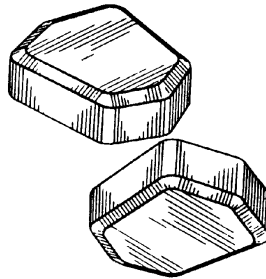


**IN THE MATTER OF AN OPPOSITION
by Novopharm Ltd. to application No. 688,588
for the trade-mark Tablet Design filed by
Burroughs Wellcome Inc. and now standing
in the name of Glaxo Wellcome Inc.**

On August 28, 1991, Burroughs Wellcome Inc. filed an application to register the distinguishing guise shown in the drawings reproduced below based on use of the guise in Canada since September of 1986. The application as advertised covered the wares “pharmaceutical preparations employing acyclovir as an active ingredient, namely tablets.” The application was advertised for opposition purposes on February 10, 1993. As a consequence of a merger on July 1, 1995, the application now stands in the name of Glaxo Wellcome Inc.



The opponent, Novopharm Ltd., filed a statement of opposition on April 13, 1993, a copy of which was forwarded to the applicant on June 16, 1993. The first ground of opposition is that the applicant’s application does not conform to the requirements of Section 30 of the Trade-marks Act because the applicant’s tablet design is not a trade-mark. The second ground is that the applicant’s application does not conform to the requirements of Section 30 of the Act because the tablet design is not a distinguishing guise.

The third ground of opposition is that the applicant’s application does not conform to the requirements of Section 30(b) of the Act because the applicant’s distinguishing guise has not been used with the wares claimed and has not been used since the date claimed. The fourth ground is that the applicant’s application does not conform to the requirements of Section 30(h) of the Act because it does not include a drawing of the applicant’s trade-mark as used.

The fifth ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3) of the Act because, as of the applicant's filing date, the applied for mark was confusing with "...other trade marks and distinguishing guises....that had been previously used by the Opponent among others." The sixth ground reads as follows:

The Opponent bases its opposition in [sic] the grounds provided by Section 38(2)(b) of the Act namely, that the trademark is not registrable in that the Applicant's shield-shaped tablet is descriptive of the pharmaceutical preparations in association with which it is used.

The seventh ground reads as follows:

The Opponent bases its opposition on the grounds provided by Section 32[sic](2)(b) of the Act, namely that the applicants [sic] alleged trade mark or distinguishing guise was not distinctive of the wares of the applicant at the date of filing of the application.

The eighth ground is that the applied for distinguishing guise is not distinctive in view of the fact that "shield-shaped" tablets have been used by various traders including the opponent. The opponent has listed 24 other such traders in its statement of opposition.

The applicant filed and served a counter statement. As its evidence, the opponent submitted the affidavits of Joseph H. Newton, Stuart Greenwood, Barnett Giblon, Paul Pitt and Sandra Pauline Scott. Messrs. Newton, Giblon and Pitt were cross-examined on their affidavits and the transcripts of those cross-examinations form part of the record of this proceeding. Mr. Greenwood was ordered to attend for cross-examination but he did not do so and the parties agree that his affidavit no longer forms part of the record.

As its evidence, the applicant submitted the affidavits of David Andrew Goff, Isis Elliott Caulder, Kenneth F. Walker, Orlando Caramignoli, Bernard Skarf and Peter Chin. All of the affiants except Mr. Chin were cross-examined on their affidavits and the transcripts of those cross-examinations and the answers to undertakings given during the Goff cross-examination form part of the record of this proceeding. Mr. Chin was ordered to attend for cross-examination but he did not do so and the parties agree that his affidavit no longer forms part of the record.

Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

As a preliminary matter at the oral hearing, the parties made submissions respecting the admissibility of the Scott affidavit. In her affidavit, Ms. Scott identifies herself as a trade-mark agent trainee. Appended as exhibits to her affidavit are notarized copies of five cross-examination transcripts purportedly from a previous opposition between Novopharm Ltd. and Burroughs Wellcome Inc. Since certified copies of the transcripts were not filed, Ms. Scott's exhibits fail to establish that the transcripts were sworn testimony in the previous opposition or that they were even filed as evidence in that opposition. Furthermore, Ms. Scott failed to submit certified copies of the affidavits which were the subject of the alleged cross-examinations. For those reasons, I ruled that the materials appended to the Scott affidavit could not be relied on in this proceeding.

