Index

Abbott, F 321
active pharmaceutical ingredients (APIs) 115, 126–32
see also trademarks in the pharmaceutical sector, EU advertising
Bagley, M 315
Baldwin, R 30, 32
banned descriptors, renewal of trademarks containing 51–2, 60 bans on brand extension medicines (umbrella brands) 133–5
Bar-Gill, O 31
Barendt, E 94
Bartley, T 257
Barton, J 235
Bauer, J 301
Beebe, B 102
behavioural science and market manipulation, certification marks for public health 271–2

The new intellectual property of health
Index

pharmaceutical trademark registration and brand protection 112–13, 114–15
umbrella brands (bans on brand extension medicines) 133–5
see also advertising; labelling; trademarks

Breheny, S 209
Broude, T 31, 285
Brüggemeier, G 83
Bubb, R 34, 41
Burgess, A 38
Burrell, R 206
Büthe, T 257

Cafaggi, F 268
Calboli, I 283–304
Callmann, R 191
Calo, R 272, 273
calorie information, certification marks for public health 266–7, 276–9
Cameron, J 81, 95
Canada
Canadian Medical Association (CMA) on tobacco packaging 21–2
Cécilia Létourneau v JTI Macdonald 179
Ford v Attorney-General of Quebec 95
freedom of expression 81
Regulations Amending the Food and Drug Regulations 135
tobacco advertising 179
Tobacco Products Control Act 22, 81
umbrella branding in pharmaceuticals 134
Carpenter, M 87
Carreño, I, 17, 138–59, 326
certification marks for public health 257–82
administrative costs 264–5
behavioural science and market manipulation 271–2
calorie information 266–7, 276–9
certification marks on food, use and impact 258–9

consumer awareness issues 264, 265, 269–70, 274–5
and consumer choice 270–75
consumer purchasing behaviour contradictions 274, 276
credence attributes (verification of hidden qualities of a product) 262, 269–70
cross-border standards 265, 266, 269
definition of certification marks 260
facilitation maximization 273–4
fair trade certification mark 266
geographical indications 261
Global Partnership for Safe and Sustainable Agriculture (Global-GAP) 269
global public–private partnership (PPP) 257–8
global value networks (GVNs) 257–8, 265–70
health policy and nudge concept 272, 273–4
health-related food products 263
label ‘fatigue’ concerns 277–8
limitations 263
marijuana tracking through supply chain 267
market manipulation concerns 259–60, 271–2, 275, 279–81
‘natural’ labels on food products 260
notice-based forms of regulation (mandatory disclosure) 258, 269–70, 272
nudge concept 271–4
‘organic’ labelling 260, 264, 267, 274–5, 279–81
population sub-groups, differing effects on 278–9
price factors in consumer choice 277
private non-profit organizations and NGOs, involvement of 268–9
products liability law 271
public health impact 275–81
public institution initiatives 266–7
supply chain management 267
tracermark suggestion 281
trademark law and certification marks 259–65
trademarks and exaggerated marketing claims 259–60
trademark’s signalling function 259, 275
Chandler, C 42
Chandon, P 277, 278
Chen, J 264
Chen, L 29
Chile, Food Health Regulation and HFSS warnings 26
China, patent applications related to unhealthy food 313–14
Chon, M 257–82
Christie, A 265
citizens choices see consumers
Cochoy, Franck 5
Codex Guidelines on Nutrition Labelling 27
Collishaw, N 52–3
commercial communication as trademark 94–7, 144, 148–9, 157–8
compensation levels, pharmaceutical investment disputes 247
competence and free movement focus, fundamental rights and trademarks 79–80
competition
distinguishing products from competitors, concerns about 59–60
unfair competition as complex and fluctuating 98–9
compound medicines 127
see also trademarks in the pharmaceutical sector, EU compulsory licences, and expropriation of pharmaceutical patents 240
confidentiality in investment dispute arbitral process 236
confusion likelihood assessment, trademarks in the pharmaceutical sector, EU 119–20, 123, 124, 126–7, 130
Conly, S 36
Connolly, G 29
Conrad, A 299
constitutionalization of IP law consideration 85–6
consumers
choices, and plain packaging and other standardization requirements 17–18, 34–6, 40–41
choices, price factors 277
consumer interest promotion and trademark law 78–9, 89–90, 103–5, 106–8, 110
consumer interest and value, capitalizing on, geographical indications (GIs) 291–2
consumer protection and trademark law, Sri Lanka 206, 210–11
information availability 1–2, 5–6, 288–9, 298–9
consumption control policies 39–42
see also behavioural sciences, plain packaging and other standardization requirements
Cook, W 191
Coombe, R 285, 290
Cooray, A 199
copyright protection 62
Cornides, J 253
Correa, C 46, 195, 318–19
Corré, P-Y 143
 costs
administrative, certification marks for public health 264–5
price factors in consumer choice 277
costs/benefits analysis, patents as tool to encourage production of healthier food 316, 326, 329
coupling principle, EU Nutrition and Health Claims Regulation (NHCR) 141
Coutrelis, N 143, 144
Cram, I 94
Cramer, C 265
credence attributes (verification of hidden qualities of a product) 262, 269–70
Index

see also certification marks for public health
Draudins, O 55–6
Dreyfuss, R 75, 102
Du Plessis, J 200, 201
Dunlop, S 42
Dunn, C 302
Durkin, S 42
Dusollier, S 87
Dutfield, G 324
cross-border standards, certification marks for public health 265, 266, 269
cultural considerations and trademarks 99, 100–102
Cunningham, R 21, 22
Daintith, T 35
Davison, M 3, 47, 48, 49, 51, 52, 53, 55, 56, 57, 61, 63–4, 66, 67, 89, 113, 156, 163–83, 190, 191, 194, 196, 219, 228
Dean, O 56
Dechezleprêtre, A 312
Denmark, fat tax 325–6
depriving owner of economic benefit, pharmaceutical investment disputes 240, 241–3, 244, 245–6
Derclaye, E 309, 312, 318, 322, 323, 325, 330–31
descriptive names 116, 117
see also trademarks in the pharmaceutical sector, EU
differentiation, patents as tool to encourage production of healthier food 319–21, 322–4
Dillbary, J 259
Dinwoodie, G 109
discrimination versus differentiation, patents as tool to encourage production of healthier food 319–21
disputes, investment see investment disputes, pharmaceutical patents and health-related goods
distinctiveness, lack of sufficient 115–18
see also trademarks in the pharmaceutical sector, EU
distinguishing products from competitors, concerns about 59–60
Dogan, S 206, 259
Drahos, P 4, 269
Dratler, J 309
'deat local' movements 302–3
Ebbeling, C 301
economic benefit, depriving owner of, in pharmaceutical investment disputes 240, 241–3, 244, 245–6
economic value of trademark registrations 51, 62
EFTA court, Philip Morris Norway AS/Staten v/Helse-og omsorgsdepartementet 92
Elsmore, M 69–111, 157–8, 206
Emerton, P 47, 51, 56, 57, 61, 63–4, 67, 178
environmentally sustainable production, encouraging, geographical indications (GIs) 299, 300
Eskridge, W 39
Ethiopia, Sidamo coffee licensing 265
EU
Charter of Fundamental Rights 6, 71, 82–3, 84, 91–2, 94–5, 157–8
colour-coded system for food packaging 27
Community Trademark (CTM) 118, 142, 156
Consumer Information Regulation 27
Directorate General for Health and Food Safety (DG SANCO) 70, 79
European Food Safety Authority (EFSA) 145, 153, 155
European Medicine Agency (EMA) 113, 120–21, 122–5
European Patent Convention (EPC) and TRIPS, patents contrary to ordre public or morality 314, 317, 323, 326–7
European Union trademark 69–70

