

O P I C



C I P O

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 13

Date of Decision: 2020-02-06

IN THE MATTER OF AN OPPOSITION

Ipsen Biopharm Ltd.

Opponent

and

Fujifilm Kyowa Kirin Biologics Co., Ltd.

Applicant

1,664,502 for ONVIADA

Application

INTRODUCTION

[1] Ipsen Biopharm Ltd. opposes registration of the trademark ONVIADA (the Mark), which is the subject of application No. 1,664,502 (the Application) filed by Fujifilm Kyowa Kirin Biologics Co., Ltd. (the Applicant).

[2] The Application is based on proposed use of the Mark in Canada in association with the following goods:

Pharmaceutical preparations for the treatment of immunologic diseases, namely, autoimmune diseases, immunologic deficiency syndromes; pharmaceutical preparations comprising an anti-tumor necrosis factor (TNF) alpha monoclonal antibody (the Goods)

[3] The Application was filed on February 19, 2014 and claims a priority filing date of February 4, 2014 based on a corresponding application in Japan.

[4] Initially at the date of filing, the Application was based on both proposed use of the Mark in Canada as well as use and eventual registration of the Mark in Japan. However, on October 11, 2017, the Applicant amended the Application to delete the foreign use and registration basis.

[5] The primary issue in this proceeding is whether there is likelihood of confusion between the Mark and Ipsen Biopharm Ltd.'s trademark ONIVYDE which is the subject of Canadian application No. 1,657,388 in association with "pharmaceutical preparations for the diagnosis and treatment of cancer for human use".

[6] I note that the opposition proceeding was initiated by Merrimack Pharmaceuticals, Inc., the predecessor in title to Ipsen Biopharm Ltd. in respect of Canadian application No. 1,657,388. The statement of opposition was later amended to reflect Ipsen Biopharm Ltd. as the opponent and owner of that application. Consequently, reference in this decision to the "Opponent" is to Merrimack Pharmaceuticals, Inc. or Ipsen Biopharm Ltd., as appropriate based on the date concerned.

[7] For the reasons set out below, I reject the opposition.

THE RECORD

[8] The Application was advertised for opposition purposes in the *Trademarks Journal* on May 20, 2015.

[9] On July 20, 2015, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). I note that the Act was amended on June 17, 2019. All references in this decision are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act before it was amended (see section 70 of the Act, which provides that section 38(2) of the Act, as it read prior to June 17, 2019, applies to applications advertised before that date).

[10] The grounds of opposition are based on non-entitlement under section 16(3) of the Act, and non-compliance with sections 30(d) and 30(i) of the Act.

[11] On October 15, 2015, the Applicant filed a counter statement denying each ground of opposition.

[12] On July 5, 2017, the Opponent requested leave to file an amended statement of opposition to reflect Ipsen Biopharm Ltd. as the opponent and owner of application No. 1,657,388. Leave to amend was granted by the Registrar on September 19, 2017. Leave to amend the counter statement to similarly identify Ipsen Biopharm Ltd. was granted on January 30, 2018.

[13] In support of its opposition, the Opponent filed the following evidence:

- A certified copy of the Opponent's Canadian application No. 1,657,388 for the trademark ONIVYDE.
- The affidavit of Clara Rozee, an articling student employed by the Opponent's agent, sworn on November 22, 2016 (the Rozee Affidavit). The Rozee Affidavit attaches as Exhibit "A" a copy of the *Food and Drugs Act*, R.S.C., 1985, c. F-27 and as Exhibit "B" a copy of the *Food and Drug Regulations*, C.R.C., c. 870, respectively.

[14] Ms. Rozee was not cross-examined on her affidavit.

[15] The Applicant did not file any evidence.

[16] Both parties filed written arguments. No hearing was held.

ONUS AND MATERIAL DATES

[17] The Opponent has an initial evidential burden to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once that burden is met, the Applicant bears the legal onus of establishing, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155 (FCA)].

