



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

**Reference: 2015 TMOB 205**  
**Date of Decision: 2015-11-12**  
**[UNREVISED ENGLISH**  
**CERTIFIED TRANSLATION]**

**IN THE MATTER OF THE OPPOSITIONS**

Focus Eye Centre Inc. **Opponent**  
**and**

Gestion FocusVision inc. **Applicant**

1,551,638 for FocusVision **Applications**  
1,551,642 for FocusVision and design

Introduction

[1] Gestion FocusVision inc. (the Applicant) filed registration application No. 1,551,638 on November 10, 2011 for the FocusVision trade-mark (the Word Mark).

[2] The application is based on a use of the Word Mark in Canada since October 1, 2008 in association with clinical medical and surgical services in ophthalmology (the Services).

[3] The same day, the Applicant also filed an application No. 1,551,642, for registration of the trade-mark FocusVision and design (the Design Mark), illustrated hereinafter:



[4] This second registration application is also based on a use of the Design Mark in Canada in association with the Services since October 1, 2008.

[5] These applications were published on August 29, 2012 in the *Trade-marks Journal* for the purposes of opposition.

[6] Focus Eye Centre Inc. (the Opponent), on October 29, 2012, filed a statement of opposition in each of the cases, raising the same grounds of opposition based on section 30 (i), 12(1)(d), 16(1)(a) and (c) and 2 (distinctiveness) of the *Trade-marks Act*, RSC (1985), c T-13 (the Act).

[7] The Applicant filed a counter statement against each of the oppositions, denying each and every ground of opposition and also containing an argument, the main points of which also appear in its written arguments.

[8] The Opponent filed, as evidence, the affidavits of Kevin Chadwick and Irena Kramer Retskaya. The Applicant filed the affidavits of Michel Podtetenov and Philippe Roberge. This evidence is identical in both cases.

[9] The parties each filed written arguments and were represented at the hearing. The Opponent's written arguments are somewhat different in each case, in that the Opponent, in the Design Mark case, addresses the design element of this mark. The Applicant's written arguments are identical in each case. The Applicant also raises the distinctiveness of the Design Mark's design in its arguments. It is obvious this argument can apply only to the Design Mark case.

[10] For the reasons described below in greater detail, I find that the registration applications should be refused.

### Evidentiary burden

[11] Under the procedure in the matter of opposition to the registration of a trade-mark, the legal onus is on the Applicant to show that the application for registration does not contravene the provisions of the Act. This means that if a determinate conclusion cannot be reached once all the evidence has been presented, then the issue must be decided against the Applicant. However, the Opponent must discharge the initial burden of proving the facts on which it bases its allegations. The fact that an initial evidentiary burden is imposed on the Opponent means that a ground of opposition will be taken into consideration only if sufficient evidence exists to allow a reasonable conclusion of the existence of the facts alleged in support of this ground of opposition [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA); and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FCTD)].

### Preliminary comments

[12] Except if mentioned otherwise, the word 'case' means cases 1,551,638 and 1,551,642. Also, the term 'Mark' refers both to the Word Mark and the Design Mark.

[13] I have studied all the evidence of record. However, I will refer only to what I consider relevant for the purposes of my decision.

[14] At the beginning the hearing, the Opponent raised the fact that the exhibits attached to the affidavits of Mr. Roberge and Mr. Podtetenev were not authenticated by the Commissioner for Oaths in whose presence these affidavits were signed. I do not consider this omission to be fatal to the Applicant's Evidence. Indeed, each exhibit is amply described in the paragraphs in which the witness refers to it. I have already dealt with a similar situation in *Tension 10 Inc v Tension Clothing Inc*, 2004 CanLII 71738 (TMOB), in which I concluded that such a defect in form was not prejudicial to the admissibility of exhibits placed in evidence.

[15] In its written arguments, apart from the degree of resemblance between the parties' marks, the Applicant did not comment on the factors enumerated in section 6(5) of the Act. However, during the hearing, a few brief comments were presented by the Applicant's agent on some of these factors. I will refer to these comments in the analysis of these factors.

Grounds of opposition based on section 30(i) of the Act

[16] Section 30(i) of the Act requires only that the Applicant declares it is satisfied it has the right to use the Mark in Canada. This statement is included in each of the registration applications.

[17] This section of the Act may be invoked in support of a ground of opposition and in very specific cases, such as when the Applicant's statement was made in bad faith [see *Sapodilla Co. Ltd. v Bristol Myers Co.* (1974), 15 CPR (2d) 152 (TMOB)].

