LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2010 TMOB 200
Date of Decision: 2010-11-25

IN THE MATTER OF AN OPPOSITION by Sanofi-Aventis to application No. 1,259,849 for the trade-mark PACIRIX in the name of GlaxoSmithKline Biologicals S.A.

[1] On June 2, 2005, GlaxoSmithKline Biologicals S.A. (the Applicant) filed an application to register the trade-mark PACIRIX (the Mark) based on proposed use of the Mark in Canada in association with vaccines for human use (the Wares).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of January 4, 2006 and on June 20, 2006 Sanofi-Aventis (the Opponent), a corporation based in France, filed a statement of opposition against the application. The Applicant filed and served a counter statement, in which it denies the Opponent's allegations.

[3] The Opponent's evidence consists of certified copies of its registrations and of the statutory declarations of Richard Grégoire and of Zeina Waked. Mr. Grégoire was cross-examined on his statutory declaration. The transcript of the cross-examination and the answers to undertakings form part of the record.

[4] The Applicant's evidence consists of the affidavits of Dr. Jean-Pierre Déry and Karen E. Thompson.

[5] Both parties requested and were represented at a hearing.

Statement of Opposition

[6] The grounds of opposition may be summarized as follows: the Applicant's application does not conform to the requirements of s. 30(a) and s. 30(e) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), the Mark is not registrable pursuant to s. 12(1)(d) of the Act, the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a) and s. 16(3)(b) of the Act, and the Mark is not distinctive.

[7] In its written argument the Opponent withdrew the grounds of opposition based on s. 30(a) and s. 30(e) of the Act. At the hearing, the Opponent confirmed the withdrawal of these grounds and further withdrew the ground based on s. 16(3)(b) of the Act with respect to its four previously filed applications under Nos. 1,237,798 / 1,237,797 / 1,145,515 / 1,030,507, which are currently abandoned.

[8] Accordingly my analysis will be based on the remaining grounds as reproduced hereafter:

> L'Opposante fonde également son opposition sur le motif énoncé à l'article 38(2)(b) à savoir que la marque de commerce PACIRIX n'est pas enregistrable, plus particulièrement qu'elle n'est pas enregistrable en vertu des dispositions de l'article 12(1)(d) en raison de la confusion qu'elle crée avec les marques de commerce suivantes de l'Opposante :
>
> - PLAVIX enregistrée sous le numéro TMA509,097 depuis le 10 mars 1999 en liaison avec des produits pharmaceutiques pour la prévention et le traitement des troubles cardiovasculaires.
>
> - PLAVIX & DESSIN (telle que ci-après illustrée) enregistrée au Canada sous le numéro TMA518,153 depuis le 19 octobre 1999 en liaison avec des produits pharmaceutiques pour la prévention et le traitement des troubles cardiovasculaires.
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> L'Opposante fonde également son opposition sur le motif énoncé à l'article 38(2)(c) à savoir que la Requérante n'est pas la personne ayant droit à l'enregistrement de la marque de commerce PACIRIX en vertu des dispositions de l'article 16(3)(a) parce qu'à la date où la Requérante a produit sa demande, soit le 2 juin 2005, la marque de commerce

PACIRIX créait de la confusion avec les marques de commerce suivantes préalablement employées ou révélées au Canada par l'Opposante :

- PLAVIX enregistrée sous le numéro TMA509,097 et employée au Canada depuis le 22 février 1999 en liaison avec des produits pharmaceutiques pour la prévention et le traitement des troubles cardiovasculaires.

- PLAVIX & DESSIN (telle que précédemment illustrée) enregistrée au Canada sous le numéro TMA518,153 et employé au Canada depuis le 21 septembre 1999 en liaison avec des produits pharmaceutiques pour la prévention et le traitement des troubles cardiovasculaires.

L'Opposante fonde également son opposition sur le motif énoncé à l'article 38(2)(d) à savoir que la marque de commerce PACIRIX de la Requérante n'est pas distinctive et plus particulièrement la marque de commerce PACIRIX n'est pas adaptée à véritablement distinguer les produits de la Requérante des produits de l'Opposante au sens de l'article 2 en raison de la confusion qu'elle crée avec les marques de l'Opposante.