The Opponent's Evidence

In his affidavit, Mr. Newton identifies himself as a pharmacist and states that he is familiar with the applicant's shield-shaped acyclovir tablets which are imprinted with the trade-mark ZOVIRAX on one side and a triangle on the other side. He states that, in the absence of those additional markings he would not be able to identify a blue or pink shield-shaped tablet as a ZOVIRAX tablet. On cross-examination, however, he was able to recognize the drawing of the applicant's distinguishing guise shown above as the applicant's ZOVIRAX tablet notwithstanding the absence of markings or color on that drawing (see page 19 of the Newton transcript). He also conceded that some patients who receive frequent refills of medications would likely recognize the appearance of their drugs - i.e. - their color, shape and size (see page 15 of the Newton transcript) and that patients taking ZOVIRAX on an ongoing basis would recognize the shape of the tablet.

In his affidavit, Mr. Newton identifies a list of 26 different tablets shown in the 1993

edition of The Compendium of Pharmaceuticals and Specialties which he describes as shield-shaped. However, he did not provide evidence establishing any acquired reputation in Canada for these different tablets. Furthermore, on cross-examination, it became apparent that the term “shield-shaped” used by Mr. Newton is vague and imprecise and could be applied to a wide range of shapes (see page 21 of the Newton transcript).

Messrs. Giblon and Pitt are both physicians who identify the same list of 26 “shield-shaped” tablets that Mr. Newton did. Like Mr. Newton, they, too, were only able to give a vague definition of the term “shield-shaped” (see page 20 of the Giblon transcript and page 14 of the Pitt transcript).

Both Messrs. Giblon and Pitt state that a tablet’s color, shape and size are of no significance to them. Neither of them would identify a shield-shaped tablet with no markings as a ZOVIRAX tablet. They both state that it is rare that a patient would ask for a medication by color, shape or size. Mr. Giblon has never heard a patient refer to his or her acyclovir medication by describing its shape (see page 14 of the Giblon transcript).

The Applicant’s Evidence

In her affidavit, Ms. Caulder reviewed the 1993 edition of The Compendium of Pharmaceuticals and Specialties with a view to determining the nature of the 26 tablets identified by Messrs. Newton, Giblon and Pitt. Ms. Caulder states that none of those 26 tablets was shown in that publication to comprise the drug acyclovir.

In his affidavit, Mr. Goff identifies himself as the Director, Corporate Affairs of Burroughs Wellcome Inc. He outlines the history of the drug acyclovir and its sale by Burroughs Wellcome Inc. under the trade-mark ZOVIRAX. His company first started selling the drug in an ointment form and the packages bore a two-dimensional trade-mark resembling the face of the applicant’s distinguishing guise. In September of 1986, Burroughs Wellcome Inc. started selling ZOVIRAX acyclovir in tablet form in the shape shown in the above

drawing, first in a 200 milligram dose and later in a 400 milligram dose. After 1990, the company also sold ZOVIRAX in an 800 milligram capsule. Sales of the tablets for the period 1987 to 1994 were about \$50 million dollars with the annual number of prescriptions being about 126,000 as of October of 1994. Sales prior to the filing of the present application were about \$25 million.

Mr. Goff states that Burroughs Wellcome Inc. has used a two-dimensional shield device similar to the applied for distinguishing guise on its bottles and boxes of ZOVIRAX acyclovir since 1986. He also states that his company has circulated thousands of copies of promotional literature to physicians and pharmacists which include a representation of the two-dimensional shield device. Appended as exhibits to Mr. Goff's affidavit are 33 examples of that literature. However, on cross-examination (see pages 17 ff.), it became apparent that most of those exhibits were published after the filing date of the present application and that a number of them do not relate to the tablet form of the applicant's ZOVIRAX product.

On cross-examination, Mr. Goff stated that Burroughs Wellcome Inc. has always sold its shield-shaped acyclovir tablets with the ZOVIRAX imprint on one side and a triangle imprint on the other. He conceded that the ZOVIRAX product bottle shown in Exhibit C-1 to his affidavit would not normally be given to patients and, even if it were, the printed matter on it would likely be covered by a pharmacist's label (see page 14 of the Goff transcript). Mr. Goff did not know whether the ZOVIRAX product box shown in his Exhibit C-3 had ever been given to patients.