[18] The material dates with respect to each ground of opposition are as follows:

- Section 38(2)(a) / sections 30(d) and (i) of the Act – the filing date of the Application, namely, February 19, 2014 [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475]; and
- Section 38(2)(c) / section 16(3) of the Act – the priority filing date of the Application, namely, February 4, 2014 [*Earthrise Farms v Saretzky* (1997), 85 CPR (3d) 368 (TMOB) at paras 17-18].

GROUND OF OPPOSITION SUMMARILY DISMISSED

Section 30(d)

[19] At paragraph 1(b) of its amended statement of opposition, the Opponent pleads that the application does not conform to section 30(d) of the Act because the Mark had not been used in any country in association with the Goods as of the material date.

[20] However, since no evidence was filed by either party relating to the use of the Mark, the Opponent does not meet its initial evidential burden under this ground. In any event, this ground of opposition was rendered moot when the Applicant amended the Application on October 11, 2017 to delete the foreign use and registration basis.

[21] In view of the above, the section 30(d) ground of opposition is dismissed.

Section 30(i)

[22] Section 30(i) of the Act requires an applicant to include a statement in the application that the applicant is satisfied that it is entitled to use the trademark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant's statement untrue such as evidence of bad faith or non-compliance with a federal statute [see *Sapodilla Co v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155; and *Canada Post Corp v Canada (Registrar of Trade Marks)* (1991), 40 CPR (3d) 221 (Fed TD)].

[23] In determining whether an opponent has met its initial evidential burden for a ground of opposition based on section 30(i) of the Act in conjunction with non-compliance with a federal statute, this Board in the past has considered whether the opponent has made out a *prima facie* case of contravention of the federal statute, as opposed to determining that there has actually been contravention. For example, section 30(i) grounds of opposition were successful in *E Remy Martin & Co SA v Magnet Trading Corp (HK) Ltd* (1988), 23 CPR (3d) 242 (TMOB) after a *prima facie* case of copyright infringement under the *Copyright Act* was found, and in *Canada Post Corp v Metromail Corp* (1997), 84 CPR (3d) 511 (TMOB) based on a finding of a *prima facie* violation of the *Canada Post Corporation Act*.

[24] In the present case, the Opponent alleges that at the date of filing the Application, the Applicant was not and could not have been satisfied that it was entitled to register the Mark in Canada in view of the provisions of the *Food and Drug Regulations*, C.R.C., c. 870 (the Regulations), because the Mark would be confusing with another branded pharmaceutical. Specifically, the Opponent's argument is that the Mark is sufficiently similar to the Opponent's trademark ONIVYDE that use of the Mark in association with a pharmaceutical would violate the Regulations.

[25] Among the many steps required to obtain government approval to sell a pharmaceutical product in Canada, the Regulations provide for an assessment of the likelihood that a proposed pharmaceutical name would be mistaken for the name of another existing pharmaceutical for which approval has already been granted. As noted by the Opponent at paragraph 44 of its written argument, "[t]he purpose of the Regulations is to assess whether there would be any likelihood of a new drug to be mistaken for or resemble another brand name. The process and guidelines identified by Health Canada ensure the health and safety of the end user, the patient."

[26] In its written argument, the Opponent identifies provisions of the Regulations which it argues would be violated if the Applicant were to use the Mark in Canada in association with the Goods, including sections C.01.014 and C.08.002 of the Regulations. By way of example, the Opponent references section C.01.014.1(2) of the Regulations, which as of the date of the Rozee Affidavit read as follows:

C.01.014.1 (1) A manufacturer of a drug, a person authorized by a manufacturer or, in the case of a drug to be imported into Canada, the importer of the drug may make an application for a drug identification number for that drug.

(2) An application under subsection (1) shall be made to the Director in writing and shall include the following information and material:

(a) the name of the manufacturer of the drug as it will appear on the label;

[...]

