



ANDREA PITTS

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Trademark Agent

Speaks: English

Year of Call: 2014 - Ontario

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Andrea Pitts

Andrea Pitts is a partner, lawyer and trademark agent in Gowling WLG's Ottawa office. Her practice covers all aspects of intellectual property with a focus on trademarks and copyright.

Andrea understands the unique and often intricate IP challenges faced by businesses across various sectors. From health sciences to pharmaceuticals, food and beverage and technology, Andrea collaborates with national and global organizations alike, tailoring her advice to meet their specific needs and maximize the value of their IP assets.

Andrea is a pragmatic advisor and problem solver. She assists clients at all stages of development to secure, protect and enforce their intellectual property. This includes managing complex trademark portfolios, providing opinions on the availability of new trademarks, and representing clients in opposition and cancellation proceedings before the Canadian Intellectual Property Office's Opposition Board. Andrea ensure her clients' intellectual property is protected and positioned for growth and revenue generation.

Additionally, Andrea provides strategic advice on contentious copyright matters and has represented clients before the Federal Court in cases involving copyright infringement and related issues.

What sets Andrea apart is her ability to connect with her clients on a personal level. Responsive to their needs, she takes the time to understand their business challenges and goals, helping IP owners overcome obstacles and optimize new opportunities.

Prior to her legal career, Andrea was a scientific researcher of neurodegenerative diseases such as Huntington's and Alzheimer's.

Practice areas

Intellectual Property Law

Trademarks, Brands & Designs

Career & Recognition

2024

February

World Trademark Review 1000 2024

2014

Year of Call, Ontario

2013

University of Ottawa, JD

2010

University of Western Ontario, MSc

2007

University of Western Ontario, HBSc

Memberships

- Law Society of Ontario
- Intellectual Property Institute of Canada

Thilo C. Agthe

PARTNER

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ABOUT THILO

Thilo Agthe's practice focuses on trademarks, copyright and trade secrets, intellectual property licensing, technology transfer, due diligence in connection with mergers, acquisitions, and financial transactions and the prosecution and defense of trademark oppositions and cancellations in the U.S. Patent & Trademark Office. In addition, he advises clients on issues regarding information technology, including website terms and privacy policies, as well as issues regarding the private and commercial use of unmanned aerial vehicles (drones) in the United States. He also counsels clients on agency, representative, distributorship, confidentiality and nondisclosure agreements, and other contractual arrangements.

Thilo has taught trademark law at New York University's School of Continuing and Professional Studies and has lectured on international trademark law, secured interest in intellectual property assets, and the Uniform Domain Name Dispute Resolution Policy. He is the co-author of "Von Medinol bis Bose: Die Problematik fehlerhafter Benutzungserklärungen bei US-Markenregistrierungen – eine Standortbestimmung" published in GRUR International: Gewerblicher Rechtsschutz und Urheberrecht, March 2011. Thilo is a frequent participant and speaker in seminars and workshops focusing on intellectual property law issues.

EXPERIENCE

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- Trademark and copyright prosecution
- Licensing
- Information technology
- Commercial transactions
- Corporate Law
- Drone (UAV) law

LANGUAGES

- German

EDUCATION

- Boston University B.A. — 1984
- University of Hamburg Germany — 1987
- Capital University Law and Graduate Center J.D. — 1991

ADMISSIONS

- New York
- Federal District Courts, Southern & Eastern Districts of New York

PROFESSIONAL ASSOCIATIONS

- International Trademark Association (INTA):
 - Member of INTA's Brand Restrictions Committee for the 2022-23 term.
 - Former vice-chair and chair of the Harmonization in Trademark Law and Practice Committee.
 - Former INTA representative at the meetings of Working Group VI of the United Nations Commission on International Trade Law.
 - 2007 co-recipient of the INTA Volunteer Service Award for the Advancement of Trademark Law.

