Preliminary Analysis of Standards of Examination for Drug Mark Registration

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Under the International Classification of Goods and Services for the Purposes of the Registration of Marks (the 9th edition), drugs are put in Cass 5, which includes drugs for human use, nutrition for medical purposes, dugs for veterinary purposes and farm pesticides. Being a special class of goods, drugs, particularly those for human use, are directly related to the life, health and safety of the consumers. In most countries, special laws and regulations regulating the making and marketing of drugs have been made, and relatively special standards for the examination of applications for drug marks registration observed.

Under the Trademark Law as amended in 2001, the Trademark Office requires submission of fewer the application materials from an applicant when applying for the registration of a trademark used in respect of a drug, without requiring the latter to furnish the drug manufacturing license or drug marketing license. However, in view of the special nature of drugs, especially those for human use, relatively stringent examination standards are followed in the substantive examination of drug trademarks; the approval and registration of a drug trademark should be in conformity with the relevant provisions of the Trademark Law, and, as well do not conflict with such laws as the Advertisement Law and the Drug Control Law and the pertinent propositions of the World Health Organisation (WHO). This writer will be probing into the standards for examination of drug trademarks in the light of the relevant laws and regulations and the practice of examination of drug trademarks in China, so as to enable applicants to file applications for registration of trademarks in a more reasonable and effective manner. Being reasonably short, this article will focus on the special standards for the examination of drug trademarks, without elaborating on those for the examination of trademarks used in respect of other commodities.[1]

Examination of absolute reasons for drug trademark registration

The examination of the absolute reasons for the registration of drug trademarks covers the examination under the law provisions concerning prohibited use of signs as marks and the distinctive character, mainly, Articles 10 and 11 of the Trademark Law. Since drug marks often involve generic names of drugs or containing descriptive words, drug marks are examined by reviewing whether a mark is composed of a generic name of designated goods or whether it directly describes the function, raw material, or intended users of the drug in such a way that it would mislead consumers. In the following section, this writer will be discussing the two aspects in the light of the present specific situation.

I. Where generic name of drug is used as mark

The name of a drug is relatively complex. As a rule, a drug at least has three names: a generic name, a commodity name and a trademark name, and the three names, both different and connected, are liable to create confusion.

The generic name of a drug, one listed in the national standards of drugs, is also known as an international non-special name. Under Article 32 of the Law of Drug Administration that "the Pharmacopoeia of the People's Republic of China and the drug standards issued by the drug regulatory department under the State Council shall serve as the national drug standards", the drug names listed herein are statutory drug names, i.e. the generic drug names.[2]" Besides, the International Non-special Names (INN) compiled by WHO and the generic names of drugs regularly promulgated to the member states are also known as generic names of drugs.

It is thus shown that the generic names of drugs are names prescribed by the State for public use. If such name is used exclusively by a business, it would lead to monopoly on the public interest. For this reason, Article 11, paragraph

one (1), of the Chinese Trademark Law provides that the generic names of drugs should not be registered as a trademark. Once the commodity name of a drug listed in the Pharmacopoeia as the generic name of the drug, even if said commodity name has been registered as a trademark, the registration thereof is likely to be cancelled.

In China, a drug manufacturing enterprise may give a drug it has made a commodity name in addition to the statutory generic name if it is practically needed. The commodity name of a drug, also known as a name used for marketing the drug, is a name created independently by a drug manufacturer and used to distinguish itself from other drug manufacturers, or to distinguish the different drugs made by the same drug manufacturer, or to distinguish a dug of one dosage type from drugs of the other dosage type of the same drug. The commodity names have been emerged for special reasons. Since the generic names of drugs promulgated by the WHO are usually rather long, and difficult to understand and pronounce, the "commodity names" are used for the convenience of enterprises to promote their products, doctors to prescribe for patients, and patients to identify drugs. After a drug manufacturer's filing an application for, and being granted, the approval of the commodity name of a drug from the State Food and Drug Administration, the commodity name is used exclusively by the manufacturer, and an application may be filed for registration of it as a trademark. The Trademark Office will examine it under the Trademark Law upon accepting the application. The name would be approved for registration as a mark if its use is found not to be prohibited under the law or it does not infringe any prior right, otherwise the application would be refused. Upon approval for the registration, the commodity name becomes the trademark name of the drug, and protected under the Trademark Law, and the mark proprietor enjoys the exclusive right to use said mark.

For a long time, abuse of the drug trademark names has given rise to the phenomenon of one drug having multiple names, which makes consumers lessable to identify the function, curative effect or ingredients of the drug, and does direct harm to the life, health and safety of the consumers. For that matter, the relevant State competent department has intensified the control of the use of drug names.[3] Along the line, one principle is strictly observed in respect of the generic names of drugs, namely, a generic name of a drug must not be used, nor registered, as a trademark. In the trademark examination practice, relatively strict standards are followed in the examination of the generic names of drugs or marks composed of a generic drug name, with attention focused on the circumstances as follows:

1. A mark which is designated to be used on goods of a drug for human use and only composed of the generic name of a drug should not be registered as a trademark. This is a comparatively simple circumstance with relatively clear legal ground involved, i.e. the provision of Article 11, paragraph one (1), of the Trademark Law. As aforementioned, the generic name of a drug is determined on the basis of the Pharmacopoeia of the People's Republic of China and the national drug standards promulgated by the State Food and Drug Administration and the International Non-special Names (INN) compiled by the WHO and the generic names of drugs regularly released to the member states compiled by the WHO and the generic names of drug regularly released to each member state. For example, neither the name Butriptyline nor its Chinese transliteration "bu ti lin" of the anti-depression drug should be registered as a trademark.

