



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2013 TMOB 48
Date of Decision: 2013-03-20

**IN THE MATTER OF AN OPPOSITION
by The Mentholatum Company Limited
to application No. 1,298,040 for the trade-
mark DEEP RELEEV in the name of
Meryl J. Squires, an individual**

[1] On April 18, 2006, Meryl J. Squires, an individual (the Applicant) filed an application to register the trade-mark DEEP RELEEV (the Mark) based on proposed use in Canada in association with the wares “medicinal herbal extracts and medicinal herbal infusions, all for therapeutic use and treatment of hematomas, wounds, ligaments, bones and injuries” (the Wares).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of April 8, 2009.

[3] On June 5, 2009, The Mentholatum Company Limited (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- pursuant to sections 38(2)(a) and 30(a) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), at the date of filing the application and at all material times, the application did not and does not contain a statement in ordinary commercial terms of the specific wares in association with which the Mark is proposed to be used;
- pursuant to sections 38(2)(a) and 30(e) of the Act, at the date of filing the application and at all material times, the Applicant did not, by itself or through a licensee, or by itself and through a licensee, intend to use the Mark;

- pursuant to sections 38(2)(b) and 12(1)(d) of the Act, the Mark is not registrable in association with the Wares on the basis that it was and is confusing with the Opponent's trade-mark registration for DEEP RELIEF (TMA314,433) in association with "analgesic ointments";
- pursuant to sections 38(2)(c) and 16(3)(a) of the Act, the Applicant is not the person entitled to registration of the Mark because as of the date of filing the application the Mark was confusing with the Opponent's trade-mark DEEP RELIEF which was previously used in Canada by the Opponent, its predecessor in title and/or its licensee(s); and
- pursuant to sections 38(2)(d) and 2, the Mark is not distinctive of the Applicant's Wares and is not adapted to distinguish the Wares from the wares of the Opponent.

[4] The Applicant served and filed a counter statement in which it denied the Opponent's allegations and put the Opponent to the strict proof thereof.

[5] In support of its opposition, the Opponent filed an affidavit of Francis P. Chan, the President of The Mentholatum Company of Canada Limited (MCAN) as well as a Director of the Opponent and The Mentholatum Company (MUS). The Opponent was also granted leave on February 14, 2012 to file an affidavit of Karen E. Thompson, a trade-mark searcher employed by the Opponent's agent.

[6] In support of its application, the Applicant filed an affidavit of Kathleen Larone, a legal assistant employed by the Applicant's agent.

[7] Both parties filed written arguments and were represented at an oral hearing.

Onus and Material Dates

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[9] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30 - the date of filing the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)].
- sections 38(2)(b)/12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)]
- sections 38(2)(c)/16(3) – the date of filing the application [see section 16(3) of the Act].
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Section 30 Grounds of Opposition

Section 30(a) of the Act

[10] The Applicant submits that the ground of opposition based on section 30(a) of the Act is insufficiently pleaded as it fails to set out the specific wares the Opponent is objecting to. I do not agree. The application claims only two types of wares, namely “medicinal herbal extracts” and “medicinal herbal infusions”. This is not a case where the list of wares is lengthy such that the Applicant would have been unable to determine which of the wares the Opponent is objecting to. I am satisfied that the Applicant knew the case it had to meet and it was able to respond to the section 30(a) ground of opposition. Based on the foregoing, I find that the ground was sufficiently pleaded and I refuse to strike it.

[11] The Opponent’s initial evidential burden under section 30(a) is a light one. In fact, the Opponent may need only present sufficient argument in order to meet its initial burden [see *McDonald’s Corporation and McDonald’s Restaurants of Canada Ltd v MA Comacho-Saldana International Trading Ltd carrying on business as Macs International* (1984), 1 CPR (3d) 101 at 104 (TMOB)].

[12] At the oral hearing, the Opponent submitted that the Applicant has not described its wares as they are customarily referred to in the trade. However, the Opponent has not provided any evidence to support a finding that the Wares are defined in anything other than ordinary commercial terms.

[13] The Opponent submits that there is ambiguity with respect to the specific nature of the “medicinal herbal extracts” and “medicinal herbal infusions” covered by the application. Specifically, the Opponent submits that the terms “extracts” and “infusions” are vague and can have multiple interpretations (e.g. infusion can be interpreted as a type of beverage and as a means for introducing a substance into the body (intravenous)).

