

Mentioning the reference product in order to advertise a generic is considered "unfair" advertising?

Kluwer Patent Blog
November 2, 2010

Miquel Montañá (Clifford Chance)

Please refer to this post as: Miquel Montañá, 'Mentioning the reference product in order to advertise a generic is considered "unfair" advertising?', Kluwer Patent Blog, November 2 2010, <http://patentblog.kluweriplaw.com/2010/11/02/mentioning-the-reference-product-in-order-to-advertise-a-generic-is-considered-unfair-advertising/>

One of the strategies used by manufacturers of generic drugs to try to capture the market of the "reference product" when the patent protecting the latter expires is to present the generic as a cheap alternative to the "reference product". This raises several interesting questions, such as whether or not a generics company, for the purpose of promoting the sales of a generic, may mention the trademark used to designate the "reference product". In a judgment dated 7 April 2010, the Supreme Court gave a negative answer to this question, noting that, in the circumstances of the case, the use of a third party's trademark to advertise a generic product was an act of "unfair" competition. In the same judgment, the Supreme Court upheld the judgment of the Madrid Court of Appeal finding that the use of a tablet with the same shape and color as the one used to market the "reference product" was an act of unfair competition.