IN THE MATTER OF AN OPPOSITION by
Novopharm Ltd. to application No. 657,397 for
the mark CIRCLE DESIGN filed by Bayer Inc.

On June 8, 1990, Bayer Inc. (then Miles Canada Inc.) filed an application to register the mark CIRCLE DESIGN, based on use of the mark in Canada since as early as May 1987, for the wares

pharmaceutical preparations namely, nifedipine.

The applied for mark CIRCLE DESIGN is described in the following terms in an amended application dated March 14, 1991:

> The trade-mark consists of the colour dusty rose applied to the whole of the visible surface of the tablet, as shown in the specimen tablet affixed to the form of the application. The tablet shown in the dotted outline does not form part of the trade-mark.

The specimen tablet referred to in the description of the mark is an actual, three dimensional sample of the applicant's product filed pursuant to Rule 29 [former Rule 33] of the Trade-marks Regulations. The drawing of the mark included with the original application filed on June 8, 1990 is shown below:

The drawing of the mark in the amended application, illustrated below, shows a dotted border indicating that the border is not part of the mark.

However, the lining representing colour has mistakenly been rotated by ninety degrees. Horizontal lining indicates the colour blue while vertical lining indicates the colour pink or red: see Section 28(2) of the Trade-marks Regulations.

The mark as advertised in the *Trade-marks Journal* (see page 1 of the opponent's written argument) is shown below:

The border is solid rather than dotted, and the lining is for the colour blue rather than for the colour pink. Further, no mention is made of the specimen referred to in the trade-mark application. In any event, at the oral hearing, it appeared that both parties understood that the applied for mark was for the colour pink applied to the surface of a tablet and that a specimen of the tablet had been filed with the Office. Therefore, in my view, the opponent has not been prejudiced by the erroneous depiction of the applied for mark appearing in the amended application or in the *Journal*. It is of course surprising that the *Journal* advertisement does not mention the specimen filed with the Office since, as will become apparent later, the specimen plays a crucial role in defining the applied for mark.

The product covered by the subject application namely, nifedipine, is a prescription medicine used to treat high blood pressure and angina. Nifedipine is typically

taken over a period of months or years rather than over a period of days as, for example, in the case of antibiotics. The applicant has been selling its nifedipine product under the brand name ADALAT in capsule form since February 1982 and in tablet form since May 1987. There are four dosages of ADALAT tablets namely 10, 20, 30, and 60 mg. Each dosage is produced in a different size tablet; the larger the dosage, the larger the tablet. All tablets are the same pink colour and have the same round, biconvex shape. The specimen tablet filed in conjunction with the subject application is the 10 mg tablet.

The subject application was advertised for opposition purposes in the *Trade-marks Journal* dated September 4, 1991. Novopharm Ltd. filed a statement of opposition on January 6, 1992, a copy of which was forwarded to the applicant on March 5, 1992. The applicant responded by filing and serving a counter statement. Both parties filed a written argument and both were represented at an oral hearing.

The first three grounds of opposition are shown below:

The fourth ground alleges that the applicant is not entitled to register the applied for mark because at the date that it was first used it was confusing with “trade-marks

namely, rose coloured tablets" previously used in Canada by the opponent. The fifth ground alleges that the applied for mark is not distinctive because rose coloured tablets were and are at all material times common to the trade [presumably the pharmaceutical trade].

The opponent's evidence consists of the affidavits of Leslie L. Dan, President of the opponent company; Dr. Paul Pitt and Dr. Allen Rein; and Joseph H. Newton and Harvey Bernard Organ, pharmacists. The applicant's evidence consists of the affidavits of Peter Alexander, Group Product Manager - Cardiovascular, of the applicant company; and Seymour Haber, pharmacist. The opponent filed the affidavit of Dr. William Allan Mahon as evidence in reply. Each affiant was cross-examined and the transcripts of cross-examination, together with exhibits and replies to undertakings, form part of the evidence herein. The applicant objected that Dr. Mahon's evidence was not proper evidence in reply. I agree that Dr. Mahon's evidence should have been filed as part of the opponent's evidence in chief, and I have therefore disregarded his testimony. In any event, nothing turns on whether Dr. Mahon's testimony is considered as part of the evidence of record. Exhibit 1 to the cross-examination of Dr. Rein is a transcript of his prior testimony on cross-examination in several related opposition cases. However, the applicant did not lay a proper foundation for introducing the prior transcript into evidence and I therefore do not consider it to be part of the record. The applicant did not file undertakings provided by the opponent's affiant namely, Mr. Dan: see the board ruling dated September 30, 1994. In such circumstances, it is up to the opponent to request leave to file the undertakings as additional evidence pursuant to Rule 44 if the opponent believes it is in its interests to do so. Finally, I do not agree with the applicant's characterization of Dr. Rein as an unreliable witness.

