

**IN THE MATTER OF AN OPPOSITION
by Immuno AG to application No. 616,570
for the trade-mark IMMUNOCORP filed by
Medicorp Sciences Inc./Sciences Medicorp Inc.
(formerly Immunocorp Inc.)**

On October 5, 1988, Immunocorp Inc. filed an application to register the mark IMMUNOCORP for various diagnostic reagents and for diagnostic services based on use of the mark in Canada since at least as early as May 13, 1988. The application was advertised for opposition purposes on March 22, 1989 and was opposed by Immuno AG on April 24, 1989. A copy of the statement of opposition was forwarded to the applicant on May 10, 1989.

The first ground of opposition is that the application does not comply with Section 30 of the Trade-marks Act because (i) the applicant never used the applied for mark in Canada or, alternatively, (ii) the applicant has abandoned the trade-mark, (iii) the applicant could not have been satisfied that it was entitled to use the applied for mark. The second ground is that the applied for mark IMMUNOCORP is not registrable pursuant to Section 12(1)(d) because it is confusing with the opponent's word mark IMMUNO registered under No. 136,995 for "medicinal and pharmaceutical preparations namely, haemo-derivatives, biologicals" (it may be appropriate at this point to interject that the opponent's products are derived from blood and live tissue, respectively, and are used for therapeutic purposes). The third ground is that the applicant is not entitled to registration pursuant to Section 16 because at the alleged date of first use of the mark IMMUNOCORP (i.e.- May 13, 1988), it was confusing with the opponent's mark IMMUNO and with the opponent's trade-name IMMUNO AG previously used by the opponent in Canada. Lastly, the opponent alleges that the applied for mark IMMUNOCORP is not distinctive of the applicant's wares and services in view of the opponent's use of its mark IMMUNO and trade-name IMMUNO AG since 1964. The applicant responded by filing and serving a counter statement.

I mention in passing that the opponent uses its mark IMMUNO in a design logo, as illustrated below:

I consider that use of the above logo qualifies as use of the mark IMMUNO *per se*: see Nightengale Interloc v. Prodesign Ltd. (1984), 2 C.P.R.(3d) 535 at 538 under the heading *Principle 1*. I would also mention that on March 26, 1990 the opponent Immuno AG filed trade-mark application No. 654,113 for the above logo covering (i) "haemo-derivatives, biologicals and vaccines" based on use in Canada since 1964, and covering (ii) "diagnostics for medical use" based on proposed use in Canada. The applicant herein has opposed that application, and I will later be referring to the pleadings in that proceeding.

During the course of these proceedings, the applicant changed its name to Medicorp Sciences Inc./Sciences Medicorp Inc. Further, the application was amended to specify the wares and services as follows:

diagnostic reagents, namely, immunodiagnostic reagents, clinical chemistry reagents, biotechnology and bio-chemistry reagents to perform assays in hospital and clinical laboratories on body fluids and all types of human tissue taken by biopsy, directed to the in vitro diagnostics industry only,

diagnostic services for the in vitro diagnostics industry only.

Minor amendments to the statement of opposition were subsequently effected.

The opponent's evidence in chief consists, in part, of the affidavit of Dr. Carlos Carl Ehrich, Medical Liaison Officer of the opponent and President of the opponent's wholly owned subsidiary and exclusive distributor in Canada namely, Immuno (Canada) Ltd.. The opponent also filed as evidence the affidavit of Dr. Franz Rozsenich (Doctor of Law), Head of the Administrative Department of the opponent company.

The applicant filed as its evidence the affidavits of Omer Bouchard, purchasing coordinator at Hôtel-Dieu Hospital in Montreal, Quebec; of Linda Thibeault, trade-mark searcher; and of Sheila Boss, Chief Biochemist of the Jewish General Hospital in Montreal, and formerly an employee of Bio-Mega Inc. The opponent filed as its evidence in reply the affidavit of Pascale Goyer, employee with the firm representing the opponent, and the affidavit

of Dr. G. Y. Sebastyan (Ph.D. in engineering), Chairman of the board of directors of Immuno (Canada) Ltd.. Drs. Ehrich, Sebastyan and Rozsenich, Sheila Boss and Omer Bouchard were cross-examined on their affidavits. The transcripts of their cross-examinations, exhibits thereto, and answers to undertakings form part of the evidence in this proceeding. Both parties filed a written argument and both parties were represented at an oral hearing.

