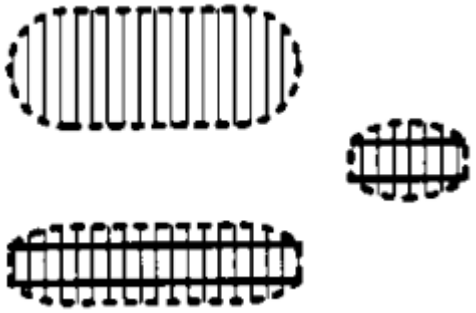
IN THE MATTER OF AN OPPOSITION by
Novopharm Limited
to application No. 804,384
for the trade-mark Red Coloured Elongate Shaped Tablet Design
in the name of Purdue Pharma

On February 14, 1996, Purdue Frederick filed an application to register the trade-mark Red Coloured Elongate Shaped Tablet Design. The application is based upon use of the trade-mark in Canada in association with pharmaceutical preparations, namely 200 mg dosage units of sustained release morphine since at least as early as January, 1991. The trade-mark is shown below:



The trade-mark consists of the colour red applied to the whole of the visible surface of the tablet. The tablet shown in dotted and solid outline does not form part of the trade-mark.

The application was advertised for opposition purposes in the Trade-marks Journal of October 23, 1996. On December 23, 1996, the opponent, Novopharm Limited, filed a statement of opposition. The applicant filed and served a counter statement on February 14, 1997.

On October 1, 1999, the opponent requested leave to file an amended statement of opposition. By letter dated December 16, 1999, leave was granted.

As its rule 41 evidence, the opponent filed a certified copy of the file history of the present application plus five affidavits, namely the affidavits of a doctor (Paul Pitt) and four pharmacists (Roger Daher, Joseph Newton, Luigi Longo and Spiridon Goussios). The applicant obtained orders for the cross-examination of each of these affiants. Transcripts of the cross-examinations of each of the opponent's affiants have been filed and form part of the record. At the oral hearing, it became apparent that the opponent's agents had provided an answer to an undertaking given with respect to Question 108 of the cross-examination of Mr. Goussios. This answer was sent to the applicant's agents by fax on August 17, 1999 and a copy was provided to me at the oral hearing. I will consider this answer to be part of the record as neither party has objected to its inclusion.

As rule 42 evidence, the applicant filed the affidavit of John H. Stewart, its Executive Vice President and General Manager. The opponent obtained an order to cross-examine Mr. Stewart and the transcript of his cross-examination is included in the record, together with answers given to certain undertakings.

As rule 43 evidence, the opponent filed the affidavits of Lucy Esposito, a law clerk, and John Andonoff, its Manager of Product and Pharmacy Support Programs. The applicant obtained leave to cross-examine each of these affiants and transcripts of their cross-examinations are included in the record.

Each party filed a written argument. The applicant, Purdue Frederick, subsequently changed its name to Purdue Pharma.

An oral hearing was held at which both parties were represented.

Grounds of Opposition

The grounds of opposition are as follows:

1. **The application is not in conformance with section 30 of the *Trade-marks Act* because**

    a) The alleged trade-mark has not been used in association with the wares described in the application since the date claimed in the application or at all;

    b) The applicant could not have been satisfied that it was entitled to use the alleged trade-mark in Canada pursuant to subsection 30(i) of the Act as the alleged trade-mark is not a trade-mark, being functional and indicative of dosage, or the type of medication, the applicant does not use the colour red for the purposes of distinguishing its wares from those of others, and in view of the fact that pharmaceutical tablets of confusingly similar appearances have been used by others at the relevant time in the Canadian marketplace.

2. **The applicant's alleged trade-mark is not registrable, in that:**

    a) It is not a trade-mark within the meaning of section 2 of the Act in that it is not a mark that is:

        i) used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others, and;

        ii) it is not a distinguishing guise;

b) it is not registrable pursuant to paragraph 12(1)(b) of the Act, in that the trade-mark sought to be registered is clearly descriptive of the wares set out in the application, namely a pharmaceutical preparation in the form of a tablet.

3. The applicant's alleged trade-mark is not distinctive in that it does not distinguish, nor is it adapted to distinguish, the applicant's wares from those of others; red 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 are and cannot be distinguished from others, including 22 listed third party tablets.