The first three grounds of opposition, as pleaded, are somewhat unclear. However,

the applicant did not object that it was unable to reply to grounds 1-3 or that the pleadings were contrary to Section 38(3)(a) of the Trade-marks Act for not setting out sufficient details. With the benefit of the opponent's written argument and submissions at the oral hearing, I understand that the opponent is alleging that (i) colour applied to the whole surface of a tablet cannot function as a mark, (ii) the applicant's tablets as actually used had additional markings on them such as the numbers 10, 20, 30, 60 and/or the word MILES, and (iii) the drawing included in the application does not accurately illustrate the applied for mark. Further, at the oral hearing, the opponent submitted that the filing of a specimen tablet is not a practice which is mandated by the Act or the Regulations and that specimen tablets filed with the Office can deteriorate over time.

The adequacy of the description required to define a mark for a tablet has been discussed in *Novopharm Ltd. v. Burroughs Wellcome Inc.* (1993), 52 C.P.R.(3d) 263 (TMOB), affirmed *Burroughs Wellcome Inc. v. Novopharm Ltd.* (1994) 58 C.P.R.(3d) 513 (F.C.T.D.). My interpretation of the above cases is that a trade-mark application which incorporates a drawing accurately depicting at least one perspective of a tablet meets the formal and substantive requirements of Section 30 so long as (i) a specimen of the tablet has been filed with the Office, and (ii) the written description of the mark in the trade-mark application refers to the specimen tablet filed with the Office. As the drawing included in the instant application accurately depicts a top view of the tablet, and as the two other criteria have been met, I reject the third ground of opposition.

The first ground of opposition is answered by *Smith Kline & French Canada Ltd. v. Canada* [1987] 2 F.C. 633 at 636 (F.C.T.D.):

> . . . the trade mark whose registration is sought is a *particular colour* of green applied to a *particular size and shape* of tablet. I would not preclude registration simply on the basis that the colour is applied to the whole of the exterior of the tablet and not to some part of it alone.
>
> (emphasis added)

In the instant case, the registration sought is for a particular colour of pink applied to a particular size and shape of tablet. I therefore reject the first ground of opposition. Further, nothing turns on the appearance of other markings on the tablets as the markings are not visible without a close inspection of the tablet: a similar finding was made in *Novopharm Ltd. v. Burroughs Wellcome Inc.*, above, at p. 269, paragraph g. The second ground of opposition is therefore rejected.

An issue which might have been raised under the second ground of opposition, but which was not raised by the opponent, concerns Mr. Alexander's evidence that the applicant began to sell ADALAT in 20 mg tablet form in May 1987 but did not begin to sell ADALAT in the 10 mg dosage until 1989. As mentioned earlier, the applied for mark is in respect of the 10 mg size tablet and not the 20 mg size. Thus, it may be that the subject application, which claims May 1987 as the date of first use for the applied for mark, contravenes Section 30(b). However, the 20 mg dosage tablet is about the same size as the 10 mg dosage tablet, while the 30 mg and 60 mg dosage tablets are appreciably larger. Of course, the subject trade-mark application is for a tablet of a particular size but not for a particular dosage. In my view, the 10 mg dosage tablet is not substantially different in size from the 20 mg dosage tablet and the variation between the two tablets, in respect of size, is very minor. Further, it would appear that the public would not be deceived or injured if the applicant is permitted to rely on the trade-mark as used, that is, in its slightly larger size, to support the registration of the smaller sized tablet: see *Nightingale Interloc v. Prodesign Ltd.* (1984), 2 C.P.R.(3d) 535 at 538 (TMOB), under the heading *Principle 2*. In this respect, Mr. Alexander's evidence is that the 10 mg and 20 mg tablets have been sold concurrently since 1989. Sales of ADALAT under the applied for mark were $1.2 million in 1989 rising steadily to $26 million in 1992 while sales of ADALAT in the 20 mg dosage tablet for the same period began at $39.7 million

and increased to $78.1 million. There is no evidence to suggest that the pubic has been deceived or injured because of the slight difference in the size of the tablets. This result is not surprising considering the care with which prescription medicine is dispensed to the public. Thus, had the opponent raised the issue, I would have found that the applicant is permitted to rely on the use of its slightly larger 20 mg dosage tablet to support the subject trade-mark application.

