



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

Citation: 2016 TMOB 166
Date of Decision: 2016-10-11

IN THE MATTER OF AN OPPOSITION

AMG Medical Inc.

Opponent

and

Ronco Disposable Products

Applicant

1,571,574 for DEFENSOR

Application

[1] AMG Medical Inc. (the Opponent) opposes registration of the trade-mark DEFENSOR (the Mark) that is the subject of application No. 1,571,574.

[2] The application is based upon use of the Mark in Canada since January 20, 2011 in association with the following goods:

Cut resistant gloves, work gloves, 7 gauge, 10 gauge, 13 gauge, 15 gauge, 18 gauge knitted cut resistant gloves, HPPE gloves, aramid gloves, stainless steel gloves, fibreglass gloves, PU gloves, nitrile gloves, foam nitrile gloves, latex gloves, neoprene gloves, palm coated gloves, fully coated gloves, stainless steel mesh gloves.

[3] The opposition was brought by the Opponent under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) and raises grounds of opposition based upon sections 2 (non-distinctiveness); 12(1)(d) (non-registrability); 16(1)(a) (non-entitlement); and 30(i) (non-conformity) of the Act. The central issue is whether there is a likelihood of confusion between the Mark and the Opponent's trade-mark DEFENSE registered under No. TMA630,420 in association with the following goods:

Thermometers (human medical use); stethoscopes; isolation gowns; lab gowns; fluid impervious gowns; gloves; shoe covers; boot covers; coveralls; headgear, namely bouffants caps, surgeon's cap; eyewear namely, goggles and eyeshields; dental and surgical masks; masks with shield; biohazard bags; hand sanitizer; operating room drapes and table covers; isolation kit, namely kits of protective equipment used for infection control purposes; hoods; lab coats; sleeve covers.

and which has been used by the Opponent in Canada in association with the registered goods “gloves”.

[4] For the reasons that follow, the opposition is successful.

The Record

[5] The application was advertised for opposition purposes in the *Trade-marks Journal* on April 2, 2014.

[6] The Opponent opposed the application by a statement of opposition filed with the Registrar on June 2, 2014. The Applicant filed and served a counter statement on October 7, 2014 denying each of the grounds of opposition set out in the statement of opposition.

[7] In support of its opposition, the Opponent filed the affidavit of its Vice President Marketing, Danny Meyers, sworn February 5, 2015 (the Meyers affidavit).

[8] In support of its application, the Applicant filed the affidavit of its President and Chief Executive Officer, Ron Pecchioli, sworn June 3, 2015 (the Pecchioli affidavit).

[9] Only the Applicant filed a written argument but both parties made submissions at an oral hearing. As objected to by the Opponent at the hearing, the Applicant has tried to introduce state of the register evidence in its written argument. I will return to that point later when assessing the additional surrounding circumstances under the test for confusion.

Analysis

The parties' respective burden or onus

[10] 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 Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 2002 FCA 29, 20 CPR (4th) 155 (FCA)].

The non-registrability ground of opposition

[11] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of section 12(1)(d) of the Act in that it is confusing with the Opponent's registered trade-mark DEFENSE referred to above.

[12] I have exercised the Registrar's discretion to confirm that this registration is in good standing as of today's date, which is the material date for assessing a section 12(1)(d) ground of opposition [see *Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[13] As the Opponent's evidential burden has been satisfied, the Applicant must therefore establish on a balance of probabilities that there is not a reasonable likelihood of confusion between the Mark and this registered trade-mark of the Opponent.

The test for confusion

[14] Section 6(2) of the Act provides 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 goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[15] Thus, this section does not concern the confusion of the trade-marks themselves, but confusion of goods or services from one source as being from another source.

[16] The test for confusion is one of first impression and imperfect recollection. As stated by Mr. Justice Denault in *Pernod Ricard v Molson Breweries* (1992), 44 CPR (3d) 359 (FCTD) at 369:

The trade marks should be examined from the point of view of the average consumer having a general and not a precise recollection of the earlier mark. Consequently, the marks should not be dissected or subjected to a microscopic analysis with a view to assessing their similarities and differences. Rather, they should be looked at in their totality and assessed for their effect on the average consumer as a whole.

[17] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at 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 the trade-marks have been in use; (c) the nature of the goods, 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. This list is not exhaustive and all relevant factors are to be considered. Further, all factors are not necessarily attributed equal weight as the weight to be given to each depends on the circumstances [see *Mattel, Inc v 3894207 Canada Inc* (2006), 2006 SCC 22, 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 2006 SCC 23, 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 2011 SCC 27, 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion].

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

Inherent distinctiveness

[18] The Opponent contends that the marks of both parties are inherently distinctive although neither mark is inherently strong. Both marks suggest that the parties' respective gloves protect the hands of the people wearing them.

[19] The Applicant partly disagrees with the Opponent. In its written argument, the Applicant submits that:

14. The Opponent's [mark DEFENSE] is a regular dictionary word, widely used in the marketplace, that describes a functional aspect of the Opponent's [goods]. Using the Opponent's [goods] will defend against medical harms. It has been held that words that describe a functional aspect of goods are considered "weak marks", lack distinctiveness and should be afforded less protection.