Onus

The applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act*. However, there is an initial evidential burden on the opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Summary of Evidence

Before addressing the specific grounds of opposition, I will summarize some of the evidence.

The applicant sells sustained release morphine in association with the trade-mark MS CONTIN. The MS CONTIN sustained release morphine is sold in several dosages. The 200 mg dosage is sold in the form intended to be protected by the present application. The 100 mg dosage is sold in the form of a grey tablet that is the subject of trade-mark application No. 804,385. The 60 mg dosage is sold in the form of an orange tablet that is the subject of trade-mark application No. 889,075.

The 30 mg dosage is sold in the form of a purple tablet that is the subject of trade-mark application No. 804,387. The 15 mg dosage is sold in the form of a green tablet that is the subject of trade-mark application No. 804,388. Each dosage of MS CONTIN is marked on one side with the letters PF. On the obverse side, the dosage is indicated, in the present case by the imprint "200 mg".

Sustained release morphine is a type of analgesic. The MS CONTIN sustained release morphine is used to treat pain, primarily in cancer patients. It appears that it is sometimes prescribed for short periods of time, whereas in some cases patients may take it for five years or longer. [question 59, Stewart cross-examination] Patients may concurrently take more than one dosage of MS CONTIN, in order to get the appropriate quantity, and typically also take other medications. [questions 41 and 132, Stewart cross-examination]

Sustained release morphine is a controlled pharmaceutical that is kept in a locked storage space in pharmacies. However, it is primarily used by self-medicating patients, as opposed to in a hospital setting. [question 42, Stewart cross-examination]

The applicant's promotional materials emphasize that different colours are associated with the different dosages. For example, there are the following statements in the promotional materials: "small, colour-coded tablets for dosing convenience and compliance"; "MS CONTIN comes in five colour-coded strengths"; "small, colour-coded tablets in a full range of strengths"; "a choice of four colour-coded, easy-to-swallow tablets ensures dosing flexibility, to meet the specific needs of each patient". [exhibits JHS-6 and JHS-9a, e and h, Stewart affidavit] In addition, in the Patient

Information Section of the 1997 Compendium of Pharmaceuticals and Specialties, at page B100 it reads, "MS Contin tablets are available in five strengths: 15 mg (green), 30 mg (violet), 60 mg (orange), 100 mg (grey) and 200 mg (red)… It may be necessary for you to take more than one tablet strength (different coloured tablets)…in order to receive the total daily dosage prescribed by your doctor." [exhibit "B", Pitt affidavit]

Nobody is contesting that care is taken in the filling of prescriptions and there was consistent evidence concerning how pharmacists go about filling prescriptions or identifying the appropriate product. The affiants who are pharmacists agree that the general practice is "for the pharmacist to review the prescription and enter the prescription information in the pharmacy records, and to prepare the vial label. The prescription is dispensed by going to the storage area, taking the bottle indicating the medication to be dispensed from the shelf and then pouring an approximate quantity on a dispensing tray, counting the number into the dispensing funnel and pouring the tablets from there into a labelled, amber-coloured vial." [see page 1, various pharmacists' affidavits] All the pharmacists, save Mr. Goussios, say at page 2 of their affidavits, "When the prescription is passed to the patient it is usually given in an amber-coloured vial with the generic name of the medication and the manufacturer's name in a code. The amber-coloured vial is enclosed in a stapled bag with the receipt or a label with the patient's name and the particulars of the prescription." Only Mr. Goussios states, "If the patient is present, I will show them the medication in the amber coloured vial and indicate to them its function, how to use it, how often, any restrictions to use and/or any common adverse effects. The amber vial is then enclosed in a bag along with the receipt and given to the patient." [paragraph 6, Goussios affidavit] On cross-examination, Mr. Goussios stated that his pharmacy's procedure is a bit unique because it is

located in a medical building with the result that patients usually are there before the prescription is bagged.