Alberto Alemanno and Enrico Bonadio - 9781784718794
Downloaded from Elgar Online at 07/25/2019 04:33:04AM
to free access
food law and registered trademarks 7
freedom of expression 80–81, 82, 157–8
fundamental rights and trademarks
see fundamental rights and
trademarks, tobacco and health, EU
health warnings on caffeine content in energy drinks 25
Imperial Tobacco and Altadis merger 58
‘non-economic’ based rights 96
nutrition and health claims see nutrition and health claims and EU trademark law
Office of Harmonization in the Internal Market (OHIM) (Trade Marks and Designs) 73, 113, 114, 117, 120
Patent Office costs/benefits analysis criterion 316
Pharmaceuticals Directive 242
‘protected designation of origin’ (PDO) and ‘protected geographical indication’ (PGI) 295–6
smoking prevalence rates 107
Standing Committee on the Food Chain and Animal Health (SCoFCAH) 153
Tobacco Products Directive 17, 19, 32, 44, 46, 60, 67, 202
Tobacco Products Directive, and fundamental rights see fundamental rights and trademarks, tobacco and health, EU
Trademark Directive and Regulation 142–3, 200–201
trademark law, nutrition and health claims see nutrition and health claims and EU trademark law
trademarks and exclusive rights 44–5
trademarks in the pharmaceutical sector see trademarks in the pharmaceutical sector, EU
EU, legal cases
Adidas AG and Adidas Benelux v Marca Mode 107
Alcon v OHIM 115, 125
André Rossius and Marc Collard v Belgium 91
Autronic v Switzerland 95
Budíjovický Budvar v Anheuser-Busch 59
DEB v Germany 95
Deutsches Weintor 85, 91, 93, 146–7
Ehrmann v Zentrale zur Bekämpfung unlauteren Wettbewerbs 147
Ekabe v OHIM 144
Eli Lilly and Company taste trademark application 118
Germany v Parliament and Council 95, 96, 157
GlaxoSmithKline v OHIM 119
Google France 58–9, 205
GP Pharm 120
Green–Swan Pharmaceuticals 144, 148–9
Gut Springenheide and Tusky 79
Herbert Karner v Troostwijk 95, 157
Hollywood v Souza Cruz 98
Imperial Tobacco 157
Kureha Corp v OHIM 115
Laboratórios Wellcome de Portugal 119
Lloyd Schuhfabrik Meyer v Klijsen Handel 79, 98
L’Oreal v Bellure 59
McNeil v OHIM 119
Martin Y Paz Diffusion SA v David Depuydt 44–5
Mundipharma v OHIM 115, 119
Onco Mouse Harvard 316
Philip Morris Brands v Secretary of State for Health 72, 82, 90, 106, 110
Pillbox 17, 67, 98
Poland v European Parliament 17, 67, 98
Promusicae 85
The Queen v Secretary of State for Health, ex p British American Tobacco 60, 67
Index

Tobacco Products II 17, 67
Transgenic Animals/HARVARD 315, 316, 326
Upjohn 316
Wellcome Foundation v OHIM 119
Wyeth Holdings 117
Zambrano 96
European Convention on Human Rights 83, 84, 92, 94–5, 96, 97, 157, 158
European Court of Human Rights 6, 82–3, 84
Anheuser-Busch v Portugal 88, 158
Barthold v Germany 95
Casado Coca v Spain 95, 157
Demuth v Switzerland 95
and freedom of expression 157
Hertel v Switzerland 95
Jacubowski v Germany 95
Markt Intern Verlag and Klaus Beermann v Germany 95, 157
Stambuk v Germany 95
Evans, S 55
exaggerated marketing claims, and trademarks 259–60
expropriation claims, investment disputes see investment disputes, pharmaceutical patents and health-related goods, expropriation claims
expropriation clauses, tobacco packaging measures under international investment law 224–9

fat
HFSS (high in fat, salt and sugar), food packaging standardization requirements 24–6, 29, 30
substitute patents 307–8
fee exemption suggestion, patents and production of healthier food 313, 329
Feinberg, J 105
Fennelly, General 96, 101, 106
Ferejohn, J 39
Ferris Wayne, G 29
Fhima, I 86, 88
Fiser, J 280
Flitner, M 324
food certification marks for public health see certification marks for public health
food-related patents, and production of healthier food 307–8
geographical indications (GIs) see geographical indications (GIs) and public health
operators’ trademarks, use of, EU Nutrition and Health Claims Regulation (NHCR) 143–4
packaging, alcohol and HFSS (high in fat, salt and sugar) 24–6, 29, 30
see also health; nutrition headings
Ford, A 210
foreign direct investment (FDI) and investment treaties 235
Fouassier, J 291
France appellations of origin 286–7, 293–5
tobacco packaging 1, 23
Frankel, S 45, 47, 56, 89, 174, 176
Fraser, B 95
free movement focus, fundamental rights and trademarks, tobacco and health, EU 79–80
free speech rights 102–3, 205–6
free trade agreements 252, 321
see also bilateral trade agreements
free-riders, protection from, geographical indications 291–2
freedom of choice 35–6
freedom of expression 80–81, 82, 86–8, 94–5, 103–5, 106, 110, 157–8
Freeman, B 20
Freuman, T 302
Friedland, M 280
Fromer, J 275
Fujiye, M 257–82
fundamental rights
compliance, EU Nutrition and Health Claims Regulation (NHCR) 156–8
and freedom of choice 35–6
Sri Lanka, public health objectives through product labelling regulation 206–9
fundamental rights and trademarks, tobacco and health, EU 69–111
brand image and package design as expressive activities 95–6
brokerage of fundamental rights 71–90
Charter of Fundamental Rights (Article 11) and freedom of expression 71, 82–3, 84, 91, 94–5
Charter of Fundamental Rights (Article 35) and right to health 91–2
compelled speech as corollary of the right to free speech 102–3
competence and free movement focus 79–80
constitutionalization of IP law consideration 85–6
consumer interest promotion and trademark law 78–9, 89–90, 103–5, 106–8, 110
cultural considerations and brand loyalty 99, 100–101
cultural currency and ‘self-expression’ effect of trademarks 101–2
freedom of expression and information 80–81, 82, 86–8, 94–5, 103–5, 106, 110
interference issues 73–5
IP versus health debate 85–6
market functionality of trademarks and hostage scenario 78–9
misleading trademarks 77
nudging lifestyle choices, effectiveness of 72, 108
packaging and labelling, and advertising, distinction between 97–8
packaging, removal of current mandatory indications of tar, nicotine and carbon monoxide levels 104
plain packaging legislation (PPL) 74
policy discretion 92, 106
protection preliminaries 90–105
right to health measurement 91–4
sector-specificity in trademark law, lack of 77–8
space appropriation and decreases in trademark manoeuvrability 74–5
standardized packaging measures (SPM) 70–71, 73–4, 75, 78, 88–9, 90, 93, 99, 103, 104, 105–6, 107
text warnings 70–71
tobacco substitutes, lack of 75
tobacco trademarks 99–101
trademark expressionism 94–105
trademark expressionism assessment 97–8
trademark law concerns on health issues 76–9
trademarks as property 88–90
trademarks as protectable form of commercial expression 94–7
unfair competition as complex and fluctuating 98–9
very large pictorial warnings (VLPW) 70–71, 74, 75, 99, 103, 105–6, 107, 108