[9] The material dates that apply to the grounds of opposition are as follows:

- s. 38(2)(b)/12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];

- s. 38(2)(c)/16(3)(a) - the date of filing of the application [see s. 16(3)];

- s. 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Ground of opposition based on s. 12(1)(d)

[10] The Opponent alleges that the Mark is not registrable pursuant to s. 12(1)(d) of the Act, as it is confusing with the registered word and design trade-marks PLAVIX (hereafter PLAVIX Marks), covering [translation] pharmaceutical products for the prevention and the treatment of cardiovascular disorders.

[11] I note that the Opponent's initial burden with respect to this ground has been satisfied as both registrations under Nos. TMA509,097 and TMA518,153 are in good standing as of today's date. Accordingly the legal onus is on the Applicant to establish that its Mark is registrable.

the test for confusion

[12] The test for confusion is one of first impression and imperfect recollection. In assessing whether there would be any reasonable likelihood of confusion between the trade-marks in question within the scope of s. 6(2) of the Act, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act. These enumerated factors need not be attributed equal weight [see, in general, *Mattel U.S.A. Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 S.C.C.)].

[13] The first factor under s. 6(5) of the Act is the strength of the marks which is broken down into two considerations; their inherent distinctiveness and their acquired distinctiveness.

[14] Regarding the inherent distinctiveness of the marks, I am of the view that both marks at issue are inherently distinctive particularly because they are invented words with no apparent link with any of the wares.

[15] Their acquired distinctiveness is measured by the extent to which the marks have become known. As the Applicant's application is based on proposed use and no evidence of use has been filed since the filing date of the application, I find that the Mark is not known in Canada.

[16] In contrast, Richard Grégoire's evidence, as it pertains to the Opponent's business activities in Canada, may be summarized as follows. Mr. Grégoire identifies himself as the Marketing Director of Sanofi-Aventis Canada Inc., a Canadian distributor of the Opponent's products in Canada. On this point, I observe that it has been found that any trade-mark use by a Canadian distributor is deemed to be use by the foreign owner of the trade-mark [see *Lin Trading Co. v. CBM Kabushiki Kaisha* (1988), 21 C.P.R. (3d) 417 (F.C.A.)].

[17] Use of the PLAVIX Marks in Canada began with the launch of the Opponent's product on February 22, 1999. Mr. Grégoire provides sales figures for the year 2001 representing over 63 million Canadian dollars. These sales have steadily increased amounting to over 223 million dollars in 2005 with a slight decline in 2006 when sales amounted to approximately 211 million dollars. Advertising and promotion expenditures from 2001 to 2006 were in excess of 70 million dollars. Exhibits RG-1 to RG-7 appended to the Grégoire statutory declaration are samples of

packaging, product monogram's, patient information leaflets and advertisements which feature the PLAVIX Marks.

[18] In view on the foregoing, I find that the PLAVIX Marks have become known to a substantial extent in Canada and accordingly are deserving of a wider ambit of protection.

[19] The following factor to be considered pursuant to s. 6(5)(b) of the Act, is the length of time that each mark has been in use. For the reasons discussed above, this factor clearly favours the Opponent.

[20] Sections 6(5)(c) and (d) of the Act deal with the nature of the wares and services and the nature of the businesses. When considering the type of wares and the nature of the trade, I must compare the Applicant's statement of wares with the statement of wares in the registrations referred to by the Opponent [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)].

[21] The Mark covers vaccines for human use while the PLAVIX Marks cover pharmaceutical products for the prevention and the treatment of cardiovascular disorders.

[22] The Applicant attempts to distinguish the nature of these wares, through the testimony of Dr. Jean-Pierre Déry.

[23] Dr. Déry has been an interventional cardiologist at Laval Hospital since 2004. He is also an Associate Professor of Medicine at Laval University and author of several publications.

[24] Dr. Déry provides general information on the circulatory system and the immune system. This information is a preamble to understanding the function between the Applicant's vaccines and the Opponents pharmaceuticals. Vaccines, he explains, are designed to eliminate communicable diseases, whereas the Opponent's pharmaceuticals are described as anti-platelet aggregation medication which is indicated for the reduction of atherothrombotic events such as the occurrence of a recent myocardial infarct (heat attack), a recent stroke, the presence of established peripheral arterial disease or acute coronary syndrome. Dr. Déry explains that while

vaccines act within the immune system, anti-platelet aggregation medication acts within the circulatory system and the pharmaceutical responses developed for treating problems arising in each system are radically different.