15. In addition, as described above, the Trademarks Registrar [sic] contains a large number of registered trademarks that contain the words “defence”, “defense” or the “defen” combination of letters. [...] It is submitted that the state of the Registrar [sic] and the co-existence of the Opponent’s [m]ark with these other registered trademarks indicate a lack of inherent distinctiveness for the Opponent’s [m]ark.

16. Conversely, the Applicant’s Mark is not a simple common word and is merely suggestive of the functionality of the Applicant’s Mark. Given the low inherent distinctiveness of the use of the word “defence” or “defense”, small differences in the two trade-marks will suffice to distinguish one mark from the other. Furthermore, it is submitted that given the lack of inherent distinctiveness in the Opponent’s [m]ark, it cannot be entitled to obtain exclusive property rights over a commonly used word to the detriment of other traders that wish to suggest the functionality of their products.

[20] At the hearing, the Applicant went further and contended that the Mark is a “coined word”.

[21] I find the truth is somewhere between the two parties’ views.

[22] The fact that there may be other “defence” or “defense” trade-marks standing on the register of trade-marks does not come into play when assessing the *inherent* distinctiveness of each of the parties’ mark per se. However, state of the register evidence may constitute a relevant circumstance to be considered as an additional circumstance under the test for confusion. I will return to that point later.

[23] As pointed out to the Applicant at the hearing, I may take judicial notice of dictionary definitions. In this regard, I note that the *Merriam-Webster Online Dictionary* defines “defensor” as an obsolete word for “defender”.

[24] As such, I agree with the Applicant that the Mark is not a common ordinary word. Still, the Mark suggests the idea that the Applicant’s gloves protect the hands of the people wearing them. That being so, I agree with the Opponent that the Mark is also inherently weak, although less so than the Opponent’s mark. In this regard, I would not go so far as to conclude that the Opponent’s mark lack inherent distinctiveness. I consider the parties’ marks to have a certain, albeit rather weak, inherent distinctiveness, though to a lesser extent for the Opponent’s mark given the greater suggestive connotation of the ordinary word “DEFENSE”.

Extent to which the trade-marks have become known

[25] The strength of a trade-mark may be increased by making it known through promotion or use. This brings me to review the evidence on this point filed through the Meyers and Pecchioli affidavits, in light of some of the representations made by the parties.

[26] I shall note that I am not affording weight to any of the statements made by the affiants that constitute personal opinion on the likelihood of confusion between the parties' marks. The likelihood of confusion is a question of fact and law to be determined by the Registrar based on the evidence of record in the present proceeding.

The Meyers affidavit

[27] Mr. Meyers states that the Opponent has used the trade-mark DEFENSE in Canada since at least as early as December 2004 and has extensively used (and presently uses) the mark in association with gloves.

[28] More particularly, Mr. Meyers explains that the Opponent sells four types of medical examination gloves under the DEFENSE mark, namely nitrile gloves, vinyl gloves, synthetic gloves and latex gloves.

[29] Mr. Meyers states that gloves bearing the DEFENSE mark are a very important product of the Opponent. In this regard, he provides a table detailing the sales (in Canadian dollars) of the Opponent's gloves bearing the trade-mark DEFENSE in Canada from 2012 to 2014 (up to date with the most recent available sales figures as of the date of his affidavit), according to which the Opponent has sold over 11 million dollars of gloves bearing the DEFENSE mark in Canada since 2012.

[30] In support of his statements of use of the DEFENSE mark, Mr. Meyers attaches the following exhibits to his affidavit:

- Exhibit B, which he describes as a printout of the electronic file used by the Opponent to print boxes bearing the DEFENSE mark that are used to package the Opponent's gloves

when sold in Canada. Mr. Meyers explains that the Opponent's gloves bearing the DEFENSE mark are sold in boxes containing a variable amount of disposable gloves;

- Exhibit C, which he explains, consists of pictures of different boxes of gloves bearing the DEFENSE mark as they are sold in Canada;
- Exhibit D, which he describes as advertising documents (namely "flyers") "showing different box designs that *were used throughout the years* [my emphasis] to package [the Opponent's] DEFENSE gloves when sold in Canada"; and
- Exhibits E and F, which consist of printouts of the websites <http://www.medprodefense.com/products/products-gloves.asp> and <http://www.amgmedical.com> showing how the DEFENSE mark is featured in the advertising of the Opponent's medical examination gloves.

[31] Mr. Meyers explains that although the Opponent does not directly spend money to advertise its gloves bearing the DEFENSE mark, the Opponent provides money to its distributors for the advertising of its products to health institutions. In turn, he is aware that these distributors, from time to time, distribute flyers to health institutions advertising the Opponent's DEFENSE gloves. Mr. Meyers states that the Opponent also provides free samples of gloves bearing the DEFENSE mark to its clients to conduct trials when bidding for various hospital contracts.

