

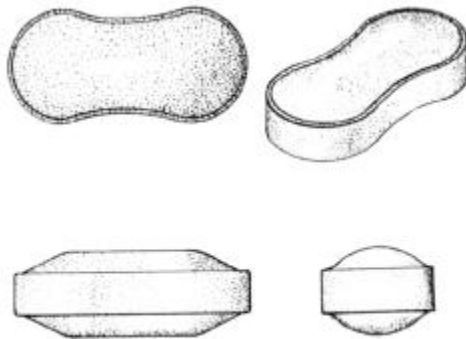
**IN THE MATTER OF AN OPPOSITION  
by Canadian Generic Pharmaceutical Association  
(formerly known as Canadian Drug Manufacturers  
Association) to application no. 841986 for the  
trade-mark PLAQUENIL PILL DESIGN filed by  
Sanofi-Synthelabo Inc.**

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On April 10, 1997 Sanofi-Synthelabo Inc. filed an application to register a distinguishing guise trade-mark referred to as PLAQUENIL PILL DESIGN, based on use in Canada since December 1991 in association with

pharmaceutical preparations, namely preparations for treatment of malaria, rheumatoid arthritis, systemic lupus erythematosus and similar conditions.

The subject application shows and describes the distinguishing guise trade-mark as follows:



The pill is generally hourglass shaped having two major sides and when viewed from one of the major sides has two convex substantially semi-circular end portions with a central portion defined by two concave curves. The pill has a generally centrally located surface between the major sides of substantially uniform height extending around the periphery of the pill in the form of a band. The two major sides have sloped, curved surfaces merging into the band. The four drawings of the distinguishing guise are merely four perspectives of the same distinguishing guise.

The Examination Branch of the Trade-marks Office advised the applicant that, in accordance with Section 32 of the *Trade-marks Act*, the applicant was required to submit evidence establishing that the mark had become distinctive of the applicant's wares at the date of filing (April 10, 1997) the application. The applicant submitted the required evidence by way of the affidavit of Vince Rizzi, which satisfied the Office that the mark was distinctive of the applicant's wares at the date of filing. Accordingly, the subject mark was advertised for opposition purposes in the *Trade-marks Journal* issue dated May 1, 2002.

The subject application was opposed by Canadian Drug Manufacturers Association (now known as Canadian Generic Pharmaceutical Association) on October 2, 2002. The Registrar forwarded a copy of the statement of opposition to the applicant on October 22, 2002. The applicant responded by filing and serving a counter statement. During the course of this proceeding the opponent was twice granted leave to amend its statement of opposition. This proceeding is based on the last amended statement of opposition dated July 8, 2003.

#### STATEMENT OF OPPOSITION

The grounds of opposition may be summarized as shown below. The numbering sequence for the grounds of opposition, below, conforms to the numbering sequence employed by the opponent.

2. The application is not in compliance with Section 30 of the *Trade-marks Act* because:

(a) The applied for mark is not a distinguishing guise. In this regard, the shape is a common tablet shape which cannot distinguish one party's wares. Further, the shape is merely ornamental or is functional as indicative of the active ingredient or dose, or to permit easy swallowing.

(b)(i) The mark has not been used since December 1991 as claimed by the applicant. In this regard, the applicant's pills are distributed in opaque bottles so that the pills are not visible. Accordingly, in the normal course of trade no notice is taken of the shape of the pill. Thus, there has been no use of the mark in the manner set out in Section 4 of the *Trade-marks Act*.

(b)(ii) The public does not consider the shape of the pill as separate and apart from the overall appearance of the pill. The overall appearance of the pill includes the word PLAQUENIL, other markings on the pill and the colour white.

(c) The application does not include an accurate drawing of the alleged trade-mark which includes the colour white and other markings including the word PLAQUENIL.

(d)(i) The applicant could not have been satisfied that it was entitled to use the alleged shape as a trade-mark in view of prior use by others of similarly shaped pills.

(d)(ii) The applicant could not have been satisfied that it was entitled to use the alleged shape as a trade-mark because the monopolization of the shape would restrain others in the pharmaceutical industry from selling similarly shaped pills.

3. The applied for mark is not registrable pursuant to Section 12 of the *Act* because:

(a) (i) It is not a distinguishing guise within the meaning of Section 2 of the *Act*.

(a)(ii) The mark is clearly descriptive or deceptively misdescriptive of the active ingredient, dose or therapeutic effect.

(b) The applied for mark is not registrable, pursuant to Section 13 of the *Act* because:

(b)(i) The alleged shape has not been used so as to have become distinctive of the applicant's wares at the date of filing. The evidence filed by the applicant during the examination of the application does not establish distinctiveness. Further, the shaping of the pill is not capable of distinguishing the applicant's wares for the reasons stated above, and also because the shape of the pill was at all material times common in the pharmaceutical trade (listed in Schedule A).

(b)(ii) The exclusive use of the shape by the applicant is likely to unreasonably limit the development of the pharmaceutical industry.

(c) The applied for mark is not distinctive of the applicant's wares, pursuant to Sections 38(2)(d) and 2 of the *Act* because:

(c)(i) Pills generally similar in shape were at all material times common to the pharmaceutical industry as evidenced by the Compendium of Pharmaceuticals and Specialties ("CPS") and the Compendium of Nonprescription Products ("CNP").

The last ground of opposition, denoted 3(c)(ii), is reproduced below:

Each and every pill of hydroxychloroquine sulfate sold by the Applicant in Canada is marked with "PLAQUENIL" and is white in colour. To the extent consumers identify the Applicant's pills based on appearance, they rely on the markings and/or colour to identify the Applicant's pills. Consumers do not identify the Applicant's pills on the basis of the shape alone. As such, the guise as applied for does not and cannot distinguish the wares of the Applicant.