There is one further matter respecting the grounds of opposition raised pursuant to Section 30. Since Section 30 deals with the formal and substantive requirements of a trade-mark application, this board has consistently taken the position that the material time for considering the issue of compliance with Section 30 is the date that the application was filed. However, in *Burroughs Wellcome*, above, the Court (at p. 519) relied on *Andres Wines Ltd v. E. J. Gallo Winery* (1975) 25 C.P.R.(2d) 126 at 130 (F.C.A.) for authority that the material date in respect of compliance with Section 30(h) was the date of filing of the statement of opposition. In *Gallo*, above, the Court was concerned with the material time for considering the issue of distinctiveness arising pursuant to Section 38(2)(d) [then 37(2)(d)] rather than with the issue of compliance with Section 30 [then Section 29]. In any event, in the instant case nothing turns on whether the material date in respect of Section 30 is the date of filing the opposition or the date of filing the application.

The fourth ground of opposition alleges that the applicant is not entitled to register the applied for mark because, at the date of first use [see Section 16(1)] of the mark, it was confusing with "trademarks namely, rose coloured tablets that had previously been used in Canada by the Opponent." In accordance with the usual rules of evidence, there is an evidential burden on the opponent to establish the facts inherent in its allegation. The presence of an evidential burden on the opponent with respect to a particular issue means

that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. As noted by the applicant, it is of course inconsistent for the opponent to allege on the one hand that colour applied to a tablet cannot function as a trade-mark and on the other hand to assert use and ownership of such marks. In any event, leaving aside the issue of inconsistent pleadings, I agree with the applicant that the opponent has not met the evidential burden to put the fourth ground in issue.

With respect to the fifth ground of opposition, I agree with the applicant that *Ciba-Geigy Canada Ltd. v. Apotex Inc*. (1992), 44 C.P.R.(3d) 289 (S.C.C.) is authority for the proposition that the appearance of a pharmaceutical product may indicate the product's commercial origin and therefore distinguish the product from those of others. The onus, as always, is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its product from those of others throughout Canada: see *Muffin Houses Inc. v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R.(3d) 272 (TMOB). The presence of an onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant. The material time for considering the circumstances respecting the issue of distinctiveness is as of the filing of the opposition, in this case January 6, 1992: see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.).

In *Novopharm Ltd. v. Burroughs Wellcome Inc.*, above, the board was concerned with the colour blue applied to a tablet having a hexagonal shape. Otherwise, many of the facts in that case, as discussed at pp. 271-272, are analogous to the instant case:

In the instant case, I infer from the opponent's evidence that, at the material date, several dozen pink coloured tablets of varying shapes, for various medicines, were available in the marketplace. However, there is no evidence that any of those products have any reputation in Canada. On the other hand, the applicant's pink tablet was familiar enough to pharmacists that they would ensure "as a secondary check as a matter of routine" that ADALAT dispensed by them conformed to the colour, shape and size of the applied for mark: see, for example, pp. 24-28 of Mr. Dan's transcript of cross-examination. The evidence also indicates that there is no other product that the pharmacist can substitute for ADALAT. Further, in the instant case, the manufacturer's name appears on packaging containing ADALAT tablets and it is therefore not unlikely that the ordinary consumer would make a connection between the applied for mark and the applicant. In view of the above, I find that, on the balance of probabilities, the applicant has supported its position

that the applied for mark is distinctive of the applicant's nifedipine product.

In view of the above, the opponent's opposition is rejected.

DATED AT HULL, QUEBEC, THIS 23rd DAY OF DECEMBER, 1996.

Myer Herzig,
Member,
Trade-marks Opposition Board