Size, Shape, and Color of Prescription Drugs: What Scope of Protection?

Kathleen M. Sheahan

Follow this and additional works at: http://lawecommons.luc.edu/luclj

Part of the Health Law and Policy Commons, and the Medical Jurisprudence Commons

Recommended Citation

Available at: http://lawecommons.luc.edu/luclj/vol13/iss1/8
Size, Shape, and Color of Prescription Drugs: What Scope of Protection?

INTRODUCTION

Prescription drugs play a critical role in modern medicine, complementing the many other procedures and techniques used by physicians to diagnose, treat, cure, or prevent various illnesses or conditions. They have become an essential tool for the physician in the administration of medical care.

Prescription drugs also have major economic consequences for the American consumer. Yet, as captive consumers, patients have little choice regarding which products they buy or what prices they pay. Product choice has already been determined by the physician when a prescription for a certain drug is written. The price of the drug is heavily influenced by the degree of competition in the pharmaceutical industry.

During the last twenty years, industry marketing practices have been criticized as minimizing competition. Generic drugs hold the promise of encouraging competition while reducing consumer costs and maintaining high quality. The passage by many states of substitution laws has encouraged the growth of this generic drug industry. With the growth, however, many problems have arisen.

2. Id.
5. The term “generic equivalent” is misleading. A generic name merely identifies the specific active ingredient, e.g., penicillin. Almost no generic substances are suitable for human use without being combined with various inert ingredients during the manufacturing process. These additives, such as lubricants and binders, are not identified by the generic term, but they can significantly influence the therapeutic effect of the drug. Office of Technology Assessment, Drug Bioequivalence Study Panel, Drug Bioequivalence 27 (1974) [hereinafter cited as OTA Report].
6. In response to the movement to promote the use of generic drugs, laws permitting and
encouraging generic substitution have been enacted in many states. See, e.g., ALASKA STAT. §§ 08.80.010-80.490 (Supp. 1980); ARK. STAT. ANN. §§ 72-1001 to 1061 (1979); CAL. BUS. & PROF. CODE § 4047.6 (West Supp. 1981); D.C. CODE ANN. § 33-732 (1981); N.Y. EDUC. LAW § 6816-a (McKinney Supp. 1980).

For many years, most states have had anti-substitution laws prohibiting the substitution of one drug for another in filling a prescription. For example, in 1972, forty-seven states had anti-substitution laws. See Green, Welfare Losses from Monopoly in the Drug Industry: The Oklahoma ‘Antisubstitution’ Law, 5 ANTITRUST L. & ECON. REV., No. 3, 108 (1972). Drug manufacturers therefore aimed their advertising at physicians, hoping to influence them to prescribe by brand-name thereby precluding pharmacists from substituting either another brand-name drug or a generic. See Note, Consumer Protection and Prescription Drugs: The Generic Substitution Laws, 67 KY. L.J. 384, 390 (1978-79) [hereinafter cited as Generic Drug Laws]. The advertising was successful; by 1972 approximately ninety percent of all prescriptions were written for brand-names. See Note, Product Liability for Prescription Drugs - The Effects of Generic Substitution on the Consumer and the Pharmacist, 23 SYRACUSE L. REV. 887, 888 (1972). However, the cost of the advertising was reflected in the higher prices of brand-name drugs and the use of generics seemed a good way to reduce costs to consumers. See Generic Drug Laws, supra this note, at 390. Between 1972 and 1979, 31 states and the District of Columbia repealed their anti-substitution laws and enacted various types of laws permitting substitutions. Id. at 395. Most of these laws encourage the pharmacist to substitute a lower cost “generic equivalent” and require that the consumer be notified of the substitution. Id. at 404-405.

Drug substitution has been vigorously supported by federal agencies. In 1976, the Department of Health, Education and Welfare (now Department of Health and Human Services) adopted Maximum Allowable Cost (MAC) Regulations which provide that the maximum amounts reimbursed to persons covered by federal health programs, such as Medicare and Medicaid, would be limited to the lowest costs at which “chemically-equivalent” drugs were generally available, thus obligating the patient to pay the difference if his physician prescribed a higher-priced brand-name. 45 CFR § 19.1-19.6 (1980). These regulations were implemented despite the fact that a government drug study confirmed that significant variations in bioavailability could exist between drug products sharing the same physical and chemical compositions. B. MacKimm, A Letter from the Publisher, MEDICAL WORLD NEWS 9 (September 6, 1974).

The FTC, while not recommending any rulemaking proceeding at the present time, has prepared a Model Product Selection Act in conjunction with the FDA to help the states frame effective substitution laws. McCarey, Generic Substitution Policy, 34 FOOD, DRUG, COSM. L.J. 103, 104 (1979) [hereinafter cited as McCarey]. In addition, it has recently launched a multi-media campaign aimed at encouraging consumers to ask pharmacists about using generic drugs. 43 FDC REP. 17, at T & G-1 (Apr. 27, 1981).

In 1978, the FDA lent the full weight of its support to the substitution movement. The FDA assisted the state of New York, which had passed substitution legislation, in preparing a list of approximately 2,500 generic drug products considered to be “therapeutically equivalent” to their higher-priced brand-name counterparts. Ball, Jr., Government versus Trademarks: Today - Pharmaceuticals, Realemon and Formica - Tomorrow?, 68 TRADEMARK REP. 471 (1978) [hereinafter cited as Ball]. The FDA was careful to emphasize that the term “therapeutically equivalent” should not be confused with “interchangeability,” that the two terms were not synonymous, and that the agency would not certify their interchangeability. When the New York list was published, however, it was titled “Safe, Effective and Interchangeable Prescription Drugs.” Id. at 479 n. 37.

Unfortunately, many of these substitution laws have not been as successful in reducing costs to consumers as had been hoped and forecast. A consensus seems to be developing...
issue: whether it is legal to allow generic drug manufacturers to copy the size, shape, and color of brand name prescription drugs or whether such copying constitutes unfair competition, false designation of origin, or counterfeiting. Controversy and confusion over this question continue unabated in the courts, in Congress, among both government officials who most vigorously supported generic drugs and organized consumer groups who have been disappointed. A survey reported in the Washington Post in July, 1980, revealed that substitution laws in Virginia, Maryland and the District of Columbia have provided only marginal savings for consumers and major profits for drugstores. Washington Post, July 28, 1980, at Al, col. 2. An evaluation of the New York generic substitution law revealed that savings were not passed on to consumers in 29% of the post-law purchases of generic substitutions and that extensive comparison shopping was required to assure maximal savings. Francetic, Lasagna, Weintraub and Karch, Prescription Prices Under the New York Generic Substitution Laws, 92 ANN. INT. MED. 3, at 419-23 (March, 1980).

