

BETWEEN :

PARLAM CORPORATIONAPPELLANT;

AND

CIBA COMPANY LIMITEDRESPONDENT.

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Mar. 13
Mar. 23

Trade Marks—Confusing—Opposition—Appeal dismissed—Trade Marks Act, S. of C. 1952-53, c. 49, ss. 12(1)(b) and (c), 37(2)(b) and (c).

Held: That the word “MIKEDIMIDE” when sounded in English is deceptively misdescriptive of the character of wares in association with which it is used and is therefore within the class of marks excluded from registration by s. 12(1)(b) of the *Trade Marks Act*.

APPEAL from a decision of the Registrar of Trade Marks upholding an opposition filed by the respondent and refusing the appellant’s application for registration of the word “MIKEDIMIDE” as a trade mark for use in association with a pharmaceutical preparation.

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The appeal was heard before the Honourable Mr. Justice Thurlow at Ottawa.

J. C. Osborne, Q.C. and *Norman Shapiro* for appellant.

M. B. K. Gordon, Q.C. for respondent.

THURLOW J. now (March 23, 1961) delivered the following judgment:

This is an appeal from a decision of the Registrar of Trade Marks, by which he upheld an opposition filed by the respondent and refused the appellant's application for registration of the word "MIKEDIMIDE" as a trade mark for use in association with "a pharmaceutical preparation effective as an antagonist to reduce or overcome toxicity of a sedative and/or hypnotic drug."

The grounds of opposition set forth in the statement of opposition filed by the respondent with the Registrar pursuant to s. 37 of the *Trade Marks Act*, S. of C. 1952-53, c. 49, were as follows:

- (a) The generic term NIKETHAMIDE is used in association with a pharmaceutical product discovered by the Ciba Company many years ago and still actively marketed by Ciba in all countries of the world. The said generic term appears in the British Pharmacopeia, 1953 Edition, Pages 363 and 364.
- (b) The word MIKEDIMIDE is similar to the generic term NIKETHAMIDE and therefore should not be registered, since confusion will be caused by the use of this term in association with a pharmaceutical product.

In his decision, the Registrar stated his reasons for refusing the appellant's application as follows:

I am of the opinion that the word "MIKEDIMIDE" and the generic term "NIKETHAMIDE" are confusing.

Accordingly, the application for registration of the word "MIKEDIMIDE" is refused pursuant to Section 37(2)(b) and (d) of the *Trade Marks Act*.

Clauses (b) and (d) of s. 37(2) of the *Trade Marks Act* merely state two grounds on which an opposition to registration of a trade mark may be based. The ground stated in clause (b) is that the trade mark is not registrable, that in clause (d) that the trade mark is not distinctive. Both grounds were argued on the hearing of the appeal.

The eligibility of trade marks for registration is provided for in s. 12, which provides, *inter alia*, that, subject to s. 13, a trade mark is registrable if it is not

- (b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French languages of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;
- (c) the name in any language of any of the wares or services in connection with which it is used or proposed to be used;

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As a matter of first impression, the word “nikethamide,” by reason of its ending, suggests to me that it is the name of a substance and that the ending is a reference to its chemical character. The evidence discloses that the word is in fact a generic term used in association with a pharmaceutical product. The *Shorter Oxford Dictionary* gives the following definitions of the word “amide”:

1. *orig.* A name given to derivatives of ammonia (NH_3) in which one atom of H was exchanged for a metal or organic radical, acid or basic, these being viewed as compounds of the *metal*, etc. with *amidogen* (NH_2). 2. *Mod. Chem.* Generic name of the compound ammonias in which one or more atoms of hydrogen are replaced by an *acid* radical.

Moreover, the letters “eth” in “nikethamide” appear to be a contraction of “ethyl.” Though it is itself used as a name, “nikethamide” is thus, if not in any other ways, descriptive of the composition of the substance itself, which from a label exhibited to one of the affidavits filed on behalf of the appellant appears to be pyridine-B-carboxylic acid diethylamide. Accordingly, the word “nikethamide” would not be registrable as a trade mark for use in association with that substance, not only because it is in common use as the name of the substance and thus unregistrable because of s. 12(1)(c), but also, in my opinion, because it would be clearly descriptive of the character of the wares in association with which it was to be used and thus unregistrable because of s. 12(1)(b). Moreover, it would not be registrable as a trade mark for use in association with any other drug, for if so used it would, to anyone familiar with the substance known as “nikethamide,” I think, be deceptively misdescriptive of the wares in association with which it was to be used and thus unregistrable because of s. 12(1)(b).

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I turn now to the word "MIKEDIMIDE," of which registration is sought as a trade mark for use in association with a pharmaceutical product. This word, when used in association with chemicals or drugs, is also, in my opinion, a descriptive word, for it appears to me to indicate by its ending that it is a substance and that it is a particular kind of substance, as well. The *Shorter Oxford Dictionary* gives as the meaning of "imide":

Chem. A name for derivatives of ammonia (NH_3), in which two atoms of hydrogen are exchanged for a metal or organic radical; these being viewed as compounds of the metal, etc. with a hypothetical radical Imidogen, NH.

The word "MIKEDIMIDE" accordingly appears to me to indicate that the substance in association with which it is used is a type of ammonia derivative (which in fact it appears to be) and the word is thus, in my opinion, descriptive of the character of the wares in association with which it is used. Whether it is "clearly" descriptive of such wares within the meaning of s. 12(1)(b) and therefore unregistrable on that account I do not pause to consider, for it is equally unregistrable because of that clause if it is "deceptively misdescriptive" of the character of such wares when depicted, written or sounded in the English or French languages.

Now the word "MIKEDIMIDE" when printed or typed, in my opinion, bears no close similarity to the word "nikethamide," but when sounded in English the two words, I think, are so similar as to be difficult to distinguish from each other. It may be accepted that a druggist familiar with nikethamide, on seeing "MIKEDIMIDE" on a package, would not assume that it contained nikethamide but, if the word "MIKEDIMIDE" were simply spoken to him without his being previously aware that the word was a trade mark, I am of the opinion that he would be not unlikely to interpret it as referring to the ammonia derivative known as nikethamide and, since the substance in association with which the word "MIKEDIMIDE" is used is not nikethamide, he might well be deceived. The same interpretation may, I think, be expected whenever any person more or less versed in the terminology of drugs and chemicals and being familiar with nikethamide hears the word "MIKEDIMIDE" spoken in English without

any further indication of what is intended. "MIKEDI-MIDE", when sounded in English, is accordingly, in my opinion, deceptively misdescriptive of the character of the wares in association with which it is used, and it falls, therefore, within the class of marks excluded from registration by s. 12(1)(b).

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In view of this conclusion, it is unnecessary to deal with any of the other sections of the Act which were discussed on the argument of the appeal. I may add, however, that s. 37 gives to "any person" the right to oppose a registration, and it does not appear to me to be necessary that he be able to show the likelihood that he himself might be harrassed or otherwise adversely affected in his business in order to support his opposition to the registration of an unregistrable mark.

The appeal will be dismissed with costs.

Judgment accordingly.