[25] Dr. Déry further explains that vaccines are typically dispensed through sterile injection, although he does point out that there are a few vaccines available in Canada in tablet form. He notes that the Opponent's anti-platelet aggregation medication is available for oral administration only.

[26] Dr. Déry also explains that the parties' respective products are to be prescribed by physicians and dispensed by pharmacists.

[27] The Applicant argues that the parties' respective wares are different in that they are aimed at preventing or treating different medical problems and further, their pharmaceutical responses are radically different. The Applicant further argues that since the parties' products are prescribed by doctors and dispensed by pharmacists, these professionals are not likely to be confused as great skill and care is exercised in prescribing and dispensing drug products such that confusion is unlikely. As the patient will have the benefit of advice given freely by the pharmacist, the risk of confusion is lessened. The Applicant further argues that as vaccines are typically administered by physicians by way of injection, and the Opponent's pharmaceuticals are in tablet form self administered by the patient, the risk of confusion at the patient level is even more unlikely.

[28] On the other hand, the Opponent submits that neither party's statement of wares is restricted as to the means of administration of the pharmaceuticals. The Opponent contends that vaccines are not solely injectable, some are available in tablet form [paragraph 53 of Dr. Déry's affidavit] and further argues that although the Opponent's products are currently available in tablet form, nothing would prevent it from developing its products in an injectable form.

[29] The Opponent points out that the Applicant has not restricted the field of its vaccines, entitling the Applicant to develop vaccines for the prevention of a wide range of ailments.

[30] The Opponent further argues that not only are the parties' wares related, their respective businesses are as well since both are in the pharmaceutical industry. This implies that their

channels of trade would be similar if not identical namely, clinics, hospitals and pharmacies, thus increasing the likelihood of confusion.

[31] In *Ciba Geigy Canada Ltd. v. Apotex, Inc.* (1992), 44 C.PR. (3d) 289 the Supreme Court of Canada established that in cases of prescribed medication, the average consumer with respect to the test for confusion consists of the physicians prescribing the medication, the pharmacists dispensing the medication and the patient.

[32] While I acknowledge the fact that there is some authority for the Applicant's contention that the risk of confusion is lessened in the field of prescription medications since the nature of the transaction is such that the products are delivered by meticulous professionals accustomed to making fine distinctions between the names of various products, the same cannot be said with respect to the final consumer of the products namely, the patient. There is no evidence that the average patient would be similarly vigilant when dealing with pharmaceutical products.

[33] In assessing confusion, I must compare the Applicant's statement of wares with the statement of wares in the registrations referred to by the Opponent. In the present case, while the products are not identical, I consider the parties' wares to be related because they are both pharmaceutical products for human use. I agree with the Opponent in that the Applicant's vaccines are not restricted as to the diseases they aim to prevent or eliminate. Accordingly, nothing would prevent the Applicant from developing vaccines overlapping in the field related to the Opponent's particular pharmaceutical products. The wares described in both of the Applicant's application and the Opponent's registrations are neither restricted to prescription drugs only, nor restricted in their physical form, dosage and mode of administration.

[34] In the absence of evidence to the contrary I presume that their channels of trade would be similar, namely medical clinics, hospitals and pharmacies.

[35] In view of the above, these third and fourth factors also favour the Opponent.

[36] The factors under s. 6(5)(e) of the Act pertain to the degree of resemblance between the trade-marks in appearance, sound and in the ideas suggested by them. Where the trade-marks are similar, the Registrar must assess the impression created by the marks in the mind of the purchaser of these wares. While marks must be assessed in their entirety (and not dissected for

minute comparison) it is still possible to focus on particular features of the marks that may have a determinative influence on the public's perception [see *United Artists Corp. v. Pink Panther Beauty Corp.* (1998), 80 C.P.R. (3d) 247 (F.C.A.)].