Gangjee, D 264, 285, 286, 287, 291, 294, 301
Garde, A 83, 84, 85, 92, 93
Geiger, C 85–6, 253
generic packaging see plain packaging

The new intellectual property of health
Index

generic products

generic descriptors and trademarks, EU Nutrition and Health Claims Regulation (NHCR) 153–4

generic drugs and patent protection 58

generic prescriptions, customer confusion between trade and generic brands 126–7, 131, 132, 136

generic prescriptions, UK 112

investment disputes, pharmaceutical patents 242, 243–4, 246–7, 249, 251

pay-for-delay agreements (patent dispute settlements) 8

geographical indications

certification marks for public health 261

and TRIPS 165, 182–3

geographical indications (GIs) and public health 283–304

asymmetrical information between producers and consumers, reduction of 288–9

consumer information availability 298–9

definition of GI, changing 292–6

‘eat local’ movements 302–3

environmentally sustainable production, encouraging 299, 300

EU, ‘protected designation of origin’ (PDO) and ‘protected geographical indication’ (PGI) 295–6

free-riders, protection from 291–2

French appellations of origin 286–7, 293–5

GI protection issues 285–6

healthy product promotion 297–304

‘higher quality’ products 284, 285

legal definition of GIs 285–6

Lisbon Agreement definition of appellations of origin 293–5

local and rural development promotion 289–91, 300–301

‘locavore’ movements 302–3

marketing and market access tools, GIs as 285, 292–7

niche and high(er)-quality products 301

partially delocalized production model 296–7

production factors 271, 288–9, 292–7, 299, 303–4

production factors rather than terroir, increased focus on 292–7, 303–4

protection levels for GIs 291–2

quality control 299, 300–301

reputation factors 290, 291–2, 293, 294, 295

‘slow food’ movement 302–3

terroir as geographical origin and product quality 286–92

and TRIPS Agreement 287, 293, 294, 297

and TRIPS Agreement, and ‘essentially attributable to its geographical origin’ 294, 295, 296, 303–4

unhealthy products 297

value and consumer interest, capitalizing on 291–2

Germany

‘Anti-Aging Bier’ trademark 148

Hipp v Milupa 145–6, 149–50

pharmaceutical trademarks 117

Gervais, D 45, 47, 51, 56, 62, 65, 89, 171, 174, 176, 178, 181, 195, 253, 300

Gibbons, L 96, 102

Gibson, J 79

Gigerenzer, G 37

Giovannucci, D 285, 290, 299

Giraud, G 288

Glanz, K 28

Global Partnership for Safe and Sustainable Agriculture (Global-GAP) 269
global public–private partnership (PPP), certification marks for public health 257–8
global value networks (GVNs) 257–8, 265–70

Goebel, B 87
The new intellectual property of health

Gorny, D 156, 158
grandfather clause, transitional rules for existing trademarks and brand names, EU Nutrition and Health Claims Regulation (NHCR) 147–50
green patenting 310–11, 312, 320
Greenawalt, K 104
Griffiths, J 7, 86
Griswold, A 268
Grosse Ruse-Khan, H 85, 251, 331
Grynberg, M 79
Haber, B 140, 149
Haeri, H 229, 230
Hagen, A 142
Handler, M 206
Hanson, J 25, 271
harmful products’ promotion, trademark registration and rights 56–63, 66–7
Harnack, L 278
Hass, J 280
Hastings, G 16, 28, 227
Hawthorne, K 279
health
certification marks see certification marks for public health
claims, and nutrition see nutrition and health claims and EU trademark law
and geographical indications (GIs) see geographical indications (GIs) and public health
health-related goods, and investment disputes see investment disputes, pharmaceutical patents and health-related goods
healthier food production see patents as tool to encourage production of healthier food
and pharmaceuticals see pharmaceuticals and tobacco see tobacco headings see also food, nutrition
Heavner, B 258, 265
Helfer, L 87–8
Hertz, A 239
Hetu, J 260, 280
HFSS (high in fat, salt and sugar) and alcohol, food packaging standardization requirements 24–6, 29, 30
Higgins, A 227
Hilf, A 35
Hoffmann, A 226, 227
Hohfeld, W 63, 64, 190–91, 192, 193, 194, 197
Holland, S 28
Hong Kong–Australia BIT, tobacco packaging measures 220–22, 223, 224–6, 228–30
Hood, C 30
hostage scenario, and market functionality of trademarks 78–9
Howells, D 105
Hudec, R 156
Hughes, J 262, 285
human rights, European Convention on Human Rights 83, 84, 92, 94–5, 96, 97, 157, 158
Hübbebräuer, A 148, 149
ICSID Arbitral Tribunal Awards
AES Summit Generation v Hungary 227, 230, 231
Alex Genin, Eastern Credit Ltd and AS Baltoil v Estonia 229, 231
Alpha Projektholding v Ukraine 225, 227
Azurix Corporation v Argentina 225, 226–7
Biwater Gauff (Tanzania) v Tanzania 225
Cargill v Mexico 229
CME Czech Republic v Czech Republic 225, 227
Compañía del Desarrollo de Santa Elena v Costa Rica 225, 227
Duke Energy v Ecuador 230
EDF (Services) v Romania 230, 231
Enron v Argentina 230
Eureko v Poland 228
Fireman’s Fund Insurance Company v Mexico 225, 226, 229
Index

FTR Holdings SA (Switzerland), Philip Morris Products SA (Switzerland) and Abal Hermanos SA (Uruguay) v Oriental Republic of Uruguay 214–15, 216–18, 221–3, 227, 228, 231

