

IN THE MATTER OF AN OPPOSITION
by Laboratoires Nordic Inc. -
Nordic Laboratories Inc. to appli-
cation No. 628,264 for the trade-
mark NORDIJECT filed by Nordisk
Gentofte A/S (now Novo-Nordisk A/S)

On March 28, 1989, the applicant, Nordisk Gentofte A/S (now Novo-Nordisk A/S), filed an application to register the trade-mark NORDIJECT for "pen injection systems, including accessories" based on proposed use in Canada. The application was advertised for opposition purposes on September 27, 1989. On May 14, 1992, a revised application was filed in which the wares were restricted to the following:

pen injection systems consisting of syringes
and hypodermic needles for injecting fluids
into the body.

The revised application was accepted on June 17, 1992.

The opponent, Laboratoires Nordic Inc. - Nordic Laboratories Inc., filed a statement of opposition on January 26, 1990, a copy of which was forwarded to the applicant on February 9, 1990. The grounds of opposition include, among others, that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the opponent's trade-mark NORDIC registered under No. 128,324 for "pharmaceuticals" and "disposable enema units."

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavit of its President and General Manager, Vincente Anido, Jr. As its evidence, the applicant filed the affidavit of Roger Paul Britton, a registered trade-mark agent. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

As for the ground of opposition based on Section 12(1)(d) of the Act, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

The applicant's mark NORDIJECT is a coined word and is therefore inherently distinctive. However, it is apparent that the latter portion of the mark is derived from the word "inject" and thus the mark is at least slightly suggestive of the nature of the applicant's pen injection systems. The applicant's mark is therefore not inherently strong. Since there is no evidence of any use or advertising of the applicant's mark, I must conclude that it has not become known at all in Canada.

The opponent's mark NORDIC has a high degree of inherent distinctiveness: see the opposition decisions in Laboratoires Nordic Inc. v. Swedish Natural Healthcase Products Ltd. (1984), 4 C.P.R.(3d) 402 at 404 and Nordic Laboratories Inc. v. Nordisk Gentofte A/S (1989), 25 C.P.R.(3d) 394 at 395. The opponent has evidenced extensive use and advertising of its trade-mark in association with pharmaceuticals. I can therefore conclude that the trade-mark NORDIC has become known throughout Canada.

The applicant's agent contended that any reputation associated with the opponent's trade-mark is limited to pharmacists and doctors. He submitted that most of the opponent's products are prescription pharmaceuticals sold under various product marks and that the trade-mark NORDIC has only been used in association with those products in a subsidiary role as a house mark. He further submitted that consumers would therefore not see the opponent's house mark NORDIC when having their prescriptions filled. However, there is no evidence to support that contention. In any event, the Anido affidavit establishes that the opponent's trade-mark NORDIC appears directly on many of the tablets it has sold. Thus, even if the applicant's various contentions are correct, the opponent's trade-mark would still have become fairly well known to consumers simply through its appearance on tablets.

The length of time the marks have been in use clearly favors the opponent. The wares of the parties are not the same but they are related. Based on his experience in the pharmaceutical industry, Mr. Anido was able to state that pen injection systems are used primarily for the administration of insulin to diabetics. The opponent's evidence establishes that it has effected fairly substantial sales of a pharmaceutical product under its trade-mark GLUCOPHAGE and its house mark NORDIC for the control of non-insulin dependent diabetes. Furthermore, even if the applicant's systems are not intended for the injection of insulin, presumably they are intended for the injection of some form of medication and the opponent produces and markets a wide variety of medications in association with its house mark NORDIC. In the absence of evidence on point from the applicant, I must conclude that there could be some overlap in the channels of trade of the parties.

As for Section 6(5)(e) of the Act, I consider there to be a fair degree of visual and phonetic resemblance between the two marks since both commence with the letters NORDI. There is little, if any, degree of resemblance between the ideas suggested by the two marks.

The applicant contends that a surrounding circumstance in the present case which lessens the effect of any degree of resemblance between the marks is the state of the register evidence introduced by the Britton affidavit. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see the opposition decision in Ports International Ltd. v. Dunlop Ltd. (1992), 41 C.P.R.(3d) 432 and the decision in Del Monte Corporation v. Welch Foods Inc. (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). Also of note is the recent decision in Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd. (1992), 43 C.P.R.(3d) 349 (F.C.A.) which is support for the proposition that inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.

Mr. Britton appended photocopies of a number of registrations to his affidavit covering trade-marks registered for different pharmaceutical preparations commencing with the letters NOR. However, only four of those registrations are for trade-marks commencing with the letters NORD. In the absence of evidence of use, the existence of only four such registrations on the register does not allow me to infer that any of those marks has been used more than minimally. Thus, I am unable to conclude that there has been common adoption of NORD-prefixed marks in the pharmaceutical industry.

Mr. Britton also appended photocopies of pages from a reference source entitled Compendium of Pharmaceuticals and Specialties which Mr. Anido also relied on in his affidavit. However, the photocopied excerpts introduced by Mr. Britton contain no entries for pharmaceutical products having trade-marks commencing with the letters NORD. Mr. Britton also visited a pharmacy in Ottawa and examined a number of prescription pharmaceutical products but none was identified by a name or mark commencing with the letters NORD.

Mr. Britton's affidavit does establish that some pharmaceutical manufacturers have used trade-marks commencing with the letters NOR. However, there are deficiencies in his evidence so that I must give it diminished weight. For example, Mr. Britton's affidavit does not give much information about the pharmaceutical products he was shown in the Ottawa pharmacy he visited. It is therefore difficult to know if they are all products of one company. Similarly, it is difficult to know if they are all products of entities other than the opponent although at least one clearly is not, namely NORFEMAC which is a product of the opponent.

Notwithstanding the weaknesses in the Britton affidavit, it does suggest to some extent that consumers may be accustomed to seeing NOR-prefixed marks in the field of pharmaceuticals and that consequently they would be more likely to center on the other portions of such marks to distinguish them. Such a finding, however, does not greatly advance the applicant's case because the marks at issue share more than just the letters NOR. As noted, they both commence with the letters NORDI and there is no evidence of common adoption and use of marks in that form or even marks prefixed by the letters NORD.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the resemblance between the wares, trades and marks of the parties, the reputation associated with the opponent's mark and the fact that the applicant's mark is a proposed mark, I find that I am left in a state of doubt respecting the issue of confusion. Since the legal burden is on the applicant, I must resolve that doubt against it. The ground of opposition based on Section 12(1)(d) of the Act is therefore successful and the remaining grounds need not be considered.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 29th DAY OF December, 1993.

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