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Citation: 2020 TMOB 87

Date of Decision: 2020-07-24

IN THE MATTER OF AN OPPOSITION

Glaxo Group Limited	**Opponent**
And	
Boehringer Ingelheim International GmBH	**Applicant**
1,779,293 for the trademark NUPLADA	**Application**

BACKGROUND

[1] On April 26, 2016, Boehringer Ingelheim International GmBH (the Applicant) applied to register the trademark NUPLADA (the Mark) based on proposed use in association with pharmaceutical preparations for the treatment and prevention of a number of different diseases and disorders. A complete list of the goods in this application is set out in Schedule A. The application was advertised in the *Trademarks Journal* on December 28, 2016.

[2] On May 29, 2017, the Mark was opposed by Glaxo Group Limited (the Opponent) under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). I note that the Act was amended on June 17, 2019. All references in this decision are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act before it was amended (see section

70 of the Act, which provides that section 38(2) of the Act, as it read prior to June 17, 2019, applies to applications advertised before that date).

[3] The grounds of opposition are based on non-entitlement under section 16(3)(a) and (b), non-registrability under section 12(1)(d) and non-distinctiveness under section 2 of the Act. The primary issue in this proceeding is whether there is likelihood of confusion between the Mark and the Opponent's trademark NUCALA which is the subject of application No. 1,530,132, applied for in association with pharmaceutical preparations for the treatment and prevention of a number of different diseases and disorders, as set out in the attached Schedule B. This mark issued to registration No. TMA965,029, in association with "pharmaceutical preparations for the treatment of respiratory diseases and their symptoms."

[4] On October 12, 2017, the Applicant filed a counter statement denying each ground of opposition.

[5] In support of its opposition, the Opponent filed the following evidence:

- A certified copy of the Opponent's Canadian application No. 1,530,132 for the trademark NUCALA;
- A certified copy of the Opponent's Canadian registration No. TMA965,029 for the trademark NUCALA; and
- The affidavit of Alison Hollands, Director Respiratory Marketing & Enterprise Digital Lead of GlaxoSmithKline Inc.

[6] Ms. Hollands was not cross-examined on her affidavit.

[7] The Applicant did not file any evidence.

[8] Both parties filed written arguments. A hearing was held at which both parties were represented.

[9] At the oral hearing, comments were requested from both parties with respect to the overlap in goods between the NUPLADA application and both the NUCALA application and

registration. Receipt is acknowledged of the Applicant's further written submissions on this issue dated June 8, 2020, and the Opponent's further written submissions dated June 9, 2020.

ONUS AND MATERIAL DATES

[10] The Opponent has an initial evidential burden to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once that burden is met, the Applicant bears the legal onus of establishing, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA*, 2002 FCA 29, 20 CPR (4th) 155 (FCA)].

[11] The material dates with respect to each ground of opposition are as follows:

- Section 38(2)(b) / section 12(1)(d) – the date of decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trademarks* (1991), 37 CPR (3d) 413 (FCA);
- Section 38(2)(c) / section 16(3)(a) & (b) – the filing date of the application, namely, April 26, 2016; and
- Section 38(2)(d) / section 2 – the filing date of the opposition, namely May 29, 2017 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317 at 324].

SUMMARY OF THE OPPONENT'S EVIDENCE

[12] As noted above, in addition to the certified copies of its application and registration for the trademark NUCALA, the Opponent has presented the evidence of Alison Hollands, Director, Respiratory Marketing & Enterprise Digital Lead of GlaxoSmithKline Inc. The most pertinent parts of Ms. Hollands' evidence may be summarized as follows:

- Ms. Hollands' company is licensed by or had the authority of the Opponent to use the NUCALA trademark in Canada and, pursuant to the license, the Opponent has control over the character and quality of the NUCALA product sold in Canada;

- The NUCALA product is a prescription medicine used in addition to other asthma medicines to treat adult patients with severe eosinophilic asthma;

- The NUCALA product was authorized by Health Canada in 2015, and was introduced in Canada in the first quarter of 2016; copies of the art work representative of the NUCALA product packaging and product label are attached as exhibits;

- Sales of the NUPLADA product in Canada by her company are confidential; according to IMS Health however, an entity Ms. Hollands does not identify, sales of the NUCALA product in Canada were in excess of $5,000,000 in 2016 and $20,000,000 in 2017; and

- Ms. Hollands' company's sales representatives promote the NUCALA product through providing a broad array of product information to health care professionals across Canada both by mail and through personal visits.

PRELIMINARY ISSUE – OBJECTIONS TO THE OPPONENT'S EVIDENCE

[13] The Applicant's agent made two main objections to Ms. Hollands' evidence. First, concerning the Opponent's Canadian sales, the Applicant's agent submits that this evidence is hearsay for the following reasons:

- no invoices or internal sales documents were provided to support or verify the sales figures provided;

- no explanation has been provided as to what IMS Health is or how Ms. Hollands has access to information from what appears to be a third party; and

- no explanation has been provided about what method was used to obtain this information, or what the sales figures are intended to cover such as what entity is selling the goods and to whom?

The Applicant further submits that this evidence does not meet the criteria for a hearsay exception as the affiant has not explained how this evidence is necessary and reliable.

[14] The second objection of the Applicant's agent is that Hollands has not adduced a copy of the license agreement as evidence nor indicated what measures or standards are applied by the Opponent to exercise control over the character and quality of the NUCALA product sold in Canada. Accordingly, the Applicant's agent maintains that this ambiguity should be interpreted against the Opponent.

[15] I agree with the Applicant's agent that the Hollands' affidavit is not without its deficiencies.

