

## DRUG'S DISTINCTIVE COLOUR, SHAPE AND FLAVOUR AS TRADEMARKS

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Traditionally and generally, a trademark is constituted of words, letters, phrases, arms, drawings or a combination of all of these. However, particularly in the pharmaceutical industry, the trademarks have changed from words to colours, shapes and flavour.

The evolution of the marketing's techniques allows the pharmaceutical companies to be inventive and original in the presentation of their products. The pharmaceutical industry insists on the visual presentation of their products and the publicity, notoriety attached to those. Patients may simply refer to the colour and shape of a tablet to identify the medication that they took for a particular illness: "I do not remember the name of the pills I took for my head ache...but they were pink round pills".

The following text will try to answer briefly to the following question: "Is registration of drug's distinctive colour, shape and flavour authorised by the *Canadian Trade-Marks Act*?".

There is nothing in the language of sections 2, 9 or the entire *Act* that would preclude that a distinctive colour, shape or flavour are not registrable. There is nothing in the *Act* nor in any of the authorities that is requiring a mark to be two-dimensional only or is precluding from registration a mark which covers the whole of the visible surface of the goods: *Smith, Kline and French Laboratories Ltd. v. Sterling-Winthrop Group Ltd* (1976) R.P.C. 511.

A trademark is a distinctive sign that is used for the purpose of distinguishing the wares or services manufactured, sold, leased, hired or performed by a person from those of others.

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Consequently, a colour, a shape or a combination of both can also be recognised as a distinctive sign which is used to identify the products of a company from those of others. The distinctive colours blue and pink applied on the shield of a pill or the distinctive triangle shape of a tablet may benefit protection as trademarks. However, the resulting marks, would as a general rule, likely to be weak: *Smith Kline & French Canada Ltd. v. Registrar of Trade-marks* (1987), 9 F.T.R. 129 (F.C.T.D.).

The onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its pharmaceutical product from those of others throughout Canada. Therefore, the registration of a common term used in the industry to identify the product, a descriptive term, an ornamental or functional characteristic would not be registrable because of their defects to distinguish the wares or services of a person from those of others.

The applicant must establish on a balance of probabilities that the ordinary consumers associate the colour, the shape or the size of a product with a single source of manufacture or supply: *Standard Coil Products (Canada) Ltd. v. Standard Radio Corporation*, (1971) F.C. 106 at 123 (F.C.T.D.), *aff'd.* (1976) 2 F.C. iv (F.C.A.). The "ordinary consumers" are not only physicians and pharmacists, but also the "ultimate consumers", that are the patients for whom the medical preparations are prescribed, even though their access is through a doctor's prescription: *Ciba-Geigy Canada Ltd. v. Apotex Limited*, (1992) 3 S.C.R. 120.

The principal impediment to the registration of a shape of a pharmaceutical preparation is the so called "functionality doctrine". In the case *Parke, Davis and Co Ltd c. Empire Laboratories Limited*, (1963) 24 Fox Pat. C. 88, 38 D.L.R. (2d) 694, (1964) Ex.C.R. 399 (Ex.C.R.), Mr. the judge Noël has decided or stated at the pages 416, 418-419 and 419 that:

"(...) the coloured gelatine band is used to close the gelatine capsule (...) we have seen (i.e., the testimony and a reference to the corresponding US patents) that the colour banded capsules of the plaintiff have many utilitarian functions and that even the presence of colour on the bands is useful in enabling the easy detection of a break on the band."

The same principle applies when a principal component of a tablet, syrup is inherently coloured. The said colour cannot be protected nor registered because it is not distinctive of the product used in association with it:

“When a medicinal component of a drug is inherently colored, that color cannot acquire trademark significance. Thus, the yellow of sulphur, the blue of cupric sulfate and the vivid red of mercuric iodide cannot be appropriated as trademarks for the corresponding medicinal”<sup>i</sup>

#### COLOURS:

Indeed, it is very important to distinguish between colour as a trademark and colour of a trademark: *Parke, Davis and Co Ltd c. Empire Laboratories Limited*, (1963) 24 Fox Pat. C. 88, 38 D.L.R. (2d) 694, (1964) Ex.C.R. 399 (Ex.C.R).

