LE REGISTRAIRE DES MARQUES DE COMMERCE

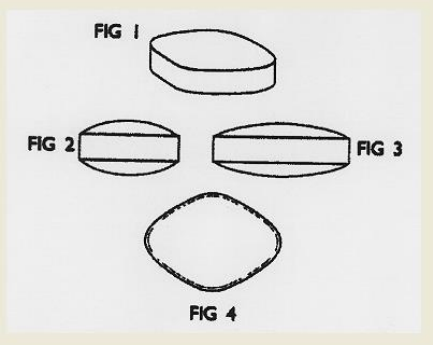
THE REGISTRAR OF TRADE-MARKS

Citation: 2013 TMOB 27
Date of Decision: 2013-01-23

IN THE MATTER OF AN OPPOSITION by Canadian Generic Pharmaceutical Association to Application No. 1,244,118 for the trade-mark MISCELLANEOUS THREE DIMENSIONAL DESIGN in the name of Pfizer Products Inc.

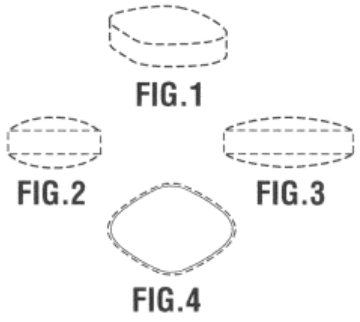
File History

[1] On January 19, 2005, Pfizer Products Inc. (the Applicant) applied to register the trade-mark, VIAGRA TABLET DESIGN subsequently amended to **MISCELLANEOUS THREE DIMENSIONAL DESIGN,** based on its use in Canada since at least as early as March 1999 in association with a pharmaceutical preparation for the treatment of sexual dysfunction (the Wares). The drawing and description in the application as filed are shown below:



Colour is claimed as a feature of the trade-mark. The trade-mark consists of the colour blue as applied to the whole of the visible surface of the tablet shown in the attached drawings. Figure 1 represents a perspective view from above and one side. Figure 2 represents an end view. Figure 3 represents a side view. Figure 4 represents a view from below or above. The designations Fig. 1, Fig. 2, Fig. 3 and Fig 4 do not form part of the trade-mark.

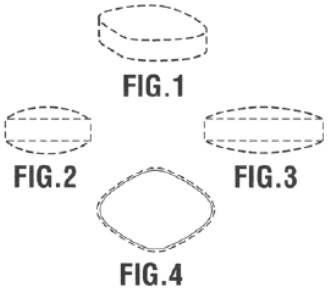
[2] On April 29, 2005 an official action was issued and the Examiner requested that the Applicant amend the drawing to show the tablet entirely in dotted outline and remove the statement "colour is claimed as a feature of the trade-mark". The Applicant responded to amend the drawing and description as set out below (the Mark):



The trade-mark consists of the colour blue as applied to the whole of the visible surface of the tablet shown in the attached drawings. Figure 1 represents a perspective view from above and one side. Figure 2 represents an end view. Figure 3 represents a side view. Figure 4 represents a view from below or above. The designations Fig. 1, Fig. 2, Fig. 3 and Fig 4 do not form part of the trade-mark.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of October 5, 2005:

1,244,118. 2005/01/19. Pfizer Products Inc., Eastern Point Road, Groton, Connecticut 06340, UNITED STATES OF AMERICA
Representative for Service/Représentant pour Signification: GOWLING LAFLEUR HENDERSON LLP, SUITE 2600, 160 ELGIN STREET, OTTAWA, ONTARIO, K1P1C3



Colour is claimed as a feature of the Trade-mark. The trade-mark consists of the colour blue as applied to the whole of the visible surface of the tablet shown in the attached drawings. Figure 1 represents a perspective view from above and one side. Figure 2 represents an end view. Figure 3 represents a side view. Figure 4 represents a view from below or above.

The designations FIG.1, FIG.2, FIG.3 and FIG.4 do not form part of the trade-mark.

WARES: A pharmaceutical preparation for the treatment of sexual dysfunction. **Used** in CANADA since at least as early as March 1999 on wares.

[4] An erratum was published on May 17, 2006.

[5] The Canadian Generic Pharmaceutical Association (the Opponent) filed a statement of opposition to the application on March 6, 2006 based on sections 38(2)(a), 38(2)(b) and 38(2)(d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). An amended statement of opposition was filed on April 21, 2006 and accepted on November 7, 2006. The Opponent's grounds of opposition are reproduced in full at Schedule 1.

[6] The Applicant filed and served a counter statement in which it denied all of the grounds of opposition.

[7] As its evidence, the Opponent filed the affidavits of Dr. Shawna Perlin, Cathy Conroy and Deborah Kall. As its evidence, the Applicant filed the affidavits of Dr. Ronald Weiss, Marie Berry, Tiffany Trunko, Marc Charbonneau, Dr. Ruth Corbin and Sharon Elliott. As its reply evidence, the Opponent filed the affidavits of Julie Tam, Dr. Howard Shiffman, Laura Furdas,

Deborah Zak, Paula Rembach and Dr. Alain D'Astous. Cross-examination of each of these affiants was conducted and transcripts filed.

[8] Both parties filed detailed written arguments. A hearing was held on May 22-24, 2012 at which both parties were represented.

Preliminary Ruling at the Oral Hearing

[9] At the beginning of the second day of the oral hearing the Opponent requested in writing that I recuse myself from presiding to avoid a reasonable apprehension of bias. In this regard, the identity of the Trade-marks Opposition Board Member assigned to decide an opposition is generally only revealed at the commencement of the hearing. The parties were given the opportunity at the beginning of the third day of the hearing to make submissions. While I initially advised the parties that I would hear from each of them for 15 minutes and decide thereafter, I did permitted the parties extended time and I adjourned the hearing for approximately 45 minutes to consider the matter. Upon my return to the hearing, I declined to recuse myself and indicated that my reasons for doing so would follow in the final decision.

Background Facts

[10] The Applicant in this case was represented by Gowlings (Ottawa office) from the filing of the application until April 3, 2012 when representation changed to Torys. I was employed by Gowlings (Toronto office) as a summer student (2003), articling student (2004-2005) and an associate (2005 – June 3, 2011). During my employment, I had no involvement with this file or the related applications or oppositions (application Nos. 883,144; 883,145; 886,243; 1,090,313; 1,090,326; 1,090,327; 1,090,328 or 1,090,329). Furthermore, as I disclosed to the parties, during my employment I only had involvement in two pharmaceutical colour/shape/size applications. This involvement was in the capacity of a junior lawyer working under more senior lawyers.

[11] With the permission of the Chairperson of the Board, I confirm I did confer with the Chairperson about the appropriateness of the hearing assignment given my previous employment and the necessity of advance disclosure in advance of the hearing. I decided that no advance disclosure was needed as I had previously been assigned files from Gowlings' offices (other than Toronto) and my assignment was consistent with the practice of the Trade-marks Opposition Board concerning conflicts of interests of Board Members.

Positions of the Parties

[12] The Opponent submitted that my employment by Gowlings (Toronto office) gives rise to a reasonable apprehension of bias. The Opponent's allegation of an apprehension of bias appears to be three pronged, namely, (1) that my prior employment with Gowlings gives rise to a reasonable apprehension of bias; (2) that the fact that Gowlings has represented those applying for colour/shape/size applications gives rise to a reasonable apprehension of bias and (3) the fact that the Applicant switched agents in advance of the hearing is as a result of the Canadian Intellectual Property Office disclosing my identity in advance.

[13] The Applicant indicated that it was not going to take a "strong position" on the recusal request but acknowledged that it was my decision. However, the Applicant did provide me with authorities and brief submissions which suggested that there was not a reasonable apprehension of bias. The Applicant also raised the issue of potential delay in the proceedings if another Opposition Board Member was to be assigned the hearing. I, however, did not account for delay in arriving at my decision as this is not a relevant circumstance.

Reasons for Preliminary Ruling

[14] I will deal first with the Opponent's allegation that the Canadian Intellectual Property Office disclosed in advance to the Applicant or its counsel that I was the Member assigned to this matter in advance of the change of representation to Torys. Such disclosure would be in direct contravention of the Canadian Intellectual Property Office's policy. In the absence of any evidence that such a disclosure occurred, and with it not uncommon for a party to change

counsel during the course of a proceeding, I do not find that the Opponent's first reason to request my recusal is credible.

[15] The issue to be determined is whether the Opponent has demonstrated that there is a reasonable apprehension of bias if I hear and determine this case. It is not a subjective test, nor does it ask if the party alleging bias has a real concern, but rather:

> what would an informed person, viewing the matter realistically and practically — and having thought the matter through — conclude. Would he think that it is more likely than not that [the decision-maker], whether consciously or unconsciously, would not decide fairly. [*Committee for Justice and Liberty v National Energy Board*, [1978] 1 SCR 369 at 394]

[16] Second, Members of the Trade-marks Opposition Board prior to joining the Board have expertise in trade-marks law. One of the ways in which such expertise has been gained is through the practice of law. Members are expected to impartially adjudicate cases involving positions which they themselves may have advocated in the past. Such advocacy does not lead to a reasonable apprehension of bias [*Sanofi-Aventis Canada Inc v Novopharm Ltd* (2006), 54 CPR (4th) 151 at paras 23-24 (FC)].

[17] Third, I. I do not find that my prior employment by another office of the Applicant's prior counsel results in a reasonable apprehension of bias. I was employed by a different office of Gowlings as an associate rather than a partner of the firm. At the time of the hearing more than eleven months had passed since my employment ended. No financial or personal relationships with the firm, its partners, clients or employees continued after my employment ended. Lastly, my decision not to recuse myself was influenced by the fact that the law is clear that decision-makers should resist the urge to step aside in the face of a bias objection as it is their duty to hear the cases that they have been assigned.

Legal and Evidentiary Onus

[18] In an opposition, the Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidentiary burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exists [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)].

Material Dates

[19] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30 - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475], however, where an application is amended after filing, the amendment is to be considered [*Ipex Inc v Royal Group Inc* (2009), 77 CPR (4th) 297 (TMOB) at para 34]

- sections 38(2)(b)/12(1)(b) - the filing date of the application [*Fiesta Barbeques Ltd v General Housewares Corp* (2003), 28 CPR (4th) 60 at para 26 (FCTD)];

- sections 38(2)(b)/12(1)(e) - the date of my decision [*Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 at 424 (FCA)]; and

- sections 38(2)(d)/2 - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 at 324-325 (FC)].

Evidence - Preliminary Issues

Admissibility of the Affidavit of Sharon Elliott

[20] The Opponent objected to the affidavit of Sharon Elliott (Opponent's written argument, section 5.1). Ms. Elliott attaches 18 affidavits and cross-examination transcripts filed in the oppositions to application Nos. 883,145, 886,243 and 883,144 for the VIAGRA BLUE TABLET DESIGN (for the 25, 50 and 100 mg tablets respectively). In its written argument, the Applicant

states that the affidavits are not relied upon for the truth of their contents (Applicant's written argument, para 13). In view of this, with the exception of the 1986 license agreement attached at Exhibit 5 to Ms. Elliott's affidavit which is discussed in paragraph 45 below, I have not relied on the exhibits to Ms. Elliott's affidavit.

Reply Evidence

[21] In its written argument, the Applicant objected to the reply evidence as not being proper reply (paras 92-96). At the oral hearing, the Applicant indicated that it was objecting to the affidavits of Dr. Howard Shiffman, Laura Furdas and Julie Tam. Section 43 of the *Trade-marks Regulations*, SOR/96-195 (the Regulations) requires that evidence be strictly confined to matters in reply. An opponent that is uncertain about whether its evidence constitutes proper reply is able to request leave to file additional evidence [see s 44 of the Regulations]. I note that no such request was made by the Opponent.