The pharmacists themselves receive MS CONTIN from their suppliers in small white vials, which are colour coded and opaque. [see exhibits JN-1, 2 and 3, Newton cross-examination]

There is no evidence from patients and only one affidavit from a physician. The pharmacists and doctor all agree that patients are rarely concerned or know about the source of manufacture of a medication and that patients do not associate the colour of a tablet with its source. They rely solely on their everyday interaction with patients to reach these conclusions, as opposed to any formalized survey.

In addition, the doctor and pharmacists all state, "I would not, in the absence of markings, identify the colour red as applied to the whole visible surface of the tablet as indicating Purdue Frederick, nor do I believe from my experience that it would indicate any particular source to patients." [see, *inter alia,* paragraph 21, Pitt Affidavit]

<u>The Law re Distinctiveness</u>

The material date for assessing distinctiveness is the date of filing of the opposition [see *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.) at 324; *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 (F.C.A.) at 130; and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 (F.C.A.) at 424].

In *Novopharm Ltd. v. Bayer Inc. et al.* (1999), 3 C.P.R. (4th) 305 (F.C.T.D.) at 321-323, aff'd (2000), 9 C.P.R. (4th) 304 (F.C.A.), Mr. Justice Evans set out some of the legal principles with respect to distinctiveness as applied to pharmaceutical colour/shape/size marks, as follows:

> **First, the burden of establishing the distinctiveness of a mark rests on the applicant, both in the opposition proceeding before the Registrar and on an appeal to this Court. Thus, Bayer must establish on a balance of probabilities that in 1992, when Novopharm filed its opposition to the application, ordinary consumers associated dusty rose, round extended-release tablets of the size of the 10 mg ADALAT tablet, with Bayer, or a single source of manufacture or supply: *Standard Coil Products (Canada) Ltd. v. Standard Radio Corp.*, [1971] F.C. 106 at p. 123, 1 C.P.R. (2d) 155 (F.C.T.D.), *affirmed* [1976] 2 F.C. iv (F.C.A.).**
>
> **Second, the "ordinary consumers" to be considered for this purpose include not only physicians and pharmacists, but also the "ultimate consumers", that is the patients for whom ADALAT tablets are prescribed and to whom they are supplied, even though their only access to nifedipine is through a physician's prescription: *Ciba-Geigy Canada Ltd. v. Apotex Inc.*, [1992] 3 S.C.R. 120, 44 C.P.R. (3d) 289.**
>
> **In *Ciba-Geigy* the Court held that the elements of the tort of passing-off were as applicable to pharmaceutical products as to any other. Accordingly, it was relevant to consider whether the "get-up" of the plaintiff's goods had acquired a distinctiveness that would lead patients to identify that "get-up" with a single source, so that they were likely to be confused into thinking that another's product, with a similar appearance to that of the plaintiff, emanated from the same source as the plaintiff's.**
>
> **I should also note that, while there are some obvious differences between actions for the tort of passing-off and opposition proceedings to the registration of a trade-mark, there is also a significant link between them. A dismissal of Novopharm's opposition will enable Bayer to prevent competitors from marketing a product that is interchangeable with ADALAT in the form of tablets with a similar appearance to Bayer's nifedipine tablets.**
>
> **Thus, in any enforcement proceedings that Bayer were to bring for trade-mark infringement, it would not be required to prove that the colour, shape and size of its product had a secondary meaning, as it would in a passing-off action if it were not the holder of valid trade-mark. By virtue of the statutory definition of a trade-mark, the valid registration of the mark at issue in this proceeding in effect irrefutably establishes that the appearance of ADALAT tablets is associated by consumers with a single source.**

Third, while I accept that the colour, shape and size of a product may together be capable in law of constituting a trade-mark, the resulting mark is, as a general rule, likely to be weak: *Smith Kline & French Canada Ltd. v. Canada (Registrar of Trade Marks)* (1987), 9 F.T.R. 129 (F.C.T.D.), 131.

In this case, pink round small tablets are commonplace in the pharmaceutical market. This means that Bayer has a heavy burden to discharge in proving on the balance of probabilities that in 1992 those properties had a secondary meaning, so that ordinary consumers associated the tablets with a single source: *Standard Coil, supra,* at p. 123. The fact that, when Novopharm filed its objection, ADALAT were the only extended-release nifedipine tablets on the market is in itself insufficient to establish a secondary meaning: *Cellular Clothing Co. v. Maxton & Murray*, [1899] A.C. 326 (H.L.), 346; *Canadian Shredded Wheat Co. v. Kellogg Co. of Canada Ltd.*, [1939] S.C.R. 329.

