

IN THE MATTER OF AN OPPOSITION  
by Novopharm Ltd. to application  
No. 593,889 for the trade-mark  
Design of a Tablet filed by  
Burroughs Wellcome Inc.

On October 21, 1987, the applicant, Burroughs Wellcome Inc., filed an application to register a trade-mark described in the following terms:

The trade mark is shown in the attached drawing -

The Trade Mark consists of the colour blue applied to the surface of a shield shaped tablet.

The applicant seeks registration for "pharmaceutical preparations and substances having antiviral properties" and the application is based on use of the trade-mark in Canada since September of 1986. The application was advertised for opposition purposes on June 8, 1988.

The opponent, Novopharm Ltd., filed a statement of opposition on July 8, 1988, a copy of which was forwarded to the applicant on August 11, 1988. The grounds of opposition are reproduced below.

- (a) The Opponent bases its opposition on the grounds provided by Section 37(2) (a) of the Trade Marks Act (hereinafter 'the Act'), namely that the Application does not comply with the requirements of Section 29(h) [now Section 30(h)], in that it does not contain an accurate representation of the alleged trade mark;
- (b) The Opponent bases its opposition on the grounds provided by Section 37(2) (b) [now Section 38(2) (b)] of the Act, namely that the Applicant's alleged mark is not registrable, in that:
- (i) it is not a trade mark and it is not a distinguishing guise within the meaning of Section 2 of the Act; or
- (ii) in the alternative, if it is a trade mark, it is not registrable pursuant to Section 12(1) (b) in that it is either clearly descriptive or deceptively misdescriptive of the character of or quality of the wares in association with which it is used; or
- (iii) in the further alternative, if it is a distinguishing guise, it is not registrable pursuant to Section 13 in that at the date of filing of the application, it had not been so used in Canada as to have become distinctive; and in addition, the exclusive use by the applicant of such distinguishing guise in association with the wares is likely unreasonably to limit the development of the pharmaceutical industry; and
- (c) The Opponent bases its opposition on the grounds provided by Section 37(2) (d) [now Section 38(2) (d)] of the Act, namely that the Applicant's alleged trade mark is not distinctive, within the meaning of Section 2 of the Act, in that it does not distinguish, and is not adapted to distinguish, the Applicant's wares from those of others.

The applicant filed and served a counter statement generally denying the allegations in the statement of opposition and asserting that the opposition is vexatious since the opponent has not raised a single issue. As its evidence, the opponent filed the affidavits of Leslie L. Dan, Joseph H. Newton, Harry Brown, Paul Pitt and Philip Feldberg. All of these affiants were cross-examined and the transcripts of those cross-examinations form part of the record of this proceeding. As its evidence, the applicant filed the affidavits of Malcolm Fletcher, Andre Lamonde, Robert W. Sterling, Mark Labow and Ben Berman. Messrs. Fletcher, Lamonde and Labow were cross-examined on their affidavits and the transcripts of those cross-examinations form part of the record of this opposition. Mr. Sterling was cross-examined by way of written interrogatories and his written responses form part of the record. Mr. Berman was not cross-examined. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

As for the opponent's first ground of opposition, the onus or legal burden is on the applicant to show its compliance with the provisions of Section 30(h) of the Act: see pages 329-330 of the opposition decision in Joseph Seagram & Sons v. Seagram Real Estate (1990), 33 C.P.R.(3d) 454 (F.C.T.D.); affg. (1984), 3 C.P.R.(3d) 325 (T.M.O.B.). There is, however, an evidential burden on the opponent respecting its allegations of fact in support of that ground. The material time for considering the circumstances respecting the issue of non-compliance with the provisions of Section 30(h) of the Act is the filing date of the application.

Section 30(h) reads as follows:

30. An applicant for the registration of a trade-mark shall file with the Registrar an application containing  
.....

(h) unless the application is for the registration only of a word or words not depicted in a special form, a drawing of the trade-mark and such number of accurate representations of the trade-mark as may be prescribed....

