

IN THE MATTER OF AN OPPOSITION
by Apotex Inc. and Novopharm Limited to application
No. 1001651 for the trade-mark TABLETS and Sun
Design filed by Smithkline Beecham Corporation
(Pennsylvania Corporation)

On January 11, 1999, the applicant, Smithkline Beecham Corporation (Pennsylvania Corporation) (“Smithkline”), filed an application to register the trade-mark TABLETS and Sun Design based on proposed use of the mark by itself, or through a licensee, in association with the following wares:

Pharmaceutical preparations, namely, anti-depressants and preparations for the treatment of diseases of the central nervous system; printed materials, namely, leaflets, booklets, workbooks, newsletters, books and guides.

and services now identified as:

Educational services in the field of healthcare; information services relating to healthcare; on-line information services relating to healthcare.

The application was advertised for opposition purposes on May 24, 2000. The design mark is reproduced below:



The application contained the following claims:

“1. The trade-mark is two dimensional. 2. Color is claimed as a feature of the trade-mark as follows; the tablet in the first box from the left is yellow, the table in the second box from the left is pink, and the tablet in the third box from the left is light blue.”

The opponents, Apotex Inc. and Novapharm Limited, filed a statement of opposition on October 24, 2000, a copy of which was forwarded to the applicant on October 31, 2000. The applicant served and filed a counter statement on Feb. 28, 2001. The opponent filed as its evidence the affidavits of Benjamin Bundle and Jan Sahai. Mr. Sahai was cross-examined on his affidavit and

the transcript of the cross-examination forms part of the record. The applicant filed the affidavits of Andrew Yee Hon Hui and Maurice Siu. Both parties filed a written argument.

On May 13, 2004, after the filing of the written arguments, the opponent requested leave to amend its statement of opposition to “particularize grounds” and clarify grounds already pleaded. On May 21, 2004, the applicant filed submissions objecting to this grant of leave. The opponent filed further submissions in support of its request on July 16, 2004. On December 7, 2004, Lisa Power, Chair of the Trade-marks Opposition Board, refused to grant leave to amend the statement of opposition.

An oral hearing was held at which both parties were represented.

Grounds of Opposition

The grounds of opposition are as follows.

The opponent has pleaded that the application does not comply with s. 30 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (“the Act”) in numerous respects. In addition, it has pleaded that the applicant’s alleged mark is not registrable because: a) it is clearly descriptive or deceptively misdescriptive of the character and/or quality of the wares with which it is proposed to be associated in that the three colours are used to indicate the dosage strength of the three tablets i.e. yellow = 10mg, pink = 20 mg and blue = 30 mg.; b) it is a distinguishing guise and the requirements of s. 13 have not been met; and c) it is a prohibited mark within the meaning of s. 10. (It is useful to state at this point that the product the applicant is now selling in association with the applied for design is also associated with the word mark PAXIL.) Finally, the opponent pleads that the mark is not distinctive because: a) yellow pills, pink pills and blue pills have been prescribed by physicians, dispensed by pharmacists and taken by patients in Canada such that the alleged trade-mark cannot actually distinguish the applicant’s tablet; and b) in view that the applicant marks each and every tablet with the word PAXIL on one side and the dosage strength on the other, that the colour, shape and size, do not and cannot distinguish the wares of the applicant.

Material Dates

The material dates with respect to each ground of opposition is as follows: s. 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469 at p. 475]; s. 12(1)(b) - the filing date of the application (see *Shell Canada Limited v. P.T. Safari Incofood Corporation*, 2005 FC 1040 and *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.); s. 13 - the filing date of the application; s. 12(1)(e) – the date of my decision [see *Allied Corporation v. Canadian Olympic Association* (1989), 28 C.P.R. (3d) 161 (F.C.A.) and *Olympus Optical Company Limited v. Canadian Olympic Association* (1991), 38 C.P.R. (3d) 1 (F.C.A.)]; non-distinctiveness - 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 p. 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at p. 424 (F.C.A.)].

Onus

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 evidential burden on the opponent to adduce sufficient admissible evidence from which it could be reasonably concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Summary of Evidence

Before addressing the specific grounds of opposition, I will summarize the evidence.