[22] Justice Pelletier in *Halford v Seed Hawk Inc* (2003), 24 CPR (4th) 220 (FCTD) at paras 14-15 provided the following guidelines as to what constitutes proper reply evidence:

> (i) Evidence which is simply confirmatory of evidence already before the court is not to be allowed.
> (ii) Evidence which is directed to a matter raised for the first time in cross examination and which ought to have been part of the plaintiff's case in chief is not to be allowed. Any other new matter relevant to a matter in issue, and not simply for the purpose of contradicting a defence witness, may be allowed.
> (iii) Evidence which is simply a rebuttal of evidence led as part of the defence case and which could have been led in chief is not to be admitted.
> (iv) Evidence which is excluded because it should have been led as part of the plaintiffs' case in chief will be examined to determine if it should be admitted...

[23] With respect to the affidavit of Dr. Howard Shiffman, I find that paragraphs 1-28 constitute proper reply evidence. These paragraphs detail Dr. Shiffman's background and mandate (paras 1-16) and evidence on whether "little blue pill" and/or "little blue diamond pill" are synonymous with VIAGRA (paras 17-28). I find that these paragraphs reply directly to Dr.

Weiss' evidence regarding the use of "little blue pill" by patients and physicians. Paragraphs 29-61 are a rebuttal of evidence lead by the Applicant and could have been led as part of the Opponent's evidence and are therefore inadmissible. Paragraph 62 does not reply to any evidence led by Dr. Weiss and is inadmissible.

[24] With respect to the affidavit of Laura Furdas, I find that paragraphs 1-10, 21-32 and 64-69 constitute proper reply evidence. These paragraphs detail Laura Furdas' background and mandate (paras 1-10), evidence on the use of "little blue pill" and "little blue, diamond shaped pill" (paras 21-32, 67-69), and the switching of patients from VIAGRA to another erectile dysfunction medicine (paras 64-66). The remainder of the paragraphs are inadmissible as they are simply a rebuttal of evidence by the Applicant and could have been led as part of the Opponent's evidence and/or are confirmatory of the evidence of Cathy Conroy.

[25] I find the affidavit of Julie Tam to be proper reply evidence as it responds directly to an issue raised in the cross-examination of Dr. Ruth Corbin. The Applicant's objection that the affidavit is inadmissible as it offends the rule in *Browne v Dunn* (1893) 6 R 67 (UK HL) that a cross-examiner give a witness notice of his intention to use extrinsic evidence to impeach his or her credibility (see John Sopinka, Sidney N. Lederman and Alan W. Bryant,*The Law of Evidence*, 2nd ed., 1999, §16.146) is addressed below in paragraph 30.

Expert Evidence

[26] As part of its evidence concerning the issue of distinctiveness, the Applicant filed the affidavit of Dr. Ruth Corbin, a survey expert. Her affidavit attached a previous affidavit that she had sworn in the oppositions to application Nos. 883,145, 886,243 and 883,144 for the VIAGRA BLUE TABLET DESIGN (for 25, 50 and 100 mg tablets respectively). The affidavit filed in the previous cases attaches a survey of pharmacists undertaken in 2002. In order to be admissible, expert evidence must meet the four criteria set out in *R v Mohan*, [1994] 2 SCR 9 (SCC):

- relevance;
- necessity in assisting the trier of fact;
- absence of any exclusionary rule; and

• from a properly qualified expert.

[27] I do not find that the evidence of Dr. Ruth Corbin is relevant to the assessment of distinctiveness at the material date of March 6, 2006. The survey of pharmacists was conducted between September 9 and October 8, 2002 (Exhibit B, page stamped 1716). It involved showing 402 pharmacists eight pharmaceuticals, including VIAGRA, with markings removed (Exhibit B, pages stamped 1717-1718). For each pharmaceutical, respondents were asked to indicate whether it was made by one company or more than one company (Exhibit B, page stamped 1718-1719). The survey purports to provide evidence that the colour, shape and size of VIAGRA is recognized by more than three quarters of pharmacists as indicating a single manufacturing source (Exhibit B, page stamped 1713).

[28] In her cross-examination, Dr. Corbin indicates that the 2002 results are relevant to 2006 since her experience with well-marketed products means awareness would increase as a product becomes entrenched (Qs 20-23, 38) and this would be the case even if another blue diamond pill had been introduced (Qs 43-45). Dr. Corbin's answers to Qs 27-33 appear to indicate that Dr. Corbin's statements with respect to distinctiveness in 2006 may be limited to VIAGRA's distinctiveness regarding medications that treat erectile dysfunction. However the relevant marketplace is all pharmaceuticals [*Novopharm Ltd v Pharma* (2005), 48 CPR (4th) 455 (TMOB) at 468]. The relevant portions of Dr. Corbin's cross-examination are set out below.

> Q20 And did you ever ask if there should be a survey for this proceeding, or have any discussions regarding any type of survey other than the one you swore – or attached in your Affidavit?
>
> I would have contemplated such advice and concluded that a new survey would not have been necessary for this proceeding.
>
> Q21 … And why is that?
>
> The results on the awareness of Viagra should be expected to be the same or stronger in a later year than they were at the time that this survey was conducted.

Q22 … And how much later, one year, two years, three years, four years? Does it matter?

The longer you give Viagra to advertise and make itself known, presumably the more entrenched awareness becomes.

Q23 … And you're convinced of that?

My experience as a marketer has proven that many times over about well-known products in the marketplace.

Q27 And are you aware whether or not since that time another blue pill has been introduced in the pharmaceutical market in Canada?

I am advised that no blue pill has been introduced with these indications which is what would be relevant to Viagra's distinctiveness in its section.

Q28 … what are the indications?

Whatever the indications are for that particular pharmaceutical, sildenafil citrate.

Q29 And what are those indications? Do you know?

I know its main indication being for erectile dysfunction.

Q30 … And who told you that since October, 2002 that no other blue pill has been introduced into Canada for erectile dysfunction?

I asked Mr. Smith to obtain that information for me, or to inform me on that, and he did so.

Q33 … Did you ask Mr. Smith whether a blue pill was introduced in Canada for an indication other than erectile dysfunction?

I didn't ask him that.

Q34 And does that matter to your conclusion that the Viagra tablet would be distinctive for years later?

My conclusions for this survey haven't changed.

Q35 No, no, but you've come up with a new conclusion… Your new conclusion is that this survey would be as valid as it was in 2002 in 2003, 2004, 2005, 2006

because, as far as you're aware, the longer Viagra is on the market, the more entrenched it becomes in consumers' minds, the more distinctive it becomes; isn't that your evidence?

… Not only is that my evidence, but I note that in the earlier survey we had included pills that were blue, and so that possibility has already been taken into account.

Q36 Okay. So I ---

… as control conditions. It included just the colour blue independent of the combination of size, shape and colour as a control condition.

Q38 … So in this particular case, the longer you go out from the date of the survey was conducted, the stronger the – are you saying that the results are even – would be even stronger if you conducted the survey today, the results

I'm not saying that for today, I'm talking about a date that would have been four or five years after this study that the awareness results would not have materially changed.

Q39 … And you're doing that on the basis of Mr. Smith advising you that since 2002 there was no blue erectile dysfunction drug introduced on the market?

Certainly not on that basis, and it's not what I said. In fact I just recently mentioned that it turns out – if you look at the original report, we concluded blue, and so your question becomes irrelevant. We already included the control for colour alone, and we're talking in this study about the combination of size, shape and colour.

Q43 … And are you are of whether or not a blue diamond shape pill was introduced subsequent to conducting the survey … for any indication other than erectile dysfunction?

Although I'm not, that certainly would not change my conclusions from this study.

Q45 And that if there was another blue diamond shape tablet for antibiotic, that wouldn't change your conclusions concerning the results of this study?

As I mentioned this study concerns the unique combination of a size, shape and colour, and that's what my conclusions are about.

[29] I do not find Dr. Corbin's answers on cross-examination consistent with my understanding of the survey since she asserts that even if another blue diamond shaped pill had been introduced between 2002 and 2006, the distinctiveness of the Mark would be the same or increased. The Applicant argues that the Opponent should be required to show that such a pill was introduced. I do not agree. The Applicant must show that its expert evidence is relevant by showing that all necessary circumstances and controls have been taken into account and that the evidence applies to the material date. For the reasons set out above, I find that Dr. Corbin's opinion evidence is not relevant to the issue of distinctiveness at the material date and is inadmissible. In light of my conclusion it is unnecessary for me to address the Opponent's other objections to Dr. Corbin's evidence.

[30] As I have found Dr. Corbin's evidence to be inadmissible, there is no need for me to consider the affidavits of Dr. Alain d'Astous or Julie Tam [*Rollerblade, Inc v Skate Jeans Inc* (2001), 14 CPR (4th) 375 at 378 (TMOB)]. If my finding on the affidavit of Dr. Corbin is incorrect, I would not have had regard to the affidavit of Dr. d'Astous. Dr. d'Astous bases the conclusions in his affidavit on principles of pattern recognition, a part of cognitive psychology. In his cross-examination, Dr. d'Astous further explains that what is in his affidavit is his opinion "based on some theoretical background because this opinion is founded on my knowledge of psychology, mental processes and the scientific literature in this area" (Q69). However, I do not find that Dr. d'Astous is a properly qualified expert in this field. I note that Dr. d'Astous is not a cognitive psychologist and stated in cross-examination that while he has written a textbook in which he discusses heuristics he does not include excerpts of it since the Kannerman and Tversky text (which was attached) is more credible (Qs 200-221). With respect to the affidavit of Julie Tam, I would have found Ms. Tam's evidence admissible as the *Browne v Dunn* rule is not offended. The letter attached to Ms. Tam's affidavit signed by Dr. Corbin was put to her in cross-examination (see Q1, Exhibit 5 to the cross-examination of Dr. Corbin; and pg 669 of the examination of Dr. Corbin on June 25, 2003 attached as Exhibit C to the affidavit of Dr. Corbin). Although Dr. Corbin did not authenticate the letter, the protection in *Browne v Dunn* is not needed since the letter was put to the affiant.

Section 38(2)(a) Grounds of Opposition

[31] The Opponent pleads that the application does not comply with sections 30(a), 30(b), 30(h) and 30(i) of the Act.

Section 30(a) Ground of Opposition

[32] The Opponent alleges that the application does not comply with section 30(a) of the Act. Section 30(a) of the Act requires that an application contain a statement in ordinary commercial terms of the specific wares in association with which the mark has been used.

[33] The Opponent argues that the Wares are not in ordinary commercial terms since sexual dysfunction encompasses a wide array of diseases including erectile dysfunction, premature ejaculation, delayed ejaculation and low libido (Opponent's Written Argument, paras 272-273). Although the Wares could have been more specifically defined as "sidenafil citrate" or "a pharmaceutical preparation for the treatment of erectile dysfunction", such a degree of specificity is not required. The *Trade-marks Office Practice Notice Compliance with Paragraph 30(a) of the Trade-marks Act - Pharmaceuticals* (dated August 6, 2003) permits applicants to name a type of disease where the type is specific to a particular area of the body. For example, the Practice Notice above indicates that "pharmaceutical preparations for the treatment of genitourinary diseases, namely, … sexually transmitted diseases…" is acceptable. The subject application conforms to the above mentioned Practice Notice and is in ordinary commercial terms. Accordingly, this ground of opposition is rejected.

