

**IN THE MATTER OF AN OPPOSITION by  
Pharmacia AB to  
application No. 1,005,697  
for the trade-mark MIRALAX  
in the name of Braintree Laboratories, Inc.**

**On February 17, 1999, the applicant, Braintree Laboratories, Inc., filed an application to register the trade-mark MIRALAX based upon proposed use of the trade-mark in Canada in association with laxatives. The application was advertised for opposition purposes in the Trade-marks Journal of January 12, 2000.**

**Pharmacia & Upjohn AB filed a statement of opposition on March 13, 2000. The applicant filed and served a counter statement on July 21, 2000. Effective September 28, 2000, Pharmacia & Upjohn AB changed its name to Pharmacia AB (hereinafter the opponent).**

**The opponent filed the affidavits of Britt-Marie Solström and Luciana Comishen in support of its opposition. The applicant filed the affidavit of Harry P. Keegan, III in support of its application. In reply, the opponent filed the affidavit of Suzy Torres.**

**Each party filed a written argument but an oral hearing was not requested.**

**The opponent has pleaded four grounds of opposition. The first ground of opposition pleads that the application does not comply with subsection 30(e) of the *Trade-marks Act*. The three remaining**

grounds plead that the trade-mark is not registrable, the applicant is not the person entitled to registration, and the trade-mark is not distinctive, all based on the assertion that MIRALAX is confusing with the trade-mark MICROLAX previously used, made known and registered by the opponent in association with pharmaceutical preparations, namely enema, and excluding oral laxative preparations. Although the ultimate legal burden lies on the applicant in opposition proceedings, there is an evidential burden on the opponent to first adduce sufficient evidence to support the truth of its allegations.

Ms. Solström, the Vice President Technical Operations Consumer Healthcare of the opponent, informs us that the opponent manufactures the MICROLAX enema in Sweden and ships the product to Canada in its final packaging. She provides the volume and value of these Canadian sales for each of the years 1998, 1999 and 2000 (over 30,000 boxes or \$300,000 U.S. ex-factory each year). She also identifies other countries where the opponent has used and registered the MICROLAX mark and sets out the opponent's various former names.

Ms. Comishen, the Director Regulatory Compliance & Quality Assurance of Pharmacia Canada Inc., informs us that her company acts as the distributor of the MICROLAX enema in Canada. She states that Pharmacia Canada Inc. was previously called Pharmacia & Upjohn Inc. as well as Pharmacia Inc. also doing business as Pharmacia Canada. She also states that the MICROLAX product is "manufactured in the city of Helsingborg in Sweden by Pharmacia AB, which is the former name of Pharmacia & Upjohn AB and which does business under the trade name Pharmacia & Upjohn."

**Ms. Comishen provides “tubes and boxes similar or identical to those utilized over the last few years in Canada for the [MICROLAX] product”. (Ms. Comishen’s affidavit was sworn in 2001.) The tubes and boxes prominently display the trade-mark MICROLAX followed by ®. The product itself is identified as a “micro-enema”.**

**Ms. Comishen also provides “price lists disseminated in Canada during the last few years” and copies of pages from the Compendium of Pharmaceuticals and Specialties for the years 1990 to 2001 showing reference to the MICROLAX product.**

**Ms. Comishen provides the same sales figures as those provided by Ms. Solström. She also explains that the MICROLAX product is available without prescription and is available in drug stores and hospitals. She states that clients “consist of hospitals, pharmacies, medical centers, health care centers, extended care homes, university institutes, the salvation army.”**

**Mr. Keegan, the applicant’s President, attests that MIRALAX laxative has been sold in the United States but that it has not yet been sold in Canada. The MIRALAX laxative is however intended to be sold by prescription and advertised to physicians, health professionals and consumers. Mr. Keegan has provided copies of ads that appeared in U.S. medical journals that he says are also subscribed to by Canadian physicians and health professionals. He provides the number of Canadian subscriptions for each of the publications in which MIRALAX ads have appeared in 2001.**