[16] However, considering first the Applicant's agent's second objection, it is well established that a license agreement need not be in writing [*Wells' Dairy Inc v U.L. Canada Inc* (2000), 2000 CanLII 15538 (FC), 7 CPR (4th) 77 (FCTD) at page 88]. Further, as pointed out by the Opponent's agent, the copy of the artwork for the NUCALA product packaging used in Canada, which is representative of the packaging used for the product since it was introduced in the first quarter of 2016 attached as Exhibit D to Ms. Hollands' affidavit, as well as the first page of the product monograph attached as Exhibit B to her affidavit, both reference the mark at issue and state the following: "NUCALA is a registered trademark of Glaxo Group Limited, used under license by GSK, Inc." I find this evidence, along with Ms. Hollands' uncontradicted statement that the Opponent has control over the character and quality of the NUCALA product sold in Canada, sufficient to demonstrate that the mark is used under license by Ms. Hollands' company and under the control of the owner [see section 50(2) of the Act].

[17] With respect to the Applicant's agent's first objection, I agree that the IMS data referred to in Ms. Hollands' affidavit is hearsay. Although Ms. Hollands' statement that the Opponent's sales figures were confidential may explain why this data was necessary, it is not clear from Ms. Hollands' affidavit whether she has any personal knowledge that this data is reliable. In the circumstances, I am not prepared to accord any significant weight to this evidence because it is based on data collected by a third party and no reasons were given as to why a person having direct knowledge could not have provided the evidence [see *R v Khan* 1990 CanLII 77 (SCC), [1990] 2 SCR 531 and *Novopharm Limited v. Pfizer Products Inc*, 2009 CanLII 82144].

[18] Even if I were to give some weight to the stated sales figures, I note that without further details regarding when the sales occurred in 2016, I would not have been able to determine if these sales occurred prior to the Applicant's filing date in any event.

SECTION 16(3)(B) GROUND OF OPPOSITION

[19] The Opponent has pleaded that the Applicant is not the person entitled to the Mark because it is confusing with its application No. 1,530,132 for the trademark NUCALA. The Opponent's initial burden is to establish that its application was filed prior to the filing date of the application (April 26, 2016) and that it was still pending at the date of advertisement (December 28, 2016) [section 16(4) of the Act]. The certified copy of the NUCALA application submitted by the Opponent confirms that this application was filed before the application's filing date and was pending at its advertisement date. While I note the application only proceeded to registration with one good (i.e. pharmaceutical preparations for the treatment of respiratory diseases and their symptoms) compared to the long list of goods that it had been applied for in association with, this is not a relevant surrounding circumstance [*ConAgra, Inc v McCain Foods Ltd* (2001), 2001 FCT 963 (CanLII), 14 CPR (4th) 288 (FCTD); *Corporativo de Marcas GJB v Bacardi & Company Limited*, 2015 TMOB 51 (CanLII); *Starbucks (HK) Limited v Rogers Broadcasting Limited*, 2013 TMOB 114 (CanLII); *Jarrow Formulas, Inc v Canada Bread Company, Limited*, 2015 TMOB 67; section 16(4) of the Act].

[20] As the Opponent has satisfied its initial burden, the Applicant must therefore establish, on a balance of probabilities, that there was no reasonable likelihood of confusion between its trademark and the Opponent's trademark as of the filing date of the Applicant's application.

The test for confusion

[21] The test for confusion is assessed as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the applicant's mark, at a time when he or she has no more than an imperfect recollection of the opponent's trademark, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401 at para 20].

[22] The test to determine the issue of confusion is set out in section 6(2) of the Act which provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them.

[23] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Veuve Clicquot, supra*; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

Inherent distinctiveness of the trademarks and the extent they have become known

[24] Both parties' marks are coined words that do not have any descriptive connotation in association with the goods concerned. I therefore consider both parties' marks to be inherently strong.

[25] The Applicant's Mark had not become known to any extent as of the filing date of the application because it was based on proposed use. While the Opponent's agent submits that its NUCALA product was introduced in Canada in the first quarter of 2016 as an asthma medication, without further details regarding when the Opponent's promotional activities occurred in 2016, I am unable to determine if these promotional activities occurred prior the Applicant's filing date.

[26] This factor therefore does not favour either party.

Length of time the trademarks have been in use

[27] As noted above, the Applicant's Mark is based on proposed use. While the Opponent's affiant stated that the Opponent's mark was introduced in Canada in the first quarter of 2016 and the Opponent had enjoyed significant sales of the product in Canada in 2016, as noted above, I have not given any weight to the sales figures provided by Ms. Hollands because they were hearsay. However, even if I had given some weight to the sales figures referenced in Ms. Hollands' affidavit, without further details regarding the dates when the Opponent's sales occurred in 2016, I would have been unable to determine if any use of the Opponent's mark occurred in Canada prior to the Applicant's filing date. This factor therefore does not favour either party.

Nature of the goods and nature of the trade

[28] When considering the goods of the parties, it is the statement of goods in the parties' trademark applications that govern the issue of confusion [*Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); and *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful, particularly where there is an ambiguity as to the goods or services covered in the applications at issue [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 1996 CanLII 3963 (FCA), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[29] As shown in Schedule A, the application for the Mark covers a wide variety of pharmaceutical preparations for the treatment of various human medical issues and diseases. The Opponent's applied for goods also cover a wide variety of pharmaceutical preparations for the treatment of various human medical issues and diseases, as shown in the attached Schedule B.