However, as more consumers, physicians and pharmacists become familiar with the options provided by these laws and the possible cost-savings of generic products, more competitive pricing among brand-name and generic manufacturers will hopefully follow.

For further discussion, see Ruggieri, Manufacturers View of Generic Substitution Legislation, 34 FOOD, DRUG, COSM. L.J. 108, 111 (1979).

7. An example of a look-alike problem is illustrated by Ives Laboratories, Inc. v. Darby Drug Co., 601 F.2d 631 (2d Cir. 1979). Plaintiff Ives developed the drug cyclandelate, which is marketed under the brand-name Cyclospasmol. It is available in two dosages: one is in a pale blue capsule and the other is in a red and blue capsule. Defendant manufacturers copied and marketed their version of cyclandelate in capsules, using colors essentially identical to Ives. The problem is not defendant manufacturers' copying the drug itself, but in selling it in the same capsule shape and colors as the Ives product.

The look-alike problem has recently emerged with serious consequences in another context. Distributors are selling tablets and capsules colored to make them look like amphetamines and other controlled substances, but which in fact contain dangerously high levels of caffeine and antihistamines. These look-alikes have been responsible for killing six women and teenagers in Illinois in less than a year. Chicago Sun-Times, Sept. 29, 1981, at 12, col. 1.

8. A drug ordinarily has three names: the chemical name which describes the structure of the drug in chemical terms; a generic name which indicates the chemical class to which the drug belongs; and the brand-name which is the name adopted by the manufacturer and registered as a trademark. See REMINGTON'S PHARMACEUTICAL SCIENCES 1309 (15th ed. 1975). The brand-name manufacturer does all the research and development of the drug and the so-called generic manufacturer uses that data and manufactures a generic product.


11. See Report of the Committee on S.1075, supra note 3, at 10-16. (History and pur-
various government agencies,\textsuperscript{12} and in the pharmaceutical industry.\textsuperscript{13} The issue is a difficult one because there are valid arguments on both sides.\textsuperscript{14} The policies designed to encourage competition directly collide with policies in favor of consumer protection and encouragement of new product development.\textsuperscript{15}

This article will trace the historical background of the "look-alike" controversy, including the impact of two Supreme Court unfair competition cases\textsuperscript{16} on the state and common law of trademark and unfair competition. The potential statutory protection for size, shape, and color in the Lanham Act will be discussed. Finally, the public policies in favor of trademark protection and against such protection will be surveyed.
DEVELOPMENT OF COMMON LAW PROTECTION

The look-alike controversy has developed in suits alleging trademark infringement and/or unfair competition under common law and state statutes. Early cases reveal judicial antipathy to protection for color or shape. Protection has traditionally been accorded only to marks identifying the producer and the court has allowed features of a competitor's product which were primarily associated with the product, rather than the producer, to be copied at will, requiring only that the copier identify the product as its own. In denying protection to size, shape, and color, however, courts relied on the color-depletion theory, believing that the limited number of colors and shapes risked appropriation by a few producers, thus creating monopolies and inhibiting competition. A general rule

17. While there are distinctions between trademark law and unfair competition law, the law of trademarks is in fact but a part of the greater law of unfair competition. See Hanover Star Milling Co. v. Metcalf, 240 U.S. 403, 412-13 (1915). See also J. Hopkins, The Law of Trademarks, Tradenames and Unfair Competition § 22 (4th ed. 1924); Recent Developments, supra note 9, at 5.

Trademark protection is derived from the common law; today the common law still remains the basic source of doctrines designed to protect trademarks even where trademark registration statutes have been enacted. E. Kitc and H. Perlmans, Legal Regulation of the Competitive Process 283-84 (2d ed. 1979). Under the common law, trademarks come to signify those marks or devices adopted and used by a producer which were arbitrary and distinctive enough to identify the producer's goods. Id. at 288. These requirements have been codified in the Trademark Act of 1946, 15 U.S.C. §§ 1051-1157 (1976) [hereinafter cited as the Lanham Act].


The rule of unfair competition in the product simulation context has been stated as: "The copying of (1) nonfunctional features of an article which (2) have acquired secondary meaning, with (3) a resulting confusion as to source or origin, constitutes unfair competition and will be enjoined by the courts. This is the majority rule reduced to its simplest formula. (citations omitted)" Pollack, Unfair Trading by Product Simulation: Rule or Rankle?, 23 Ohio St. L.J. 74, 76 (1962).

19. See Leschen Rope Co. v. Broderick, 201 U.S. 166 (1906) (courts don't favor monopolizing color); Lucien Lelong, Inc. v. Lenel, Inc., 181 F.2d 3 (5th Cir. 1950) (no trademark rights attached at common law to shape of goods); Campbell Soup Co. v. Armour & Co., 175 F.2d 795 (3d Cir. 1949) (if one manufacturer allowed to monopolize red, others will monopolize the rest and the list of colors will soon run out); Diamond Match Co. v. Saginaw Match Co., 142 F. 727 (6th Cir. 1906) (only a few primary colors and, if protected here, the rest will soon be appropriated); Harrington v. Libby, 11 F. Cas. 606 (S.D.N.Y. 1877) (shape not recognized as a trademark).

In 1958 Haig and Haig was allowed to register their pinched-shaped whiskey bottle as a trademark. Ex parte Haig & Haig Ltd., 118 U.S.P.Q. 229 (1958). The Commissioner based the decision solely on the fact that the bottle had acquired secondary meaning. Id. at 230-31.
emerged that size, shape, and color would be protected only if those features were nonfunctional and had acquired secondary meaning. Both elements must be shown to obtain trademark protection. These trademark concepts have filtered into the law of unfair competition, as well, and must be shown to claim this protection.

Functional features include those which affect their purpose, action or performance, or the facility or economy of processing, handling or using them. The nonfunctionality requirement prevents a producer from gaining the equivalent of a perpetual common law monopoly or patent. Functional features, therefore, unless otherwise protected, may be copied at will.