[14] Both parties submitted that the Registrar is permitted to exercise his or her discretion to check the *Wares and Services Manual* to determine whether a particular entry is present or not [see *Effigi Inc v ZAM Urban Dynamixs Inc* (2010), 89 CPR (4th) 461 (TMOB); *Johnson & Johnson v Integra Lifesciences Corp* (2011), 98 CPR (4th) 429 (TMOB)]. I agree.

[15] The Opponent notes that the terms “herbal extracts” and “herbal infusions” are not found in the *Wares and Services Manual*. I agree. However, this does not necessarily lead to the inexorable conclusion that the Wares do not comply with section 30(a) of the Act.

[16] The Applicant referred to a search of the *Wares and Services Manual* for the term “herbal” which it adduced at the oral hearing. The Applicant submitted that the Wares are defined at least as specifically as the examples in the search results. I agree.

[17] At the oral hearing the Applicant also referred to section 2.5.2 of the *Wares and Services Manual* which indicates that herbal supplements, which the Applicant analogized to its “herbal extracts” and “herbal infusions”, must be described in detail by either:

- a. naming the disease, arthritis, cancer; or
- b. specifying the disease group or type of disease, disorder, or condition to be treated, e.g., cardiovascular diseases, mood disorders, for building body mass, for promoting weight loss; or
- c. by indicating the specific type of botanical, herbal supplement, homeopathic remedy, nutraceutical, dietary supplement, food supplement, nutritional supplement, herbs for medicinal purposes, herbal beverages for medicinal purposes, herbal remedy, botanical extract and plant extract.

[18] The Applicant has specified that the “herbal extracts” and “herbal infusions” are used to treat “hematomas, wounds, ligaments, bones and injuries”.

[19] Having reviewed both parties' submissions and the excerpts of the *Wares and Services Manual* to which I have been referred, I am satisfied that the Wares are sufficiently defined to satisfy section 30(a) of the Act.

[20] Based on the foregoing, I dismiss this ground of opposition on the basis that the Opponent has failed to meet its evidential burden.

Section 30(e) of the Act

[21] At the oral hearing the Opponent submitted that while it was not withdrawing this ground of opposition, it would not be making any submissions on it.

[22] Since the application contains a statement that the Applicant by itself or through a licensee intends to use the Mark in Canada, it formally complies with section 30(e) of the Act.

[23] The Opponent failed to include any allegations of fact in support of its allegation that the Applicant did not intend to use the Mark in Canada for the Wares. Further, there is no evidence of record to suggest a lack of intention to use the Mark on the part of the Applicant. As a result, I dismiss the ground of opposition based upon non-compliance with section 30(e) for having been insufficiently pleaded or alternatively for the Opponent having failed to meet its evidential burden.

Non-registrability Ground – Section 12(1)(d) of the Act

[24] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if the registration relied upon is in good standing as of the date of the opposition decision. The Registrar has discretion to check the Register in order to confirm the existence of the registration relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The registration for the trade-mark DEEP RELIEF (TMA314,433) remains extant and therefore the Opponent has satisfied its evidential burden.

[25] I must now assess whether the Applicant has met its legal burden.

[26] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[27] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC).]

Section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[28] At the oral hearing both parties asked that I take judicial notice of dictionary definitions. As I indicated at the oral hearing, I may refer myself to a dictionary to determine the meaning of words [see *Insurance Co of Prince Edward Island v Prince Edward Island Insurance Co* (1999), 2 CPR (4th) 103 (TMOB)]. The *Canadian Oxford Dictionary* defines the word “deep” as “extending far down from the top”, “relief” as “the alleviation of or deliverance from pain, distress, anxiety, etc.” and “relieve” as “alleviate or reduce (pain, suffering, pressure, etc.)”.

[29] Taking into account the dictionary definitions of the component words, the Opponent’s trade-mark DEEP RELIEF is descriptive of the associated wares, namely “analgesic ointments”. The Opponent’s DEEP RELIEF mark suggests that the analgesic ointments provide deep relief from pain. The Opponent’s DEEP RELIEF mark is therefore not inherently distinctive.

[30] The Applicant submits that the Mark contains a coined word and is thus inherently distinctive. While I agree that the Mark includes a coined word, I find that the word RELEEV is phonetically equivalent to the word RELIEVE. While I agree with the Applicant that RELIEVE is a verb whereas RELIEF is a noun, I find that both words convey the same idea such that the

word RELEEV in the Mark is at least suggestive of the ability of the Wares to provide relief from the various conditions itemized in the specification of wares (i.e. hematomas, wounds, ligaments, bones and injuries).