The counter statement submitted by the applicant generally denies each ground of opposition and, in particular, states that "The evidence filed by the applicant establishes that the applicant's distinguishing guise was distinctive as of the date of filing."

#### EVIDENCE

The opponent's evidence consists of the affidavits of Dr. Neil Marshall; Julie Tam; Sean Bugden; Dr. Philip Baer; Paula Rembach; Donna Zwarych; and Jennifer dela Cruz. The above individuals, excepting Jennifer dela Cruz, were cross-examined on their affidavit testimony. The transcripts of their cross-examinations, and exhibits thereto, form part of the evidence of record. The applicant did not file any evidence in this proceeding. Both parties filed a written argument, however, only the opponent was represented at an oral hearing.

#### ESTABLISHING THE DISTINCTIVENESS OF A DISTINGUISHING GUISE

In Section 2 of the *Trade-marks Act* a distinguishing guise is identified as a type of trade-mark and is defined as follows:

- (a) a shaping of wares or their containers, or
- (b) a mode of wrapping or packaging wares

the appearance of which is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others;

In the instant case, the applicant claims that the shaping of its pill is a distinguishing guise. There is no reason in principle why the applicant cannot do so: see *Novopharm Limited and Apotex Inc. v. Hoffman-La Roche Limited/Hoffman-La Roche Limitée* concerning application no. 1006334 for the trade-mark XENICAL Capsule Design, decided May 5, 2006, TMOB, yet unreported.

Section 13(1)(a) of the *Act* requires a distinguishing guise to be distinctive of the applicant's wares or services at the date of filing the application. Section 32(1) requires the applicant to file evidence with the Registrar, during the period when the mark is being administratively processed (that is, the examination stage), to substantiate that the distinguishing guise is in fact distinctive at the date of filing:

13(1) A distinguishing guise is registrable only if

- (a) it has been so used in Canada by the applicant or his predecessor in title as to have become distinctive at the date of filing an application for its registration;

32(1) An applicant who claims that his trade-mark is registrable under subsection 12(2) or section 13 shall furnish the Registrar with evidence by way of affidavit or statutory declaration establishing the extent to which and the time during which the trade-mark has been used in Canada and with any other evidence that the Registrar may

require in support of the claim.

(underlining added)

Section 37 requires the Registrar to consider the evidence adduced by the applicant and to refuse the application if the Registrar is satisfied that the mark is not registrable; otherwise, the trade-mark application progresses to the next administrative stage:

37(1) The Registrar shall refuse an application for the registration of a trade-mark if he is satisfied that

- (a) the application does not conform to the requirements of section 30,
- (b) the trade-mark is not registrable, or
- (c) the applicant is not the person entitled to registration of the trade-mark because it is confusing with another trade-mark for the registration of which an application is pending, and where the Registrar is not so satisfied, he shall cause the application to be advertised in the manner prescribed.

Notice to applicant

(2) The Registrar shall not refuse any application without first notifying the applicant of his objections thereto and his reasons for those objections, and giving the applicant adequate opportunity to answer those objections.

Doubtful cases

(3) Where the Registrar, by reason of a registered trade-mark, is in doubt whether the trade-mark claimed in the application is registrable, he shall, by registered letter, notify the owner of the registered trade-mark of the advertisement of the application.

(underling added)

It is apparent from Section 37, above, that the onus is on the Registrar to satisfy himself that a mark is not registrable, that is, the onus is not on the applicant to establish that the distinguishing guise is registrable. There is no onus on the applicant. It follows from this that in opposition proceedings the applicant cannot claim any presumption of registrability simply because the mark in issue passed the Registrar's consideration under Section 37. Thus, in opposition proceedings the distinctiveness of a distinguishing guise is an open question. Moreover, in opposition proceedings, once distinctiveness has been put into issue then the usual civil legal onus is on the applicant, that is, to establish on a balance of probabilities that its distinguishing guise trade-mark is distinctive: see *Molson Breweries v. Canada (Register of Trade-marks)* (1992), 41 C.P.R. (3d) 234 at 241-243 where Mr. Justice Strayer dealt with similar issues in respect of evidence furnished to the Registrar pursuant to Section 12(2).

In the instant case, the applicant provided the affidavit of Vince Rizzi to the Registrar, during the examination stage, to establish the extent to which the distinguishing guise had been used in Canada. Generally, in opposition proceedings it is not necessary for the applicant to re-file evidence that had been put before the Registrar pursuant to Section 32(1), however, it is necessary for applicant to advise the Board, and the other party, of the applicant's reliance on such evidence, to provide the opponent with a copy of the evidence and to ensure that the individual who provided the evidence is available for cross-examination. In the instant opposition proceeding the applicant has not indicated, other than by oblique reference in its counter statement, that it would be relying

on Mr. Rizzi's evidence. Accordingly, in this opposition proceeding there is no evidence whatsoever to support the applicant's claim that the distinguishing guise in issue was distinctive of the applicant's wares at the material date April 10, 1997. Of course, it would be unfair to the opponent if the Board were to take Mr. Rizzi's evidence into account when Mr. Rizzi is unavailable for cross-examination.

#### DECISION

In view of the foregoing, the opponent succeeds on the ground of opposition denoted by 3(b)(i) above. The subject application is therefore refused.

The opponent would also likely have succeeded on the grounds of opposition denoted by 3(c)(i) and (ii). In this regard, the opponent's evidence provided by physicians and pharmacists is sufficient to meet the evidential burden on the opponent to support the above mentioned grounds of opposition, while the applicant has not submitted any evidence to show that its distinguishing guise was distinctive at any material time.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 14th DAY OF DECEMBER, 2006 .

Myer Herzig,  
Member,  
Trade-marks Opposition Board