

CANADA / JUDGMENT

Novopharm Limited v. Astrazeneca Ab

2001 FCT 645

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Federal Court

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Novopharm Limited v. Astrazeneca Ab

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Ottawa, Ontario, Tuesday the 12th day of June 2001

PRESENT: The Honourable Madam Justice Dawson

BETWEEN:

NOVOPHARM LIMITED

Applicant

- and -

ASTRAZENECA AB

- and -

THE REGISTRAR OF TRADE-MARKS

Respondents

REASONS FOR ORDER AND ORDER

DAWSON J.

- [1] In these two applications Novopharm Limited ("Novopharm") brings appeals, pursuant to subsection 56(1) of the Trade-marks Act, R.S.C. 1985, c. T-13 ("Act") from decisions of Myer Herzig, a member of the Trade-marks Opposition Board ("Registrar"), made on June 14, 1999. In each of these decisions the Registrar rejected Novopharm's opposition to an application made by Astrazeneca AB, or its predecessor, (together referred to as "Astra") to register a trade-mark.
- [2] By order of the Court these applications were set down for hearing on the same date. While no order had been made pursuant to Rule 105 of the Federal Court Rules, 1998, counsel for the parties both argued the applications together upon the records filed in each proceeding. Most of the evidence was identical. As the matters were argued together, I am issuing one set of reasons applicable to both proceedings.
- [3] In T-1470-99, Novopharm appeals the Registrar's decision rendered in trade-mark application no. 699,918. In T-1471-99, Novopharm appeals the Registrar's decision rendered in trade-mark application no. 699,917.

THE PROCEEDINGS BEFORE THE REGISTRAR

i) Application no. 699,918 ("918 proceeding")

- [4] In this application, made on February 28, 1992, Astra sought registration of the mark TABLET DESIGN (red-brown) based on proposed use in Canada in association with "pharmaceutical preparations namely, felodipine". The mark was described in the application as follows:

The trade-mark as [sic] shown in the attached drawing and consists of a red-brown colour applied to the whole of the visible surface of the tablet, as shown in the specimens affixed to the application. The tablet shown in dotted outline does not form part of the trade-mark.

- [5] The drawing referred to consisted of two perspectives, a top view and a side view, of a round, biconvex tablet, the outline of which was shown by a dotted line. The area inside each outline was shaded with a dense pattern of small dots.
- [6] Novopharm's statement of opposition was filed on September 14, 1993 and the grounds of opposition were stated as follows:

- (a) The Opponent bases its opposition on the grounds provided by Section 38(2)(c) of the Trade Marks Act (hereinafter 'the Act'), namely that the application does not comply with S. 30 in the following respects:
- (i) The alleged trade mark is not a trade mark;
 - (ii) The application does not include a drawing of the trade mark by the applicant.
- (b) The Opponent bases its opposition on the grounds provided by Section 38(2)(c) of the Act, namely, that even if the alleged trademark is a trademark, the Applicant is not the person entitled to the registration pursuant to S. 16(3) in that it was confusingly similar with trademarks namely, red-brown tablets that had previously been used in Canada by persons other than the applicant.
- (c) The Opponent bases its opposition on the grounds provided by S. 38(2)(d) in that the trade mark is not distinctive in that it does not distinguish, nor is it adapted to distinguish the wares of the applicant from those of others. Red-brown tablets were and are at all material times common to the trade and had been used by others so that the wares of the applicant cannot be distinguished from others, inter alia, the tablets of:

Apotex Inc.

Boehringer Ingelheim (Canada) Ltd.

Merrell Dow Pharmaceuticals (Canada) Inc.

[7] In its counter-statement Astra denied each ground of opposition. In respect of opposition ground (a) Astra asserted that "[t]hese grounds of opposition are speculative or incorrect"; in respect of ground (b) that the "statement of opposition does not contain sufficient detail to enable the applicant to reply thereto"; and in respect of ground (c) Astra objected that "the shape and particular drug of any tablet referred to ... are not set out and accordingly it is not possible to fully respond thereto".