Fourth, it is not fatal to an application that consumers may also use means other than the mark for identifying the product with a single source. Thus, while pharmacists rely mainly on the brand name and other identifying indicia on the stock bottles and packaging containing the product, or the inscription on the tablets, which is not part of the mark, if there is evidence that to any significant degree they also recognized the product by its appearance (excluding the markings on the tablet because they are not part of the mark), this may be sufficient to establish the distinctiveness of the mark.

In addition, Madam Justice Dawson made the following observations concerning the issue of distinctiveness in *Novopharm Ltd. v. AstraZeneca AB et al.* (2003), 28 C.P.R. (4th) 129 (F.C.T.D.) [hereinafter "AstraZeneca (Dawson)"] at pages 133 to 134:

It follows that what is to be determined in this proceeding is whether Astra has met its burden to establish that the proposed trade-marks were distinctive as of the date of opposition. This turns upon the factual question as to whether as of the date of opposition, tablets marketed in an appearance similar to Astra's 5 mg and 10 mg tablets render Astra's marks non-distinctive and thereby preclude registration of the trade-mark.

The term "distinctive" is defined in section 2 of the Act in the following terms:

"distinctive", in relation to a trade-mark, means a trade-mark that actually distinguishes the wares or services in association with which it is	**« distinctive » Relativement à une marque de commerce, celle qui distingue véritablement les marchandises ou services en liaison**

used by its owner from the wares or services of others or is adapted so to distinguish them.

avec lesquels elle est employée par son propriétaire, des marchandises ou services d'autres propriétaires, ou qui est adaptée à les distinguer ainsi.

As the Court of Appeal wrote in *AstraZeneca AB v. Novopharm Ltd.*, 2003 FCA 57 at paragraph 16:

[...] A mark actually distinguishes by acquiring distinctiveness through use, resulting in distinctiveness in fact. A mark that is "adapted so to distinguish" is one that does not depend upon use for its distinctiveness because it is inherently distinctive. A coined or invented word mark falls into this category: Standard Coil Products (Canada) Ltd. v. Standard Radio Corp., [1971] F.C. 106 (T.D.), at 115; The Molson Companies Limited v. Carling O'Keefe Breweries of Canada Limited, [1982] 1 F.C. 175 (T.D.), at 278-79.

Principles to be applied when considering this issue are:

1. The trade-mark applicant must satisfy the tripartite test enunciated in *Phillip Morris v. Imperial Tobacco Ltd.* (1985), 7 C.P.R. (3d) 254 (F.C.T.D.) at page 270. See: *AstraZeneca v. Novopharm, supra* at paragraph 19. The third part of the tripartite test requires that the association between the mark and the product enables the owner of the mark to distinguish his product from that of others.

2. Colour alone has not been viewed as being inherently distinctive. See: *AstraZeneca v. Novopharm,* at paragraph 18.

3. Proof of actual distinguishment is not an easy burden to discharge. See: *AstraZeneca v. Novopharm,* at paragraph 20.

4. Where the active ingredient in the pharmaceutical product is not claimed as the trade-mark, and the trade-mark sought to be registered is the colour and shape of the tablet, the applicant must show that the colour and shape distinguishes the tablet from the tablets of other manufacturers. See: *AstraZeneca v. Novopharm,* at paragraph 22.

5. It is incumbent on the trade-mark applicant to show that physicians, pharmacists or patients can and do use the proposed trade-mark in choosing whether to prescribe, dispense or request the product. See: *Novopharm Ltd. v. Astra Aktiebolag* (2000), 6 C.P.R. (4th) 16 (F.C.T.D.); aff'd (2001) 15 C.P.R. (4th) 327 (F.C.A.).