2. A mark designated to be used on a drug for human use and composed of a distinctive portion and the generic name of the drug as a whole may be registered as a trademark if the name of the goods applied for registration is the same as the generic name of the drug, with disclaimer made of the exclusive right to the portion of the generic name in said mark. But if the name of the goods applied for registration is not the same as the generic name of the drug, it should be refused due to the likelihood of confusion on the part of consumers. Taking the mark "Beibei Xiaoer Qingre Pian" (literally "beibei" means "baby", "Xiaoer" child, and "Qingre Pian" fever relieving pill) for example, an application for registration of the mark as a whole may be approved if "Xiaoer Qingre Pian" is the goods in respect of which the mark is to be used as it falls outside the scope of the exclusive right. If the goods designated in the application is a drug for human use, the application would be refused as the mark would easily mislead consumers.

3. A mark should not be registered as such in which a non-standard generic name of a drug is used or which is extremely similar to the generic name of a drug or which was once the generic name of the drug listed in a the local drug Pharmacopoeia or an alias or former name of a drug or the use of which would easily mislead consumers. For example, "Rou Hongmeisu" (literally "Rou" means "soft" and "Hongmeisu" "erythromycin"), which is very similar to the generic name of the drug Hongmeisu (erythromycin), would easily

mislead consumers, so should not be registered as a trademark; "Burexitong", the alias of acetaminol, should not be used and registered as a trademark.

4. Where the generic name of a drug for human use is designated to be used on goods of a drug for veterinary purposes, whether the mark has a distinctive portion or not, it would obviously create confusion on the part of consumers, and affect the safe use of the drug, so it should not be used and registered as a trademark.

II. Examination of drug trademarks containing descriptive words indicating function, raw material or intended users of goods

A drug is a special class of goods, the main function of which is to treat disease and to save the patients. A drug manufacturer usually publicises or demonstrates the function or effect of the goods it makes in various ways to market the goods. Trademarks are often used to this end. In practice, many drug trademarks, such as "Niuduxiao" (eliminating uraemia) and "Kechuanling" (curing asthma), directly describe the function of the goods in respect of which they are used. Marks of the kind should be directly refused under Article 11, paragraph one (2) of the Trademark Law that "signs having direct reference to the function, intended purpose, raw material or other characteristics of goods shall not be registered as a trademark". But there exist numerous marks of another type, the meaning of which does not merely directly indicate the function, curative effect or intended users of a drug, and the way of combination of which is somewhat original. But these marks either contain words of the name of disease, organs of human body or intended users, or homophonic words indicating the function or curative effect of a drug, so they mislead consumers and affect the safe use of the drug, and are improper to be used or registered as trademarks.

The special character of drugs are shown by the fact that manufacture and administration of drugs are the responsibility of several administrative departments and are regulated by a variety of laws and regulations. For example, it is required, in the Principles of China for Using Generic Names as Names of Drugs and the Principles for Naming Drug Commodity, and the proposals on drug names made by the WHO, that use of the drug names should be avoided that might give patients indications in connection with anatomy, physiology, pathology or therapeutics.[4] Besides, in approving commodity names, the SFDA considers whether the commodity name of a drug would cause misunderstanding or inconvenience in medical treatment. It is obviously improper for a trademark name to co-exist with a generic name and commodity name on the package of the drug if it is not in conformity with the above principle. Therefore, in the examination of the trademark of a drug for human use, use of words having reference to the location of dissected human body or curative effect is under strict control, and if violation of the above provision occurs, the trademark will be refused as it would mislead consumers about the function of the goods or the mark is devoid of distinctive character.

The circumstances in which marks should not be approved for registration include:

1. Where marks directly refer to the function of the goods. It is quite common for words of drug names to be used as marks that directly refer to or indirectly indicate the function of drugs. For that matter, comparatively strict examination standards are applied in the examination of marks of the kind because they are likely to mislead consumers about the function, and affect the safe use of the drugs as in the circumstances shown below:

• Marks should be refused that are composed of names of human organs or diseases or directly indicate the function of goods or are likely to mislead consumers about the function of goods. Such examples are "Sukanggutongbao" (rapid recovery of bone sickness), "Yimailuo" (good for the arteries and veins), "Nouxuejian" (good for the blood), "Gongliubao" (being good for the womb after miscarriage), "Bohuo" (good for the neck), "Tongganlining" (drug for flu), "Ganrike" (drug for flu) and "Linkexing" (drug for curing gonorrhea).