Secondary meaning, although an elusive concept, may be described as a word or device initially considered to be merely descriptive of a product, but which, through exclusive use and pro-

The "color depletion" argument has been found unpersuasive in recent cases, as well. See Marion Laboratories, Inc. v. Michigan Pharmacal Corp., 338 F. Supp. 762, 768 (E.D. Mich. 1972) ("Plaintiff introduced a color wheel provided by Eli Lilly & Co. to illustrate the color combinations available for capsules from which it appears that as many as 12,000 color combinations are available."); Ives Laboratories, Inc. v. Darby Drug Co., 601 F.2d 631, 643 (2d Cir. 1979) ("[A]n endless number of color combinations was available to the defendants.").

20. See also William R. Warner & Co. v. Eli Lilly & Co., 265 U.S. 526 (1924) (chocolate ingredient in quinine product not nonfunctional); Norwich Pharmacal Co. v. Sterling Drug, Inc., 271 F.2d 569 (2d Cir. 1959) (pink color of Pepto Bismol may be functional for its psychological effect); Upjohn Co. v. Schwartz, 246 F.2d 254 (2d Cir. 1957) (size and color found functional); Ross-Whitney Corp. v. Smith, Kline & French Laboratories, 207 F.2d 190 (9th Cir. 1953) (heart shape of amphetamine tablet found to be nonfunctional and to have acquired secondary meaning); Smith, Kline and French Laboratories v. Heart Pharmaceutical Corp., 90 F. Supp. 976 (S.D.N.Y. 1950) (shape and color of drug nonfunctional and had acquired secondary meaning).

The yellow of sulphur, the blue of cupric sulfate, and the vivid red of mercuric iodide are inherently colored, however, and cannot be appropriated as trademarks. Cooper, Trademark Aspects of Pharmaceutical Design, 70 TRADEMARK REP. 1, 9 (1980) [hereinafter cited as Cooper.]


22. RESTATEMENT OF THE LAW TORTS § 742, Comment a (1938). See also Pagliero v. Wallace China Co., 198 F.2d 339 (9th Cir. 1952) (nonfunctional means not important to a product's commercial success); Filter Dynamics Int'l., Inc. v. Astron Battery, Inc., 19 Ill. App. 3d 299, 311-12, 311 N.E. 2d 386 (1974). (functional features include those which contribute to the efficiency or economy of a product and those which contribute to the product's utility, durability or effectiveness).


24. One source of protection is the patent laws, which can be found in chapter 35 of the United States Code.
motion has come to indicate the source of a product. Where a particular word or device has come to indicate the source of a product, it is possible that consumers will be confused if another manufacturer were allowed to use the same word or device on its product. Protection of products that have secondary meaning, therefore, reduces potential consumer confusion. Generally, only a likelihood of confusion, and not proof of actual confusion, is required to satisfy a showing of secondary meaning.

Even where nonfunctionality and secondary meaning/likelihood of confusion could not be shown, courts have granted protection where plaintiff could show that defendant had engaged in selling its goods as those of plaintiff, referred to as “palming off.” In the prescription drug context, “palming off” has been found not only where a generic manufacturer actively persuaded pharmacists to covertly substitute its product for the brand name drug, but even where the mere suggestion to substitute was made.

In 1964 the Supreme Court decided two cases which have had a profound effect on the common law of unfair competition. In *Sears, Roebuck & Co. v. Stiffel Co.*, Stiffel had obtained design patents on its floor-to-ceiling pole lamp. When Sears marketed a substantially identical lamp at a much lower price, Stiffel brought suit against Sears for patent infringement under federal law and for unfair competition under Illinois law. The district court held the patents invalid, and therefore did not discuss the federal claim. The court continued, however, to find that Sears had violated the Illinois law of unfair competition because the lamps were substantially identical to Stiffel's lamps and confusion was likely to oc-
The court of appeals affirmed, holding that, under Illinois law, there was no need to show that Sears had been "palming off" its lamps as Stiffel's; Stiffel only had to show a likelihood of confusion as to the source of the product.\(^3\)

The Supreme Court reversed, finding the Illinois law of unfair competition incompatible with the federal patent law and, therefore, preempted.\(^3\) The Court held that where federal patent law permits copying, the mere inability of the public to distinguish between two identical articles is not sufficient to support an injunction against copying or an award for damages for copying under state laws of unfair competition.\(^3\) The Court specifically stated, however, that a State may require labeling or other precautions to prevent consumers from being misled as to source.\(^3\) In addition, the Court recognized that a State may protect trademarks, labels, or distinctive dress in the packaging of goods to prevent others from imitating these features and misleading purchasers.\(^3\) However, the Sears Court would allow any product itself not protected by federal patent laws to be freely copied as long as it was properly labeled.

Compco Corp. v. Day-Brite Lighting, Inc.,\(^3\) was decided the same day as Sears. In that case, Day-Brite, a manufacturer of fluorescent lighting fixtures, had obtained design patents on a light fixture. When Compco began marketing very similar fixtures, Day-Brite brought suit alleging patent infringement under federal law and unfair competition under Illinois law. The District Court, as in Sears, held the patents invalid, but found Compco guilty of unfair competition under Illinois law where Day-Brite's unique design identified it to the trade and the concurrent sale of the two products was likely to cause confusion.\(^3\) The Court of Appeals affirmed, on the ground that there was substantial evidence to support a likelihood of confusion, which was sufficient to support a finding of unfair competition under Illinois law.\(^3\)

The Supreme Court reversed, again finding the Illinois law of

---

30. 376 U.S. at 226.
31. 313 F.2d 115 (7th Cir. 1963).
32. 376 U.S. at 225.
33. Id. at 232.
34. Id.
35. Id.
37. 376 U.S. at 235.
38. 311 F.2d 26 (7th Cir. 1962).
unfair competition preempted by federal patent law. The Court again held that, although the trial court had found that the design had acquired secondary meaning, the design could be copied at will if it was not entitled to patent or other federal statutory protection. The Court seemed to go further than they had in Sears, stating that even if a design feature is nonfunctional and possesses secondary meaning, it is insufficient to furnish a basis for prohibiting copying. The Court also stated that, although a state may not prohibit the copying and selling of unpatented articles, it may require producers who make and sell copies to label accurately as to source.

The sweeping language of these two decisions has been a source of much comment. These cases were thought to overrule much of the traditional law of unfair trade. Sears and Compco were generally perceived as having a drastic effect on the entire law of unfair competition.

