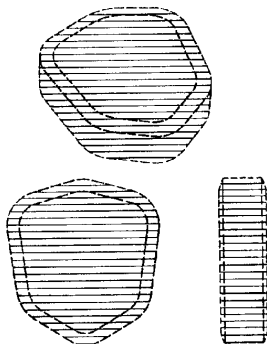


IN THE MATTER OF AN OPPOSITION  
by Novopharm Ltd. to application No. 747,265  
for the trade-mark Shield Shaped Design filed by  
Burroughs Wellcome Inc. and now standing  
in the name of Glaxo Wellcome Inc.

On February 10, 1994, Burroughs Wellcome Inc. filed an application to register the trade-mark shown in the drawings reproduced below based on use of the trade-mark in Canada since September of 1986. The application as advertised covered the wares “antiviral pharmaceutical tablets containing a dosage of the drug acyclovir.” The applied for mark is described in the application as follows:

“the trade-mark is shown on the specimen tablets filed with this application and consists of the colour blue applied to the whole surface of a flat, bevelled-edge shield-shaped tablet with identical opposed faces illustrated in the attached drawing lined for the colour blue.”

The application was advertised for opposition purposes on November 2, 1994. The trade-mark as advertised did not refer to the specimen of the tablet referred to in the application. As a consequence of a merger on June 30, 1995, the application now stands in the name of Glaxo Wellcome Inc.



The opponent, Novopharm Ltd., filed a statement of opposition on January 3, 1995, a copy of which was forwarded to the applicant on June 9, 1995. The grounds of opposition are reproduced below:

(a) The Opponent bases its opposition on the grounds provided by Section 38(2)(a) of the Trade-Marks Act (hereinafter “the Act”), namely that the application does not comply with s.30 in the following respects:

(i) The alleged trade-mark is not a trade-mark, in that the applicant has not used the trade-mark for the purposes of distinguishing its wares from those of others; and the trade-mark is functional, being indicative of dosage;

(ii) The application does not include an accurate representation of the trade-mark in that: the trade-mark as depicted purports to be the colour blue as applied to the surface of a tablet; and the shape of the tablet purports to be a flat bevelled-edged shield-shaped tablet with identical opposed faces; whereas, the alleged trade-mark as used, is used for different dosages of acyclovir in different colours; the use of a dotted outline indicates an undefined shape; the tablet as actually used does not have identical opposed faces but in fact has an imprint of the word “ZOVIRAX” diagonally across one surface and on the obverse surface the imprint of a triangle.

(b) The Opponent bases its opposition on the grounds provided by S.38(2)(d) in that the trade-mark is not distinctive in that it does not distinguish, nor is it adapted to distinguish the wares of the applicant from those of others. Blue shield shaped tablets were and are at all material times common to the trade and had been used by others so that the wares of the applicant cannot be distinguished from others, *inter alia*, the tablets of:

Rhone-Poulenc Rorer, namely Sectral 200 mg  
Merck Frosst Canada Inc., namely Timolide  
Merck Sharpe & Dohme Canada, namely Mevacor 20 mg;  
Merck Sharpe & Dohme Canada, namely Proscar 5 mg;

The applicant filed and served a counter statement generally denying the allegations in the statement of opposition. As its evidence, the opponent submitted the affidavits of Duncan Durham, Marlene Lovinsky, John Mizsyn, and Harvey Leopold, all of whom are pharmacists. As its evidence, the applicant submitted a certified copy of a Trade-Mark Opposition Board decision dated October 29, 1993, regarding application no. 593,889 for the trade-mark Design of a Tablet, filed by Burroughs Wellcome Inc. (**Novopharm v. Burroughs Wellcome Inc.** (1993), 52 C.P.R. (3d) 263 (T.M.O.B.) (hereinafter **Novopharm v. Burroughs (TMOB)**)).

Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

### The Applicant’s Evidence

As a preliminary matter, I would like to discuss the admissibility of the applicant’s evidence. In this regard, I consider that a certified copy of a previous decision complies with Rule 42(1) of the *Trade-Mark Regulations* and Section 54 of the *Act*. However, in my view, this type of evidence is not admissible for the truth of its contents but rather only serves to establish that a decision regarding the trade-mark Design of a Tablet (Application No. 593,889) was made and that the findings for that

decision were based on the evidence that was before the Board Member in that particular case. Presumably, if the applicant had wished to rely on similar evidence as that was filed in that case, it was up to the applicant to file such evidence for the present case.

