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SHADES OF PURPLE DO NOT CONSTITUTE DISTINCTIVE TRADE-MARK RULES CANADA'S FEDERAL COURT IN DISPUTE INVOLVING INDICIA USED FOR INHALER IN THE TREATMENT OF ASTHMA

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In a recent trade-mark dispute involving various pharmaceutical companies, Canada's Federal Court revisited the issue of the ambit of protection granted to trade-marks consisting of shades of colour and confirmed that such ambit is still quite limited (*Apotex Inc. et al. v. Glaxo Group Limited and the Registrar of Trade-marks*, 2010 FC 291 (F.C., Barnes J., March 12, 2010)).

The dispute before the Court centered on a trade-mark registration secured in Canada on May 9, 2007 by Glaxo Group Limited, a pharmaceutical company. The trade-mark in question (the "May 9, 2007" mark) consisted of the colours dark purple and light purple applied to the visible surface of portions of an inhaler for administration of pharmaceuticals and was, of course, registered for use with inhalers. This 2007 registration resulted from an application previously filed on June 18, 2004 on the basis of alleged use of the trade-mark in Canada since at least as early as October 1999.

Also used in association with the inhalers were the trade-marks ADVAIR and DISKUS (that were not challenged before the Court). Accordingly, when the ADVAIR DISKUS inhaler was sold to the public, it was presented in a box marked with the words *Advair* and *Diskus* and that also contained some information about Glaxo Group Limited, the recommended dosages of the product, its recommended storage, its list of ingredients, etc. While the trade-marks ADVAIR and DISKUS were apparently easily discernable, the trade-mark protected by the May 9, 2007 registration had no trade-name or label; it was rather a mark comprised of the shape and two complementary purple colours.

This is the mark that Apotex Inc. and other pharmaceutical companies attacked before the Federal Court on December 21, 2007. They requested that its

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corresponding registration be expunged on the basis that the trade-mark lacked distinctiveness.

Therefore, the issue before the Court was whether on December 21, 2007, physicians, pharmacists and patients would, to any significant degree, recognize the May 9, 2007 mark by its appearance (excluding labels and packaging) and associate that get-up with a single source.

In order to determine whether the May 9, 2007 mark was distinctive of its owner, the Court outlined the following test at paragraph 13 of its reasons: It is insufficient to simply show that the appearance of a product may represent a secondary check of product identity or that it may cause a person to wonder whether the expected product was correctly dispensed; rather, what is required is that physicians, pharmacists and patients relate the trade-mark to a single source and thereby use the mark to make their prescribing, dispensing and purchasing choices. Accordingly, an educated guess about the source of a product is not enough to constitute distinctiveness and neither is a design that is simply unique in the marketplace and recognized as such.

The Court noted that colour and shape can constitute valid trade-marks in that they can serve to distinguish the wares of one trader from those of another. However, because such marks are also used with more “traditional” trade-marks consisting of words or designs, the commercial distinctiveness of marks consisting of colours would not surprisingly be more difficult to establish. This is particularly true in the area of medication and health related products where patients would be more alert to the presence of well-known trade-marks and other wording appearing on a given product’s labelling. In fact, in paragraph 19 of its reasons, the Court noted that the distinctiveness of the mark based on colour and shape may be adversely affected by its association with a registered trade-name that will be used by patients to distinguish the source of the product linked thereto. In other words, as mentioned in paragraph 20 of the Court’s reasons, a trade-mark based on get-up cannot acquire its distinctiveness by virtue of its use in association with a distinctive word-mark.

The Court then proceeded to examine whether the May 9, 2007 mark was indeed distinctive of its owner. At paragraph 22 of its reasons, the Court wrote that the essential problem in support of the supposed distinctiveness of the mark under attack was that the inhaler was never marketed without a corresponding label so that witnesses each gave an opinion on a hypothetical situation that almost never occurred, that is the use *simpliciter* of the May 9, 2007 mark in association with inhalers.

For example, in paragraph 24 of its reasons, the Court wrote about one witness who candidly acknowledged that it was the trade-name ADVAIR that was used to properly identify Glaxo Group Limited’s product and, in the absence of a label, he would be suspicious about what he had in front of him.

Indeed, what transpired from the whole evidence was that appearance provides “an uncertain basis for drawing conclusions about product identity or source”.

After reviewing the evidence, at paragraph 33 of its reasons, the Court concluded that no prudent medical professional would rely upon the colour or shape of an inhaler to exercise a professional judgment about such a product; similarly, few patients would make a choice about their inhaler based solely on the appearance of an unlabelled product.

In short, the Court decided that the Plaintiffs had met their burden of establishing that the Defendant’s May 9, 2007 mark lacked distinctiveness at the date when the proceedings were commenced. The application was allowed and the Court ordered that the registration for the May 9, 2007 mark be struck from the register of trademarks.

This case is a timely reminder of the limited scope of protection afforded to “trademarks” consisting of shades of colour; moreover, in its reasons, the Court stated an obvious (but challenging) reality: it is always difficult for colours to acquire distinctiveness when they are constantly used with a companion trade-mark that is recognised by consumers as distinguishing the source of the products associated thereto.



