

IP Hotline

May 08, 2012

RESPITE FOR THE PHARMACEUTICAL INDUSTRY - CONTROLLER GENERAL PUBLISHES A LIST OF INTERNATIONAL NON-PROPRIETARY NAMES

In the exercise of powers granted to the Controller General of Patents, Designs and Trademarks ("CG") under the Trade Marks Act, 1999 ("Act"), the CG has published a list of international non-proprietary names ("INN") and has stated that the same cannot be registered as trademark under the Act¹.

Background

What are International Non-Proprietary Names (INN)

Often common **pharmaceutical substances** are referred to by different names, resulting in a confusion regarding the substance used in a particular composition. To resolve this confusion, the **World Health Organization ("WHO")** has tried to give a separate identity, i.e a unique name to common **pharmaceutical** substances (such as paracetamol) to ensure safety of the patients. Such INNs are globally recognized names and since they are available in public domain (and are not permitted to be trademarked by anyone), they are called non-proprietary names.

Prohibition of Registration of INNs and words deceptively similar to INNs

In India, registration of INNs and words which are deceptively similar to INNs are prohibited under Section 13 (b) of the Trademark Act, 1999, which states that:

1. words commonly used and accepted as name of any chemical element/ compound, or
2. words declared by the WHO and notified by the Registrar of Trade Marks as INNs or names deceptively similar to such name,

shall not be registered under the Act.

Although this section under the TM Act has been in effect since 2003, a list of INNs was not issued until recently. Considering that INNs are used in relation to **pharmaceutical** substances, recognizing a list of INNs assumed relevance so that same/ similar trademarks cannot be applied for, creating confusion as to the identity of the product. It is with this objective that the CG has issued a list of 8151 names as INNs, which is available here http://www.ipindia.nic.in/list_INN_08February2012.pdf.

With a list of INNs being notified by the CG, any names which are identical or deceptively similar to those on the INN list will not be registered as a pharmaceutical trademark. This will hopefully put an end to a spate of pharmaceutical trademarks litigations where the similarity of the marks becomes the moot question in dispute. This will also ensure that no one manufacturer has an exclusive right over such generic /no-proprietary words or names.

Minu Ramani, Aarushi Jain & Gowree Gokhale

You can direct your queries or comments to the authors

¹ http://www.ipindia.nic.in/OfficeCircular/notification_INN_14February2012.pdf

DISCLAIMER

The contents of this hotline should not be construed as legal opinion. View detailed disclaimer.

This Hotline provides general information existing at the time of preparation. The Hotline is intended as a news update and Nishith Desai Associates neither assumes nor accepts any responsibility for any loss arising to any person acting or refraining from acting as a result of any material contained in this Hotline. It is recommended that professional advice be taken based on the specific facts and circumstances. This Hotline does not substitute the need to refer to the original pronouncements.

This is not a Spam mail. You have received this mail because you have either requested for it or someone must have suggested your name. Since India has no anti-spamming law, we refer to the US directive, which states that a mail cannot be considered Spam if it contains the sender's contact information, which this mail does. In case this mail doesn't concern you, please unsubscribe from mailing list.

Research Papers

Compendium of Research Papers

April 11, 2024

Third-Party Funding for Dispute Resolution in India

April 02, 2024

Opportunities in GIFT City

March 18, 2024

Research Articles

Private Client Insights - Sustainable Success: How Family Constitutions can Shape Corporate Governance, Business Succession and Familial Legacy

January 25, 2024

Private Equity and M&A in India: What to Expect in 2024?

January 23, 2024

Emerging Legal Issues with use of Generative AI

October 27, 2023

Audio

IBC allows automatic release of ED attachments: Bombay HC reaffirms

April 15, 2024

The Midnight Clause

February 29, 2024

Enforceability of unstamped or inadequately stamped Arbitration Agreements

January 10, 2024

NDA Connect

Connect with us at events, conferences and seminars.

NDA Hotline

Click here to view Hotline archives.

Video

Cyber Incident Response Management

February 28, 2024

Webinar : Navigating Advertising

**Laws in India Part II Fireside Chat
with Manisha Kapoor**

February 27, 2024

**Webinar : Navigating Advertising
Laws in India**

February 20, 2024