

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.

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You can direct your queries or comments to the authors

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

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