[18] The Opponent alleges in its statement of opposition that the Applicant was aware of the existence of the Opponent's FOCUS EYE CENTRE INC, 1-800-IN FOCUS and FOCUS LASER CENTRE trade-marks in association with medical services, namely laser surgery due to their use in Canada for nearly the past 18 years. However, it cannot be inferred from the Applicant's mere knowledge of the existence of the Opponent's trade-marks that Applicant was in bad faith at the time of filing of each of its registration applications.

[19] The Opponent's written arguments and its oral representation in this sense during the hearing, are to the effect that the Applicant knew of the Opponent's marks, because the Applicant had discontinued a first application for registration of the FocusVision & Eye Design trade-mark, registration application No. 1,445,924, following an opposition invoked by the Opponent.

[20] There is no evidence of record on this subject. When I pointed out this deficiency at the hearing, the Opponent invited me to use my discretionary power to consult the Register I informed the Opponent during the hearing that I was not prepared to exercise this discretionary power in such a situation. I agree with the Applicant. The Opponent did not allege this fact in its statement of opposition. Thus, the Applicant did not have to file, and indeed did not file, evidence concerning the reasons that could have justified such discontinuance.

[21] The Registrar will consult the Register only to verify the status of registrations or registration applications argued in the statement of opposition [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB) and *Royal Appliance Mfg Co v Iona Appliances Inc* (1990), 32 CPR (3d) 525 (TMOB)]. If the Opponent wished to support its ground of opposition based on section 30(i) of the Act on the facts, it had to allege them in its statement of opposition and prove them in its evidence.

[22] For all these reasons, I reject this ground of opposition.

Ground of opposition based on section 12(1)d) of the Act

[23] The Opponent alleges, in its statement of opposition, that the Mark is confusing with its FOCUS EYE CENTRE and Design and 1-800-IN FOCUS registered trade-marks.

[24] The relevant date for analyzing this ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413, on page 424 (FCA)].

[25] Mr. Chadwick is the Opponent's President. He filed a certified copy of the following registrations held by the Opponent:

- No. TMA471,642 for the FOCUS EYE CENTRE and Design trade-mark reproduced below:



[TRANSLATION] registered in association with medical services, namely laser surgery.

- No. TMA471,275 for the 1-800-IN-FOCUS trade-mark, in association with the same services.

[26] I checked the Register and can confirm these registrations are still valid. The Opponent has therefore fulfilled its initial burden of proof.

[27] I find that the Opponent's chances of success on this ground of opposition are better with the FOCUS EYE CENTRE and Design mark. Indeed, if the Opponent does not prevail with this trade-mark, it would scarcely be more successful with its 1-800-IN-FOCUS trade-mark.

[28] It is therefore incumbent on the Applicant to prove, on a balance of probabilities, that use of the Mark in association with the Services does not risk creating confusion with the Opponent's FOCUS EYE CENTRE and Design mark. The test to be applied to rule on this issue is stated in section 6(2) of the Act. This test does not address confusion between the marks themselves, but rather confusion regarding the source of the goods and services. Accordingly, I have to determine whether a consumer who sees the Mark used in association with the Services would believe they are offered or authorized by the Opponent.

[29] I must take into account all relevant circumstances, including those listed in section 6(5) of the Act, i.e. the inherent distinctiveness of the trade-marks and the extent to which they have become known; the period during which the trade-marks have been in use; the nature of the goods, services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. This list is not exhaustive and it is unnecessary to assign the same weight to each of these factors [see *Mattel Inc v 3894207 Canada Inc* 2006 SCC 22 (CanLII), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* 2006 SCC 623 (CanLII), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc et al* 2011 SCC 27 (CanLII), 92 CPR (4th) 361 (SCC) for a more in-depth analysis of the general principles governing the test for confusion].

The inherent distinctiveness of the trade-marks and the extent to which they have become known

[30] In its written arguments, the Opponent claims that the FOCUS EYE CENTRE and Design mark has an inherent distinctiveness, whereas the Mark can be perceived as suggestive of the Services. During the hearing, the Applicant submitted that the Word Mark had an inherent distinctiveness because it is an invented word.