[37] In this respect, I am of the view that there is a fair degree of resemblance between the Mark and the Opponent's marks, visually and in sound owing to the letters P and A which appear in the first syllable of the marks and to the combined letters IX which comprise the end portion of the marks. While I acknowledge that people have a tendency to slur the ending of a word, I believe in this case the suffix IX would not be slurred but rather would have an impact on the mark as a whole.

[38] As the marks at issue are coined words which do not suggest any ideas in particular, there is no resemblance in the ideas suggested by them.

further surrounding circumstances

State of the Register

[39] As a surrounding circumstance, the Applicant submits that it is the owner 84 marks including RIX as their suffix, covering vaccines for human use [see Thompson affidavit]. I note however that 22 of these marks have since been abandoned.

[40] It is the Applicant's contention that since it is the owner of such a very large number of trade-marks, the average consumer of imperfect recollection would, upon first impression, associate the Applicant's Mark with the Applicant and not the Opponent.

[41] To counter this argument, the Opponent points out that most of these marks are pending applications and that only five are registered. The Applicant however brought to my attention that seventeen of these marks are currently registered and not 5 as suggested by the Opponent.

[42] In any event, I agree with the Opponent's contention that the Applicant has not supported such registrations with evidence of use and accordingly I do not consider the doctrine of a series or family of marks of much assistance to the Applicant in this case as it has not established that it possesses a family of trade-marks.

The issue of drug error

[43] As a further surrounding circumstance, the Opponent argues that particular care must be taken in preventing medication error which could culminate in grave consequences. The Opponent submits that jurisprudence guides use as to the importance of avoiding this type of confusion in the sale of pharmaceuticals even in instances where such pharmaceuticals are exclusively sold by way of prescription citing in support of its contention the following passage in *Mead Johnson & Co. v. G.D. Searle & Co.* (1967), 53 C.P.R. 1 : "Confusion in such products can have serious consequences for the patient. Confusion in medicines must be avoided. (…) Prevention of confusion and mistakes in medicines is too vital to be trifled with".

[44] Although the possibility of errors in prescribing, dispensing or administering drugs is not directly related to the likelihood of confusion as to the source of the product, which is the issue for decision in this case, I find the Opponent at the hearing raised an interesting observation when stating that mistake and confusion are not mutually exclusive. I agree, since one of the factors the Registrar must consider when assessing confusion is the degree of resemblance between the marks in appearance and sound. A consumer mistaken about the identity of the marks in relation to the wares may have already inferred that they are manufactured by the other person. In other words, mistaking one trade-mark for another necessarily implies that there is a high degree of resemblance between the marks, which is one of the factors to be considered in the test for confusion pursuant to s. 6(5)(e) of the Act.

Conclusion re likelihood of confusion

[45] The legal onus is on the Applicant to show that there is no reasonable likelihood of confusion between the trade-marks at issue. In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. I have also had regard to all of the surrounding circumstances, including those enunciated under s. 6(5) of the Act. In view of my conclusions above, I find that the Applicant has failed to discharge the legal onus upon it to show that, on the balance of probabilities, there is no reasonable likelihood of confusion as to the source of the parties' wares. I reach this conclusion particularly in light of the inherent

distinctiveness and the acquired reputation associated with the Opponent's marks, the similarities in the wares and their channels of trade and the resemblance between the marks.

[46] I have also considered that if there is doubt whether the registration of a trade mark would cause confusion with a prior mark, the doubt must be resolved against the newcomer [*Conde Nast Publications Inc. v. Union des éditions modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)].

[47] Accordingly the ground of opposition based on s. 12(1)(d) of the Act is successful.

Remaining grounds of opposition

[48] The remaining grounds of opposition also turn on a determination of the issue of the likelihood of confusion between the Mark and the Opponent's PLAVIX Marks. The material dates for assessing the likelihood of confusion in respect of the non-entitlement and non-distinctiveness grounds are, respectively, the Applicant's filing date and the date of opposition. In my view, the differences in material dates do not have any significant impact on the determination of the issue of confusion between the marks of the parties. Thus, my finding above that the Mark is likely to be confused with the Opponent's marks also apply to these grounds of opposition which also succeed.

Disposition

[49] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

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Lynne Pelletier
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office