LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2015 TMOB 77
Date of Decision: 2015-04-21

IN THE MATTER OF AN OPPOSITION by Aventis Pharma S.A. to application No. 1,452,781 for the trade-mark AMPRIVA in the name of Acorda Therapeuthics, Inc.

Introduction

[1] Aventis Pharma S.A. (the Opponent) opposes registration of the trade-mark AMPRIVA (the Mark) that is the subject of application No. 1,452,781 filed by Acorda Therapeutics, Inc. (the Applicant).

[2] The application was filed on September 23, 2009. It was amended on a couple of occasions in response to office actions. It now covers:

> Pharmaceutical preparations for the treatment of function in neurological, neurotrauma, autoimmune, neuromuscular, demyelinating, cardiac and neurodegenerative diseases and disorders, namely spinal cord injuries, multiple sclerosis, stroke, brain injury, Guillain-Barre Syndrome, Charcot Marie Tooth Syndrome, Parkinson's Disease, seizure disorders, cerebral palsy, muscular dystrophy, Lambert-Eaton, spasticity, neuropathic pain, Alzheimer's Disease, anterior horn cell diseases, cluster headache, migraine, peripheral neuropathy, diabetic neuropathy, congestive heart failure, myocardial infarction, and mononeuritus multiplex (the Goods).

[3] The application was filed on the basis of proposed use in Canada.

[4] The opposition was brought by the Opponent under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition pleaded in a statement of opposition filed by the Opponent are based on sections: 12(1)(d) (registrability), 16(3)(a) (non-entitlement) and 2 (distinctiveness). They all turn on the issue of likelihood of confusion with the Opponent's trade-mark APIDRA. The grounds of opposition are detailed in Annex A to this decision.

[5] For the reasons explained below, I refuse the application in part.

The Record

[6] The application was advertised in the *Trade-marks Journal* on April 25, 2012. The Opponent filed its statement of opposition on September 25, 2012. The Applicant filed and served a counter statement in which it denied each and every ground of opposition pleaded by the Opponent.

[7] The Opponent filed as evidence the affidavits of Jean-Michel Ross and Babak Abbaszadeh as well as a certified copy of registration TMA737,291 for the trade-mark APIDRA. The Applicant elected not to file evidence.

[8] Both parties filed written argument and were represented at the hearing.

The parties' respective burden or onus

[9] The legal onus is on the Applicant to show that its application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA); and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FCTD)].

Preliminary remarks

[10] I wish to point out that in reaching my decision I have considered all the evidence in the file but I will refer in my reasons for this decision only to the relevant portions of the evidence.

Grounds of opposition summarily dismissed

[11] The Applicant has identifed in its written argument a fatal flaw in the Opponent's evidence related to the prior use of its trade-mark APIDRA. In fact Mr. Ross, a representative of Sanofi-Aventis Canada Inc., (Sanofi Canada) has provided in his affidavit evidence of use of the trade-mark APIDRA in Canada by Sanofi Canada but nowhere in his affidavit or in the Opponent's evidence do we have information as to the relationship between the Opponent and Sanofi Canada.

[12] Consequently any evidence of use in Canada of the trade-mark APIDRA cannot benefit to the Opponent. In fact at the outset of the hearing the Opponent's agent mentioned that she would not make any representations with respect to the grounds of opposition based on prior use of the Opponent's trade-mark APIDRA.

[13] Therefore the ground of opposition based on the prior use or making known of the aforesaid trade-mark in Canada by the Opponent (non-entitlement under section 16(3)(a) of the Act) is dismissed. The Opponent's ground of opposition based on lack of distinctiveness of the Mark is also dismissed because the Opponent has not shown that its mark has become sufficiently known in Canada to negate the distinctiveness of the Mark. The Opponent failed to meet its initial burden with respect to both of these grounds.

[14] What remains to be decided is the ground of opposition known as 'registrability' of the Mark under section 12(1)(d) of the Act.

Registrability of the Mark under section 12(1)(d) of the Act

[15] The relevant date for the analysis of this ground of opposition is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 at 424 (FCA].

[16] As mentioned before, the Opponent filed a certified copy of registration TMA737,291 for the trade-mark APIDRA. I used my discretion to check the register and confirm that the Opponent is the owner of this registration and it is extant. It covers the following goods:

Pharmaceutical products, namely, pharmaceutical preparations for the treatment of diabetes.

[17] Consequently the Opponent has met its initial burden with respect to this ground of opposition.

[18] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trade-marks are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the goods, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC), *Mattel Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 96 CPR (4th) 361 (SCC)].

[19] The test under section 6(2) of the Act does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether a consumer who sees the Applicant's Goods bearing the Mark, would think they emanate from or are sponsored by or approved by the Opponent.