Mr. Walker is a physician and a syndicated newspaper columnist who states that he frequently prescribes ZOVIRAX and is aware of the shield-shaped tablet. On cross-examination, he conceded that he does not see the tablet when he prescribes it. He also conceded that if the tablet did not have the triangle imprint on it, he might not recognize it as ZOVIRAX (see page 8 of the Walker transcript).

Messrs. Caramignoli and Skarf are pharmacists who swore essentially identical affidavits. They both state that they are familiar with the appearance of many pharmaceuticals. The drawing of the present distinguishing guise is included in each of their affidavits and they both state that it exclusively denotes Burroughs Wellcome Inc. as the source. However, on cross-examination, both gentlemen conceded that if they were presented with a white tablet of the same shape, they would not identify it as ZOVIRAX (see page 7 of the Caramignoli transcript and page 20 of the Skarf transcript).

The Grounds of Opposition

Initially, I wish to note that the descriptions of the applicant's distinguishing guise used by both parties in this case are not very helpful. Typically, both parties refer to the guise as being shield-shaped but this term is vague, imprecise and covers a multitude of different configurations. The applicant has even referred to its guise as being five-sided (see pages eight and twelve of the applicant's written argument) which is not the case. The guise is, in fact, six-sided. I consider the most helpful and accurate description of the applicant's guise for the purposes of this proceeding is hexagonal.

The first two grounds of opposition are that the applicant's application does not conform to the requirements of Section 30 of the Act because it is not for a trade-mark or a distinguishing guise. However, one of the definitions of a distinguishing guise appearing in Section 2 of the Act is "a shaping of wares" and that is precisely what the present application covers. Furthermore, Section 2 states that a distinguishing guise is a trade-mark. Thus, the first two grounds of opposition are unsuccessful.

As for the opponent's third ground of opposition, the onus or legal burden is on the applicant to show its compliance with the provisions of Section 30(b) of the Act: see the opposition decision in Joseph Seagram & Sons v. Seagram Real Estate (1984), 3 C.P.R.(3d) 325 at 329-330 and the decision in John Labatt Ltd. v. Molson Companies Ltd. (1990), 30

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

The applicant's own evidence establishes that there has been continuous use of its applied for distinguishing guise since the date claimed. The opponent did not tender evidence to dispute that claim but instead submits that the sale of the applicant's acyclovir tablets with the ZOVIRAX and triangle markings does not constitute use of the applied for mark. I disagree. I consider that sales of the applicant's actual tablet could constitute use of the distinguishing guise since the public would, as a matter of first impression, perceive use of the actual tablet as being use of the tablet's shape: see the opposition decision in Nightingale Interloc Ltd. v. Prodesign Ltd. (1984), 2 C.P.R.(3d) 535 at 538. Thus, the third ground is also unsuccessful.

As for the opponent's fourth ground of opposition, again the onus or legal burden is on the applicant to show that its application conforms to the requirements of Section 30(h) of the Act as per the Seagram case noted above. There is, however, an evidential burden on the opponent respecting its allegations of fact in support of that ground. The material time for considering the circumstances respecting the issue of non-conformance with the requirements of Section 30(h) of the Act is the filing date of the application.

Section 30(h) reads as follows:

30. An applicant for the registration of a trade-mark

shall file with the Registrar an application containing.....

(h) unless the application is for the registration only of a word or words not depicted in a special form, a drawing of the trade-mark and such number of accurate representations of the trade-mark as may be prescribed....

It is clear that the applicant has formally complied with the provisions of Section 30(h) since it did file a drawing as illustrated above. The issue then becomes whether or not the drawing is an accurate and adequate representation of the trade-mark applied for. I consider that it is. The applicant has provided two different representations of its distinguishing guise in three-dimensional perspective. This, in my view, provides sufficient information to define the mark claimed and used: see Novopharm Ltd. v. Burroughs Wellcome Inc. (1994), 58 C.P.R.(3d) 513 (F.C.T.D.); affg. (1993) 52 C.P.R.(3d) 263 at 268 (T.M.O.B.). Thus, the fourth ground is also unsuccessful.