[31] Based on the foregoing, I find that the Mark possesses a greater degree of inherent distinctiveness than the Opponent's DEEP RELIEF mark by virtue of the fact that it includes a coined word whereas the Opponent's DEEP RELIEF mark is merely made up of dictionary words which are descriptive of the associated wares. However, neither party's mark is particularly inherently strong.

[32] At the oral hearing the Applicant submitted that the lack of inherent distinctiveness in the Opponent's DEEP RELIEF mark should be a deciding factor in the confusion analysis relying on Member Bradbury's decision in *Gemological Institute of America Inc v Gemology Headquarters International LLC* (2012), 105 CPR (4th) 220 (TMOB). In *Gemological Institute* Member Bradbury held that while in most instances the degree of resemblance is the most important factor, in that particular case the resemblance was due to the inclusion of the words GEMOLOGY and GEMOLOGICAL which were descriptive of the parties' field of business. The parties' marks featured a number of other words, with GEMOLOGY/GEMOLOGICAL being only one word in each of the marks. In refusing to find confusion, Member Bradbury held that the opponent was attempting to monopolize a word that was descriptive of the opponent's wares. In the present case, however, we are not dealing with a situation where the Applicant has taken one descriptive word from the Opponent's mark; rather, it is the entirety of the Opponent's mark which is similar to the Mark. Thus I agree with the Opponent that *Gemological Institute* can be distinguished from the present case.

[33] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. I will now turn to the extent to which the trade-marks have become known in Canada.

[34] The application for the Mark is based on proposed use and the Applicant has not filed any evidence of use or reputation for the Mark. As a result, I must conclude that the Mark has not become known to any extent.

[35] The registration for the Opponent's DEEP RELIEF trade-mark issued subsequent to the filing of a declaration of use in 1986. In his affidavit Mr. Chan makes the sworn statement that the Opponent and its predecessors-in-title have used the DEEP RELIEF mark since 1986 in association with analgesic ointments. Mr. Chan also provides sales figures as well as documentary evidence of sales and advertising for the Opponent's wares.

[36] The Applicant raises two problems with the Opponent's evidence. Firstly, the Applicant submits that any use which has been evidenced of the DEEP RELIEF mark is use by MCAN and does not accrue to the Opponent. Secondly, despite claiming use of the DEEP RELIEF mark since 1986, the Opponent has only provided documentary evidence and sales figures dating back to 2008.

[37] In his affidavit, Mr. Chan states that since the assignment of the DEEP RELIEF registration to the Opponent in 1993, MCAN has used the mark in Canada pursuant to a "licensing arrangement" with the Opponent (paragraph 12). Mr. Chan further states that pursuant to this licensing arrangement the Opponent has "by itself or through an authorized representative" "indirectly controlled the character and quality of the goods bearing the DEEP RELIEF trade-mark sold in Canada" (paragraph 13).

[38] The Applicant submits that any use by MCAN cannot accrue to the Opponent as the Opponent has failed to satisfy section 50(1) of the Act. Specifically, the Applicant submits that Mr. Chan failed to provide any particulars of the alleged licensing arrangement, or explain why it was an arrangement rather than an agreement, or identify the authorized representative, or describe how the Opponent indirectly controlled the character and quality of the goods.

[39] At the oral hearing, the Opponent submitted that the sworn statements made by Mr. Chan, in the absence of cross-examination or contradictory evidence are sufficient to support a finding that the Opponent exercised the proper degree of care and control over the character and quality of the Opponent's wares such that use by MCAN could accrue to the Opponent pursuant to section 50(1) of the Act [see *Republic of Cyprus v Producteurs Laitiers du Canada* (2010), 84 CPR (4th) 421 (FC); aff'd 93 CPR (4th) 255 (FCA) and *Boyer Candy Co v Hershey Canada Inc* (2001), 21 CPR (4th) 257 (TMOB)].

