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Triple blow for pharmaceutical company Kowa in dispute with generic drug manufacturer Krka

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01 February 2022

GREECE
Legal updates: case law analysis and intelligence

- **This dispute involved Kowa, the owner of the mark PITAVA in Class 5, and Krka, the maker of the Pitavador generic prescription drug**
- **Kowa suffered a series of defeats before the Hellenic Trademarks Committee and the Athens Civil Court of First Instance**
- **Both the committee and the court found that Kowa's mark was quasi-identical to the INN Pitavastatin**

In two joined cases, the Hellenic Trademarks Committee rejected the opposition lodged by Kowa Company Ltd - the owner of the international registration for the trademark PITAVA designating Greece - against a trademark application for PITAVADOR filed by Krka, tovarna zdravil, dd, Novo mesto, and accepted the invalidity action lodged by Krka against Kowa's trademark PITAVA on absolute grounds. In parallel, the Athens single-member Civil Court of First Instance rejected Kowa's petition for injunctions filed against Krka on the ground of trademark infringement.

Background

Kowa lodged an opposition against the trademark application for PITAVADOR filed by Krka to cover pharmaceuticals in Class 5 on the grounds of double similarity and risk of confusion with the prior international registration for PITAVA, designating Greece, registered in Class 5 and used in connection with a pharmaceutical product for the treatment of cholesterol containing the active substance Pitavastatin (international non-proprietary name or INN).

In turn, Krka filed an invalidity action against the trademark PITAVA based on absolute grounds, claiming that the sign was not registrable as a trademark because it:

- incorporates the basic part of the INN Pitavastatin;
- is descriptive; and

- lacks distinctive character.

Both cases were jointly heard by the Hellenic Trademarks Committee.

At the same time, Kowa lodged a petition for injunctions against Krka before the Athens single-member Civil Court of First Instance on the ground of trademark infringement. Kowa requested that Krka cease the use of the applied-for trademark PITAVADOR in connection with a drug containing the same active ingredient (Pitavastatin) and to withdraw said product from the Greek market. Within the context of this procedure, Kowa sought a temporary restraining order and requested the immediate issuance of the decision, claiming urgency.

Civil Court decision

In Decision 1918/2021, the Civil Court refused to issue both the restraining order and the petition for injunctions. The court accepted Krka's basic arguments, namely that neither trademark infringement nor a risk of confusion had been established, as the trademarks under comparison and their respective packaging were sufficiently different. It also took into account that the goods at issue are prescription-only medicines sold in pharmacies. The court further ruled that the prior mark PITAVA is not entitled to protection: it is descriptive and lacks distinctive character as it incorporates the three first syllables of the INN Pitavastatin (namely, its dominant part), with no additional figurative or word element.

Therefore, the court rejected the petition for injunctions as lacking merit.

Trademarks Committee decisions

At the administrative level, in Decisions 114 and 115/2021, the Trademarks Committee rejected the opposition filed by Kowa against PITAVADOR and accepted the invalidity action filed by Krka against the international registration for PITAVA.

The committee held that the oral and visual impression of the opposed trademark was clearly different from that of Kowa's mark, especially in the mind of the targeted specialised public (ie, doctors, pharmacists and patients), mainly due to the strong pronunciation of the consonants contained in its suffix ('D' and 'R') and the visual difference created by the addition of the fourth syllable. Therefore, there was no identity with the prior mark.

The committee further ruled that the prior mark did not identify the origin of the products of a particular undertaking, but merely indicated to the consumer the active ingredient contained therein. Pursuant to the committee' s rationale, the mere fact that the attacked trademark did not incorporate the suffix 'statin' did not differentiate it from the active substance Pitavastatin - especially for the Greek specialised public, who understands such term as referring to the general category of substances for lowering cholesterol.

Comment

It is noteworthy that both the Trademarks Committee and the Civil Court adopted a similar view on the invalidity of the earlier mark as being quasi-identical to the INN.

Following the decisions, Krka is fully entitled to continue the commercialisation of the Pitavador generic prescription drug containing the active ingredient Pitavastatin.

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