With respect to parts (i) and (ii) of the first ground of opposition, the opponent has not adduced any evidence in support of its allegations but relies solely on the applicant's failure to adduce quantitative evidence of sales under its mark IMMUNOCORP. There is however some qualitative evidence of sales under the applied for mark by Bio-Mega Inc. (which company was apparently intended to be a registered user of the mark IMMUNOCORP before the rescindment of the registered user regime of the Trade-marks Act). In any event, I do not consider that the opponent has met its evidential burden to put allegations (i) and (ii) in issue. Further, there is no evidence supporting the allegation in (iii) above. Thus, the first ground of opposition pursuant to Section 30 need not be considered further.

The remaining grounds of opposition turn on the issue of confusion between the applied for mark IMMUNOCORP, for diagnostic in vitro reagents and services, and the opponent's mark IMMUNO for medicinal and pharmaceutical preparations. I do not consider that anything turns on whether the issue of confusion is determined at the material date May 13, 1988 in respect of the ground of opposition pursuant to Section 16, or at the material date April 24, 1989 in respect of the ground of opposition alleging non-distinctiveness, or at the material date which is the date of my decision in respect of the ground of opposition pursuant to Section 12(1)(d).

The legal burden is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2), between the applied for mark IMMUNOCORP and the opponent's mark IMMUNO. In determining whether there would be a reasonable likelihood of confusion, I am to have regard to all the surrounding circumstances, including those enumerated in Section 6(5). The presence of a legal burden 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: see John Labatt Ltd. v. Molson Companies Ltd. (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.).

With respect to Section 6(5)(a), the opponent's mark IMMUNO possesses a low degree of inherent distinctiveness in relation to medicinal and pharmaceutical preparations because the term "immuno" is highly suggestive of an immunological response. In this regard, "immune" is a dictionary word having a fairly precise meaning in medicine, namely, producing antibodies to a corresponding antigen. The term "immuno-" is also found in dictionaries; it is a prefix used in conjunction with a variety of medical terms and has the same meaning as immune. Further, I accept Sheila Boss' evidence (see p. 51 of her transcript of cross-examination) that the term "immuno" alone (i.e., without the hyphen) implies "an immunological activity in the relationship between an antigen and an antibody", that is, it has the same connotation as the word immune. Similarly, the applied for mark IMMUNOCORP has a low degree inherent distinctiveness in relation to diagnostic reagents and services because it is suggestive of a company that supplies or distributes reagents for testing, or tests for, immune responses. The opponent's mark IMMUNO and trade-name IMMUNO AG would have acquired some reputation in Canada by the end of 1986 as a result of about \$2.2 million in sales in Canada for the period 1984-1986 inclusive. Total sales in Canada for the period 1984-1989 inclusive amounted to \$24 million; sales averaged \$10 million for each of the years 1988 and 1989. Thus, the opponent's mark would have acquired a fair reputation in Canada at the later material dates, at least in that specialized field of the pharmaceutical industry dealing in haemo-derivatives and biologicals. In this regard, 75% of the opponent's sales in Canada are to the Red Cross. As discussed earlier, the applicant has not provided any evidence regarding its sales or advertising under its mark IMMUNOCORP. Thus, I conclude that the mark IMMUNOCORP was not known to any significant extent at any material time.

With respect to Section 6(5)(b), the opponent has been using its mark IMMUNO in Canada since about 1964. However, the only quantitative evidence of use of its mark is for the period 1984-1989. Accordingly, I infer *de minimus* use of the opponent's mark prior to 1984.

Similarly, I have inferred *de minimus* use of the applicant's mark at all relevant times. Thus, the length of time that the marks have been in use in Canada favours the opponent to some extent.