While composed of a name of human organ or diseases, the mark, as a whole, having acquired the secondary meaning and not mislead consumers, may be preliminarily examined as shown with the examples of "Haogang" (good feeling), "Woxinfeixiang" (my heart is flying) and "Xiagurouqing" (gentle hearted knight-errant).

• A drug mark composed of the combination of a distinctive part and a word indicating the function of a drug would be refused because such a mark easily misleads consumers about the function and curative effect of the goods, and is contrary to the principles of drug naming, as shown with the examples of "Shiyaoweikangsu "(good for stomach), "Yongyannaoxinkang" (good for heart) and "Ruangongliujing" (good for uterus).

2. A mark directly referring to the intended users of goods or composed of words indicating the intended users of goods, which easily misleads consumers about the in-

tended users of goods, should not be approved for registration. For example, "Fuping" (meaning "female safety") and "Tongkejing" (cough drug for children).

But if a mark generally refers to non-fixed group, and does not directly indicate the users of the goods in respect of which it is used, or obviously has any other derivative meaning, it may be preliminarily examined as shown with the marks of "Xinnushi "(new women) and "Meishaonu"(pretty girl), which do not direct indicate the users of the goods in respect of which it is used .

3. Words like "Wuwei" (five tastes), "Shenyin" (ginseng)", "Yourugai" (good milk calcium), "Linsunjisun" (phosphoric acid and creatine), "Liuweidihuang (six taste rehmannin) showing the raw material of the goods, or misleading the consumers about the raw material or ingredients of the drug should not be registered as a trademark.

But if the name of a raw material, together with some other word, forms the words of a mark and has another meaning, it may be preliminarily examined as showing in the word "Renshenniao" (ginseng bird),

4. Use of homophonic words implying the function, curative effect of the drugs in respect of which they are used as marks which do no good to safe use of the drugs and cause consumers to misidentify or wrongly buy their drugs, such as "Anxuezhi" (it sounds good for blood), "Gusongkang" (it sounds good for bones) and "Xiaogongliu" (it sounds good for uterus), while not showing the function of drugs, these marks, as a whole, are extremely similar to their homophones such as "Anxuezhi" (it sounds good for blood), "Gusongkang" (it sounds good for bones) and "Xiaogongliu" (it sounds good for uterus) if they are used as marks, and are liable to mislead the consumers about the function of the goods, and affect the safe use of the drugs.

Examination of relative reasons of drug trademarks

The examination of relative reasons of drug trademarks, namely determination of similar marks generally follows the standards as set forth in the Trademark Examination Standards. In the meantime, due to the special characteristics of the marks of the type, special circumstances exist with the comparison of similar marks.

1. Two marks different in the presence of the Chinese character "Tang" (meaning hall or venue) are determined as similar marks.

According to the Chinese traditional practice, many drug manufacturers and distributors often use the character "Tang" as part of their corporate trade name, and the character has now become a name specially standing for the venue of medicinal business operation. As a result, it has a relative weakened distinctive character. For that matter, the pair of marks, such "Guangji" and "Guangjitang", are determined as similar marks, so are the pair of "Renhe" and "Renhetang" marks.

2. Two marks different in the presence of the Chinese characters "Te" (special), "Ling" (effective), "Kang" (healthy), "Ning" (peace), "Ke" (cure) and "Xin" (new) are determined as similar marks. Since these Chinese characters, all indicative of the function or curative effect of the goods, are weak in distinctive character, as exemplified by the pairs of the drug marks, such as "Lineng" and "Linengning"; and "Anke" and "Ankekang" which should be determined as similar marks.

3. Where trademarks used in respect of drugs for human use end in such Chinese characters as "Su" (element), "Dan" (pill), "San" (powder), "Wan" (ball), "Gao" (ointment), "Fen" (powder), "Ji" (dosage). "Shuang" (cream), and "Ye" (liquid), these final characters are deemed to be automatically disclaimed. Marks different only in these characters are identical in the distinctive part, such as the marks of "Guangling" and "Guanglingsan", and "Jingu" and "Jingusu", are all similar marks. ■

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[1] See the Trademark Examination and Adjudication Standards issued by the State Administration for Industry and Commerce in December 2005.

[2] The Drug Administration Law effective on 1 December 2004 marks the end of the local power to examine and approve manufacturing of drugs and local standards of drugs. Names of drugs for general use are determined under the national standards.

[3] It is required in the Notice Relating to the Administration of Further Standardization of Drug Names issued by the State Food and Drug Supervision Administration that except medicants having new chemical structure or new active elements and drugs of patented chemical compounds, commodity names should not be used for all other drugs.

[4] Article 3 of the Principles for Nomination of Commodity Names of Drugs provides that the following Chinese characters should not be used: (1) those exaggerating or implying curative effective of the drugs; (2) those showing parts of treatment; (3) those directly showing dosage type, quality, raw material, function, use and other features of the drugs; (4) those directly showing the characteristics of those on which the drugs are to be used; (5) those related to pharmacology, anatomy, physiology, pathology or therapeutics;