Lower courts, however, have generally been reluctant to apply Sears and Compco rigidly to non-patent cases and, relying on two subsequent Supreme Court cases, have tended to limit their ap-

39. 376 U.S. at 234.
40. Id. at 238.
41. Id.
42. Id.
44. See, e.g., 3 R. CALLMANN, THE LAW OF UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES, § 60.4(a) (3d ed. 1969): "These startlingly disappointing companion decisions so revolutionized our thinking with respect to the law of unfair competition that almost every one of its previously accepted premises must now be re-examined." See also Derenberg, Product Simulation: A Right or A Wrong?, 64 COLUM. L. REV. 1192 (1964): "The roof had seemingly fallen in on a vast structure of federal and state precedents laboriously built up since the days of the Court's famous decision in the International News case."
45. Goldstein v. State of California, 412 U.S. 546 (1973) and Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470 (1974). In Goldstein, which dealt with the category of sound recordings which had been left altogether "unattended" by Congress, the Court found insufficient basis upon which to find a Congressional intent to preempt state protection of the recordings. Sears and Compco were distinguished on the ground that those cases dealt with the establishment of uniform federal standards of patentability. Kewanee held that a state's law of trade secrets was not preempted by the federal patent laws because patent law does not deal with trade secret law and the objectives of each of these laws do not necessarily conflict.

One commentator has asserted that, if the elements of the common law or state statute violation are different in kind from patent or copyright infringement, Sears and Compco will not be applicable, but will operate only "to preempt any rights [granted] under the
In the look-alike drug context, most courts have fashioned remedies based on palming off, thus avoiding the Sears-Compco limitations. The language in Compco indicates that the Sears-Compco doctrine refers only to preemption of state laws and is not addressed to rights which are granted or recognized under other federal laws. Thus, courts have also applied the traditional unfair competition standards of nonfunctionality and secondary meaning, which have been codified under federal law in section 43(a) of the Lanham Act, in affording protection against copying.

STATUTORY PROTECTION UNDER THE LANHAM ACT

Since Sears and Compco, protection against copying the product itself appears to be no longer available under common law or state unfair competition laws. Plaintiff, therefore, must seek relief against unprivileged imitation elsewhere. The Lanham Act provides for federal registration of a trademark which distinguishes the goods of the applicant from those of others. Trademark protection is afforded to the distinguishing mark that a seller affixes to his goods. Trademark registration, therefore, will not be

common law or statute's of a state that are equivalent to copyright or patent and that extend to works or articles coming within the scope of those federal laws. . . .” Dannay, supra note 43, at 142-43.

46. Dannay, supra note 43, at 143.

47. See Marion Laboratories, Inc. v. Michigan Pharmacal Corp., 338 F. Supp. 762, 769 (E.D. Mich. 1972), aff’d without opinion, 473 F.2d 910 (6th Cir. 1973) (the court noted that Sears and Compco specifically mentioned that palming off was an area where states can continue to impose liability under state unfair competition laws).


49. “If the design is not entitled to a design patent or other federal statutory protection. . . .” 376 U.S. at 238.

50. Dannay, supra note 43, at 144.

51. See SK&F v. Premo Pharmaceutical Laboratories, Inc., 625 F.2d 1055 (3d Cir. 1980); Ives Laboratories, Inc. v. Darby Drug Co., 601 F.2d 631 (2d Cir. 1979); Truck Equipment Service Co. v. Fruehauf Corp., 536 F.2d 1210 (8th Cir.), cert. denied, 429 U.S. 861 (1976). For an argument that federal unfair competition laws that use the same standards as the state laws that were found to frustrate the procompetition goals of federal patent laws are equally hostile to those goals, see Comment, Generic Drug Laws and Unfair Competition Claims Under the Lanham Act - An Uneasy Alliance: Ives Laboratories, Inc. v. Darby Drug Co., 33 Rutgers L. Rev. 227 (1980) [hereinafter cited as An Uneasy Alliance].


53. Section 32 of the Lanham Act provides the owner of a registered trademark with a right of action against
granted for a mark that is merely descriptive of a product\textsuperscript{54} or that is not indicative of the source of the product.\textsuperscript{55}

Although a particular color design or shape of a distinctive nature might be eligible for trademark registration,\textsuperscript{56} most look-alike drugs do not involve such features as have been traditionally trademarkable.\textsuperscript{57} Plaintiffs can, however, seek protection under Sections 32 and 43(a) of the Lanham Act.

\textit{Section 32 of the Lanham Act}

The protection afforded by section 32 is narrower than that conferred by section 43(a).\textsuperscript{58} It relates only to infringement of the trademark itself and thus would apply only to cases where the registered trademark or a confusingly similar one had been used by someone other than the registrant.\textsuperscript{59} For the large number of untrademarked capsules, therefore, this section appears to offer little protection.

Under the doctrine of contributory trademark infringement, however, one who actively shares a retailer’s infringement of the trademark is also liable under section 32.\textsuperscript{60} Despite the ostensible

\begin{itemize}
  \item Any person who shall, without consent of the registrant - (a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale . . . of any goods . . . with which such use is likely to cause confusion, or to cause mistake, or to deceive . . .
  \item 15 U.S.C. § 1114 (1976). See Ives Laboratories, Inc. v. Darby Drug Co., 601 F.2d 631 (2d Cir. 1979) (manufacturer would be liable under § 32 if it suggested, even if only by implication, that a druggist fill a bottle with the generic product and apply the brand name (trademark) to the label, or continued to sell the generic product that facilitated this to a druggist whom it knew or had reason to know was doing this).
\end{itemize}

54. Section 2 of the Lanham Act provides:

\begin{quote}
No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration . . . unless it . . . (e) Consists of a mark which, (1) when applied to the goods . . . is merely descriptive . . . of them. . . .
\end{quote}


56. For example, Lemmon Pharmacal’s color-specked tablets, Eli Lilly’s bullet-shaped capsules, and Parke-Davis’ color-banded capsules are federally registered trademarks. Cooper, \textit{supra} note 20, at 2.

57. Swenson, \textit{supra} note 25, at 361. To date, no U.S. trademark registration has been granted for a conventionally shaped tablet or capsule or a capsule merely using two different colors. \textit{Id.} at 361. \textit{But see} note 56 \textit{supra}.


59. \textit{Id.}

60. Contributory infringement has been found in cases where one places the infringing label on the goods before delivering them to the retailer. John B. Stetson Co. v. Stephen L.
requirement that the contributory conduct be active, some courts would find liability for contributory infringement where a manufacturer or wholesaler had only suggested that a retailer fill a prescription with the generic product and apply another's trademark to the label. Liability has been found even where the defendant merely sold the generic product which facilitated covert substitution to a pharmacist whom the manufacturer or wholesaler knew or should have known was engaging in such practices.

