IN THE MATTER OF AN OPPOSITION by Roberts Laboratories Inc. to application No. 753,471 for the trade-mark CENTRACOL filed by Centrapharm Limited/Centrapharm Limitée, now Centrapharm Inc.

On April 29, 1994, the applicant, Centrapharm Limited/Centrapharm Limitée, filed an application to register the trade-mark CENTRACOL based upon proposed use of the trade-mark in Canada in association with:

> "Produits pharmaceutiques, nommément: solutions analgésique, antipyrétique, décongestionnante, et antitussive; sirop contre la toux, sirop contre le rhume, poudre en sachets à effet décongestionnant, capsules, comprimés, et suppositoires."
> [Translation: Pharmaceutical products, namely: analgesics, antipyretics, decongestants, and cough suppressants; cough syrup, cold syrup, sachets of decongestant powder, capsules, tablets, and suppositories.]

The present application was advertised for opposition purposes in the ***Trade-marks Journal*** of November 23, 1994 and the opponent, Roberts Laboratories Inc., filed a statement of opposition on April 24, 1995, a copy of which was forwarded to the applicant on July 26, 1995. The opponent alleged that the applicant's trade-mark is not registrable and not distinctive, that the applicant's application does not comply with Subsection 30(i) of the ***Trade-marks Act***, and that the applicant is not the person entitled to its registration of the trade-mark CENTRACOL since the applicant's trade-mark is confusing with the opponent's registered trade-mark CHERACOL, registration No. TMDA47670, covering a preparation for the treatment of coughs, colds, and other bronchial and pulmonary affections which had been previously used in Canada.

The applicant filed and served a counter statement in which it generally denied the allegations set forth in the statement of opposition. The opponent filed as its evidence the affidavit of Arthur Eugene Woodruff while the applicant submitted as its evidence the affidavits of Chantal Poirier and Pierre Laurin. The applicant alone filed a written argument and neither party requested an oral hearing. Further, during the opposition, the applicant changed its name to Centrapharm Inc.

As its first ground, the opponent alleged that the present application does not satisfy the requirements of Subsection 30(i) of the ***Trade-marks Act*** in that the applicant could not have been satisfied that it was entitled to use the trade-mark CENTRACOL in Canada in association with the

wares covered in the present application in that the mark CENTRACOL is confusing with its trade-mark CHERACOL used in association with a preparation for the treatment of coughs, colds, and other bronchial and pulmonary affections. While the legal burden is upon the applicant to show that its application complies with Section 30 of the ***Trade-marks Act***, there is an initial evidentiary burden on the opponent in respect of the Section 30 ground [see ***Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.***, 3 C.P.R. (3d) 325, at pp. 329-330]. To meet the evidentiary burden upon it in relation of a particular issue, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. In the present case, even had the applicant been aware of the opponent's trade-mark prior to filing the present application, such a fact is not inconsistent with the statement in the present application that the applicant is satisfied that it is entitled to use the trade-mark CENTRACOL in Canada on the basis *inter alia* that its trade-mark is not confusing with the opponent's trade-mark CHERACOL. Thus, the success of this ground is contingent upon a finding that the trade-marks at issue are confusing [see ***Consumer Distributing Co. Ltd. v. Toy World Ltd.***, 30 C.P.R. (3d) 191, at p. 195; and ***Sapodilla Co. Ltd. v. Bristol-Myers Co.***, 15 C.P.R. (2d) 152, at p. 155]. I will therefore consider the remaining grounds which are based on allegations of confusion between the applicant's trade-mark CENTRACOL and the opponent's trade-mark CHERACOL.

The second ground of opposition is based on Paragraph 12(1)(d) of the ***Trade-marks Act***, the opponent asserting that the applicant's trade-mark is not registrable in that there would be a reasonable likelihood of confusion between the trade-mark CENTRACOL and its registered trade-mark CHERACOL. In assessing whether there would be a reasonable likelihood of confusion between the trade-marks at issue within the scope of Subsection 6(2) of the ***Trade-marks Act***, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those which are specifically enumerated in Subsection 6(5) of the ***Act***. Further, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the date of my decision, the material date in relation to the Paragraph 12(1)(d) ground [see ***Park Avenue Furniture Corporation* v. *Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks***, 37 C.P.R. (3d) 413 (F.C.A.)].

The applicant's trade-mark CENTRACOL as applied to the wares covered in the present application is inherently distinctive. Further, the opponent's trade-mark CHERACOL as applied to the wares covered in registration No. TMDA47670 possesses some measure of inherent distinctiveness although it does suggest that the opponent's wares have a cherry flavour. Having regard to the affidavit evidence of the parties, I have concluded that both trade-marks have become known to some extent in Canada as of the date of my decision. While the extent to which the trade-marks at issue have become known does not favour either party, the length of time the trade-marks at issue have been in use in Canada clearly weighs in the opponent's favour, the opponent's predecessor-in-title having apparently commenced use of the trade-mark CHERACOL in this country in 1929.