6. It is not fatal to an application that consumers may also use means other than the mark for identifying the product with a single source. As Mr. Justice Evans, as he then was, wrote in *Novopharm Ltd. v. Bayer Inc.* (1999), 3 C.P.R. (4th) 305 at paragraph 79; aff'd (2000) 9 C.P.R. (4th) 304 (F.C.A.):

[...] Thus, while pharmacists rely mainly on the brand name and other

> **identifying indicia on the stock bottles and packaging containing the product, or the inscription on the tablets, which is not part of the mark, if there is evidence that to any significant degree they also recognized the product by its appearance (excluding the markings on the tablet because they are not part of the mark), this may be sufficient to establish the distinctiveness of the mark.**

Relevant Market to be Considered re Distinctiveness

The current case law makes it clear that the relevant market to be considered with respect to distinctiveness for trade-mark applications such as the present one is all pharmaceuticals. [see *AstraZeneca AB v. Novopharm Ltd. et al.* (2003), 24 C.P.R. (4th) 326 (F.C.A.); *Novopharm Ltd. v. AstraZeneca AB et al.* (2003), 28 C.P.R. (4th) 129 (F.C.T.D.); *Novopharm Ltd. v. Astra Aktiebolag* (2004), 36 C.P.R. (4th) 158 (T.M.O.B.)] It is evident from the affidavit of Mr. Stewart and the written argument of the applicant that the applicant was of the view that its trade-mark need only distinguish its sustained release morphine from the sustained release morphine of others or perhaps the analgesics of others. Whether or not this may have been the appropriate test at an earlier time, it is not the test at the present time.

Opponent's Initial Burden – Evidence re Other "Red Tablets"

For the purposes of the oral hearing, and with the applicant's agent's consent, the opponent kindly provided a table identifying each red tablet referred to in the pleadings and the evidence, with an indication of the evidence relating to each. This summation of the evidence was much appreciated as it was both useful and extremely time-saving.

The opponent's evidence provides copies of excerpts from the Compendium of Pharmaceuticals and Specialties (CPS), "which shows red tablets available in Canada in 1996." [see *inter alia* paragraph 12, exhibit "D", Goussios affidavit] Mr. Stewart, the applicant's affiant, agrees that the

CPS is a listing of pharmaceutical products available in Canada [paragraph 15, Stewart affidavit].

The applicant's MS CONTIN 200 mg tablet appears in the 1996 CPS, together with the following tablets that I consider to be the most similar to MS CONTIN 200 mg in colour and shape:

1. **EPIVAL 125 mg**
2. **TYLENOL Extra Strength Cough Caplets**
3. **LOPRESOR 50 mg**
4. **ENTROPHEN 500 mg**
5. **CHOLEDYL SA 400 mg**

In addition, more than twenty red, circular or oval tablets appear in the 1996 CPS.

Although the various pharmacists identify various red tablets that they have dispensed, I have not accorded that evidence any weight since there is no indication that they dispensed such tablets prior to the material date of January 1991.

I conclude on the basis of the foregoing evidence that the opponent has met its evidential burden to show that red tablets were common to the Canadian pharmaceutical trade as of the material date. [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.) at 58]

Although there is considerably less evidence of other red, elongate shaped tablets, as opposed to other red, circular or oval tablets, I note that Mr. Justice Evans, as he then was, considered

evidence of pills that shared only the colour of the applied for mark in *Novopharm Ltd. v. Bayer Inc. et al.* (1999), 3 C.P.R. (4th) 305 (F.C.T.D.), where he said at p. 330:

> **This evidence, it is true, does not always address both the colour *and* the shape and size of medication other than ADALAT. However, in my opinion it tends to negate Bayer's claim that the colour and shape of ADALAT are distinctive of the product, especially since the colour pink as applied to a small round biconvex pill can hardly be said to be inherently distinctive: *Novopharm Ltd. v. Searle Canada Inc.* (1995), 60 C.P.R. (3d) 400 (T.M.O.B.).**

