IN THE MATTER OF AN OPPOSITION by Novopharm Ltd. to application No. 675,935 for the trade-mark AZT filed by The Wellcome Foundation Limited

On February 1, 1991, the applicant, The Wellcome Foundation Limited, filed an application to register the trade-mark AZT for the following wares:

> **antiviral and antiretroviral preparations and substances for the treatment of HIV infection, AIDS and AIDS related complexes.**

The application is based on proposed use in Canada and was advertised for opposition purposes on July 1, 1992.

The opponent, Novopharm Ltd., filed a statement of opposition on November 24, 1992, a copy of which was forwarded to the applicant on December 15, 1992. The first ground of opposition is that the applicant's application does not comply with the provisions of Section 30(h) of the Trade-marks Act because the application does not contain an accurate representation of the trade-mark. The second ground is that the applied for trade-mark is not registrable because it is not a trade-mark and it is not a distinguishing guise.

The third ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(b) of the Act because it is clearly descriptive or deceptively misdescriptive of the character or quality of the applied for wares. In support of this ground, the opponent alleges that the trade-mark is one pronunciation of the common name of the wares, namely AZT or azidothymidine.

The fourth ground of opposition is that the applied for trade-mark is not distinctive. The fifth ground is that the applicant's application does not comply with the provisions of Section 30(b) of the Act because the applicant did not use its trade-mark since the date claimed.

The applicant filed and served a counter statement. As its evidence, the opponent submitted the affidavits of Sidney J. Smith, Stanley E. Read and Michael Spino. The applicant's evidence comprises the affidavits of Elizabeth-Ann Felso and Paul J. Mongenais.

Both Ms. Felso and Mr. Mongenais were cross-examined on their affidavits and the transcripts of those cross-examinations form part of the record of this proceeding. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

Not surprisingly, the opponent withdrew its first and fifth grounds of opposition since the applied for trade-mark is not a design mark and the application does not claim use of the mark. The first and fifth grounds are therefore unsuccessful.

As for the second ground, the applicant has not applied to register a distinguishing guise and the opponent failed to provide any allegations of fact to support its bald assertion that the applied for trade-mark is not registrable. Thus, the second ground of opposition is also unsuccessful.

As for the opponent's third ground of opposition, the material time for considering the circumstances respecting the issue arising pursuant to Section 12(1)(b) of the Act is the date of my decision: see the decision in Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers (1992), 41 C.P.R.(3d) 243 (F.C.A.). The issue is to be determined from the point of view of an everyday user of the wares and services. Furthermore, the trade-mark in question must not be carefully analyzed and dissected into its component parts but rather must be considered in its entirety and as a matter of first impression: see Wool Bureau of Canada Ltd. v. Registrar of Trade Marks (1978), 40 C.P.R.(2d) 25 at 27-28 and Atlantic Promotions Inc. v. Registrar of Trade Marks (1984), 2 C.P.R.(3d) 183 at 186. Finally, the onus or legal burden is on the applicant to show that its trade-mark is registrable although there is an initial evidential burden on the opponent to adduce enough evidence to support its case.

In his affidavit, Dr. Read establishes that he is a medical researcher specializing in infectious diseases in general and AIDS in particular. Since at least as early as 1990, he has known AZT as an alternate name for the anti-AIDS medicine zidovudine.

In his affidavit, Dr. Smith identifies himself as the Vice-President, Research and Development Laboratories of the opponent. He states that, since 1990, he has known AZT to be an alternate name for the anti-AIDS drug zidovudine or azidothymidine. Appended as an exhibit to his affidavit is an excerpt from the 1993 edition of the Compendium of Pharmaceuticals and Specialities which lists zidovudine, azidothymidine and AZT as non-proprietary names.

The Spino affidavit introduces into evidence the results of computerized searches of a medical literature data base. Those searches revealed what appear to be numerous generic or descriptive uses of the name AZT in the titles of articles relating to AIDS research. Mr. Spino appended as an exhibit to his affidavit a number of research papers containing descriptive uses of the name AZT. Of particular note is the third paper in that exhibit authored by three members of Wellcome Research Laboratories which is presumably related to the applicant. At the bottom of the first page of that article, AZT is identified not as a trade-mark but rather as an abbreviation for the drug 3'-azido-3'-deoxythymidine.

In view of the above, I find that the opponent has met its evidential burden. The opponent has shown that at least two medical specialists have recognized AZT as one of the alternate names for a particular anti-AIDS drug. The opponent has also provided a number of examples in the medical literature where that name is used generically or descriptively including one apparently from the applicant's own researchers.

As noted above, the onus or legal burden is on the applicant to show that its trade-mark is registrable. The applicant's evidence, in my view, falls short of that standard. In her affidavit, Ms. Felso identifies herself as a secretary with the firm acting as the applicant's trade-mark agent and states that she instructed a public search company to locate trade-mark registrations for the name AZT throughout the world. Appended as Exhibit A to her affidavit are purported photocopies of 31 foreign registrations.

On cross-examination, Ms. Felso acknowledged that she did not append the search report as an exhibit to her affidavit and that she did not know what happened to it. She also acknowledged that she did not see the original trade-mark registrations or certified copies from which the copies appended to her affidavit were purportedly made. Thus, I can give little or no weight to Ms. Felso's evidence. In any event, the existence of foreign trade-mark registrations for the name AZT does not assist the applicant in showing that its applied for trade-mark is not clearly descriptive or deceptively misdescriptive in Canada.

In his affidavit, Mr. Mongenais identifies himself as an articling student and appends as exhibits to his affidavit photocopies of excerpts from a number of publications including dictionaries and textbooks. On cross-examination, Mr. Mongenais admitted that he did not make any of the photocopies and that he did not examine any of the publications. Thus, little or no weight can be given to his affidavit. I can, however, take judicial notice of dictionaries and some do identify AZT as a trade-mark. However, many of those dictionaries are from countries where, according to Ms. Felso's affidavit, AZT is registered as a trade-mark. They are not necessarily determinative of the situation in Canada.

The opponent has adduced evidence tending to show that AZT is a generic or descriptive term for a particular anti-AIDS drug. The applicant has countered with weak and unreliable evidence which, at most, suggests that AZT is a registered trade-mark in various foreign jurisdictions. As noted by the opponent, it is surprising that there is no direct evidence from the applicant showing how it adopted its trade-mark, how it uses the mark on wares, packaging and in advertising in other countries and the extent of its worldwide sales and advertising. Presumably, such evidence does not exist.

Having considered all of the evidence, I find that the applicant has not met its legal burden to show that its applied for trade-mark does not offend the provisions of Section 12(1)(b) of the Act. Thus, the third ground is successful.

As for the fourth ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - November 24, 1992): see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.).

In view of my finding respecting the third ground of opposition, it follows that the applicant's trade-mark AZT is not distinctive because it is clearly descriptive of the character of the applicant's wares. The fourth ground is therefore also successful. The fourth ground did not include any specific allegations of non-distinctiveness in view of third party uses of similar marks.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 25th DAY OF SEPTEMBER, 1997.

David J. Martin,
Member,
Trade Marks Opposition Board.