[30] The parties agree that many of the applied for goods of the Applicant overlap with the applied for goods of the Opponent. The parties also disagree, however, with respect to a number of the remaining applied for goods. In this regard, the Applicant's agent submits that absent any evidence to the contrary, a plain reading of the statement of goods supports the position that only the goods agreed upon can be considered to directly overlap with one another.

[31] For ease of reference, I reproduce below the applied for goods that the parties agree overlap and I have used strike through to highlight those goods that remain:

> Pharmaceutical preparations for the treatment of cardiovascular disease; pharmaceutical preparations for the treatment of central nervous system diseases and disorders, namely central nervous system infections, brain diseases, central nervous system movement disorders, ocular motility disorders, spinal cord diseases, encephalitis, epilepsy, Alzheimer's, cerebral palsy, Parkinson's disease; pharmaceutical preparations for the treatment of neurological diseases and disorders, namely ~~brain injury, spinal cord injury, seizure disorders,~~ Alzheimer's, ~~Huntington's disease, cerebral palsy~~; pharmaceutical preparations for the treatment of genitourinary diseases, namely urological diseases, infertility, sexually transmitted diseases, inflammatory pelvic diseases; pharmaceutical preparations for the treatment of gastrointestinal/diseases and disorders; pharmaceutical preparations for the treatment of musculoskeletal diseases and disorders, namely connective tissue diseases, bone diseases, osteoporosis, spinal diseases, back pain, fractures, sprains, cartilage injuries; pharmaceutical preparations for the treatment of allergies; pharmaceutical preparations for the treatment of diabetes; pharmaceutical preparations for the treatment of hypertension; pharmaceutical preparations for the treatment of erectile dysfunction; pharmaceutical preparations for the treatment of sexual dysfunction; pharmaceutical preparations for the treatment of cancer; pharmaceutical preparations for the treatment of migraines; pharmaceutical preparations for the treatment of pain, namely headaches, migraines, back pain, pain from burns, neuropathic pain; pharmaceutical preparations for the treatment of obesity; pharmaceutical preparations for the treatment of inflammation and inflammatory diseases, namely inflammatory bowel diseases, inflammatory connective tissue diseases, inflammatory pelvic diseases; pharmaceutical preparations for the treatment of the respiratory system; pharmaceutical preparations for the treatment of infectious diseases, namely respiratory infections, eye infections; pharmaceutical preparations for the treatment of immunological diseases and disorders, namely autoimmune diseases, immunologic deficiency syndromes, Acquired Immune Deficiency Syndrome (AIDS); pharmaceutical preparations for the treatment of viral diseases and disorders, namely herpes, hepatitis, Acquired Immune Deficiency Syndrome (AIDS); pharmaceutical preparations for the treatment of stroke; pharmaceutical preparations for the treatment of psychiatric diseases and disorders, namely mood disorders, anxiety disorders, panic disorders, cognitive disorders, schizophrenia, depression; ~~pharmaceutical preparations for the treatment of substance abuse disorders, namely alcoholism and drug addiction; pharmaceutical preparations for the treatment of carpal tunnel syndrome; pharmaceutical preparations for the treatment of varicose veins; pharmaceutical preparations for the~~

~~treatment of dental and oral diseases;~~ pharmaceutical preparations for the treatment of osteoporosis; pharmaceutical preparations for the treatment of arthritis; pharmaceutical preparations for the treatment of multiple sclerosis; pharmaceutical preparations for the treatment of yeast infections; pharmaceutical preparations for the treatment of prostate disorders; pharmaceutical preparations for the treatment of pulmonary disorders; pharmaceutical preparations for use in oncology; pharmaceutical preparations for use in dermatology, namely dermatitis, skin pigmentation diseases; pharmaceutical preparations for use in ophthalmology; pharmaceutical preparations for use in ocular disorders; pharmaceutical preparations for use in gastroenterology; pharmaceutical preparations for the treatment of gynecological disorders, namely premenstrual syndrome, endometreosis, yeast infections, menstrual irregularities; pharmaceutical preparations, namely cholesterol preparations, namely preparations to lower cholesterol; ~~pharmaceutical preparations namely smoking cessation preparations;~~ pharmaceutical preparations namely tissue and skin repair preparations; ~~pharmaceutical preparations namely acne medication~~; pharmaceutical preparations namely allergy medication; ~~pharmaceutical preparations namely antacids; pharmaceutical preparations namely anthelmintics; pharmaceutical preparations namely antiarrhythmics; pharmaceutical preparations namely antibiotics; pharmaceutical preparations namely anticoagulants; pharmaceutical preparations namely anticonvulsants; pharmaceutical preparations namely antidepressants; pharmaceutical preparations namely antiemetics; pharmaceutical preparations namely antiflatulants; pharmaceutical preparations namely antihistamines~~; pharmaceutical preparations namely antihypertensives; pharmaceutical preparations namely anti-infectives; pharmaceutical preparations namely anti-inflammatories; ~~pharmaceutical preparations namely antiparasitics; pharmaceutical preparations namely antibacterials; pharmaceutical preparations namely antifungals; pharmaceutical preparations namely antivirals; pharmaceutical preparations namely burn relief medication; pharmaceutical preparations namely calcium channel blockers; pharmaceutical preparations namely central nervous system depressants; pharmaceutical preparations namely central nervous system stimulants;~~ pharmaceutical preparations namely cough treatment medication; ~~pharmaceutical preparations namely diarrhea medication~~; pharmaceutical preparations namely gastrointestinal medication; pharmaceutical preparations namely glaucoma agents; ~~pharmaceutical preparations namely hydrocortisone; pharmaceutical preparations namely hypnotic agents; pharmaceutical preparations namely sedatives.~~

[32] The Opponent's agent, on the other hand, submits that the diseases identified in many of the Applicant's remaining applied for goods are the same or similar to those of the Opponent or that there is an overlap in therapeutic application, e.g. An anticoagulant may be used in the treatment of cardiovascular disease amongst other things. The table below highlights those additional applied for goods of the Applicant which the Opponent's agent submits overlaps with its goods either because the disease identified is the same or similar or because there is an overlap in therapeutic application.