[8] Ground (b) was withdrawn by counsel for Novopharm at the oral hearing before the Registrar.

[9] In rejecting Novopharm's opposition the Registrar wrote that:

With respect to the ground of opposition denoted by (a)(i) above, the applicant submits that the opponent has not provided any facts to explain why the applied for trade-mark is not a trade-mark. The applicant therefore contends that the opponent's pleading contravenes Section 38(3) (a) of the Trade-marks Act which requires a ground of opposition to be set out in sufficient detail to enable the applicant to reply thereto. I agree with the applicant: see, for example, *Novopharm Ltd. v. Hoechst Aktiengesellschaft* (1997), 76 C.P.R. (3d) 257 at 261 (TMOB).

With respect to the ground of opposition denoted by a(ii) above, the application does in fact include a drawing namely, two perspectives of the applied for mark. Further, the drawings, together with the written description of the mark and specimens on file, are adequate to describe the mark: see *Novopharm Ltd. v. Bayer* 1996, 76 C.P.R. (3d) 560 at 566-567 (TMOB); *Novopharm Ltd. v. Glaxo Wellcome* (May 28, 1999, yet unreported, at p. 6, (TMOB)). Thus, the ground of opposition denoted by a(ii) is rejected.

[...]

With respect to the third ground of opposition denoted by (c) above, the applicant argues as follows at paragraph 33 of its written argument.

33. With respect to paragraph 1(c), namely, that, the trade-mark is not distinctive since it does not distinguish nor is it adapted to distinguish the wares of the Applicant from those of others as red-brown tablets were and are at all material times common to the trade and have been used by others so that the wares of the Applicant cannot be distinguished from the wares of other named pharmaceutical manufacturers, this allegation similarly does not provide sufficient detail to enable the Applicant to reply thereto. Of the three companies referred to there is no indication of any specific pharmaceutical products relied on (i.e. which red-brown tablets), the active ingredients therein, the shape thereof, or of any circumstances relevant to when, where or in what quantity such red-brown tablets were used.

Again, I must agree with the applicant. In my view, the applicant should not be faced with the burden of investigating what products are sold by third parties in an attempt to discover which red-brown tablets the opponent may possibly be referring to. If I am wrong in this, then I find that the opponent has not supported the allegations in the statement of opposition. That is, there is no quantitative evidence, and insufficient qualitative evidence, of sales or use of any pharmaceutical tablets which have a colour and shape combination resembling the applied for mark.

I would add that at the oral hearing counsel for the opponent vigorously pursued the issue of non-distinctiveness of the applied for mark based on marketplace use of pharmaceutical tablets not cited or alluded to in the statement of opposition, and based on allegations of improper licencing of the applied for mark to Hoechst-Roussell Canada Inc., also absent from the opponent's pleadings. In respect of the above, the opponent's arguments were based on Stephen Wilton's affidavit evidence filed on behalf of the applicant, and on Mr. Wilton's testimony elicited at his cross-examination. The opponent might, of course, have requested leave to amend its pleadings pursuant to Section 40 of the Trade-marks Regulations after reviewing Mr. Wilton's affidavit evidence and/or oral testimony, but neglected to do so. In the circumstances, I am unable to consider grounds of opposition not pleaded: see *Imperial Developments Ltd. v. Imperial Oil Limited* (1984), 79 C.P.R. (2d) 12 at pp 19-21 (F.C.T.D.)

In view of the above, the opponent's opposition is rejected.

(ii) Application no. 699,917 ("917 proceeding")

[10] In this application, also made on February 28, 1992, Astra sought registration of the mark PINK TABLET Design, based on proposed use in Canada in association with "pharmaceutical preparations namely, felodipine". The mark was described in the application as follows:

The trade-mark is shown in the attached drawing and consists of a pink colour applied to the whole of the visible surface of the tablet, as shown in the specimens affixed to the application. The tablet shown in dotted outline does not form part of the trade-mark.

[11] The drawing was identical to that contained in the '918 proceeding.