A recent Second Circuit decision, currently pending before the Supreme Court, is an example of this extended liability. In *Ives Laboratories, Inc. v. Darby Drug Co.*, the circuit court found that defendants' use of identically colored, look-alike drug capsules should have been reasonably anticipated to induce pharmacists to

---

Stetson Co., 85 F.2d 586 (2d Cir.), cert. denied, 299 U.S. 605 (1936) (if the defendant participates in the manufacture of hats which carry the infringing mark, it is an infringer of the trademark); Andrew Jergens Co. v. Bonded Products Corp., 21 F.2d 419 (2d Cir. 1927), cert. denied, 275 U.S. 572 (1928) (defendant is liable for contributory infringement even though it only manufactured the product which was deceptively sold as plaintiff's product which it knew plaintiff was manufacturing and selling). One who knowingly and deliberately instigates a retailer's infringement of the trademark is also liable. See *Stix Products, Inc. v. United Merchants and Manufacturers*, 285 F. Supp. 479 (S.D.N.Y. 1968).

61. *Upjohn Co. v. Schwartz*, 246 F.2d 254 (2d Cir. 1957) (sale by defendant manufacturer to a druggist, with the suggestion that the product sold could be substituted for a competitor's product, is itself a type of palming off); *Marion Laboratories, Inc. v. Michigan Pharmaceutical Corp.*, 338 F. Supp. 762 (E.D. Mich. 1972) (liability will be found if plaintiff can show that defendant suggested and encouraged the palming off of its product). See also *Smith, Kline & French Laboratories v. Clark & Clark*, 157 F.2d 725 (3d Cir. 1946).

62. *Ives Laboratories, Inc. v. Darby Drug Co.*, 638 F.2d 538 (2d Cir. 1981) (manufacturer liable if it continued to sell capsules containing the generic drug which facilitated passing off by a druggist whom it knew or had reason to know was engaging in such practices); SK&F Co. v. Premo Pharmaceutical Laboratories, Inc., 625 F.2d 1055 (3d Cir. 1980) (actionable for a drug manufacturer to put a product in the hands of a pharmacist in a form in which the manufacturer can reasonably anticipate that it may be passed off as another product even if the manufacturer does nothing else to encourage passing off); *A.H. Robins Co. v. Medicine Chest Corp.*, 206 U.S.P.Q. (BNA) 1015 (E.D. Mo. 1980) (anyone who puts goods into the hands of dealers for sale to the public which contain the means for deceiving purchasers, and/or which can be reasonably anticipated to so deceive, is subject to an injunction).


The Supreme Court has granted certiorari and will be asked to decide whether § 32 grants a trademark owner monopoly rights in the color(s) of its product; whether a manufacturer or wholesaler of generic drugs is liable for contributory trademark infringement based on a finding that the use of look-alikes assisted druggists in mislabeling and that they could reasonably have anticipated that the use of look-alikes facilitated such practice; and whether generic drug manufacturers and wholesalers should be enjoined from using the colors of a brand name drug product in manufacturing and marketing generics. 50 U.S.L.W. 3266 (Oct. 13, 1981).
covertly substitute the generic product for the trademarked brand-name drug. The generic manufacturers and suppliers had contributed, the court found, to the pharmacist's infringement of the brand name by packaging the generic product in look-alike capsules. Thus, although the section 32 remedy was designed to protect the trademarked name of the product, the holding has the effect of extending trademark protection to the size, shape, and color of brand-name drugs, even where such features are themselves not trademarked under section 32 of the Lanham Act.

Section 43(a) of the Lanham Act

Section 43(a) creates a federal statutory claim of unfair competition. It has been construed to include the imitation of any non-functional features of a competitor's product which have acquired secondary meaning. Elements necessary for recovery under the section 43(a) remedy are codifications of the common law of unfair competition: (1) the nonfunctional features must be shown to be so distinctive in design or general appearance as to identify the source of the product; (2) purchasers are induced to buy the product because of the identification of source; and (3) secondary meaning had already been established when the imitator introduced his copy to the public.

64. The court suggested that the simplest way to reduce illegal substitution and mislabelling would be to require that generic drugs be sold in a form which does not resemble the trademarked product. 638 F.2d at 545. The court reasoned that this would alert the consumer to the possibility that he or she has been given the generic when the doctor had specifically prescribed the trademarked product, as well as give notice that the lower cost of the generic should have been charged if that in fact was what was given. Id.
65. Id. at 543.
66. Section 43(a) provides:
   Any person who shall affix, apply, or annex, or use in connection with any goods or services, or any container or containers for goods, a false designation of origin, or any false description or representation . . . shall be liable to a civil action . . . by any person who believes that he is or is likely to be damaged by the use of any such false description or representation.
15 U.S.C. § 1125(a)(1976). See SK&F Co. v. Premo Pharmaceutical Laboratories, Inc., 625 F.2d 1055 (3d Cir. 1980) (§ 43(a) creates a federal statutory tort of unfair competition beyond simple trademark infringement and is broad enough to include the tort of unprivileged imitation, the imitation of any nonfunctional physical details of a competitor's product that have acquired a secondary meaning.)
68. 3 R. CALLMAN, UNFAIR COMPETITION, TRADEMARKS, AND MONOPOLIES, § 77.4(e)(2) (3d ed. 1969).
Color has traditionally been found to be essential to the commercial success of a product and, therefore, functional.\textsuperscript{69} A finding of functionality precludes protection of the color.\textsuperscript{70} A finding of functionality of color has been based on the argument that many elderly patients associate the appearance of the drug with its therapeutic effect and, therefore, refuse to take equivalent drugs in capsules of a different color.\textsuperscript{71} Others have argued, albeit unsuccessfully, that the size, shape, and color of drugs assist in identifying drugs in an emergency situation, and in identifying medications patients have previously taken.\textsuperscript{72} Several recent cases, however, have found that the color of the drug was nonfunctional, thus giving plaintiff an opportunity to show secondary meaning.\textsuperscript{78}