Application No. 1779293 NUPLADA	**Application No. 1530132 NUCALA**
Pharmaceutical preparations for the treatment of neurological diseases and disorders, namely brain injury, spinal cord injury, seizure disorders, Alzheimer's, Huntington's disease, cerebral palsy	Pharmaceutical preparations for the treatment of Parkinson's Disease, Alzheimer's disease and dementia
Pharmaceutical preparations namely acne medication	Pharmaceutical preparations for the treatment of dermatological diseases and disorders namely dermatitis, skin and skin structure diseases, infections, and injuries, psoriasis, eczema and sexually transmitted diseases
Pharmaceutical preparations namely antacids	Pharmaceutical preparations for the treatment of gastrointestinal related diseases and disorders namely irritable bowel disorders and symptoms, digestive disorders, and acid related disorders
Pharmaceutical preparations namely anthelmintics	Pharmaceutical preparations for use as anti-infectives
Pharmaceutical preparations namely antiarrhythmics	Pharmaceutical preparations for the treatment or prevention of cardiovascular, cardiopulmonary, cardio-renal, and renal diseases
Pharmaceutical preparations namely antibiotics	Pharmaceutical preparations for the treatment and prevention of respiratory diseases and their symptoms
Pharmaceutical preparations namely anticoagulants	Pharmaceuticals for the treatment or prevention of respiratory diseases and their symptoms
Pharmaceutical preparations namely anticonvulsants	Pharmaceutical preparations for the treatment of insomnia, restless leg, fibromyalgia, epilepsy, migraine, pain, stroke and multiple sclerosis
Pharmaceutical preparations namely antidepressants	Pharmaceutical preparations for the treatment of central nervous system diseases and disorders, namely, central nervous system infections, brain diseases, central nervous system movement disorders, ocular motility

	disorders, spinal cord diseases, depression and anxiety and their related disorders namely schizophrenia and psychoses
Pharmaceutical preparations namely antiemetics	Pharmaceutical preparations for the prevention and treatment of sequelae of oncologic diseases and their treatment namely nausea and vomiting, hematologic depression, mucositis, cachexia, pain and bone pain, fatigue
Pharmaceutical preparations namely antiflatulants	Pharmaceutical preparations for the treatment of gastrointestinal related diseases and disorders namely irritable bowel disorders and symptoms, digestive disorders and acid related disorders
Pharmaceutical preparations namely antihistamines	Allergy medications
Pharmaceutical preparations namely antiparasitics	Pharmaceutical preparations for use as anti-infectives
Pharmaceutical preparations namely antibacterials	Pharmaceutical preparations for use as anti-infectives
Pharmaceutical preparations namely antifungals	Pharmaceutical preparations for use as anti-infectives
Pharmaceutical preparations namely antivirals	Pharmaceutical preparations for use as anti-infectives
Pharmaceutical preparations namely burn relief medication	Pharmaceutical preparations for the treatment of damaged skin and tissue
Pharmaceutical preparations namely calcium channel blockers	Pharmaceutical preparations for the treatment or prevention of cardiovascular, cardiopulmonary, cardio-renal, and renal diseases
Pharmaceutical preparations namely central nervous system depressants	Pharmaceutical preparations for the treatment of central nervous system diseases and disorders namely central nervous system infections, brain diseases, central nervous system movement disorders, ocular motility disorders, spinal cord diseases, depression and anxiety and their related disorders namely

	schizophrenia and psychoses
Pharmaceutical preparations namely central nervous system stimulants	Pharmaceutical preparations for the treatment of central nervous system diseases and disorders namely central nervous system infections, brain diseases, central nervous system movement disorders, ocular motility disorders, spinal cord diseases, depression and anxiety and their related disorders namely schizophrenia and psychoses
Pharmaceutical preparations namely diarrhea medication	Pharmaceutical preparations for the treatment of gastrointestinal related diseases and disorders namely irritable bowel disorders and symptoms, digestive disorders and acid related disorders
Pharmaceutical preparations namely hydrocortisone	Pharmaceutical preparations for the treatment and prevision of respiratory diseases and their symptoms

[33] I agree with the Opponent that an overlap for pharmaceutical goods would favour the Opponent with respect to goods that target the same or similar indications as those in the Opponent's application [*Evonik Industries AG v Glaxo Group Limited*, 2019 TMOB 49]. The Opponent's agent, however, also referred to the decision in *GD Searle & Co v Mead Johnson & Co* (1967), 53 CPR 1 (Ex Ct), wherein the Court noted the following: "[i]n the field of medical products, it is particularly important that great care be taken to prevent any possibility of confusion in the use of trademarks". While I do not disagree with this statement, it has also been stated that this passage does not suggest that the standard of confusion in opposition proceedings relating to pharmaceuticals is different than that applicable to other goods. As noted by Hearing Officer Eaton in *American Home Products Corporation and Wyeth v William H Rorer (Canada) Ltd*, 42 CPR (2d) 149 at page 232: "There is only one statutory standard fixed by s-s. (2) of s. 6 of the Trade Marks Act, and the essential question to be determined is expressly related to source of product: *Rowntree Co. Ltd. v. Paulin Chambers Co. Ltd.*, *supra*, at p. 136."