[12] Novopharm's statement of opposition was filed on February 16, 1993 and the grounds of opposition were stated as follows:

(a) The Opponent bases its opposition on the grounds provided by Section 38(2)(c) of the Trade Marks Act, R.S. 1985, c. T-13 (hereinafter "the Act"), namely that the application does not comply with S. 30 of the Act in the following respects:

(i) The alleged trade mark is not a trade mark;

(ii) The alleged trade mark has not been used with the wares referred to in application since the date claimed; and

(iii) The application does not include a drawing of the applicant's alleged trade mark.

(b) The Opponent bases its opposition on the grounds provided by Section 38(2)(c) of the Act, namely, that even if the Applicant's alleged mark were a trade mark, the Applicant is not the person entitled to registration thereof pursuant to S. 16(1) in that at the date of first use, it was confusingly similar with trade marks namely pink tablets that had previously been used in Canada by the Opponent.

(c) The Opponent bases its opposition on the grounds provided by S. 38(2)(d) in that the trade mark is not distinctive since it does not distinguish and is not adapted to distinguish the wares of the applicant from those of others. Pink tablets were and are at all material times common to the trade and had been used by others so that the wares of the applicant are and cannot be distinguished from others, inter alia, the tablets of:

[a list of 26 companies]

[13] In its counter-statement Astra denied each ground of opposition. In respect of opposition ground (a) Astra asserted that "these grounds of opposition are speculative or incorrect"; in respect of ground (b) that the "statement of opposition does not contain sufficient detail to enable the applicant to reply thereto ..."; and in respect of ground (c) Astra objected that "the shape and particular drug of any tablet referred to ... are not set out and accordingly it is not possible to fully respond thereto".

[14] In rejecting Novopharm's opposition the Registrar wrote that:

With respect to the ground of opposition denoted by (a)(i) above, the applicant submits that the opponent has not provided any facts to explain why the trade-mark applied for is not a trade-mark. The applicant therefore contends that the opponent's pleading contravenes Section 38(3)(a) of the Trade-marks Act which requires a ground of opposition to be set out in sufficient detail to enable the applicant to reply thereto. I agree with the applicant: see, for example, *Novopharm Ltd. v. Hoechst Aktiengesellschaft* 1997, 76 C.P.R. (3d) 257 at 261 (TMOB). With respect to the ground of opposition denoted by a(ii) above, the subject application is based on proposed use in Canada and therefore ground a(ii) does not raise a proper ground of opposition. With respect to the ground of opposition denoted by a(iii) above, the opponent again submits that the pleading contravenes Section 38(3)(a) of the Act. I agree. If I am wrong in this, then I am required to consider the applicant's submissions that (1) the drawing of the mark is not lined for the colour pink in accordance with the colour chart in the Trade-marks Regulations, and that (2) markings on the applicant's tablets form an integral part of the tablet for the purpose of identifying the tablet. In my view, the application as filed clearly describes pink as a feature of the mark and therefore the applicant is not obliged to follow the colour scheme set out in the Regulations: see Section 28 of the Regulations. As regards markings on the applicant's tablets, a close inspection of the specimen tablets reveals that they are inscribed with the letters AFM on one side of the tablet. However, that by itself is insufficient to negate the sufficiency of the drawings (and the description of the mark) as set out in the subject application: see *Novopharm Ltd. v. Bayer* 1996, 76 C.P.R. (3d) 560 at 566-567 (TMOB). Thus, each of the grounds of opposition a(i) to a(iii) are rejected.