[32] Mr. Meyers states that the Opponent sells its DEFENSE gloves through two different channels of trade. First, to hospitals and health institutions across Canada through distributors, the largest one being Cardinal Health. Second, directly to Wal-Mart a major retailer and numerous chains of retail pharmacies across Canada.

[33] Both in its written argument and at the hearing, the Applicant has contended that the pictures of all of the boxes contained in the above-mentioned exhibits show the use of the design mark containing the phrase "MedPro Defense" and not the word mark DEFENSE. It submits that in fact, in its trade-mark notices on its advertisements and other documents included in the above-mentioned exhibits, the Opponent clearly inputs the ® symbol after the use of the phrase

“MedPro Defense”. At the hearing, the Applicant went further and contended that the word “DEFENSE” was used descriptively in some of the advertising material filed under Exhibit D.

[34] I disagree with the Applicant’s position.

[35] The use of a trade-mark in combination with additional words or features constitutes use of the registered trade-mark if the public, as a matter of first impression, would perceive the trade-mark per se as being used. This is a question of fact which is dependent on whether the trade-mark stands out from the additional material, for example by the use of different lettering or sizing, or whether the additional material would be perceived as clearly descriptive matter or as a separate trade-mark or trade-name [see *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); and *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)]. Furthermore, it is trite law that nothing prohibits the use of two or more trade-marks simultaneously [see *AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD)].

[36] In the present case, given the positioning and the use of the different fonts, sizes and colours, I agree with the Opponent that the word “DEFENSE” would likely be perceived as a separate trade-mark by the public on first impression despite being used in conjunction with the word “MedPro” and a shield design in the sample packaging provided in Exhibits B, C and D, reproduced in part in Schedule A attached hereto.

[37] Contrary to the Applicant’s contention, I do not believe that the placement of the registered trade-mark symbol after the word “DEFENSE” necessarily indicates that the phrase “MedPro Defense”, with or without the shield design element, is used as a unitary trade-mark. It may reflect trade-mark rights in the word “DEFENSE”, apart from the phrase “MedPro DEFENSE” and shield design [see, for example, *Barbera 1870 SpA v Barbera Caffé SpA*, 2012 TMOB 99, 102 CPR (4th) 49; and *Fraser Milner Casgrain LLP v LG Electronics Inc*, 2014 TMOB 232 (CanLII), CarswellNat 5618]. Furthermore, as pointed out by the Opponent at the hearing, the sample packaging (and advertisement) filed under Exhibit D reproduced in part in Schedule A specifically includes the registered trade-mark symbol after the word “MedPro” distinct from the word “DEFENSE”.

[38] Also, contrary to the Applicant's contention, I do not believe that the word "DEFENSE" is used descriptively by the Opponent in that later sample packaging (and advertisement). What is used descriptively is the phrase "Personal Protection Equipment / Équipement de protection personnelle" beneath the word "DEFENSE". Again, the word "DEFENSE" stands out.

[39] That being said, I agree with the Applicant that the manners of use and advertising of the trade-mark DEFENSE with gloves diminish somewhat the measure of reputation that the Opponent can claim in it. While the Meyers affidavit establishes extensive use of the trade-mark DEFENSE in association with the Opponent's gloves in Canada since at least as early as 2012, if not before, it always appears in association with other trade-marks that are also shown in a prominent fashion on the packaging of the Opponent's gloves. Consequently, the reputation which would accrue to the Opponent's trade-mark DEFENSE on its own is somewhat diminished with respect to its goods [see *Euro-Pharm International Canada Inc v Eurofarma Laboratórios Ltda* 2015 TMOB 91].

[40] Even so, I agree with the Opponent that it can reasonably be concluded that the trade-mark DEFENSE has become known to a fairly significant extent in Canada in relation to the Opponent's medical examination gloves.

The Pecchioli affidavit

[41] Mr. Pecchioli states that the Applicant has extensively used (and presently uses) the Mark in Canada "in relation to a line of cut-resistant gloves" since at early as June 2011. He refers collectively to these gloves as the "Products" and I will do the same while summarizing his evidence.

[42] Mr. Pecchioli states that the Products bearing the Mark are manufactured for the purpose of improving occupational health and safety by protecting against cut and scrape work hazards.

[43] Mr. Pecchioli states that the Applicant markets and sells the Products to be used for the following purposes:

- (a) automobile manufacturing and assembly;
- (b) cable and wiring handling;

- (c) construction and renovations for handling building materials and power tools;
- (d) glass handling;
- (e) metal fabrication and process;
- (f) metal handling of all types;
- (g) residential and institutional window and door manufacturing;
- (h) metal cutting industry;
- (i) shipping and receiving areas where knives and blades are used;
- (j) food processing environment where knives are being used.

[44] Mr. Pecchioli explains that the line of Products includes cut resistant gloves that vary in what the Applicant identifies as a “cut-resistant level”, referring to the strength of the material used. End-users of the Products will select a particular “cut-resistant level” that suits their intended use.

[45] Mr. Pecchioli states that since launching the Products, the Applicant has steadily improved its sales figures of the Products and he provides the gross sales figures (in Canadian dollars) of the Products in Canada from 2012 to 2015 (up to May 31, 2015), which amount to in excess of 310,000 dollars.