Andrew Yee Hon Hui

Mr. Hui identifies himself as a pharmacist in Ontario. He states that he is familiar with the different dosages of Paxil. He states that there is a 10mg dose which is yellow in colour, a 20mg dose which is pink in colour and a 30mg dose which is blue in colour. Paxil pills are clearly marked with identifying markings. They are marked PAXIL on one side and "10", "20" or "30"

on the other side depending on the dosage. He states that he has never seen a Paxil pill that did not have these clearly visible and dominant markings. Thus, if he were provided with a pill that had a similar colour, shape and size as Paxil, but had no markings, he would not be able to conclude that the product is Paxil. He further states that colour, or colour and shape or colour, shape and size of a pill are not enough for him to identify a pill. He uses the markings, the box/bottle and the DIN to identify medications.

Paxil is used in the treatment of depression, panic disorder, obsessive-compulsive disorder and social phobia or social anxiety disorder. He asserts that most patients are not concerned with the appearance of their pills but are primarily concerned with the therapeutic effect of their drug.

Mr. Hui further states that there are a number of coloured prescriptions in the Canadian marketplace that are yellow, pink and blue in colour. Attached as Exhibit A to his affidavit is a list of the prescription yellow, pink and blue pills that he has dispensed since at least January, 2000. Attached as Exhibit B are the relevant pages from the 2000 Compendium of Pharmacist Specialties (“CPS”) which reference those pills listed in Exhibit A to his affidavit. He further states that some of the drugs listed in Exhibit A may be used at the same time as Paxil in the treatment of concurrent or associated conditions. He also provides a list of pink, yellow and blue pills which are used to treat the same conditions as Paxil. Finally, he asserts that he is also aware of a number of over the counter pink, yellow and blue pills. Lists of pink, yellow and blue pills that he is familiar with and that have been sold at his pharmacy since at least as early as January 2000 are attached as Exhibit C to his affidavit. Attached as Exhibit D to his affidavit are the relevant pages from the 2000 CPS and 1996 CNP which reference those pills listed in Exhibit C to his affidavit.

As Exhibit E, Mr. Hui provides a chart of drugs that have different colours for different dosages. There are two other drugs beside Paxil that come in a yellow, pink and blue colour scheme for different dosages, namely Eltroxin and Synthroid. Although Mr. Hui did not comment on any other drugs, at the oral hearing the opponent submitted that the evidence also showed three other

drugs that had the same colour scheme as PAXIL for different dosages. These drugs were Sinemet, Prinzide and Ogen. The opponent pointed to the appearance of these drugs in the CPS. My review of the products that appear in the CPS leads me to question if some of the tablets shown are the same shades of yellow, pink or light blue as the applicant's tablets. On the other hand, the colour claims in the application are rather broad since no particular shade of the colours yellow or pink have been indicated. In any case, I do agree with the applicant that if there were other tablets that had the same colour combination for dosages as PAXIL, Mr. Hui would have included them on his chart.

Maurice Siu

Dr. Siu identifies himself as an Ontario physician. He states that he is familiar with Paxil and has prescribed it since 1998. He explains that he never relies on the colour, shape and size of a drug to determine the type of medication which it contains or who manufactures it. If he is not familiar with a drug, he consults the product monograph and/or the CPS to obtain information about the medication. When he is familiar with a drug, he identifies it by trade name or active ingredient. He understands that all pharmaceutical tablets have some form of identifiable marking on their surface. PAXIL tablets are marked "PAXIL" on one side and the dosage amount on the other side, namely, "10", "20" or "30".

He explains that many of his patients have come to identify the type of medication by its general appearance. For example, the patient may refer to the medication as "my white heart pill" or "my yellow arthritis pill" or "my pink anti-depressant".

Attached as Exhibit A to his affidavit is an enlarged picture of the design mark that is the subject of these proceedings. He states that he has seen this picture in advertisements in various medical journals, in PAXIL information pamphlets supplied to physicians and in dosing guidelines. Attached as Exhibit B are copies of sample materials displaying the TABLETS and Sun Design mark.

At paragraphs 18 and 19 of his affidavit, he states the following:

18. When I look at the picture in Exhibit A, the three pills trigger me into thinking about various titration strategies to employ with patients. That is, what starting dosage of Paxil I should initiate my patients on.
19. The three different coloured tablets that are pictured represent to me that colour is an indication of the dosage strength and that there are three different dosage strengths of Paxil. (I would not, however, remember which colour was for which dosage strength). This is similar to many other pharmaceuticals where different dosages come in different colours. For example, anti-psychotic medications employ different colours to indicate different dosage strengths.