Inherent distinctiveness of the trade-marks and the extent to which they have become known

[20] Both marks are highly inherently distinctive. The degree of distinctiveness of a trade-mark may be enhanced through its use or promotion in Canada. The application is based on proposed use and there is no evidence of use of the Mark in the record. As for the use of the Opponent's trade-

mark APIDRA, as mentioned earlier I cannot associate the evidence of use of that trade-mark, described in Mr. Ross' affidavit, to the Opponent. Consequently, this factor favours neither party.

Length of time the marks have been in use

[21] At the hearing the Opponent was relying on the declaration of use filed by the Opponent to obtain the registration of its trade-mark APIDRA to claim a slight advantage under this factor. The Opponent contends that since the declaration of use was filed in March 2009, one can assume that its trade-mark has been in use since that date. I am fully aware that such use is considered to be '*de minimis*' use [see *Novopharm Ltd. v. Genderm Canada Inc.* (1998), 85 C.P.R. (3d) 247 (TMOB)] and therefore it will not be a determining factor in this decision.

The nature of the goods and their channels of trade

[22] Not surprisingly, a great deal of the Opponent's evidence and the parties arguments deal with this issue. I will therefore summarize the relevant portion of the Opponent's evidence.

[23] Mr. Babak Abbaszadeh graduated from medical school in 1999. Since then he practiced medicine as part of 'Médecins Sans Frontières' in locations with vulnerable civilians and post-conflict populations. He joined 'pharmaceutical companies' in 2007 as medical director of 'Sanofi Iran' and is currently Head of Medical Affairs for 'Sanofi' in Canada. Neither Sanofi Iran nor Sanofi are defined in his affidavit. I assume that they are different entities than Sanofi Canada. In fact the Opponent did not make representations on this issue.

[24] Mr. Abbaszadeh was asked by the Opponent's agent 'to indicate if patients suffering from diabetes and treated with APIDRA products could also be prescribed AMPRIVA according to the above list of goods and the link between diabetes and one or more of the diseases [identified in the list of Goods]'. He states the following:

- Approximately 15 percent of patients with diabetes have symptoms and signs of polyneuropathy but nearly 50 percent of cross-sectional population samples have evidence of peripheral nerve damage as judged by nerve conduction abnormalities.
- The duration of diabetes is perhaps the most important factor. Fewer than 10 percent of patients have clinically evident polyneuropathy at the time of discovery of diabetes, but this figure rises to 50 percent after 25 years. The presence of diabetic retinopathy is associated with higher incidences of neuropathy. It is not surprising

therefore, that neuropathy is most common in diabetics older than 50 years; it is infrequent in those younger than age 30 years and is rare in childhood.

- The only preventive treatment for diabetic neuropathy is the maintenance of blood glucose concentration at close to normal range. The prevailing view, derived from long-term human studies, is that there is a relationship between peripheral nerve damage and inadequate regulation of the diabetes.

[25] Based on limited information provided to him by the Opponent's agent on the product AMPRIVA it is Mr. Abbaszadeh's understanding that the pharmaceutical preparation AMPRIVA could be used for the management of neuropathy of patients with diabetes (Diabetic Neuropathy), as one of the common cause of neuropathy is diabetes. Therefore the use of this product by diabetics is 'high likely to happen in real life clinical practice'.

[26] This evidence has not been contradicted by the Applicant. As it happens sometimes in highly specialized field such as medicine and pharmaceutical preparation, plain language is seldom used making it difficult for a layman to fully understand the details of this evidence. However, it is my understanding that there exists a strong possibility that diabetics taking APIDRA pharmaceutical preparation could also suffer from neuropathy and thus the Goods could be prescribed for the treatment of this condition.

[27] I have no evidence that there exists some form of association between the other diseases described in the list of Goods and diabetics. The common feature between the parties' goods, except for what has been described above, is the fact that they are both pharmaceutical preparation. The Applicant argues that given the nature of the goods, and the serious condition of those who will take the Goods, they will pay particular attention to the medicine prescribed. I have no evidence in the record to support such contention.

[28] The Applicant further argues that the first consumer of the Goods is not the patient but rather the prescription doctor and the pharmacist. I cannot subscribe to this argument. Firstly, I have no evidence that the parties' pharmaceutical preparations are prescribed medicine. Also, in determining the likelihood of confusion between two trade-marks in the field of pharmaceutical products, not only the doctors and pharmacists are considered as consumers but also the end user of the product, namely the patients [see *Ciba-Geigy Canada Ltd v Apotex Inc* [1992] 3 SCR 120].

[29] The parties' goods are pharmaceutical preparations that could be used by the same type of patients (diabetics). I have no evidence that their channels of trade would differ. I conclude that both of these factors favour the Opponent in so far as the Applicant's pharmaceutical preparation concerns the treatment of diabetic neuropathy.