[46] Mr. Pecchioli states that the Mark is prominently displayed on all of the Products and its packaging when sold in Canada. All of the Products are intended to be reusable products and are not intended to be disposable.

[47] Mr. Pecchioli explains that the Products are sold by the packaged bag or case. For all Products except the Defensor 69-510 Cut-Level 5 gloves, each bag contains 6 pairs of gloves and each case contains eight bags. Each bag of the Defensor 69-510 Cut-Level 5 gloves contains 12 pairs per bag and 6 bags per case. The price of each of the Products ranges from over \$ 4.00 to \$9.00 per pair of gloves. The price of each case ranges from under \$200.00 to \$400.00.

[48] Mr. Pecchioli states that the Applicant markets the Products to its target distributors through the use of catalogues, flyers and other forms of advertisement. In addition, the Applicant

advertises the Products on its website (<http://ca.en.safety.ronco.ca/category/25/safety-gloves.html>).

[49] In support of his statements of use of the Mark, Mr. Pecchioli attaches the following exhibits to his affidavit:

- Exhibit A, which he describes as pictures of several Products, each of which bears the Mark;
- Exhibit B, which he describes as pictures of the bags that the pairs of gloves are packaged in and the case in which the bags are packaged in, each of which bears the Mark as they are sold in Canada;
- Exhibit C, which he describes as pictures of advertisements prominently displaying the Mark, used by the Applicant to promote the Products and their intended uses; and
- Exhibit D, which he describes as screenshots of the advertisements of the Products and the use of the Mark displayed on the Applicant's website.

[50] To sum up, I agree with the Applicant that its Mark has become known to some extent in Canada.

Conclusion regarding section 6(5)(a)

[51] In the end, I agree with the Opponent that the overall consideration of the section 6(5)(a) factor, which involves a combination of inherent and acquired distinctiveness of the parties' marks, favours it. While the Mark has a somewhat higher degree of inherent distinctiveness, the Opponent's mark has more acquired distinctiveness. The Opponent sold over 11 million dollars' worth of medical examination gloves from 2012 to 2014, compared to the Applicant's sales amounting to about 310,000 dollars' worth of cut-resistant gloves from 2012 to 2015 (up to the May 31, 2015).

The length of time the trade-marks have been used

[52] The mere existence of a registration can establish no more than “de minimis” use and cannot give rise to an inference of continuing use of the mark [see *Entre Computer Centers, Inc v Global Upholstery Co* (1992), 40 CPR (3d) 427 (TMOB)].

[53] In the present case, the registration for the Opponent’s trade-mark DEFENSE refers to a declaration of use of the mark filed on December 9, 2004 and Mr. Meyers asserts that the Opponent has used it since then. While his affidavit does not necessarily establish continuous use of the DEFENSE mark in association with the Opponent’s medical examination gloves dating as far back as 2004, it does positively evidence such use since at least as early as 2012, if not well before (see the sample advertising documents showing different box designs which Mr. Meyers asserts, *were used throughout the years* to package the Opponent’s DEFENSE gloves filed under Exhibit D).

[54] In comparison, the Applicant’s application claims a date of first use of the Mark dating back to January 20, 2011 and Mr. Pecchioli asserts that the Applicant has used the Mark since as least as early as June 2011. While his affidavit does not establish continuous use of the Mark in association with the Applicant’s cut-resistant gloves dating back to 2011, it does positively evidence such since at least as early as 2012.

[55] Having regard to the foregoing, I find that the overall consideration of this second factor does not significantly favour one party over the other.

The nature of the goods, services or business, and the nature of the trade

[56] When considering the nature of the goods, services or business and the nature of the trade, I must compare the Applicant’s statement of goods with the statement of goods in the registration relied upon by the Opponent [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties’ actual

trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 1996 CanLII 3963 (FCA), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[57] As indicated above, the Opponent's registration covers, among other goods: "gloves".

[58] In its written argument, the Applicant submits that a search of the word "gloves" in the Canadian Intellectual Property Office Goods and Services Manual approved terms tool provides the Practice Note that the entry of the word "gloves" (on its own without any additional adjective or descriptive term) signifies "the most commonly understood meaning of gloves, i.e. a fitted covering for the hand for casual or formal wear". In addition, the Manual lists the phrases "gloves for use in hospitals" and "latex gloves" as approved terms that could have been used to differentiate from the common use of the word "gloves".

[59] The Applicant also puts great emphasis on the fact that the Opponent's gloves are always sold in boxes that contain 100 to 200 disposable, thin gloves. It points out that Exhibit D to the Meyers affidavit indicates that the boxes are sold at a price between \$6.99 and \$14.99. Therefore, while not sold individually, the unit cost of each pair of gloves is between \$0.07 and \$0.14. The Applicant submits that conversely, its gloves are sold by the case, each case containing either 6 or 8 bags, each bag containing 6 or 12 pairs of the Applicant's gloves. The unit cost of each pair of gloves ranges from \$4.00 to \$9.00. The Applicant submits that given the dramatic price increase per unit, a reasonable purchaser would exercise caution and carefully evaluate the products he/she wishes to purchase rather than simply relying upon a hasty impression of the trade-mark. It would be clear upon first impression of the Applicant's products and the Opponent's products which gloves are disposable and sold at a cost per unit indicative of a disposable product, and which gloves are not disposable and sold at a cost per unit of a reusable, durable pair of gloves intended for specific industrial uses. The Applicant submits that given the look of the products and their packaging, the number and price of each unit, target purchasers of both the Applicant's products and the Opponent's products would not be confused.