GEA Group v Ukraine 230

Glamis Gold v USA 229, 230

Grand River Enterprises Six Nations v USA 231

Impregilo v Argentine Republic 225, 230, 231

International Thunderbird Gaming Corporation v Mexico 229

LG&E v Argentina 225, 226, 229

Loewen Group v United States 249

Marvin Feldman v Mexico 229

Metalclad Corp v Mexico 227

Parkerings-Compagniet v Lithuania 225

Pope & Talbot v Canada 225, 228

PSEG Global v Republic of Turkey 230

Saipem v the People’s Republic of Bangladesh 249

SD Myers v Canada 225, 229

Sempra Energy v Argentina 227

Siemens AG v Argentina 231

Suez v Argentina 227

Técnicas Medioambientales Tecmed v Mexico 225, 226, 227, 230

Telenor Mobile Communications AS v the Republic of Hungary 226, 229

Tokios Tokeles v Ukraine 225

Total v Argentina 230, 231

Waste Management v Mexico 228, 229

Ikerd, J 303

Incardona, R 105

incentives and consumption control, plain packaging and other standardization requirements 40, 41

India, plain packaging for tobacco products 89

information availability, and geographical indications (GIs) 288–9, 298–9

freedom of expression and information, trademarks, tobacco and health, EU 80–81, 82, 86–8, 94–5, 103–5, 106, 110

intellectual property IP Act and right to use trademark, Sri Lanka see Sri Lanka, public health objectives through product labelling regulation, IP Act and right to use trademark and non-IP legislations 7–8

regime conflicts, and standardization requirements 16–17, 41, 42

regulatory requirements and IP rights 4–7

rights, nutrition and health claims and EU trademark law 140–41, 148, 156–8

versus health debate, fundamental rights and trademarks, tobacco and health, EU 85–6

see also patents; trademarks

interference with investor’s property, degree of, tobacco packaging measures 227–8

interference issues, fundamental rights and trademarks, tobacco and health, EU 73–5

International Center for Alcohol Policies 25

International Code of Marketing of Breastmilk Substitutes 32, 44

international investment see investment

International Non-proprietary Name (INN) 115–17, 120, 121, 123–4, 130

see also trademarks in the pharmaceutical sector, EU investment

bilateral investment and free-trade agreements 220–22, 223, 224–6, 228–30, 321

international investment law and tobacco packaging measures see tobacco packaging measures
The new intellectual property of health

affecting IP protection under international investment law
investment disputes, pharmaceutical patents and health-related goods
233–54

*Apotex v USA* 244–7, 249–50, 251
arbitral process in investment arbitration 236
arbitrator role 252–4
confidentiality in arbitral process 236

*Eli Lilly v the Government of Canada* 243–4, 248, 250
fair and equitable treatment violation claims 247–50
foreign direct investment (FDI) and investment treaties 235
Free Trade agreements (FTAs) and TRIPS Agreement 252
generic products 242, 243–4, 246–7, 249, 251
international investment law and pharmaceutical patents 234–6
investment, notion of 237–9
investor-state arbitrations concerning pharmaceutical patents 237–51

*Lilly v Cuba* 237–8
NAFTA violations 245, 246–7, 248, 249–50
prudential jurisdictional doctrine or reasonable apprehension doctrine, reliance on 245

*Servier v Poland* 238–9, 240–42, 247

*Signa v Canada* 247–8
TRIPS Agreement obligations 244, 251–2, 253

see also health: pharmaceuticals investment disputes, pharmaceutical patents and health-related goods, expropriation claims 239–47
compensation levels 247
compulsory licences 240
depriving owner of economic benefit 240, 241–3, 244, 245–6
direct or indirect 239–46, 249

non-discrimination element 242, 243, 250–51
parallel imports 240
proportionality issues 242–3
usefulness criteria 244

Ireland, Public Health (Standardised Packaging of Tobacco) Act 1, 22, 23

Italy

Competition Authority (ICA) and food labelling and advertising 151–2
Food Supplements Association (AIIPA) and ‘probiotic’ term use 153

*Salini Costruttori and Italtrade v Kingdom of Morocco* 222

Jacoby, J 105
Japan, Patent Office accelerated examination programme 311
Jones, T 80
jurisdiction, prudential jurisdictional doctrine or reasonable apprehension doctrine, reliance on in investment disputes 245
jurisdictional objections, tobacco packaging measures affecting IP protection under international investment law 221–4
justifiable positive encumbrance on use of trademarks 66–8

Justus, M 258, 265

Kahneman, D 17
Kappos, D 332
Karunaratna, D 198
Katz, A 259
Kelsey, J 81
Kenkel, D 29
Kirby, K 40
Knitter, M 117

Kojo, D 284
Kossdorf, K 141
Kramer, A 260, 280
Kratzke, W 88
Kruse, C 280
Krystallis, A 101

Ireland, Public Health (Standardised Packaging of Tobacco) Act 1, 22, 23

See also health: pharmaceuticals investment disputes, pharmaceutical patents and health-related goods, expropriation claims 239–47
compensation levels 247
compulsory licences 240
depriving owner of economic benefit 240, 241–3, 244, 245–6
direct or indirect 239–46, 249

non-discrimination element 242, 243, 250–51
parallel imports 240
proportionality issues 242–3
usefulness criteria 244
Krzeminska-Vamvaka, J 94, 95, 97
Kühling, J 83, 84, 92
Kur, A 45, 89, 296–7
Kysar, D 25, 271
labelling
label ‘fatigue’ concerns 277–8
packaging and labelling, and advertising, distinction between 97–8
packaging and labelling factors, trademarks in the pharmaceutical sector, EU 123
plain packaging see plain packaging regulation, Sri Lanka see Sri Lanka, public health objectives through product labelling regulation see also advertising; brands; packaging; trademarks
Lamy, P 306
Landenburger, C 84, 91–2, 93
Landes, W 259
Lane, E 262, 312, 313
Laurenza, E 7, 138–59
Laustsen, R 78, 79
Lefebvre, R 28
legal cases see EFTA court; EU, legal cases; ICSID Arbitral Tribunal Awards; individual countries; London Court of International Arbitration; Permanent Court of Arbitration; World Health Organization; World Trade Organization (WTO) Dispute Settlement
legal definition of geographical indications (GIs) 285–6
legal and historical context, Sri Lanka, public health objectives through product labelling regulation 197–200
legitimate interests of trademark owners 56–63, 66–7, 177–8, 179
Lemley, M 88, 206, 259
Leskien, D 324
Licenses, compulsory, and expropriation of pharmaceutical patents 240
Linder, N 279
Lisbon Agreement definition of appellations of origin 293–5
Lobstein, T 38
local and rural development promotion, geographical indications (GIs) 289–91, 300–301
‘locavore’ movements 302–3
London Court of International Arbitration, *EnCana Corporation v Republic of Ecuador* 228
Lowenstein, G 25
Lunsford, J 45
McCarthy, J 59
McCarthy, M 300
McCarty, L 193
McCombe, Justice 92, 94, 105
McGeveran, W 88
McGrady, B 24, 29, 49, 52, 53, 65, 214
McLachlan, C 226
mandatory disclosure 34, 40–41, 258, 269–70, 272
Marie-Vivienne, D 289
marijuana tracking through supply chain 267
market functionality of trademarks and hostage scenario 78–9
market manipulation concerns, certification marks for public health 259–60, 271–2, 275, 279–81
marketing and market access tools, geographical indications as 285, 292–7
Marsoof, A 48, 49, 61, 64, 89, 103, 113, 135, 169, 184–212, 228–9
Marteau, T 28, 39
Mattli, W 257
Medication errors review, Australia 126–7
medicine information panel for non-prescriptive medicines, Australia 130, 132
Meidinger, E 268
Meisterernst, A 140, 149, 157
Melchor, S 155
Menapace, L 288, 289, 291, 301
The new intellectual property of health