Degree of resemblance

[30] As stated by the Supreme Court of Canada in *Masterpiece*, in the majority of cases, the degree of resemblance between the marks in issue is the most important factor.

[31] The Applicant argues that the marks in issue must be viewed as a whole; they should not be put side by side; one must consider the overall impression of the marks; and it is the imperfect recollection of the Opponent's mark that matters. I do not think that there is any dispute over those principles.

[32] The parties' marks are coined words with no apparent correlation with words in the English or French languages. There are no apparent ideas suggested by the parties' marks.

[33] The Opponent argues that both marks have the same first and last letter (A). Moreover, the letter 'I' appears in the middle of both marks. Finally, both marks have the letters 'P' and 'R'. This is the wrong approach used in assessing the degree of resemblance between two trade-marks. The Opponent is doing a 'side by side' analysis of the marks. Overall the Mark, which inherently distinctive, is composed of the majority of the letters forming the Opponent's highly distinctive trade-mark, and these letters appear in a similar sequence.

[34] Given the uniqueness of the Opponent's trade-mark, I can foresee a diabetic consumer, having an imperfect recollection of the trade-mark APIDRA and confronted with Goods bearing the mark AMPRIVA, could think that the Opponent is the source of origin of the Goods.

State of the Register

[35] To its written arguments, the Applicant attached as an annex a list of trade-marks all beginning and ending with the letter A. At the hearing, the Applicant's agent invited me to use the Registrar's discretion to consult the register to confirm their existence. I mentioned at the hearing

that I was not prepared to do that. If a party intends to rely on extracts of the register to argue the state of the register, it should file them as part of its evidence. The Applicant chose not to file any evidence. The Registrar will exercise its discretion to consult the register in very limited situations involving public interest, such as to verify if an opponent is the registered owner of registration(s) alleged in its statement of opposition in the absence of evidence in the record to that effect [see *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. However there is no public interest in the Registrar seeking to assist an applicant to register its trade-mark by checking the register and thereby do what the Applicant ought to have done by filing evidence in this opposition [see *John Labatt Limited v WCW Western Canada Water Enterprises Inc* (1991), 39 CPR (3d) 442 (TMOB)].

Conclusion

[36] From this analysis I conclude that the Applicant has not discharged its onus to prove, on a balance of probabilities, that there exists no likelihood of confusion between the Mark and the Opponent's trade-mark APIDRA when used in association with pharmaceutical preparations for the treatment of diabetic neuropathy.

[37] I wish to remind that the ultimate onus is on the Applicant. In this case, at best for the Applicant, I could have reached a result where the balance of probabilities would be equal and thus the Applicant would still not have discharged its legal onus in so far as the application covers pharmaceutical preparations for the treatment of diabetic neuropathy.

[38] Accordingly, I maintain in part the ground of opposition based on section 12(1)(d) of the Act.

Disposition

[39] Pursuant to the authority delegated to me under section 63(3) of the Act, I allow the application in part only with respect to the following goods:

> Pharmaceutical preparations for the treatment of function in neurological, neurotrauma, autoimmune, neuromuscular, demyelinating, cardiac and neurodegenerative diseases and disorders, namely spinal cord injuries, multiple sclerosis, stroke, brain injury, Guillain-Barre Syndrome, Charcot Marie Tooth

> Syndrome, Parkinson's Disease, seizure disorders, cerebral palsy, muscular dystrophy, Lambert-Eaton, spasticity, neuropathic pain, Alzheimer's Disease, anterior horn cell diseases, cluster headache, migraine, peripheral neuropathy, congestive heart failure, myocardial infarction, and mononeuritus multiplex.

pursuant to section 38(8) of the Act [see *Produits Menagers Coronet Inc v Coronet-Werke Heinrich Schlerf Gmbh* (1986), 10 CPR (3d) 492 (FCTD) as authority for a split decision].

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Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Annex A

The grounds of opposition raised by the Opponent in its statement of opposition can be summarized as follow:

1. The Mark is not registrable pursuant to section 12(1)(d) of the *Trade-marks Act* RSC 1985, c T-13, (the Act) as being confusing with the Opponent's registered trade-mark APIDRA, registration TMA737,291 covering pharmaceutical products, namely pharmaceutical preparations for the treatment of diabetes;

2. The Applicant is not the person entitled to the registration of the Mark pursuant to section 16(3)(a) of the Act in that at the date of filing of the application the Mark was confusing with the Opponent's registered trade-mark that had been previously used in Canada by the Opponent in association with pharmaceutical products, namely pharmaceutical preparations for the treatment of diabetes;

3. Pursuant to section 38(2)(d) of the Act, the Mark is not distinctive as it does not actually distinguish nor is it capable of distinguishing the Goods from the goods of the Opponent, in view of the confusion it creates with the Opponent's trade-mark APIDRA.