[60] The Applicant further submits that its products are sold through an authorized network of distributors that specifically target the food and industrial market segments, and do not sell to the health industry. The Applicant adds that it does not distribute directly to consumers.

[61] The Applicant submits that consumers who purchase the Opponent's products through retailers would not be confused by the Applicant's products as the Applicant's products are not sold to end-consumers. The Applicant further submits that distributors who purchase the Opponent's products would not be confused by the Applicant's products because the Applicant does not sell the Applicant's products to distributors who wholesale to the health industry.

[62] I do not find these arguments to be persuasive.

[63] First, the goods "gloves" in the statement of goods of the Opponent's registration must be read in the context of the entire statement of goods. It can readily be understood that they are not meant for casual or formal wear. The Meyers affidavit further shows that the Opponent's gloves consist of four types of medical examination gloves, namely nitrile gloves, vinyl gloves, synthetic gloves and latex gloves, which can be used for different purposes like "Bloodborne pathogens"; "Emergency room", "Laboratory", "Harsh Chemicals", "Mechanical", "Food handling", and "Housekeeping" [see, among others, the sample advertisements attached under Exhibit D to the Meyers affidavit, reproduced in part in Schedule B attached hereto].

[64] Second, the fact that the parties' gloves are sold at different prices is not that a significant consideration. For one thing, the Opponent's gloves, like the Applicant's, are not sold per unit. Rather, Mr. Pecchioli asserts that the Applicant's gloves are sold by the packaged bag or case. Further, even if the Applicant's gloves are in fact more expensive, the Supreme Court of Canada stated in *Masterpiece, supra*, that although consumers in the market for expensive goods may be less likely to be confused, the test is still one of first impression. It is an error to believe that, since consumers of expensive goods and services generally take considerable time to inform themselves about the source of those goods and services, there is a reduced likelihood of confusion. Confusion must instead be assessed from the perspective of the first impression of the consumer approaching a costly purchase when he or she encounters the trade-mark. The possibility that careful research may later remedy confusion does not mean that no confusion

ever existed or that it will not continue to exist in the minds of consumers who did not carry out that research.

[65] Third, the “look” of the parties’ products and their packaging is not a relevant consideration. While such considerations as design and get-up are certainly relevant in a passing off action, such is not the case where an opponent is relying upon a trade-mark registration in opposing an applicant’s trade-mark application [see *WordPerfect Corporation v Formulator Software Inc*, 1990 CanLII 6412 (TMOB)].

[66] Fourth, the Opponent’s gloves are not strictly confined to the health industry. As mentioned above and as stressed by the Opponent at the hearing, the Meyers affidavit shows that the Opponent’s medical examination gloves can be used for different purposes like “Laboratory”, “Harsh Chemicals”, “Mechanical”, “Food handling”, and “Housekeeping”. I agree with the Opponent that some of these purposes apparently overlap with the ones described above by Mr. Pecchioli.

[67] Far from contradicting this point, the website excerpts filed under Exhibit D to the Pecchioli affidavit specify that the Applicant’s cut-resistant glove “DEFENSORTM 69-510 can be worn by itself, or as a liner underneath a *disposable glove* [my emphasis] or another glove that is not cut resistant, or as a back-up underneath another cut-resistant glove in situations where the cut hazard is extremely high” [see also the sample advertisements attached under Exhibit C to the Pecchioli affidavit reproduced in part in Schedule C attached hereto, showing the Applicant’s DEFENSOR glove worn as a liner underneath a disposable glove similar to the types of gloves sold by the Opponent, in the handling of food].

[68] Fifth, the Pecchioli affidavit focuses on the Applicant’s “line of cut-resistant gloves” only, whereas the statement of goods covered by the Applicant’s application would encompass also other types of gloves not specifically characterized as being cut-resistant, such as HPPE gloves, aramid gloves, nitrile gloves, foam nitrile gloves, latex gloves, neoprene gloves, palm coated gloves, and fully coated gloves, which could potentially overlap with the Opponent’s nitrile gloves, vinyl gloves, synthetic gloves and latex gloves. I acknowledge that many of the Applicant’s gloves depicted in the exhibits attached to the Pecchioli affidavit are described as “Nitrile Palm Coated Aramid *Cut Resistant Gloves*” [my emphasis] or “PU Palm Coated HPPE

Cut Resistant Gloves” [my emphasis]. However, the statement of goods in the Applicant’s application contains no such restriction.