As another preliminary matter, at the oral hearing, the applicant's agent submitted that the opposition decision it filed as its evidence supports the contention that the doctrine of **issue estoppel** applies to the present case. In this regard, the applicant's agent relied on the SCC decision of **Angle v. M.N.R.** [1975], 2 S.C.R. 248 at 253-254, wherein the requirements of issue estoppel were set out as follows: 1) that the same question has been decided; 2) that the judicial decision which was said to create the estoppel was final; and 3) that the parties to the judicial decision or their privies were the same person as the parties to the proceedings on which the estoppel is raised or their privies.

The applicant's agent submits, *inter alia*, that the present application was filed to overcome the objections made by Board Member Martin with respect to the s.30(h) ground of opposition in **Novopharm v. Burroughs Wellcome (TMOB)**. The applicant's agent further submits that because the present case involves the same parties and raises substantially the same issues that were considered by Board Member Martin in **Novopharm v. Burroughs Wellcome (TMOB)**, and subsequently by the Federal Court in **Novopharm v. Burroughs Wellcome Inc.** (1994), 58 C.P.R. (3d) 513 (F.C.T.D.), the doctrine of issue estoppel prevents the opponent from raising those additional grounds of opposition in this case (*i.e.* all grounds except for the s.30(h) ground).

In my view, the opponent in the present case should not be precluded from raising similar grounds of opposition in the present case as it did in **Novopharm v. Burroughs Wellcome (TMOB)** because a final decision with respect to the **substantive** issue of each of these grounds has never been made. In **Novopharm v. Burroughs Wellcome (TMOB)**, Board Member Martin rejected the remaining grounds of opposition (*i.e.* all grounds except for the s.30 ground) because they contravened s.38(3)(a) of the *Act* as they were not set out in sufficient detail to enable the applicant to reply to them. Thus, in my view, any discussion in that case regarding the substantive matter raised by these issues that followed this determination (*eg.* registrability, descriptiveness and

distinctiveness) was made by Board Member Martin in *obiter*<sup>1</sup>, and was also based on evidence filed in that case which is not before me in the present case. Further, I do not consider that the decision made with respect to the remaining grounds of opposition was “final” because at appeal, Justice McKeown did not address any of the remaining grounds of opposition because he agreed with Board Member Martin’s findings with respect to the s.30(h) ground. In view of the above, I consider that the doctrine of issue estoppel is not applicable to the present case. Consequently, I find that the opponent is not precluded from raising similar grounds of opposition in the present case as it did in **Novapharm v. Burroughs Wellcome (TMOB)**.

### The Opponent’s Evidence

The affidavits of the opponent’s affiants are substantially the same. In this regard, each of the affiants identify themselves as a pharmacist and state that they are familiar with the applicant’s shield-shaped acyclovir tablets which are imprinted with the trade-mark ZOVIRAX on one side and a triangle on the other side. They state that, in the absence of those additional markings, they would not be able to identify a blue shield-shaped tablet as a ZOVIRAX tablet. Each affiant identifies a list of 33 different tablets shown in the 1995 edition of The Compendium of Pharmaceuticals and Specialties which they describe as “shield-shaped”. However, neither of them provided evidence establishing any acquired reputation in Canada for these different tablets. Further, I observe that only 5 of the 33 tablets listed are in various shades of the colour blue.

All of the affiants also state that to patients, the appearance of their tablets is associated with the condition for which the drug has been prescribed, and the relief from the symptoms of their ailments. If an error in dispensing is made, the patient assumes that he or she has received the wrong medication, not the wrong brand. Further, the affiants state that patients frequently identify their medication by saying, for example, “my yellow heart pill”, or “my white diabetes pill”.

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<sup>1</sup> The fact that the comments made by Board Member Martin in **Novapharm v. Burroughs Wellcome (TMOB)** were “obiter” was acknowledged by Mr. Martin himself in **Apotex v. Burroughs Wellcome Inc.** (now Glaxo Wellcome Inc.), 68 C.P.R. (3d) 521 at 526 (1996).

## The Grounds of Opposition

Paragraph 1(a)(ii) of the statement of opposition appears to raise a ground of non-conformance with the requirements of Section 30(h) of the *Act*. Section 30(h) of the *Act* reads as follows:

30. An applicant for the registration of a trade-mark shall file with the Registrar an application containing.....

(h) unless the application is for the registration only of a word or words not depicted in a special form, a drawing of the trade-mark and such number of accurate representations of the trade-mark as may be prescribed....

