



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

Citation: 2011 TMOB 9
Date of Decision: 2010-01-24

**IN THE MATTER OF AN OPPOSITION
by Bayer Aktiengesellschaft to application
No. 1,201,366 for the trade-mark BAYER
in the name of Robert Victor Marcon**

[1] On December 11, 2003, Robert Victor Marcon (the Applicant), filed an application for the trade-mark BAYER (the Mark) based upon proposed use of the Mark in Canada. The statement of wares currently reads:

Dental products namely: toothbrushes; toothpaste; dental floss and floss wands; mouthwash; dental whitening strips and pastes; dental desensitizing strips and pastes; aerosol breath fresheners; Topical skin balms namely: sunscreens; tanning balms; lotions; creams; and combinations thereof.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of November 8, 2006.

[3] On April 10, 2007, Bayer Aktiengesellschaft (the Opponent) filed a statement of opposition against the application. The grounds of opposition are that the Applicant's application does not conform to the requirements of s. 30(e) and s. 30(i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), the Mark is not registrable pursuant to s. 12(1)(d), the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a) and s. 16(3)(c), and the Mark is not distinctive. The s. 12(1)(d), s. 16(3)(a), s. 16(3)(c) and s. 38(2)(d) grounds are based on a likelihood of confusion with the Opponent's use and registration of a number of BAYER registered trade-marks and BAYER trade-name, registered and/or used in association with a

variety of wares. The particulars of the Opponent's registrations are identified in Schedule A to this decision.

[4] The Applicant filed and served a counter statement, in which it denied the Opponent's allegations.

[5] The Opponent's evidence consists of the following:

- certified copies of the Opponent's registrations listed in Schedule A to the statement of opposition;
- certified copies of the Applicant's applications for other well-known and arguably famous trade-marks listed in Schedule B to the statement of opposition (the particulars of which are attached as Schedule B to this decision);
- the affidavit of Kevin Skinner;
- the affidavit of Robert Patone; and
- the affidavit of P. Claire Gordon.

[6] The Applicant's evidence consists of the affidavit of the affidavit of Mr. Robert Victor Marcon. As its evidence in reply, the Opponent filed the Affidavit of Gay J. Owens, a certified copy of excerpts from the file history of the application at issue, and a certified copy of an affidavit sworn by the Applicant in the opposition proceeding relating to the Applicant's application No. 1,168,019 for the trade-mark CORONA with a certified copy of the transcript of the cross-examination of Robert Victor Marcon thereon.

[7] Only Mr. Marcon was cross-examined on his affidavit and the transcript from the cross-examination is part of the record.

[8] Both the Applicant and the Opponent filed a written argument. An oral hearing was conducted at which only the Opponent was represented.

Onus and Material Dates

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial 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 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

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

- s. 38(2)(a)/s. 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- s. 38(2)(b)/s. 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 C.P.R. (3d) 413 (F.C.A.)];
- s. 38(2)(c)/s. 16(3) - the filing date of the application [see s. 16(3)];
- s. 38(2)(d)/non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Section 12(1)(d)

[11] The s. 12(1)(d) ground of opposition turns on the issue of the likelihood of confusion between the Mark and each of the Opponent's marks.

[12] I note that the Opponent's initial burden with respect to the s.12(1)(d) ground has been satisfied because all of its registrations as detailed in Schedule A are in good standing. As I consider registration Nos. TMDA24895 and TMA469,352 to be the most relevant to the issue of confusion in the present case, I will focus my discussion on these trade-marks and where appropriate refer to them collectively as the BAYER mark.

test for confusion

[13] 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. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks or trade-names 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 or trade-names in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight.

[14] The Supreme Court of Canada has discussed the appropriate process for assessing all the surrounding circumstances to be considered in determining whether two trade-marks are confusing in its decisions in *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401. It is with these general principles in mind that I shall now assess all of the surrounding circumstances.

s. 6(5)(a) - inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

[15] The Applicant submits that the Opponent's BAYER trade-mark is a weak mark. In this regard, the Applicant filed Internet evidence showing listings of Bayer as a surname in Canada and the U.S., and listings of six geographical locations in Canada that begin with the word Bayer or Bayers, i.e. Bayer Lake, and printouts from third party websites that relate to four businesses in the United States whose names include "Bayer". As such, the Applicant submits that the Opponent's mark is a weak mark that cannot be afforded a wide scope of protection.

