

**IN THE MATTER OF AN OPPOSITION BY
Novopharm Ltd. to application no. 699,917 for
the trade-mark PINK TABLET Design filed
by Astra Aktiebolag (formerly Aktiebolaget Astra)**

On February 28, 1992, the applicant, Astra Aktiebolag, filed an application to register the mark PINK TABLET Design, based on proposed use in Canada in association with pharmaceutical preparations namely, felodipine.

The mark is described in the application as shown below:

Specimens of the mark referred to in the description above are found in an envelop affixed to the inside back cover of the subject file. The subject application was advertised for opposition purposes in the *Trade-marks Journal* dated December 16, 1992 and was opposed by Novopharm Ltd. on February 16, 1993. A copy of the statement of opposition was forwarded to the applicant on April 16, 1993. The applicant responded by filing and serving a counter statement. The first two grounds of opposition are reproduced below in full, while the third ground is reproduced in part:

[a list of 26 companies]

The applicant's counter statement denies each of the grounds of opposition. Further, the applicant pleads that in respect of (a) above, "these grounds of opposition are speculative or incorrect;" in respect of (b) above, that the "statement of opposition does not contain sufficient detail to enable the applicant to reply thereto . . . ;" and in respect of (c) above, that "the shape and particular drug of any tablet referred to . . . are not set out and accordingly it is not possible to fully respond thereto."

The opponent filed as its evidence the affidavits of Dr. Paul Pitt, Mr. Stuart Greenwood, and Mr. George Mladenoff. The applicant's evidence consists of the affidavit of Stephen Wilton, which was admitted into the record as additional evidence. However, the opponent applied to the Federal Court, Trial Division to quash the Board's decision to admit Mr. Wilton's evidence into the record. Mr. Justice Gibson dismissed the application for judicial review by way of an Order dated April 4, 1996: see *Novopharm Ltd. v. Aktiebolaget Astra* (1996), 68 C.P.R. (3d) 117. Dr. Pitt and Mr. Mladenoff were cross-examined on their affidavits and the transcripts thereof and

exhibits thereto form part of the evidence herein. Mr. Greenwood was not made available for cross-examination and the parties agree that his affidavit does not form part of the evidence in this proceeding. Stephen Wilton's affidavit concerns an agreement between the applicant and Hoechst-Roussel Canada Inc. whereby Hoechst is licensed to use the applied for mark. Mr. Wilton submitted an affidavit in a related proceeding (concerning application no. 669,618) and was cross-examined on one occasion with respect to his evidence in both proceedings. The transcript of his cross-examination is part of the evidence record in this proceeding only insofar as it relates to the above-mentioned license agreement. Both parties filed a written argument and both parties were represented at an oral hearing. It is customary at oral hearings for the opponent to address the Board first, and for the opponent to reply to the applicant's submissions. In the instant case, through inadvertence, the applicant presented its case first. However, the opponent was permitted final reply.

With respect to the ground of opposition denoted by (a)(i) above, the applicant submits that the opponent has not provided any facts to explain why the trade-mark applied for is not a trade-mark. The applicant therefore contends that the opponent's pleading contravenes Section 38(3)(a) of the *Trade-marks Act* which requires a ground of opposition to be set out in sufficient detail to enable the applicant to reply thereto. I agree with the applicant: see, for example, *Novopharm Ltd. v. Hoechst Aktiengesellschaft* 1997, 76 C.P.R.(3d) 257 at 261(TMOB). With respect to the ground of opposition denoted by a(ii) above, the subject application is based on proposed use in Canada and therefore ground a(ii) does not raise a proper ground of opposition. With respect to the ground of opposition denoted by a(iii) above, the opponent again submits that the pleading contravenes Section 38(3)(a) of the *Act*. I agree. If I am wrong in this, then I am required to consider the applicant's submissions that (1) the drawing of the mark is not lined for the colour pink in accordance with the colour chart in the *Trade-marks Regulations*, and that (2) markings on the applicant's tablets form an integral part of the tablet for the purpose of identifying the tablet. In my view, the application as filed clearly describes pink as a feature of the mark and therefore the applicant is not obliged to follow the colour scheme set out in the *Regulations*: see Section 28 of the *Regulations*. As regards markings on the applicant's tablets, a close inspection of the specimen tablets reveals that they are inscribed with the letters AFM on

one side of the tablet. However, that by itself is insufficient to negate the sufficiency of the drawings (and the description of the mark) as set out in the subject application: see *Novopharm Ltd. v. Bayer* 1996, 76 C.P.R. (3d) 560 at 566-567 (TMOB). Thus, each of the grounds of opposition a(i) to a(iii) are rejected.

At paragraphs 38 and 39 of its written argument, reproduced below, the applicant discusses its pleadings in the counter statement that the remaining grounds of opposition, denoted by (b) and (c) above, provide insufficient details for the applicant to frame a proper denial:

Again, I must agree with the applicant. In my view, the applicant should not be faced with the burden of investigating what products are sold by the opponent, and by third parties, in an attempt to discover which pink tablets the opponent may possibly be referring to. If I am wrong in this, then I find that the opponent has not supported the allegations in the statement of

opposition. That is, there is no quantitative evidence, and insufficient qualitative evidence, of sales or use of any pharmaceutical tablets which have a colour and shape combination resembling the applied for mark.

In view of the above, the opponent's opposition is rejected.

DATED AT HULL, QUEBEC, THIS 14th DAY OF JUNE, 1999.

Myer Herzig,
Member,
Trade-marks Opposition Board