Section 30(b) Ground of Opposition

[34] Section 30(b) of the Act requires, for a trade-mark that has been used in Canada, the date from which the applicant or his named predecessors in title, if any, have so used it. Section 30(b) requires that there be continuous use of the applied-for trade-mark in the normal course of trade from the date claimed to the filing date of the application [*Benson & Hedges (Canada) Ltd v Labatt Brewing Co* (1996), 67 CPR (3d) 258 (FCTD) at 261-262]. Section 4(1) of the Act sets out the requirements of use of a trade-mark for wares:

> A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

In *Syntex Inc v Apotex Inc* (1984), 1 CPR (3d) 145 (FCA) at 151, Justice Stone explains that the critical point in time is the time of transfer:

> Use of a trade-mark is deemed to have occurred if at the time property in or possession of the wares is transferred, in the normal course of trade, it is "marked on the wares themselves or on the packages in which they are distributed". The mark thus may come to the attention of the transferee in a direct way at the time of transfer which is the critical point in time. Similarly, for there to be a deemed use, notice of any other manner of association is likewise to be given at that same point in time.

[35] The Opponent alleges that the application does not conform to section 30(b) because the Mark has not been used pursuant to section 4 since March 1999 for the following reasons:

- the Mark is not visible at the time of transfer and no notice of association is given;
- the mark used, which includes the entire appearance of the tablet including markings, is not the Mark;
- the Wares are split into two smaller triangular shaped tablets (see para 40 below) such that the Mark has not been used;
- the Mark has not been used since the date claimed (March 1999); and
- there was improper licensing such that the Applicant did not use the Mark.

[36] The legal onus is on the Applicant to show that its application complies with section 30 of the Act. To meet its evidentiary burden, the Opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist [*John Labatt Ltd, supra*]. The Opponent's burden is, however, lighter with respect to section 30(b) of the Act because the facts supporting use of the Mark are particularly within the knowledge of the Applicant [*Tune Masters v Mr. P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89]. While the Opponent may rely upon the Applicant's evidence to meet its evidentiary burden in relation to this ground, if it does, it must show that the Applicant's

evidence is "clearly" inconsistent with the Applicant's claims set forth in the application [*York Barbell Holdings Ltd v ICON Health & Fitness Inc* (2001), 13 CPR (4th) 156 at 162 (TMOB)].

Visibility and Notice of Association at Time of Transfer

[37] The evidence of Marc Charbonneau, Senior Product Manager for VIAGRA, is that since 1999, over 2 million samples have been distributed to patients (para 21). Samples are distributed in a box which provides information to patients with respect to using VIAGRA (Ex C-2). In his cross-examination, Mr. Charbonneau explains that samples are given to physicians who then distribute them to patients (Qs 191-192). Dr. Perlin, a family physician, explains that, if she does have VIAGRA samples, patients will remove medication from the box at the time samples are given to them.

> Q110 And you mentioned, and I don't think this was clear, when he pulled out the product package insert, you said your patients flip it out. What were you referring to?
>
> Well, sometimes in the office, if I do have samples, then I will give them a sample package. And most of the time they will take out the box, they don't want to carry around a box, they find it cumbersome, especially men, they don't have a purse or anything, so they will just take out whatever medication is and put it in their pocket or in their jacket, or whatever. …
>
> Q111 I am just trying to understand the word "flip". When you say the word "flip", it is not clear…
>
> They take it out and they throw it right in the garbage … because they don't want to be carrying around all this stuff.
>
> Q112 … So are you telling me this is something that you have seen the patients do? Yes, I have.

[38] So long as samples are given in anticipation of securing orders and sales, the provision of samples is in the normal course of trade [*CBM Kabushiki Kaisha v Lin Trading Co Ltd* (1985), 5 CPR (3d) 27 (TMOB) at 31-33]. As Dr. Perlin has indicated that when samples are given, patients "will take out the box, they don't want to carry around a box, they find it cumbersome, especially men", put the medication in their pocket or jacket, and throw the box out, I find that at least some of the patients receiving samples would have seen the Mark at the time of transfer. As

I have found that some patients receiving samples have seen the Mark, it is not necessary for me to conclude whether patients receiving a prescription for VIAGRA for the first time are shown the tablets by their pharmacists. As such, a section 30(b) ground of opposition based on the Mark not being visible at the time of transfer or there being no notice of association cannot succeed.

Use of the Mark Applied-For

[39] The Opponent alleges that the Mark has not been used since the tablets sold by the Applicant have always featured the markings "Pfizer" on one side and "VGR 25", "VGR 50", or "VGR 100" on the other. The section 30(b) ground of opposition based on the fact that the tablets have markings cannot succeed since a member of the public would, as a matter of first impression, perceive use of the actual tablet as also being use of the Mark alone since the markings are minor in nature [*Novopharm v Burroughs Wellcome Inc* (1993), 52 CPR (3d) 263 at 269 (TMOB)].

Tablet Splitting

[40] While there is evidence that some patients split their tablets (see for example, the affidavit of Cathy Conroy, a pharmacist, at para 9), there is no evidence that this is widespread or that it occurs at the time of transfer. As such, a section 30(b) ground of opposition based on tablet splitting cannot succeed.

Use Since the Date Claimed

[41] There is no evidence that supports the ground of opposition based on the allegation that the Mark has not been used since March 1999. Consequently, the Opponent has not satisfied its initial burden and a ground of opposition based on failure to use the Mark since March 1999 cannot succeed.

Licensing

[42] The Opponent alleges that the Wares are manufactured by Pfizer Canada Inc. without a proper license from the Applicant, such that the Mark has not been used by the Applicant since March, 1999.

[43] Tiffany Trunko, Assistant General Counsel-Trademarks of Pfizer Inc. and head of the Pfizer Global Trade-mark Department, provides the following evidence in her affidavit and cross-examination:

- Pfizer Products Inc. and Pfizer Canada Inc. are wholly owned subsidiaries of Pfizer Inc. and are part of the Pfizer Group of Companies (para 2).
- VIAGRA is sold in Canada under license by Pfizer Canada Inc. (para 2).
- The license covers all of the trade-marks applicable to VIAGRA tablets including the VIAGRA trade-mark, the PFIZER trade-mark and the "blue diamond tablet three dimensional tablet" (Qs 107-110). These trade-marks are licensed to Pfizer Canada Inc. and the license includes strict quality control over the use of the mark on, or in connection with the goods and the quality of the goods themselves (Qs 112-115).
- During the course of cross-examination, Ms. Trunko provides the following answers to questions about the specific trade-mark license in place:

  Q119 With respect to [the] trade-mark application in question, is there a license agreement in place?

  Yes. With respect to the blue diamond trade-mark of Viagra, yes.

  Q120 But it's not attached to your affidavit here?

  It is not attached, correct.

  Q122 [The terms] of this specific trade-mark license agreement?

  Sure. Relate to licensing of the trade-mark to Pfizer Canada Inc. and the parameters under which they use the mark in connection with the product that they sell.

  Q123 And what are those parameters?

Like any trademark license, length of time, quality control, rights upon termination, infringement. There are others.

Q124 Okay. What's the length of time applicants hold in this license agreement?

The, for this particular blue diamond tablet trade-mark of Viagra, the period, the minimum is – at least the period of which this product has been sold in Canada.

Q125 As in when was it entered into and when does it expire?

There is an agreement from 1986 that covered this product, and a – an additional agreement that replaced that entered into 2006.

Q127 When you say the agreement of 1986 – that was entered into in 1986, does that relate to the colour, shape and size of the Viagra tablet?

The 1986 trade-mark license agreement was long before this trade-mark existed. It is an agreement between Pfizer Inc and Pfizer Canada. And over time – it has a large schedule of trade-marks, and over time grew to include marks that came into being after the signing date, the effective date of the license. It did come to include marks later developed by Pfizer, including those pertaining to Viagra.

Q128 When you said that that agreement was between Inc and Canada, Pfizer Inc.

There is a 1986 agreement between Pfizer Inc and Pfizer Canada Inc.

Q131 Thank you.

There is a separate agreement, which I mentioned directly between Pfizer Products Inc and Pfizer Canada Inc., dated 2006. And there are further agreements relating to the 1986 document.

- During re-examination (Qs 497-505) and cross-examination on the re-examination questions (Qs 506-510), Ms. Trunko provided further information regarding the license agreements.

Q502 You mentioned a 1986 agreement with Pfizer Canada and Pfizer Inc.; can you discuss what, if any, role Pfizer Products had in relation to that agreement?

The 1986 trade-mark license agreement between Pfizer Inc and Pfizer Canada Inc evolved in such a way that Pfizer Products Inc which did not exist in 1986

> stepped into the shoes of Pfizer Inc as licensor. And was subsequently, many of those same license mark became the subject of a 2006 agreement, directly from Pfizer Products Inc to Pfizer Canada Inc.
>
> Q510 Yes. We've asked that you produce the relevant license agreements then?
>
> (Counsel) … We'll consider that.

[44] The Opponent objected to Question 502 during the cross-examination as being improper since "a re-examination is to clarify an ambiguous answer that is unclear, not to raise new areas and ask witnesses to discuss things". The law on re-examination is explained by Watt JA in *R v Candir* (2009), 257 OAC 119 (OCA) at para 148:

> It is fundamental that the permissible scope of re-examination is linked to its purpose and the subject-matter on which the witness has been cross-examined. The purpose of re-examination is largely rehabilitative and explanatory. The witness is afforded the opportunity, under questioning by the examiner who called the witness in the first place, to explain, clarify or qualify answers given in cross-examination that are considered damaging to the examiner's case. The examiner has no right to introduce new subjects in re-examination, topics that should have been covered, if at all, in examination in-chief of the witness.

I find that the re-examination was proper as it afforded the witness the opportunity to explain an answer concerning the 1986 agreement. No new area was raised.

[45] The Opponent also requests that I draw an adverse inference because neither the 1986 nor 2006 License Agreements were produced. I note that the 1986 agreement was attached to the affidavit of Sharon Elliot filed in this proceeding and counsel for the Applicant drew this to the attention of counsel for the Opponent (see Q1 to the cross-examination of Marc Charbonneau). With respect to the 2006 agreement, consideration of it is not relevant for the purposes of section 30(b) as it falls after the material date, January 19, 2005, the filing date of the application.

[46] While the Applicant's evidence with respect to the licensing of the Mark could have been clearer, Ms. Trunko's evidence that the 1986 agreement evolved to cover several marks, that the Applicant "stepped into the shoes" of the licensor and that a license with the Applicant has governed all of the trade-marks used in the sale of VIAGRA since the time it has been sold in

Canada is not clearly inconsistent with the Applicant's claim of use since March 1999. As such, the Opponent has not met its initial burden and the section 30(b) ground of opposition based on a failure of the Applicant to properly license the Mark is rejected.

Section 30(h) Ground of Opposition

[47] Section 30(h) of the Act provides that an application shall contain, "...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." In *Apotex Inc v Monsanto Canada Inc* (2000), 6 CPR (4th) 26 (FCTD), Rouleau J discusses the requirements of section 30(h) at 31-32:

> First, paragraph 30(h) of the Trade-marks Act provides that a trade-mark application must contain a drawing of the trade-mark and such number of accurate representations of the mark as may be prescribed. The onus is on the applicant for a mark to show its compliance with this requirement of the legislation. The drawing submitted must be a meaningful representation of the applicant's mark in the context of the written description appearing in the application and must enable the determination of the three-dimension limits of the tablet to which the colour is applied. The rationale behind these statutory requirements is that a trade-mark registration is a monopoly and must therefore, be precise in terms of its scope.

[48] The Opponent alleges that the Applicant does not comply with section 30(h) of the Act for the following reasons:

- the drawing is not accurate since the trade-mark as used includes markings (paras (3)(d)(i) and (3)(d)(x) of the Statement of Opposition);
- no specific shade of blue is specified and the Mark covers a wide range of colours (paras (3)(d)(vii) and (3)(d)(xi) of the Statement of Opposition);
- the 50 and 100 mg tablets may be split by consumers rendering the shape of the tablet taken a triangle (para (3)(d)(xii) of the Statement of Opposition); and
- the drawing and description fail to define whether the mark is two dimensional or three dimensional, may show a distinguishing guise, consist of colour and shape or colour, shape and size, cover all sizes and shapes, permit the associated wares to be variety of sizes and shapes. Furthermore, it is unclear whether the solid lines on the drawing appear on the tablet and, if three dimensional, no disclaimer of the three dimensional object is offered (paras

(3)(d)(ii), (3)(d)(iii), (3)(d)(iv), (3)(d)(vi), (3)(d)(ix), (3)(d)(x) and (3)(d)(viii) of the Statement of Opposition).