The applicant's analgesics, antipyretics, decongestants, and cough suppressants; cough syrup, cold syrup overlap the opponent's preparations for the treatment of coughs, colds, and other bronchial and pulmonary affections covered in registration No. TMDA47670. On the other hand, the applicant's sachets of decongestant powder, capsules, tablets, and suppositories differ from the opponent's wares. As for the respective channels of trade associated with the wares of the parties, the applicant submitted that its wares are sold over-the-counter whereas the opponent's CHERACOL products are dispensed by pharmacists in accordance with a written prescription from a registered physician. However, in addition to medical doctors and pharmacists who are involved in the prescribing and dispensing of the opponent's products, patients must also be considered as part of the relevant public in assessing the issue of confusion where medication is dispensed under prescription [see ***Ciba-Geigy Canada Ltd. v. Apotex Inc***., [1992] 3 R.C.S. 120]. In any event, the opponent's registration does not include a limitation that its wares are prescription drugs. As a result, for the purposes of the Paragraph 12(1)(d) ground, the Registrar must consider that there could be a potential overlap in the channels of trade of the parties since their wares could be distributed through drug stores or pharmacies.

As for the degree of resemblance between the trade-marks at issue when considered in their entireties as a matter of immediate impression and imperfect recollection, there is some similarity in appearance between the trade-marks CHERACOL and CENTRACOL although there is relatively

little similarity in the sounding of these marks. Furthermore, the trade-marks CHERACOL and CENTRACOL do not suggest any ideas in common.

As a further surrounding circumstance in considering the issue of confusion, the applicant relied upon evidence of its adoption of a number of trade-marks having the initial element CENTRA, including the marks CENTRATUSS, CENTRAACID, CENTRALAX and CENTRARUB, as well as evidence of use of the trade-marks CENTRATUSS and CENTRAACID. According to the applicant, its marks would be perceived as being closely linked to its corporate name which likewise includes the element CENTRA. As the applicant has evidenced some use of its trade-marks CENTRATUSS and CENTRAACID, I am prepared to accord some weight to this surrounding circumstance.

As yet a further surrounding circumstance in considering the issue of confusion, the applicant submitted evidence of use in the marketplace of the trade-marks CEPACOL for antibacterial lozenges, PHARMACOL cough/cold syrup and TRIAMINACOL cough syrup. This evidence points to the fact that the suffix COL has been adopted and used by other traders in the marketplace in association with various types of over-the-counter cough and cold medication. As a result, this surrounding circumstance weighs in the applicant's favour in assessing the likelihood of confusion between the trade-marks CENTRACOL and CHERACOL.

Having regard to the above and, in particular, to the fact that the applicant's sachets of decongestant powder, capsules, tablets, and suppositories differ from the opponent's wares, that the applicant has adopted and used other CENTRA marks as applied to pharmaceutical preparations and that other trade-marks having the suffix COL are being used in the marketplace, I have concluded that there would be no reasonable likelihood of confusion between the applicant's trade-mark CENTRACOL as applied to "poudre en sachets à effet décongestionnant, capsules, comprimés, et suppositoires*"* and the opponent's registered trade-mark CHERACOL covering "preparations for the treatment of coughs, colds, and other bronchial and pulmonary affections". I have therefore dismissed the Paragraph 12(1)(d) ground of opposition as it relates to these wares. On the other hand, there is a clear overlap between the applicant's analgesics, antipyretics, decongestants, and

cough suppressants; cough syrup, cold syrup and the opponent's preparations for the treatment of coughs, colds, and other bronchial and pulmonary affections and these wares could travel through the same channels of trade. Since there is some similarity in appearance between the trade-marks at issue, I am therefore left in doubt in respect of the issue of likelihood of confusion between the trade-marks CENTRACOL and CHERACOL as applied to these wares. I have therefore concluded that the applicant's trade-mark is not registrable in view of Paragraph 12(1)(d) of the ***Trade-marks Act*** in relation to "Produits pharmaceutiques, nommément: solutions analgésique, antipyrétique, décongestionnante, et antitussive; sirop contre la toux, sirop contre le rhume".

The material dates for considering the issue of the likelihood of confusion in relation to the non-entitlement and non-distinctiveness grounds are, respectively, the applicant's filing date [April 29, 1994] and the date of opposition [April 24, 1995]. However, the conclusions noted above in assessing the surrounding circumstances in relation to the Paragraph 12(1)(d) ground do not change significantly when these criteria are considered as of the material dates in relation to the non-entitlement and non-distinctiveness grounds. Thus, the above conclusions in respect of the issue of confusion likewise apply to the final two grounds of opposition.

In view of the above, I refuse the present application as applied to "Produits pharmaceutiques, nommément: solutions analgésique, antipyrétique, décongestionnante, et antitussive; sirop contre la toux, sirop contre le rhume" and otherwise reject the opponent's opposition to registration of the trade-mark CENTRACOL as applied to "poudre en sachets à effet décongestionnant, capsules, comprimés, et suppositoires". In this regard, I would note the decision of the Federal Court, Trial Division in ***Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH***, 10 C.P.R. (3d) 492 in respect of there being authority to render a split decision in a case such as the present.

DATED AT HULL, QUEBEC, THIS 19th DAY OF NOVEMBER, 1997.

G.W. Partington

Chairperson
Trade Marks Opposition Board