The registration of a single colour as a trademark is not permitted because it could be seen as a monopoly of the colour in a particular industry. If an application relies on a colour only, then the application is defective because a colour alone cannot constitute a trademark: *Wampole & Co. v. Hervay Chemical Corp. of Canada*, (1929) Ex.C.R. 78, *aff'd.* (1930) S.C.R. 336.

However, it is possible to register the coloration of a specific product, as an example TMA 346,453 which consists of the colour blue applied on the whole of the visible surface of a tablet. A colour might constitute a trademark, if the colour is only one feature of the mark (as applied to the surface of a tablet of a particular size and shape): *Smith Kline & French Canada Ltd. v. Registrar of Trade-marks*, (1987) 2 F.C. 633, 636 (F.C.T.D.).

The technicalities of the application form are very important when it comes to the description of the colour as a trademark. Especially in opposition proceedings, where the Registrar has no discretion to amend an application by changing it after it has been advertised: paragraph 37(a) of the *Regulations*.

The integrity of the Register is a crucial element. An adequate and accurate advertisement prior to the registration of a trademark, would undermine whether to oppose the registration of a mark that might jeopardise some interests: *McDonald's Corp. v. Registrar of Trade-Marks* (1989), 24 C.P.R. (3d) 463-466 (F.C.A.). There is an important public interest in ensuring the integrity of the Register as a record on which individuals can rely in order to know with certainty the precise scope of the monopoly asserted through the trademark.

#### SHAPE AND SIZE:

In addition, in Canada, it is possible to register a particular shape or appearance of a product as a “distinguishing guise”. A distinguishing guise is

defined by section 2 of the *Trade-Marks Act* as: “ a shaping of wares or their containers or a mode of wrapping or packaging wares or the appearance of which is used by a person”. The appearance of the wares must serve to distinguish the wares of the applicant from the wares of others.

If a particular shape of a tablet fits in the definition of a distinguishing guise, the owner would have no choice but to register it as a distinguishing guise. To obtain the registration of a distinguishing guise, the applicant must prove that the mark has acquired distinctiveness (date of filing) in a way that it has not limited the development of any art or industry.

## FLAVOUR:

In Canada, the registration of a flavour is still uncertain. Many authors and practitioners have debated the question. The problem lies in the fact that it would be difficult to describe the mark in an objective way. Unfortunately, it is practically impossible to describe a flavour objectively. In fact, there is no standard to describe a flavour or a mix of aroma.

Also, there is the question of “functionality” related to the flavour. In the pharmaceutical industry, flavours are used to cover up the bad taste of the medicinal ingredients. As said in Canada, we are still in a precarious stage about flavour registration but in United States, Mr. the judge Sutherland in the case *William R Warner & Co. v. Eli Lilly & Co.*, (1924) 265 U.S. 526 (S.C.) has stated that:

“the respondent has no exclusive right to the use of its formula. Chocolate is used as an ingredient, not alone for the purpose of imparting a distinctive colour, but for the purpose of also making the preparation peculiarly agreeable to the palate, to say nothing of its effect as a suspending medium. While it is not a medicinal element in the preparation, it serves a substantial and desirable use, which prevents it from being a mere matter of dress. It does not merely serve the incidental it shall be called nonessential”

There is also the question of the “use” of a flavour. How can you prove that the flavour is used when the consumers will taste it after the transfer?

## CONCLUSION

We have seen therefore that in Canada certain hurdles still exist in respect of the obtaining of additional trademark protection through colours, shapes and

flavour. However, it is also fairly clear that the Courts and the Legislator have become increasingly open to allowing for protection and 'value-added' through the use of distinguishing elements other than traditional words and designs.

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<sup>i</sup> Iver P. COOPER, “Trademark Aspects of Pharmaceutical Product Design”, (1980) 70 *Trademark Reporter* 1, at page 99