CIVIC ENGAGEMENT

- Co-ambassador of the University of Hamburg (Germany) Alumni Association for the New York, Connecticut and New Jersey tri-state area.
- Volunteer pilot for [Pilots N Paws](#) (animal rescue organization).

ADDITIONAL EXPERIENCE

- Advised a major German automobile manufacturer in connection with negotiations with an Oscar-winning Hollywood actor regarding his appearance in a television commercial;
- Handling of several major trademark portfolios, including maintenance and renewals in the United States;
- Advising several major German apparel companies regarding their entry into the U.S. market, especially with respect to trademark protection and labeling laws;
- Participation in most mergers and acquisition transactions handled by the firm, including the preparation of necessary IP due diligence reports and IP transfer agreements;
- Advising a major Swiss pharmaceutical company in connection with its service agreements with various U.S. pharmaceutical companies;
- Preparation and review of website terms of use and privacy policies;
- Assisted an aircraft manufacturing company through its formation and start-up period.

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ATTORNEY
ADVERTISING

CONTACT



Brand Restrictions

Andrea Pitts | Gowling WLG
Thilo Agthe | Wuersch & Gering

NYIPLA – June 26, 2024

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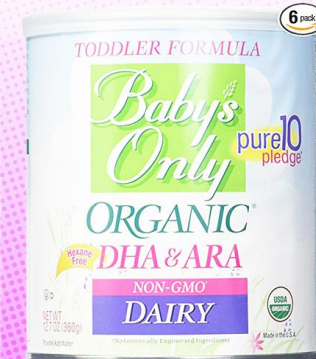
V. Brand Restrictions globally

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Why Do We Have Brands?

- ✓ Indicate product origin
- ✓ Key quality indicators



What Are Brand Restrictions?

Legislation and regulations that restrict brand use, reduces the use of trademarks on packaging or even bans their use altogether

The industry main targets:

- ✓ Alcoholic beverages;
- ✓ Sugar-loaded foods;
- ✓ Fat-filled foods;
- ✓ Cosmetics;
- ✓ Pharmaceuticals;
- ✓ Video games;
- ✓ Infant Formula.



Visual Example of a Brand Restriction



THEN



VERSUS

NOW

Brand Restrictions – Examples

- Plain packaging;
- Limitations on the types of advertising;
- Limitations or restrictions on claims that may be made (such as health claims);
- Limitations on advertising at particular venues;
- Limitations on advertising towards children;
- Limitations on press or magazine advertising;
- Limitations on the sale of particular products;
- Limitations on the type of packaging that may be used – requiring usage of generic packaging;
- Restrictions on sport (or other) sponsorships;
- Limitations or provisions dealing with the use of trademarks and branding elements.

The Origin of Brands Restrictions – Why?

Brand restrictions originate from **government** and **legislation**, and purport to combat health and welfare issues

