

THE COLOUR AND SHAPE OF A PHARMACEUTICAL TABLET DEEMED NOT DISTINCTIVE ENOUGH TO WARRANT TRADE-MARK REGISTRATION, FEDERAL COURT RULES

By

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The Trial Division of the Federal Court of Canada recently ruled that the Registrar of Trade-Marks ("Registrar") had made a reasonable decision in refusing to allow the registration of the trade-mark YELLOW TABLET DESIGN for the shape and colour of the Applicant's felodipine pills used in the treatment of hypertension (*Astrazeneca AB v. Novopharm Limited and Registrar of Trade-marks*, T-810-00, October 30, 2001, Kelen J.).

The facts

The Applicant, Astrazeneca AB ("Astra") applied to register the trade-mark YELLOW TABLET DESIGN (TMO 783,267) for a tablet containing felodipine, a drug used in the treatment of persons suffering from hypertension. The trade-mark application depicted a tablet which was round in shape and yellow in colour. The pills were sold under the work mark PLENDIL. The respondent Novopharm Limited ("Novopharm") opposed the trade-mark application alleging, amongst other things, that Astra's trade-mark was not distinctive (Section 38 of the *Trade-Marks Act*, R.S.C. 1985, c. T-13.).

The Registrar's decision

The evidence submitted to the Registrar showed that Astra was the only manufacturer of felodipine. The tablets were packaged in a "blister bubble" sleeve which was inserted in a box which was marked as PLENDIL. The evidence submitted by Novopharm demonstrated that there were approximately twenty (20) yellow round tablets available on the Canadian market for the treatment of hypertension.

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It was argued that when pharmacists dispense the tablets, they rely not only on the colour and shape of the tablets, but also on the identification of the product on the packaging. Both parties agreed that the physicians give little, if any, consideration to the colour and shape of the drugs they prescribe to their patients. Astra did not adduce any evidence showing that the end consumers of felodipine, namely the patients, associated the colour and shape of the tablets with PLENDIL.

The Registrar rejected Astra's argument that, since it was the only manufacturer of felodipine in Canada, consumers would necessarily associate the shape and colour of the tablets with the PLENDIL product. In his view, Astra's definition of the relevant market was too narrow. The Registrar therefore accepted Novopharm's position that the shape and colour of the PLENDIL tablets was not distinctive, therefore unregistrable as a trade-mark.

The Federal Court ruling

Astra appealed the Registrar's decision to the Trial Division of the Federal Court of Canada (Section 56 of the *Trade-Marks Act*). On appeal, Astra adduced additional evidence, specifically the affidavit of a pharmacist stating that the colour and shape of the felodipine tablets were inspected by pharmacists prior to dispensing them, but that these pharmacists did not rely solely on the product's appearance to identify the PLENDIL product. The affidavit also stated that the packaging of the PLENDIL tablets enabled the pharmacist to observe the colour and shape of the product, as well as identify the supplier, the ingredients and the brand name. As for the additional evidence submitted by Novopharm, it simply reaffirmed the fact that there were other round, yellow tablets for the treatment of hypertension available on the Canadian market.

Since the additional evidence adduced before the Court was not materially different from the evidence adduced before the Registrar, the Trial Judge ruled that it would not have affected the Registrar's findings on the issue of distinctiveness. The Trial Judge therefore applied the ruling of the Federal Court of Appeal in *Molson Breweries v. John Labatt Limited*, (2000) 3 F.C. 145 (Fed. C.A.) and ruled that the appropriate standard of review of the Registrar's findings was reasonableness *simpliciter*.

The Trial Judge considered the applicable case law which stated that although "...the colour, shape and size of a product may together be capable in law of constituting a trade-mark, the resulting mark is, as a general rule, likely to be inherently weak..." (*Novopharm Ltd. v. Bayer Inc.*, (1999) 3

C.P.R. (4th) 305, Evans J., at p. 322). (Other cases where colour and shape were not held as distinctive: *Eli Lilly Co. v. Novopharm Ltd.*, (1993) 73 C.P.R. (3d) 371, (F.C.T.D.), appealed at (2000) 10 C.P.R. (4th) 10, (F.C.A.); *Novopharm Limited v. Astra*, (2000) F.C.J. no. 496, (F.C.T.D.), appealed (2001) F.C.A. no 296, (F.C.A.)). The Supreme Court of Canada had considered the “get-up” of a pharmaceutical tablet to be distinctive, (*Ciba-Geigy Canada Ltd. v. Apotex Inc.*, (1992) 44 C.P.R. (3d) 289 (S.C.C.)), but the Trial Judge distinguished that case from the one at bar, as the origin of the wares in the Supreme Court decision could only be established by the pharmaceutical tablets themselves.

The fact that pharmacists recognised the colour and shape of the PLENDIL tablets inside the packaging was insufficient to enable the Trial Judge to conclude that the colour and shape of the tablets were distinctive enough to warrant a trade-mark registration. There was no evidence that patients, or the physicians who prescribed the medication, identified the colour and shape of the tablets with Astra’s PLENDIL product without verifying the actual box and dispenser. The Trial Judge agreed with the Registrar’s finding that Astra had not discharged its burden of proving, on a balance of probabilities, that the colour and shape of its PLENDIL tablets had acquired secondary meaning, i.e. that the ordinary consumer would associate the colour and shape of the tablets with the PLENDIL trade-mark, brand name, or with Astra as its supplier. Since it was the packaging that made the wares distinctive, not the colour and shape of the tablets, the Trial Judge ruled that the Registrar’s findings were reasonable and consequently dismissed Astra’s appeal with costs.

This decision therefore reaffirms the heavy burden of proof an Applicant must meet in order to register the colour and shape of its wares as a trade-mark. Future Applicants, especially in the pharmaceutical industry, should be weary of the fact that, although the colour and shape of their wares may be different from those of others, colour and shape should not automatically be construed as distinctive, thus warranting trade-mark registration.

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