[34] In this case, the only evidence filed with respect to the use or promotion of any of the applied for goods is the Opponent's evidence of its NUCALA product. The evidence shows that the Opponent's NUCALA product was authorized by Health Canada in 2015 as a prescription medicine used in addition to other asthma medicines to treat adult patients with severe

eosinophilic asthma and it is administered by subcutaneous injection. There is no evidence regarding any of the other applied for goods of the Opponent.

[35] Therefore, other than the limited evidence of the Opponent's mark in association with its prescription medicine to treat asthma, all that I have to determine this issue is a plain reading of both parties' statement of goods. Given that the remaining objected to statements of goods specified by the Applicant can cover the treatment of a range of indications, I find that both the Applicant's applied for goods set out in the chart above as well as the goods that the Applicant concedes are overlapping, are of a similar nature to the Opponent's applied for goods. I note that I may have found differently had the Applicant submitted evidence on this point.

[36] I therefore consider this factor to significantly favour the Opponent with respect to the following goods:

> Pharmaceutical preparations for the treatment of cardiovascular disease; pharmaceutical preparations for the treatment of central nervous system diseases and disorders, namely central nervous system infections, brain diseases, central nervous system movement disorders, ocular motility disorders, spinal cord diseases, encephalitis, epilepsy, Alzheimer's, cerebral palsy, Parkinson's disease; pharmaceutical preparations for the treatment of neurological diseases and disorders, namely brain injury, spinal cord injury, seizure disorders, Alzheimer's, Huntington's disease, cerebral palsy; pharmaceutical preparations for the treatment of genitourinary diseases, namely urological diseases, infertility, sexually transmitted diseases, inflammatory pelvic diseases; pharmaceutical preparations for the treatment of gastrointestinal/diseases and disorders; pharmaceutical preparations for the treatment of musculoskeletal diseases and disorders, namely connective tissue diseases, bone diseases, osteoporosis, spinal diseases, back pain, fractures, sprains, cartilage injuries; pharmaceutical preparations for the treatment of allergies; pharmaceutical preparations for the treatment of diabetes; pharmaceutical preparations for the treatment of hypertension; pharmaceutical preparations for the treatment of erectile dysfunction; pharmaceutical preparations for the treatment of sexual dysfunction; pharmaceutical preparations for the treatment of cancer; pharmaceutical preparations for the treatment of migraines; pharmaceutical preparations for the treatment of pain, namely headaches, migraines, back pain, pain from burns, neuropathic pain; pharmaceutical preparations for the treatment of obesity; pharmaceutical preparations for the treatment of inflammation and inflammatory diseases, namely inflammatory bowel diseases, inflammatory connective tissue diseases, inflammatory pelvic diseases; pharmaceutical preparations for the treatment of the respiratory system; pharmaceutical preparations for the treatment of infectious diseases, namely respiratory infections, eye infections; pharmaceutical preparations for the treatment of immunological diseases and disorders, namely autoimmune diseases, immunologic deficiency syndromes, Acquired Immune Deficiency Syndrome (AIDS); pharmaceutical preparations for the treatment of

viral diseases and disorders, namely herpes, hepatitis, Acquired Immune Deficiency Syndrome (AIDS); pharmaceutical preparations for the treatment of stroke; pharmaceutical preparations for the treatment of psychiatric diseases and disorders, namely mood disorders, anxiety disorders, panic disorders, cognitive disorders, schizophrenia, depression; pharmaceutical preparations for the treatment of osteoporosis; pharmaceutical preparations for the treatment of arthritis; pharmaceutical preparations for the treatment of multiple sclerosis; pharmaceutical preparations for the treatment of yeast infections; pharmaceutical preparations for the treatment of prostate disorders; pharmaceutical preparations for the treatment of pulmonary disorders; pharmaceutical preparations for use in oncology; pharmaceutical preparations for use in dermatology, namely dermatitis, skin pigmentation diseases; pharmaceutical preparations for use in ophthalmology; pharmaceutical preparations for use in ocular disorders; pharmaceutical preparations for use in gastroenterology; pharmaceutical preparations for the treatment of gynecological disorders, namely premenstrual syndrome, endometreosis, yeast infections, menstrual irregularities; pharmaceutical preparations, namely cholesterol preparations, namely preparations to lower cholesterol; pharmaceutical preparations namely tissue and skin repair preparations; pharmaceutical preparations namely acne medication; pharmaceutical preparations namely allergy medication; pharmaceutical preparations namely antacids; pharmaceutical preparations namely anthelmintics; pharmaceutical preparations namely antiarrhythmics; pharmaceutical preparations namely antibiotics; pharmaceutical preparations namely anticoagulants; pharmaceutical preparations namely anticonvulsants; pharmaceutical preparations namely antidepressants; pharmaceutical preparations namely antiemetics; pharmaceutical preparations namely antiflatulants; pharmaceutical preparations namely antihistamines; pharmaceutical preparations namely antihypertensives; pharmaceutical preparations namely anti-infectives; pharmaceutical preparations namely anti-inflammatories; pharmaceutical preparations namely antiparasitics; pharmaceutical preparations namely antibacterials; pharmaceutical preparations namely antifungals; pharmaceutical preparations namely antivirals; pharmaceutical preparations namely burn relief medication; pharmaceutical preparations namely calcium channel blockers; pharmaceutical preparations namely central nervous system depressants; pharmaceutical preparations namely central nervous system stimulants; pharmaceutical preparations namely cough treatment medication; pharmaceutical preparations namely diarrhea medication; pharmaceutical preparations namely gastrointestinal medication; pharmaceutical preparations namely glaucoma agents; pharmaceutical preparations namely hydrocortisone.