[40] The Applicant referred to the comments of the Federal Court of Appeal in *Spirits International BV v BCF SENCRL* (2012), 101 CPR (4th) 413 at para 27 on the issue of the evidence necessary to satisfy section 50(1) of the Act. Specifically, the Applicant submitted that this decision suggests that there is a requirement to provide assertions of fact describing how the licensor had exercised the necessary degree of control. The Applicant pointed me to the following passage from *Spirits International*:

[27] BCF submitted that the statements in the Denisov affidavit are too vague to establish that Spirits BV exercised sufficient control over the nature and character of the vodka sold under the subject mark during the relevant period. I do not agree. As I read the statements in the Denisov affidavit, they are more than bare assertions that the control required by section 50 of the Trade-Marks Act exists. They are assertions of fact describing how Spirits BV had and exercised the required degree of control.

[41] Every case is to be determined on its own facts. In the present case, I have no reason to doubt the veracity of Mr. Chan's sworn statements. I am satisfied that his sworn statements regarding the licensing arrangement and the exercise of care and control are sufficient to satisfy the requirements of section 50(1) of the Act such that use by MCAN will accrue to the Opponent.

[42] The second issue the Applicant raised with respect to the Opponent's evidence is that, despite making the sworn statement that the Opponent and its predecessors in title have used the DEEP RELIEF mark in Canada since 1986, Mr. Chan only provides documentary evidence and sales figures back to 2008.

[43] In his affidavit Mr. Chan states that products bearing the DEEP RELIEF mark form part of the line of pain relief products distributed by MCAN in Canada. Mr. Chan states that these include a line of products which are available in a variety of rubs and patches, all of which are designed to ease muscle and joint inflammation caused by athletic activity, sports or injury (paragraph 15).

[44] In his affidavit, Mr. Chan provides sample packaging for the Opponent's DEEP RELIEF products which he states is current to the date of filing his affidavit (Exhibit C). Mr. Chan does, however, make the sworn statement that the manner in which the Mark appears on the packaging samples in Exhibit C is representative of the manner in which the DEEP RELIEF mark has been

used by the Opponent, through its licensee MCAN, and by the Opponent's predecessors in title in association with "analgesic ointments, creams, patches, rubs, wraps, and gels" in Canada.

[45] The Applicant submits that the manner in which the DEEP RELIEF mark appears on the packaging is not sufficient to satisfy section 4(1) of the Act as it appears in association with other trade-marks in such a way that it is acting merely as a descriptive term to identify the function of the associated products (i.e. "New DEEP RELIEF deep down relief for deep down pain"). Furthermore, the Applicant points out that the DEEP RELIEF mark appears in conjunction with the trade-marks DEEP COLD or DEEP HEATING.

[46] At the oral hearing, the Opponent submitted that jurisprudence dictates that nothing precludes the use of multiple marks side by side on packaging [see *Ogilvy Renault LLP v Mephisto Inc* (2012), 101 CPR (4th) 477 (TMOB); *Spirits International BV v Distilleries Melville Ltee* (2011), 96 CPR (4th) 277 (TMOB)]. I agree with the Opponent.

[47] At the oral hearing, the Opponent submitted that it first used the DEEP RELIEF mark in association with the trade-mark MENTHACIN and then around 2008/2009 it changed its packaging and relaunched its brand in such a way that greater prominence was given to the DEEP RELIEF trade-mark. The Opponent submitted that this is supported in part by the presence of the word "NEW" on the packaging which refers to the fact that new products have been rolled into the DEEP RELIEF brand.

[48] Based on the foregoing, I am satisfied that the evidence establishes that the DEEP RELIEF mark has been applied to packaging for the Opponent's products in a manner that satisfies section 4(1) of the Act since 1986. The fact remains, however, that the Opponent has not provided any evidence establishing the extent of sales in Canada before 2008. The Opponent's sales figures range from \$250,000 to \$5.7 million from 2008 to 2010. The Opponent has also provided advertising expenditures for products associated with the DEEP RELIEF mark amounting to approximately \$40,000 annually for the years 2008 – 2010. The Opponent has also provided sample advertisements which prominently display the DEEP RELIEF mark for the years 2008 – 2010 [Chan affidavit, Exhibits F1-F3].

[49] Mr. Chan states that the dramatic increase in sales in 2009 and 2010 can be explained by the widening of the Opponent's DEEP RELIEF product line "to include additional topical products, namely, wraps and patches" (para 22). Mr. Chan states that prior to 2008 the DEEP RELIEF mark was applied to only one topical ointment product.

