly similar, despite the fact that they are both prescription drugs, and the court determined the relevant consumer to be "a consumer group with a high level of attention: namely, doctors and pharmacists".

On the other hand, the TPI rejects applications which are identical or almost identical to an already registered INN code. Within this scope it rejected an application to register 'Meloglaptin' (in class 5) during its examination on absolute grounds. The rejection was based on a high level of similarity existing with the (already registered) INN code melogliptin.

Pharma companies should also take into account the 'three-letter rule', which the Pharmaceuticals and Medical Devices Agency of the Ministry of Health applies when issuing sale licences for drugs. When issuing a sale licence, the agency requires the drug name to be different from those of earlier licensed drugs. In some cases, the agency accepts a difference in three letters. Accordingly, this sets a higher bar for the similarity examination of pharma trademarks.

Three criteria should be taken into account when selecting a trademark for a pharma product:

- The trademark should be differentiated from the INN code or the active ingredient in order to prevent an office action based on a descriptiveness argument;
- The trademark should be differentiated enough from equivalent products in the market to avoid a likelihood of confusion before the relevant public; and
- The selected product name should comply with the agency's three-letter rule, which is applied during the last stage of the sale licence application.

The TPI's and the Appeal Court's practices are based on the idea that the closer a trademark is to the active ingredient or the INN code, the weaker the trademark is. In practice, it is accepted that similar trademarks can exist alongside each other, even if they are derived from the same active ingredient or the INN code. However, the TPI and Appeal Court do not seem to take precedent cases into account during similarity examination of trademarks which have little or no reference to the active ingredient or INN code.

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