Mill, J 105
Mills, O 315
misleading trademarks 77, 123
Mitchell, A 3, 16, 44, 51, 173, 213–32
Montt, S 230
Mooney, A 301
morality, trademarks contrary to
morality or public order 53–4
Morcom, C 50
Moschini, G 288, 291, 301
Munro, C 94
Munzer, S 288, 291
Mylly, T 85

NAFTA violations, investment disputes,
pharmaceutical patents and
health-related goods 245, 246–7,
248, 249–50
national treatment claims 168, 250–51
‘natural’ labels on food products 260
negative rights, to prevent exploitation
of brand 44–6, 50
Nestle, M 276
Netherlands
Bogstra v Co-operative Condensed
Fabrik 198–9
Croos v De Soysa 199
freedom of expression 83
Kapadiya v Mohamad 198
trademarks and Roman Dutch Law
[RDL] 198–200
neutrality principle paradox, patents as
tool to encourage production of
healthier food 325–6
Newcombe, A 226
NGO involvement, certification marks
for public health 268–9
niche and high(er)-quality products, and
geographical indications 301
non-communicable diseases increase,
patents as tool to encourage
production of healthier food
305–6, 307–8
non-compliance with food law regime
effects, EU Nutrition and Health
Claims Regulation (NHCR) 143
non-discrimination element, investment
disputes, pharmaceutical patents
and health-related goods 242, 243,
250–51
non-prescriptive medicines, medicine
information panel, Australia 130,
132
non-traditional pharmaceutical
trademarks 118
non-word trademarks 163–5
Northern, G 280
Norway, freedom of expression 83
notice-based forms of regulation
(mandatory disclosure) 258,
269–70, 272
nudge concept
behavioural sciences 30–32, 35–6,
37–9, 40, 41–2
certification marks for public health
271–4
lifestyle choices, effectiveness of 72,
108
nutrition
bilateral investment and free-trade
agreements and protection of
public health and nutrition 321
nutrient profiles 139–40, 328–9
see also food; health
nutrition and health claims and EU
trademark law 138–59
Charter of Fundamental Rights of the
EU (CFREU) and freedom of
expression 157–8
commercial communication as
trademark 144, 148–9, 157–8
European Food Safety Authority
(EFSA) 145, 153, 155
freedom of expression and European
Convention for the Protection of
Human Rights and Fundamental
Freedoms (ECHR) 157–8
IP rights 140–41, 148, 158
nutrient profiles 139–40
‘OMEGA 3’ figurative trademark 144
Slim Fast trademark 152–3
trademark inclusion issues 140
nutrition and health claims and EU
trademark law, Nutrition and
Health Claims Regulation
(NHCR) 138–58
brand-specific nutrition and health claims 154–5
coupling principle 141
Flexibility Guidance 154–5
food operators’ trademarks, use of 143–4
generic descriptors and trademarks 153–4
health claims concept 146–7
international IP provisions and fundamental rights, compliance with 156–8
and national advertising supervision bodies 150–52
non-compliance with food law regime effects 143
‘probiotic’, use of term 145–6, 153–4
trademarks at risk 152–3
trademarks as health claims 144–6
and traditional trademark law 142–6
transitional rules for existing trademarks and brand names (‘grandfather’ clause) 147–50

obesity increase, patents as tool to encourage production of healthier food 305–6, 307–8
Obolovich, V 74, 79
O’Connor, B 285
Oliver, P 95
Ollberding, N 278
Olynk, N 269
‘OMEGA 3’ figurative trademark 144
‘organic’ labelling 260, 264, 267, 274–5, 279–81
Osseweijer, P 274
Oude Ophuis, P 301