[16] The Applicant has filed similar evidence in the opposition proceedings regarding the trade-marks CORONA, L'OREAL PARIS, CHANEL and EVIAN [see *Cerverceria Modelo, S.A. v. Marcon* (2009), 70 C.P.R. (4th) 355 at 372 (T.M.O.B.), *L'Oréal v. Marcon*, 85 C.P.R. (4th) 381 (T.M.O.B.), *Chanel S. de R.L. v. Marcon* (2010), 85 C.P.R. (4th) 399 (T.M.O.B.) and *Société Anonyme des Eaux Minerales D'Evian v. Marcon*, 2010 TMOB 83]. In each of those decisions, it was emphasized that when considering s. 6(5)(a) of the Act, the Registrar is to consider both

the inherent distinctiveness and the acquired distinctiveness of the marks at issue. Therefore, in the present case, even if the Applicant's printouts from the Internet were sufficient to show that the average Canadian consumer would perceive BAYER as a geographic location, surname or corporate name, this would not be sufficient on its own to show that the Opponent's BAYER mark is a weak mark entitled to a narrow ambit of protection. One must also consider the acquired distinctiveness of the marks at issue. The evidence shows that the Opponent's mark has acquired a high degree of distinctiveness through significant use, as described below.

[17] The evidence of Mr. Skinner, Country Division Head of the Consumer Care division of Bayer Inc. in Canada, provides the following information:

- BAYER as a name and BAYER as a trade-mark have been used in Canada since at least as early as 1896.
- Bayer Aktiengesellschaft (which is the same as Bayer AG) is the majority shareholder of Bayer Inc., and has its headquarters in Leverkusen, Germany. It is one of the world's leading innovative companies in the health care and medical products industry.
- The Consumer Care division of the health care business of Bayer AG is among the largest marketers of over-the-counter (OTC) medications and nutritional supplements in the world. Bayer AG's OTC business on a world-wide level is one of the top three in the world.
- There are over 120 products in the consumer care category which are sold in every province and territory in Canada with the BAYER trade-marks and BAYER trade-name in all leading retail pharmacy, supermarket and department store retailers. The best known of the BAYER health care products is ASPIRIN.
- Total sales figures for Bayer Inc., including consumer care products, in Canada for the period 2000 – 2006 on an annual basis range between \$910 million to over \$1.6 billion.
- There is significant promotion and advertisement of the consumer care products in which the BAYER trade-marks and trade-names are displayed. This includes point of sale displays, advertisements to the trade and retailers, promotional activities, and display of the trade-marks and trade-name on the products and associated packaging and information.
- The expenditures on advertising and promotion of consumer care products in Canada have been in excess of \$12,000,000 each year for the period 2000 to 2006.
- Surveys of the Canadian public conducted jointly by Leger Marketing and Marketing magazine in 2006 and 2007 indicate that BAYER is the most recognized health care

brand in Canada. Canadians have also voted Bayer as the top respected healthcare company in Canada.

[18] It is clear from Mr. Skinner's evidence that the Opponent's mark has become very well known in Canada. As for the Applicant's mark, since the Applicant filed no evidence of use or making known of its mark, I must conclude that its mark has not become known in Canada at all. This factor therefore favours the Opponent.

s. 6(5)(b) - the length of time each trade-mark has been in use

[19] The length of time that each mark has been in use favours the Opponent.

s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

[20] When considering the wares, services and trades of the parties, it is the statement of wares in the parties' trade-mark application and registration that govern in respect of the issue of confusion arising under s. 12(1)(d) [*Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)]. In the present case, the applied for wares include, *inter alia*, dental products, topical skin balms, lotions, creams and combinations thereof. Some of the registered wares of the Opponent, as listed in its registration Nos. TMDA24895 and TMA 469,352, include pharmaceutical preparations used for the relief of pain and to reduce fever; nasal decongestants; pharmaceutical preparations, namely anti-fungals, anti-infectives and anti-hypertensives; vitamin and mineral supplements; and diagnostic re-agents for medical use.

