IN THE MATTER OF AN OPPOSITION by Novopharm Ltd. to application No. 637,454 for the trade-mark COLOUR YELLOW APPLIED TO A TABLET filed by Searle Canada Inc.

On July 31, 1989, Searle Canada Inc. filed an application to register the mark "the colour yellow applied to the whole of the visible surface of the tablet as shown in the specimens filed herewith." The application is based on use in Canada since at least as early as January 1982 in association with the wares "pharmaceutical preparations namely tablets containing 80 mg. of verapamil hydrochloride as the active ingredient." The application included the following drawings lined for the colour yellow:

The application was amended at the examination stage to comply with Office objections : see the Office letter dated February 9, 1990. The amended application deletes reference to specimens and describes the mark as "the colour yellow applied to the whole of the visible surface of the tablet. The representation of the tablet shown in dotted outline does not form part of the trade-mark." The application included the following representation of the tablet:

It may be that the applicant has failed to define its trade-mark with sufficient particularity by complying with the Office objection and deleting the phrase "as shown in the specimens filed herewith". I will return to this issue later. For the moment I will proceed on the basis that the applied for trade-mark is the colour yellow (as can be seen in the specimen tablet of record) applied to the shape of tablet as illustrated in the amended application.

The application was advertised for opposition purposes on October 24, 1990 and was opposed by Novopharm Ltd. on February 21, 1991. A revised statement of opposition was submitted by the opponent as a result of objections to the initial statement of opposition raised by the board. A copy of the revised statement of opposition was forwarded to the applicant on May 17, 1991.

The first ground of opposition is that (i) the alleged trade-mark is not a trade-mark, (ii) the alleged trade-mark has not been used with the wares referred to in the application since the date claimed, (iii) the application does not include a drawing of the trade-mark. The second ground is that the applicant is not the person entitled to register the alleged mark because at the first date of use of the mark it was confusing with "trademarks namely, yellow tablets" that had been previously used in Canada by the opponent. The third ground is that the applied for mark is not distinctive because yellow tablets are common in the trade and have been used by a number of companies. The applicant responded by filing and serving a counter statement.

The opponent's evidence consists of the affidavits of Dr. Paul Pitt, Joseph H. Newton, Julius Sokoloff, Philip Feldberg, pharmacists, and Leslie L. Dan, President of the opponent company. The applicant did not file any evidence in support of its application. Both parties filed a written argument and both were represented at an oral hearing.

I will first consider the ground of opposition alleging that the applied for mark, which is the colour yellow (as seen in the specimen sample of the mark provided by the applicant pursuant to Rule 30(d)(ii) of the Trade-marks Regulations) applied to a flattened sphere tablet is not distinctive of the applicant's pharmaceutical preparation.

The onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its pharmaceutical preparation from those of others throughout Canada: see Muffin Houses Inc. v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (TMOB). There is, however, an evidential burden on the opponent to adduce sufficient evidence which, if believed, would support its allegation that the colour yellow applied to a flattened sphere tablet is not distinctive of the applicant's wares. The presence of a legal burden on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against that the applicant: see Joseph E. Seagram & Sons v. Seagram Real Estate Ltd. (1984), 3 C.P.R.(3d) 325 at 329-30 (TMOB), and see John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 at 297-300 (F.C.T.D.). The material time for considering the circumstances respecting the issue of distinctiveness is as of the filing of the opposition, in this case February 21, 1991: see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.); Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.). Further, I am permitted to take into account evidence of all the surrounding circumstances including, for example, the parties' sales and advertising under their respective marks, up to the material date: see Castle & Cooke, Inc. v. Popsicle Industries Ltd. (1990), 30 C.P.R.(3d) 158 (TMOB).

