IN THE MATTER OF AN OPPOSITION by Novopharm Ltd. to application No. 711,976 for the trade-mark AMOXI-TABS filed by SmithKline Beecham Corporation, and now standing in the name of Pfizer Inc.

On August 31, 1992, the applicant, SmithKline Beecham Corporation, filed an application to register the trade-mark AMOXI-TABS in association with "veterinary antibiotic preparations". The present application was accompanied by an application for the registration of a registered user of the trade-mark in respect of "veterinary antibiotic preparations".

The present application was advertised for opposition purposes in the ***Trade-marks Journal*** of April 7, 1993 and the opponent, Novopharm Ltd., filed a statement of opposition on September 7, 1993 which was amended in response to objections raised by the Opposition Board. The applicant submitted that the opponent ought to have requested leave pursuant to Rule 40 of the ***Trade-marks Regulations*** to amend its statement of opposition as the amended statement included new grounds of opposition. In my view, Rule 40 does not apply to amendments made to a statement of opposition prior to the Opposition Board forwarding a copy thereof to the applicant pursuant to Subsection 38(5) of the ***Trade-marks Act***. However, even if I am incorrect, I consider that the Registrar effectively granted the opponent leave to add the additional grounds by accepting the amended statement of opposition.

A copy of the amended statement of opposition was forwarded to the applicant on January 21, 1994 and the applicant served and filed a counter statement on February 21, 1994. The opponent submitted as its evidence the affidavit of Jack M. Kay while the applicant filed the affidavit of W. Thomas Borders and two affidavits of Susan Burkhardt dated February 29, 1996 and March 29, 1996, together with a certified copy from the Trade-marks Office file relating to abandoned application No. 644,196. Jack M. Kay, W. Thomas Borders and Susan Burkhardt were cross-examined on their respective affidavits, the transcripts of their cross-examinations and the exhibits thereto, as well as the responses to undertakings given during the cross-examinations, forming part of the opposition record. The opponent also submitted the affidavits of Steven Johnston, Michael Foorer and Elizabeth Salmon as evidence in reply. Both parties filed a written argument and the

opponent alone was represented at an oral hearing. Further, during the opposition, the present application was assigned to Pfizer Inc., the current applicant of record.

The following are the grounds of opposition relied upon by the opponent in its amended statement of opposition:

> a) The applicant's trade-mark AMOXI-TABS is not registrable in view of Paragraph 12(1)(c) of the ***Trade-marks Act*** as it is merely an abbreviated form of the name of the wares of the application, amoxicillin tablets;
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> b) The applicant's trade-mark AMOXI-TABS is not registrable in view of Paragraph 12(1)(d) of the ***Trade-marks Act*** as it is confusing with the registered trade-mark NOVAMOXIN, registration No. 409,703, covering "Pharmaceutical preparations namely, amoxicillin;
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> c) The applicant is not the person entitled to registration of the trade-mark AMOXI-TABS in view of Paragraph 16(3)(a) of the ***Trade-marks Act*** in that, at the date on which the applicant filed its application, the applicant's trade-mark was confusing with the opponent's trade-mark NOVAMOXIN which had been used in Canada by the opponent prior to that date;
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> d) The applicant's trade-mark AMOXI-TABS is not distinctive in that the applicant and the opponent both sell pharmaceuticals, being wares of the same general class and the use by the applicant of its trade-mark is likely to lead to the inference that the opponent's wares and those of the applicant are sold by the same person;
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> e) The applicant's trade-mark AMOXI-TABS is not distinctive in that it does not distinguish, nor is it adapted to distinguish, the applicant's wares from those of others, namely, the wares of Apotex Inc. sold under the trade-mark APO-AMOXI and the wares of Nu-Pharm Inc. sold under the trade-mark NU-AMOXI.