Secondary meaning necessary for trademark protection can be established by evidence of extensive sales and advertising.\textsuperscript{74} Often size, shape, and color of a drug are the sole means of identifying the producer.\textsuperscript{75} Most of the courts holding color non-functional

\begin{itemize}
\item \textsuperscript{69} See, e.g., William R. Warner & Co. v. Eli Lilly & Co., 265 U.S. 526 (1924); Norwich Pharmacal Co. v. Sterling Drug, Inc., 271 F.2d 569 (2d Cir. 1959); Smith, Kline & French Laboratories v. Clark & Clark, 157 F.2d 725 (3d Cir. 1946).
\item \textsuperscript{70} The court in In re Deister Concentrator Co., 289 F.2d 496 (C.C.P.A. 1961), held that functional features would not be registered under the Act, even if they had acquired secondary meaning. The Court of Customs and Patent Appeals found that the public's right to copy functional features was necessary in the interests of effective competition. \textit{Id.} at 504.
\item \textsuperscript{75} Even where the drug capsule is labeled as to manufacturer, logos would necessarily be so small as to be ineffective to prevent confusion as to source or passing off. See SK&F Co. v. Premo Pharmaceutical Laboratories, Inc., 625 F.2d 1055, 1061 (3d Cir. 1980).
\end{itemize}
have also found that the size, shape, and color had acquired secondary meaning.\textsuperscript{76}

The brand-name plaintiff must show not only that the size, shape, and color of the drug are non-functional and have acquired secondary meaning, but, in addition, that the buyer's motivation in purchasing the copy was caused by this confusion.\textsuperscript{77} This motivational element makes it more difficult to prove secondary meaning in an action for unfair competition than in a trademark infringement action, where there is no motivational element.\textsuperscript{78} Because of the unique practices involved in marketing prescription drugs, it is almost impossible to prove that the consumer was motivated by source association. In contrast to the normal buyer-seller relationship there are three parties involved in the purchase of a prescription drug: the physician, the pharmacist and the patient.\textsuperscript{79} Those who choose the product do not buy it and those who buy it do not choose it.\textsuperscript{80} Purchasers of prescription drugs are, in reality, captive consumers.\textsuperscript{81} Physicians decide what product to prescribe, in what quantity, and with what frequency.\textsuperscript{82}

The traditional standard of secondary meaning/likelihood of confusion, which focuses on purchaser motivation, seems therefore, inappropriate in the prescription drug context.\textsuperscript{83} Yet courts continue to apply this standard, even while noting consumer passiveness in purchasing these products.\textsuperscript{84} Some courts circumvent this element by finding a likelihood of confusion, even though it was

\begin{footnotes}

\footnotetext[77]{See American Footwear Corp. v. General Footwear Co., 609 F.2d 655, 663 (2d Cir. 1979), cert. denied, 100 S. Ct. 1601 (1980); Lucien LeLong, Inc. v. Lander Co., 164 F.2d 395 (2d Cir. 1947); Crescent Tool Co. v. Kilborn & Bishop Co., 247 Fed. 299 (2d Cir. 1917); Competitive Torts, supra note 21, at 912-913 (1964).

\footnotetext[78]{See Competitive Torts, supra note 21, at 911-912.

\footnotetext[79]{Swenson, supra note 25, at 362.

\footnotetext[80]{McCary, supra note 6, at 103.

\footnotetext[81]{1972 Hearings, supra note 1, at 2.

\footnotetext[82]{Id.

\footnotetext[83]{An Uneasy Alliance, supra note 51, at 255.

not the ultimate consumer who was likely to be confused. Courts are diluting the traditional standards of unfair competition resulting in protection of size, shape, and color. More appropriate standards by which to measure relief are therefore necessary.

POLICIES IN FAVOR OF TRADEMARK PROTECTION

Consumer's Right to Know

Patients today want more information about the drugs prescribed for them. A 1975 study, for example, found that a significant number of patients surveyed wanted to know the reasons for the drug’s use, and to be informed of the common risks involved, of the risk of over-dosage, under-dosage or not using the drug, and of other important issues regarding the drug. Public policy favoring protection of the consumer’s right to know is evidenced by the “duty to warn” of the risks associated with a drug, FDA ingredient labeling requirements, and the trademark laws themselves.

Look-alike drugs are, by definition, virtually indistinguishable from brand-name drugs. This prevents consumers from obtaining crucial information. For example, the basic premise of those advocating generic imitation, that all chemically equivalent drugs are qualitatively and therapeutically equivalent regardless of their source, has been vigorously challenged by the Pharmaceutical Manufacturers Association (PMA), physicians, and pharmacists. A government study on drug bioequivalency stated that well-documented and significant differences in bioavailability have been demonstrated in chemically-equivalent products. The danger in

85. See SK&F Co. v. Premo Pharmaceutical Laboratories, Inc., 481 F. Supp. 1184 (D.N.J. 1979) (allowed plaintiffs to show secondary meaning/likelihood of confusion in the minds of the physicians prescribing the drug); Hoffman LaRoche, Inc. v. Premo Pharmaceutical Laboratories, Inc., 502 PATENT, TRADEMARK, AND COPYRIGHT J. (BNA)A-4 (D.N.J. Oct. 30, 1980) (merely found that the imitation was very likely to cause confusion such that it would be mistaken for plaintiff's product).


88. 21 U.S.C. §§ 343(g) (1); 352(e), (n) (1980).

89. For an extensive authority supporting this contention, see Ball, supra note 6, at 480 n.38.

90. OTA Report, supra note 5, at 11.

“Bioavailability” refers to a measurement of the rate and extent to which an administered drug reaches general circulation in the blood stream. Two drugs are “chemically equivalent” when they contain the same amount of the same active ingredients; two chemically equivalent drugs are considered “bioequivalent” when they result in the same bioavailability when administered in the same amount to the same individual.
having a prescription filled with a look-alike drug that is not bioequivalent is that the product may be either subpotent, and therefore ineffective, or too powerful.\textsuperscript{91} With look-alike drug capsules, consumers having prescriptions refilled may be misled into thinking that they are being given medicine from the same, original, reliable source.

In addition, there may be more fundamental problems involving drug quality. A study on drug product safety concluded that drug products from different manufacturers differed in quality in several respects and that these differences may lead to substantial differences in therapeutic effect and/or safety.\textsuperscript{92} A government study has confirmed that pharmaceutical manufacturing processes are not standardized.\textsuperscript{93} Variations affecting purity, potency, stability and dissolution time may frequently occur depending upon differing procedures for quality control.\textsuperscript{94} These findings demonstrate that random substitution of a generic look-alike is not in the best interest of the consumer. In fact, the disparity in manufacturer performance as reflected in an independent study has prompted one commentator to recommend pharmacist review of individual

---

Two chemically equivalent drugs are considered "therapeutically equivalent" if they result in the same therapeutic response when administered in the same amount to the same individual. See OTA Report, supra note 5, at vi; Remington's Pharmaceutical Services 1368 (5th ed. 1975).

