

**IN THE MATTER OF AN OPPOSITION
by Novopharm Ltd. to application No. 671,135
for the trade-mark Tablet Design filed by
Hoechst Aktiengesellschaft**

On November 27, 1990, the applicant, Hoechst Aktiengesellschaft, filed an application to register the trade-mark Tablet Design (illustrated below) based on use in Canada since March of 1984 with “pharmaceutical preparations, namely pentoxifylline.” The applied for trade-mark is described in the application as follows:

The trade-mark is shown in the attached drawing and consists of a pink colour applied to the whole of the visible surface of the tablet as shown in the drawings and in the specimens affixed to the application. The drawing is lined for the colour pink. The tablet shown in dotted outline does not form part of the trade-mark.

The application was advertised for opposition purposes on November 11, 1992.

The opponent, Novopharm Ltd., filed a statement of opposition on January 11, 1993, a copy of which was forwarded to the applicant on June 23, 1993. The first ground of opposition is that the applicant’s application does not comply with the provisions of Section 30 of the Trade-marks Act because the subject of that application is not a trade-mark. The second ground is that the applicant’s application does not comply with the provisions of Section 30(b) of the Act because the applicant has not used its trade-mark since the date claimed. The third ground is that the applicant’s application does not comply with the provisions of Section 30(h) of the Act because it does not include a drawing of the applicant’s mark.

The fourth ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(1) of the Act because, as of the applicant’s claimed date of

first use, the applied for trade-mark was confusing with “...trademarks namely, pink tablets” previously used in Canada by the opponent. The fifth ground is that the applied for trade-mark is not distinctive in view of the use by various other traders of pink tablets.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavits of Stuart Greenwood, Lawrence Erlick and George Mladenoff. The applicant filed an affidavit of David Nicholas Podwalski. Mr. Podwalski was cross-examined on his affidavit and the transcript of that cross-examination forms 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.

The opponent did not include any supporting allegations of fact for its first ground. Thus, that ground does not comply with Section 38(3)(a) of the Act and is therefore unsuccessful. In any event, there is nothing of record to suggest that the applicant’s applied for design cannot function as a trade-mark.

As for the opponent's second ground of opposition, the onus or legal burden is on the applicant to show its compliance with the provisions of Section 30(b) of the Act: see the opposition decision in Joseph Seagram & Sons v. Seagram Real Estate (1984), 3 C.P.R.(3d) 325 at 329-330 and the decision in John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 (F.C.T.D.). There is, however, an evidential burden on the opponent respecting its allegations of fact in support of that ground. That burden is lighter respecting the issue of non-compliance with Section 30(b) of the Act: see the opposition decision in Tune Masters v. Mr. P's Mastertune (1986), 10 C.P.R.(3d) 84 at 89. Furthermore, Section 30(b) requires that there be continuous use of the applied for trade-mark in the normal course of trade since the date claimed: see Labatt Brewing Company Limited v. Benson & Hedges (Canada) Limited and Molson Breweries, a Partnership (1996), 67 C.P.R.(3d) 258 at 262 (F.C.T.D.). Finally, the opponent’s evidential burden can be met by reference to the applicant’s own evidence: see Labatt Brewing Company Limited v. Molson Breweries, a Partnership (1996), 68 C.P.R.(3d) 216 at 230 (F.C.T.D.).

The opponent's evidence is not directed towards showing that the applicant did not use its applied for trade-mark since the date claimed. However, the applicant's own evidence appears to cast doubt on its claimed date of first use. Mr. Podwalski identifies himself as the National Sales Director of Hoechst-Roussel Canada Inc. which is the successor to Hoechst Canada Inc., both companies being subsidiaries of the applicant. Mr. Podwalski states that Hoechst-Roussel Canada Inc. and its predecessor have sold pentoxifylline in Canada since March 1984 in the form of a pink, oblong tablet in association with the trade-mark TRENTAL.

Mr. Podwalski appended representative packaging as Exhibit B to his affidavit. That packaging identifies TRENTAL as a registered trade-mark of the applicant but does not specifically indicate who is the owner of the trade-mark claimed in the present application. However, the packaging identifies Hoechst-Roussel Canada Inc. as the source of the wares and there is no indication that Hoechst-Roussel Canada Inc. is a licensee or authorized user of the applicant. Thus, it would appear that the message generated by the packaging is that Hoechst-Roussel Canada Inc. is the source of the tablets and the user of the applied for mark.

In view of the above, I find that the opponent has met its initial evidential burden respecting the second ground of opposition. It was therefore incumbent on the applicant to show that use of the applied for mark was by itself or by Hoechst-Roussel Canada Inc. or its predecessor under license from the applicant. The applicant failed to do so and thus the second ground of opposition is successful.