The opponent's evidence is sufficient to at least meet its evidential burden regarding the allegation that the colour yellow applied to a flattened sphere tablet is not distinctive of the applicant's wares. This is so despite deficiencies in the evidence such as a lack in

precision in identifying what pharmaceutical preparations in the form of yellow tablets are actually sold in Canada and a failure to quantify or attempt to estimate such sales by parties other than the applicant. Nevertheless, on a fair review of the evidence, I am satisfied that other pharmaceutical manufacturers sell drugs in the form of yellow tablets intended to treat medical conditions of the same general nature as those treated by the applicant's verapamil hydrochloride preparation. Further, as far as I am able to determine from exhibit material, it appears that the shade of the colour yellow applied to tablets by other manufacturers is for all practical purposes the same shade of yellow applied by the applicant. The opponent's evidence also at least to some extent supports the proposition that the average consumer looks to the colour (and shape and size) of tablets to determine the nature and strength of the medication rather than to determine any particular source of the medication. As the applicant has not filed any evidence in support of its application, and has not challenged the opponent's evidence by cross-examination, I find that the applicant has not met the legal onus on it to show that, on a balance of probabilities, the colour yellow applied to its tablet is distinctive of its wares.

I therefore refuse the applicant's application. Hence, it is not necessary for me to consider the remaining grounds of opposition. The outcome would not have been any different in this case had I not had regard to the specimen tablet to determine the particular shade of yellow applied by the applicant. The applicant's mark, whether broadly or narrowly defined in colour, would have been found to be non-distinctive in view of third party uses.

I would add, however, that the Office may have acted inappropriately in requiring the applicant to amend its application to delete the reference to the specimen sample in the description of the mark: see, for example, Smith Kline & French Canada Ltd. v. Canada (Registrar of Trade Marks) [1987] 2 F.C. 633 where the Court approved of a similar description referring to a specimen:

> . . . the colour green applied to the whole of the visible surface of the tablet, *as shown in the specimen tablet* affixed to the form of the application, the precise shade of green being shown in the attached colour patch.
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> (emphasis added)

The Court, at page 636 of the above decision, also found that

> . . . the trade mark whose registration is sought is a *particular colour of green* applied to a *particular size* and shape of tablet. I would not preclude registration simply on the basis that the colour is applied to the whole of the exterior of the tablet and not to some part of it alone.
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> (emphasis added)

See also Novopharm Ltd. v.Burroughs Wellcome Inc. (1993), 52 C.P.R. (3d) 263 (TMOB), affd. Burroughs Wellcome Inc. v. Novopharm Ltd. (yet unreported, November 14, T-3008-93, (F.C.T.D.)) which support the conclusion that specimen samples may be referred to in describing the applied for mark in a trade-mark application.

Without reference to the specimen sample the description of the trade-mark in the instant case is the colour yellow (of no particular shade) applied to a flattened sphere tablet (of no particular size). Thus, by complying with the Office request and deleting the reference to the specimen sample in the description of the mark, it may be that the applicant has failed to adequately describe the particular shade of the colour yellow and the particular size of the tablet that it is applying to register as a mark. If so, then the opponent would also succeed on part (i) of the first ground of opposition. On the other hand, it may be that I can have regard to the specimen to determine the shade of colour and size of the tablet regardless of whether the specimen is incorporated by reference in the description of the mark. If so, then the application as amended adequately describes the mark.

There is one further matter that arose at the oral hearing. The opponent took the position that in view of new Section 38(7.2) of the Act the application should be considered

abandoned because the applicant did not file evidence or a statement that it did not intend to file evidence. The applicant's due date to file its evidence under the former legislation was September 12,1992. Proceedings advanced to the written argument stage on February 25, 1993. New Section 38(7.2) came into force on January 15, 1994. Thus, the applicant is precluded from requesting a retroactive extension of time to comply with new Section 38(7.2) because a fresh step in the proceedings was taken after September 12, 1992. In such circumstances, I not believe that it would be fair to penalize the applicant for its failure to comply with new Section 38(7.2), nor do I believe that the legislature could have intended Section 38(7.2) to apply retrospectively in such circumstances.

DATED AT HULL, QUEBEC, THIS 31st DAY OF JANUARY, 1995.

Myer Herzig,
Member,
Trade Marks Opposition Board