**Mr. Keegan states that the MIRALAX product is for the treatment of occasional constipation. MIRALAX laxative is supplied in a white, granulated powder that the patient dissolves in a liquid for consumption. The dose frequency is once a day. Mr. Keegan enters into a comparison of the MICROLAX product sold in the United States and the MIRALAX product sold in that country. In paragraph 14, he states, “ In my opinion, there are differences between the products, their methods of use and their chemical compositions that are significant enough to avoid the likelihood of confusion.” I am according this opinion no weight. Not only is Mr. Keegan not an expert with respect to the likelihood of confusion between trade-marks under Canadian law but also there is nothing in the parties’ statements of wares that would oblige them to only use their trade-marks in the manner, or with the specific chemical product, in association with which they have used their marks in the U.S. to date.**

**Mr. Keegan also provides a copy of the prosecution file with respect to the opponent’s registration for MICROLAX. The file shows that pursuant to an opposition filed by the owner of the trade-mark MAGNOLAX, the owner of the application for MICROLAX restricted its statement of wares to exclude oral laxative preparations.**

**Ms. Torres, a trade-mark analyst employed by Thomson & Thomson Canada, provides the results of a search that she conducted of a database of in-use drug names and associated data. The results that she obtained concern the use of MIRALAX in the United States.**

*Section 30 Ground of Opposition*

There is no evidence that supports the opponent's allegation that the applicant "did not intend at the time of filing the application and still does not intend to use the trade-mark MIRALAX in Canada in connection with laxatives." Accordingly, this ground of opposition fails.

*Paragraph 12(1)(d) Ground of Opposition*

The opponent has not provided a copy of the registration upon which it relies. I have therefore exercised the Registrar's discretion to check the Register and have confirmed that registration No. 156,802 for MICROLAX remains on the register and is currently in the name of the opponent. [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.*, 11 C.P.R. (3d) 410 (T.M.O.B.)]

The material date with respect to paragraph 12(1)(d) is the date of my decision [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.)]. There is a legal burden on the applicant to establish on a balance of probabilities that there would be no reasonable likelihood of confusion between its mark and the registered mark.

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in subsection 6(5) of the Act. Those factors specifically set out in subsection 6(5) are: the inherent distinctiveness of the

trade-marks and the extent to which they have become known; the length of time each has 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 in appearance or sound or in the ideas suggested by them. The weight to be given to each relevant factor may vary, depending on the circumstances [see *Clorox Co. v. Sears Canada Inc.* 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

Neither of the marks has a great degree of inherent distinctiveness. The opponent's mark suggests that it is a small (micro) laxative (lax), as reinforced by the fact that the product is itself described on its packaging as a micro-enema. The applicant's mark might be considered to be a contraction of "miracle laxative".

The extent to which each of the marks has become known in Canada favours the opponent, as does the length of time that each mark has been used in Canada.

The parties' wares are of the same general class, namely pharmaceuticals used to treat constipation. Although the MICROLAX registration specifically excludes oral laxatives, i.e. the exact wares that Mr. Keegan indicates are sold under the MIRALAX trade-mark, the MIRALAX application covers the broader wares, laxatives, which could include enemas. Although the opponent's registration does not give it the exclusive right to use its mark in association with oral laxatives, oral laxatives are still closely related to the opponent's wares. In addition, although the opponent's wares are sold without prescription while the applicant intends to sell its wares

pursuant to prescriptions, their channels of trade could overlap.

Overall, the marks bear a reasonably high degree of resemblance. This resemblance is due in part to their common suggestive suffix, LAX but it is the first part of a mark that is typically considered more important for the purpose of distinction [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) and *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)]. If one considers the first part to be the first syllable, then the first part of each mark is also identical. The resemblance between the marks in idea suggested is considerably less than the resemblance in appearance or sound, as a result of the meaning of “micro”.

As a further surrounding circumstance, the applicant points to the fact that there was no opposition to the registration of its mark in the United States of America. I do not find this to be significant as the situation in the United States may very well be quite different from that in Canada.