Jan Sahai

Mr. Sahai identifies himself as Director of Marketing CNS (Central Nervous System) with GlaxoSmithKline Inc. He explains that his company is a related company of the applicant and is licensed to use the trade-mark in Canada. Under the license, the applicant has control of the character and quality of the wares with which the trade-mark has been used by his company and by its predecessors. He refers to the applicant, its predecessors and his company collectively as "GSK".

He explains that since the trade-mark PAXIL was launched in 1993, it has been promoted extensively in Canada through visits by sales representatives to physicians. During such visits, information concerning PAXIL and its use are provided to the physicians both through verbal presentations and through written promotional materials. Representative samples of promotional material displaying the applied for mark which has been distributed to physicians in Canada since approximately February, 1999, are attached as Exhibits A through G of his affidavit.

He explains that the trade-mark has been used in Canada by GSK since approximately February 1999 in association with information leaflets and booklets provided to physicians.

On cross-examination, Mr. Sahai admitted that the colour of a PAXIL tablet indicates its dosage (Sahai cross-ex., p.22). Mr. Sahai also agreed that markings on tablets are required for

identification. He further stated that the TABLETS and Sun design is not used on the packaging of the materials, nor is it featured on the PAXIL website.

Benjamin Bundle

Mr. Bundle is a Trade-mark Searcher for the applicant's agent. He searched the Canadian Trade-mark Database, CD NameSearch for the purpose of locating trade-marks enclosing a sun design or logo owned by the applicant. Attached as Exhibit A to his affidavit are extracts from the CIPO Register of the registrations Nos. TMA491,090; TMA 473,076 and the present application, 1,001,651, all owned by the applicant.

Distinctiveness Ground of Opposition (Section 38(2)(d))

In both its written and oral argument, the opponent set out some of the legal principles with respect to distinctiveness as applied to pharmaceutical colour/shape/size marks. The applicant, on the other hand, argued that such cases do not apply to the present case because the present mark is a two dimensional design, namely a long slim rectangle divided into four shaded boxes, the first three of which contain depictions of a yellow tablet, a pink tablet, and a light blue tablet and the fourth box consisting of the applicant's distinctive Sun Design. Further, the applicant submits that it is not seeking a monopoly only on pharmaceutical preparations, but also on printed materials, and various healthcare services including educational services, informational services and on-line informational services. Finally, the applicant argues that since it is not applying for the "get up" of a tablet, its trade-mark is not a distinguishing guise and therefore it does not have to show acquired distinctiveness.

I agree with the applicant that the present case can be distinguished from other colour/shape/size cases for several reasons, one of which being that the current application is not for the registration of a particular trade-dress of tablets or capsules. However, many of the cases cited by the opponent also stand for general principles of law that can be applied to a wide variety of cases. I will therefore apply those general principles as I see fit.

Madame Justice Dawson made the following observations concerning the issue of distinctiveness in *Novopharm Ltd. v. AstraZeneca AB et al.* (2003), 28 C.P.R. (4th) 129 (F.C.T.D.) [hereinafter "*AstraZeneca (Dawson)*"] at pages 133 to 134:

"It follows that what is to be determined in this proceeding is whether Astra has met its burden to establish that the proposed trade-marks were distinctive as of the date of opposition. This turns upon the factual question as to whether as of the date of opposition, tablets marketed in an appearance similar to Astra's 5 mg and 10 mg tablets render Astra's marks non-distinctive and thereby preclude registration of the trade-mark.

The term "distinctive" is defined in s. 2 of the Act in the following terms:

"distinctive", in relation to a trade-mark, means a trade-mark that actually distinguishes the wares or services in association with which it is used by its owner from the wares or services of others or is adapted so to distinguish them.

« distinctive » Relativement à une marque de commerce, celle qui distingue véritablement les marchandises ou services en liaison avec lesquels elle est employée par son propriétaire, des marchandises ou services d'autres propriétaires, ou qui est adaptée à les distinguer ainsi.

As the Court of Appeal wrote in *AstraZeneca AB v. Novopharm Ltd.*, 2003 FCA 57 at paragraph 16:

[...] A mark actually distinguishes by acquiring distinctiveness through use, resulting in distinctiveness in fact. A mark that is "adapted so to distinguish" is one that does not depend upon use for its distinctiveness because it is inherently distinctive. A coined or invented word mark falls into this category: *Standard Coil Products (Canada) Ltd. v. Standard Radio Corp.*, [1971] F.C. 106 (T.D.), at 115; *The Molson Companies Limited v. Carling O'Keefe Breweries of Canada Limited*, [1982] 1 F.C. 175 (T.D.), at 278-79.

