

**IN THE MATTER OF AN OPPOSITION by
Johnson & Johnson to Application No.
1,237,570 for the trade-mark RAPINYL filed
by Endo Pharmaceuticals Inc.**

I The Proceedings

[1] On November 17, 2004 Endo Pharmaceuticals Inc. (the “Applicant”) filed an application to register the trade-mark RAPINYL (the “Mark”) based on proposed use in Canada in association with pharmaceutical preparations namely analgesics (the “Wares”).

[2] The application was advertised on November 9, 2005 in the Trade-marks Journal for opposition purposes. Johnson & Johnson (the “Opponent”) filed a statement of opposition on January 3, 2006 and the Registrar forwarded it to the Applicant on February 2, 2006. The Applicant filed a counter statement on March 23, 2006 in which, in essence, it denies all grounds of opposition described hereinafter.

[3] Neither the Opponent nor the Applicant filed evidence. Both parties filed written arguments and were represented at an oral hearing.

II The statement of opposition

[4] The grounds of opposition raised by the Opponent are:

1. The application does not conform to the requirements of s. 30(e) of the Trade-marks Act, R.C.S. 1985, c. T-13, (the “Act”) in that at the filing date of the application:

The Applicant was already using the Mark in Canada;

Alternatively or cumulatively, the Applicant never intended to use the Mark in Canada;

2. The application does not conform to the requirements of s. 30(i) of the Act as the Applicant could not have been satisfied that it is entitled to use the Mark in Canada in association with the Wares;

3. The Mark is not registrable in view of s. 12(1)(d) of the Act because it is confusing with the Opponent's registered trade-mark REMINYL, registration number TMA552885;
4. The Applicant is not entitled to registration of the Mark in view of s. 16(3) (a) and (b) of the Act because at the filing date of the application the Mark was confusing with the Opponents' trade-mark REMINYL that had been previously used or made known in Canada and for which an application for registration had been previously filed by the Opponent;
5. The Applicant's Mark is not distinctive and cannot be distinctive of the wares of the Applicant since:
 - i) It does not actually distinguish nor is adapted to distinguish the Wares in association with which it is allegedly used by the Applicant, nor is it adapted to distinguish them;
 - ii) The Mark is used outside the scope of licensed use provided for by s. 50 of the Act;
 - iii) As a result of the transfer of the Mark, rights subsist in two or more persons to the use of trade-marks confusing with the Mark and those rights were exercised by those persons, contrary to s. 48(2) of the Act.

III General principles governing opposition proceedings

[5] The legal burden is upon the Applicant to show that its application complies with the provisions of the Act, but there is however an initial evidential onus 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 exist. Once this initial onus is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company*, [2005] F.C. 722].

IV Grounds of opposition dismissed for failure by the Opponent to meet its onus of proof

[6] In order to be successful under the first, second, fourth and fifth grounds of opposition, the Opponent had to adduce sufficient evidence in order to reasonably conclude that there were facts supporting each of these grounds of opposition. No evidence of prior use or making known of the Opponent's trade-mark was filed, which is essential for the Opponent to meet its initial

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onus under the grounds of opposition of entitlement based on s. 16(3)(a) or distinctiveness [see *Boehringer Ingelheim Pharma KG v. Braintree Laboratories* 2004 CarswellNat 4705].

[7] With respect to the ground of opposition based on s. 16(3)(b), it is improperly pleaded. The Opponent failed to identify the application number and to allege that it was still pending when the present application was advertised [see s. 16(4) of the Act].

[8] As for the grounds of opposition based on s. 30(e) of the Act, the Opponent did not file any evidence that would support an allegation that the Applicant, at the filing date of the application, was using the Mark in Canada or never intended to use it. Concerning the ground of opposition based on s. 30(i), as pleaded it does not constitute a valid ground of opposition. All that is required from an applicant under that section of the Act is a statement that it is satisfied that it is entitled to use the Mark. Such statement is included in the application. I am of the view that where an applicant has provided the statement required under s. 30(i), that 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 C.P.R. (2d) 152 (T.M.O.B.) at 155]

[9] Consequently I am dismissing all those grounds of opposition.

