

**IN THE MATTER OF AN OPPOSITION
by Apotex Inc. to application No. 722,545
for the trade-mark Tablet Design filed by
Searle Canada Inc. and now standing in
the name of Monsanto Canada, Inc.**

On February 11, 1993, Searle Canada Inc. filed an application to register the trade-mark Tablet Design (illustrated below) based on use in Canada since August 25, 1986. The application (as amended) covers the following wares:

pharmaceutical preparations namely tablets containing 200 mcg of misoprostol as the active ingredient.

The applied for trade-mark is described in the application as follows:

The trade-mark is shown in the attached drawing and consists of the colour white applied to the whole of the visible surface of the tablet. The representation of the tablet shown in dotted outline does not form part of the trade-mark.

The application was advertised for opposition purposes on October 13, 1993 and was subsequently assigned to Monsanto Canada, Inc.



The opponent, Apotex Inc., filed a statement of opposition on December 13, 1993, a copy of which was forwarded to the applicant on April 16, 1994. The first ground of opposition is that the applicant's application does not comply with the provisions of Section 30 of the Trade-marks Act because the subject of that application is not a trade-mark. The second ground is that the applicant's application does not comply with the provisions of Section 30(b) of the Act because the applicant has not used its trade-mark since the date claimed. The third ground is that the applicant's application does not comply with the provisions of Section 30(h) of the Act because it does not include an accurate representation of the applicant's mark.

The fourth ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(1) of the Act because, as of the applicant's claimed date of

first use, the applied for trade-mark was confusing with “...trademarks namely, white tablets” previously used in Canada by the opponent. The fifth ground is that the applied for trade-mark is not distinctive in view of the use by various other traders of white tablets.

The applicant filed and served a counter statement. The opponent’s evidence consists of the affidavits of James Marshall Bowen and James Edward George Snowden. The applicant’s evidence consists of the affidavits of Jason T. Pankratz and Ronald S. Clark. Messrs. Pankratz and Clark were cross-examined on their affidavits and the transcripts of those cross-examinations form part of the record of this proceeding. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

The opponent did not include any supporting allegations of fact for its first ground. Thus, that ground does not comply with Section 38(3)(a) of the Act and is therefore unsuccessful. In any event, the applicant’s applied for design can function as a trade-mark: see Smith Kline & French Ltd. v. Registrar of Trade Marks [1987] 2 F.C. 633 (F.C.T.D.).

As for the opponent's second ground of opposition, the onus or legal burden is on the applicant to show its compliance with the provisions of Section 30(b) of the Act: see the opposition decision in Joseph Seagram & Sons v. Seagram Real Estate (1984), 3 C.P.R.(3d) 325 at 329-330 and the decision in John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 (F.C.T.D.). There is, however, an evidential burden on the opponent respecting its allegations of fact in support of that ground. That burden is lighter respecting the issue of non-compliance with Section 30(b) of the Act: see the opposition decision in Tune Masters v. Mr. P's Mastertune (1986), 10 C.P.R.(3d) 84 at 89. Furthermore, Section 30(b) requires that there be continuous use of the applied for trade-mark in the normal course of trade since the date claimed: see Labatt Brewing Company Limited v. Benson & Hedges (Canada) Limited and Molson Breweries, a Partnership (1996), 67 C.P.R.(3d) 258 at 262 (F.C.T.D.). Finally, the opponent’s evidential burden can be met by reference to the applicant’s own evidence: see Labatt Brewing Company Limited v. Molson Breweries, a Partnership (1996), 68 C.P.R.(3d) 216 at 230 (F.C.T.D.).

The evidence establishes that the applicant has always sold its 200 microgram dosage of misoprostol under the trade-mark CYTOTEC in a white, hexagonal tablet. The tablet is scored in the middle on both sides with a line and is lightly scored on one side with the word SEARLE above the middle line and the numerals 1461 below it. The opponent contends that sales of the applicant's tablets in that form do not constitute use of the applied for trade-mark because of the addition of the word SEARLE and the numerals. However, in view of the fact that the indicia SEARLE and 1461 are only lightly scored on one side of the tablet and are barely legible, it seems likely that the white shape of the tablet would stand out as its dominant feature. Thus, the public would, as a matter of first impression, perceive use of the actual tablet as also being use of the tablet's white shape alone: see the opposition decision in Nightingale Interloc Ltd. v. Prodesign Ltd. (1984), 2 C.P.R.(3d) 535 at 538 and page 269 of the opposition decision in Novopharm Ltd. v. Burroughs Wellcome Inc. (1994), 58 C.P.R.(3d) 513 (F.C.T.D.); affg. (1993), 52 C.P.R.(3d) 263 at 273 (T.M.O.B.). As noted by the applicant, the use of other trade-marks on the applicant's tablet does not preclude registration of the trade-mark claimed in this application: see Ciba-Geigy Canada Ltd. v. Apotex Inc. (1992), 44 C.P.R.(3d) 289 at 304 (S.C.C.).

The opponent also contended that continuous use of the applied for trade-mark had not been shown since the only evidence of use is by the applicant's predecessor-in-title Searle Canada Inc. However, the Clark affidavit establishes that Monsanto Canada Inc. acquired the assets of Searle Canada Inc. in 1994 and carried on that company's business as the Searle Canada Division of Monsanto Canada Inc. Thus, the applicant has shown continuous use of the applied for trade-mark by Searle Canada Inc. and the Searle Canada Division of Monsanto Canada, Inc. since the date claimed. Thus, the second ground is unsuccessful.