The Opponent's allegation that the drawing shows a distinguishing guise (para (3)(d)(v)) will be addressed in the section considering the section 38(2)(b) ground of opposition.

Markings Issue

[49] The Opponent alleges that the Mark does not include an accurate drawing since the Mark as used includes markings on the tablet. The markings are minor in nature, with "Pfizer" and "VGR 25", VGR 50" or "VGR 100" (depending on dose) lightly scored on the top and bottom of the VIAGRA tablets. These markings would not be regarded by consumers as part of the Mark [*Novopharm v Burroughs Welcome, supra*]. Furthermore, it has already been concluded that it is possible to file an application for the appearance of a tablet without including the markings on the capsule [*Novopharm Ltd v Eli Lilly and Company* (2004), 45 CPR (4th) 254 (TMOB) at 282]. Accordingly, the section 30(h) ground of opposition based on the markings on the VIAGRA tablet is rejected.

Colour Issue

[50] The Opponent alleges that no shade of blue is specified and the Mark covers a broad range of colours that consumers cannot differentiate between. While the Applicant may have been more specific in the description of the colour blue (by attaching either a colour patch or referencing a specific shade from a colour identification system), there is no requirement to further describe "blue" [*Novopharm Ltd v Pfizer Products Inc,* 2009 CarswellNat 4119 (TMOB) at para 23]. Moreover, section 28 of the Regulations specifies that the colour of a trade-mark shall be described and provides a list of colours, including blue, which may be indicated. This supports the Applicant's submissions that further specification of blue is not required. Accordingly, the section 30(h) ground of opposition based on the failure to specify a particular shade of blue is rejected.

Tablet Splitting

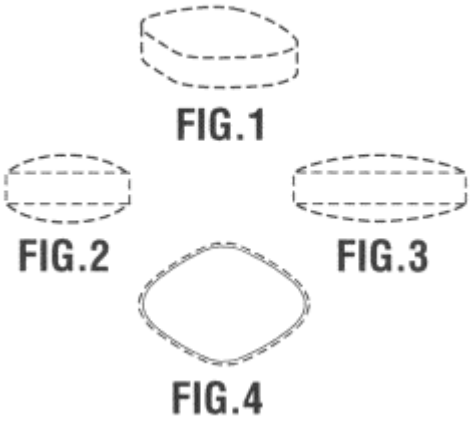
[51] The Opponent alleges that, in the normal course, consumers split the 100 mg VIAGRA tablets such that the drawing is not representative of the shape of the tablet. While the evidence shows that some consumers may split their tablets after purchase, this cannot result in non-compliance with section 30(h) since the drawing shows the Mark as used.

Inaccurate Drawing

[52] The Opponent alleges that the Mark is not accurately represented and does not comply with the requirements of section 30(h) of the Act on the basis that the drawing and description fail to define the Mark as two-dimensional or three-dimensional and, if three-dimensional, fail to disclaim the object in the dotted outline; fail to show whether the Mark consists of colour and shape or colour, shape and size; and fail to limit the monopoly applied-for as the Mark appears to cover all sizes and a variety of shapes. The Opponent also alleges that it is unclear whether the solid lines on the drawing appear on the tablet.

[53] The drawing and description (as amended) are reproduced below:

TRADE-MARK:



TRADE-MARK DESCRIPTION:

The trade-mark consists of the colour blue as applied to the whole of the visible surface of the tablet shown in the attached drawings. Figure 1 represents a perspective view from above and one side. Figure 2 represents an end view. Figure 3 represents a side view. Figure 4 represents a view from below or above.

TRADE-MARK EXCLUSION:
The designations FIG.1, FIG.2, FIG.3 and FIG.4 do not form part of the trade-mark.

[54] The Opponent first alleges that the drawing and description may indicate a two-dimensional or three-dimensional trade-mark and covers all shapes. I do not find any such ambiguity since the drawing and description clearly show that the claimed colour will be applied-to the six sides of a three dimensional diamond shaped tablet with width, height and depth as opposed to a two dimensional figure lacking depth. Furthermore, the Applicant has complied with the *Trade-marks Office Practice Notice: Three Dimensional Marks (2000-12-06)* which requires, for a three-dimensional mark, the application should include a description of the mark that makes it clear that the mark applied-for is a three-dimensional mark. In this case, the description "whole of the visible surface of the tablet shown in the attached drawings" does so.

[55] With respect to the size of the tablets, while the evidence demonstrates that the VIAGRA tablets do increase slightly in size according to dose; there is no requirement for the Applicant to restrict the Mark claimed to a specific size [*Simpson Strong-Tie Company, Inc v Peak Innovations Inc* (2009), 79 CPR (4th) 79 (FCTD) at para 65].

[56] In view of the foregoing, I find that the application complies with section 30(h) as it contains a meaningful representation of the Mark. The drawing and description "the colour blue applied to the whole of the visible surface of the tablet shown in the attached drawing" indicates that the Mark is the colour blue applied to the visible surface of the tablet rather than the tablet itself. The limits of the Mark are clearly defined by the drawing and description. Finally, I note that it is not fatal to the application that the drawing includes both dotted and solid lines [*Novopharm Ltd v Pfizer Products Inc*; *supra* at para 27] or that the description fails to include a disclaimer since disclaimers often give rise to ambiguity [*Novopharm Ltd v Astra AB* (2000), 6 CPR (4th) 16 at para 8; *Novopharm Ltd v Pfizer Products Inc*; 2009 CarswellNat 4120 (TMOB) at para 30 *(Novopharm Ltd v Pfizer Products (No 2))*]. Accordingly, the section 30(h) ground of opposition based on the allegation that the drawing is inaccurate is rejected.

Section 30(i) Ground of Opposition

[57] The Opponent alleges that the application does not comply with section 30(i) as the Applicant could not have been satisfied it was entitled to register the Mark since: (i) the Applicant is aware of other pills with similar appearances; (ii) consumers do not consider the colour or shape of a pharmaceutical to be a trade-mark; (iii) registration of the Mark would unreasonably limit development of the Canadian pharmaceutical industry by excluding a generic version of VIAGRA with the same colour/shape/size and (iv) the Applicant has obtained an industrial design registration showing that the appearance of the tablet is merely ornamental.

[58] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground of opposition should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155] or where there is a *prima facie* case of non-compliance with a federal statute such as the *Copyright Act* RSC 1985, c C-42, *Food and Drugs Act*, RSC 1985, c F-27 or *Canada Post Corporation Act*, RSC 1985, c C-10 [*Interactiv Design Pty Ltd v Grafton-Fraser Inc* (1998), 87 CPR (3d) 537 (TMOB) at 542-543].

[59] As its evidence in support of this ground of opposition, the Opponent has submitted the file history of this application as Exhibit A to the affidavit of Ms. Kall. Within the file history is a copy of the affidavit of Jennifer McKay (an associate of the Applicant's agent at the time) dated March 31, 2005 in which Ms. McKay states:

> para 6 Further, the Applicant currently holds three Canadian patents relating to the subject matter of the application, namely, patent numbers 2,163,446; 2,044,748; and 2,262,268. When Canadian pharmaceutical patents expire or when generic manufacturers enter the market, it is normally the practice of generic pharmaceutical companies to copy the trade dress of the brand holder. It is important that the rights of the Applicant to the subject matter of the application be firmly established prior to the expiry of the above references patents or the market entry of generic manufacturers.
>
> para 7 In this regard, generic manufacturers have already sought to come to market, despite the patents, by filing a submission for regulatory approval and alleging that the patents are invalid or would not be infringed. Therefore, the effective patent protection may be less than the actual [*sic*] expiry date of the

> patent. As such, the Applicant's rights will be compromised unless this application is expedited.

[60] The Opponent argues that this evidence is sufficient to meet the Opponent's burden since it shows that the subject application is to supplement patent protection. The affidavit of Jennifer McKay, however, cannot meet the Opponent's evidential burden since the case law establishes that a mark consisting of colour applied to the surface of a tablet can constitute a trade-mark [see, for example, *Smith Kline & French Canada Ltd v Canada (Registrar of Trade Marks)*, [1987] 2 FC 633 (FCTD)]. This is even the case when the tablet is also subject to patent protection where the patent does not dictate the shape of the tablet [*Novopharm Ltd v Pfizer Products Inc*, *supra* at para 51]. There is no such evidence here. As the application includes the required statement and there is no evidence of bad faith or other exceptional circumstances underlying the Opponent's allegations, the section 30(i) ground is rejected.

Section 30 and Section 2 of the Act

[61] As part of the section 30 ground of opposition, the Opponent has alleged that the Mark is not a trade-mark within the meaning of section 2 of the Act since the Mark cannot be used to distinguish the Applicant's Wares from those of others. The definition of a trade-mark in section 2 of the Act is:

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

[62] Mr. Charbonneau explains that the blue diamond shape was chosen for its unique appearance among pharmaceutical products (para 9) and that the Applicant has engaged in extensive marketing of VIAGRA to educate the public and establish a brand identity with respect to the Mark (para 16). The evidence of advertising, appearing in the affidavit of Marc Charbonneau and described below, is directed at physicians, pharmacists and patients, and consistently includes depictions of the Mark:

- Materials and samples are provided to health care professionals for distribution to patients. For example, commencing in 2001 thousands of copies of the *Treatment*

Optimization Pad were provided to physicians (Exhibit C-13), from this pad a page with information about VIAGRA can be torn off and provided to a patient. This page includes the *www.viagra.ca* web-site and toll free number for patients to call for more information (para 35). Over 2000 calls have been received from the Helpline since 2003 and over 150,000 page views to the web-site between 2004 and 2006 (para 36). Since 1999 over 2 million samples of VIAGRA have been distributed to patients (para 21).

- In 2006, there were approximately 110 sales representatives across Canada promoting VIAGRA (para 3; Qs 71, 74-76). These sales representatives visit health care professionals and provide "detail aids" which are tools which provide education around erectile dysfunction and how to optimize treatment with VIAGRA (Q153-154). Exhibit D provides examples of such material distributed to health care professionals (Exs D1-D73).
- Since 2001, VIAGRA television commercials have been aired in Canada (Exs E-4 – E-11, Q328). Mr. Charbonneau indicates that the 2005 *Bleep* commercial series (Exs E-7 – E-8) received over 3000 Gross Rating Points which corresponds to 30% of a target audience being exposed to the advertising (paras 118, 122). While such evidence is hearsay, I am prepared to give it some weight since it appears that such information would be provided to the Applicant in the normal course (Qs 330-336) [*Miller Brewing Co v Labatt Brewing Co* (1991), 36 CPR (3d) 400 at 406 (TMOB)].
- Since 2001 print advertising has appeared in *Time, Sports Illustrated, Macleans* and the *Toronto Star* (paras 132 and 134). I take judicial notice that the *Toronto Star* has wide circulation in the Toronto area and the other publications have some circulation in Canada [*Milliken & Co v Keystone Industries (1970) Ltd* (1986), 12 CPR (3d) 166 (TMOB) at 168-169].

[63] There is no evidence of record that the Applicant lacked the intention to use the Mark as a trade-mark. The Opponent's evidence is directed to the ability of the Mark to distinguish the Wares rather than the Applicant's intention with respect to the Mark. Accordingly, the Opponent has not met its evidential burden and the ground of opposition based on section 2 of the Act is rejected.