At paragraphs 38 and 39 of its written argument, reproduced below, the applicant discusses its pleadings in the counter statement that the remaining grounds of opposition, denoted by (b) and (c) above, provide insufficient details for the applicant to frame a proper denial:

38. With respect to the ground in paragraph 1(b), namely, that, even if the Applicant's alleged mark were a trade-mark, the Applicant was not the person entitled to registration thereof in accordance with section 16(1) [sic] in that at the date of first use, it was confusingly similar with the trade-mark namely, pink tablets that had been previously used in Canada by the Opponent, this allegation is also non-sensical, bare and ambiguous. The application is based on proposed use. Furthermore, while the Opponent asserts its own use of pink tablets, the Opponent has failed to supply any facts relating to which specific pharmaceutical products the Opponent relies on (i.e. which pink tablets), the active ingredient therein, the shape or the date of the use thereof. Viewed objectively, this paragraph does not provide the Applicant sufficient detail to enable the Applicant to reply thereto and therefore should be rejected.
39. With respect to paragraph 1(c), namely, that, the trade-mark is not distinctive since it does not distinguish and is not adapted to distinguish the wares of the Applicant from those of others as pink tablets were and are at all material times common to the pharmaceutical trade and have been used by others so that the wares of the Applicant are and cannot be distinguished from the wares of other named pharmaceutical manufacturers, this allegation similarly

does not provide sufficient detail to enable the Applicant to reply thereto. Of the total number of companies referred to there is no indication of any specific pharmaceutical products relied on (i.e. which pink tablets) the active ingredient therein, the shape thereof, or of any circumstances relevant to when, where or in what quantity such pink tablets were used.

Again, I must agree with the applicant. In my view, the applicant should not be faced with the burden of investigating what products are sold by the opponent, and by third parties, in an attempt to discover which pink tablets the opponent may possibly be referring to. If I am wrong in this, then I find that the opponent has not supported the allegations in the statement of opposition. That is, there is no quantitative evidence, and insufficient qualitative evidence, of sales or use of any pharmaceutical tablets which have a colour and shape combination resembling the applied for mark.

In view of the above, the opponent's opposition is rejected.

[15] While in the '917 proceeding there is no indication in the Registrar's decision that ground of opposition (b) was withdrawn at the oral hearing (as was noted by the Registrar in his decision in the '918 proceeding), on this appeal no error was alleged in the Registrar's decision with respect to ground of opposition (b).

[16] Similarly, with respect to ground a(ii) in the '917 proceeding, no error was alleged in the Registrar's conclusion that non-use is not a proper ground of opposition to an application based on proposed use.

ISSUES

[17] Novopharm raised the following issues in each application now before the Court:

1. Is the mark applied for a trade-mark, as defined by the Act?;
2. Did Astra comply with subsection 30(h) of the Act by providing a proper drawing?; and
3. Is the mark distinctive of Astra?

[18] Astra framed the issues somewhat differently, stating that the first and threshold issue is whether Novopharm has established any error in the findings made by the Registrar that its statements of opposition were deficient, and if so, whether Novopharm has established the merits of its grounds of opposition.

STANDARD OF REVIEW

[19] In *Novopharm Ltd. v. Bayer Inc.* (2000), 9 C.P.R. (4th) 304 (F.C.A.), the Court of Appeal confirmed that the standard of review applicable to the Registrar's decision is as stated by the majority of the Court in *Molson Breweries, a Partnership v. John Labatt Ltd.* (2000), 5 C.P.R. (4th) 180 (F.C.A.). That standard was expressed as follows:

Even though there is an express appeal provision in the Trade-marks Act to the Federal Court, expertise on the part of the Registrar has been recognized as requiring some deference. Having regard to the Registrar's expertise, in the absence of additional evidence adduced in the Trial Division, I am of the opinion that decisions of the Registrar, whether of fact, law or discretion, within his area of expertise, are to be reviewed on a standard of reasonableness simpliciter. However, where additional evidence is adduced in the Trial Division that would have materially affected the Registrar's findings of fact or the exercise of his discretion, the Trial Division judge must come to his or her own conclusion as to the correctness of the Registrar's decision.