Although two drug products may contain the same active ingredient, each manufacturer uses different excipients (inactive ingredients) in the manufacturing process which can cause differences in bioequivalency/bioavailability affecting the safety and efficacy of the drug.


91. For example, the brand-name drug, "Dimetapp Extentabs", releases its active ingredients within a 10 - 12 hour period, while the generic look-alike releases its active ingredients within 3 - 4 hours. A.H. Robins Co. v. Medicine Chest Corp., 206 U.S.P.Q. (BNA) 1015, 1019 (E.D. Mo. 1980).

Certain patients are particularly vulnerable to therapeutic inequivalency problems. See E. W. Martin, Hazards of Medication 94 (2d ed. 1978) (those with allergies, metabolic deficiencies, and special problems of absorption, distribution and excretion). In those cases, when a particular brand of drug is well-tolerated by the patient, safe and effective therapy depends on that specific product being dispensed.


93. OTA Report, supra note 5, at 34.

94. Id. at 27.
manufacturer FDA records prior to purchase to ensure buying only from those who appear to have a good FDA record. Obvious product differentiation helps the consumer determine that he or she is receiving products of a desirable manufacturer. Denial of protection results in drugs of the least conscientious manufacturer in the industry indistinguishable in the marketplace from those of the manufacturer who strives for the highest standards of quality.

Finally, the economic policy underlying generic substitution is that of reducing drug prices for consumers. When a look-alike generic is substituted for a brand-name drug, a consumer may be unaware of the substitution and may be charged the higher brand-name price. Prohibition of generic copying makes covert substitution more difficult and increases the likelihood of the consumer knowing whether the brand-name or the generic has been used to fill the prescription.

Protection of Brand-Name Manufacturers

The look-alike issue raises serious questions of product liability. Brand-name manufacturers have pointed out the potential difficulty of assessing liability where a patient has suffered injury caused by a substituted look-alike product and then filed suit against the brand-name manufacturer. Recent decisions allowing DES victims to sue unidentifiable manufacturers have highlighted this problem. Allowing generic look-alikes renders producer identification almost impossible to the user and leaves the larger brand-name manufacturers vulnerable to lawsuits, whether or not

95. Block, supra note 92, at 175.
96. See Cooper, supra note 20, at 31 n. 111 (a survey revealed that a Washington, D.C., pharmacy dispensed inexpensive look-alike generics in place of the more expensive brand-name drug without informing the consumer and, in most cases, without passing on any savings to the consumer, despite considerably lower acquisition costs by the pharmacy); Swenson, supra note 25, at 368 (if pharmacists are passing on cost savings to consumers, it follows they should be eager to inform them about the substitution).
they were in fact responsible for the injury.

In addition, where generic manufacturers use the same size, shape, and color of the brand-name drug, covert substitution is facilitated, if not actually encouraged.99 Because of this, the brand-name manufacturers' economic return may be eroded. A diminished economic return may cause the manufacturer to respond by limiting allocation to areas beneficial to the consumer, such as product development or quality control.100 The manufacturer has significant economic investments which deserve protection.

**Policies in Favor of No Protection**

The growth and vitality of generic manufacturers is the result, in large part, of the steady government support over the past decade. This support has come from the Department of Justice,101 The Food and Drug Administration,102 the Federal Trade Commis-

---


100. The continuing development of new drugs and the improvement of those already in existence are goals that must be fostered in the best interest of the public. Recent studies have shown that the costs of such research and development has risen from $54 million in 1976 to $70 million in 1979, and 75% of these new drugs marketed yield yearly sales that are significantly less than the annual research and development cost of developing a new drug. It has been estimated that most new drugs require more than twenty years to accumulate sales as large as the estimated cost of bringing them to market. Although most of these drugs are protected by patents for 17 years, there are significant marketing delays due to FDA pre-market review. This has resulted in less and less of a drug's patent life remaining by the time it reaches the market. If little opportunity remains to recover research expenditure, the stimulus to invest in these increasingly expensive but vital therapeutic areas will disappear.

Two recent studies conducted jointly by Professor J. Weston of UCLA's Graduate School of Management and Dr. J. Virts, a staff economist with Eli Lilly Co., highlight the increasing costs of research and development in the research-intensive portion of the U.S. pharmaceutical industry. See 555 SCRIP: WORLD PHARMACEUTICAL NEWS 8 (Jan. 12, 1981).

101. The Department of Justice, in an amicus curiae brief for defendants in a look-alike case, stressed that freedom to copy the product of a competitor is fundamental in a competitive economy. Amicus Curiae Brief, supra note 73 at D-2. It advocated the views of economists who envision a system in which standardized methods of production will ensure that the goods of all producers will be completely interchangeable. These economists consider that protection from imitation is, in essence, protection of a monopoly. Allowing imitation, on the other hand, is a step toward "purifying competition" by elimination of monopoly elements. Where goods are copied, they are more nearly standardized and, if successful, the rationale is that the originator will be more likely to lower prices to compete with the imitator. For a more complete discussion, see Ball, supra note 6; see also J. Robinson, THE ECONOMICS OF IMPERFECT COMPETITION (1933); E. Chamberlin, THE THEORY OF MONOPOLISTIC COMPETITION (1948).

102. The Food and Drug Administration (FDA) has promulgated regulations that place additional burdens upon pharmaceutical manufacturers in the selection and use of trademarks. See 21 CFR § 201.10(c)(3) (1981); 21 CFR § 201.6(b) (1981).
sion,\textsuperscript{103} and various legislation.\textsuperscript{104} Although this support has come from many sources, it is commonly the result of the public policy encouraging the fostering of competition.

Proponents of copying have found additional support in judicial decisions which have recognized the economic desirability of allowing imitation. While having little sympathy for the willful imitator, courts have nevertheless found that copying must be permitted.\textsuperscript{105} The United States Supreme Court in the \textit{Sears} and \textit{Compco} decisions, balancing the national policy favoring free competition and the policy granting limited patent monopolies, also recognized the importance of allowing copying to promote competition.\textsuperscript{106} This single public policy is indeed a powerful argument in favor of granting no protection to size, shape, or color.

