

## Legal Issues - Seminar Series

### Legal Issues in ‘Pharmaceutical-Trademarks & Marketing-Regulatory Approvals; Drugs’

Issue: Can distinctiveness of pharmaceutical drugs be claimed on the basis of shape or colour?

## Related Provisions

### ❖ Section 2(m), Trade Marks Act, 1999

#### “ 2. Definitions and interpretation

*(m) "mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof... ”*

### ❖ Section 2(zb), Trade Marks Act, 1999

#### “ 2. Definitions and interpretation

*(zb) "trade mark" means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours... ”*

## Related Provisions (Contd.)

### ❖ Section 9 (1), Trade Marks Act, 1999

*“9. Absolute grounds for refusal of registration*

*(1) The trade marks –*

*(a) which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person;*

*(b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service;*

*(c) which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade,*

*shall not be registered:*

*PROVIDED that a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark.”*

## Related Provisions (Contd.)

### ❖ Section 9 (3), Trade Marks Act, 1999

*“9. Absolute grounds for refusal of registration*

*(3) A mark shall not be registered as a trade mark if it consists exclusively of –*

*(a) the shape of goods which results from the nature of the goods themselves; or*

*(b) the shape of goods which is necessary to obtain a technical result; or*

*(c) the shape which gives substantial value to the goods.”*

## Relevant Judicial Decisions

- ❖ *Pfizer Products Inc. Vs. B.L. & Company And Ors. [2002(25)PTC262(DEL), High Court of Delhi, Judgement dated April 10, 2002]*

“68. ..the plaintiff has not launched its product in India so far. It has no business in India. It has not advertised its product in India. Therefore, although the Indian public may know about the 'wonder drug - VIAGRA' and its use, **most of the people would not have any knowledge about its trade dress.** Most of the people would not have seen this drug. It could be that some of the Indians while going abroad would have bought this drug or some may have bought the same in the grey market in India as claimed by the plaintiff...Persons belonging to such category would, however, be marginal and insignificant, when compared to the vast segment of people requiring and/or in need of this drug. In any case even **those persons who have read the description of VIAGRA as blue diamond shape tablet (without seeing the same) would now have the defendant's drug in totally different colour (it being changed to pink).** Therefore, the alleged confusion, if any, on his ground does not survive. Therefore, this trade dress may not be of much consequence while examining the aspect of "misrepresentation".” (emphasis supplied)

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## Relevant Judicial Decisions (contd.)

❖ *Cipla Ltd Vs M.K. Pharmaceuticals [MIPR [2008(36)PTC166(DEL)], High Court of Delhi, Judgement dated July 23, 2007]*

“5. ...whether defendant can copy the colour of the plaintiff's tablets and shape of the plaintiff's tablets. It is settled law that there can be no monopoly over colours...The medicines are not bought by colours by the customers. There are thousand types of tablets available with Chemist for different ailments. No one goes to a chemist and asks for red, blue, orange, peach or white colour of tablets. **All medicines are purchased at the advise of Doctors and they are sold on prescription. ...Even those tablets readily available without prescription, are known by their names.** You will not find any manufacturer advertising his tablets by colour or shape. Even the common brands Crocin, Anacin, Disprin, Coldarin etc. are sold by name and not by shape or colour of the tablets... Neither colour of the tablet can be associated with any brand...” (emphasis supplied)

## Relevant Judicial Decisions (contd.)

❖ *Cipla Ltd Vs M.K. Pharmaceuticals [MIPR [2008(36)PTC166(DEL)], High Court of Delhi, Judgement dated July 23, 2007]*

“5...Shape of the tablets is not associated either with the quality of the tablets or with the nature of medicine. Most of the tablets are made round, oval or cylindrical shape so that they are easy to swallow... It cannot be said that because the shape of the plaintiff tablets and defendant’s tablets being oval, it was going to create confusion in the minds of the customers... **The distinctiveness of the medicines is in the name and not in the colour and shape.** Even if there has been deliberate copying of similar colour and shape of the plaintiff's tablets that would not amount to passing off, since **colour and shape are not indicative of the drugs neither they are associated with the trade mark...**” (emphasis supplied)

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## Relevant Judicial Decisions (contd.)

❖ *Ranbaxy Laboratories Limited Vs M/S Cipla Limited [2008:DHC:3352], High Court of Delhi, Judgement dated December 16, 2008]*

“5. The above decision deals with the same product of the plaintiff/respondent. It also deals with an identical grievance, albeit regarding another manufacturer. There, the manufacturer was M/s M.K. Pharmaceuticals. Here, the manufacturer is the appellant - M/s Ranbaxy Laboratories Ltd. There is no other difference. The issue in this appeal is thus squarely covered by the ratio of the decision in the aforesaid judgment of M/s Cipla Limited (supra). Consequently, the interim order passed by this Court on 21st April, 2004 is made absolute...”



## Relevant Judicial Decisions (contd.)

- ❖ *Alkem Laboratories Limited Vs. Elnova Pharma [(CVT/5298/2014 HPHC), High Court of Himachal Pradesh, Judgement dated March 12, 2015]*

“27. ...it is to be remembered that no trader by adopting and using a particular style of get-up acquires a right to prevent a rival or second trader using the same or similar get-up, unless the get-up of the first trader has become so associated in the minds of the public with the first trader's goods as to be distinctive of the goods of the first trader and of no other. There is nothing to stop one trader simply copying the design or get-up of another, in the absence of protection afforded by copyright or a registered trade mark. Merely, being first in the field does not confer any right. But, then it is not to suggest that a competitor is permitted to use or imitate that design, so that it "represents its goods as the goods of somebody else. What the law seeks to protect is the goodwill of the latter's business and not simply the proprietor's right to use the design or mark. Therefore, the basis question is whether, directly or indirectly the manner in which the goods of the respondents are presented to the relevant consumer are such as to convey to the minds of the latter of impression that they are the goods of the applicant...”

## Relevant Judicial Decisions (contd.)

- ❖ *Alkem Laboratories Limited Vs. Elnova Pharma [(CVT/5298/2014 HPHC), High Court of Himachal Pradesh, Judgement dated March 12, 2015]*

*“27. ...In an “appearance” or get-up case it is not enough simply to say that the former are very like the latter. It must be established that the consumers have, by reason of the appearance of the goods of the applicant, come to regard them as having the same trade source or provenance, whether are manufacturing or marketing, though it matters that they have no idea at all of the identity of the trade source or provenance. It is not necessary that the applicant's design should be novel, provided that the get-up is distinctive of the applicant's goods and has been identified with them.”*

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## Conclusion

- ❖ The current position is to consider various factors in determining the distinctiveness of pharmaceutical drugs based on shape or color
- ❖ While shape and color can potentially contribute to the distinctiveness of a product, they may not always be sufficient on their own to establish distinctiveness.
- ❖ For a pharmaceutical drug to be considered distinctive, it must have acquired secondary meaning in the eyes of consumers.

# THANK YOU!

## Questions?

**Madhulika Tyagi**, Trainee Associate

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