- [20] Where additional evidence is adduced on appeal, the Court of Appeal has directed that in order to determine the appropriate standard of review this Court must first determine whether the additional evidence would have materially affected the Registrar's findings of fact or the exercise of his discretion.
- [21] In the appeals now before the Court new evidence was tendered. That evidence was described by the appellant to be significant quantitative and qualitative evidence as to the sales and use of pharmaceutical tablets said to have a colour and shape combination resembling the marks applied for. It was submitted by Novopharm that this evidence was relevant to issues a(i) and (c) which are common to both the '917 and '918 proceedings.
- [22] The first question to be addressed therefore is whether the additional evidence would have materially affected the Registrar's findings. Those findings may be summarized as follows.
- [23] In the '918 proceedings, the Registrar rejected opposition ground a(i) because Novopharm's pleadings contravened paragraph 38(3)(a) of the Act; rejected opposition ground a(ii) because the application contained a drawing and that it, together with the written description of the mark and specimens on file, were adequate to describe the mark; and rejected opposition ground (c) because Novopharm's allegation did not provide sufficient detail so as to enable Astra to respond to it.
- [24] While with respect to ground (c) the Registrar went on to consider whether Novopharm had supported the allegations in its statement of opposition, and found that it had not, that analysis and conclusion was stated to be made in the event that the Registrar had committed a reviewable error in his conclusion on the adequacy of the pleadings. It was therefore an alternate ground which must only be considered if the Registrar committed a reviewable error in reaching his conclusion on the adequacy of the pleading.
- [25] Setting aside that alternate conclusion and having regard to the Registrar's reasons and the nature of the new evidence, I conclude that with respect to the '918 proceeding the new evidence would not have affected the Registrar's findings of fact or his discretion. Therefore, so long as the Registrar's decisions were within his area of expertise, they are to be reviewed on a standard of reasonableness simpliciter.

- [26] This standard requires the Court to subject the Registrar's reasons to a somewhat probing examination for the purpose of determining whether the Registrar's decision can be said to be clearly wrong: *Canada (Director of Investigation and Research) v. Southam Inc.*, [1997] 1 S.C.R. 748 at paragraphs 56 to 60.
- [27] As for the '917 proceeding, the Registrar rejected ground a(i) because Novopharm's pleading contravened paragraph 38(3)(a) of the Act; rejected opposition ground a(ii) because it was not a proper ground of opposition; rejected ground a(iii) because the pleading contravened paragraph 38(3)(a) of the Act; and rejected opposition ground (c) because Novopharm's allegation did not provide sufficient detail to enable Astra to reply to it. Again, the Registrar provided alternate conclusions to support his rejection of grounds (a)(iii) and (c), but those alternate grounds need only be examined in the event that the Registrar committed a reviewable error when reaching the primary basis for rejecting either ground.
- [28] Looking at the primary grounds for his decision and having regard to the Registrar's reasons and the nature of the new evidence, I am again satisfied that the additional evidence would not have affected the Registrar's findings of fact or his discretion. Therefore, in considering the Registrar's decision in the '917 proceeding, so long as the Registrar's decisions were within his area of expertise, they are to be reviewed on a standard of reasonableness simpliciter.
- [29] As for the nature of the Registrar's area of expertise, in *Novopharm Ltd. v. Bayer Inc.*, [2000] 2 F.C. 553 (F.C.T.D.), *aff'd* (2000), 9 C.P.R. (4th) 304 (F.C.A.) Evans J., as he then was, observed at paragraph 35 that he would give considerable weight to the decision of the Registrar on the interpretation of the drawing and verbal description of a proposed trade-mark. In *Molson Breweries, a Partnership v. John Labatt Ltd.*, *supra*, Rothstein J.A. for the Court noted that the Registrar has expertise and that the opinion of the Registrar on the interpretation of the Act is entitled to some deference. That expertise was held to not extend to the proper construction of section 45 of the Act by Rothstein J.A. for the Court in *Lang Michener v. United Grain Growers Ltd.*, [2001] F.C.J. No. 437, 2001 FCA 66 (F.C.A.) at paragraph 9.
- [30] In the present case, the Registrar's decisions related in substance to determining the adequacy of the content of Novopharm's statement of opposition and to the interpretation of the drawing and verbal description of the proposed mark.
- [31] A determination of the adequacy of a statement of opposition involves interpreting the requirement of paragraph 38(3)(a) of the Act and determining on the facts before the Registrar whether the grounds of opposition provide sufficient detail to enable an applicant to reply thereto. This involves a question of mixed fact and law which in every case will be very fact-specific with little precedential value. This determination goes to the heart of the regulation of practice and procedure in opposition proceedings. I therefore find issues of the adequacy of a statement of opposition to be within the expertise of the Registrar.