[69] Sixth, while Mr. Pecchioli states in his affidavit that the Applicant sells its cut-resistant gloves “through an authorized network of distributors that specifically target the food and industrial market segments” described above in paragraph 43, and that the Applicant “does not and has no intentions of using the [Mark] in association with disposable examination gloves to be sold to distributors or consumers in the medical or hospital industries”, the application for the Mark does not include any restriction on the channels of trade through which the Applicant’s goods may travel. Neither does the Opponent’s registration for the trade-mark DEFENSE.

[70] In this regard, the Meyers affidavit establishes that the Opponent’s gloves are not only sold to hospitals and health institutions across Canada, but also directly to major retailer Wal-Mart and numerous chains of retail pharmacies across Canada.

[71] As stressed by the Opponent at the hearing, it is also worth noting that Mr. Meyers states in his affidavit that:

I am directly and personally aware of the activities of Ronco Disposable Products in Canada and I am aware that they do sell medical examination gloves in Canada. I consider Ronco Disposable Products as a direct competitor of the Opponent.

[72] Far from contradicting this point, the website excerpts pertaining to the Applicant’s DEFENSOR™ 69-510 HPPE Glove Cut Level 5 filed under Exhibit D to the Pecchioli affidavit provide under the heading “Quick Links” a list of what appears to be links to other sections of the Applicant’s website relating to other products of the Applicant in the following fields: “HEAD PROTECTION”; “HAND PROTECTION”; “BODY PROTECTION”; “FOOD”; “HEALTHCARE”; and “INDUSTRIAL”. I note that the excerpts also include under the heading “Related Products”, what appears to be photographs and links to other products of the Applicant like DEFENSOR™ 69-560 glove; polypropylene shoe cover; disposable gloves; and safety glasses. Nothing prevents the Applicant from expanding its current line of products offered to the healthcare industry to include the DEFENSOR gloves.

[73] Lastly, it is worth reminding that it is not necessary that the parties operate in the same general field or industry or that their respective goods and services be of the same type or quality for there to be a likelihood of confusion. As stated in section 6(2) of the Act, confusion may occur “whether or not the goods or services are of the same general class.”

[74] Having regard to the foregoing, I find that the overall consideration of these third and fourth factors favours the Opponent.

The degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[75] As noted by the Supreme Court in *Masterpiece, supra*, at paragraph 49, “the degree of resemblance, although the last factor listed in [section] 6(5) [of the Act], is the statutory factor that is often likely to have the greatest effect on the confusion analysis [...] if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion”.

[76] Moreover, as previously mentioned, it is well-established in the case law that likelihood of confusion is a matter of first impression and imperfect recollection. In this regard, “[w]hile the marks must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public’s perception of it” [see *Pink Panther Beauty Corp v United Artists Corp* (1998), 1998, CanLII 9052 (FCA), 80 CPR (3d) 247 (FCA), at para 34]. Even though the first word or portion of a trade-mark is generally the most important for the purpose of distinction, the preferable approach is to first consider whether any aspect of the trade-mark is particularly striking or unique [see *Masterpiece, supra*, at para 64].

[77] Applying those principles to the present case, I find there is a fairly high degree of resemblance between the parties’ marks. They only differ by their endings: the letter “E” in the Opponent’s mark has been replaced by the suffix “OR” in the Mark.

[78] With regard to the Applicant’s submissions that the Mark has no meaning in the trade and is not common parlance, I note that one must have regard to common sense when assessing the

first impression of the Mark having regard to the goods in question [see *Neptune SA v Canada (Attorney General)* (2003), 29 CPR (4th) 497 (FCTD); and *Ontario Teachers' Pension Plan Board v Canada (Attorney General)* (2010), 89 CPR (4th) 401 (FC); 99 CPR (4th) 213 (FCA)].

[79] Regardless of whether one knows that the Mark is an obsolete word for “defender”, it is readily apparent that the Mark is derived from the word “defense”. The suffix “-or” denotes “‘a person or thing that does something’, e.g. *investigator, decorator, escalator, ventilator*” [see *The English Oxford Living Dictionaries*]. In the present case, both marks suggest that the parties’ respective gloves protect the hands of the people wearing them. As a matter of fact, and as mentioned above under my review of the section 6(5)(a) factor, the Applicant itself acknowledges that the Mark is “suggestive of the functionality” of the Applicant’s gloves.

[80] Before concluding on this fifth factor, I note that I am not placing any weight on the Applicant’s unsubstantiated submission that the word “DEFENSE” is common to the trade. For one thing, the state of the register evidence referred to by the Applicant in its written argument and at the hearing has not been filed in evidence. I will return to this point below. Furthermore, the mere fact that the Opponent’s mark consists of an ordinary dictionary word having a suggestive connotation in the context of the Opponent’s protective gloves is insufficient by itself to lead to a finding that it is necessarily common to the trade.

Additional surrounding circumstances

State of the register

[81] As mentioned above, the Applicant has tried to introduce state of the register evidence in its written argument.