With respect to Section 6(5)(c) and (d), both parties are involved in health care and both market their wares directly to hospital staff. However, the parties' wares are different intrinsically and relate to different specialties. The applicant's diagnostic reagents and services relate to the analysis of body fluids. The analysis is usually performed in hospital laboratories by laboratory technicians. The target market for diagnostic reagents are hospital laboratories. By contrast, the pharmaceutical industry relates to drugs and medicines that are administered to people through an intermediary namely, a physician. The target market for the pharmaceutical industry includes physicians and pharmacies in hospitals. Further, I accept Sheila Boss' evidence that there is a clear line of demarcation between the diagnostics industry and the pharmaceutical industry: see, for example, lines 15-20, p. 32 of her transcript of cross-examination. See also the following extracts from Ms. Boss' transcript of cross-examination:

I only see people for diagnostics, they don't know anything about the pharmaceutical industry. You could ask them what an aspirin was, they won't know. I mean, really, they are totally separate. So the marketing, the pharmaceutical people I never see them. They go to see the physicians, they don't see the clinical chemists: at p. 39

If the pharmaceutical industry has never in three and a half years approached me to try to sell me their product, its pretty safe to assume that they're never going to. I'm never going to be asked to buy or distribute in my hospital or try out a new drug, it's not the right approach: at p. 47

. . . the pharmaceutical industry develops drugs . . . a diagnostic industry does not develop drugs. A diagnostic industry may, at a physician's request, use serum samples or urine samples to detect the presence of a drug in it: at p. 23

Mr. Bouchard's evidence is that the responsibility for purchasing diagnostic reagents and pharmaceutical products lie with different departments within a hospital. He goes on to say that this division of responsibility is in transition as the modern trend is towards one

central purchasing office. According to Mr. Bouchard, orders which are placed by purchasing departments are made from catalogues by a product identification number and the trade-mark of the product would be irrelevant to personnel placing purchase orders.

The opponent submits that it would be logical for the pharmaceutical industry to extend its products to include diagnostic reagents and vice versa, for the diagnostics industry to market pharmaceuticals. In this regard, there is convincing evidence that the opponent markets diagnostic reagents in other countries and is seriously contemplating marketing diagnostic reagents in Canada. Further, Ms. Boss' former employer namely, Bio-Mega Inc., changed the focus of its activities from a diagnostic company to a pharmaceutical company. In fact, that change prompted Ms. Boss' departure from Bio-Mega to continue her career in diagnostics at the Jewish General Hospital in Montreal. However, the evidence is far from convincing that what may be true of the opponent and of Bio-Mega is also true for the pharmaceutical and diagnostics industries as a whole. In any event, even if a pharmaceutical company were to become involved in diagnostics, the evidence is clear that pharmaceuticals and diagnostics are distinct products marketed to distinct specialty groups namely, physicians and laboratory personnel respectively. There is some scant evidence that individuals such as haemophiliacs may self-administer the opponent's products and thus might be familiar with the opponent's trade-mark and trade-name. However, there is no evidence concerning what proportion of the opponent's sales are representative of purchases made by the general public as opposed to institutional purchases intended for a hospital setting such as an operating room. On the evidence before me, it is difficult to conclude that the general public is familiar with the opponent company or its trade-mark IMMUNO. Similarly, there is nothing in the evidence to suggest that the general public would be familiar with trade-marks for diagnostic products or with the companies that supply or distribute diagnostic products.

With respect to Section 6(5)(e), there is a substantial degree of resemblance between the marks IMMUNOCORP and IMMUNO, as the applied for mark consists of the opponent's mark with an additional suffix. The opponent's position was that the resemblance between the applied for mark and the opponent's trade-name Immuno AG was enhanced because a fair

number of Canadians would be aware that the letters AG in the German language mean "corporation" in the English language. However, the opponent has not adduced any evidence in support of its submission, and I do not believe that it is a matter for which I can take judicial notice.