- [32] Similarly, as noted by Evans J. in *Bayer*, supra, the interpretation of the drawing and verbal description of a trade-mark relates to practice and procedure followed by the Trade-marks Office with respect to trade-mark applications. This, I find, is also within the expertise of the Registrar.
- [33] It follows, in my view, that the primary bases of the Registrar's decisions are to be reviewed on the standard of reasonableness simpliciter.

ANALYSIS

- [34] Because these matters were argued together and raise essentially the same issues, and because I have concluded that each impugned decision of the Registrar attracts the same standard of review, I think it most convenient to deal with the issues in order as they relate to each proceeding.

Opposition Ground a(i) in both proceedings

- [35] As set out above, this ground was expressed identically in each statement of opposition. The Registrar found that each assertion that "[t]he alleged trade mark is not a trade mark" contravened paragraph 38(3)(a) of the Act.
- [36] Section 38 of the Act prescribes the procedure to be followed by a party who opposes an application for the registration of a trade-mark and the procedure to be followed to deal with that opposition. Subsection (3) deals with the content of a statement of opposition, and as previously noted, paragraph (a) requires a statement of opposition to set out "the grounds of opposition in sufficient detail to enable the applicant to reply thereto".
- [37] Novopharm argued that the pleading provided sufficient detail because it was clear that Astra understood what was at issue. Novopharm also asserted that the Registrar erred in disposing of the issue on a technical ground because Astra did not raise the issue of insufficiency in its counter-statement.
- [38] As to Novopharm's first point, I am not satisfied that even if Astra did understand the basis on which it was asserted that the alleged trade-mark was not a trade-mark, that the Registrar's decision was unreasonable. Irrespective of the parties' dealings, the Registrar cannot, in my view, be said to have been clearly wrong by requiring compliance with the statute.
- [39] Paragraph 38(3)(a) of the Act ensures compliance with the basic requirement of fairness that each party be informed of the case to be met: *Carling Breweries Ltd. v. Molson Companies Ltd. et al.* (1984), 1 C.P.R. (3d) 191 (F.C.T.D.). The paragraph also ensures that an applicant can make a properly informed decision as to whether to abandon the application, and ensures that new issues or positions are not taken on any appeal to this Court. This Court has in the past held that an appeal is limited to issues raised before the Registrar: *McDonald's Corp. v. Coffee Hut Stores Ltd.* (1994), 76 F.T.R. 281 (T.D.) at page 286; *aff'd* (1996),

68 C.P.R. (3d) 168 (F.C.A.).

- [40] As to Novopharm's second point, that Astra did not raise this concern in its counter-statement, I accept the submission made on Astra's behalf that it was reasonably open to the Registrar to determine whether the statutory requirement was met.
- [41] The Registrar's conclusion that the requirement of the paragraph was not met was, I find, reasonable and not clearly wrong. The conclusion was made in accordance with jurisprudence of this Court: see *Benson & Hedges (Canada) Ltd. v. Imasco Ltd.* (1976), 25 C.P.R. (2d) 269 (F.C.T.D.) at page 272.