[31] The Word Mark and the FOCUS EYE CENTRE and Design mark are marks that have a low degree of inherent distinctiveness. I do not believe the Word Mark has a higher degree of inherent distinctiveness than the FOCUS EYE CENTRE and Design mark. Even though the Word Mark is an invented word, it is simply the juxtaposition of two common English words, namely 'focus' and 'vision'. Moreover, the use of uppercase in the word 'Vision' serves to separate these words. The Word Mark, when it is used in association with the Services, is suggestive of the nature of the Services. Regarding the Opponent's FOCUS EYE CENTRE and Design mark, I do not see how the use of a very unoriginal design would give it distinctiveness superior to that of the Word Mark. The FOCUS EYE CENTRE and Design mark is also suggestive of the services associated with it.

[32] Regarding the Design Mark, I find it has an inherent distinctiveness slightly superior to that of the FOCUS EYE CENTRE and Design mark. Indeed, the Design Mark design, although highly suggestive, is more original than that of the Opponent's mark.

[33] The distinctiveness of a mark can be enhanced by its use and the extent to which it has become known in Canada due to its use and promotion. I will therefore proceed to analysis the evidence of record regarding the use of the parties' marks.

[34] Mr. Chadwick alleges that the Opponent started using the FOCUS EYE CENTRE and FOCUS EYE CENTRE and Design marks in association with vision correction surgery in February 1993. The Opponent offers its services at two clinics, i.e. in Kingston and Ottawa, Ontario. Thus, the Opponent would have provided such services to over 25,000 patients across Canada, including a substantial number domiciled in Quebec. However, Mr. Chadwick does not tell us what this 'substantial' number would be.

[35] Mr. Chadwick adds that the Opponent promotes its laser surgery vision correction services by the publication of ads in newspapers and magazines and on radio in Canada. He affirms that the Opponent spends substantial amounts to promote its marks in association with its services. To support his statements, Mr. Chadwick filed copies of brochures promoting the Opponent's services in association with its FOCUS EYE CENTRE and FOCUS EYE CENTRE and Design marks.

[36] Apart from the number of surgeries performed since 1993, I find this evidence very slim. Indeed, we have no information on the Opponent's turnover during that period. We have no information on the amounts spent by the Opponent to promote its services in association with its FOCUS EYE CENTRE and Design mark and we have no information on the distribution of the advertising documentation (periods, areas, quantities, etc.) filed in support of Mr. Chadwick's affidavit.

[37] At most, I consider that the FOCUS EYE CENTRE and Design mark was known to a limited extent in the Kingston and Ottawa areas.

[38] Mr. Podtetenev is the Applicant's majority shareholder and sole director. He alleges the Applicant was incorporated on April 28, 2008. According to the excerpt from the statement of information of a legal person in the Quebec Enterprise Register, filed as Annex A to its affidavit, the Applicant carries on ophthalmology service activities and operates a vision surgery clinic. The clinic operated by the Applicant has been located on Île-des-Sœurs (Montreal area) in Quebec since September 2008.

[39] Mr. Podtetenev alleges that, since September 2008, the Applicant has used the Mark in association with the operation of its medical clinic in ophthalmology. He affirms that, since 2008, the Applicant has used the expression FocusVision in its trade name, advertising documents and logo, and he filed excerpts from the Applicant's website as Annex B to support his claims. This is the only evidence of record regarding use of the Mark within the meaning of section 4(2) of the Act.

[40] Based on this evidence, it is impossible to determine the extent to which the Mark has become known in Canada in association with the Services. We do not have the Applicant's turnover for the Services provided in association with the Mark. We do not have the number of surgeries performed by the Applicant in association with the Mark. Finally, we do not have any information on the number of people who visited the Applicant's website. At most, I consider that the Mark was known to a very limited extent on Île des Sœurs, in the Montreal area.



The period during which the trade-marks have been in use

[41] It appears from the evidence described above that the Opponent has used its FOCUS EYE CENTRE and Design mark since 1993, while the Applicant has used the Mark since September 2008.

[42] This factor therefore favours the Opponent.

The type of services and the nature of the trade

[43] It appears obvious to me that the services offered by the parties and the nature of their respective trades overlap.

[44] These two factors therefore also favour the Opponent.

Degree of resemblance between the marks involved

[45] I recall that the Supreme Court of Canada, in its *Masterpiece* ruling, supra, clearly indicated that the degree of resemblance between the marks is the factor that is often likely to have the greatest effect on the examination of confusion. This ruling also teaches us that the dominant element of each mark must be identified.

Word Mark

[46] The Word Mark is formed by the juxtaposition of the words ‘focus’ and ‘vision’. I do not consider one of these words more dominant than the other. However, the ‘focus’ element is the first component of the Word Mark. It has been determined in the past that the first element of a trade-mark is generally the most important [see *Conde Nast Publication Inc v Union des Éditions Modernes* (1979), 46 CPR (2d) 183 (FCTD)]. A similar reasoning applies to the Opponent's mark. I do not believe that the ‘centre’ and ‘eye’ elements and the design are dominant elements. Thus, for each of the marks involved, the ‘focus’ element dominates these marks.