The onus or legal burden with respect to this ground is on the applicant to show its compliance with s.30 of the *Act*: see the opposition decision **Joseph E. Seagram & Sons Ltd. v. Seagram Real Estate Ltd.** (1990), 33 C.P.R. (3d) 454 (F.C.T.D.); affirming 3 C.P.R. (3d) 325 at 329-330 (Hearing Officer - Trade-Marks). There is, however, an evidential burden on the opponent respecting its allegations of fact in support of this ground. With respect to the material time for considering the circumstances respecting the issue of non-compliance with the provisions of s.30 of the *Act*, the Board has consistently taken the position that since s.30 deals with the formative and substantive requirements of a trade-mark application, the material time for considering the issue of compliance with Section 30 is the date the application was filed (in this regard, please refer to the opposition decision in **Novopharm v. Bayer Inc.** (1996), 76 C.P.R. (3d) 560).

In my view, it is clear that the applicant has formally complied with the provisions of Section 30(h) in the present case since it did file a drawing as s.30(h) requires. The issue then becomes whether or not the drawing is an accurate and adequate representation of the trade-mark applied for. I consider that it is. In addition to providing three different representations of its trade-mark in two-dimensional perspectives, the applicant has made a claim as to its trade-mark's blue colour and has also provided a detailed written description of the shape of the mark. Further, the applicant has delineated the shape of the trade-mark in the written description by reference to the specimen filed pursuant to ss. 30 and 33 of the *Trade-Mark Regulations*.<sup>2</sup> Finally, although the applicant's tablets

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<sup>2</sup> I consider that the fact that the specimen was not referred to in the advertisement which appeared in the *Trade-Marks Journal* to be of no consequence to the application's overall ability to comply with s.30(h).

feature the trade-mark ZOVIRAX on one side and a triangular indentation on the other side, I consider that the use of the actual tablet sold by Burroughs Wellcome Inc. also constitutes use of the blue shape of the tablet ‘per se’ since the public would, as a matter of first impression, perceive use of the actual tablet as also being use of the tablet’s blue shape alone: see the opposition decision in **Nightingale Interloc Ltd. v. Prodesign Ltd.** (1984), 2 C.P.R. (3d) 535 at 538 and **Novopharm v. Burroughs Wellcome (TMOB)** at 268. Further, use of other trade-marks on the applicant’s tablet does not preclude registration of the trade-mark claimed in the application: see **Ciba Geigy Canada Ltd. v. Apotex Inc.** (1992), 44 C.P.R. (3d) 289 at 304 (S.C.C.).

The opponent also submitted that the application does not comply with s.30(h) because by using a dotted outline in its drawing, the applicant effectively eliminated any shape restriction for its mark. In my view, the use of a dotted outline in the drawings does not form part of the trade-mark.

Instead, I consider that the dotted outline serves to indicate how the trade-mark may be applied to the wares since the applicant is not claiming the actual tablet as its trade-mark, but rather the shape of the tablet as it defines the limits of the claim to the colour blue. I also note that it is a practice requirement of the Examination Division that applications for trade-marks which include a representation of the wares must include a drawing in a dotted outline as opposed to a full-line drawing which is only allowed for distinguishing guise applications. In any event, I still find that the present application complies with s.30(h) because it also defines the applicant’s trade-mark in terms of the specimen tablets filed with the application. Those specimens function as “accurate representations of the trade-mark” which serve to clarify any ambiguity or discrepancy in the drawing provided. Consequently, I am satisfied that the applicant has provided sufficient information to define the mark as claimed and used and accordingly, the second ground of opposition is not successful.

Paragraph 1(a)(i) of the statement of opposition, as pleaded, does not appear to raise a ground of non-conformance with any of the enumerated requirements of Section 30. Instead, this ground appears to be based on the general allegation that the application cannot comply with Section 30 of the *Act* because the mark applied for is not a trade-mark. In this regard, the opponent argues that the

applied for mark is not a trade-mark because: 1) it is non-distinctive; and 2) it is functional, being indicative of dosage. I am not sure if this ground, as pleaded, raises a proper ground of opposition. In any event, I do not consider it necessary to decide the first issue under this ground because the distinctiveness issue will be addressed below under the third ground of opposition. As for the remaining issue, even if I were to consider it a proper ground of opposition, I would not be satisfied that there is anything of record to suggest that the applicant's mark cannot function as a trade-mark. The mere fact that the applied for mark may be indicative of dosage is not sufficient, in my view, to prevent it from being able to function as a trade-mark (see, for example, the unreported opposition decision **Apotex Inc. v. Searle Canada Inc.** (now standing in the name of Monsanto Canada, Inc.) (S.N. 671,135; December 15, 1997). Consequently, this ground of opposition is not successful.