Section 38(2)(b) Grounds of Opposition

Mark is Not Registrable Because it is a Distinguishing Guise

[64] The Opponent alleges that the Mark is not registrable since it is a distinguishing guise being directed to the shaping of the Wares; the Wares being a particular colour. While there are arguments which support such an interpretation of the Act, the Federal Court and the Registrar have held that a particular colour, applied to a particular shape of a tablet is the proper subject of a trade-mark and not a distinguishing guise [see, for example, *Smith Kline & French Canada Ltd v Canada (Registrar of Trade-marks)* (1987), 14 CPR (3d) 432 (FCTD); *Novopharm Ltd v Purdue, supra* at 475*; Novopharm Ltd v Pfizer Products Inc, supra* at 29]. As part of its submissions on this ground of opposition, the Opponent argues that the Mark should have been assessed in examination and opposition as a distinguishing guise (Opponent's Written Argument, para 419) because (as filed) the drawing was in all solid lines and the description did not disclaim the tablet. As discussed above, because the Applicant subsequently amended the drawing and description, there is no requirement for the application to be assessed as a distinguishing guise since the application is to be assessed as amended [*Ipex Inc v Royal Group Inc* at para 34]. Accordingly, the application is not contrary to section 38(2)(b) on the basis that the Mark is a distinguishing guise.

Application is Contrary to 12(1)(b)

[65] The Opponent alleges that the Mark is not registrable pursuant to section 12(1)(b) of the Act. Section 12(1)(b) prohibits the registration of a trade-mark which is clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services with which it is used or proposed to be used. As there is no evidence that the Mark is clearly descriptive or deceptively misdescriptive in the English or French language of a characteristic or quality of the Wares, the Opponent has not met its evidentiary burden and this ground of opposition is rejected.

Application is Contrary to Section 12(1)(e)

[66] The Opponent alleges that the Mark is not registrable pursuant to section 12(1)(e) of the Act because it is prohibited by section 10 of the Act as the Mark is recognized by patients as designating a kind or type of medication and by pharmacists and other health care professionals as designating the kind and quantity of the Wares. Section 10 prohibits the adoption of marks that have through ordinary commercial usage become recognized in Canada as designating the kind, quality, quantity, destination, value, place of origin or date of production of the wares.

[67] To meet its initial burden, the Opponent must demonstrate that the Mark (or any other mark "so nearly resembling that mark as to be likely to be mistaken therefor") was used extensively in Canada prior to the relevant date to designate a type of medication, and that the Mark had an accepted definition or meaning in the industry [*Producteurs Laitiers du Canada v Republic of Cyprus (Ministry of Commerce, Industry & Tourism)* (2010), 84 CPR (4th) 421 (FC) at para 54; aff'd (2011), 93 CPR (4th) 255 (FCA)].

[68] The Opponent has failed to meet its burden as there is no evidence that the Mark had an accepted meaning in the pharmaceutical industry as designating the Wares as opposed to suggesting the brand VIAGRA specifically. As such, this ground of opposition is rejected.

Application Must be Refused as it was Not Re-advertised

[69] The Opponent alleges that the failure of the application to be re-advertised to correct an error in the original advertisement means that the application must be refused. The application as advertised included the statement "colour is claimed as a feature of the Mark" which had been deleted during prosecution. The Registrar subsequently published an erratum on May 17, 2006.

[70] Section 16 of the Regulations states that every advertisement shall set out the trade-mark claimed. Although the wording of section 16 is mandatory it does not mean that any error, omission or oversight in an advertisement nullifies the advertisement [*Enterprise Car & Truck Rentals Ltd v Enterprise Rent-A-Car Co* (2000), 7 CPR (4th) 368 (TMOB) at 373]. The Federal

Court of Appeal in *McDonald's Corp v Registrar of Trade-marks* (1989), 24 CPR (3d) 463 (FCA) at 466 explains the circumstances where re-advertisement appears to be required:

> The prohibition of amendments after advertising set out in s. 37 must be construed in light of the purpose of the advertising. It is to put on notice those of the public whose interests may be affected by the registration. It is not those who have entered into opposition proceedings, as the present appellants, whose rights may be unfairly impaired by the acceptance of amendments as required by Hardee. Those persons are involved and will, as here, have the opportunity to oppose the application as amended. Rather, it is those who considered the application as advertised and decided they had no basis upon which to oppose it. They might have decided otherwise had they been aware of the true basis upon which the application was ultimately to be disposed of. The legislation contemplates only one advertisement per application.

[71] The Opponent argues that the fact that the deleted statement "colour is claimed as a feature of the Mark" appears in the advertisement means that the application was required to be re-advertised. Since the Federal Court in *Novopharm Ltd v Bayer Inc* (1999), 3 CPR (4th) 305 (FCTD) at para 21 indicated that colour is one feature of trade-marks involving colour applied-to tablets of a particular shape and size, and the colour blue can be regarded as one of the features of the Mark, re-advertisement was not required. The error in the advertisement cannot be said to have impacted potential opponents' assessment of the application because the colour blue is a feature of the Mark. The publication of an erratum was sufficient in this case. Therefore, the section 38(2)(b) ground of opposition based on the failure of the application to be re-advertised is rejected. As I have found that the publication of an erratum was sufficient in this case, it is not necessary for me to decide whether the failure of an advertisement to be re-advertised is a valid ground of opposition.

Section 38(2)(d) Grounds of Opposition

[72] The Opponent alleges that the Mark is not distinctive for the following reasons:

- The Mark does not distinguish the Wares from those of others prescribed and taken in Canada (Statement of Opposition para (5)(a)).

- The Mark does not distinguish the Wares from other similarly shaped pills such as VIGREX, VEEGA and SILAGRA for treating sexual dysfunction (Statement of Opposition para (5)(c)).
- In the absence of the PFIZER and VGR 25, VGR 50 and VGR 100 markings, the colour and shape does not distinguish the Wares (Statement of Opposition para (5)(d)).
- The appearance of the tablets is used to indicate dosage and or therapeutic effect and not source (Statement of Opposition para (5)(e)). In addition, consumers are predisposed to differently sourced pharmaceuticals having a similar appearance (Statement of Opposition para (5)(i)).
- As the Applicant has patents for the Wares, the Applicant has exclusive rights and as no others are permitted to manufacture and sell the Wares, the Mark cannot distinguish the Wares of the Applicant from the wares of others (Statement of Opposition para (5)(f)).
- The Applicant cannot rely on its patent monopoly in the Wares to establish distinctiveness of the applied-for Mark which is merely the alleged appearance of the Wares; nor can the Applicant seek to extend its monopoly by inferring distinctiveness (Statement of Opposition para 5(g)(h)).
- The Applicant has not properly licensed the mark to other users, including Pfizer Canada Inc., in accordance with section 50 of the Act (Statement of Opposition para (5)(h)).

Each of the Opponent's allegations will be considered below although not necessarily in the order in which they appear.

[73] The material date for assessing the non-distinctiveness of the mark is the filing date of the statement of opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, *supra*]. Accordingly, the material date in this proceeding is March 6, 2006, the date the original statement of opposition was filed [*2076631 Ontario Ltd v 2169-5762 Quebec Inc*; 2011 CarswellNat 2643 (TMOB) at para 91].

VIGEX, VEEGA and SILAGRA Pills

[74] As no evidence of the colour, shape, or size of VIGEX, VEEGA, or SILAGRA pills or their availability in Canada has been furnished, the Opponent's distinctiveness ground of opposition cannot succeed based on this allegation.

Patents Related to VIAGRA

[75] The Opponent alleges that the Mark is not distinctive because the Applicant has exclusive rights in respect of the Wares, the Mark cannot distinguish the Wares of the Applicant and, moreover, the Applicant cannot rely on its patent monopoly to establish distinctiveness. I adopt the comments of Chairperson Carreau who in *Novopharm Ltd v Pfizer Products Inc, supra* at para 51 states:

> A patent associated with a drug is not an impediment to a trade-mark registration for the colour and shape of the tablet where the patent does not dictate the shape of the tablet [*Apotex Inc v Searle Canada Inc* (1997), 85 CPR (3d) 104 (TMOB)]. Further, there is no authority for the proposition that distinctiveness cannot be acquired during a period of patent monopoly [*Thomas & Betts Ltd v Panduit Corp* (2000), 4 CPR (4th) 498 (FCA) at 505].

[76] Accordingly, the distinctiveness ground of opposition cannot succeed on the basis that the Applicant has obtained patent protection for the Wares.

Appearance Indicates Therapeutic Effect and Dosage Not Source

[77] The Opponent alleges that the Mark is not distinctive because "the appearance of the tablets is used to indicate dosage and/or therapeutic effect and not source". In other words, patients, pharmacists and physicians identify the Mark with a tablet that treats sexual dysfunction. With respect to pharmacists, Ms. Conroy's evidence is that colour of a medication can help avoid dispensing errors (para 28). With respect to physicians, Dr. Perlin's evidence is that she would "never rely on the colour, shape and size of a drug to determine the type of medication it contains" (para 13). Neither of these affiants' evidence supports the allegation that physicians or pharmacists use appearance to indicate dosage and/or therapeutic effect. With respect to patients, they appear to associate the Mark with VIAGRA itself in addition to the

dosage or therapeutic effect. Dr. Perlin provides the following evidence in her cross-examination:

> Q62 And is it fair to say that when a patient undergoes this … maybe we can call it a ritual of punching through the tablet and seeing the other side of the blister package that has the Pfizer symbol and the Viagra symbol, that they might develop an association between that blue diamond tablet and the words?
>
> I think they associate the pill, with "This is great, this is Viagra, and I am going to take this and it is going to make me have an erection and I am going to have some good sex." But it is not going to be … to say also that they are going to associate it with Pfizer is really … I have never in my life, with this drug or any other drugs, ever heard anyone say to me, "This is a great drug made by so-and-so and so". They will say "Viagra worked for me". …

While Ms. Conroy provided evidence that patients typically associate the appearance of pills with the type of medication and do not associate appearance with a particular brand or manufacturer (para 34), her evidence speaks about medications generally as opposed to VIAGRA tablets specifically. With respect to Dr. Perlin's evidence that "patients are more comfortable with an interchangeable product that is similar in appearance to the first product available", this evidence again addresses pharmaceuticals generally. Furthermore, the question of whether a generic product should have the same appearance as that of a brand name product to avoid misunderstanding on the part of the patient is not a question that the Registrar has authority to rule on [*Novopharm Ltd v Eli Lilly & Co* (2004), 45 CPR (4th) 177 (TMOB) at para 34].

[78] Given the evidence of Ms. Conroy and Dr. Perlin above, I do not find that the Opponent has met its burden with respect to this ground of opposition.

Colour, Shape and Size of the Mark Does Not Distinguish From Other Pills

[79] The Opponent alleges that the Mark does not distinguish, nor is adapted to distinguish, the Wares from those of others, and in the absence of the PFIZER and VGR 25, VGR 50 and VGR 100 markings, the colour and shape do not and cannot distinguish the Wares.