[21] The Applicant argues that the parties' wares "are unrelated, do not intermingle, occupy different market niches, are incompatible, non-interchangeable, non-substitutable, and non-competitive". The Opponent, on the other hand, submits that the wares of the parties are similar in that they all relate to consumer health care products. Moreover, the Opponent also sells consumer health care products in the form of cream and lotions to be applied to the skin (e.g. MYOFLEX, CANESTEN, OZONOL) (see Skinner affidavit, para. 18, Exhibits C, D and K), and the applied for wares specifically include various types of skin balms, including creams and lotions.

[22] The following comments from Chairperson Carreau in the L'OREAL PARIS decision are particularly helpful to the present case:

In *Mattel*, the Supreme Court of Canada reviewed the relevance of a connection or a resemblance between the nature of the wares when assessing confusion and noted that the wares need not be of the same general class. All surrounding circumstances including the nature of the wares must be taken into consideration. Stressing the importance of considering all surrounding circumstances, the Court reasoned in *Mattel* that the fame of a mark does not trump all remaining surrounding circumstances and confusion cannot be automatically presumed in these instances. The Court reasoned that "a difference in wares or services does not deliver the knockout blow, but nor does the fame of the trade-mark" (see *Mattel*, para 72). The full factual context of each case will determine the likelihood of confusion; in some cases, certain factors will carry greater weight than others. In this regard, I agree with the Opponent's submissions that it is not necessary for the parties to operate in the same general field or industry for there to be likelihood of confusion (*Miss Universe, Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)) and the wares or the services need not be of the same general class for the use of a trade-mark to cause confusion with another (*Maison Cousin (1980) Inc. v. Cousins Submarines Inc.* (2006), 60 C.P.R. (4th) 369 (F.C.A.)).

The Opponent's evidence demonstrates that the L'Oréal Products, including those sold under the trade-mark L'OREAL PARIS are sold *inter alia* in pharmacies, department stores and grocery stores. The Applicant did not file any evidence with regards to where his products would be sold. However, vitamin, mineral and herbal supplements, as well as non-alcoholic beverages are often sold in pharmacies, department stores and grocery stores. Accordingly, it appears that the channels of trade for the applied for Wares and the Opponent's L'Oréal Products, including those sold under the trade-mark L'OREAL PARIS may overlap.

[23] In my view, while the Applicant's wares in the present case may be different than the Opponent's wares, I agree with the Opponent that the wares are related to the extent that they all comprise consumer health care products. In that sense and in the absence of evidence to the contrary, there is a connection between the wares.

[24] With respect to the parties' channels of trade, the Opponent's evidence shows that its consumer care products, including those sold under the BAYER trade-mark, are sold in retail pharmacies, supermarkets and department stores. The Applicant did not file any evidence with regards to where its products would be sold. However, in view that the Applicant's wares also comprise consumer care products, the parties' channels of trade would presumably overlap.

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

[25] With respect to the degree of resemblance between the marks, the Mark is identical to the Opponent's registered BAYER trade-mark.

Surrounding circumstances

[26] In support of the Applicant's claim for registration, the Applicant presents a small sampling of various identical marks owned by different owners in order to "provide a confirmed base of precedents which can be used in any quantitative comparisons or legal illustrations". The Applicant submits that said marks are relevant because each one was registered or approved during the same commercial time periods. Further, the Applicant submits that some of these marks may be considered famous yet have co-existed peacefully for many years with the others. This co-existence, in the Applicant's opinion, has endured despite the fact that many of the wares of the respective marks seem to be engaged in identical or overlapping areas of business. As its evidence on this point, the Applicant attaches printouts from the Canadian Trade-marks Database for the marks DUTCH BOY, CORONA, APOLLO, FINLANDIA, and GREYHOUND, as well as printouts of court decisions from the Internet regarding the registrability of these marks.