The applicant objected to the admissibility of the opponent's Rule 43 affidavits as not being proper reply evidence. In this regard, the Foorer affidavit is not strictly confined to matter in reply and paragraphs 4 and 5 of the Johnston affidavit are not limited to evidence of use of the marks NU-AMOXI and NOVAMOXIN in the veterinary marketplace in Canada and therefore are not strictly confined to matter in reply to Mr. Borders' evidence. Further, paragraphs 2 to 4 and 7 to 10 of the Salmon affidavit are not strictly confined to matter in reply in that they appear to merely augment the responses given to questions 188, 189, 199 and 208 by Mr. Borders during his cross-examination.

As its first ground, the opponent alleged that the trade-mark AMOXI-TABS is merely an abbreviated form of the name of the wares covered in the present application, namely, amoxicillin tablets. This allegation does not support a Paragraph 12(1)(c) ground and therefore the first ground is contrary to Paragraph 38(3)(a) of the ***Trade-marks Act***. Further, even if the opponent has properly

raised a Paragraph 12(1)(c) ground, the opponent's evidence does not show that the trade-mark AMOXI-TABS is the name in the English language, or any other language, of its "veterinary antibiotic preparations". Rather, the evidence of record appears to indicate that the mark AMOXI-TABS is descriptive when applied to amoxicillin tablets as opposed to being the name of such wares. For example, Mr. Kay states in his affidavit that the trade-mark AMOXI-TABS "is composed of terms which should be available for use by any pharmaceutical manufacturer, as it is merely a description of the wares, namely amoxicillin trihydrate tablets", that "amoxicillin is a widely used antibiotic prescribed in the treatment of infections", and that to his knowledge TABS "is a common abbreviation in the pharmaceutical industry for tablets". Likewise, in her affidavit, Ms. Salmon states that she would "expect the term "AMOXI-TABS" when used to describe a pharmaceutical preparation, would describe tablets having as the active ingredient amoxicillin (trihydrate)". Thus, the first ground of opposition is unsuccessful.

The second ground is based on Paragraph 12(1)(d) of the ***Trade-marks Act***, the opponent asserting that the trade-mark AMOXI-TABS is not registrable in that it is confusing with the registered trade-mark NOVAMOXIN, registration No. 409,703. While the opponent has not filed a copy of its registration as evidence, the Registrar does have the discretion, in view of the public interest to maintain the purity of the register, to check the register in order to confirm the existence of the registration relied upon by the opponent [see ***Quaker Oats of Canada Ltd./ La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.***, 11 C.P.R. (3d) 410]. In doing so, I noted that the trade-mark NOVAMOXIN, registration No. 409,703, was registered March 19, 1993 in association with "Pharmaceutical preparations namely, amoxycillin" and is presently in good standing.

In determining whether there would be a reasonable likelihood of confusion between the trade-marks AMOXI-TABS and NOVAMOXIN, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those specifically set forth in Subsection 6(5) of the ***Trade-marks Act***. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the date of decision, the material date in respect of the Paragraph 12(1)(d)

ground of opposition [see ***Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks***, (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

With respect to Paragraph 6(5)(a) of the ***Act***, the opponent's trade-mark NOVAMOXIN possesses some degree of inherent distinctiveness when considered in its entirety even though the element AMOXIN suggests that the wares covered in registration No. 409,703 are or contain amoxicillin (trihydrate). The applicant's trade-mark AMOXI-TABS is at least highly suggestive if not descriptive of tablets having amoxicillin (trihydrate) as an active ingredient and therefore possesses very little inherent distinctiveness. No evidence of use of the trade-mark AMOXI-TABS in Canada has been adduced by the applicant and its proposed trade-mark must be considered as not having become known to any extent in Canada. Likewise, no admissible evidence has been adduced by the opponent to show that its trade-mark NOVAMOXIN has become known to any measurable extent in Canada. I have concluded therefore that neither the extent to which the trade-marks at issue have become known [Para. 6(5)(a)] nor the length of time the trade-marks have been in use [Para. 6(5)(b)] are particularly relevant surrounding circumstances in assessing the likelihood of confusion between the applicant's trade-mark AMOXI-TABS and the opponent's trade-mark NOVAMOXIN.