As for the third ground of opposition, Section 30(h) reads as follows:

30. An applicant for the registration of a trade-mark shall file with the Registrar an application containing.....

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

The applicant did file a drawing of its applied for mark and, in view of the initial portion of the description of the mark appearing in the application, it is apparent that the drawing depicts the mark for which the applicant seeks registration. Thus, it would appear that the applicant has complied with Section 30(h) and the third ground is therefore unsuccessful.

The opponent submitted that the drawing does not comply with Section 30(h) because the applicant effectively eliminated any shape restriction for its mark by including the statement that the tablet shown in dotted outline does not form part of the mark. The opponent contended that such a statement means that the applicant is claiming the color white 'per se' as its trade-mark apart from the tablet itself.

Although the statement referred to by the opponent is somewhat ambiguous and confusing, the initial portion of the description of the trade-mark in the application clearly limits the mark to the whole of the visible surface of the tablet. The statement referred to by the opponent appears to be simply an indication that the applicant is not claiming the tablet as its trade-mark but only the shape of the tablet as it defines the limits of the claim to the color white. At the oral hearing, the applicant's agent indicated that the statement simply means that the applicant is not claiming rights in hexagonal tablets 'per se.' Given the ambiguity in the statement, however, it should not have been included in the description of the mark although it was apparently only included to satisfy a practice requirement of the Examination Division: see, for example, page five of the unreported opposition decision in Novopharm Ltd. v. Hoechst Aktiengesellschaft (S.N. 671,135; March 19, 1997).

As for the fourth ground of opposition, the opponent has failed to evidence use of any of its trade-marks prior to the applicant's claimed date of first use. The fourth ground is therefore unsuccessful.

As for the fifth ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares and services from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. -

December 13, 1993): see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.). Finally, there is an evidential burden on the opponent to prove the allegations of fact in support of its ground of non-distinctiveness.

The opponent's affiants are both pharmacists. Exhibit 2 to each of those affidavits comprises an excerpt from a publication identified as the 1994 Compendium of Pharmaceuticals and Specialties which each affiant states includes white tablets used by other manufacturers in 1994. Each affiant states that several of those tablets are used in the treatment of conditions which are concurrent or associated with gastric ulcers. However, neither pharmacist specifically identifies any particular tablet appearing in the excerpt. Furthermore, neither affiant evidences how any of those tablets have been used in Canada or the extent to which they have been used. In fact, neither affiant was able to state that he prescribed or filled a prescription relating to any third party white tablet, much less one used to treat gastric ulcers or related conditions. Thus, the opponent has failed to meet the evidential burden on it and the fifth ground is therefore unsuccessful.

Even if the opponent had evidenced a reputation in Canada for different third party white tablets, it appears that the final ground would still have been unsuccessful. The applicant's application is narrowly restricted to the specific drug misoprostal in a specific dosage and it appears that no one else is selling that drug in any form much less in the form of a white, hexagonal tablet. Furthermore, the Clark affidavit evidences significant sales of the applicant's tablet for a number of years. Finally, the applicant has distributed advertising materials which promote the color and shape of the applicant's tablets. Thus, in accordance with the opposition decision in Burroughs Wellcome Inc. (at page 273), the evidence suggests that the applicant's trade-mark can distinguish the applicant's specific product from other pharmaceutical products. Unlike the situation in Novopharm Ltd. v. Searle Canada Inc. (1995), 60 C.P.R.(3d) 400 at 404 (T.M.O.B), the evidence does not establish that other pharmaceutical manufacturers sell drugs in the form of the applicant's tablet for the treatment of the same or similar medical conditions for which the applicant's drug is prescribed.

The opponent also submitted that the applicant's trade-mark cannot distinguish the applicant's wares because the applicant has the exclusive right to produce the specific drug misoprostol. In this regard, the opponent relied on the decisions in Canadian Shredded Wheat Co. Ltd. v. Kellogg Co. of Canada [1938] 1 All E.R. 618 (P.C.) and Thomas & Betts Ltd. v. Panduit Corp. (1997), 74 C.P.R.(3d) 185 (F.C.T.D.). However, the opponent failed to plead a ground of non-distinctiveness based on such a submission.

Even if the opponent had pleaded such a ground, it would have been unsuccessful. In the Canadian Shredded Wheat case, the Judicial Committee of the Privy Council held that the plaintiff's trade-mark SHREDDED WHEAT was descriptive and the name of the product. The product was a cereal biscuit of a particular shape which was the subject of a patent. The plaintiff also alleged passing off based on the shape of its product. The Judicial Committee of the Privy Council dismissed the passing off action on the basis that there was only one shape available for the product based on the teachings of the patent. There was also no evidence that any consumers had been deceived. Similar reasoning was applied in the Thomas & Betts case.

In the present case, whatever monopoly the applicant may have is for the drug misoprostol and not for the shape of the tablet. The hexagonal shape was not dictated by the teachings of any patent or any functional requirements. The evidence suggests that the applicant's tablet could have been produced in any number of shapes.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I reject the opponent's opposition.

DATED AT HULL, QUEBEC, THIS 15th DAY OF DECEMBER, 1997.

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