packaging and advertising, distinction between 97–8
plain see plain packaging
removal of current mandatory indications of tar, nicotine and carbon monoxide levels 104
trademarks in the pharmaceutical sector, EU 123
see also labelling
parallel imports, investment disputes, pharmaceutical patents and health-related goods 240
Paris Convention and patents 326–7
plain packaging of tobacco products, Australia 168, 169, 170–71, 177–8, 180–81, 182
trademark law protection 77
trademark registration and rights 47–9, 51, 52–5, 56–7, 65
see also World Trade Organization (WTO) TRIPS Agreement
partially delocalized production model, geographical indications (GIs) and public health 296–7
Paster, B 206
patents
pharmaceutical patents and investment disputes see investment disputes, pharmaceutical patents and health-related goods
see also intellectual property; trademarks
patents as tool to encourage production of healthier food 305–32
bilateral investment and free-trade agreements and protection of public health and nutrition 321
costs/benefits analysis criterion 316, 326, 329
differentiation and refusal of neutrality principle 322–4
discrimination versus differentiation 319–21
European Patent Convention (EPC) and TRIPS, patents contrary to ordre public or morality 314, 317, 323, 326–7
expert involvement 328
fast-track procedures for patent applications 310–13, 317, 319, 331–2
fee exemption suggestion 313, 329
food-related patents 307–8
green patenting 310–11, 312, 320
international patent No WO 2013162802 A1, fat particle compositions 308
neutrality principle paradox 325–6
nutrient profiling model 328–9
obesity and non-communicable diseases, increase in 305–6, 307–8
Patent Cooperation Treaty (PCT) and fast-track procedures 312–13
patent regime amendments to incentivize production of healthy foodstuffs 309–18
protection term extension 317–18
socially useful technologies, use of 310, 312, 319–20
and TRIPS Agreement 314, 317, 318, 319, 321, 328
TRIPS anti-discrimination rule 318
TRIPS and plant variety rights protection 324
unhealthy food, proposal for exclusion from patentability 313–17, 325–7
US Patent No 5260087, fat and egg yolk substitute 307
US patent No 6485775, fat substitute 308
US patent No 8647696, low fat food containing gas bubbles 307–8
Patton, A 311
pay-for-delay agreements (patent dispute settlements), generic products 8
Peritz, Rudolph 8
Permanent Court of Arbitration
Chorzów Factory Case (Germany v Poland) 240
German Interests in Polish Upper Silesia 239–40
Philip Morris Asia Ltd (Hong Kong) v Australia 213, 217, 218, 223–5, 228, 230–31
Saluka Investments v Czech Republic 226, 230
Peru, Act to Promote Healthy Eating among Children and Adolescents 26–7
Pettman, S 140
pharmaceuticals
behavioural sciences, plain packaging and other standardization requirements 27–8
investment disputes see investment disputes, pharmaceutical patents and health-related goods trademarks see trademarks in the pharmaceutical sector, EU
see also health
Phillips, J 76, 77, 78, 85, 300
pictorial health warnings on tobacco packs, introduction of, Sri Lanka 185–202, 207–8
Pildes, R 34, 41
Pires de Carvalho, N 65, 66
plain packaging and behavioural sciences see behavioural sciences, plain packaging and other standardization requirements challenges, Sri Lanka 205–11 generic packaging history 21–2 and international investment law 215–16, 217, 218 legislation, fundamental rights and trademarks, tobacco and health, EU 74 tobacco products, trademark registration and rights 60–61 see also packaging plain packaging of tobacco products, Australia, and WTO TRIPS challenge 163–83 approaches to interpretation 166–7, 169–70, 181, 182 Australian measures and non-word trademarks 163–5 claims concerning trademarks and geographical indications 165 geographical indications (Articles 22.2 and 24) 182–3 government restrictions on the use of trademarks (Article 19) 179–80 individual claims 167–74
intellectual property conventions (Article 2.1) 168
national treatment claim (Article 3) 168
Paris Convention 168, 169, 170–71, 177–8, 180–81, 182
protectable subject matter and definition of trademark (Article 15.1) 168–9
protectable subject matter and registration of trademark (Article 15.1) 169
rights conferred and prevention of particular uses of registered trademark that is well known (Article 16.3) 170–71
rights conferred and trademark protection (Article 16.1) 169–70, 177, 178
unjustifiably encumbered by special requirements (Article 20) 171–82
unjustifiably encumbered by special requirements (Article 20), duelling contexts 176–82
unjustifiably encumbered by special requirements (Article 20), and legitimate interests of trademark owners (and Article 17) 177–8, 179
unjustifiably encumbered by special requirements (Article 20), meaning of 174–6
unjustifiably encumbered by special requirements (Article 20), relationship between trademark owners and governments acting as regulators 178–9
unjustifiably encumbered by special requirements (Article 20), right to regulate for public health and 'spirit of use' international trademark law argument 180–81
plant varieties protection and TRIPS 324
Plomer, A 315
political acceptability, plain packaging and other standardization requirements 34–5
Pollay, R 101
Poncibo, C 105
population sub-groups, differing effects of certification marks on 278–9
positive rights, trademark registration 47–63
Posner, R 78, 259
Pottage, A 17
Powys Whyte, K 38
prescription products, and trademarks 115
Preston Smith, J 260
price factors in consumer choice 277
prior exclusive rights of a third party, trademark registration 54
private non-profit organizations involvement, certification marks for public health 268–9
privilege of using trademark 63–4
‘probiotic’, use of term, EU Nutrition and Health Claims Regulation (NHCR) 145–6, 153–4
product labelling see labelling
production factors, geographical indications (GIs) and public health 271, 288–9, 292–7, 299, 303–4
property, trademarks as 88–90
proportionality issues
investment disputes, pharmaceutical patents and health-related goods 242–3
public interest and tobacco packaging measures 226–7
protectable subject matter and definition of trademark 168–9
protection levels for geographical indications 291–2
protection term extension, patents as tool to encourage production of healthier food 317–18
prudential jurisdictional doctrine or reasonable apprehension doctrine, reliance on, investment disputes, pharmaceutical patents and health-related goods 245
public health see health
public institution initiatives,
certification marks for public
everal health 266–7
public interest
legislative measures for restricting
trademark use 48–9
population sub-groups, differing
effects of certification marks on
278–9
proportionality measures, tobacco
packaging measures under
international investment law
226–7
socially useful technologies, use of
310, 312, 319–20
public order, trademarks contrary to
morality or public order 53–4
public–private partnership (PPP),
certification marks for public
health 257–8
quality
control, geographical indications
299, 300–301
credence attributes, certification
marks for public health 262,
269–70
‘higher quality’ products,
geographical indications 284,
285
terroir as geographical origin and
product quality 286–92
Rebonato, R 18
refusal of neutrality principle, patents as
tool to encourage production of
healthier food 322–4
registration
and brand protection 112–13, 114–15
tablet or capsule shapes and flavours
118
trademarks see trademark registration
and rights
‘regulatory chill’ effect 41
regulatory clearance of pharmaceutical
names 120–21
regulatory requirements and IP rights
4–7
Reinsch, A 226, 227
removable trademarks after purchase,
Sri Lanka 209–11
renewal of trademarks containing
banned descriptors 51–2, 60
reputation factors, geographical
indications 290, 291–2, 293, 294,
295
revocation argument, trademark
registration and rights 55–6
Ricketson, Sam 3
Ricolfi, M 285, 321–2
right to health measurement,
fundamental rights and
trademarks, tobacco and health,
EU 91–4
rights
conferred and prevention of
particular uses of registered
trademark that is well known
170–71
EU Charter of Fundamental Rights 6,
71, 82–3, 84, 91–2, 94–5, 157–8
free speech rights 102–3, 205–6
freedom of choice 35–6
fundamental see fundamental rights
freedom of expression 80–81, 82,
86–8, 94–5, 103–5, 106, 110,
157–8
fundamental see fundamental rights
Ritzert, M 289, 291
Roberto, C 266, 276, 278
Rühr, A 301
Roman Dutch Law (RDL), Sri Lanka, public health objectives through product labelling regulation 198–200

Rotstein, F 265
Rubino, A 284

Sakulin, W 88
Salacuse, J 226
Salas, B 153
Salguero, M 303
Salini test, tobacco packaging measures and international investment law 222

Samaraweera, K 203
Scassa, T 87
Schechter, F 88, 206
Schifferstein, H 301
Schneider, C 40, 41, 271, 275
Schovsbo, J 88
Schreuer, C 230
Schuldt, J 279
Schwarz, N 279
Scott, C 269
Sebrié, E 219

sector-specificity in trademark law, lack of 77–8
self-expression, and cultural currency effect of trademarks 101–2
Selinger, E 37–8
Senftleben, M 86
Shanahan, D 206
Sherman, B 318, 322, 325, 329, 331
Shiffman, S 100
Shiner, R 94
Sibony, A-L 35, 38
signalling, trademark’s signalling function 259, 275
Sinclair, I 253
Skoblikov, L 155
Sleenhoff, S 274
Slim Fast trademark 152–3
’slow food’ movement 302–3
Smith, H 192
Snowdon, C 87
socially useful technologies, use of 310, 312, 319–20