It is clear that the applicant has formally complied with the provisions of Section 30(h) since it did file a drawing as illustrated above. However, it is not clear that the drawing provided by the applicant is a meaningful representation of the applicant's mark in the context of the written description appearing in the application. The written description refers to the color blue applied to the surface of a shield shaped tablet which I take to mean that the color blue is applied to the entire surface of a tablet having a particular configuration. The drawing is required to define that configuration in order to determine the limits of the trade-mark claimed.

In the present case, the drawing is of little assistance in determining the three-dimensional limits of the tablet to which the color blue is applied. The drawing is simply a two-dimensional representation of one aspect of the tablet, presumably the top surface of the tablet. That single two-dimensional drawing is insufficient to determine the overall shape of the tablet. I am unable to tell if the tablet has sides, if the bottom surface is the same as the top surface or if either surface is concave or convex. I am also unable to determine the relative dimensions of any given face of the tablet to any other face of the tablet.

In view of the above, I find that the applicant's drawing is insufficient to

delineate the trade-mark for which registration is sought and I therefore find that the ground of opposition of non-compliance with Section 30(h) is successful. In Smith Kline & French Canada Ltd. v. Registrar of Trade Marks [1987] 2 F.C. 633 (F.C.T.D.), Mr. Justice Strayer found that a particular color applied to the entire surface of a tablet of a particular size and shape qualified as a trade-mark. However, implicit in that finding is the principle that an applicant has to accurately describe the trade-mark for which it is seeking registration. In the present case, the drawing is too imprecise to make the applicant's description of its trade-mark meaningful. The applicant should have provided a drawing showing the trade-mark in three dimensional perspective. Alternatively, the applicant could have provided several two dimensional representations of the mark from different perspectives. A less satisfactory alternative might have been to provide a detailed written description of the shape of the mark and rely on the single drawing already filed. A further alternative along those lines would be to have delineated the shape of the trade-mark in the written description by reference to the specimen filed pursuant to Rules 30 and 33 of the Trade-marks Regulations. This latter alternative appears to have been the one chose in the Smith Kline case (see page 634 of the reported decision). In any event, Section 30(h) requires that the present applicant provide an accurate drawing of the trade-mark which, either by itself or in conjunction with the description of the trade-mark in the application, delineates the shape of the trade-mark claimed. The present applicant's drawing fails on both counts.

The applicant submitted that the drawing filed is an accurate representation of the mark when viewed in the context of the specimen tablets filed in support of the application. Each specimen is a blue tablet having an identical slightly bevelled hexagonal shape both top and bottom joined by short sides of the same length. Having viewed those specimens, I have a good idea as to the shape of the applicant's mark. However, unlike in the Smith Kline case, the present applicant has not delineated its description of its trade-mark by reference to the specimens. Thus, if a registration were to issue from the present application, the public examining that registration on the trade-marks register would not know what the shape of the applicant's trade-mark was and would be given no instructions as to how to determine that shape. If a member of the public were astute enough to track down the Trade-marks Office file containing the original application, the discovery of the specimens on file would be helpful but not determinative since the shape of the specimens is not incorporated by reference into the description of the trade-mark appearing in the registration.

The opponent also argued that the Section 30(h) ground should be successful on the basis that the drawing is not an accurate representation of the trade-mark actually used since the tablets sold by the applicant have always featured the trade-mark ZOVIRAX on one side and a triangular indentation on the other side. It is the opponent's contention that use of the actual tablets does not constitute use of the applied for trade-mark. This issue is moot, of course, because the applicant failed to provide an accurate drawing of its claimed trade-mark. However, if it had and it was based on the actual tablets sold, I would have found that sales of the tablet would have constituted use of the applied for mark since the public would, as a matter of first impression, perceive use of the actual tablet as also being use of the tablet's blue shape alone: see the opposition decision in Nightingale Interloc Ltd. v. Prodesign Ltd. (1984), 2 C.P.R. (3d) 535 at 538.