At pages 7 and 8 of its written argument, the applicant has pointed to submissions made by the opponent’s predecessor when it was defending its application to register MICROLAX from an opposition by the owner of the trade-mark MAGNOLAX for medicinal laxative preparations. At that time, the owner of the MICROLAX trade-mark argued that confusion was not likely with MAGNOLAX because: MICROLAX was for rectal use while MAGNOLAX was an oral preparation; “the suffix LAX is very common in trade marks and cannot in itself constitute a

distinguishing feature of the marks”; and the “two prefixes MAGNO and MICRO have completely different pronunciations and suggest opposite ideas”. The Registrar did not issue a decision in the opposition proceedings; instead, the opponent withdrew the opposition once the owner of the MICROLAX application excluded oral laxatives from its statement of wares.

The applicant now argues that the opponent must be bound by its predecessor’s position and that the paragraph 12(1)(d) ground of opposition must therefore fail. In other words, the applicant is invoking “file wrapper estoppel”.

In *S.C. Johnson & Son, Ltd. et al. v. Marketing International Ltd.* (1979), 44 C.P.R. (2d) 16 (S.C.C.), the Supreme Court of Canada alluded to the dilemma faced by a company that argued one way during the prosecution of an application but then wished to argue the opposite way when endeavouring to enforce the resulting registration. However, in *Domtar Inc. v. Commercial Plastics & Supply Corp.* (1990), 30 C.P.R. (3d) 122 (T.M.O.B.), Hearing Officer Martin stated at page 124:

Although the applicant did not file a written argument or make any oral submissions, it is apparent from its counterstatement that it was taking the position that the opponent was estopped from alleging confusion in this case as a consequence of statements made in obtaining its registrations. In this regard, the applicant relied on the decision in *S.C. Johnson & Son, Ltd. v. Marketing Int'l Ltd.* (1979), 44 C.P.R. (2d) 16 at pp. 27-8, 105 D.L.R. (3d) 423, [1980] 1 S.C.R. 99 (S.C.C.). However, in my view, that decision does not support the applicant's contention that an opponent's statements made in obtaining its prior registrations constitute some form of estoppel although such statements can be given some weight in assessing the issue of confusion: see the decision in *McDonald's Corp. v. Silcorp Ltd.* (1989), 24 C.P.R. (3d) 207 at p. 212 (F.C.T.D.).

Accordingly, I have considered the submissions made by the opponent’s predecessor but they are



**not determinative of the outcome of this proceeding.**

**Having considered all the surrounding circumstances, I conclude that the applicant has not satisfied the onus on it to show that, on a balance of probabilities, there is not a reasonable likelihood of confusion between MICROLAX as applied to “pharmaceutical preparations, namely enema, and excluding oral laxative preparations” and MIRALAX as applied to “laxatives”. I reach this conclusion based primarily on the degree of resemblance between the marks, the overlap between the wares as well as the channels of trade, and the lack of reputation associated with the MIRALAX mark. The registrability ground of opposition accordingly succeeds.**

***Entitlement Ground of Opposition***

**The opponent has met its initial burden under sections 16 and 17 to show use of its mark in Canada prior to February 17, 1999 and non-abandonment of its mark as of January 12, 2000.**

**The material date for assessing the likelihood of confusion under subsection 16(3) is February 17, 1999. However, in the circumstances of this case, nothing turns on the date at which the issue of confusion is determined. Accordingly, a consideration of the surrounding circumstances as of February 17, 1999 leads me to reach the same conclusion that I reached above with respect to the paragraph 12(1)(d) ground of opposition. The entitlement ground of opposition therefore also succeeds.**

*Distinctiveness Ground of Opposition*

The material date with respect to a ground of opposition based on non-distinctiveness is the date of filing of the opposition [see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)]. Once again, the differences between the surrounding circumstances as of this date and today's date are not significant. The applicant has not met its onus to show that MIRALAX can distinguish its wares from those of the opponent. This ground of opposition therefore also succeeds.

*Disposition*

Having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the *Trade-marks Act*, I refuse the application pursuant to subsection 38(8) of the Act.

DATED AT TORONTO, ONTARIO, THIS 6th DAY OF AUGUST 2004.

Jill W. Bradbury  
Member  
Trade-marks Opposition Board