The current case law makes it clear that the relevant market to be considered with respect to distinctiveness for trade-mark applications in colour, size and shape tablet cases is all pharmaceuticals [see *AstraZeneca AB v. Novopharm Ltd. et al.* (2003), 24 C.P.R. (4th) 326 (F.C.A.); *Novopharm Ltd. v. AstraZeneca AB et al.* (2003), 28 C.P.R. (4th) 129 (F.C.T.D.); *Novopharm Ltd. v. Astra Aktiebolag* (2004), 36 C.P.R. (4th) 158 (T.M.O.B.)]. Although the applied for mark is not for the colour, shape or size of a tablet, and the applied for pharmaceutical wares have been restricted to “anti-depressants and preparations for the treatment of diseases of the central nervous system”, I still consider the relevant market in the present case to be all pharmaceuticals since the evidence shows that many patients taking anti-depressants and preparations for the treatment of diseases of the central nervous system also take medication for various other concurrent or related conditions [see also *Novopharm v. Bayer* (1999), 3 C.P.R. (4th) 305 (F.C.T.D.)].

The burden is therefore on the opponent to show that there was sufficient use in the pharmaceutical marketplace of a confusingly similar mark to negate the distinctiveness of the applicant’s trade-mark [see *Motel 6 Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58].

First Arm of s.38(2)(d) issue

For the purposes of the oral hearing, and with the applicant’s agent’s consent, the opponent kindly provided a table identifying each yellow, pink and blue tablet referred to in the pleadings and the evidence with an indication of the evidence relating to each. The summation of the evidence was appreciated.

A large part of the opponent’s evidence was submitted to show that pink, yellow and blue tablets (prescription and non-prescription) were common in the marketplace since at least January, 2000. In this regard, the opponent’s evidence provides copies of excerpts from the 2000 CPS which shows prescription yellow, pink and blue pills that Mr. Hui personally dispensed since at least

January, 2000, and pink, yellow and blue over the counter pills sold at his pharmacy since at least as early as January, 2000 (see paragraphs 9 and 13 of the Hui affidavit, and Exhibits A and C).

The opponent's evidence also includes a chart of drugs with different colours for different dosages. Only 3 drugs are listed that have yellow, pink and blue in their colour scheme. These include Eltroxin, Synthroid and the applicant's PAXIL drug. At the oral hearing, the opponent's agent pointed to 3 other drugs listed in the CPS (i.e. Sinemet, Prinzide and Ogen) which the opponent submitted also came in the colour combination yellow, pink and blue for dosages. As I mentioned earlier in my summary of Mr. Siu's evidence, I am not certain about the opponent's submission that these other drugs share the same colour scheme as the applicant's PAXIL drug.

Relying on the decision in *Novopharm Limited v. Purdue Pharma* (Application No. 804,387, trade-mark PURPLE COLOURED CIRCULAR SHAPED TABLET Design; May 6, 2005 (TMOB)), the opponent submits that in view of the evidence furnished in the present case it has met its evidential burden under this ground. I respectfully disagree. In the *Novopharm v. Purdue Pharma* case, *supra*, the mark being applied for was a purple coloured circular shaped tablet design. The opponent's evidence that purple tablets were common to the Canadian pharmaceutical trade as of the material date was therefore sufficient for the opponent to meet its evidential burden in that case.

The present case can be distinguished because the mark in the present case is not for the colour, shape or size of 1, 2 or 3 tablets. Instead, it is for the rectangular design of four squares, 3 of which show a different coloured tablet and the fourth of which shows a sun design. Further, the design of the mark is not lined for any colour claims as in other cases. Rather, colours have only been claimed as a feature of the mark. Finally, the mark as advertised clearly states that the monopoly being claimed is for a two dimensional mark, not 1, 2 or 3 three dimensional tablets.

Therefore, just because the opponent has shown that pink, yellow and blue tablets have been common in the marketplace since at least January, 2000, and that some of these pharmaceuticals

had yellow, pink and blue in the colour scheme to indicate dosage, I am not satisfied that this evidence is sufficient to negate the distinctiveness of the applied for mark *as a whole*. As Madame Justice Dawson stated in *Astrazeneca (Dawson)*, *supra*, the applicant would only have the burden shifted to it to establish that the proposed mark was distinctive if, at the date of opposition, it was shown that there were tablets marketed in an appearance similar to the applicant's so as to render the applicant's mark non-distinctive. As the applicant submitted, it is not material whether any of the component parts of its mark are registrable or not by themselves. The mark as a whole must be considered [*Lake Ontario Cement Ltd. v. Registrar of Trade-marks* (1976) 31 C.P.R. (2d) 103; *Toronto Montessori Schools v. Montessori Nursery and Day Care Center Inc.*, 58 C.P.R. (3d) 148; *Canadian Schenley Distilleries Ltd. v. Registrar of Trade-marks and Bodegas Rjoja Santiago, S.A.* 15 C.P.R. (2d) 1].