[82] More particularly, the Applicant refers to 171 registered trade-marks that would contain the word “defence” or “defense” and 273 registered trade-marks that would contain the combination of letters spelling “defen” standing on the Canadian register of trade-marks. The Applicant also lists four trade-marks, namely GORE-TEX BEST DEFENSE (TMA571,251) in relation to goods and services that would include gloves; 2nd DEFENSE (TMA841,071) in relation to goods and services that would include a specified type of glove; DEFENDO & Design

(TMA643,625) in relation to goods and services that would include a specified type of glove; and PREMIUM DEFENSE (allowed application No. 1,664,260) in relation to protective work gloves.

[83] Transposing the comments of the Registrar in *1772887 Ontario Limited v Bell Canada*, 2012 TMOB 42 at paragraph 24, to the present case, I note that state of the register evidence cannot be considered where it is adduced through pleadings and without filing certified copies of the registrations or at least an affidavit affixing particulars of the relevant registrations [see *Unitron Industries Ltd v Miller Electronics Ltd* (1983), 78 CPR (2d) 244 at 253 (TMOB)]. Furthermore, 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 of Canada Ltd / La Compagnie Quaker Oats du Canada Ltd* (1986), 11 CPR (3d) 410 (TMOB) at 411; and *Royal Appliance Mfg Co v Iona Appliance Inc* (1990), 32 CPR (3d) 525 (TMOB)]. The parties to opposition proceedings are expected to prove each aspect of their case following fairly strict rules of evidence [see *Loblaw's Inc v Telecombo Inc* 2004 CarswellNat 5135 at para 13 (TMOB)].

[84] Accordingly, I shall disregard such “evidence” as having not been properly introduced. In any event, I note that only three registered marks and one allowed application would be relevant, which is far from being a sufficient number for inferences about the state of the marketplace to be made [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); and *Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)].

Conclusion regarding the likelihood of confusion

[85] As indicated above, the Applicant bears the legal onus of establishing on a balance of probabilities that its application complies with the requirements of the Act. The presence of a legal onus on the Applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant.

[86] Contrary to the Applicant's contention, the issue is not whether the Opponent ought to be afforded a monopoly over the suggestive word "DEFENSE" in Canada, but whether an individual having an imperfect recollection of the Opponent's DEFENSE trade-mark as associated with the Opponent's gloves, would, as a matter of first impression and imperfect recollection conclude that the Applicant's gloves come from the same source or that some form of authorization exists between the parties. I find this is such a case.

[87] Indeed, in view of the potential overlap between the parties' goods and trades, I am not satisfied that the Applicant has sufficiently distinguished its Mark from that of the Opponent.

[88] Accordingly, the section 12(1)(d) ground of opposition succeeds.

The non-distinctiveness ground of opposition

[89] The Opponent has pleaded that the Mark does not distinguish the applied-for goods of the Applicant from the goods of the Opponent, nor is it adapted so as to distinguish them in view of the Opponent's prior use and registration in Canada of its trade-mark DEFENSE.

[90] An opponent meets its evidential burden with respect to a distinctiveness ground if it shows that as of the filing date of the opposition (in this case June 2, 2014) its trade-mark had become known to some extent at least to negate the distinctiveness of the applied-for mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD)]. As per my review above of the Meyers affidavit, the Opponent has met its evidential burden with respect to its DEFENSE gloves.

[91] The difference in relevant dates does not substantially affect my analysis above under the section 12(1)(d) ground of opposition.

[92] The non-distinctiveness ground of opposition therefore succeeds.

The remaining grounds of opposition

[93] As I have already refused the application under two grounds, I will not address the remaining grounds of opposition.

Disposition

[94] In view of the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule A

Excerpt from Exhibit C to the Meyers affidavit showing pictures of different boxes of gloves



Excerpt from Exhibit D to the Meyers affidavit showing sample advertising documents depicting boxes of gloves

AMG MedPro
The Professional Choice
Le choix des professionnels

Synthetic
Lightly Powdered & Powder Free
Medical Examination Gloves

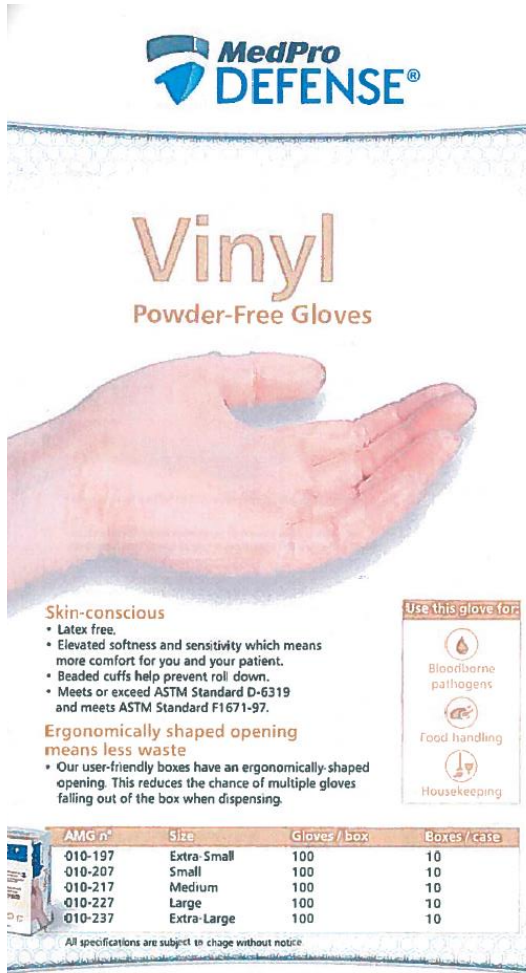
Defense
Protects against bloodborne pathogens
Protège contre les pathogènes sanguins