Opposition Ground a(ii) in the '918 proceeding

- [42] In response to Novopharm's opposition based on the ground that the application did not include a drawing of the trade-mark as required by subsection 30(h) of the Act, the Registrar concluded that the application did include a drawing and that it, together with the written description of the mark and specimens on file, were adequate to describe the mark. While Astra submitted that the Registrar disposed of this issue on the basis of the adequacy of the pleadings (as he disposed of the identical issue in the '917 proceeding) I am not prepared to ignore the Registrar's express recitation of his reasons.
- [43] In arguing that the Registrar erred, Novopharm noted that the burden was on Astra to show compliance with subsection 30(h) of the Act which requires:
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;
30. Quiconque sollicite l'enregistrement d'une marque de commerce produit au bureau du registraire une demande renfermant_:
- [...]
- h) sauf si la demande ne vise que l'enregistrement d'un mot ou de mots non décrits en une forme spéciale, un dessin de la marque de commerce, ainsi que le nombre, qui peut être prescrit, de représentations exactes de cette marque;

Reliance was placed upon the conclusion of Evans J. in *Bayer*, supra, at paragraph 50 where he stated:

[...] when the state is granting a monopoly, competitors and the public at large are entitled to insist on strict compliance with the terms of the legislation authorizing the grant. There is a public interest in ensuring the accuracy of the Register as a public record of trade-marks that

extends beyond whether there is any immediate likelihood of confusion. The rights enforceable in the future by a trade-mark holder are defined by the terms of the application as registered, including the drawing, and competitors ought to be able to regard the terms of the registration as definitive of the registrant's legal rights.

- [44] Novopharm argued that the Registrar erred because the lines on the application did not indicate either a red or brown colour as stipulated in section 28 of the Trade-marks Regulations; because the Registrar erred in relying upon the specimens on file to determine the adequacy of the drawings; and because while the description indicated a mark for a colour and a particular shape, the application stated that the tablet shown in dotted outline was not part of the trade-mark. Novopharm noted that the applicant referred to the "whole of the visible surface" which suggested that the tablet should be entirely red-brown and without markings.
- [45] Despite Novopharm's argument, I have not been persuaded that the Registrar's conclusion should be interfered with.
- [46] The colour applied for was described by Astra in its application as "red-brown". Contrary to Novopharm's assertion that the drawing is contrary to section 28 of the Trade-marks Regulations, the colour chart in subsection 28(2) does not offer an applicant for a trade-mark the option of marking specifically a "red-brown" colour. Had Astra hatched the diagram with either a vertical line denoting the red colour, or a line slanted to the right denoting the colour brown, the result would be inaccurate and contradictory with the verbal description. Instead, Astra applied an undefined pattern of dots and described the colour in the description of the trade-mark. The Registrar accepted this as adequate and I see nothing clearly wrong in his conclusion.
- [47] Similarly, I do not find the applicant's assertion that the drawing is inadequate because the description indicates that the mark is for a colour and a shape, but the application states that the tablet shown in dotted outline is not part of the trade-mark, persuasive. This argument was rejected by Evans J. in *Bayer*, supra, at paragraphs 32 to 36 as follows:
- [32] Novopharm alleges that the application could be understood to be claiming the colour dusty rose as the mark because the drawing included with the verbal description stated that the "tablet shown in dotted outline does not form part of the trade-mark". If this is so, then the application is defective because a colour alone cannot constitute a trade-mark: *Wampole & Co. v. Hervay Chemical Corp. of Canada*, [1929] Ex. C.R. 78, aff'd [1930] S.C.R. 336.
- [33] I find no merit in this contention. The words just quoted from the verbal description of the application are intended to indicate that the mark claimed is not the table itself, but only the colour as applied to its outer surfaces as shown in the specimen filed with the Trade-marks Office.

- [34] It is apparent from another somewhat similar case, *Novopharm Ltd. v. Astra Aktiebolag*, [1997] T.M.O.B. No. 303, that the words, "tablet shown in dotted line does not form part of the trade-mark", are included at the instance of the Office for the purpose explained above. In my opinion, they are quite apt to make the intended distinction between the product itself and its physical properties of shape and outward colour.
- [35] Further, if I had any doubt on this issue I would have given considerable weight to the Registrar's opinion since it relates to a matter of practice and procedure followed by the Office with regard to trade-mark applications.
- [36] Hence, I find no error in the Registrar's conclusion that the mark applied for was not limited to colour, but was for the colour dusty rose as applied to the whole of the outside of the tablets shown in the specimen.
- [48] In my view, the words now impugned by Novopharm are apt to make the intended distinction between the tablet itself and its physical properties of shape and outward colour. As to the markings on the tablet, it was common ground before me that in Canada all pharmaceutical medications contain some identifying markings. This was not an impediment to the registration of the trade-mark in the *Novopharm Ltd. v. and Bayer*, *supra*.
- [49] Given that the verbal description and the drawings were neither inconsistent nor inaccurate I do not find that the Registrar erred by referencing the specimens.