Generic manufacturers point to the trade protection already granted to brand-name manufacturers through patent protection.\textsuperscript{107} With this protection, brand-name manufacturers are, ar-

\begin{itemize}
  \item \textsuperscript{103} The authors of a Federal Trade Commission (FTC) report determined that the use of pharmaceutical trademarks (brand-names) ensured market dominance by brand-name companies and proposed limiting all pharmaceutical trademarks to a single 20 year term. B. Bond \& D. Lean, \textit{Sales, Promotion and Product Differentiation in Two Prescription Drug Markets} (FTC Bureau of Economics 1977) [hereinafter cited as FTC Report]. When the patent on a particular drug expires, therefore, competitors would be free to copy not only the chemical formula, but the trademarked name, thus denying the pharmaceutical industry the trademark protection afforded others. \textit{See generally} Comment, \textit{The FTC and the Generic Doctrine: A New Rx for Pharmaceutical Trademarks}, 15 Tulsa L.J. 327 (1979); FTC Report, supra; Dixon, \textit{Trademarks, the Federal Trade Commission and the Lanham Act}, 68 Trademark Rep. 463 (1978); 1 J. McCarthy, \textit{Trademarks and Unfair Competition}, § 12.1 at 405-06 (1973).
  \item \textsuperscript{104} For example, the Kefauver Amendments to the Federal Food, Drug and Cosmetic Act reduced the importance of trademarks for prescription drugs by mandating the use, size and placement of generic terms in labelling and in advertising. 21 U.S.C. § 352 (e)(1)(1962). These amendments sought to encourage physicians to prescribe by generic rather than brand name. \textit{See Note, Drug Amendments of 1962 - Generic-Name Prescribing: Drug Price Panacea?}, 16 Stan. L. Rev. 649, 653-655 (1964).
  \item \textsuperscript{105} \textit{See Smith v. Chanel, Inc.}, 402 F.2d 562, 568 (9th Cir. 1968) ("Disapproval of the copyist’s opportunism may be an understandable first reaction, but this initial response to the problem has been curbed in deference to the greater public good."); American Safety Table Co. v. Schreiber, 269 F.2d 255, 272 (2d Cir. 1959) ("[T]he bare imitation of another’s product, without more, is permissible. And this is true regardless of the fact that the courts have little sympathy for a willful imitator."); Millinery Creators’ Guild v. FTC, 109 F.2d 175, 177 (2d Cir. 1940) ("Courts have refrained from enjoining the pirate because they will not support a monopoly in an unpatented idea.")
  \item \textsuperscript{106} 376 U.S. at 230-31.
  \item \textsuperscript{107} Patent restoration legislation is currently under consideration in Congress. Sen. Mathias’ patent bill (S.255), providing drugs with up to seven years of additional patent protection to compensate for marketing delays due to the time it takes to get FDA approval, cleared the Senate Judiciary Committee, 43 FDC Rep. 21, at 6 (May 25, 1981), but Senators Kennedy and Metzenbaum maintain that the bill is not in the public interest. 43 FDC Rep.
guably, given a sufficient period of time to recoup their investment.

Generic drug manufacturers have received more recent encouragement from the government policy concerning new drug applications.\(^\text{108}\) This is further manifestation of government encouragement of greater competition in the prescription drug industry, and indirectly supports the generic manufacturer's argument that look-alike drugs are necessary for optimal competition.

**CONCLUSION**

Trademarks have traditionally been used as an identification of origin or source of a product in the marketplace. They are a practical means of distinguishing between the source of products which have given satisfaction in the past and those that have not. Whether or not a consumer actually knows the name of the producer or simply recognizes the trademark, the mark serves as an assurance that the product originates from a specific source and the result is the same. The reputation of that particular producer

---


\(^{108}\) For a new drug to be approved, the Federal Food, Drug and Cosmetic Act and FDA regulations require that an NDA (new drug application) contain full reports of clinical investigations made to show the safety and efficacy of a drug. 21 U.S.C. § 355(d) (1980); 21 CFR § 314.1 (c)(12) (1981). The NDA process is often expensive and time consuming. An NDA for a duplicate drug, however, may be approved on the basis of independently published studies, not actually duplicated by the manufacturer itself. 21 CFR § 314.1(c) (12) (e) (1981). This policy is known as the "paper NDA". Many generic drug manufacturers, therefore, may take advantage of another's research when making a drug application.

The consumer is affected where the studies forming the basis of the paper NDA were not necessarily performed using the same inactive ingredients or under the same manufacturing conditions. Significant differences in strength, purity and efficacy of the duplicate drug are therefore possible.

A more dangerous situation occurs where a generic manufacturer distributes unapproved look-alike drugs (no paper NDA) claiming that they are not "new" drugs under the Federal Food, Drug and Cosmetic Act because they are "generally recognized as safe and effective." 21 U.S.C. § 321(p) (1976). *See* United States v. Premo Pharmaceutical Laboratories, Inc., 511 F. Supp. 958 (D.N.J. 1981) (generic versions of previously approved products are new drugs because they contain different excipients than their pioneer counterparts, thus leading to possible bioavailability/bioequivalency problems). *But see* United States v. Generix Drug Corp., Nos. 80-5652, 80-5856 and 80-5857 (5th Cir., Sept. 4, 1981) (while it may be good public policy to regulate bioavailability and bioequivalency of generic drugs through a new drug application, the statutory language of the Federal Food, Drug and Cosmetic Act does not require such approval. "New drug" applies only to the active ingredient of a drug product).
will be an essential factor in the consumer's ultimate decision of whether or not to choose that product.

Although colors themselves traditionally have not been entitled to any protection because of fear of monopolization, recent court decisions have recognized that the choice of colors for drugs is myriad. Size, shape, and color of a new drug are chosen for traditional trademark purposes: to indicate the producer and to distinguish the drug from those of other producers. These features are a form of "commercial signature" merely facilitating the protection of a producer's good will in the marketplace by distinguishing the product from that of others.\(^{109}\) Where the medicinal component of a drug is not inherently colored, the choice of color is arbitrary and does not prevent another manufacturer from producing the same drug. There should be, therefore, no bar to trademark registration.

Finally, it is in the public interest to maintain individual identity in trade: the consumer is assured of getting the product s/he wants and the merchant is assured of realizing the results of his or her enterprise.\(^{110}\)

In today's market, with increased consumer awareness and pharmacist responsibility, a quality generic can compete openly and honestly for a share of the market. By affording trademark protection to size, shape and color of prescription drugs, a manufacturer can compete with others in terms of its own reputation, its own products and its own private identity.\(^{111}\)

Kathleen M. Sheahan

---

110. Pattishall, supra note 15, at 971.
111. Id.