Health and Welfare Issues

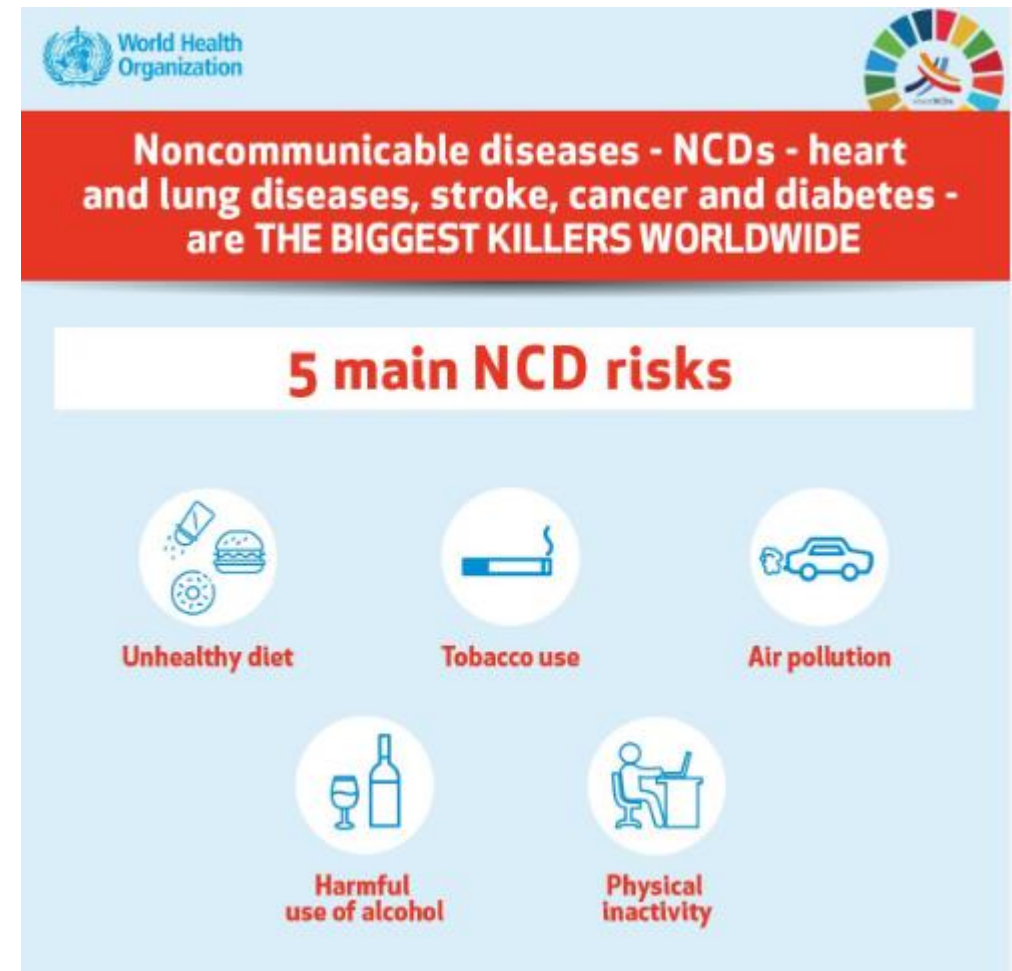


Policymakers



The Origin of Bran Restrictions – Why?

- 1990: WHO campaign to combat **noncommunicable diseases (NCDs)**
- **Burden on social and economic development** in many countries around the world
- Principal NCDs:
 - ✓ cardiovascular diseases,
 - ✓ obesity,
 - ✓ cancer,
 - ✓ chronic respiratory disease,
 - ✓ diabetes, and
 - ✓ mental and neurological conditions.
- All NCDs share the following risk factors: tobacco, alcohol, air pollution, unhealthy diet, and physical inactivity



Consequences

The Consequences for Brand Owners and the Economy

- ✓ Economic loss to businesses and economy;
- ✓ Reduced incentive for innovation;
- ✓ Loss of brand identity and value;
- ✓ Loss of registered trademark rights;
- ✓ Reduced ability to police against illegal trade;
- ✓ Loss of marketshare to cheaper alternatives.



The Consequences for Consumers

- ✓ Diminished trust;
- ✓ Increased worry about safety and legitimacy of products;
- ✓ Health risks;
- ✓ Reduced choice;
- ✓ Marketplace confusion.

NOT TRUSTED

**Are these brand restrictions
necessary?**

Brand Restrictions May Not be Effective

“ These measures are being imposed without adequate due diligence or clear evidence to show that the intended results can be achieved... These restrictions on brands are reckless. They undermine consumer trust in brands and will cause enormous damage to businesses and consumers.”

-- INTA CEO Etienne Sanz de Aced

The Downside: A Major Consideration

- The illegal trade, counterfeits and reduced border enforcement
- **Diminished support for social causes** - Brand Finance report in 2021: *"Brands support important social causes and help bring about change"*
- **Questionable benefits** - IEA Report (Institute of Economic Affairs), 2023: *"Between 1991 and 2001, alcohol advertising fell by 10.8% [...], but alcohol consumption rose by 15.8%"*

Again, are brand restrictions really necessary to safeguard the public health?