The opponent submitted that the fourth ground should succeed because the drawings do not accurately depict the mark or guise actually used which includes the imprints of a triangle and the word ZOVIRAX. I disagree. As noted above, use of the actual tablet sold by Burroughs Wellcome Inc. also constitutes use of the shape of the tablet ‘per se.’ As noted by the applicant’s agent, the fact that the markings are lightly engraved on the tablet does not necessarily mean that those markings are part of the tablet’s overall shape since engraving is the only practical way to mark the tablet.

The fifth ground does not raise a proper ground of prior entitlement because it is based on the provisions of Section 16(3) of the Act. The present application is based on use in Canada, not proposed use. Thus, the fifth ground is also unsuccessful. Even if the fifth ground had been properly pleaded pursuant to Section 16(1) of the Act, it would have been unsuccessful. The opponent failed to evidence any prior use of its trade-marks and it is precluded from relying on prior use of third party marks : see Section 17(1) of the Act.

The sixth ground also does not raise a proper ground of opposition. The opponent has merely alleged that the applicant’s mark is descriptive of the pharmaceutical preparations

with which it is used. The opponent has failed to allege what the mark is clearly descriptive of such as the character, quality or origin of the wares as required by Section 12(1)(b) of the Act. Thus, the sixth ground is not in compliance with Section 38(3)(a) of the Act and is unsuccessful. Even if that hurdle had been overcome, I doubt that the opponent could have raised a proper ground under Section 12(1)(b) since it is difficult to discern what allegations of fact could have been included to support such a ground.

In its written argument, the applicant contended that the seventh ground of opposition is not in compliance with Section 38(3)(a) of the Act. I disagree. Although the wording of that ground could have been clearer, I consider that it is sufficient to raise a ground of non-registrability pursuant to Section 13(1)(a) of the Act - i.e. - that the applicant applied for distinguishing guise had not been so used in Canada by the original applicant to have become distinctive as of the filing date of the present application. From a review of paragraph 1(d) of the counter statement, it is apparent that the applicant understood the nature of the seventh ground since it denied the opponent's allegations and asserted that its distinguishing guise was distinctive of its wares at the date of filing the application.

Section 2 of the Act defines distinguishing guise as follows:

“distinguishing guise” means

- (a) a shaping of wares or their containers, or
- (b) a mode of wrapping or packaging wares

the appearance of which is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others.

Section 13(1)(a) of the Act reads as follows:

13(1) A distinguishing guise is registrable only if

- (a) it has been so used in Canada by the applicant or his predecessor in title as to have become distinctive at the date of filing an application for its registration...

By its very nature, a distinguishing guise such as the applicant applied for shaping of wares is inherently weak since it is to a large extent functional: see Gillette Canada Inc. v. Mennen Canada Inc. (1991), 40 C.P.R.(3d) 76 (F.C.T.D.); affg. (1989), 27 C.P.R.(3d) 467 at 472 (T.M.O.B.). In the present case, the applicant's guise serves as the medium through which the applicant's medication is delivered. Given the wealth of pharmaceutical tablets in the

marketplace, the inherent ability of the applicant's guise to function as a trade-mark is secondary, at best. That is presumably why Section 13(1)(a) of the Act calls for evidence of acquired distinctiveness before allowing such a mark to be registered. In other words, the initial presumption is that a distinguishing guise by itself would generally not be recognizable as a trade-mark by consumers and should not be registered until such time as they have been educated by the trade-mark owner as to its alternate status.

In the present case, the evidence establishes that the shape of the applicant's ZOVIRAX tablet appears to be unique among pharmaceutical tablets in the Canadian marketplace. However, the evidence also establishes that there is a wide variety of shapes used for pharmaceutical tablets. Furthermore, there are at least several other hexagonally-shaped tablets in the marketplace and a number of others that have shapes similar to the applicant's tablet. Thus, the applicant's distinguishing guise is inherently weak even within its own market although not as inherently weak as more common shapes such as a biconvex tablet. Thus, the heavy onus placed on an applicant by Section 13(1)(a) of the Act is even more severe in the present case. By way of analogy, reference may be made to Section 12(2) of the Act and the requirements for obtaining registration of a clearly descriptive mark. The degree of evidence required to show acquired distinctiveness of a trade-mark pursuant to Section 12(2) is inversely proportional to the degree of inherent distinctiveness of the mark: see Molson Companies Limited v. Carling Breweries Ltd. (1988), 19 C.P.R.(3d) 129 (F.C.A.).