As the opponent has not shown marks similar in appearance to the applicant's mark as a whole, the opponent has not negated the distinctiveness of the applicant's mark. As the distinctiveness of the applicant's mark has not been put into issue, it is not necessary to discuss how the applicant's mark has been used in the marketplace to date. Unlike decisions rendered in many of the colour, shape and size cases referred to by the opponent, the burden has not shifted to the applicant in the present case to show that its mark has acquired distinctiveness. This arm of the s.38(2)(d) ground therefore fails.

Second Arm of s.38(2)(d) issue

The second arm of the opponent's s.38(2)(d) ground is that since the applicant marks each and every tablet with PAXIL on one side, and the dosage strength on the other, the colour, shape and size of the applicant's tablets do not and cannot distinguish the wares of the applicant. As the applied for mark is not for the colour, shape or size of the applicant's tablets, I consider that this arm of the opponent's s.38(2)(d) ground is also unsuccessful.

At the oral hearing, the opponent also challenged the distinctiveness of the applicant's mark on the basis that the applicant has not properly licensed the mark to other users including

“GlaxoSmithKline”, “SmithKline Beecham”, “SmithKline Beecham Pharma” and “SmithKline Beecham Pharma Inc.”, in accordance with s. 50 of the Act. However, as the opponent did not raise the issue of improper licensing in its statement of opposition under its ground of non-distinctiveness, I am precluded from considering it [see *Imperial Developments v. Imperial Oil Ltd.* (1984), 79 C.P.R. (2d) 12 (F.C.T.D.) at 21].

Section 30 Grounds of Opposition

The first s.30 ground pleaded is that the subject matter of the application is not a trade-mark because it cannot be used to distinguish the applicant's wares. In my view, this pleading does not raise a ground of non-conformance with any of the enumerated requirements of s. 30. Instead, this ground appears to be based on the general allegation that the application does not comply with s. 2 of the Act because the mark applied for is not a trade-mark because it cannot be used to distinguish its wares from those of others in the marketplace. As I do not consider this to be a proper ground of opposition, this pleading fails.

The second s.30 ground is that the applicant could not have been satisfied that it was entitled to use the mark pursuant to s.30(i) because it is confusing with marks previously used or made known in Canada. As the opponent did not plead that the applicant was aware of other marks with confusingly similar appearances, this pleading also fails [see *Novopharm Ltd. v. Astra Aktiebolag* (2000), 6 C.P.R. (4th) 101 (T.M.O.B.) at 108].

The final s.30 ground is that the drawings filed with the application do not properly define the limits of the monopoly being applied for for several reasons. As some of these arguments overlap with other pleadings, I do not intend to address each of these arguments in detail.

One of the opponent's arguments under this ground is that it is unclear if the trade-mark being applied for is only the two dimensional representation of the pills or if it would also cover the pills themselves. This ambiguity, the opponent argues, leaves open the possibility that the trade-mark could be considered confusing with three dimensional tablets once the trade-mark issues.

As previously discussed, the mark being applied for is not for the pill/tablet itself but rather is for the rectangular design of 4 squares, 3 of which show a different coloured tablet and the final one depicting a sun design. In my view, the drawing clearly shows the mark being applied for. Further, I do not think that use of a two dimensional picture could be conceived as use of a three dimensional tablet mark. In considering this issue, I had regard to the following comment from Board Member Bradbury in *Novapharm Limited and Apotex Inc. v. Astra Aktiebolag (now AstraZeneca AB)* (January 20, 2004; Application No. 815,154):

“...the picture on the front of the box is 2 dimensional and the applicant is clearly seeking to register a three-dimensional mark. I do not think that use of the one is use of the other, otherwise, someone who registered a picture could then argue that it was using its mark when it sold a 3D object that resembled the picture, which was not permitted in *N.V. Sumatra Tobacco Trading Co. v. Imperial Tobacco Ltd.* (2001), 11 C.P.R. (4th) 501 (F.C.T.D.).”