Hands-On Protection for Medical Professionals

- Proven Barrier Protection**
 - Protect hands against blood borne pathogens such as hepatitis and HIV, as well as body fluids.
 - Meet or exceed ASTM, D5250 requirements for barrier strength
- Greater Fit**
 - Made of stretch vinyl specially formulated to offer greater elasticity and superior fit when compared to traditional vinyl gloves.
- Sensitivity**
 - Our specially formulated polyvinyl chloride gloves offer a smooth surface for superior tactile sensitivity.
- Latex-Free**
 - No risk of allergic reaction to latex proteins because gloves are made of polyvinyl chloride.
- Peace of Mind**
 - All MedPro Defense gloves are manufactured in state-of-the-art manufacturing facilities that are ISO-9002 certified, ensuring consistent quality.
- Economy**
 - Synthetic gloves are a cost-efficient alternative to latex gloves.

Schedule B


Excerpts from Exhibit D to the Meyers affidavit showing sample advertising documents describing different purposes of use



MedPro DEFENSE®

Vinyl

Powder-Free Gloves



Skin-conscious

- Latex free.
- Elevated softness and sensitivity which means more comfort for you and your patient.
- Beaded cuffs help prevent roll down.
- Meets or exceed ASTM Standard D-6319 and meets ASTM Standard F1671-97.

Ergonomically shaped opening means less waste

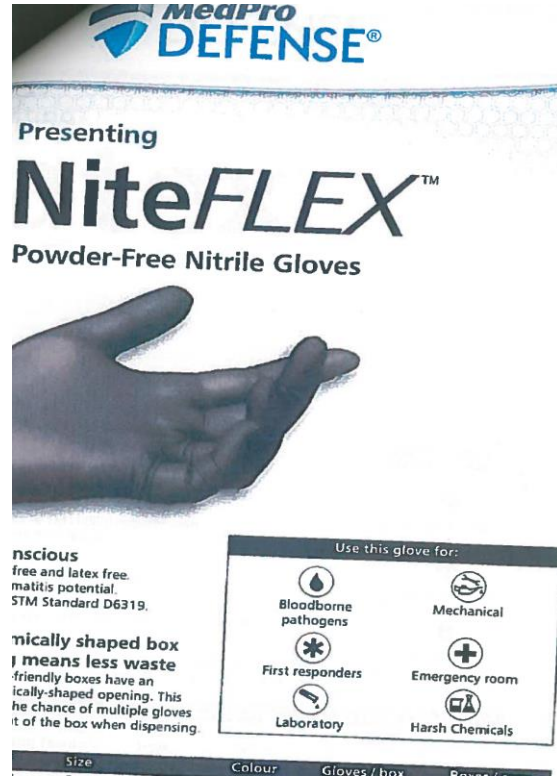
- Our user-friendly boxes have an ergonomically-shaped opening. This reduces the chance of multiple gloves falling out of the box when dispensing.

Use this glove for:

- Bloodborne pathogens
- Food handling
- Housekeeping

| AMG n° | Size | Gloves / box | Boxes / case |
|---------|-------------|--------------|--------------|
| 010-197 | Extra-Small | 100 | 10 |
| 010-207 | Small | 100 | 10 |
| 010-217 | Medium | 100 | 10 |
| 010-227 | Large | 100 | 10 |
| 010-237 | Extra-Large | 100 | 10 |

All specifications are subject to change without notice.




MedPro DEFENSE®

Presenting

NiteFLEX™

Powder-Free Nitrile Gloves



Skin-conscious
 free and latex free.
 malitis potential.
 STM Standard D6319.

Ergonomically shaped box opening means less waste
 friendly boxes have an ergonomically-shaped opening. This reduces the chance of multiple gloves falling out of the box when dispensing.

Use this glove for:

- Bloodborne pathogens
- First responders
- Laboratory
- Mechanical
- Emergency room
- Harsh Chemicals

Size Colour Gloves / box Boxes / case

Schedule C

Excerpt from Exhibit C to the Pecchioli affidavit

DEFENSOR™ 69-510
Cut Resistant Glove, Level 5

**EXPERIENCE CUT PROTECTION
LIKE NEVER BEFORE**

Can be worn by itself, or as a
liner underneath other types
of gloves

CFIA
ACCEPTED

EN388
CE 3542

HEAD HAND BODY
PROTECTION

Tel: 905.660.6700
Email: ronco@ronco.ca
www.ronco.ca

RONCO
focus on quality

For more information call **RONCO now!**

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: 2016-09-13

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