(f) the brand name under which the drug is to be sold;

[...]

(o) in the case of a drug for human use, an assessment as to whether there is a likelihood that the drug will be mistaken for any of the following products due to a resemblance between the brand name that is proposed to be used in respect of the drug and the brand name, common name or proper name of any of those products:

(i) a drug in respect of which a drug identification number has been assigned,

(ii) a radiopharmaceutical, as defined in section C.03.201, in respect of which a notice of compliance has been issued under section C.08.004 or C.08.004.01, and

(iii) a kit, as defined in section C.03.205, in respect of which a notice of compliance has been issued under section C.08.004 or C.08.004.01.

[Emphasis added]

[27] The Opponent also references section C.08.002(2) of the Regulations, which as of the date of the Rozee Affidavit included an equivalent provision to that underlined in section C.01.014.1(2), above.

[28] However, in this proceeding, the Opponent has not provided any evidence with which to assess whether there may be a *prima facie* violation of any provision of the Regulations. Indeed, the Opponent's only evidence on this issue consists of copies of the *Food and Drugs Act* and the Regulations themselves. For example, as a threshold issue with respect to section C.01.014.1(2) of the Regulations, the Opponent has not provided any evidence that it sells, or has applied for or obtained approval to sell in Canada a drug having a drug identification number under the name ONIVYDE (or a radiopharmaceutical or a kit under that name), to which a product might be compared under section C.01.014.1(2) of the Regulations. The Opponent having filed a trademark application in Canada to register the trademark ONIVYDE does not itself demonstrate those facts (nor does the fact that trademark application proceeded to registration). In sum, the

Opponent has provided no evidence to demonstrate a *prima facie* violation of any provision of the Regulations and consequently the Opponent has not met its initial evidential burden under section 30(i). This ground of opposition is therefore dismissed.

[29] In addition, it is worth noting at this stage that the issues addressed by the Regulations are different from those addressed under section 6 of the *Trademarks Act*. As noted by the Opponent in its written argument, the provisions of the Regulations on which it relies are directed at preventing medication error due to mistake arising from pharmaceutical names. Section 6 of the *Trademarks Act* is directed at consumer confusion as to the *source* of goods. While mistake and source confusion are not mutually exclusive, they are also not synonymous. Consequently, the analysis below regarding a likelihood of confusion under section 6 of the *Trademarks Act* for the purposes of evaluating the section 16(3) ground of opposition should be considered to have no bearing on any evaluation of the two parties' trademarks that might take place under the *Food and Drugs Act* or Regulations.

SECTION 16(3) GROUND OF OPPOSITION

[30] At paragraph 1(a) of its amended statement of opposition, the Opponent pleads that the Applicant is not the party entitled to registration of the Mark under section 16(3) of the Act, because it is confusing with the Opponent's trademark ONIVYDE which is the subject of the previously filed Canadian application No. 1,657,388. In this regard, the Opponent can rely only on section 16(3)(b) of the Act, as it has not plead any facts or filed any evidence relating to grounds of opposition under sections 16(3)(a) or (c) of the Act.

[31] The Opponent included in its evidence a certified copy of Canadian application No. 1,657,388. The Opponent's application was filed on December 20, 2013, claiming priority to a United States application filed on June 26, 2013, and thus precedes the priority filing date of the Applicant's Application. The Opponent's application was still pending on the date the Applicant's Application was advertised.

[32] The above is sufficient for the Opponent to meet its initial evidential burden under the section 16(3)(b) ground of opposition. Therefore, the Applicant must establish, on a balance of

probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's trademark.

[33] I note that the Opponent's application for the trademark ONIVYDE subsequently matured to registration (TMA1,040,753) on July 12, 2019. However, that has no bearing on the Opponent's section 16(3)(b) ground of opposition, since the Opponent's application was still pending when the Applicant's Application was advertised. Also, the Opponent has not included a section 12(1)(d) ground of opposition seeking to rely on its registration.