[37] With respect to the parties' channels of trade, the Opponent's evidence shows that the Opponent's pharmaceutical preparation for the treatment of respiratory diseases and their symptoms is a prescription medication that is administered by subcutaneous injection. It is marketed to health care professionals and patients through the Opponent's website, as well as through promotional and informative material left by sales representatives for health professionals and their patients. There is no information as to the Opponent's channels of trade for any of its other applied for goods.

[38] The Applicant, on the other hand, has filed no evidence with respect to its intended nature of trade, and its statements of goods are not restricted to any specific channels of trade. Therefore, in the absence of any evidence from the Applicant to the contrary, I assume that both parties' goods would be marketed and sold through the same channels of trade.

Degree of resemblance in appearance, sound and idea

[39] When assessing the degree of resemblance, it is not appropriate to dissect trademarks into their component parts. Trademarks instead must be examined as a whole. In *Masterpiece*, *supra* at paragraph 64, the Supreme Court of Canada states that the preferable approach when assessing resemblance is to first consider whether there is an aspect of the trademark that is particularly striking or unique.

[40] The Opponent submits that there is a strong phonetic and visual resemblance between the marks for the following reasons:

- Both word marks have three syllables;
- Both word marks start with the element "NU" and end with the vowel "A";
- Both word marks have a phonetically similar pronunciation and appearance arising from the identical prefix NU and the similar suffixes ADA and ALA.

[41] The Applicant's agent, on the other hand, submits that while the marks share the prefix NU, the marks are differentiated in appearance by the distinctive remaining portions CALA and PLADA which share no visual similarities. The Applicant's agent further submits that the marks are sounded differently, as the second portion of the Opponent's mark would be sounded as a short "a" as in the word "tequila" whereas the second portion of the Applicant's mark would be sounded as a long "a" as in the word "cicada".

[42] In my view, the most striking element in each case is the coined word forming each trademark. When I consider the trademarks as a whole, I find that while the differing middle components do result in some differences between the parties' trademarks in appearance, overall, I find that there is still a fair degree of resemblance between them as a matter of first impression.

[43] With respect to how the marks are sounded, in the absence of evidence from a linguistic expert, I cannot accept the Applicant's agent's argument that the marks would be pronounced differently. I therefore find that there is also some degree of resemblance between the marks when sounded as it is reasonable to assume that the average consumer would pronounce the ending of both marks with a short "a" sound.

[44] Finally, with respect to the ideas suggested by the marks, I do not find any resemblance between the marks since both are coined words that do not have any descriptive connotations. The idea suggested is therefore a neutral factor.

Conclusion regarding the likelihood of confusion

[45] The analysis of a likelihood of confusion is to determine whether, as a matter of first impression, a typical Canadian consumer somewhat in a hurry would think that goods bearing the two parties' marks come from the same source.

[46] As mentioned earlier, the degree of resemblance between the parties' marks is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion. This is particularly the case, however, where the parties' goods and the parties' channels of trade, are the same or overlapping [see *Reynolds Consumer Products Inc v PRS Mediterranean Ltd* (2013), 2013 FCA 119 (CanLII), 111 CPR (4th) 155 (FCA) at paras. 26-30].

[47] In this case, having considered all of the surrounding circumstances, and in particular the fact that the parties do not disagree that some of the Applicant's applied for goods do not target the same or similar indications as those of the Opponent's applied for goods, I find that the Applicant has met the onus on it to show that the balance of probabilities weighs in its favour on the issue of confusion with respect to the following goods:

- pharmaceutical preparations for the treatment of substance abuse disorders, namely alcoholism and drug addiction;
- pharmaceutical preparations for the treatment of carpal tunnel syndrome;
- pharmaceutical preparations for the treatment of varicose veins;
- pharmaceutical preparations for the treatment of dental and oral diseases;

- pharmaceutical preparations namely smoking cessation preparations;
- pharmaceutical preparations namely hypnotic agents; and
- pharmaceutical preparations namely sedatives.

[48] This ground of opposition succeeds with respect to all of the other applied for goods because the potential for direct overlap between the parties' goods tips the balance of probabilities for these goods in the Opponent's favour.

[49] Accordingly the section 16(3)(b) ground of opposition is successful in part.

REMAINING GROUNDS OF OPPOSITION

[50] The basis of the remaining registrability, entitlement and distinctiveness grounds of opposition are allegations of confusion with the Opponent's trademark NUCALA, application No. 1,503,132, which was applied for in association with pharmaceutical preparations for the treatment and prevention of a number of different diseases and disorders, (as set out in the attached Schedule B) and the Opponent's registered mark NUCALA, which issued to registration as No. TMA965,029 in association with "pharmaceutical preparations for the treatment of respiratory diseases and their symptoms."

[51] In view that the Opponent did not provide further details about the extent of its promotional activities for its NUCALA mark in Canada or any admissible evidence about the Opponent's sales from 2016 or 2017, I do not find that the Opponent has met its burden under the section 16(3)(a) or section 2 ground of opposition. These grounds are accordingly dismissed.

[52] With respect to the section 12(1)(d) ground, I have exercised my discretion to confirm that the Opponent's registration No. TMA965,029 is extant. The Opponent has therefore met its burden under this ground. I do not, however, intend to address this remaining ground of opposition in detail. Noting that the Opponent's evidence of use and reputation in Canada is almost entirely with respect to pharmaceutical preparations for the treatment of respiratory diseases and their symptoms, this ground of opposition would not have resulted in the refusal of any additional goods.