The opponent also argues under this ground that since the applicant's tablets have markings on both sides (i.e. PAXIL on one side and the dosage strength on the other) then the appearance of the tablet which includes the colour, shape, size and the markings must be shown in the drawings. This argument is also based on the assumption that the trade-mark gives rights in a three dimensional mark. As I've already decided that this trade-mark will not give rights in a three dimensional tablet, I do not consider that the appearance of each of the tablets must be shown in the drawings. This ground of opposition is therefore unsuccessful.

Registrability Grounds of Opposition

Section 12(1)(b)

Under this ground the opponent pleads that the mark sought to be registered is clearly descriptive and deceptively misdescriptive of the character and/or quality of the wares with which it is proposed to be associated in that the three colours of the tablets are used to indicate the dosage strength of the three tablets, namely yellow=10 mg, pink = 20 mg and blue = 30 mg.

The issue as to whether the trade-mark TABLETS and Sun Design is clearly descriptive or deceptively misdescriptive of the character or quality of the applicant's wares must be considered from the point of view of the average consumer of those wares. Further, in determining whether the trade-mark is clearly descriptive or deceptively misdescriptive, the trade-mark must not be dissected into its component elements and carefully analysed, but rather must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks*, 40 C.P.R. (2d) 25, at pp. 27-28 and *Atlantic Promotions Inc. v. Registrar of Trade Marks*, 2 C.P.R. (3d) 183, at p. 186].

The opponent submits that the applied for mark is clearly descriptive of the character or quality of pharmaceutical preparations of a certain dosage amount. The individual tablets that appear as part of the applicant's design mark do indicate the dosage of that particular colour of tablet on the tablet. However, the test under s.12(1)(b) is whether the mark *as a whole* is clearly descriptive or deceptively misdescriptive of the applied for wares or services. In the present case, 1/4 of the applicant's mark is comprised of a sun design. Further, the statement of wares does not indicate that the pharmaceutical preparation must be sold in the form of three tablets of different colours. I therefore do not see how the mark applied for clearly describes a character or quality of the applied for wares or services and this ground is dismissed.

Section 13

The opponent has pleaded that the applicant's trade-mark is a distinguishing guise. Distinguishing guises are defined in s.2 of the Act as: a) a shaping of wares or their containers; or b) a mode of wrapping or packaging of the wares.

The opponent has argued throughout this proceeding that the applied for mark is a three dimensional mark as opposed to a two dimensional mark. I have already ruled that the wording used by the applicant in its description of the mark, along with the drawings illustrated in the application have convinced me that the monopoly being sought is for a two dimensional design mark. Even if I had found the applicant's mark to have been a three dimensional mark, it has

already been held that a trade-mark consisting only of one or more colours applied to the whole visible surface of a particular three dimensional object is considered as an ordinary trade-mark, not a distinguishing guise (see *Novopharm Limited v. Astra Aktiebolag*, Appln. No. 815,154; January 20, 2004; and *Novopharm Limited v. Eli Lilly and Company*, Appln. No. 783,742; November 9, 2004 (TMOB)). This ground is therefore unsuccessful.

Section 10

The opponent has pleaded that the mark claimed is a prohibited mark within the meaning of s.10 of the Act in that it is recognized in Canada:

- i) by patients, as designating a kind or type of medication including its therapeutic effect; and
- ii) by pharmacists and other health care professionals as designating the kind and quality of the wares, in particular the 10, 20 and 30 mg dosage strengths as is commonplace in the pharmaceutical industry and not as indicative of the source of the wares.

The opponent did not submit any direct evidence from patients. Further, as noted above there is no evidence with respect to the applicant's mark *as a whole* being recognized in Canada as designating the dosage strength of pharmaceuticals. At best, the opponent's evidence shows that there is a handful of third parties who use yellow, pink and light blue tablets to indicate dosage amounts of their pharmaceuticals, and that one physician recognizes that the applicant uses colour as an indication of dosage strength.

In my view, this evidence is insufficient to show that the applicant's TABLETS and Sun Design mark has become recognized in Canada by ordinary and *bona fide* commercial usage as designating the kind or quality of the applicant's wares and services within the scope of s.10 of the Act. Therefore, this ground of opposition also fails.

Disposition:

Accordingly, and with the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s.38(8) of the Act

DATED AT GATINEAU, QUEBEC, THIS 16th DAY OF December, 2005.

C. R. Folz
Member,
Trade-Marks Opposition Board