The test for confusion

[34] The test to determine the issue of confusion is set out in section 6(2) of the Act which provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them.

[35] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

[36] The test for confusion is assessed as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the applicant's mark, at a time when he or she has no more than an imperfect recollection of the opponent's trademark, and does not pause to give the

matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot, supra*, at para 20].

Inherent distinctiveness of the trademarks and the extent they have become known

[37] Neither the Applicant's Mark nor the Opponent's trademark has a dictionary meaning in English or French. There is no evidence that either mark has any descriptive connotation in association with the goods concerned. Both marks appear to be coined terms. Thus, both parties' trademarks have a high degree of inherent distinctiveness.

[38] There is no evidence that either party's trademark has been used or otherwise become known in Canada to any extent.

Length of time the trademarks have been in use

[39] As noted above, there is no evidence that either party's trademark has been used in Canada. Consequently, this factor favours neither party.

Nature of the goods and nature of the trade

[40] When considering the goods of the parties, it is the statement of goods in the parties' trademark applications that govern the issue of confusion [*Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); and *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful, particularly where there is an ambiguity as to the goods or services covered in the application or registration at issue [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Proctor & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[41] The parties' goods are related in that they are both pharmaceuticals for human use [see *Servier Canada Inc v American Home Products Corp* (1997), 79 CPR (3d) 539 (TMOB) at para

10]. While there is no evidence that the specific treatment indications overlap, in the absence of any evidence from the parties to the contrary, I assume that both parties' goods would be marketed and sold through the same channels of trade to doctors, pharmacists and patients.

[42] Consequently, this factor favours the Opponent.

Degree of resemblance in appearance, sound and idea

[43] There is a degree of resemblance between the marks visually. Both marks are comprised of seven letters beginning with "ON", and both marks share the letters "I", "V" and "D", albeit in a different order.

[44] When sounded, in my view, the marks as a whole are quite different. While they share the component "ON", the remaining portions of each mark, namely, "IVYDE" and "VIADA", sound quite different.

[45] While the first portion of a mark will in some cases be the most significant when assessing a likelihood of confusion [see *Conde Nast Publications Inc. v Union des Editions Modernes* (1979), 46 CPR (2d) 183 at 188 (FCTD)], the resemblance must be assessed with a consideration of whether there is an aspect of the mark that is particularly striking or unique [see *Masterpiece, supra*, at para 64]. In the present case, in my view, the striking element of each party's mark is the coined word that comprises each mark in its entirety, rather than the letters "ON".

[46] With respect to the idea conveyed, since both marks are coined terms without any dictionary meaning or descriptive connotation, neither mark conveys a particular idea and so there is no resemblance in the ideas conveyed.

Conclusion regarding the likelihood of confusion

[47] The analysis of a likelihood of confusion is to determine whether, as a matter of first impression, a typical Canadian consumer somewhat in a hurry would think that goods bearing the two parties' marks come from the same source. While there is some visible similarity between the marks ONIVYDE and ONVIADA due to shared letters, when the marks are

considered as a whole, in my view, the similarities are not ones which would likely give rise to consumer confusion as to the source of the goods.

[48] In particular, in the absence of evidence from the Opponent to the contrary, I do not think the shared letters “ON” at the beginning of the respective parties’ marks is sufficient to suggest to consumers that the marks indicate products from the same source, given the differences in the remaining portions of each party’s mark. Moreover, each mark is a coined term with its own inherent distinctiveness, and as a whole the marks are quite different when sounded.

[49] Taking into account all of the circumstances contemplated by section 6(5) of the Act, I am satisfied that the Applicant has met its legal burden to demonstrate on a balance of probabilities that there is no reasonable likelihood of confusion.

[50] Accordingly, the section 16(3) ground of opposition is dismissed.

DISPOSITION

[51] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

Timothy Stevenson
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE No Hearing Held

AGENTS OF RECORD

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