Source - <https://iea.org.uk/media/alcohol-advertising-bans-are-not-evidence-based-finds-new-iea-report/>



Brand Restrictions Globally



Impacted Industry Sectors

- **Not just tobacco!**
- **Impacted industry sectors include:**
 - ✓ Infant formula;
 - ✓ Alcoholic beverages;
 - ✓ Energy – and in some case, by extension, the automotive industry;
 - ✓ Pharmaceuticals;
 - ✓ Food & beverage.

Infant Formula

Restrictions on the use of some kinds of trademarks – the loss of trademark rights



United Kingdom

Limitations on advertising particular products

- Advertising is restricted to publications specializing in baby care and scientific publications
- Label can't include pictures of infant, or other pictures or text which may idealise use of such formula
- Advertisement must only provide scientific and information and can't imply or create a belief that bottle-feeding is equivalent or superior to breastfeeding
- Advertisements must not confuse between infant formula and follow-on formula



Enfamil For a healthy baby indeed.

Enfamil keeps your baby from spitting up, unlike milk substances.

www.Enfamil.com

The advertisement features a photograph of a smiling woman looking at a happy baby. Below the photo is a can of Enfamil Premium Lipi infant formula. The text 'Enfamil keeps your baby from spitting up, unlike milk substances.' is written in a serif font, and the website 'www.Enfamil.com' is at the bottom.

Australia

Limitations on advertising sale of particular products

- **Marketing in Australia of Infant Formula: Manufacturers and Importers Agreement**
- Participating companies must not:
 - ✓ advertise or promote infant formula;
 - ✓ imply that formula is better than breastfeeding;
 - ✓ advertise formula to parents through the healthcare system;
 - ✓ hand out free formula to parents;
 - ✓ give financial incentives to sales staff or health workers for selling or promoting formula.
- The Australian Breastfeeding Association and World Breastfeeding Trends Initiative Australia recommend that a stronger regulatory framework is required... **stay tuned!!**

Infant Formula Brand Restrictions

- **Do not account for the realities of:**
 - ✓ Women (bodily autonomy, financial, health);
 - ✓ Childrearing;
 - ✓ Commerce;
 - ✓ Consumers.

Alcohol

Australia

Limitations on types of advertising

- **Alcohol Beverage Advertising Code** – new advertising limitations as of 2023



Ireland & Norway

Alcohol Label Requirements

- Ireland – Public Health (Alcohol) Act
 - ✓ All alcohol labels to display warnings about cancer, liver disease, and pregnancy symbols by May 2026
- Norway – pending proposal regarding alcohol health warnings



The graphic features a red background with white and black text and icons. On the left, a wine glass icon contains the text '2.2 UK Units' and 'Per 175ml'. Next to it is a bottle icon with '9.4 UK Units'. Below these is the text 'Search: OneYou Alcohol'. On the right, a white box contains the heading 'ALCOHOL CAN CAUSE CANCER' in red, followed by the text 'To keep health risks from alcohol to a low level it is safest not to drink more than 14 UNITS a week on a regular basis'. Below this, another white box contains the text 'It is safest to avoid alcohol when pregnant or trying to conceive' and a circular icon of a pregnant woman with a red prohibition sign over it.