With respect to the third 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. - January 3, 1995): 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 **Novopharm v. Burroughs (TMOB)**, Board Member Martin made the following comments in *obiter* with respect to the distinctiveness of the applied for blue coloured shield shaped tablet for "pharmaceutical preparations and substances having anti-viral properties":

"The evidence establishes that there are a wide variety of sizes, shapes and colors used in manufacturing pharmaceutical pills and tablets. In particular, the opponent's evidence points to the existence in Canada of several dozen pharmaceutical tablets of different manufacturers which have various shapes and are colored blue. The opponent's evidence also establishes that a number of pharmaceutical manufacturers produce tablets having a shield-like or hexagonal appearance...

*In contrast to the foregoing, the applicant's ZOVIRAX product has enjoyed extensive sales since its introduction. That reputation has been buttressed by means of product information literature which includes a two dimensional representation of the applicant's mark. The evidence also shows that some pharmacists have come to associate the shape, size and color of the applicant's ZOVIRAX product with a particular source. However, the evidence also shows that such an association arises within the narrow context of filling a prescription for ZOVIRAX wherein the shape, size and color of the tablets are noted as they are dispensed from the container, a container which bears the trade-mark ZOVIRAX and information about the product.*

The evidence therefore establishes that there are a large number of different shapes, sizes and colours employed in the manufacture of pharmaceutical tablets. And within the crowded market-place, there are a significant number of tablets that are coloured various shades of blue and a number that have a shield-like or

hexagonal shape. *On the other hand, the evidence also shows that the applicant's particular trade-mark has become recognized as such by at least some pharmacists.* However, that recognition is associated with a tablet having a specific size, shape and colour and which is the anti-viral compound acyclovir used for the treatment of a specific condition, namely, herpes.

The question then becomes whether or not the applicant's application contains a sufficiently narrow claim to the mark which has actually acquired distinctiveness. ... If I assume that the applicant's mark is as shown on the specimen, then the evidence suggests that the mark can distinguish the applicant's specific product from other pharmaceutical products.

This leads to the final consideration, namely, whether the applied-for mark is distinctive of the applied for wares. If, on the one hand, the applicant had sought registration for pharmaceutical products in general, then it cannot distinguish the applicant's wares from those of others in view of the widespread use of tablets having a similar shape or color. On the other hand, if the applicant had sought registration for the particular anti-viral compound acyclovir used in the treatment of herpes, it would *appear* that its mark can serve to distinguish." (emphasis added)

As in the above case, the evidence in the present case establishes that there are a wide variety of sizes, shapes and colours used in manufacturing pharmaceutical pills and tablets. In particular, the evidence in the present case points to the existence in Canada of at least four pharmaceutical tablets of different manufacturers which have a similar hexagonal or shield-shape and blue colour as the applicant's tablet. The evidence also shows that there are some pharmacists who are familiar with the applicant's tablet used in the treatment of herpes simplex.

Unlike the case in **Novopharm v. Burroughs**, however, the applicant in the present case did **not** file any evidence of use of its mark in Canada. Thus, there is no evidence that the applied for mark has acquired any distinctiveness in Canada. Further, although the evidence in the present case shows that some pharmacists are familiar with the applicant's product, the evidence does **not** show that any of the pharmacists who testified could identify a blue shield shaped tablet as a Zovirax tablet used for the treatment of herpes simplex **without the markings that appear on the tablet**, *i.e.* the word Zovirax written across one side and the triangle imprint on the other. Consequently, I am not satisfied that the applicant has met the heavy onus on it of showing that its trade-mark was adapted to distinguish or actually distinguished its wares from those of others at the material time. Accordingly, I find that the applied for mark was not distinctive of the applicant's wares at the material date and the third ground of opposition is successful.

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 28<sup>th</sup> DAY OF MAY , 1999.



C. Folz  
Member,  
Trade Marks Opposition Board.