see also public interest

Sommer, T 315
Sornarajah, M 236
South Africa
Foodstuffs, Cosmetics and Disinfectants Act 32
IP rights 199–200
space appropriation and decreases in trademark manoeuvrability 74–5
Spence, M 88, 95–6, 102
Spina, A 18, 104
’spirit of use’, international trademark law 180–81
Sri Lanka, legal cases
Ceylon Bank Employees Union v Commissioner of Labour 203
Ceylon Tobacco Company v Hon. Maithripala Sirisena, Minister of Health 103, 186–7, 188, 200, 202, 204, 208
Joseph Perera v the Attorney General 207
Karunathilaka v Dayananda Dissanayake 206
Leelananda v Ernest de Silva 188
Sunila Abeysekera v Ariya Rubasinghe 207, 209
Sri Lanka, public health objectives through product labelling regulation 184–212
advertising and the use of trademarks on products, distinction between 188–9
Agrarian Development Ordinance 201
Ceylon Tobacco Company (CTC) challenge to legality of Tobacco Regulations 186–7, 188 and free speech rights 205–6 and fundamental rights 206–9
National Authority on Tobacco and Alcohol (NATA) Act 184–5, 186–7, 188–9, 202
National Authority on Tobacco and Alcohol (NATA) Act, 2015 Amendment 203–5
National Authority on Tobacco and Alcohol (NATA) Act, 2015
Amendment, Supreme Court determination 204–5, 207–8
pictorial health warnings on tobacco packs, dimensions of 187–8, 203–4
pictorial health warnings on tobacco packs, introduction of 185–202, 207–8
plain packaging challenges 205–11
plain packaging challenges, and trade restrictions 206–7
removable trademarks after purchase 209–11
Tobacco Products (Labelling and Packaging) Regulations 185–7, 202
Trade Marks Act 198
trademark law and consumer protection 206, 210–11
Urban Development Authority 201–2
and WHO Framework Convention on Tobacco Control (FCTC) 187
Sri Lanka, public health objectives through product labelling regulation, IP Act and right to use trademark
Australian Tobacco Plain Packaging Act comparison 189–95
exclusive rights 195–6
interpretation of 188, 189–201, 205
legal and historical context 197–200
and Roman Dutch Law (RDL) 198–200
trademark rights as absolute 201–2
TRIPS Agreement and trademark rights (Article 16) and right to exclude unauthorized third-party use 195–7, 198
standardization requirements, and behavioural sciences see
behavioural sciences, plain packaging and other standardization requirements standardized packaging measures (SPM), fundamental rights and trademarks, tobacco and health, EU 70–71, 73–4, 75, 78, 88–9, 90, 93, 99, 103, 104, 105–6, 107
Starling, S 152
Staver, A 267
Sterckx, S 315
Stern, B 240
Stern, S 55–6
Stone, A 80–81
Stout, M 318
Strom, S 273
Studdert, L 130
substantive claims, tobacco packaging measures and international investment law 224–31
Sunstein, C 17, 30, 38, 39, 108, 270, 271, 272, 273
supply chain management 267
sustainability, environmentally sustainable production, encouraging 299, 300
Switzerland–Uruguay BIT, tobacco packaging measures 220–22, 223, 224–6, 228–30
Tallent, K 230
technologies, socially useful technologies, use of 310, 312, 319–20
terroir see under geographical indications
Thailand, alcohol products 24–5
Thaler, R 17, 30, 38, 108, 270, 271, 272, 273
Thambisetty, S 315, 326, 330
Thorndike, A 277
tobacco
behavioural sciences, plain packaging and other standardization requirements 29, 32–3, 35, 40
and health see fundamental rights and trademarks, tobacco and health, EU
plain packaging, Australia see plain packaging of tobacco products, Australia, and WTO challenge
plain packaging and tobacco control strategies 20–21
plain packaging, trademark registration and rights 60–61
Index

substitutes, lack of 75

tobacco packaging measures affecting IP protection under international investment law 213–32

Australia, plain packaging measures 215–16, 217, 218

expropriation clauses 224–9

fair and equitable treatment (FET) 226, 229–31

interference with the investor’s property, degree of 227–8

investments under Switzerland–Uruguay and Hong Kong–Australia BITs 220–22, 223, 224–6, 228–30

jurisdictional objections 221–4

Permanent Court of Arbitration, Philip Morris Asia Ltd (Hong Kong) v Australia 213, 217, 218, 223–5, 228, 230–31

public interest proportionality measures 226–7

Ratione Temporis Argument 223

Salini test 222

substantive claims 224–31

TRIPS Agreement trademark rights (Article 16.1) 228

Uruguay tobacco packaging and labelling 214–15, 216–18

Torremans, P 86, 87, 315

tracermark suggestion, certification marks for public health 281

distinctive function, plain packaging and other standardization requirements 15–16

dominance of tobacco advertising 59–60

distinction of products from competitors, concerns about 59–60

deregulatory measures for restricting use in public interest 48–9

tobacco packaging and advertising 58–61, 62, 63, 188–9

commercial communication as 94–7, 144, 148–9, 157–8

contrary to morality or public order 53–4

and exaggerated marketing claims 259–60

and fundamental rights see fundamental rights and trademarks, tobacco and health, EU

international trademark law 47–8, 180–81

law and certification marks 259–65

legitimate interests, plain packaging of tobacco products, Australia, and WTO TRIPS challenge 177–8, 179

legitimate interests of trademark owners 56–63, 66–7, 177–8, 179

misleading trademarks 77, 123


rights, Sri Lanka see Sri Lanka, public health objectives through product labelling regulation, IP Act and right to use trademark signalling function, certification marks for public health 259, 275

see also advertising; brands; intellectual property; labelling; patents

trademark registration and rights 43–68

advertising function of trademarks 58–61, 62, 63

alleged purposive interpretation of international trademark law provisions 47–8

distinguishing products from competitors, concerns about 59–60

domestic trademark laws, interpretation of 49–50

economic value of registrations 51, 62

generic drugs and patent protection 58

harmfulness of product and IP analysis 62–3

justifiable positive encumbrance on use of trademarks 66–8

legislative measures for restricting use in public interest 48–9
legitimate interests of trademark owners and promotion of harmful products 56–63, 66–7
negative rights, to prevent exploitation of brand 44–6, 50
plain packaging of tobacco products 60–61
positive rights 47–63
privilege of using trademark 63–4
registration of a sign which violates prior exclusive rights of a third party 54
registration versus use 50–55, 57–8, 62
renewal of trademarks containing banned descriptors 51–2, 60
revocation argument 55–6
trademarks contrary to morality or public order 53–4
TRIPS Agreement, Article 20 64–8
TRIPS Agreement and Paris Convention, alleged spirit of 47–9, 51, 52–5, 56–7, 65
unjustifiable positive encumbrance on use of trademarks 65–6
word trademarks 60–61, 67–8
trademarks in the pharmaceutical sector, EU 112–37
active pharmaceutical ingredients (APIs) 115, 126–32
compound medicines 127
confusion likelihood assessment 119–20, 123, 124, 126–7, 130
consumer knowledge and awareness 115, 117, 118, 119–20, 126–7, 131–2, 133
descriptive names 116, 117
distinctiveness, lack of sufficient 115–18
European Medicine Agency (EMA) 113, 120–21
European Medicine Agency (EMA) approval process (Name Review Group (NRG)) 122–5
generic prescriptions, customer confusion between trade and generic brands 126–7, 131, 132, 136
International Non-proprietary Name (INN) 115–17, 120, 121, 123–4, 130
misleading pharmaceutical qualities 123
non-traditional pharmaceutical trademarks 118
Office of Harmonization in the Internal Market (OHIM) (Trade Marks and Designs) 113, 114, 117, 120
packaging and labelling factors 123
pharmacologically-related substances and common stem 116
prescription products 115
regime differences 124–5
registration and brand protection 112–13, 114–15
regulatory clearance of pharmaceutical names 120–21
statutory framework 121
tablet or capsule shapes and flavours, registration of 118
see also pharmaceuticals
trademarks in the pharmaceutical sector, EU, Australian regulatory requirements comparison 125–30
active ingredient, prominence and placement 128–32
bans on brand extension medicines (umbrella brands) 133–5
consumer knowledge and awareness 126–7, 131–2, 133
draft Therapeutic Goods Order 128–30
impact on pharmaceutical brands 130–32
medication errors review 126–7
medicine information panel for non-prescriptive medicines 130, 132
Therapeutic Goods Administration (TGA) 125–32
Tran, S 311, 313, 324
Tregear, A 288
Tritton, G 316
Turkey, alcohol products 25
Index 355