Before proceeding, I should mention that Mr. Andonoff has provided Canadian sales figures with respect to a number of third party red tablets, which he obtained through a database created by Intercontinental Medical Statistics Canada (IMSC), a company that monitors the pharmaceutical industry and provides sales information to its clients. The admissibility of these figures has been challenged by the applicant on the basis that they are hearsay. Regarding the issue of reliability, Mr. Andonoff expresses his opinion that IMSC is recognized by many pharmaceutical companies as a reliable source of product sales information and it is noted that at least one of the applicant's brochures cites information obtained from IMSC [exhibit JHS-9c, Stewart affidavit]. Although the figures may have been obtained from a reliable third party source, the question remains if Mr. Andonoff was the appropriate party to provide the figures. The opponent has argued that it was not necessary for the IMSC data to be provided by an employee of IMSC because the data was extracted from a database on which Mr. Andonoff has been trained. However, it appears that some unidentified person within his department prepared the reports and Mr. Andonoff only checked the CPS to see if the tablets listed were the stated colour. In any event, I have chosen to not rule on the admissibility of the third party sales figures introduced by Mr. Andonoff for the simple reason that such a ruling is not required in view of my holding that the opponent has met its initial burden based on other evidence.

I should also mention that at page 43 of the cross-examination of Mr. Andonoff, the applicant's agent commented, "In reviewing this material I would take the position that it isn't proper subject matter of reply which I think is how it's been tendered and I conducted this cross-examination on the basis that I'm reserving my right to assert at the appropriate time that it isn't the proper subject matter of reply." However, the applicant did not assert in its written argument that Mr. Andonoff's evidence is not proper reply evidence. In any event, it matters not since my decision does not turn on Mr. Andonoff's evidence.

Applicant's Burden - Evidence of Use of Applicant's Mark as of the Date of Opposition

Sales of the applicant's MS CONTIN 200 mg Red Coloured Elongate Shaped tablets began in Canada at least as early as January 1991. As of the end of 1996, sales had amounted to $3,064,000. [paragraph 19, Stewart affidavit] The number of tablets that these sales account for has not been provided. I am not certain that these would qualify as impressive sales but, in any event, "impressive sales figures alone do not satisfy the burden on an applicant for a trade-mark of proving distinctiveness." [*Novopharm Ltd. v. Astra Aktiebolag* (2000), 6 C.P.R. (4th) 16 (F.C.T.D.) at 25, affirmed 15 C.P.R. (4th) 327]

The applicant's own affiant, Mr. Stewart, makes it clear that the colour and shape trade-marks which it has associated with its MS CONTIN product do not serve to distinguish its product from other pharmaceutical preparations sold in similarly coloured and shaped tablets, but rather only from other sustained release morphine. For example, during his cross-examination, which related

to the applications for the trade-marks for four of the dosages of MS CONTIN, there was the following exchange, at pages 23-24:

> **Q. Now sir, one of the applications here is for a green round tablet. You are familiar with that?**
>
> **A. Yes.**
>
> **Q. And I take it that there is nothing particularly unique about green round tablets out in the marketplace?**
>
> **A. No. In the pharmaceutical marketplace there are a wide variety of tablet colours. There are a lot of green tablets, there are a lot of red tablets, a lot of white tablets, colourless tablets. I think the universe that we have tried to speak to about here in this application is that of the sustained release morphine universe.**

Later on in the cross-examination, during a discussion of the pills which the opponent's affiants identified as looking similar to the MS CONTIN tablets, the transcript reads as follows [pages 32-34]:

> **Q. And it would appear that you are trying to draw a distinction between the fact that you have different drugs as being important when we look at whether or not these would be considered to be similar? We can draw a distinction between a pill that has morphine in it from a pill that has thyroid in it or something else, is that right?**
>
> **A. Actually I prepared this list in response to the affidavits that were filed by your client.**
>
> **Q. No, I'm aware of that but the point is that you seem to be placing a lot of emphasis on the fact that these drugs that were listed as looking the same or similar - -**
>
> **A. Yes?**
>
> **Q. - - have different active substances in them, is that right?**
>
> **A. Yes, and the reason that I am doing that is that these were raised in the affidavits of the gentlemen as to why there was no distinctiveness to the colours of the MS CONTIN tablets and we have always indicated that our distinctiveness was within the sustained release morphine category not all pharmaceuticals. Not all tablets in the marketplace and have long recognized that there are far less colours than there are different drugs and different tablets.**

Q. And so that in your view you can carve up the marketplace in these narrow categories, is that right? We can look at just sustained release morphine and we don't need to worry about pills that look identical but they are used for different treatments?