As for the additional grounds of opposition, the portions of paragraphs (b) (i) and (b) (ii) of the statement of opposition predicated on the assumption that the applicant's mark is a distinguishing guise do not raise grounds of opposition since the application is for a trade-mark, not a distinguishing guise. The remaining grounds of opposition are that the trade-mark is not a trade-mark, is not registrable in view of Section 12(1) (b) of the Act and is not distinctive. However, the opponent did not provide supporting allegations of fact for any of these grounds. Thus, it is not possible to determine the basis for any of these three grounds and each contravenes Section 38(3) (a) of the Act. They are therefore unsuccessful. It should be noted that the Opposition Board Practice Notice date December of 1987 indicates that, in assessing a statement of opposition when originally filed, it is the opponent's responsibility to ensure that each of its grounds is properly pleaded. The Opposition Board's responsibility is only to determine if the opposition raises one substantial issue for decision.

From a review of the evidence and argument of record, it is possible to determine to some extent the nature of the allegations of fact that the opponent is implicitly relying on. For example, with respect to the ground of opposition that the applied for trade-mark is not a trade-mark, it appears that the opponent is asserting that the nature of the applicant's trade-mark is such that it cannot function as a trade-mark. Those assertions are effectively answered by the Smith Kline decision which is support for the proposition that a particular color applied to the entire surface of a tablet of a particular shape can function as a trade-mark.

The opponent also submitted that the applicant's trade-mark is not a trade-mark since it cannot function as such. In particular, the opponent submitted that physicians, pharmacists and patients viewed the shape, size and color of a pill or tablet as indicative of the type or strength of the medication. The evidence shows that this may be true in some instances. But the evidence also shows the opposite - i.e. - that physicians and pharmacists (and possibly patients) sometimes associate the shape, size and color of a tablet with a source of origin of the medication.

The opponent further submitted that the mark could not function as a trade-mark because the applicant's product is a prescription drug and patients have no choice in what is dispensed to them by pharmacists and because they do not see the trade-mark at the time of the transfer of the trade-marked goods. The evidence, however, establishes otherwise. Patients do have a choice of different brands of the same drug including the so-called generic equivalents and they often have an opportunity to see the shape and color of the pills or tablets when the pharmacist is counting them out and when they are placed in a clear plastic vial. Thus, even if the opponent's second ground of opposition had been adequately pleaded to accord with the submissions in its written argument, it would have been unsuccessful.

As for the ground of opposition based on Section 12(1) (b) of the Act, even with the assistance of the opponent's written argument, I am at a loss to know exactly what the opponent wishes to allege. I believe that the opponent's position may be that the color blue applied to the entire surface of a tablet clearly describes a blue tablet of that shape. If so, the opponent's argument fails in view of the Smith Kline decision discussed above.

As for the ground of opposition based on non-distinctiveness, a review of the opponent's arguments reveals that the opponent wished to allege that the applicant's mark was not distinctive in view of third party uses of similar marks. If such a ground had been in issue, the onus or legal burden would have been on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - July 8, 1988): see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.); Molnlycke Aktiebolag v. Kimberly-Clark Ltd. (1982), 61 C.P.R.(2d) 42 at 52 (F.C.T.D.); Work Wear Corp. v. Triple G. Manufacturing Inc. (1990), 32 C.P.R.(3d) 463 at 467 (F.C.T.D.); Murjani International Ltd. v. Universal Impex Co. Ltd. (1986), 12 C.P.R.(3d) 481 at 484 (F.C.T.D.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.).

If the ground of non-distinctiveness had been adequately pleaded, I would have found that the applicant had satisfied the onus on it. Although the evidence does establish the existence of two or three tablets having a shape similar to the applicant's tablet, they appear in a United States publication and there is no evidence that they have any reputation in Canada. In fact, the evidence suggests they have no reputation in Canada in view of the fact that certain affiants who are practising pharmacists were not familiar with the third party products. Furthermore, the third party tablets are for different pharmaceutical products than those claimed in the present application.

The evidence establishes that there are a wide variety of sizes, shapes and colors used in manufacturing pharmaceutical pills and tablets. Thus, the applicant's mark could not be said to be inherently strong. However, it has enjoyed extensive sales since its introduction and that reputation has been buttressed by means of product information literature which includes a two-dimensional representation of the applicant's mark. Thus, I can conclude that the applicant's mark is distinctive in fact. The final ground of opposition would therefore also have been successful.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 29<sup>th</sup> DAY OF OCTOBER 1993.

David J. Martin,  
Member,  
Trade Marks Opposition Board.