[80] The Opponent's evidence set out below is sufficient to meet its burden:

- The appearance of similarly shaped medications in the product identification section of the 2005 and 2006 Compendium of Pharmaceuticals and Specialties (CPS) including: MONOPRIL (10 mg); CARDURA-4; and 3TC (affidavit of Deborah Kall, Exhibits H-K).
- The appearance of blue medications in the product identification section of the 2005 and 2006 CPS including: BENYLYN 1 COLD AND FLU; SYNTHROID (137μg); ASPIRIN (coated 81 mg); WELLBUTRIN SR (100 mg); PROSCAR (5 mg); REQUIP (5 mg); ZOVIRAX (200 mg); IMOVANE (7.5 mg); ANSAID (100 mg); SINEMET (100 mg/10mg); SIMPLY SLEEP (25 mg); PAXIL (30 mg); TYLENOL COLD EXTRA STRENGTH (Nightime); VIRACEPT (250 mg); VALTREX (500 mg) and TYLENOL Aches and Strains; DETROL LA (4mg); XENICAL (120 mg); CARDIZEM (240 mg) REYATAZ (200 mg); and DALACIN (300 mg) (affidavit of Deborah Kall, Exhibits H-K).
- The evidence of Cathy Conroy, a pharmacist who has practiced for 26 years and currently practices in Mississauga, Ontario that she had dispensed at least the following of those listed above: ZOVIRAX (200 mg); ANSAID (100 mg); PAXIL (30 mg); VALTREX (500 mg); and sold TYLENOL ACHES AND STRAINS (affidavit of Cathy Conroy, Exhibit A, para 16; cross-examination of Cathy Conroy, Q39).
- The affidavit of Paula Rembach, a research analyst with the Opponent, who provides IMS data. I note the IMS for 2005 indicates over 10,000 prescriptions for at least the following: 3TC; CARDURA-4; and DETROL LA (Exhibit C).
- While the Opponent also submitted that the prescribing and dispensing of Yohimbine, a medication used to treat erectile dysfunction, advances its allegation of non-distinctiveness, I do not find this to be the case. The evidence is that since the introduction of VIAGRA, Yohimbine is dispensed very infrequently (Cathy Conroy,

Q101; Marie Berry Q254). Moreover, Dr. Perlin confirms that while she has heard of Yohimbine she doesn't know any thing more about it and doesn't prescribe it (Qs 30-31).

With respect to the CPS evidence, the existence of a fairly high number of blue pills and/or multi-sided pills in the 2005 and 2006 CPS allows me to conclude that at least some of those pharmaceuticals have been actively marketed in Canada at the material date.

[81] Since the Opponent has met its burden, the legal onus is on the Applicant to show that its Mark is adapted to distinguish or actually distinguishes its Wares from those of others throughout Canada. Accordingly, the Applicant must establish as of the relevant date, on a balance of probabilities, that the Mark distinguished the Applicant's Wares from the wares of others. In *Philip Morris Inc v Imperial Tobacco Ltd* (1985), 7 CPR (3d) 254 (FCTD) at 270, the Court held that for a mark to distinguish wares three conditions must be met: (1) that a mark and a product (or ware) be associated; (2) that the "owner" uses this association between the mark and his product and is manufacturing and selling his product; and, (3) that this association enables the owner of the mark to distinguish his product from that of others. Furthermore, it is incumbent on the Applicant to show that physicians, pharmacists and patients [*Novopharm Ltd v Bayer Inc, supra* at para 73] recognize it as a Mark, not just as an ornamental or functional element of the product [*Novopharm Ltd v Astra AB* (2000), 6 CPR (4th) 101 at (TMOB) at 112]. The Federal Court of Appeal has also confirmed that to be distinctive consumers must relate or associate the trade-mark with the source of the Wares [*Apotex Inc v Canada (Registrar of Trade Marks)* (2010), 91 CPR (4th) 320 (FCA) at para 7].

Use by the Applicant

[82] The packaging of the VIAGRA tablets attached to the affidavit of Marc Charbonneau indicates that VIAGRA is a trade-mark of Pfizer Products Inc. licensed to Pfizer Canada Inc. (Exhibit A-1-A-4). Since the packaging does not reference the Mark, the Mark cannot be presumed to be used under license pursuant to section 50(2) of the Act.

[83] The Opponent argues that the Applicant's evidence does not support the conclusion that the use of the Mark by Pfizer Canada Inc. enures to the Applicant. Ms. Trunko provides the following evidence concerning the license between the Applicant and Pfizer Canada Inc.:

> Q119 With respect to [the] trade-mark application in question, is there a license agreement in place?
>
> Yes. With respect to the blue diamond trade-mark of Viagra, yes.
>
> Q124 Okay. What's the length of time applicants hold in this license agreement?
>
> The, for this particular blue diamond tablet trade-mark of Viagra, the period, the minimum is – at least the period of which this product has been sold in Canada.
>
> Q125 As in when it was it entered into and when does it expire?
>
> There is an agreement from 1986 that covered this product, and a – an additional agreement that replaced that entered into 2006.
>
> Q127 When you say the agreement of 1986 – that was entered into in 1986, does that relate to the colour, shape and size of the Viagra tablet?
>
> The 1986 trade-mark license agreement was long before this trade-mark existed. It is an agreement between Pfizer Inc and Pfizer Canada. And over time – it has a large schedule of trade-marks, and over time grew to include marks that came into being after the signing date, the effective date of the license. It did come to include marks later developed by Pfizer, including those pertaining to Viagra.
>
> Q128 When you said that that agreement was between Inc and Canada, Pfizer Inc. There is a 1986 agreement between Pfizer Inc and Pfizer Canada Inc.
>
> Q131 Thank you.
>
> There is a separate agreement, which I mentioned directly between Pfizer Products Inc and Pfizer Canada Inc., dated 2006. And there are further agreements relating to the 1986 document.

During re-examination (Qs 497-505) and cross-examination on the re-examination (Qs 506-510), Ms. Trunko provided further information regarding the license agreements.

> Q502 You mentioned a 1986 agreement with Pfizer Canada and Pfizer Inc.; can you

discuss what, if any, role Pfizer Products had in relation to that agreement? The 1986 trade-mark license agreement between Pfizer Inc and Pfizer Canada Inc **evolved in such a way that Pfizer Products Inc which did not exist in 1986 stepped into the shoes of Pfizer Inc as licensor. And was subsequently, many of those same license mark became the subject of a 2006 agreement, directly from Pfizer Products Inc to Pfizer Canada Inc.**

Q510 Yes. We've asked that you produce the relevant license agreements then? (Counsel) … We'll consider that.

[84] I consider Ms. Trunko's testimony above and at Qs 112-115 that the license to Pfizer Canada Inc. includes quality control over the use of the mark on, or in connection with the goods and the quality of the goods themselves, sufficient to support the conclusion that the use enures to the Applicant by virtue of section 50 of the Act. if the Opponent wanted to confirm further details about the license, it could have asked additional questions during cross-examination. Finally, although the 2006 License Agreement was not produced this does not lead to the adverse inference that there was no license in place. Rather, the inference to be drawn is that there was no written license agreement in place. As there is no requirement for a license to be in writing, this is not determinative.

Sales of VIAGRA Enuring to the Applicant

[85] There have been considerable sales of VIAGRA since it launched in Canada in March 1999 (Charbonneau affidavit, para 14). As of 2006, total Canadian sales had exceeded $470 M with the yearly sales in 2005 and 2006 exceeding $60 M (Charbonneau affidavit, para 15). This audited sales information is obtained from IMS and widely used in the pharmaceutical industry in Canada (Charbonneau affidavit, para 15). I note that in each of 2005 and 2006 there were over 850,000 prescriptions for VIAGRA filled (Rembach affidavit, Exhibit C). Since both the Applicant and Opponent's affiants have referenced IMS data (specifically Marc Charbonneau and Paula Rembach) and explained how it is collected, I accept that it is admissible as an exception to the general rule against hearsay. However, "impressive sales figures alone do not satisfy the burden on an applicant for a trade-mark of proving distinctiveness" [*Novopharm Ltd v Astra AB* (2000), 6 CPR (4th) 16 (FCTD) at 25 aff'd (2001), 15 CPR (4th) 327 (FCA)].

Mark Must be Distinctive Amongst Patients, Physicians and Pharmacists

[86] To meet its legal onus the Applicant must demonstrate that its Mark is distinctive amongst patients, physicians and pharmacists.

Patients

[87] The only witness to indicate that they have taken VIAGRA is Marc Charbonneau and as he is the brand manager for this drug he is not representative of patients generally.

[88] The only other evidence before me with respect to patients generally is from pharmacists and physicians reporting on their perceptions of what patients think. I place a limited amount of weight on the evidence from Dr. Perlin, Cathy Conroy, and Laura Furdas with respect to their perceptions of patients' associations with medicine generally (for example associating it with function) (see, for example, Perlin affidavit, para 21; Conroy affidavit para 34, Q 49; Furdas affidavit para 27) since this evidence is with respect to medications generally and there is no evidence showing medications generally receive the advertising exposure or have the popularity that VIAGRA has.

[89] Mr. Charbonneau's evidence is that there has been extensive marketing of VIAGRA which has educated the public and established a brand identity with respect to the Mark (para 16). The evidence of Mr. Charbonneau, in combination with the considerable sales of VIAGRA, indicates that patients have received considerable exposure to the Mark or depictions of the Mark:

- The box that VIAGRA is sold in clearly lists the brand name of the medication and its manufacturer (Exhibits A1, A4). It also includes a depiction of the Mark in the form of a blue diamond featured on the packaging.
- Since 1999 over 2 million samples of VIAGRA have been distributed to patients (para 21). The boxes the samples are provided in include a depiction of the Mark (Exhibit C-2).
- Since 2001, VIAGRA television commercials have been aired in Canada (Exs E-5 – E-11, Q328). Mr. Charbonneau indicates that the 2005 *Bleep* commercial series (Exs E-7 –

E-8) received over 3000 Gross Rating Points which corresponds to 30% of a target audience that has been exposed to the advertising (paras 118, 122).

- Since 2001 print advertising has appeared in *Time*, *Sports Illustrated, Macleans* and the *Toronto Star* (paras 132 and 134).

[90] My finding that many patients have been exposed to advertising is consistent with the evidence of Dr. Shiffman who states in cross-examination that he thinks that there was extensive advertising of VIAGRA between its launch and 2006 and that patients were more than likely to have been exposed to this advertising (Qs 93-95). Furthermore, it appears that VIAGRA has been referred to or is understood to be a "little blue pill" by at least some patients further suggesting that the Mark has a reputation with at least some consumers (Berry affidavit, paras 18-19; Weiss affidavit, paras 15, 19; Furdas affidavit, para 28, Shiffman affidavit, para 21). I find Ms. Berry's evidence on this point credible since one of the Opponent's affiants Cathy Conroy, also states that patients will not say the name VIAGRA as they are somewhat embarrassed about taking a medication for erectile dysfunction (Conroy affidavit, para 32). I do not accept Ms. Furdas' or Dr. Shiffman's evidence that patients referring to "little blue pill" were referring to the function of VIAGRA as there is no evidence that patients have been educated that "little blue pill" refers to medication treating erectile dysfunction generally, nor is there any indication as to why this would occur with respect to the Mark. The evidence of advertising and reputation discussed above, while not constituting use of a mark, may result in an increase to its distinctiveness [*Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC) at para 29].

[91] When asked about the association that a consumer taking VIAGRA would have, Dr. Perlin explains that there is a connection between the appearance of VIAGRA and the drug itself: "I think they associate the pill with, "This is great, this is Viagra and I am going to take this and it is going to make me have an erection and I am going to have some good sex" (Q 62). I find Dr. Perlin's evidence on this point to demonstrate that patients associate the Mark and the Wares as Dr. Perlin states that they associate it with the brand VIAGRA as opposed to stating that patients associate it with erectile dysfunction medications generally. Dr. Perlin's evidence

also appears to be consistent with the evidence of Marie Berry (para 19) and Dr. Ronald Weiss (para 19, Q127). Based on the above, I find that the Mark is distinctive amongst patients.