[47] As for the idea suggested by these marks, it appears to be the same when the marks are used in association with the parties' services. Indeed, the Word Mark suggests to an Anglophone or a bilingual person the idea that vision surgeries are performed at the Applicant's clinics. The

same is true of the clinics operated by the Opponent in association with its FOCUS EYE CENTRE & Design mark.

[48] The Applicant made an issue of the fact that the Opponent's mark is unilingual English while the Word Mark makes no reference to a specific language. I recall that the Federal Court concluded that the test for confusion between trade-marks must be approached from the angle of a unilingual Francophone, unilingual Anglophone or bilingual consumer [see *Pierre Fabre Médicament v SmithKline Beecham Corp* (2000), 8 CPR (4th) 389 (FCTD), 2000 CarswellNat 1837]. Although the Word Mark is an invented word, it is composed of two English words that an Anglophone or bilingual consumer will be able to recognize. I therefore cannot accept this argument to distinguish the marks involved.

[49] In its written arguments, the Applicant indicates that a simple consultation on the Google search engine makes it possible to recognize there is no confusion. It claims that a search for the Opponent's mark refers to its website and not to the Applicant's, whereas a search for the Word Mark refers to the Applicant's website and not to the Opponent's.

[50] I have no evidence of record that such searches were run. In his affidavit, Mr. Roberge mentions that he visited the Applicant's website. There is no mention of a preliminary search run with the Google search engine. In any event, I do not believe such a search would have been conclusive, even if it had been run. In fact, the test is not the actual confusion between the marks, but rather to determine whether the use of the Word Mark in association with the Services could be confusing with the Opponent's mark, used in association with the Opponent's services.

#### Design Mark

[51] Regarding the Design Mark, the Applicant mentions that the design illustrates an eye and thus refers clearly to ophthalmology. Thus, if I permit myself to continue this line of argument, it is my opinion that the design adds another element suggestive of the nature of the Services.

[52] Moreover, the Opponent argues that the presence of an eye in the Design Mark only accentuates the resemblance between the ideas suggested by the parties' marks. Thus, the Design

Mark includes the design of an eye, while the FOCUS EYE CENTRE and Design mark includes the word 'eye', the English word for 'œil'.

[53] I agree with the Opponent. The idea suggested by the Design Mark and the FOCUS EYE CENTRE and Design mark is essentially the same: the services offered by the parties are ophthalmology services.

[54] I conclude this factor favours the Opponent, both in the Word Mark case and in the Design Mark case.

#### Other factors raised by the parties

[55] The Applicant argues that accepting the opposition would be tantamount to granting the Opponent a monopoly of the word 'focus', which is a common English word. I do not agree with the Applicant's approach. The question is not to determine whether the Opponent enjoys a monopoly of the word 'focus' but rather to determine the probability of confusion as to the source of the parties' services, considering all the factors enumerated in section 6(5) of the Act.

[56] I find that the additional elements of the Mark are insufficient to distinguish the Mark from the Opponent's mark. It remains that there is a reasonable likelihood of confusion between these marks when they are used in association with the same kind of services.

[57] The Applicant also raises the absence of confusion despite the coexistence of the marks for a period of more than 8 years. The Opponent argues that there has been confusion, as evidenced by the allegations to this effect contained in Mr. Chadwick's affidavit. I will deal with these two arguments separately.

#### Absence of confusion

[58] First of all, the absence of confusion is not necessarily conclusive in itself. Often in the past, the Registrar has based his conclusion of absence of likelihood of confusion on the fact that there is an absence of confusion despite an exhaustive use of the parties' marks in the same territory for a long time. Yet in the present case, the Opponent operates only two clinics located in à Kingston and Ottawa, while the Applicant has only one place of business, on Île des Sœurs

in the Montreal area. Moreover, I do not have enough information on the magnitude of the parties' turnover during this period of coexistence. I therefore consider, in the circumstances, that the absence of proof of a case of confusion is not a determining factor in this case.

#### Case of confusion

[59] Regarding the case of confusion alleged by the Opponent, it can be summarized as follows. Mr. Chadwick alleges that the existence of the clinic operated by the Applicant was brought to his attention by colleagues in the laser surgery vision correction field. These persons believed that the trade-marks used by the Applicant were confusing with the Opponent's marks.

