

IN THE MATTER OF AN OPPOSITION
by Laboratoires Nordic Inc.- Nordic Laboratories Inc.
to application serial No. 593,348
for the mark NORDITROPIN
filed by Novo-Nordisk A/S
(successor in title to Nordisk Gentofte A/S)

On October 14, 1987, the original applicant, Nordisk Gentofte A/S, filed an application to register the trade-mark NORDITROPIN for the wares

growth hormone preparations based on intended use in Canada. The subject application was advertised for opposition purposes on May 4, 1988. The opponent, Laboratoires Nordic Inc.-Nordic Laboratories Inc. ("Nordic"), filed a statement of opposition on August 17, 1988, a copy of which was forwarded to the applicant on August 30, 1988. Novo-Nordisk A/S was subsequently recorded as owner of the subject application by virtue of a merger with the original applicant.

The grounds of opposition are that the applied for mark is not registrable and that the applicant is not the person entitled to registration, because the applied for mark NORDITROPIN is confusing with one, or more, of the opponent's registered trade-marks namely NORDIC, NORBITONE, NORFEMAC, NORILAC, and NORSENA, covering various pharmaceutical preparations, previously used and made known in Canada by the opponent and its registered users. The opponent also alleges that the applicant is not entitled to registration because the applied for mark is confusing with the opponent's trade name Laboratoires Nordic Inc.- Nordic Laboratories Inc. Further grounds of opposition are that the applied for mark is not distinctive of the applicant's wares, and that the application is not in compliance with Section 30(i) of the Trade-marks Act, in view of the opponent's prior rights in the above mentioned marks.

The applicant filed a counter statement admitting that the opponent is the owner of the above mentioned registered marks, but otherwise denied the other allegations in the statement of

opposition.

The opponent's evidence consists of the affidavit of Michel Guerin, Senior Vice-President, Operations and Administrative Services, of Nordic. The applicant did not cross-examine Mr. Guerin on his affidavit nor did the applicant file any evidence.

Only the opponent filed a written argument; however, both parties were ably represented at an oral hearing.

I will first consider the ground of opposition pursuant to Section 12(1)(d), namely, that the applied for mark NORDITROPIN is not registrable because it is confusing with the opponent's registered mark NORDIC covering, inter alia, pharmaceuticals. The material date to consider the issue of confusion arising pursuant to Section 12(1)(d) is the date of my decision - see Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R. (3d) 413 (F.C.A.); but see also Conde Nast Publications Inc. v. The Canadian Federation of Independent Grocers (1991), 37 C.P.R. (3d) 538 (TMOB).

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 NORDITROPIN and the opponent's registered mark NORDIC. 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.)

The opponent has used its mark NORDIC as a house mark on a wide range of prescription and non-prescription pharmaceutical

preparations since about 1980. The mark NORDIC also functions as a trade name to identify the opponent's business. Mr. Guerin's affidavit evidence establishes extensive use and advertising of the opponent's house mark (and trade name) NORDIC on product labels and packaging as well as on advertising and brochures. Having regard to the extensive sales and advertising under the opponent's house mark and trade name NORDIC, albeit in a subsidiary role to the opponent's product marks which receive greater emphasis, I am able to conclude that the opponent's house mark and trade name NORDIC has achieved a substantial reputation in Canada. Further, the opponent's mark NORDIC possesses a fair degree of inherent distinctiveness as the mark NORDIC does not suggest any qualities or characteristics of the opponent's products or business.

The applied for mark NORDITROPIN also possesses a fair degree of inherent distinctiveness. The subject application is based on proposed use in Canada and there is no evidence that the applied for mark NORDITROPIN is known to any extent. The parties' wares are related in that growth hormones belong to the general category of pharmaceutical preparations that, I assume, are dispensed by pharmacists and doctors. In the absence of evidence to the contrary, I assume that the parties' channels of trade would be the same or overlapping namely, through health care professionals such as doctors and pharmacists.

The resemblance between the opponent's mark NORDIC and the applied for mark NORDITROPIN lies in the first portion of the marks. The opponent submits that applicant has, in fact, appropriated almost the whole of the mark NORDIC and merely added the suffix TROPIN. The opponent submits that because the first syllable in a trade-mark is the more important for the purposes of distinction (see Conde Nast Publications Inc. v. Union Des Editions Modernes (1979), 46 C.P.R.(2d) 183 at 188 (F.C.T.D.)), it follows that there is a high likelihood of confusion between the marks in issue.

At the oral hearing, the agent for the applicant argued that the prefix "Nor" has been commonly adopted for pharmaceutical preparations, and that therefore it would be wrong to place undue emphasis on the first portions of the marks for assessing the likelihood of confusion. The applicant submits that rather than focusing on the non-distinctive prefix NOR, greater emphasis should be placed on comparing the distinctive suffixes, namely TROPIN and DIC. However, the applicant has not filed evidence of actual marketplace use of marks prefixed by NOR for pharmaceuticals, nor has the applicant filed evidence concerning the state of the trade-marks register from which I might possibly infer common use and adoption of the prefix NOR. Not surprisingly, at the oral hearing the agent for the applicant requested that I exercise my discretion to review the trade-marks register to confirm the alleged existence of at least 30 registered marks (standing in the names of different owners) for pharmaceutical preparations prefixed by NOR. I have declined to do so because it would be prejudicial to the opponent: see John Labatt Ltd. v. W.C.W. Western Canada Water Enterprises Inc. (1991), 39 C.P.R.(3d) 442 at 445-446 (TMOB); see also Realestate World Services v. Realcorp Inc. (1993), 48 C.P.R.(3d) 397 at 403-404 (TMOB). In the result, there is no support for the applicant's submission that reduced emphasis ought be placed on the first portion of the marks in issue.

Considering that the opponent has established a significant reputation for its house mark (and trade name) NORDIC, that the parties' wares are related and their channels of trade are the same or overlapping, that the marks in issue resemble each other to a certain degree owing to a shared, distinctive prefix, and considering further that in the field of medical products extra caution must be taken to avoid confusion in the use of trade-marks (see Mead Johnson & Co. v. G.D. Searle & Co. (1967), 53 C.P.R. 1 at 9-10 (Ex. C.)), I find that the applicant has not satisfied the legal burden on it to show that there is no reasonable likelihood of confusion between the marks in issue. Accordingly, the opponent

succeeds on its ground of opposition pursuant to Section 12(1)(d),
and I need not consider the remaining grounds of opposition.

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

DATED AT HULL, QUEBEC, THIS 30th DAY OF SEPTEMBER , 1993.

Myer Herzig,
Member,
Trade-marks Opposition Board