DISPOSITION

[53] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition with respect to the following goods:

- pharmaceutical preparations for the treatment of substance abuse disorders, namely alcoholism and drug addiction;
- pharmaceutical preparations for the treatment of carpal tunnel syndrome;
- pharmaceutical preparations for the treatment of varicose veins;
- pharmaceutical preparations for the treatment of dental and oral diseases;
- pharmaceutical preparations namely smoking cessation preparations;
- pharmaceutical preparations namely hypnotic agents;
- pharmaceutical preparations namely sedatives;

and I refuse the application with respect to all of the remaining applied for goods pursuant to section 38(12) of the Act.

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Cindy R. Folz
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD

HEARING DATE Monday, May 25, 2020

AGENTS OF RECORD

Robert A. MacDonald	For the Opponent
Gowling WLG	
Lesley Gallivan	For the Applicant
Marks & Clerk	

SCHEDULE A – APPLICATION NO. 1779293 – NUPLADA

Goods

Pharmaceutical preparations for the treatment of cardiovascular disease; pharmaceutical preparations for the treatment of central nervous system diseases and disorders, namely central nervous system infections, brain diseases, central nervous system movement disorders, ocular motility disorders, spinal cord diseases, encephalitis, epilepsy, Alzheimer's, cerebral palsy, Parkinson's disease; pharmaceutical preparations for the treatment of neurological diseases and disorders, namely brain injury, spinal cord injury, seizure disorders, Alzheimer's, Huntington's disease, cerebral palsy; pharmaceutical preparations for the treatment of genitourinary diseases, namely urological diseases, infertility, sexually transmitted diseases, inflammatory pelvic diseases; pharmaceutical preparations for the treatment of gastrointestinal/diseases and disorders; pharmaceutical preparations for the treatment of musculoskeletal diseases and disorders, namely connective tissue diseases, bone diseases, osteoporosis, spinal diseases, back pain, fractures, sprains, cartilage injuries; pharmaceutical preparations for the treatment of allergies; pharmaceutical preparations for the treatment of diabetes; pharmaceutical preparations for the treatment of hypertension; pharmaceutical preparations for the treatment of erectile dysfunction; pharmaceutical preparations for the treatment of sexual dysfunction; pharmaceutical preparations for the treatment of cancer; pharmaceutical preparations for the treatment of migraines; pharmaceutical preparations for the treatment of pain, namely headaches, migraines, back pain, pain from burns, neuropathic pain; pharmaceutical preparations for the treatment of obesity; pharmaceutical preparations for the treatment of inflammation and inflammatory diseases, namely inflammatory bowel diseases, inflammatory connective tissue diseases, inflammatory pelvic diseases; pharmaceutical preparations for the treatment of the respiratory system; pharmaceutical preparations for the treatment of infectious diseases, namely respiratory infections, eye infections; pharmaceutical preparations for the treatment of immunological diseases and disorders, namely autoimmune diseases, immunologic deficiency syndromes, Acquired Immune Deficiency Syndrome (AIDS); pharmaceutical preparations for the treatment of viral diseases and disorders, namely herpes, hepatitis, Acquired Immune Deficiency Syndrome (AIDS); pharmaceutical preparations for the treatment of stroke; pharmaceutical

preparations for the treatment of psychiatric diseases and disorders, namely mood disorders, anxiety disorders, panic disorders, cognitive disorders, schizophrenia, depression; pharmaceutical preparations for the treatment of substance abuse disorders, namely alcoholism and drug addiction; pharmaceutical preparations for the treatment of carpal tunnel syndrome; pharmaceutical preparations for the treatment of varicose veins; pharmaceutical preparations for the treatment of dental and oral diseases; pharmaceutical preparations for the treatment of osteoporosis; pharmaceutical preparations for the treatment of arthritis; pharmaceutical preparations for the treatment of multiple sclerosis; pharmaceutical preparations for the treatment of yeast infections; pharmaceutical preparations for the treatment of prostate disorders; pharmaceutical preparations for the treatment of pulmonary disorders; pharmaceutical preparations for use in oncology; pharmaceutical preparations for use in dermatology, namely dermatitis, skin pigmentation diseases; pharmaceutical preparations for use in ophthalmology; pharmaceutical preparations for use in ocular disorders; pharmaceutical preparations for use in gastroenterology; pharmaceutical preparations for the treatment of gynecological disorders, namely premenstrual syndrome, endometreosis, yeast infections, menstrual irregularities; pharmaceutical preparations, namely cholesterol preparations, namely preparations to lower cholesterol; pharmaceutical preparations namely smoking cessation preparations; pharmaceutical preparations namely tissue and skin repair preparations; pharmaceutical preparations namely acne medication; pharmaceutical preparations namely allergy medication; pharmaceutical preparations namely antacids; pharmaceutical preparations namely anthelmintics; pharmaceutical preparations namely antiarrhythmics; pharmaceutical preparations namely antibiotics; pharmaceutical preparations namely anticoagulants; pharmaceutical preparations namely anticonvulsants; pharmaceutical preparations namely antidepressants; pharmaceutical preparations namely antiemetics; pharmaceutical preparations namely antiflatulants; pharmaceutical preparations namely antihistamines; pharmaceutical preparations namely antihypertensives; pharmaceutical preparations namely anti-infectives; pharmaceutical preparations namely anti-inflammatories; pharmaceutical preparations namely antiparasitics; pharmaceutical preparations namely antibacterials; pharmaceutical preparations namely antifungals; pharmaceutical preparations namely antivirals; pharmaceutical preparations namely burn relief medication; pharmaceutical preparations namely calcium channel blockers; pharmaceutical preparations namely central nervous system depressants; pharmaceutical

preparations namely central nervous system stimulants; pharmaceutical preparations namely cough treatment medication; pharmaceutical preparations namely diarrhea medication; pharmaceutical preparations namely gastrointestinal medication; pharmaceutical preparations namely glaucoma agents; pharmaceutical preparations namely hydrocortisone; pharmaceutical preparations namely hypnotic agents; pharmaceutical preparations namely sedatives.