[27] The Applicant presented a similar argument and evidence on this point in the CORONA, L'OREAL PARIS, EVIAN and CHANEL oppositions. The following comments made by Chairperson Carreau in the L'OREAL PARIS decision, are therefore also applicable to the present case:

As his evidence, he attaches printouts from the Canadian Trade-mark Database to show "parallel and co-existing use" of certain trade-marks, including the trade-marks DUTCH BOYS, TRIUMPH, APOLLO, GREYHOUND, FINLANDIA and CORONA. The Applicant also furnished in evidence printouts of court decisions from the Internet and a copy of a newspaper article regarding the registrability of trade-marks. I do not consider evidence of several unrelated identical or similar marks on the Register to be relevant to the present proceedings; the issue of confusion between the Mark and the Opponent's L'OREAL PARIS trade-mark is a decision to be made based on the surrounding circumstances and the particular facts of this case. Each case must be decided upon its own merit. In addition, the decisions by the Examination Section of the Trade-marks Office, who do not have evidence filed by the parties in opposition proceedings, to

register marks are not binding and have no precedential value for the Registrar in determining the registrability of a trade-mark in an opposition proceeding (see *Thomas J. Lipton Inc. v. Boyd Coffee Co.* (1991), 40 C.P.R. (3d) 272 (T.M.O.B.) and *Procter & Gamble Inc. v. Morlee Corp.* (1993), 48 C.P.R. (3d) 377 (T.M.O.B.)).

[28] I agree with Chairperson Carreau's comments on this issue and find that they can be equally applied to the present case. I therefore do not consider the Applicant's evidence and argument on this point to be relevant to the present proceeding.

Conclusion re: likelihood of confusion

[29] The test for confusion to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees BAYER on the Applicant's dental products and topical skin balm wares, at a time when he or she has no more than an imperfect recollection of the Opponent's BAYER trade-mark, and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot*].

[30] In view of my findings above, and in particular the Opponent's extensive reputation and use of its BAYER mark, the potential overlap between the parties' channels of trade, and the fact that the marks are identical, I find that the Applicant has not discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between its BAYER mark and the Opponent's registered BAYER marks. The s. 12(1)(d) ground of opposition therefore succeeds.

Section 16(3) and s. 38(2)(d) Grounds of Opposition

[31] The s. 16(3) and s. 38(2)(d) grounds of opposition also turn on a determination of the issue of the likelihood of confusion between the Mark and the Opponent's BAYER trade-mark and BAYER trade-name. The material dates for assessing the likelihood of confusion in respect of the non-entitlement and non-distinctiveness grounds are, respectively, the Applicant's filing date and the date of opposition. In my view, the differences in material dates do not have any significant impact on the determination of the issue of confusion between the trade-marks of the parties. Thus, my finding above that the trade-marks are likely to be confusing applies to these grounds of opposition which also succeed.

Remaining Grounds of Opposition

[32] As I have already refused the application under three grounds, I will not address the remaining grounds.

Disposition

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

Cindy R. Folz
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

TRADE-MARK	REGISTRATION NUMBER
BAYER	TMDA24895
BAYER	UCA50841
BAYER	TMA469,352
BAYER	TMA507,755
BAYER	NFLD0762
BAYER	NFLD0939
BAYER CROSS Design	TMA469,414
BAYER CROSS Design	TMA507,844
BAYER IMMUNO 1	TMA523,566
BAYER IN CROSS Design	TMDA24896
BAYER IN CROSS Design	NFLD0763
FIVE LETTERS ARRANGED IN THE FORM OF A CROSS, THE MIDDLE LETTER BEING COMMON TO BOTH BRANCHES OF THE CROSS AND THE CROSS BEING ENCLOSED IN A CIRCLE & Design	UCA50850

SCHEDULE B

TRADE-MARK	APPLICATION NUMBER
COORS	1,168,021
BUDWEISER	1,168,020
ABSOLUT	1,168,026
CHANEL	1,202,435
FINLANDIA	1,168,024
SENSODYNE	1,186,813
TIM HORTON'S	1,186,804
BEEFEATER	1,168,023
CANADIAN CLUB	1,168,022
JACK DANIEL'S	1,168,016
JACK DANIEL'S	1,202,335
SOUTHERN COMFORT	1,168,272
DOM PERIGNON	1,168,014
HEINEKEN	1,168,025
CORONA	1,168,019
Nescafé	1,201,480
EVIAN	1,188,155
NESTLÉ	1,201,360