Pharmacists

[92] The evidence of the pharmacists Cathy Conroy, Laura Furdas, and Marie Berry all indicate that they are familiar with and recognize the appearance of VIAGRA and acknowledge that it is manufactured by a single source (Berry affidavit, para 9; Furdas cross-examination, Qs193-194, 220; Conroy cross-examination Qs 9, 138). While it is clear from the evidence that pharmacists would not identify medication by reference to colour, shape and size alone (see for example paras 28-29 of the Conroy affidavit), this in itself is not fatal to the application [*Novopharm Ltd v Bayer Inc, supra* at para 79]. In *Apotex v Registrar of Trade-marks* (2010), 81 CPR (4th) 459 (FC) aff'd 91 CPR (4th) 320 (FC), Justice Barnes states that the fact that a design is unique, such as the Mark, and is recognized as being so, is not sufficient for distinctiveness (at para 13). He further states that appearance provides an uncertain basis for drawing conclusions about product identity or source and that, for a professional, the brand name and label will almost always trump product appearance for identifying source (para 26). Finally, Justice Barnes in examining the evidence before him evaluated whether colour and shape were the "primary characteristics" by which the wares in that case were distinguished from others or by which purchasers make their choices (para 34). In upholding this decision, the Federal Court of Appeal confirmed that what is required is that pharmacists relate the trade-mark to their dispensing choices [*Apotex Inc v Canada (Registrar of Trade Marks)(FCA), supra* at para 7].

[93] In the subject opposition, I do not find that there is sufficient evidence to meet the Applicant's burden that pharmacists use the Mark as one of the primary characteristics by which VIAGRA tablets are distinguished from the Wares of others. Rather it appears that the DIN, name of the drug and dosage, and UPC on the cardboard box are used during the dispensing process (Conroy affidavit, para 24). Furthermore, from the cross-examination of Ms. Berry it appears very unlikely that pharmacists use the appearance of VIAGRA to distinguish or differentiate it from other products.

Q575 And what circumstances does a pharmacist use the appearance of Viagra to

> distinguish or differentiate it from other products?
> In the case that maybe the patient has mixed up their tablets with their other medication, we help them sort it out that way. If we have some tablets that perhaps are loose on the shelf, we would identify it, but that's very unlikely.

[94] If I had found the Corbin survey admissible, I would have found that it supported the fact that the Mark was recognized as being unique and as such was recognizable to pharmacists as being associated with VIAGRA brand tablets manufactured by one company. However, it is not clear that this evidence is sufficient to meet the criteria stated by Justice Barnes since the evidence shows that pharmacists primarily use other means to distinguish pharmaceuticals from one source as being from another source. As such, I am left in a state of doubt as to whether the Mark is distinctive amongst pharmacists.

Physicians

[95] The evidence relating to distinctiveness of the Mark with respect to physicians consists of the affidavits of Dr. Perlin, Dr. Weiss and Dr. Shiffman.

[96] Dr. Weiss' evidence is that he has no difficulty describing VIAGRA as a blue diamond-shaped tablet (para 15) and he recognizes the VIAGRA tablet as being novel (para 14; Q253). If this was sufficient to demonstrate distinctiveness, which I doubt in view of the *Apotex v Registrar of Trade-marks* case, the fact that Dr. Weiss participated in developing and presenting the Male Sexual Dysfunction Main Pro-C Course (para 7) funded by Pfizer, who also assisted in its development (Qs 49-53), and sat on the Pfizer Pharmaceuticals VIAGRA Steering Committee (para 6), a committee which provides Pfizer with advice, guidance and feedback from key opinion leaders (Q92) at around the material date (Q96) suggests that Dr. Weiss may have had a different awareness of the Mark than physicians generally.

[97] Dr. Perlin's evidence is that she does not keep up with what pharmaceutical products look like (para 15) and is familiar with the appearance of VIAGRA only by nature of her involvement in a previous trade-mark opposition proceeding where it was shown to her (Q16). Dr. Perlin's evidence is that she is not familiar with television advertising related to VIAGRA as

she does not watch commercials or "any thing" (Qs 17-18), does not look at advertising in medical journals as she only looks at ads concerning new drugs that she has not heard of (Q20) and has not encountered advertising for VIAGRA in newspapers and magazines (Q21). It is, however, not clear that Dr. Perlin's limited exposure to advertising for VIAGRA in television, newspapers or medical journals is representative of physicians generally.

[98] Dr. Shiffman's evidence on cross-examination is that while he is aware of the appearance of VIAGRA (Q 84) and advertising of VIAGRA (Qs 33-34,94) and is aware that VIAGRA is manufactured by Pfizer (Q164), he does not associate the appearance of VIAGRA with a single source due to the nature of the pharmaceutical market. At questions 85-86, Dr. Shiffman states:

> Q85 If somebody brought you a blue diamond tablet, as a first impression, you would think that that is Viagra?
> Not necessarily.
> Q86 What else would you think it might be?
> It could be any thing because I don't know the appearance of all the tablets.

[99] The evidence in the subject opposition leaves me in a state of doubt as to whether the Mark is distinctive amongst physicians. In *Royal Doulton Tableware Ltd v Cassidy's Ltd* (1986), 1 CPR (3d) 214 (FCTD) the Federal Court explains that a trade-mark may be recognized as unique but not be distinctive:

> It is to be noted that a distinctive trade mark is one which links, e.g., goods with a vendor so as to distinguish them from the goods of other vendors. It is not distinctive if it simply distinguishes one design of goods from another design of goods even though if one had special trade knowledge one might know that these two kinds of goods are sold respectively by two different vendors. Such a concept of distinctiveness would run counter to a basic purpose of the trade mark which is to assure the purchaser that the goods have come from a particular source in which he has confidence. See Fox, Canadian Law of Trade Marks and Unfair Competition (3rd ed., 1972) at pp. 25-26.

Conclusion Regarding Distinctiveness

[100] The evidence does not enable me to conclude on a balance of probabilities that the Mark was distinctive to physicians or pharmacists as of March 6, 2006. This is because the Applicant has not clearly established that a significant number of physicians and pharmacists relate the Mark to prescribing and dispensing of the Wares. Accordingly, the distinctiveness ground of opposition succeeds on this basis.

Disposition

[101] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse application No. 1,244,118 pursuant to section 38(8) of the Act.

_____

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule 1

Section 38(2)(a) of the Act

3. The Opponent bases its opposition on the grounds provided by Section 38(2)(a) of the Act, namely that the application does not comply with Section 30 in the following respects:

(a) The preamble to Section 30 of the Act provides that the Applicant must be applying to register a "trade-mark". The alleged trade-mark is not a trade-mark within the meaning of Section 2 of the Act. Under Section 2 of the Act a trade-mark is defined as a mark that is used for the purpose of distinguishing or so as to distinguish the Applicant's wares from those of others. The Applicant has chosen a common colour and shape as a trade¬mark, which cannot be used to distinguish its wares from those of others, or even for the purpose of distinguishing its wares. Further, the applied for mark is merely ornamental (the Applicant having obtained Industrial Design Registration No. 88762 on the basis that the applied for design is ornamental), or functional as indicative of the dosage or therapeutic effect, or as a means for formulating a stable orally ingestible composition or as facilitating splitting. Furthermore, if the wares covered by the application are Viagra tablets, the wares of the Applicant are all marked with "Pfizer" on one side and "VGR 25", "VGR 50" or "VGR l00" (depending on the dosage of the tablet) on the reverse. By ensuring that its wares are all so marked, the Applicant has admitted and acknowledged that the colour, shape and size alone are insufficient to distinguish its wares from the other wares in the marketplace.

(b) The application does not comply with Section 30(a) of the Act, in that the application does not contain a statement in ordinary commercial terms of the specific wares or services with which the mark has been used. The description "pharmaceutical preparation for treating sexual dysfunction" is overly broad and encompasses an array of diseases treatable by a wide variety of medications. The wares do not include any reference to a pharmaceutical drug(s), tablet formulation, dose or the nature of the condition being treated. This is in contrast to the 2005 and 2006 Compendium of Pharmaceutical Specialties ("CPS") which states that Viagra is used for the treatment of male erectile dysfunction. Furthermore, due to the above noted ambiguity, the description does not comply with the July 6, 2003 Practice Notice on Compliance with Paragraph 30(a) of the Trade-marks Act - Pharmaceuticals. For purposes of this Statement of Opposition, the Opponent has assumed that the wares covered by this application are Viagra tablets. Accordingly, if the trade-mark is being used, which is denied, it is only being used in association with the 25 mg, 50 mg or 100 mg dosages of sildenafil citrate.

(c) The application does not comply with Section 30(b) of the Act in that the alleged trade-mark has not been used with the wares referred to in the application since at least as early as the date claimed in view of the following:

(i) At the time of the transfer of the property or in possession of the wares, the mark is not "marked" on the wares, instead it is the wares; nor is the mark associated in any other manner with tablets such that notice of association is given to the

person to whom the property or possession is transferred in the normal course of trade, a blue three-dimensional pill, is not visible at the time of transfer due to the manner in which the tablets are packaged and dispensed;

(ii) If anything, it is the Applicant's packaging, that it uses as a trade-mark;

(iii) If the mark is ever visible at the time of transfer of the property in or possession of the wares, there is no notice of association with the wares. Consumers are unaware that any mark has been applied to the wares, such consumers being generally familiar with pills having the same or similar colour and shape including those attached as Schedules "A" and "B". If the Applicant's wares do come to the attention of the person to whom the property or possession is transferred, it is the presence of the markings "Pfizer" on one side and "VGR 25", "VGR 50" or "VGR 1 00" on the reverse (depending on the dosage of the tablet) that may serve to distinguish the Applicant's wares from those of others. Furthermore, such consumers being generally aware those different brands of pharmaceuticals have the same or similar colour, shape and size. As such colour shape and size is not indicative of source. The Opponent relies on, inter alia, the pills referenced in the 2005 and 2006 Compendium of Pharmaceutical Specialties ("CPS"), 1996 Compendium of Nonprescription Products (CNP), and 2002/03 Compendium of Self-Care Products ("CSCP"), the pills in the CPS and CSCP are listed in Schedules "A" and "B" respectively;

(iv) To the extent that the Applicant's tablets are being used as a trade-mark (which is not admitted, but denied), it is the entire appearance of the tablet that is being used (and not the mark applied for). This includes particular markings, shape and size. Further, the Applicant's tablets vary in shade, such that in the normal course of trade the tablets would not always be perceived as being blue;

(v) If anything, the Applicant differentiates between dosages of sildenafil citrate using the tablet appearance, including different shapes and or sizes and markings;

(vi) The wares are manufactured by a different entity, namely Pfizer Canada Inc., without proper license from the Applicant, such that the claimed mark has not been used by the Applicant since the date claimed;

(vii) In the normal course the consumer splits the Applicant's tablets such that the alleged trade-mark has not been used with the wares referred to in the Application;

(viii) The trade-mark was not used in Canada in association with the wares since at least as early as March 1999; and

(ix) The colour blue has not been used in association with the wares

since at least as early as March 1999.

(d) The application does not comply with Section 30(h) of the Act in that the application does not include an accurate drawing and representation of the alleged trade-mark. Specifically:

(i) The trade-mark does not include an accurate drawing and representation of the alleged trade-mark, since the trade-mark includes markings on the tablet;

(ii) It is completely unclear exactly what mark is being claimed as the Applicant's mark. The drawing appears to show a hatched outline on certain parts of the tablet in Figures 1-3 and a solid outline in Figure 4. However, the Applicant has failed to include any written description of the mark as required by the Trade-marks Examination Manual, Parts IV.2.1, IV.2.3, IV.2.4 and IV.2.6;

(iii) The Applicant has not complied with the December 6, 2000 Practice Notice on Three-dimensional Marks. In particular, (l) the application does not contain a drawing or drawings showing the visible features of the tablet in dotted outline; and (2) a description indicating that the trade-mark consists of the particular colour only as applied to the tablet shown in the drawing; and (3) the advertisement does not state that the three-dimensional object in the dotted outline does not form part of the trade-mark;

(iv) The description and drawings fail to define what the trade-mark consists of, including whether the mark is two dimensional or three dimensional and whether the mark consists of the colour and shape of the wares or colour, shape and size;

(v) The application indicates the colour blue is applied to the whole of the visible surface of the tablet shown. Accordingly, in the alternative if the mark is a trade-mark it is in fact a distinguishing guise. The drawings should therefore be in full outline and the requirements of Section 13 of the Act must be met. By attempting to avoid the requirements of Section 13 of the Act in this way, it is completely unclear what exactly is being claimed. Furthermore, size cannot form part of the trade-mark application.

