

Webinar Global Brand Protection

Usefulness of Trademark in Biopharma. US v EU.



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Qualitex Co. v. Jacobson Products Co., 514 U.S. 159 (1995),

Qualitex Company used a combination of green-gold on its dry cleaning press pads.

With more efforts and resources spent on the advertisement of Qualitex's products, emphasizing the green-gold combination, the color combination had become a distinctive feature of Qualitex's products. Qualitex registered the green-gold color as a trademark.

Jacobson Products, a competitor, began using a similar shade on its press pads.



Qualitex filed a trademark infringement lawsuit against Jacobson.

The 9th Circuit held that the Lanham Act, did not permit the registration of a color alone as a trademark.

Qualitex Co. v. Jacobson Products Co., 514 U.S. 159 (1995),

1. **The Lanham Act is permissive:** Trademarks are broadly defined. The list of exemplary trademarks includes a wide range of symbols *e.g.*, colors. It should not be read narrowly.
2. **Identification and Distinction:** Qualitex's green-gold color met the basic requirements for a trademark. It served to identify and distinguish Qualitex's goods from those of others and to indicate their source.
3. **Secondary Meaning:** The green-gold color had developed a secondary meaning; customers associated it with Qualitex, thereby identifying the source of the press pads.
4. **Non-Functionality:** The color was not functional, meaning it did not offer a utilitarian advantage.

In re Forney Industries

The Federal Circuit held that:

--multicolor marks can be inherently

distinctive and thus may not require evidence of acquired distinctiveness to be registered; and

--multicolor marks need not be used within a well-defined shape or border in order to be eligible for trademark protection.



Which is More Valuable, patents vs trademarks?

Both are important.

International enforcement is a key for brand pharmaceuticals. That is one reason trademarks are very useful.

US vs EU?

Both are important.

International enforcement is a key for brand pharmaceuticals.

Should cover important markets and important production sites.

Gray Market Products in US

Abbott Lab v. Adelpia Supply USA, 2024 WL 4250223 (E.D.N.Y. Aug. 22, 2024).

Defendants infringed Abbott's trademarks by selling international version of diabetes strips in US

Differences in the packaging labels and other descriptions on each item (such as National Drug Code number) approved by FDA are material.

Permanent injunctions against 57 defendants and large-figure damages awards against 28 defendants

Injunction: *eBay, Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 391 (2006).

Irreparable injury;
Legal remedies are inadequate;
Balance of hardships; and
Public interest.

Gray Market Products in EU

Perfumesco.pl sp. z o.o., sp. k. v Procter & Gamble International Operations SA, European Court of Justice (Case C-355/21)

Procter & Gamble was the exclusive licensee of the HUGO BOSS mark.

In Poland, online seller Perfumesco.pl sold “testers,” the description of which said that these products smell the same as the full-size product.

The defendant also sold products that had been placed on the market outside the territory of the EEA (gray market products), and products with tempered barcodes.

Gray Market Products in EU

Perfumesco.pl sp. z o.o., sp. k. v Procter & Gamble International Operations SA, European Court of Justice (Case C-355/21)

The Polish court ordered the destruction of the seized goods.

The Polish Supreme Court decided to ask the ECJ whether the destruction measure should only include pirated goods or also genuine goods from the grey market.

Article 10(1) of Directive 2004/48 (Enforcement Directive)

Can order “destruction” of goods to “enforce intellectual property rights.”

Gray Market Products in EU

Perfumesco.pl sp. z o.o., sp. k. v Procter & Gamble International Operations SA, European Court of Justice (Case C-355/21)

ECJ held:

All goods found to infringe any intellectual property rights are covered by Article 10 Directive 2004/48 without excluding destruction in the case of any of those infringements.

Gray market products are unlawfully imported into the EEA and may be destroyed.

Gray Market Products in EU

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A judge can weigh the seriousness of the infringement against the remedies ordered, as well as the interests of third parties.

The EU rules on exhaustion apply in the entire EEA)

Territoriality

US patents

- **Can only be enforceable in the United States**
- **Can seek damages based on infringement in the United States**
- **USPTO issues US patents**

Foreign patents

- **Can only be enforceable in foreign jurisdictions**
- **Damages usually based on infringement in foreign countries**
- **Foreign patent offices issue foreign patents**