As a surrounding circumstance, the applicant relies on the state of the trade-marks register to demonstrate that the term "immune" is a common element of trade-marks in the health care industry. State of the register evidence is only relevant in so far as one can make inferences from it about the state of the marketplace: see Ports International Ltd. v Dunlop Ltd. (1992), 41 C.P.R.(3d) 432 (TMOB) and Del Monte Corporation v. Welch Foods Inc. (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). See also Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd. (1992), 43 C.P.R.(3d) 349 (F.C.A.) which is support for the proposition that inferences about the state of the register can only be drawn from state of the register evidence where large numbers of relevant registrations are located. The applicant's evidence shows ten registrations and eight trade-mark applications having the term immune, or variations of it such as "immuno" or "immuni" or "immu", as a component of the mark, most often appearing as a prefix. The aforementioned registrations and applications are mostly for diagnostic products and stand in the names of 14 different third parties. Some of those third parties also have the term "immune", or variations of it, as a prefix in their company name. The applicant also relies on Dr. Sebastyan's evidence on cross-examination concerning a publication entitled Clinical Diagnostics & Biotechnology- Canada 1991- Company Directory and Survey. Dr. Sebastyan's position on cross-examination was that if a company is listed in the publication, then it is active in Canada. Some of the supply companies listed in that publication are Immuchem Corp., Immuno Medica, Immunodiagnostics, Immunon (Lipshaw), Immunosystems Inc., Immunotech Corp. (see p. 155), Immunoassey Systems (see p. 56); Immucor Canada Inc. and Immunocorp Sciences Inc. are listed as distributors. I infer from the above that users of diagnostic products are at least to some extent accustomed to distinguishing among trade-marks and trade-names having the component "immune", or variations of it, on the basis of other components in the mark or trade-name.

Dr. Rozsenich's evidence on cross-examination was that similar market conditions and marks similar to those at issue in this proceeding are found in the pharmaceutical and diagnostic industries in other countries. However, when counsel for the applicant attempted to pursue a line of questioning relating to whether such marks have co-existed without confusion, Dr. Rozsenich refused to answer on advice from counsel : see pp. 16-19 of his transcript of cross-examination. Accordingly, I have drawn the negative inference that such marks co-exist without confusion in other countries where similar market conditions prevail.

At the oral hearing counsel for the opponent urged me to find an admission against interest by the applicant in its statement of opposition concerning application No. 654,113 (mentioned earlier). The pleadings in that proceeding are conveniently collected as exhibits to the Sebastyan cross-examination. Although counsel for the opponent objected to the introduction of those exhibits as evidence during the cross-examination, counsel withdrew its objections at the oral hearing. The admission in issue is the applicant's allegation in its statement of opposition, dated February 4, 1991, that the opponent's IMMUNO logo is confusing with the applicant's mark IMMUNOCORP used in Canada in association with diagnostic services and immunodiagnostic reagents. Had the matter rested there, the above pleading may have been fatal to the applicant in the instant proceeding. However, the statement of opposition was amended (as admitted by counsel for the opponent and as evidenced by exhibit LR-3), on March 18, 1992, to limit the allegation of confusion to the opponent's IMMUNO logo mark "as intended to be used in association with diagnostics for medical use." There is no inconsistency in the applicant's amended position that the parties' marks are confusing if both are used in the field of diagnostics but not confusing if the marks are restricted to different specialties namely, diagnostics and pharmaceuticals. I would also mention that at the oral hearing counsel for the opponent attempted to introduce new evidence which I refused to admit in view of objections raised by counsel for the applicant: in this regard see, for example, Provigo Inc. v. Union Agricole des Cooperatives Laitieres Isigny-Sur-Mer & Sainte-Mere- Eglise (1993), 49 C.P.R.(3d) 569 at pp. 572-573 (TMOB).

In considering whether the marks in issue are confusing, I have kept in mind that the

test for confusion is one of first impression and imperfect recollection. Factors of particular significance are that the term "immuno" has little inherent distinctiveness in the health care field, that the parties' market their products to different specialty groups (unlike the situation in Ciba-Geigy Canada Ltd. v. Apotex Inc. [1992] 3 S.C.R. 120 where the general public formed both parties' clientele), and that the opponent has not established a reputation in Canada in the field of diagnostics. Considering also the negative inference that I have drawn respecting the co-existence, without confusion, of similar marks in the pharmaceutical and diagnostic fields in other countries where similar market conditions prevail, I have concluded that the comparatively small difference between the marks in issue is sufficient to avert confusion.

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

DATED IN HULL, QUEBEC, THIS 31st DAY OF JANUARY, 1994.

Myer Herzig,
Member,
Trade-marks Opposition Board.