[60] In the first place, I must point out that there is no information regarding the names of the persons who communicated with Mr. Chadwick or the dates or these communications, or how these communications occurred. Moreover, Mr. Chadwick does not tell us why these persons could not have signed an affidavit to this effect. The content of these communications appears to be hearsay and the Opponent has not proved the criteria of admissibility of such evidence or the necessity and reliability of such information (*R v Kahn* [1990] 2 SCR 531).

#### State of the Register

[61] Attached to Mr. Podteteney's affidavit as Exhibit C is a search of the Canadian Intellectual Property Office (CIPO) trade-marks database. Mr. Podteteney alleges this search proves that the word 'focus' is used in a multitude of fields and for a variety of trade-marks.

[62] I note that Mr. Podteteney does not indicate in his affidavit whether he or another person conducted this search. Moreover, he does not describe the methodology used to conduct this search. Finally, even if I accepted this evidence, the majority of the citations are registration applications that were discontinued or are under opposition. The only registered trade-marks that appears relevant is YOUR VISION, OUR FOCUS, registration TMA724,612. I cannot infer from a single citation that the use of the word 'focus' as a component is widespread in the ophthalmology field [see *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

### The location of the parties' places of business

[63] Both in its written arguments and during the hearing, the Applicant argued that there cannot be confusion, because the Opponent has only two places of business, both located in Ontario, while the Applicant operates in Montreal. Moreover, the Applicant argues that the evidence proves it has a local clientele, in the Montreal area.

[64] I must remind the parties that the registration of a trade-mark gives the owner of this mark the exclusive right to use it throughout Canada [see section 19 of the Act]. Thus, the Opponent is not limited to using its registered trade-marks in Ontario. It has the right to use them in the rest of Canada, including Montreal. The same is true for the Applicant which, if it obtains registration of the Mark, will be able to use it in the rest of Canada, including Ontario. This is the reason why, in section 6(2) of the Act, it is stipulated that the 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 services associated with those marks are performed by the same person.

### Conclusion

[65] Although the parties' marks are weak marks, I am not satisfied that the Applicant has fulfilled its legal onus of proving, on a balance of probabilities, that the Mark is not confusing with the Opponent's mark. I find that the length of time the marks have been in use (section 6(5)(b)), the nature of the services and the nature of the trades of the parties (sections 6(5)(c) and (d)), and the degree of resemblance between the marks involved (section 6(5)(e)) work in the Opponent's favour.

[66] I therefore accept this ground of opposition.

### Ground of opposition based on section 16(1)(a) of the Act

[67] The Opponent argues in its statement of opposition that the Applicant is not the person entitled to registration of the Mark under section 16(1)(a) and (c) of the Act, because on the date of first use of the Mark alleged in the registration applications, it was confusing with the Opponent's trade-marks described above.

[68] The relevant date to analyze this ground of opposition is the date of first use of the Mark alleged in the registration applications (October 1, 2008) [see section 16(1) of the Act].

[69] To satisfy its initial burden under section 16(1) of Act, the Opponent must prove the use of its trade-marks before the date of first use alleged by the Applicant in its registration applications (October 1, 2008) and that it had not discontinued them as of the date of publication of the Applicant's registration applications (August 29, 2012) [see *Optic Nerve Art & Design Ltd v Optic Nerve Design*, 2005 CanLII 78205].

[70] The Opponent's Evidence detailed under the preceding ground of opposition meets these requirements. I therefore find that the Opponent has discharged its initial burden.

[71] Regarding the analysis of the relevant factors enumerated in section 6(5) as of October 1, 2008, I find that the same result follows as the one obtained under the ground of opposition based on section 12(1)(d) of the Act, and for the same reasons: the Applicant was unable to prove, by a balance of probabilities, that there was no confusion, on the relevant date, between the Mark and the Opponent's FOCUS EYE CENTRE & Design mark when the Mark is used in association with the Services.

[72] I therefore also accept this ground of opposition.

#### Other grounds of opposition

[73] Considering that the Opponent has prevailed on two distinct grounds of opposition, it is unnecessary to rule on the other grounds of opposition (sections 2 and 16(1)(c) of the Act).

Decision

[74] In exercising the authority delegated to me pursuant to the provisions of section 63(3) of the Act, I refuse registration applications No. 1,551,638 and No. 1,551,642 according to the provisions of section 38(8) of the Act.

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Jean Carrière  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

Certified translation  
Arnold Bennett

Date of hearing: 2015-08-27

Appearances

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