[50] The Applicant submits that these additional products, namely wraps and patches, do not constitute "ointments". The Opponent disagrees and submits that the fact that the products are not specifically marketed as "ointments" does not mean that they are not ointments. The Opponent submits that the definition of ointment would include wraps and patches which would release ointment onto the affected area. I note that the *Canadian Oxford Dictionary* defines "ointment" as "a smooth greasy healing or cosmetic preparation for the skin". The Opponent relies on a definition for "ointment" which states that it "includes any semi-solid preparations usually containing medicine, applied externally". The Opponent also submits that as the registration for the DEEP RELIEF mark issued more than 20 years ago, the wares "analgesic ointments" should be given a liberal and broad interpretation.

[51] I am of the view that I need not make a determination on whether wraps and patches constitute ointments. The fact is that the Opponent has provided sample packaging and sales figures for various products including rubs, gels and creams all of which I am satisfied clearly constitute ointments. While it is unfortunate that the Opponent did not provide a breakdown of the sales figures, I am satisfied that the Opponent has evidenced not insubstantial sales figures for products some of which would clearly constitute analgesic ointments and which the evidence shows display the DEEP RELIEF mark on their packaging.

[52] Based on the foregoing, I am satisfied that the Opponent has established that the DEEP RELIEF mark has become known to some extent by virtue of the evidenced sales of analgesic ointments bearing the DEEP RELIEF mark in Canada from 2008 – 2010.

Section 6(5)(b) – the length of time each has been in use

[53] Based on the evidence of record, I am satisfied that the Opponent's DEEP RELIEF Mark has been in use for longer than the Mark and thus this factor favours the Opponent.

Sections 6(5)(c) and (d) – the nature of the wares, services or business and trade

[54] It is the Applicant's statement of wares as defined in its application versus the Opponent's registered wares that govern my determination of this factor [see *Esprit International v Alcohol Countermeasure Systems Corp* (1997), 84 CPR (3d) 89 (TMOB)].

[55] While I agree with the Applicant that the exact nature of the parties' specific wares differs, I note that there is significant similarity between the parties' wares as they both cover medicinal products used to treat or alleviate symptoms related to various conditions.

[56] The *Canadian Oxford Dictionary* defines "analgesic" as "relieving pain". The evidence shows that the Opponent's wares include various preparations to relieve pain caused by arthritis, sprains, strains, etc. to various parts of the body. The Applicant's wares are used to treat "hematomas, wounds, ligaments, bones and injuries". The sample products provided by the Opponent in its evidence could all be used to relieve pain associated with at least ligaments, bones and injuries. This serves to create a direct overlap in the nature of the parties' wares. At the oral hearing the Applicant attempted to create a distinction between analgesic and therapeutic use. I disagree. I am of the view that the notions of "therapeutic use" and "treatment of" as identified in the Wares could include pain relief.

[57] Referring to the definition for "ointment" set out above, I am of the view that "medicinal herbal extracts" and "medicinal herbal infusions" could be ingredients in the Opponent's ointments.

[58] Based on the foregoing, I find that there is a similarity in the nature of the parties' wares.

[59] With respect to the nature of the parties' trades, the evidence demonstrates that the Opponent's analgesic ointments have been made available to consumers in pharmacies, drug stores and pharmacy sections of large department stores and grocery stores throughout Canada. The Opponent's evidence demonstrates that its products are also sold online. I note that the evidence shows excerpts from third party websites. I am not willing to rely upon these third party websites as evidence of the truth of their contents [see *Candrug Health Solutions Inc v Thorkelson* (2007), 60 CPR (4th) 35 (FCTD), reversed (2008), 64 CPR (4th) 431 (FCA)].

However, I accept Mr. Chan's statement that the Opponent's wares are also available online through retailers' websites.

[60] The Applicant submits that I should take judicial notice of the fact that analgesic ointments are not sold in the same aisle as herbal extracts in pharmacies or drug stores. I am not willing to take judicial notice of this fact.

[61] The Applicant has not provided any evidence regarding the nature of its trade. In light of the similarity in the parties' wares, I find that the parties' channels of trade could also overlap.

[62] Based on the foregoing, this factor favours the Opponent.

Section 6(5)(e) – the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[63] In most instances, the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2) 145, conf 60 CPR (2d) 70 (FCTD)]. This principle was recently upheld by the Supreme Court of Canada in *Masterpiece, supra*.

[64] “Although the marks are not to be dissected when determining matters of confusion, it has been held that the first portion of a trade-mark is the most relevant for purposes of distinction.” [see *K-Tel International Ltd v Interwood Marketing Ltd* (1997), 77 CPR (3d) 523 (FCTD) at 527]. In the present case, the first portion of the parties' marks is identical.

