IN THE MATTER OF AN OPPOSITION
by Norwich Eaton Pharmaceuticals, Inc.
to application serial No. 613,891
for the mark MACROLIN
filed by Cetus Corporation

On August 25, 1988, Cetus Corporation filed an application to register the trade-mark MACROLIN, based on proposed use in Canada, for the wares

"therapeutic agents namely immunomodular, anticancer and anti-infective blood treatment pharmaceuticals."

The subject application was advertised for opposition purposes on February 15, 1989. Norwich Eaton Pharmaceuticals, Inc. (a United States of America company) filed a statement of opposition on March 10, 1989, a copy of which was forwarded to the applicant on April 7, 1989.

The grounds of opposition are summarised below:

(a) Cetus is not entitled to registration because, at the date Cetus filed its application, the applied for mark MACROLIN was confusing with the opponent's previously filed application serial No. 596,868 for the mark MACROBID covering "urinary tract antibacterials,"

(b) Cetus is not entitled to registration because, at the date Cetus filed its application, the applied for mark MACROLIN was confusing with the mark MACRODANTIN previously used by the opponent in Canada in association with a "pharmaceutical preparation containing nitrofurantoin,"

(c) the applied for mark MACROLIN is not registrable because it is confusing with the opponent's registered mark MACRODANTIN, registration No. 161,608, covering a "pharmaceutical preparation containing nitrofurantoin,"

(d) the application does not comply with Section 30(e) of the Trade-Marks Act in that the applicant Cetus did not intend to use the applied for mark in association with the wares specified.

The applicant filed, and served, a counter statement summarily denying the opponent's allegations.

The opponent's evidence consists of the affidavits of Nikoletta Voulgaris, an employee of the opponent's agents, and of Gary Sullivan, General Manager of Norwich Eaton Pharmaceuticals, Inc. (a Canadian company). Mr. Sullivan's company is a registered user of the opponent's mark MACRODANTIN.

Ms. Voulgaris' affidavit merely serves to introduce into evidence certified copies of the opponent's application for MACROBID and registration for MACRODANTIN relied on in the statement of opposition.

Mr. Sullivan's evidence is that the product sold under the mark MACRODANTIN is an antibacterial drug used in the treatment of specific urinary tract infections. It has been sold in Canada by the opponent or by Mr. Sullivan's company since at least as early as 1985. Sales in 1985 were about $1.7 million rising steadily to $2.8 million in 1989. Advertising costs were about $190,000 in 1985 rising steadily to $415,000 in 1989. About 300,000 units of the drug were sold during the period 1985 - 1989.

The applicant's evidence consists of the affidavit of Karen E. Thompson, a trade-mark searcher. Her evidence relates to the state of the trade-marks register. Ms. Thompson's search on the Dynis data base reveals 8 references to registrations and applications with the prefix MACRO. Of these, two registrations (for MARCOBID and MACRODANTIN) belong to the opponent, and one application is for the subject mark MACROLIN. Of the remaining five references, one is to an abandoned application and another is to an expunged mark; it is not clear whether references to the registered marks MACROSORB and MACROTEC concern pharmaceutical preparations; the remaining reference is to the mark MACRODEX, registered in 1953,

for medicinal and pharmaceutical preparations. Ms. Thompson also evidences about 17 registered trade-marks comprised of the prefix MICRO for pharmaceutical preparations, in the names of about 14 different registrants.

Both parties filed written arguments and both were represented at an oral hearing.

The opponent has not filed any evidence to substantiate its allegation that the applicant did not intend to use the mark MACROLIN. Therefore, the ground of opposition denoted by (d) above need not be considered further - see John Labatt Ltd. v. Molson Companies Ltd. (1990) 30 C.P.R.(3d) 293 at pp. 297-300 (F.C.T.D.).

The grounds of opposition denoted by (b) and (c) above turn on the issue of confusion between the applied for mark MACROLIN and the opponent's mark MACRODANTIN, either at the date of filing the subject application, namely August 25, 1988, with respect to the issue of entitlement, or at the date of my decision, with respect to the issue of registrability. In the circumstances of this case, nothing turns on which material date is chosen.

In applying the test for confusion, I am required to consider all the surrounding circumstances including those enumerated in Section 6(5). The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2), between its proposed mark MACROLIN and the opponent's mark MACRODANTIN. Further, I must exercise extra caution in determining the issue of confusion regarding marks applied to prescription, as well as to over the counter, pharmaceutical preparations - see Schering Canada Inc. v. Thompson Medical Co. (1983) 81 C.P.R.(2d) 270 at 275 (TMOB); G.D. Searle & Co. v. Ex-Lax, Ltd. (1986) 8 C.P.R.(3d) 303 at 307 (TMOB).

The marks MACRODANTIN and MACROLIN are inherently distinctive,

coined words having no specific connotations. Nevertheless, the prefix MACRO may suggest something large, for example, in the beneficial effects of the medicines, or perhaps something large in relation to the chemistry of their ingredients. In the latter regard, the opponent advertises that its product MACRODANTIN "is a larger crystal form of nitrofurantoin." The suggestive connotation of the component MACRO therefore detracts somewhat from the inherent distinctiveness of the marks in issue.

I conclude that the opponent's mark MACRODANTIN is known to a fair extent in Canada as a result of sales and advertising in the period 1985 to 1989 inclusive. There is no evidence that the applied for mark MACROLIN is known to any extent. Length of time in use is a factor that also favours the opponent. On the basis of the opponent's evidence, and the description of wares in the subject application, it appears that the parties' wares are used for different purposes. The fact that the parties' products are used for different purposes does not assist the applicant when I am determining the issue of confusion between the parties, marks - see Schering Canada Inc., above.

It is not entirely clear from the evidence whether the parties' wares are prescription drugs. In all likelihood they are; however, nothing turns on whether the wares are prescription or non-prescription items. The crucial factor is that both parties' wares are pharmaceutical preparations for human use - see Mead Johnson & Co. v. G.D. Searle & Co. (1967) 53 C.P.R. 1 at pp 9-10 (Ex. C.). Further, overlap is likely in the parties' trades and in the parties' channels of distribution, namely through physicians, pharmacies, and extended care facilities.

There is some resemblance between the parties' marks, visually and aurally, when the marks are considered in their entireties, owing to the prefix MACRO and the ending IN comprising each mark. Neither mark suggests any idea in particular.

As a surrounding circumstance, the state of the register evidence suggests that the public is, to at least a certain extent, accustomed to distinguishing among pharmaceutical preparations sold under marks prefixed by the component MICRO. However, at the oral hearing, the applicant advised that it was no longer relying on the state of the register evidence as it pertains to the prefix MICRO. Presumably, the argument would have been that the public, already somewhat familiar with the prefix MICRO for pharmaceutical preparations, would react with the same acuity to distinguish between marks beginning with MACRO. That argument was not presented and I need not deal with it.

In view of the above, and considering in particular the similarities in the marks themselves and the jurisprudence directing me to exercise extra caution when determining the issue of confusion between marks relating to pharmaceutical preparations, I find that I am in a state of doubt as to whether, as a matter of first impression and imperfect recollection, the applied for mark MACROLIN is confusing with the opponent's mark MACRODANTIN. As the legal burden is on the applicant, such doubt must be resolved against it. Accordingly, the grounds of opposition denoted by (b) and (c) above are successful. The remaining ground of opposition denoted by (a) above need not be considered.

In view of the above, the applicant's application is refused.

DATED AT HULL, QUEBEC, THIS 30th DAY OF October, 1992.

Myer Herzig,
Member,
Trade-marks Opposition Board