

**IN THE MATTER OF AN OPPOSITION by Ciba-Geigy Canada
Ltd. to application No. 754,955 for the trade-mark “O” PRIN
filed by Laboratoires Dolisos, Société Anonyme**

On May 17, 1994, the applicant, Laboratoires Dolisos, Société Anonyme, filed an application to register the trade-mark “O” PRIN based on proposed use of the trade-mark in Canada in association with “Produits Pharmaceutiques, nommément spray nasal”. The present application was advertised for opposition purposes in the *Trade-marks Journal* of October 18, 1995 and the opponent, Ciba-Geigy Canada Ltd., filed a statement of opposition on January 17, 1996, a copy of which was forwarded to the applicant on February 6, 1996. The applicant served and filed a counter statement on March 1, 1996.

The opponent filed as its evidence the affidavit of Steven Shane while the applicant submitted as its evidence that affidavit of Pascal Frochisse. The opponent submitted a second affidavit of Steven Shane as evidence in reply. Both parties filed written arguments and neither party requested an oral hearing.

The first ground of opposition is based on Subsection 30(e) of the *Trade-marks Act*, the opponent alleging that the applicant did not intend to use the trade-mark “O” PRIN in Canada as of the filing of the application and did not intend to use the mark as a trade-mark. The opponent also alleged that the present application does not comply with Subsection 30(i) of the *Trade-marks Act* in that the applicant was, at the time of filing the present application, aware of the opponent’s registered trade-marks OTRIVIN, registration No. 108,783 and OPHRIVIN-A, registration No. 413,101, and could not therefore have been satisfied as to its entitlement to use the mark “O” PRIN.

While the legal burden is upon the applicant to show that its application complies with Subsections 30(e) and 30(i) of the *Trade-marks Act*, there is an initial evidential burden on the opponent in respect of its Section 30 grounds [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330]. As no evidence has been filed by the opponent in support of its allegation that the applicant did not intend to use the trade-mark “O” PRIN in Canada, the opponent has failed to meet the evidential burden upon it in respect of this ground.

Likewise, as no evidence has been furnished by the opponent in support of its allegation that the applicant could not have been satisfied that it was entitled to use the trade-mark “O” PRIN in Canada, the opponent has failed to meet the evidential burden upon them in respect of the Subsection 30(I) ground. Moreover, even had the applicant been aware of the opponent’s trade-marks OTRIVIN and OPHRIVIN-A prior to filing the present application, such a fact does not preclude the applicant from being satisfied that it was entitled to use the trade-mark “O” PRIN in Canada on the basis *inter alia* that its mark is not confusing with the opponent’s trade-marks. Thus, the success of this ground is contingent upon a finding that the trade-marks at issue are confusing [see *Consumer Distributing Co. Ltd. v. Toy World Ltd.*, 30 C.P.R. (3d) 191, at p. 195; and *Sapodilla Co. Ltd. v. Bristol-Myers Co.*, 15 C.P.R. (2d) 152, at p. 155].

The remaining grounds of opposition all turn on the issue of confusion, the opponent alleging that the applicant’s trade-mark “O” PRIN is not registrable and not distinctive, and that the applicant is not the person entitled to its registration, in that the trade-mark “O” PRIN is confusing with its trade-marks OTRIVIN and OPHRIVIN-A, registration Nos. 108,783 and 413,101, which had previously been used in Canada in association with pharmaceutical preparations for human and veterinary use (registration No. 108,783) and decongestant and anti-allergy preparation (registration No. 413,101). In assessing whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those specifically enumerated in Subsection 6(5) of the *Trade-marks Act*. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between its trade-mark “O” PRIN and the opponent’s trade-marks OTRIVIN and OPHRIVIN-A as of the material dates in this proceeding. The material date in respect of the Paragraph 12(1)(d) ground of opposition is the date of decision [see *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. et al*, 37 C.P.R. (3d) 413 (F.C.A.)] while the material dates for assessing the non-entitlement and non-distinctiveness grounds are, respectively, the applicant’s filing date [May 17, 1994] and the date of opposition [January 17, 1996].

Considering initially the inherent distinctiveness of the trade-marks at issue [Para. 6(5)(a)],

both the applicant's trade-mark "O" PRIN and the opponent's trade-marks OTRIVIN and OPHRIVIN-A are inherently distinctive as applied to the respective wares of the parties.

With respect to the extent to which the trade-marks at issue have become known [Para. 6(5)(a)], and having regard to the first Shane affidavit, I have concluded that the opponent's trade-mark OTRIVIN has become fairly well known in Canada in association with an over-the-counter nasal decongestant with sales from 1988 to 1995 inclusive exceeding \$40,000,000 while total advertising expenditures from 1988 to 1996 exceeded \$11,000,000. On the other hand, the opponent's sales of its OPHRIVIN-A over-the-counter ocular decongestant have been relatively modest in comparison to its OTRIVIN nasal decongestant with \$263,000 in sales in Canada from 1992 to 1995. Thus, the opponent's trade-mark OPHRIVIN-A has only become known to relatively minor extent in Canada. Likewise, having regard to the Frochisse affidavit, the applicant's trade-mark "O" PRIN has only become known to a minor extent in Canada with \$83,000 in sales of its "O" PRIN nasal spray from October 1994 to 1996 inclusive. Thus, the extent to which the trade-marks at issue have become known weighs in the opponent's favour and, in particular, in relation to its OTRIVIN trade-mark. Further, the length of time the trade-marks at issue have been in use [Para. 6(5)(b)] also favours the opponent in that the trade-mark OTRIVIN as applied to a nasal spray has been used in Canada since 1957 whereas the applicant commenced use of its trade-mark in Canada in October of 1994.

As for the nature of the wares [Para. 6(5)(c)] and the nature of the trade [Para. 6(5)(d)] of the parties, the applicant's nasal spray and the opponent's OTRIVIN nasal decongestant are essentially identical and would therefore travel through the same channels of trade in Canada. Indeed, paragraph 11 of the Frochisse affidavit and paragraph 2 of the second Shane affidavit indicate that the wares of both parties are available to Canadian consumers through such retail outlets as Shopper's Drug Mart, Uniprix, Pharaprix and Obonsoins.

Considering the degree of resemblance between the trade-marks at issue [Para. 6(5)(e)], the applicant's trade-mark "O" PRIN and the opponent's trade-mark OTRIVIN bear only a minor degree of similarity in appearance and sounding and no similarity in the ideas suggested. Further, there is

some similarity in appearance and in sounding between the applicant's mark and the opponent's trade-mark OPHRIVIN-A when these marks are considered in their entireties and, again, there is no resemblance in the ideas suggested by these marks.

Considering that the wares and channels of trade associated with the applicant's mark and the opponent's trade-mark OTRIVIN are the same and that the opponent's trade-mark is fairly well known in Canada, and even bearing in mind that the degree of resemblance in appearance and in sounding between these trade-marks is limited, I am in doubt as to whether there would be a reasonable likelihood of confusion between these marks and am therefore obliged to resolve that doubt against the applicant. I have concluded therefore that the applicant has failed to meet the legal burden upon it in respect of the issue of confusion. As a result, the applicant's trade-mark "O" PRIN is not registrable and not distinctive, and the applicant is not the person entitled to its registration.

Having been delegated by the Registrar of Trade-marks pursuant to Section 63(3) of the *Trade-marks Act*, I refuse the applicant's application pursuant to subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC, THIS 19th DAY OF APRIL, 1999.

G.W. Partington,
Chairperson,
Trade-marks Opposition Board.