V The Third Ground of Opposition (Registrability)

[10] The relevant date to assess the registrability of the Mark under s. 12(1)(d) of the Act is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A.)]. In order to meet its initial burden the Opponent had to file a certified copy of its registration but it failed to do so. However the Registrar has discretion to verify the register to determine if in fact the trade-mark alleged in support of this ground of opposition is registered and if the registration is in good standing [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats Ltée. v. Manu Foods Ltd.*, 11C.P.R. (3d) 410].

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[11] The Applicant is inviting the Registrar not to exercise such discretion as the Opponent's conduct in the file would justify that position. The Applicant is alleging that it has been waiting since 2004 to obtain the registration of the Mark but the Opponent has been delaying the file. The Applicant further alleges that after requesting numerous extensions of time to file its evidence, the Opponent informed the Registrar on April 16, 2007 that it did not intend to file evidence.

[12] I note from a review of the file that the Opponent obtained 4 extensions of time totalling 12 months to file its evidence or the statement required under s. 38(7.1) of the Act. All these requests were justified by different sets of circumstances such as maternity leave of the agent responsible for the file or exploring the possibility of a settlement. On the other hand the Applicant did request a six- month extension of time of its own. Under these circumstances I am not prepared to conclude that the Opponent abused the process.

[13] I did exercise my discretion and do confirm that the Opponent is the registered owner of the trade-mark REMINYL, registration number TMA552885, in association with human pharmaceutical, namely a neurological preparation. The registration is still in good standing. Therefore the Opponent has met its initial onus.

[14] Consequently I have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with the Opponent's registered trade-mark REMYNIL. The test to determine this issue is set out in s. 6(2) of the Act and I must take into consideration all the relevant surrounding circumstances, including those listed in s. 6(5): the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the wares, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks or trade-names in appearance, or sound or in the ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Clorox Co. v. Sears Canada Inc.* (1992), 41 C.P.R. (3d) 483 (F.C.T.D.) and *Gainers Inc. v. Marchildon* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)]. I refer to the decision of the Supreme Court of Canada in *Mattel, Inc. v.*

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3894207 *Canada Inc.* (2006), 49 C.P.R. (4th) 321 where Mr. Justice Binnie commented on the assessment of the criteria enumerated above to determine the likelihood of confusion.

[15] I agree with the Applicant's position that the Opponent's trade-mark REMNYL seems to have a slightly higher degree of inherent distinctiveness than the Mark. Even though both marks are coined words, the prefix RAPI suggests rapid relief when used in association with analgesics. As regards the extent to which the parties' respective trade-marks have become known, the present application is based on proposed use. The Opponent did not file any evidence to show that its trade-mark has been used and is still being used in Canada such that it has become known to some extent in Canada. In summary, the first factor described in s. 6(5)(a) of the Act favours the Opponent.

[16] As discussed in the previous paragraph there is no evidence of use of the parties' trade-marks. It may be inferred from the registration of the Opponent's trade-mark that there has been *de minimus* use but that would not be sufficient however to give great weight to this factor [see *Novopharm Ltd. v. Genderm Canada Inc.* (1998), 85 C.P.R. (3d) 247].

[17] A good portion of the written arguments and the oral hearing was devoted to the nature of the parties' products and the nature of the trade. I reiterate that there is no evidence in the file. Therefore I cannot assess most of the arguments put forward by the parties on these issues. For example the Applicant, in its written argument, is suggesting that the Opponent's pharmaceutical preparation would be used to treat neurological disorders such as Alzheimer's disease, Parkinson's disease and Huntington's disease. There is no proof of those allegations. The Applicant suggests that the Opponent's neurological preparation would be obtained after the patient consulted a neurologist or another specialist. Again there is no evidence to support such assertion.

[18] The Opponent makes reference to some of the particularities of the pharmaceutical industry. Even though those representations were made under the heading of additional surrounding circumstances they may be considered under the nature of the trade. In any event, as

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it will become obvious from a reading of this decision, it does not matter if it is treated under this heading or as an additional surrounding circumstance.