A. I'm not sure what you mean by worry about.

Q. Well, in so far as to whether or not there is going to be as you say distinctiveness of your trade mark for the colour and shape we don't have to look at other categories of drugs?

A. What we are saying is - - to reiterate what we are saying is that within the category of sustained release morphine products which are by far and away the most frequently prescribed for the treatment of severe pain the MS CONTIN colour and shape are very distinctive and they serve to differentiate MS CONTIN from other brands of sustained release morphine.

Conclusion re Distinctiveness Ground of Opposition

According to paragraph 22 of *AstraZeneca (Dawson),* the proper question is: what does a red pill mean to a pharmacist? It is clear to me that in the present case, the answer is not "medication from one particular source".

Overall, I do not find that the evidence from the health professionals in this case differs significantly from many previous cases where a colour/size/shape mark was held to not distinguish one source's pharmaceutical preparation. For example, at paragraph 12 of his affidavit Dr. Pitt states that he "would not identify any prescription tablet by the colour alone" and at paragraph 22 of his affidavit, Mr. Goussios states that he "would not, in the absence of markings, identify the colour red as applied to the whole visible surface of the tablet as indicating Purdue Frederick, nor do I believe from my experience that it would indicate any particular source to patients." Regarding patients, as stated by Mr. Justice Evans in *Novopharm Ltd. v. Bayer Inc.* (*supra*) at p. 331, it is not necessary to file direct evidence to show that patients associate the applied-for mark with a single source, but the absence of such evidence "is damaging when there is evidence from

pharmacists and physicians to the effect that patients typically do not associate the appearance of a medication with a single source."

The opponent submits that individuals must use something other than the colour and shape to distinguish the applicant's product from other red tablets, and the applicant has not satisfied me that it is reasonable to conclude otherwise.

The fact that others use a similar look for products in the same general class of wares, *i.e.* pharmaceutical preparations, means that the applicant ought not to be given the exclusive right to monopolize this look through registration. The applicant has not satisfied the burden on it to show that, on a balance of probabilities, the applied for trade-mark was distinctive of its wares as of the material date. As stated in *Novopharm Ltd. v. Astra Aktiebolag* (2000), 6 C.P.R. (4th) 101 (T.M.O.B.) at 112, "Given the inherent weakness of such a mark, it was incumbent on the applicant to clearly show that many consumers recognize it as a mark and not just as an ornamental or functional element of the product." Even the applicant's own affiant appears to agree that the applied for colour and shape does not distinguish its sustained release morphine from other pharmaceutical products.

The non-distinctiveness ground of opposition therefore succeeds.

<u>Section 30 Grounds of Opposition</u>

The material date with respect to the section 30 grounds of opposition is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469 at 475].

Ground 1(a): non-compliance with subsection 30(b)

The opponent pleads that the applied for trade-mark has not been used in association with the wares. At the oral hearing, the opponent's agent explained its position further. In particular, it submitted that the evidence did not indicate that the actual tablets are ever shown to consumers at the time of transfer, with the result that the alleged trade-mark is never seen at the time of transfer as required by subsection 4(1). Subsection 4(1) is reproduced below:

> **4. (1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.**

I agree that the evidence does not show that pharmacists see the pills when they are delivered to them. In addition, there is no evidence that pharmacists open the amber-coloured vials to show the pills to patients before transferring them to them.

At the oral hearing, the applicant's agent pointed out that the applicant's MS CONTIN is sometimes sold in blister packs. There ensued a debate as to whether pills are visible when packaged in a blister pack, the applicant's agent relying on the dictionary definition of a blister pack in support of its position. Despite the opponent's agent's objection, I am prepared to accept the dictionary definition of "blister pack", namely "a package holding and displaying merchandise in a clear plastic case sealed to a sheet of cardboard". [see Merriam-Webster Online Dictionary] Examples of the applicant's blister packs are in evidence (exhibit JHS-8, Stewart affidavit) but as they are empty, the opponent argued that one cannot tell if the material that would seal the pills to

the cardboard is transparent or not. Given the dictionary definition of blister pack and the lack of cross-examination on this point, I am not prepared to conclude that the pills would not be visible when transferred in this packaging. However, there remains the question of when the blister packaging was used. This is answered in part by the 1991 CPS, which refers to the applicant's wares being available in blister packaging.