The material time for considering the issue arising pursuant to Section 13(1)(a) of the Act is the applicant's filing date - i.e. - August 28, 1991. The test to be applied is whether or not the evidence is sufficient to show that the average purchaser of the applied for wares recognizes the applicant's distinguishing guise as distinguishing the applicant's wares from those of others. An average purchaser of pharmaceutical wares in general would include physicians, pharmacists and patients: see Ciba-Geigy Canada Ltd. v. Apotex Inc. (1992), 44 C.P.R.(3d) 289 at 315 (S.C.C.). The test then becomes how extensive is the potential class of purchasers for the specific pharmaceutical wares claimed in the statement of wares? In the present case, since the applicant's wares comprise an acyclovir tablet that can be used for the

treatment of everything from herpes to shingles to chicken pox, the average purchaser could be any adult Canadian. Thus, the applicant is required to show that most adult Canadians recognize the applicant's distinguishing guise as such.

In the present case, the evidence is not overwhelming. On the applicant's side, we have one physician and two pharmacists who state that they recognize the applicant's distinguishing guise as identifying the source of the wares. However, on cross-examination, they conceded that if the applicant's tablet was without certain markings or of a different color, they might not recognize the shape as pointing to the same source. On the opponent's side, we have one pharmacist and two physicians who state that they give no significance to the shape of tablets in identifying them. However, on cross-examination, it became apparent that they might well recognize the shape of the applicant's tablet as unique to the applicant.

The Goff affidavit provides evidence of substantial sales of the applicant's tablets prior to the filing date of the present application. However, impressive sales figures alone will not necessarily satisfy the applicant's burden: see the Molson Companies case referred to above. This is particularly so in the present case where the applicant's guise is inherently weak and the nature of the trade minimizes the possibility that the consuming public (and even physicians and pharmacists) will even see the shape of the tablets when purchased. Furthermore, given the nature of the wares, the substantial sales figures are restricted to a relatively small class of purchasers who, in this case, tend to be repeat purchasers. Thus, the vast majority of Canadians are not aware of the shape of the applicant's tablets, much less whether or not that shape functions as a distinguishing guise.

The applicant relied on the promotional literature appended as exhibits to the Goff affidavit to establish that Burroughs Wellcome Inc. had educated people as to the trade-mark status of the shape of its tablet. However, most of those materials were produced after the material time and some were for products other than the ZOVIRAX tablet. Furthermore, given the nature of the trade, those materials were only circulated to a limited audience, namely physicians and pharmacists.

It was incumbent on the applicant to establish that Canadian consumers had become aware of its distinguishing guise as of the material time and that they recognized it as a trade-mark in its own right. There is no direct evidence from consumers in this case stating their recognition of the applicant's distinguishing guise. The guise itself is not inherently strong such that it would be easily recognized as such without the owner educating the public as to its trade-mark status and there is limited evidence of such education. Furthermore, there is no survey evidence showing that a significant portion of the consuming public recognizes the shape of the ZOVIRAX tablet as a trade-mark: see Eli Lilly and Co. v. Novopharm Ltd. (1997), 73 C.P.R.(3d) 371 at 395 (F.C.T.D.). In fact, what little indirect evidence there is about the public's awareness suggests that they do not recognize the shape of the applicant's tablet as a distinguishing guise. Thus, I find that the applicant has failed to satisfy the onus on it pursuant to Section 13(1)(a) of the Act. The seventh ground is therefore successful.

As for the eighth ground of opposition, the onus or legal burden is on the applicant to show that its guise or mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - April 13, 1993): see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.).

My conclusions respecting the seventh ground are also applicable here. The applicant's evidence on the issue of distinctiveness was not sufficient as of the filing of the present application for the purposes of Section 13(1)(a) of the Act and the intervening evidence between that date and the filing of the opposition does not greatly advance the applicant's case. There were additional sales but, as noted earlier, sales alone are not of great assistance to the applicant's case. More of the promotional material appended as exhibits to the Goff affidavit is relevant but again it suffers from its limited circulation. Furthermore, the evidence shows that in 1993 there were other similarly shaped tablets in the marketplace although it is difficult

to determine if they had acquired any reputation themselves among the consuming public. On balance, I find that the applicant has failed to satisfy the heavy onus on it of showing that its guise is distinctive throughout Canada. Thus, the eighth ground is also successful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 5th DAY OF FEBRUARY, 1999.

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