2.2
UK Units

Per
175ml

9.4
UK Units

Search:
OneYou Alcohol

ALCOHOL CAN CAUSE CANCER

To keep health risks from alcohol to a low level it is safest not to drink more than **14 UNITS** a week on a regular basis

It is safest to avoid alcohol when pregnant or trying to conceive



France

Limitations on advertisement features

- French Evin Law, 1991
 - ✓ prohibits alcohol ads through media targeted at youth
 - ✓ product information must only contain factual/informative data and objective qualities – **upheld in 2020 decision**
 - ✓ Alcohol ads require the health warning ‘alcohol abuse is dangerous for health’ to appear on all alcohol advertisements



Foods

Canada

- Pending legislation -> **Bill C-252 – An Act to amend the Food and Drugs Act (prohibition of good and beverage marketing directed at children)**
- If enacted, it will restrict advertising to children of foods contributing to excess intake of sodium, sugar, and saturated fat



STAY TUNED

Pharmaceuticals

European Medicines Agency (EMA)

Name Review Group (NRG)

Guidelines on the acceptability of names for human medicinal products processed through the centralised procedure (7th update – published Dec 15, 2023)



European Medicines Agency (EMA)

Name Review Group (NRG)

- Consider the phonetic characteristics of an invented name and the potential difficulties in pronunciation in the different EU official languages
- Use of repeated vowels or consonants may create such difficulties, which may result in the incorrect identification of the medicinal product
- Use of consecutive vowels or consonants, especially in the first part of the invented name, should be avoided to ensure the correct identification of the product in electronic systems

Food and Drug Administration (FDA)

Center for Drug Evaluation and Research (CDER)

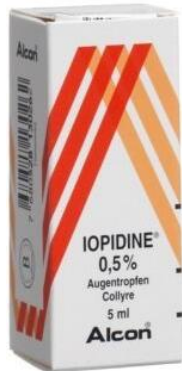
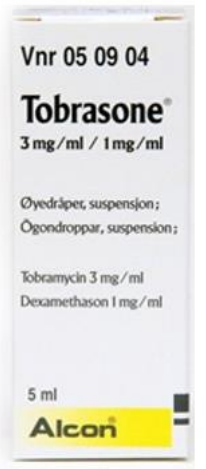
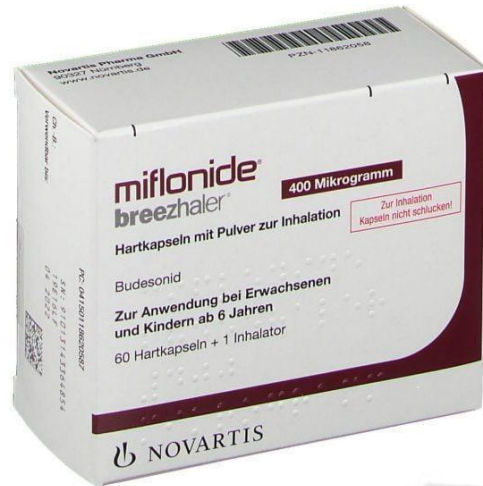
Safety Considerations for Container Labels and Carton Labeling Design to Minimize Medication Errors – May 2022



Parallel Traders

Re-Boxing in the EU

- Lobbying and litigation efforts advocating for packaging replacement when pharmaceutical products are parallel traded within the EU
- Some National Health Authorities making re-boxing compulsory



Glivec® 400 mg
Filmtabletten
Imatinib
90 Filmtabletten
Zum Einnehmen.

Glivec® 400 mg
Filmtabletten
Imatinib
90 Filmtabletten

90 filmdragerade tabletter
Votrient® 200 mg
filmdragerade tabletter
pazopanib

Vnr. 12 54 12
Miflonide® Breezhaler®
400 mikrogram
Budesonid

Inhalationspulver, hårde kapsler
60 kapsler + 1 Breezhaler
Til inhalation

Eucreas® 50 mg/1000 mg
filmovertrukne tabletter
vildagliptin/metforminhydrochlorid
60 filmovertrukne tabletter
Oral anvendelse

Vnr 53 52 14
Tobrasone®
3 mg/ml /
1 mg/ml
tobramycin/
gentamicin
Ögondroppar,
suspension
5 ml
Tobrasone® är ett
registrerat varumärke,
som tillhör Novartis AG.