The applicant submitted that its claim to use of the applied for mark since March of 1984 was legitimate in view of the fact that it submitted a registered user application (R.U. 128943) in favor of Hoechst Canada Inc. when it filed the present trade-mark application. I disagree. Although the decision in Imperial Developments Ltd. v. Imperial Oil Ltd. (1984), 79 C.P.R.(2d) 12 (F.C.T.D.) held that use of an applied for trade-mark by a proposed registered user subsequent to the filing of the trade-mark application could not be used to defeat the distinctiveness of the applicant's mark if the use by the proposed registered user was 'bona fide', that decision did not go so far as to hold that such use by a proposed registered user

could inure to the benefit of the applicant prior to the registered user being approved by the Registrar of Trade-marks. In any event, it is clear that use by a proposed registered user prior to the filing date of the trade-mark application does not inure to the benefit of the applicant.

The applicant further submitted that the registered user application constitutes a license agreement qualifying under Section 50(1) of the Act. In my view, the registered user application does not satisfy the requirements of Section 50(1) in this case since there is no provision for the exercise of control of the character or quality of the wares by Hoechst Aktiengesellschaft. Even if it did, however, it would only be effective from its date of execution which is November 27, 1990. Contrary to the applicant's submissions, it would not have any retrospective effect back to March of 1984.

As for the third ground of opposition, Section 30(h) 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 applicant did file a drawing of its applied for mark and, in view of the initial portion of the description of the mark appearing in the application, it is apparent that the drawing depicts the mark for which the applicant seeks registration. Thus, it would appear that the applicant has complied with Section 30(h) and the third ground is therefore unsuccessful.

The opponent submitted that the drawing does not comply with Section 30(h) because the applicant effectively eliminated any shape restriction for its mark by including the statement that the tablet shown in dotted outline does not form part of the mark. The opponent contended that such a statement means that the applicant is claiming the color pink 'per se' as its trade-mark apart from the tablet itself.

Although the statement referred to by the opponent is somewhat ambiguous and confusing, the initial portion of the description of the trade-mark in the application clearly

limits the mark to the whole of the visible surface of the tablet. The statement referred to by the opponent appears to be simply an indication that the applicant is not claiming the tablet as its trade-mark but only the shape of the tablet as it defines the limits of the claim to the color pink. However, given the ambiguity in the statement, it should not have been included in the description of the mark although, as noted by the applicant, it was only added at the request of the Trade-marks Office. In any event, I would have found that the present application complies with Section 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.

As for the fourth ground of opposition, the opponent has failed to evidence use of any of its trade-marks prior to the applicant's claimed date of first use. The fourth ground is therefore unsuccessful.

As for the fifth 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 and services 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 11, 1993): 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.). Finally, there is an evidential burden on the opponent to prove the allegations of fact in support of its ground of non-distinctiveness.

Two of the opponent's affiants are pharmacists and the third (Erlick) is a physician. Exhibit 2 to each of the opponent's affidavits comprises an excerpt from a publication identified as the 1993 Compendium of Pharmaceuticals and Specialties which each affiant states includes pink tablets and capsules similar to the applicant's used by other manufacturers in 1993. However, neither pharmacist specifically identifies any particular tablet or capsule appearing in the excerpt and Dr. Erlick only identifies one, namely

LOPRESOR. Furthermore, none of the affiants evidences how any of these tablets and capsules have been used in Canada or the extent to which they have been used. In fact, none of the affiants was able to state that he prescribed or filled a prescription relating to any third party pink tablet or capsule. Thus, the opponent has failed to meet the evidential burden on it and the fifth ground is therefore unsuccessful.

Even if the opponent had evidenced a reputation in Canada for different third party pink tablets and capsules, it appears that the final ground would still have been unsuccessful. The applicant's application is narrowly restricted to the specific drug pentoxifylline and it appears that no one else is selling that drug in any form much less in the form of a pink, oblong tablet. Furthermore, the Podwalski affidavit evidences significant sales of the applicant's tablet for a number of years. Thus, in accordance with the opposition decision in Novopharm Ltd. v. Burroughs Wellcome Inc. (1994), 58 C.P.R.(3d) 513 (F.C.T.D.); affg. (1993), 52 C.P.R.(3d) 263 at 273 (T.M.O.B.), the evidence suggests that the applicant's trade-mark can distinguish the applicant's specific product from other pharmaceutical products. Unlike the situation in Novopharm Ltd. v. Searle Canada Inc. (1995), 60 C.P.R.(3d) 400 at 404 (T.M.O.B), the evidence does not establish that other pharmaceutical manufacturers sell drugs in the form of pink oblong tablets or capsules for the treatment of the same or similar medical conditions for which pentoxifylline is prescribed.

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 19th DAY OF MARCH, 1997.

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