Opposition Ground a(iii) in the '917 proceeding

- [50] The Registrar found that Novopharm's objection to the drawing contravened paragraph 38(3) (a) of the Act, and then in the event that such conclusion was wrong went on to consider the merits of Novopharm's objection. While I agree that it was somewhat anomalous to dispose of the issue on a technical basis in this proceeding when the Registrar did not in the '918 proceeding, I cannot find that the Registrar's conclusion that the objection was nothing more than a bare assertion and hence in contravention of paragraph 38(3)(a) of the Act was clearly wrong.
- [51] Moreover, I am satisfied that the Registrar's alternate conclusion on this ground was not clearly wrong.
- [52] What was significantly different about the drawing in this proceeding arises from the fact that the colour chart in subsection 28(2) of the Trade-marks Regulations contains a visual representation for the colour pink. Here, the tablet was verbally described to be pink and was visually depicted in the drawing by a dense pattern of dots. The colour chart in subsection 28(2) provides that a vertical hatching, not dots, be applied to designate the colour red or pink.

- [53] The Registrar relied upon the clear verbal description "pink" and the fact that subsection 28(2) of the Trade-marks Regulations provides that the colour chart is to be used where the description "is not clear" so as to conclude that the drawing complied with the Act. As noted, I am satisfied that conclusion of the Registrar was not clearly wrong.
- [54] It should be noted that the dense pattern of dots used in the drawing has no significance in the colour chart. This is distinguishable from the situation before Evans J. in Bayer, supra, where the tablet was described to be pink, but was depicted as blue because the cross-hatching was that used in the colour chart in subsection 28(2) to depict blue.

Opposition Ground (c) in both proceedings

- [55] In each proceeding Novopharm objected that the trade-mark was not descriptive because the coloured tablets were common to the trade and could not be distinguished from "others, inter alia, the tablets of" a number of listed pharmaceutical companies.
- [56] The Registrar concluded that this allegation provided insufficient detail and that the applicant should not be required to investigate what products are sold by third parties to discover what coloured tablets the opponent was referring to.
- [57] Astra had in its counter-statement clearly complained that it could not respond to this ground of application without particulars of the shape and specific drugs referred to.
- [58] I am not able to conclude that the Registrar was clearly wrong in disposing of the objection on this basis. Novopharm's listing of pharmaceuticals was not exhaustive, as shown by its inclusion of the phrase "inter alia". Moreover, without indication of any specific product relied upon, or of any of the circumstances relevant to when, where, or in what quantities tablets were used I fail to see how Astra was to know the case to be met and be able to reply to it. It follows, in my view, that the Registrar's conclusion cannot be said to be clearly wrong.
- [59] That conclusion is, I find, dispositive of Novopharm's appeal on this ground. While on this appeal Novopharm adduced substantial new evidence relevant to the Registrar's alternate conclusion that the opponent had not supported the allegations in the statement of opposition, in my view I would only be free to consider that evidence if satisfied that the Registrar erred in his primary conclusion that Novopharm's statement of opposition was deficient. I am not so satisfied.
- [60] Accordingly, for these reasons I have concluded that the appeals should be dismissed.
- [61] If the parties are unable to agree upon costs, the issue of costs is reserved for further submissions by the parties.

ORDER

- [62] IT IS THEREFORE ORDERED THAT:

1. The appeals are dismissed.
2. The issue of costs is reserved for further submissions in the event the parties are unable to reach an agreement.

"Eleanor R. Dawson"

Judge

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