(vi) The drawings and representation of the application do not properly define the limits of the trade-mark monopoly being applied for. The mark appears to cover all sizes and variety of shapes, as the wares can be a variety of sizes and shapes;

(vii) The mark also covers a broad range of colours. Consumers cannot differentiate between a wide range of colours, for example, turquoise, teal, aqua, aquamarine or bluish green;

(viii) If the wares which are the subject of the application are the 25 mg, 50 mg or 100 mg strength Viagra tablets, it is completely unclear exactly what mark is being

claimed as the Applicant's mark. The Applicant has co-pending trade-mark applications (Application Nos. 883,144, 883,145, 886,243) which appear to cover different marks. As such, it is unclear what features are/are not included in the within application (including size and shape);

(ix) It is unclear whether the solid lines included in the drawings appear on the tablet;

(x) The drawing suggests that the outside surface of the tablet is smooth; however, there are indentations where the markings are;

(xi) There is no shade of blue specified; and

(xii) If the wares which are the subject of the application are the 25 mg, 50 mg or 100 mg strength Viagra tablets, the 50 mg and 100 mg tablets may be broken in half to obtain two 25 mg (or two 50 mg) strength tablets, for example, prior to patient consumption. The shape of the tablet in the application is meaningless with respect to strength, as once the tablet is broken in half, the tablets are no longer the shape as set out in the drawing, but a triangular tablet. In the normal course the consumer splits the tablet such that the tablet is no longer representative of the alleged shape of the tablet shown in the drawing.

(e) Application No. 1,244,118 does not comply with Section 30(i) of the Act in that the Applicant could not have been satisfied that it was entitled to use the alleged trade-mark, in that:

(i) The Applicant was aware of other trade-marks with confusingly similar appearances;

(ii) It has been the practice in Canada that different manufacturers of pharmaceuticals containing the same active ingredient sell and offer for sale pharmaceuticals having the same colour, shape and size. Furthermore, pharmaceuticals containing different active ingredients have been sold in the same colour, shape and size. As a result, consumers do not consider the colour or shape of a pharmaceutical to be a trade-mark. In this marketplace (as defined by, inter alia, the CPS, CNP and CSCP), the Applicant could not have been satisfied to use the colour and shape of a pharmaceutical as a trade-mark;

(iii) Pharmaceutical pills having a similar colour, shape and/or size have been used by others at the relevant time in the Canadian marketplace, namely the colour blue applied to the whole of the visible surface of the tablet; *inter alia,* the pills listed at Schedules "A" and "B";

(iv) If the wares which are the subject of the application are the 25 mg,

50 mg or 100 mg strength Viagra tablets, the Applicant has co-pending trade-mark applications (Application Nos. 883,144, 883,145, 886,243) which appear to cover variations of the mark in this application. Therefore, the Applicant is unclear as to what its own mark actually is, and accordingly, it could not have been satisfied that it was entitled to use the applied for mark as a trade-mark;

(v) The Applicant could not have been satisfied that it was entitled to use the alleged trade-mark in Canada because of the monopolization of such an alleged trade-mark will restrain others in the pharmaceutical industry from selling similarly shaped and coloured pills; such features of shape and colour being utilitarian, ornamental, and functional for oral formulation purposes and dosage identification;

(vi) The Applicant obtained Industrial Design Registration No. 88762 acknowledging that the tablet appearance is merely ornamental; and

(vii) The Applicant has never used "the colour blue as applied to the whole of the visible surface of the tablet shown" for the purpose of distinguishing its wares from the wares of others; if anything, the Applicant uses its markings or packaging to distinguish its wares from those of others.

Section 38(2)(b) of the Act

4. The Opponent bases its opposition on the grounds provided by Section 38(2)(b) of the Act, namely that the Applicant's alleged trade-mark is not registrable, in that:

(a) The alleged trade-mark, if it is a trade-mark (which is not admitted, but denied), is a distinguishing guise being directed to the shaping of the wares; the wares having a particular colour. A distinguishing guise is defined in Section 2 to be a "shaping of wares or their containers" as well as "a mode of wrapping or packaging wares" the appearance of which is used to distinguish. The ware is the same three-dimensional entity defined as the trade-mark - it must follow that the trade-mark is for a specific shaping of the wares and is therefore a distinguishing guise. The Applicant cannot avoid the requirements of Section 13 by adding colour as a feature of the distinguishing guise. It is inconsistent to describe the mark as a colour applied to a three-dimensional shape, and then claim that the mark is separate from that shape. Accordingly, if the alleged trade-mark is a trade-mark the Applicant is obliged to meet the requirements under Section 13 of the Act.

(b) The application states that the alleged trade-mark is the colour blue applied to the whole of the visible surface of the tablet shown in the attached drawings. According to the December 6, 2000 Practice Notice on Three-dimensional Marks, where a trade-mark contains both elements that fall within the definition of a distinguishing guise and elements that do not fall within the definition of a distinguishing guise the special provisions of the Act concerning distinguishing guises apply. Pursuant to Section 13 of the Act, a distinguishing guise

is registrable only if it has been so used in Canada, at the date of filing of the application, to have become distinctive. A distinguishing guise is defined in Section 2 to be a "shaping of wares or their containers" as well as "a mode of wrapping or packaging wares", the requirements of Section 13 cannot be avoided by adding the element of colour to the shaping of the wares. Accordingly, if the alleged trade-mark is a trade-mark the Applicant is obliged to meet the requirements under Section 13 of the Act.

(c) In the alternative, because the alleged trade-mark is defined not only by colour and shape, but also by size, the mark is a trade dress and not registrable under any provision of the Trade-marks Act.

(d) Pursuant to Section 12(1)(b) of the Act the alleged trade-mark is either clearly descriptive or deceptively misdescriptive (of the active or therapeutic effect or of the dosage) of the wares in association with which it is alleged to have been used.

(e) If the alleged trade-mark is a distinguishing guise (which is not admitted but is denied), it is not registrable under section 13(1)(b) of the Act because the exclusive use by the Applicant of the distinguishing guise in association with the wares with which it has been used is likely to unreasonably limit the development of the pharmaceutical industry in view of the fact that the general practice in Canada is that generic pharmaceutical products and/or preparations have a similar appearance to products and/or preparations of third party manufacturers. Furthermore, the ability to manufacture oral dosage forms would be limited, there being a limited number of suitable shapes and/or colours available for pharmaceutical compounds.

(f) Contrary to section 12(1)(e) of the Act, the alleged trade-mark is a prohibited mark within the meaning of Section 10 of the Act and therefore is not registrable having regard to the pharmaceutical marketplace, including the practice of different manufacturers to market pharmaceuticals having similar or the same colour and shape and also size and also having regard to the pills listed at Schedules "A" and "B"; the mark claimed, if recognized at all, is recognized in Canada:

(i) by patients, as designating a kind or type of medication, including its therapeutic effect and/or dosage; and

(ii) by pharmacists and other health care professionals, as designating the kind and quantity of the wares, its therapeutic effect and/or dosage and not as indicative of the source of the wares.

(g) The Registrar of Trade-marks had no jurisdiction to advertise the trade-mark application. The mark advertised in the Trade-marks Journal dated October 5, 2005 was not the mark that received an Approval Notice from the Registrar dated September 1, 2005. The Applicant amended their application in a submission dated June 15, 2005 based on the Examiner's report dated April 29, 2005. It was this amended application that received an

Approval Notice from the Registrar. The mark advertised was the Applicant's mark in the original application dated January 19, 2005.

Section 38(2)(d) of the Act

5. The Opponent bases its opposition on the grounds provided by Section 38(2)(d) of the Act, namely, that the Applicant's alleged trade-mark is not distinctive for the following reasons:

(a) In the event the Applicant's trade-mark is determined to meet the requirements of s.2, the Applicant's alleged trade-mark consisting of "the colour blue as applied to the whole of the visible surface of the tablet shown" is not distinctive in that it does not distinguish, nor is it adapted to distinguish, the Applicant's wares from those of others; blue pills and related shades, and/or the same or similarly shaped pills were and are at all material times common to the pharmaceutical trade and have been prescribed by physicians, dispensed by pharmacists and taken by patients in Canada along with the Applicant's blue tablets so that the mark does not actually distinguish the Applicant's tablets, nor is it adapted to distinguish the Applicant's tablets; instead the mark consists of common elements from the marketplace having regard to *inter alia*, the blue pills and/or similarly shaped and coloured pills attached as Schedules "A" and "B". Full particulars of when, how and the extent to which these pills have been used in the marketplace are within the full knowledge of the Applicant, having regard to the accepted reference texts, the CPS, CNP and CSCP, IMS data to which the Applicant subscribes, and the Applicant's extensive knowledge of the marketplace through its own marketing and sales departments and the marketing and sales departments of related companies. The Opponent relies on the CPS, CNP and CSCP as providing state of the marketplace evidence regarding blue pills and/or similarly shaped and coloured pills.

(b) The Applicant has described their tablet in the CPS, in part, as being "round", which is one of the most common pill shapes. The mark cannot, therefore be distinctive in that it cannot distinguish or be adapted to distinguish;

(c) In addition to Schedules "A" and "B", there are also third party blue similarly shaped and coloured pills for treating sexual dysfunction, for example, Vigrex, Veega and Silagra. As a result, a number of different traders selling sildenafil citrate products having a similar colour, shape and/or size such that consumers do not consider these indicia to denote source.

(d) It is clear from the fact that the Applicant marks each and every tablet with "PFIZER" on one side and "VGR 25", "VGR 50" and "VGR 100" (depending on the dose) on the reverse, that in the absence of these markings the colour and shape do not and cannot distinguish the wares of the Applicant.

(e) The appearance of the tablets is used to indicate dosage and/or therapeutic effect and not source.

(f) If it is accepted that the proper comparison market for the wares of the trade-mark application is restricted to the pills for treating sexual dysfunction, (which the Opponent denies), the alleged trade-mark does not actually distinguish, nor can it be adapted to distinguish the Applicant's wares as the Applicant or their predecessor in title has applied for and obtained Canadian Patents for the wares which are the subject matter of this application, namely:

Canadian Patent No. 2,044,748	expiring June 17, 2011
Canadian Patent No. 2,163,446	expiring on May 13, 2014

As a result the Applicant has exclusive rights in respect of the wares forming the subject matter of this application, such that the applied for trade-mark cannot distinguish the wares of the Applicant from the wares of others, as no others are legally permitted to manufacture or sell the specific wares of the Applicant, as the Applicant is aware.

(g) In the alternative to paragraph (f), the Applicant cannot rely on its patent monopoly in the wares to establish distinctiveness of the applied for mark, which is merely the alleged appearance of the wares; nor can the Applicant seek to extend its monopoly by inferring distinctiveness of the colour of the tablets based on this monopoly.

(h) The Applicant has not properly licensed the mark to other users, including Pfizer Canada Inc., in accordance with Section 50 of the Act.

(i) The general practice in Canada is that generic pharmaceutical products and/or preparations have a similar appearance to products and/or preparations of third party manufacturers. Consumers are predisposed to different sourced pharmaceuticals having a similar appearance, and do not therefore regard product appearance as an identifier of the wares of any particular trader. Consumers are accustomed to and expect generic products and/or preparations to look similar or/the same as the brand name products and/or preparations. The colour, shape and/or size of pharmaceutical products are not an indicator of source.