

The Little Blue Pill: A Look at Nonconventional Trademarks for Pharmaceuticals in the UAE

Sadaf Nakhaei

s.nakhaei@tamimi.com - Dubai, UAE

The debate over pharmaceutical trade dress protection is heated. From one standpoint, generic companies argue that brand name pharmaceutical companies are hiding under the auspices of trade dress rights for products that are no longer subject to patent protection and should be considered part of the public domain. On the other side of argument, brand name pharmaceutical companies argue that, for the period of the patent protection, usually 20 years, they have had market share of the product, therefore, they should be allowed to extend the longevity of their protection through other forms of intellectual property ('IP') and to maintain the goodwill already associated with their product.

It is common knowledge that a trademark is a name or logo associated to a company which allows consumers to identify the product. Trade dress rights, on the other hand, can be identified as any material quality of a product or its physical appearance that serves as a brand identifier. Such physical aspects of the products can include its shape, colors and even textures. It can be argued that trade dress rights, in general, protects the overall appearance of an object when the object is intended as source identifier. Although the term 'trade dress' is not defined in the UAE trademark law, the definition of trademarks in the UAE law broadly includes certain elements qualifying such as trade dress. These include sounds, colours and shapes. In practice, trade dress rights in the UAE are commonly referred to as nonconventional trademarks. In order to be able to secure a trade dress or nonconventional trademark protection for pharmaceuticals, the applicant must demonstrate that consumers have come to associate the physical attributes of the pharmaceutical, such as colour, size and shape, with the manufacturer. Trade dress, or nonconventional trademarks, do not, however, protect functional elements. A product feature is considered functional if the product would not work properly without that element or if that element affects the cost or quality of the product.

As it applies to the pharmaceutical industry, legal protection extending beyond patents is even more important especially amid increasing concerns about counterfeit drugs which copy the appearance, packaging and name of brand name pharmaceuticals. It can be further argued that the protection allowed through trade dress, or nonconventional trademarks, serves as a public function meant to protect consumers from deception by the producers of look-a-like drugs.

In addition to the threats of counterfeit pharmaceuticals and the need to enforce nonconventional trademarks with regards to such products, there is also the argument that consumers need to be able to identify the brand by the appearance of the pills. One of the first drugs to be promoted heavily to consumers based on the unique colour and shape of the drug was Viagra produced by Pfizer. Pfizer widely advertised the appearance of the pill, which served to identify Viagra by both the pale blue colour and the diamond shape of the tablets. Given Pfizer's continued and long term efforts in advertising the appearance of the Viagra pill, consumers over the years have recognised and commonly referred to the product as 'the little blue pill'. Due to Pfizer's marketing campaign and the massive publicity surrounding the product, Pfizer was able to establish before the registering authority that consumers were able to identify Viagra as one being produced by Pfizer by the pale blue color and diamond shape of the pill. The massive advertising of the product and the product awareness amongst consumers made it easier for Pfizer to claim that the look of the pill was protectable. In view of Pfizer's registrations, generic drug makers are prevented from using the appearance of the Viagra pill (diamond shape in combination with the pale blue color) for their generic products. It can be further argued that the color, shape and size of a pill are directly related to the

drug's potency, as such, maintaining a constant color and size between the actual product versus the generic product would promote patient safety.

In conclusion, to satisfy that there is trade dress right, a manufacturer must demonstrate that the color and shape of the product can be linked to the manufacturer of the tablets. As a practical matter, pharmaceutical manufacturers desiring trade dress protection for their products must carefully select and cultivate that trade dress. As discussed above, one way to attain this threshold is by investing in promotional campaigns that will cause consumers to associate the look of the pill with the particular source. In fact, given the increase in the trend of patient-directed advertising, many companies are investing a significant part of their budget on creative marketing campaigns, which can help to establish trade dress rights.