The opponent's evidential burden with respect to subsection 30(b) can be met by reference to the applicant's own evidence. [*Labatt Brewing Co. v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.) at 230] However, in this case, the applicant's evidence is not 'clearly' inconsistent with the applicant's claims as set forth in its application. I therefore find that the opponent has not met its initial burden with respect to its subsection 30(b) ground. Ground 1(a) is therefore dismissed.

Ground 1(b): non-compliance with subsection 30(i)

As I understand it, the opponent's position is that this case differs in several ways from past cases in which similar pleadings were rejected. Primarily, the opponent argues that it is clear that from the beginning the applicant intended the colour of the pill to indicate the dosage and that this is not a case where there was at first one dosage in one colour, with later coloured dosages being added as time went by. Instead, four distinctly coloured dosages were introduced at once, with the red 200 mg tablet being added later, and the promotional materials appear to have always emphasized that the colours indicated the strength of the pill. Of course, the present application is not solely for colour, but colour is the dominant portion of the mark, given that the shape claimed is certainly not unique.

Despite this possible factual difference, I reject the first arm of this ground of opposition. There is no apparent reason why the applicant had to chose the colour red for its 200 mg dosage unit of sustained release morphine and the fact that this colour may distinguish one of the applicant's dosages from its other dosages should not in my view prove fatal. Presumably the applicant's intent in filing an application restricted to a specific dosage was to carve out that marketplace and I am not satisfied on a balance of probabilities that it could not have been satisfied that it was entitled to do so.

Regarding the last phrase of the pleading, I note that the opponent did not plead that the applicant was aware of the others' confusingly similar appearances, with the result that this part of the pleading fails. [see *Novopharm Ltd. v. Astra Aktiebolag* (2000), 6 C.P.R. (4th) 101 (T.M.O.B.) at 108]

<u>Registrability Grounds of Opposition</u>

The material date with respect to paragraph 12(1)(b) is the filing date of the application [see *Zorti Investments Inc. v. Party City Corporation* (2004), 36 C.P.R. (4th) 90 (T.M.O.B.); *Havana Club Holdings S.A. v. Bacardi & Company Limited* (2004), 35 C.P.R. (4th) 541 (T.M.O.B.); *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)].

Ground 2(a)

This pleading essentially submits that the alleged mark is not registrable because it is not a trade-mark. The opponent submits that an argument that the subject matter of an application is not a

trade-mark falls under section 12 of the Act, not section 30. In support of its position, it relies primarily on *W.J. Hughes & Sons "Corn Flower" Ltd. v. Morawiec* (1970), 62 C.P.R. 21 (Ex. Ct.).

The opponent acknowledges that similar pleadings have been rejected by this Board in decisions, such as *Novopharm Ltd. v. Astra Aktiebolag* (2004), 36 C.P.R. (4th) 158 (T.M.O.B.) and *Novopharm Limited v. Eli Lilly and Company*, November 9, 2004 re application No. 783742 (T.M.O.B.). However, it seeks to distinguish these recent decisions on the basis that at the filing of those applications, there was no evidence that the colour of the pills served to distinguish one dosage of the applicant's product from its other dosages. However, in theory, I do not see why a mark cannot serve to both identify the source of a product and distinguish one of that source's products from another of that source's products. I therefore dismiss this ground.

Ground 2(b)

The second arm of the registrability pleadings is analogous to one pleaded and rejected in the two decisions of the Board referred to in the foregoing paragraph. To paraphrase those decisions, the wares are not described in the application as being in tablet form and there is no evidence that 200 mg dosages of sustained release morphine must necessarily be sold in tablet form. Therefore the mark applied-for does not clearly describe a character or quality of 200 mg dosage units of sustained release morphine and this ground is dismissed.

<u>Disposition</u>

Having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the *Trade-marks Act*, I refuse the applicant's application pursuant to subsection 38(8) of the Act.

DATED AT TORONTO, ONTARIO, THIS 6th DAY OF MAY 2005.

Jill W. Bradbury
Member
Trade-marks Opposition Board