SCHEDULE B – APPLICATION NO. 1,530,132 – NUCALA

Goods

Pharmaceutical preparations for use as anti-infectives; Pharmaceutical preparations for the treatment of viral conditions, namely human immunodeficiency virus (HIV), HPV, RSV, hepatitis, herpes genitalis, herpes labialis, herpes simplex virus, varicella-zoster virus, Epstein-Barr virus and cytomegalovirus; Pharmaceutical preparations for the treatment and prevention of metabolic related diseases and disorders namely disorders of the endocrine system, diabetes, metabolic syndrome, obesity, weight loss and weight management; Pharmaceutical preparations for the treatment or prevention of cardiovascular,cardiopulmonary, cardio-renal, and renal diseases; Pharmaceutical preparations for the prevention and treatment of oncological diseases; Pharmaceutical preparations for the prevention and treatment of sequelae of oncologic diseases and their treatment namely nausea and vomiting, hematologic depression, mucositis, cachexia, pain and bone pain, fatigue; Pharmaceutical preparations for the treatment and prevention of respiratory diseases and their symptoms; Pharmaceutical preparations for the treatment of central nervous system infections, brain diseases, central nervous system movement disorders, ocular motility disorders, spinal cord diseases, depression and anxiety and their related disorders namely schizophrenia and psychoses; Pharmaceutical preparations for the treatment of Parkinson's Disease, Alzheimers disease and dementia; Pharmaceutical preparations for the treatment of insomnia, restless leg, fibromyalgia, epilepsy, migraine, pain, stroke and multiple sclerosis; Pharmaceutical preparations for the treatment of pain namely neuropathic pain, inflammatoryrelated pain and fibromyalgia; Pharmaceutical preparations for the treatment of inflammation and inflammatory related diseases and disorders namely arthritis, inflammatory bowel diseases inflammatory connective tissue diseases, COPD, asthma, atherosclerosis, vasculitis, synovitis, psoriasis, eczema, scleroderma, and other inflammatory-related skin disorders; Pharmaceutical preparations for the treatment of blood-related diseases and disorders namely thrombocytopenia, coagulation disorders, bleeding disorders, platelet disorders, blood vessel disorders, sickle-cell disease and its related disorders, anemias, and infections in or of the blood; Pharmaceutical preparations for the treatment of musculoskeletal diseases, disorders, and injuries namely connective tissue diseases, bone diseases, osteoporosis, spinal diseases, back pain, gout, fractures, sprains, sports injuries, osteogenesis imperfecta, muscle wasting (cachexia),

renal osteodystrophy, cartilage injuries, joint replacement, and osteoarthritis; Pharmaceutical preparations for use in ophthalmology; Pharmaceutical preparations for the treatment of dermatological diseases and disorders namely dermatitis, skin and skin structure diseases, infections, and injuries, psoriasis, eczema, and sexually transmitted diseases; Pharmaceutical preparations for the treatment of hormonal related diseases and disorders namely pre-term labour, hypogonadism, testosterone/androgen disorders and estrogen disorders; Pharmaceutical preparations for the treatment of gastrointestinal related diseases and disorders namely irritable bowel disorders and symptoms, digestive disorders, and acid related disorders; Pharmaceutical preparations for the treatment of sexual dysfunction namely erectile dysfunction, male and females sexual dysfunction disorders namely arousal disorder, pain disorder, desire disorder, and orgasm disorder; Pharmaceutical preparations for the treatment of genitourinary diseases namely urological diseases and disorders; Pharmaceutical preparations for the treatment of gynaecological diseases, reproductive health and fertility, contraception, bladder and continence disorders, prostate diseases and disorders; Pharmaceutical preparations for the treatment of sexually transmitted diseases, inflammatory pelvic diseases, pre-term labour, pre-eclampsia, vasomotor/menopausal symptoms, endometriosis/uterine fibroids, Leiomyoma, endourology/stone; Pharmaceutical preparations for the treatment of infectious diseases namely prostatitis, nephritis, cystitis, vaginitis, sexually transmitted diseases, renal disease; Pharmaceutical preparations for the treatment of PMDD/PMS, dysmenorrheal male hypogonadism, and hormonal disorders namely polycystic ovary syndrome; Pharmaceutical preparations for the treatment of male pattern baldness; Pharmaceutical preparations for the treatment of hepatological related diseases namely hepatitis, non-alcoholic fatty liver disease (NAFLD), non-alcoholic steatohepatitis (NASH), liver fibroids, and cirrhosis; Pharmaceutical preparations for the treatment of obesity or to aid in weight loss or weight management; Pharmaceutical preparations for the treatment of sepsis; Pharmaceutical preparations for the treatment of alopecia; Pharmaceutical preparations for the treatment of psychiatric diseases and disorders namely mood disorders, anxiety disorders, cognitive disorders, schizophrenia, and psychoses; Pharmaceutical preparations for the treatment of immune system related diseases and disorders, namely immunosuppressants; Pharmaceutical preparations for the treatment of damaged skin and tissue; Pharmaceutical preparations for the treatment of immunologic diseases and disorders, namely, autoimmune diseases and disorders; Pharmaceutical preparations for the

treatment of malaria; Pharmaceutical preparations for the treatment of tuberculosis; Allergy medications; Vaccines namely, prophylactic and therapeutic vaccines for humans.