[19] The Opponent is arguing that additional care should be given to trade-marks covering pharmaceutical preparations and argues that Health Canada does regulate this field of activity. There is no evidence that the Mark must comply with any special regulations in view of the nature of the wares or the trade. The present application is governed by the general principles related to trade-mark law and in particular the issue of likelihood of confusion between two trade-marks. There is no evidence to support any assumption of facts related to the so-called particularity of the pharmaceutical industry. If the Opponent wanted to rely on any of the principles it enunciated in its written argument or presented at the oral hearing, a minimum of factual evidence should have been provided in support of them.

[20] Under these circumstances I am not prepared to make any distinction or association that the parties would like me to do that goes beyond a straight reading of the description of the parties' respective wares. There are too many fact driven assumptions that I would have to make. This is too remote from the concept of taking judicial notice of undisputed facts known to a vast majority of the population. The Applicant is relying on case law discussing differences in the pharmaceutical products involved and the presence of health professionals (doctors and pharmacists) in the chain of interveners when a pharmaceutical product is prescribed to a patient. All these cases were decided on the basis of the evidence filed. For example there is reference to prescribed medication and the informed consumer in *Pierre Fabricant Médicament v. SmithKline Beecham Corp.* (2004), 35 C.P.R. (4th) 23. I have no evidence that a health professional would intervene before the patient purchases one of the parties' medicines. There is no evidence that one product would be obtained through prescription as opposed to an over-the-counter drug for the other one.

[21] I shall simply limit myself to a straight comparison of the parties' respective wares as defined in the application and the Opponent's registration. There are both pharmaceutical products and consequently they fall in the same general class of wares. However I can verify the meaning of words in dictionaries. I consulted *The Canadian Oxford Dictionary* and "analgesic"

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is an adjective defined as “relieving pain”. The Opponent’s wares are defined as “neurological preparation” which suggests use to treat neurological problems.

[22] In the absence of evidence to the contrary I presume that their channels of trade would be the same, namely drug stores or pharmacies.

[23] The test to determine the degree of resemblance between two trade-marks has been laid down in the following words by Mr. Justice Malone in *Polo Ralph Lauren Corp. v. United States Polo Assn.* (2000), 9 C.P.R. (4th) 51:

“With respect to the degree of resemblance in appearance, sound or ideas under subparagraph 6(5) (e), the trade-marks at issue must be considered in their totality. As well, since it is the combination of elements that constitutes a trade-mark and gives distinctiveness to it, it is not correct to lay the trade-marks side by side and compare and observe similarities or differences among the elements or components of the marks when applying the test for confusion. In addition, trade-marks must not be considered in isolation but in association with the wares or services with which they are used.”

[24] The Opponent, despite arguing in its written argument that the applicable test is the imperfect recollection of its trade-mark by a consumer when confronted with the Mark, is making a detailed analysis of the marks in issue. It argues that both marks are composed of three syllables; they share the same first letter R and the identical last two syllables INYL. This is the wrong approach as by doing so the Opponent is putting the marks side by side.

[25] The appropriate test is to put ourselves in the shoes of a casual consumer who has a vague recollection of the Opponent’s trade-mark and sees an analgesic bearing the Mark. Would he think that it originates from the Opponent?

[26] In determining the answer to this question I have to take into consideration not only the nature of the wares in issue but also the fact that the first portion of a trade-mark is often more important for the purpose of distinction [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183; *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding*

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Ltd. (1991), 37 C.P.R. (3d) 413; *Phantom Industries Inc. v. Sara Lee Corp.* (2000), 8 C.P.R. (4th) 109]. In this instance the first component of the Opponent's trade-mark is the distinctive term REM while for the Mark it is RAP, which is suggestive of "rapid relief" when used in association with the Wares. On that basis I conclude that the marks when viewed as a whole are different both visually and phonetically. Moreover the ideas suggested by them are not the same.

[27] From this analysis I rule that the Applicant has discharged its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's trade-mark REMINYL. Even though the parties' wares are in the same general class, their purposes are different: the Wares are pain reliever while the Opponent's wares are for use as neurological treatment. The marks are different visually, phonetically and in the ideas suggested by them.

VI Conclusion

[28] Pursuant to the authority delegated to me by the Registrar of Trade-marks under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

DATED IN BOUCHERVILLE, QUEBEC, THIS 23th DAY OF DECEMBER 2009.

Jean Carrière,
Member, Trade-marks Opposition Board