As for the nature of the wares [Para. 6(5)(c)] and nature of the trade [Para. 6(5)(d)] of the parties, the applicant's wares are defined as "veterinary antibiotic preparations" while the wares covered in registration No. 409,703 are "Pharmaceutical preparations namely, amoxycillin". As amoxicillin tablets can be for veterinary use [see para. 8, Kay affidavit], there is a potential overlap in the nature of the wares of the parties and, as a result, a potential overlap in the nature of the trade associated with these wares.

As for the degree of resemblance between the trade-marks at issue [Para. 6(5)(e)], I find there to be very little, if any, similarity in appearance or in sounding between the applicant's trade-mark AMOXI-TABS and the registered trade-mark NOVAMOXIN. Further, while both marks may suggest some connection with amoxicillin (trihydrate), the opponent is not entitled to a monopoly in respect of such an idea.

As a further surrounding circumstance, the evidence of records points to at least the adoption by third parties of the marks NU-AMOXI and APO-AMOXI as applied to amoxicillin trihydrate. However, there is little admissible evidence of use of these trade-marks in Canada and the mere existence of these marks is therefore of limited relevance to the assessment of the likelihood of confusion between the trade-marks AMOXI-TABS and NOVAMOXIN.

As there is little similarity between the trade-marks at issue and the opponent's registered trade-mark NOVAMOXIN possesses only a limited degree of inherent distinctiveness, I have concluded that there would be no reasonable likelihood of confusion between the applicant's trade-mark AMOXI-TABS and the opponent's registered trade-mark NOVAMOXIN. I would also note that even if paragraph 5 of the Johnston affidavit were admissible reply evidence, I would not have altered my conclusion in relation to the issue of confusion between the trade-marks AMOXI TABS and NOVAMOXIN. I have therefore rejected the second ground of opposition.

The next ground is based on Paragraph 16(3)(a) of the ***Trade-marks Act***, the opponent asserting that the applicant is not the person entitled to registration of the trade-mark AMOXI-TABS in that the applicant's trade-mark was confusing as of the filing date of the present application [August 31, 1992] with its trade-mark NOVAMOXIN which had been used in Canada by the opponent prior to that date. However, the opponent has failed to adduce any admissible evidence from which I could have concluded that it had previously used its trade-mark NOVAMOXIN in Canada. In any event, and even had the opponent established its prior use and non-abandonment of its trade-mark NOVAMOXIN as required by Subsections 16(5) and 17(1) of the ***Trade-marks Act***, I would not have found there to be any reasonable likelihood of confusion between the trade-marks AMOXI-TABS and NOVAMOXIN in view of my comments in relation to the Paragraph 12(1)(d) ground of opposition. As a result, this ground is also unsuccessful.

The fourth ground is that the applicant's trade-mark AMOXI-TABS is not distinctive in that the applicant and the opponent both sell pharmaceuticals, being wares of the same general class and the use by the applicant of its trade-mark is likely to lead to the inference that the opponent's wares and those of the applicant are sold by the same person. These allegations *per se* do not support a

non-distinctiveness ground of opposition [see, in this regard, ***Benson & Hedges (Canada) Ltd. v. Imasco Ltd.***, 25 C.P.R. (2d) 269, at p. 272] and this ground is therefore contrary to Paragraph 38(3)(a) of the ***Trade-marks Act***. I have therefore dismissed the fourth ground of opposition.