Tushnet, R 5, 91

UK
Advertising Standards Authority (ASA) and food labelling and advertising 150–51
Food Standards Agency, nutrient profiling model 328–9
Intellectual Property Office (IPO) and pharmaceutical trademarks 116–17
Medicines and Healthcare Regulatory Agency (MHRA) 122, 134
nutrition and health claims and trademarks at risk 152–3
Patent Office prioritized examination system 310
Standardised Packaging of Tobacco Products Regulations 1, 22, 23, 56, 83
trademark law and freedom of expression 86
trademark regulations 45–6, 48
umbrella branding in pharmaceuticals 134

UK, legal cases
Anisminic v Foreign Compensation Commission 203
British American Tobacco v Department of Health 3, 6, 17, 45–6, 48, 60–61, 67, 98, 106, 169, 170, 200–201
J Bolliger v Costa Brava Wine 287
London Borough of Hackney v Cedar Trading 76
R (on the application of British American Tobacco UK Ltd) v Secretary of State for Health 136
R (on the application of Lumsdon) v Legal Services Board 99
R (on the application of Philip Morris Brands Sarl) v Secretary of State for Health 136
Smith-Kline & French Laboratories v Sterling-Winthrop Group 118
Tobacco Packaging 72, 82, 93, 102, 108, 110

umbrella brands (bans on brand extension medicines) 133–5
unhealthy food, proposal for exclusion from patentability 313–17, 325–7
unhealthy products, geographical indications (GIs) and public health 297
unjustifiable positive encumbrance on use of trademarks 65–6
unjustifiably encumbered by special requirements see under plain packaging of tobacco products, Australia, and WTO TRIPS challenge

Uruguay
legislation on misleading or deceptive tobacco packaging 23–4

Philipp Morris v Uruguay 23–4
Switzerland–Uruguay BIT, tobacco packaging measures 220–22, 223, 224–6, 228–30
tobacco packaging and labelling 214–15, 216–18

US
Affordable Health Care Act 266
certification marks as geographical indications 261
certification marks for public health see certification marks for public health
Federal Food, Drug and Cosmetic Act 244–5
freedom of expression 103–4
LEED mark and Green Building Council 262
‘natural’ labels on food products 260
Organic Foods Production Act 267
Patent Office, patentability exclusion for inventions considered immoral 314–15
Patent Office prioritized examination system 310, 311
patents to encourage production of healthier food 307–8
sugary beverage products labelling, California 26
trademark law 78–9, 206
The new intellectual property of health

Washington State Liquor Cannabis (formerly Control) Board (WSLCB) 267
US, legal cases
Class Action Compl, Howerton v Cargill 260
Class Action Compl and Jury Demand, Martin v Cargill 260
Diamond v Chakrabarty 330
Hanover Star Milling Co v Metcalf 206
Lowell v Lewis 315
R J Reynolds Tobacco Co v Food and Drug Admin 104
Swiss Watch International v Federation of the Swiss Watch Industry 263–4
Virginia State Board of Pharmacy v Virginia Citizens Consumer Council 95, 103–4
usefulness criteria, pharmaceutical patents and health-related goods 244
Vadi, V 233–54
value and consumer interest, geographical indications capitalizing on 291–2
global value networks (GVNs) 257–8, 265–70
Van den Brink, M 96
Van der Merwe, C 200, 201
Van Harten, G 236
Vandebergh, M 31
Vandevelde, K 231
Vaver, D 87, 266
Verhoestraete, F 143, 144
Verpeaux, M 83
very large pictorial warnings (VLPW) 70–71, 74, 75, 99, 103, 105–6, 107, 108
Voight, J 302
Voon, T 81, 87, 173, 218, 219, 298
Wakefield, M 41–2
Wansink, B 277, 278
Watson, J 105
‘wear-off’ effect, risk of 37
Weatherill, S 105
Wells, A 330
Williams, C 301
Williams, E 284
Woods, L 97
word trademarks 60–61, 67–8
Guidelines on Marketing to Children 30
Methanex Corporation v USA 223
pharmaceutical name approval and International Non-proprietary Name (INN) 116, 117, 122, 124
Punta del Este Declaration on measures to protect public health 226
very large pictorial warnings (VLPW) 74
World Trade Organization (WTO) Dispute Settlement
Brazil–Tyres 172, 174
Canada – Pharmaceutical Patents 57, 58, 320–21
Canada – Term of Patent Protection 319
DS434 Australia – Certain Measures Concerning Trademarks and Other Plain Packaging Requirements Applicable to Tobacco Products and Packaging 89, 218–19
EC – Trademarks and Geographical Indications 46, 48, 56–7, 62, 68, 196, 197, 200–201, 228
EC – Hormones 166
EC–Seals 172, 174
US – Section 211 Appropriation Acts 55
Index

US–Continued Zeroing 167
US–Shrimp 167

World Trade Organization (WTO)
TRIPS Agreement
Doha Declaration on Public Health 179–80
and Free Trade agreements (FTAs) 252
geographical indications 287, 293, 294, 297
geographical indications, ‘essentially attributable to its geographical origin’ 294, 295, 296, 303–4
obligations, investment disputes, pharmaceutical patents and health-related goods 244, 251–2, 253
patent rights, permitted exceptions to (Article 30) 57
patents contrary to ordre public or morality 314, 317, 323, 326–7
patents as tool to encourage production of healthier food 314, 317, 318, 319, 321, 324, 328
plain packaging of tobacco products, Australia see plain packaging of tobacco products, Australia, and WTO TRIPS challenge
plant variety rights protection 324

trademark holders, legitimate interests of (Article 17) 57
trademark registration and rights (Article 20) 64–8
trademark registration and use (Article 15) 51, 52, 77
trademark revocation (Article 19) 56
trademark rights and right to exclude unauthorized third-party use (Article 16) 195–7, 198
trademark rights, tobacco packaging measures and international investment law (Article 16.1) 228
trademarks and exclusive rights (Article 16) 45–6

see also Paris Convention

Yannaca-Small, K 227
Yeung, K 34
Yoghurt and Live Fermented Milks Association (YLFA), ‘probiotic’ term use 153
Yong, H-H 42
Yu, P 88
Zahaf, M 303
Zapata, A 289, 300
Zimmermann, D 95