[65] The Opponent submits that the parties' marks are so similar as to be considered identical. While I do acknowledge the difference between RELIEF and RELEEV in appearance and possibly in sound, I find that the idea suggested by the words is essentially the same.

[66] The Applicant submits that small differences may be relevant in determining the likelihood of confusion as between otherwise similar or identical marks. To this end the Applicant relied upon a decision in which the marks at issue were ALOEVITE and ALOESPA [see *Aloette Cosmetics, Inc v Medique Cosmetics Inc* (2006), 51 CPR (4th) 196 (TMOB)]. I am of the view that this case can be distinguished on the facts. Specifically, I note that while in both

cases the prefixes of the marks are identical, contrary to the cited case in the present case the suffixes are highly similar in appearance and sound and essentially identical in idea suggested.

[67] I am of the view that when the marks are viewed in their entirety they share a great degree of similarity, in particular in ideas suggested.

[68] Based on the foregoing, this factor favours the Opponent.

Additional Surrounding Circumstance – State of the Register

[69] In its written argument, the Applicant introduced the existence of two registered trademarks belonging to third parties and attempted to rely on these as supporting a finding that marks including the word DEEP for similar wares were already coexisting on the register with the Opponent's DEEP RELIEF mark.

[70] The law is clear that, when adjudicating in an opposition proceeding, the Registrar does not exercise discretion to take cognizance of his own records except to verify whether claimed trade-mark registrations and applications are extant [see *Quaker Oats, supra* and *Royal Applicant Mfg Co v Iona Appliance Inc* (1990), 32 CPR (3d) 525 at 529 (TMOB)].

[71] Based on the foregoing, I am not willing to place any weight on the Applicant's submissions regarding these third party registrations.

Additional Surrounding Circumstance – OHIM Decision

[72] Ms. Thompson attaches to her affidavit a copy of a decision of OHIM regarding an opposition to an application for the Mark in that jurisdiction. The Opponent submits that this decision is relevant as it establishes the fact that the likelihood of confusion between the parties' marks has already been acknowledged in another jurisdiction, namely in OHIM where an opposition was accepted and registration of the Mark was refused.

[73] The Opponent submits that while foreign decisions may not be binding on the Registrar they may, in appropriate circumstances be considered for persuasive value or used as a guide. The Opponent asks that I place such weight on the OHIM decision in the present case.

[74] In its written argument the Applicant submitted that foreign decisions are not generally given precedential value by the Registrar. I agree. Foreign jurisprudence is not binding on the Registrar. This is particularly true in the present case where no evidence has been provided regarding the applicable law in the foreign jurisdiction. Based on the foregoing, I find that the decision from OHIM has no precedential value and thus this does not form a relevant surrounding circumstance supporting the Opponent's position. That being said, I need not have found that this circumstance supported the Opponent in order to find in its favour.

Conclusion

[75] In applying the test for confusion I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, in particular the similarity in the parties' marks (particularly in ideas suggested), as well as the similarity in the nature of the parties' wares and trades, I am not satisfied that Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's DEEP RELIEF mark.

[76] Having regard to the foregoing, the ground of opposition based on section 12(1)(d) of the Act is successful.

Non-distinctiveness Ground – section 38(2)(d) of the Act

[77] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its Wares from those of others throughout Canada [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd.* (1985), 4 CPR (3d) 272 (TMOB)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness.

[78] Pursuant to its evidential burden, the Opponent is under an obligation to show that, as of the filing of the statement of opposition, the DEEP RELIEF mark had become known sufficiently to negate the distinctiveness of the Mark [see *Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FC)].

[79] As discussed more fully in the analysis of the section 12(1)(d) ground of opposition, the Opponent was successful in establishing that the DEEP RELIEF mark had become known to some extent in association with analgesic ointments as of the date of filing the statement of opposition and as a result the Opponent has met its evidential burden.

[80] The difference in material dates is insignificant and thus for the same reasons as identified above in the analysis of the section 12(1)(d) ground of opposition, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities that there is no reasonable likelihood of confusion between the parties' marks. Accordingly, the non-distinctiveness ground is also successful.

Section 16(3)(a) Ground of Opposition

[81] As the application has already been refused under two grounds of opposition, I will not address the section 16(3)(a) ground of opposition.

Disposition

[82] Pursuant to the authority delegated to me under section 63(3) of the Act, refuse the application pursuant to section 38(8) of the Act.

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office