As its final ground, the opponent has alleged that the trade-mark AMOXI-TABS does not distinguish, nor is it adapted to distinguish, the applicant's wares from the wares of Apotex Inc. sold under the trade-mark APO-AMOXI and the wares of Nu-Pharm Inc. sold under the trade-mark NU-AMOXI. The material time for considering the circumstances regarding the issue of non-distinctiveness is September 7, 1993, the filing date of the original statement of opposition [see ***Re Andres Wines Ltd. and E.&J. Gallo Winery***, 25 C.P.R. (2d) 126 (F.C.A.), at p.130; and ***Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.***, 37 C.P.R.(3d) 412 (F.C.A.), at p. 424]. Furthermore, 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, Inc. v. Muffin House Bakery Ltd.***, 4 C.P.R.(3d) 272 (T.M.O.B.)]. There is, however, an evidential burden on the opponent to prove the allegations of fact in support of its non-distinctiveness ground of opposition [see ***Clarco Communications Ltd. v. Sassy Publishers Inc.***, 54 C.P.R.(3d) 418, at p. 431 (F.C.T.D.)].

Initially, I would note that the opponent did not rely upon use of the trade-mark AMOXI [para. 8 and exhibit "3" to the Kay affidavit] in challenging the distinctiveness of the applicant's mark and its evidence in relation to use of the trade-mark AMOXI is of no relevance to the final ground of opposition. The issue arises as to whether the opponent has adduced evidence relating to the sale by Apotex Inc. of wares in Canada under the trade-mark APO-AMOXI and the sale by Nu-Pharm Inc. of wares under the trade-mark NU-AMOXI. The listing of these marks in the Compendium of Pharmaceuticals and Specialties in 1994 is not sufficient to meet the evidential burden on the opponent in relation to the non-distinctiveness ground and, in any event, the 1994 Compendium is dated subsequent to the material date for considering the non-distinctiveness ground.

Apart from the above, the following questions were put to Mr. Kay and the following answers were given by him during his cross-examination:

MS. STEINBERG: Q. Would you consider the trade mark Apo-Amoxi, Nu-Amoxi and Novamoxin to be confusing with each other?

A. No.

Q. So the component of Amoxi in one mark can consist [sic.] with Amoxi on another provided there are other letters or components to distinguish them. Is that correct?

MR. JOHNSTON: Don't answer that question.

While Mr. Kay's response is certainly not determinative of the issue of confusion, I cannot accept the opponent's position that various parties can be using trade-marks having the AMOXI element as a part of their mark but that the applicant's trade-mark AMOXI-TABS, which is less similar to any of the other marks than are those marks to each other and is applied to veterinary antibiotic preparations, would not be adapted to distinguish the applicant's wares from those associated with the trade-marks APO-AMOXI, NU-AMOXI and NOVAMOXIN which have not become recognized in the veterinary use area [see para. 6, Borders affidavit]. In any event, and absent any admissible evidence showing that either of the marks APO-AMOXI or NU-AMOXI have acquired any measure of a reputation in Canada, I find that the opponent has not met its evidential burden in relation to the final ground.

The opponent submitted at the oral hearing that the final ground includes a consideration of the issue that the applicant's trade-mark is not distinctive in that it is descriptive of its wares. Further, the opponent requested that, in the event that the wording of the final ground is found not to include the descriptiveness issue, it be granted leave to amend its statement of opposition in order to specifically include this allegation in its final ground. Certainly, the wording of the final ground does not include the allegation that the trade-mark AMOXI-TABS is descriptive and such an allegation cannot be inferred either from the wording of the final ground or from the other grounds of opposition. Moreover, as this opposition has already advanced beyond the oral hearing stage, I am not prepared to grant the opponent's request that it now be permitted to amend its statement of opposition in order to specifically include this allegation. As a result, the final ground is also unsuccessful.

Having been delegated authority by the Registrar of Trade-marks pursuant to Subsection 63(3) of the ***Trade-marks Act***, I reject the opponent's opposition pursuant to Subsection 38(8) of the ***Trade-marks Act***.

DATED AT HULL, QUEBEC THIS 28th DAY OF OCTOBER, 1999.

G.W.Partington,
Chairperson,
Trade-marks Opposition Board.