Tafinlar® 50 mg
hårde kapsler
Dabrafenib
120 kapsler
Oral anvendelse

Tafinlar® 50 mg
hårde kapsler
Dabrafenib
120 kapsler

12 x 2 x 0,25 ml Vnr 12 46 85

IOPIDINE® 10 mg/ml
apraklonidin
ögondroppar, lösning i endosbehållare

NOVARTIS

ENTRESTO® 49 mg/51 mg
filmovertrukne tabletter
SACUBITRIL/VALSARTAN

PRØVEPAK./SAMPLES
180119494-01-01

56 filmovertrukne tabletter

Entresto® er et registreret varemærke,
der tilhører Novartis AG.

Cosentyx® 150 mg
injektionsvätska, lösning, i förfylld injektionspenna
sekukinumab
2 förfyllda SensoReady-pennor
Subkutan användning

Kisqali® 200 mg
filmdragerade tabletter
ribociklib
63 filmdragerade tabletter
Oral användning

Jakavi® 5 mg tabletter
ruxolitinib
56 tabletter

Fossil Fuels

Fossil Fuels

- Pending Bill C-372 – Fossil Fuel Advertising Act



Bill C-372 - Overbroad sections

Prohibition

6 It is prohibited for a person to promote a fossil fuel, a fossil fuel-related brand element or the production of a fossil fuel except as authorized by the provisions of this Act or of the regulations.



- ✓ Captures hybrid vehicles
- ✓ Captures promotions of hybrid vehicles, their parts, and associated performance chemicals

Bill C-372 - Overbroad sections

Manner of Promotion Elements

8 It is prohibited for a person to promote a fossil fuel or the production of fossil fuel

(a) in a manner that states or suggests that the fossil fuel, its production or its emissions are less harmful than other fossil fuels, their production or their emissions;...

(c) by using terms, expressions, logos, symbols or illustrations that are prohibited by the regulations.

Bill C-372 - Overbroad sections

False Promotion

7 (1) It is prohibited for a person to promote a fossil fuel or the production of a fossil fuel in a manner that is false, misleading or deceptive with respect to or that is likely to create an erroneous impression about the characteristics, health or environmental effects or health or environmental hazards of the fossil fuel, its production or the emissions that result from its production or use.

Considerations

(2) The general impression conveyed by a promotion and the literal meaning of any statement contained in a promotion are to be taken into account in determining whether a promotion is made in such a manner.

Brand Restrictions in the US

Brand Restrictions in the US

Balance between the rights of the speaker and those of the listener, viewer or consumer remains a grey area

Conflicting caselaw

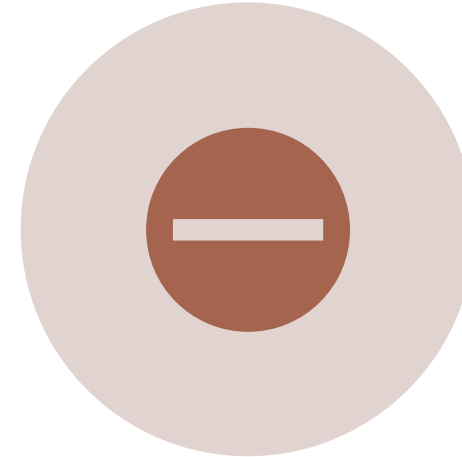
Virginia State Board of Pharmacy v Virginia Citizens Consumer Council Inc. (1976)	R.J Reynolds Tobacco Co. v U.S. Food and Drug Administration (2012)
Rights of listeners, viewers and consumers are as important as the speaker	Ignored the interests of listeners and viewers, and instead focused primarily on protecting free speech for corporate commercial message

STAY TUNED

Questions



WHAT ARE THE ALTERNATIVES TO
BRAND RESTRICTIONS?



HOW HAVE BRAND RESTRICTIONS
BEEN SUCCESSFUL?



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