



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

Citation: 2016 TMOB 158
Date of Decision: 2016-09-26
[UNREVISED ENGLISH
CERTIFIED TRANSLATION]

IN THE MATTER OF AN OPPOSITION

| | |
|------------------------------|--------------------|
| Novartis AG | Opponent |
| and | |
| Satisloh AG | Applicant |
| 1,520,419 for OPTIFOG | Application |

Introduction

[1] Novartis AG (the Opponent) opposes registration of the trade-mark OPTIFOG (the Mark) covered by application No. 1,520,419 in the name of Satisloh AG (the Applicant).

[2] This application, filed on March 23, 2011, was originally in the name of Essilor International (Compagnie générale d'optique) a limited company (Essilor International), and was based both on the proposed use of the Mark in Canada, and the registration and use of the Mark abroad. By confirmatory assignment entered into on December 28, 2012, the Mark which is the object of this application was assigned to the Applicant. Moreover, the Applicant voluntarily amended this application on November 10, 2014 to withdraw the basis of registration and use of the Mark abroad. Consequently, this application henceforth is based only on the proposed use of the Mark in association with the following goods:

Solutions and other preparations for cleaning and maintaining spectacle lenses and ophthalmic lenses (other than contact lenses); anti-fog maintenance solutions and other preparations for spectacle lenses and ophthalmic lenses (other than contact lenses). Ophthalmic lenses; spectacle lenses; treated ophthalmic lenses and spectacle lenses; ophthalmic lenses and spectacle lenses coated with an anti-fog layer; ophthalmic lenses and spectacle lenses with anti-fog properties; coatings for ophthalmic lenses and spectacle lenses.

[3] The Opponent bases its opposition on various grounds related to the question of the application's compliance within the meaning of section 30 of the *Trade-marks Act*, RSC 1985, c. T-13 (the Act), namely the question of the probability of confusion between the Mark and one or more of the trade-marks consisting of the "OPTI" element combined with other elements that are the object of registrations or registration application described in the appendix, belonging to the Opponent and allegedly having been used by the Opponent in Canada.

[4] As my analysis will reveal, I find there is reason to reject the opposition.

The record

[5] The statement of opposition was originally filed on December 11, 2012, then amended voluntarily by the Opponent on June 10, 2013, with the permission of the Registrar. The Applicant filed a counter statement in response to each of them, denying each of the grounds of opposition argued.

[6] In support of its opposition, the Opponent filed a first affidavit of Pam Mulhall dated October 22, 2013 and an affidavit by Monica Molina dated October 21, 2013. It also filed a second affidavit of Ms. Mulhall dated June 30, 2014.

[7] In support of its application, the Applicant originally filed two affidavits of Xavier Kotelnikoff dated July 10 and August 12, 2014. These affidavits then were replaced with an affidavit of Thierry Cordovant dated March 5, 2015. Mr. Cordovant was cross-examined on his affidavit, and the transcript of his cross-examination as well as the answers to the undertakings made during the latter were entered on the record.

[8] Only the Opponent filed a written argument. However, the two parties were represented at the hearing held in this case.

Analysis

The burden incumbent on the Parties

[9] It is initially for the Opponent to establish the well-foundedness of its opposition. However, the legal onus of showing that the Mark is registrable falls to the Applicant, according to the balance of probabilities [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), 20 CPR (4th) 155 (FCA)].

Analysis of Evidence

Opponent's Evidence

First affidavit of Pam Mulhall

[10] Ms. Mulhall holds the position of Finance Manager with Alcon Canada Inc. (Alcon Canada).

[11] Ms. Mulhall affirms that the Opponent holds a family of trade-marks composed of the element "OPTI" and that a licence concerning the use of each of these marks in Canada was granted to Alcon Canada.

[12] Ms. Mulhall, in paragraph 4 of her affidavit, then draws up a list of the trade-marks comprising the element "OPTI" that the Opponent or its predecessors-in-title "registered" in Canada. However, as noted by the Applicant, this list includes three trade-marks described as having been the object of registration applications and not registered, namely the OPTI-FREE PUREMOIST, OPTI-FREE SEPT and OPTILASIK marks. In fact, the list drawn up by Ms. Mulhall repeats the list of registrations and registration applications described in the appendix, except for the OPTIFIT and OPTI-FREE EVERMOIST marks alleged in the amended statement of opposition but not mentioned in Ms. Mulhall's affidavit, and the addition of the OPTI-FREE SEPT maker in association with "*contact lens solutions*", alleged nowhere in the amended statement of opposition.

[13] Ms. Mulhall specifies that when she refers to the use of a trade-mark or the fact that a product is marketed or associated with a given trade-mark, this means that:

5. ...one of Alcon's OPTI Marks is stamped or printed on the container in which the product is sold, or on the packaging in which the container for the product is sold, or is stamped or printed on a label which is affixed to the container for the product or packaging in which the container for the product is sold, or on the wares themselves.

6. ... when I state that one of Alcon's OPTI Marks is "advertised" or "promoted", I mean to refer to promotional literature or publications in which one of Alcon's OPTI Marks is shown.

7. ... statements made herein pertaining to the "use" and "promotion" of trade-marks will refer to the use or promotion of one or several of Alcon's OPTI Marks in Canada, unless specifically stated to the contrary.

[14] As noted by the Applicant during the hearing, the reference to "Alcon" poses a problem in that it differs from the defined term "Alcon Canada". When questioned on this subject during the hearing, the Opponent's agent could not provide any answer. Given the subsequent reference, sometimes to Alcon, sometimes to Alcon Canada, throughout Ms. Mulhall's affidavit, I am not ready to infer that this is a mere typographical error and that Alcon and Alcon Canada are necessarily one and the same entity. The references sometimes to Alcon, sometimes to Alcon Canada, are also repeated in the Opponent's written arguments. Moreover, the details of some of the registrations filed in support of Ms. Molina's affidavit (discussed below) mention various predecessors-in-title of the Opponent, such as Alcon Pharmaceuticals, Ltd., Alcon Universal Ltd., and Alcon, Inc., and some of the packaging, labels and promotional material filed by Ms. Mulhall under Exhibit "A" (discussed below) apparently refer to Alcon Laboratories, Inc., thereby adding to the ambiguity of Ms. Mulhall's assertions. Consequently, in my view of Ms. Mulhall's affidavit, I will repeat the references, sometimes to Alcon, sometimes to Alcon Canada, as is. Any ambiguity in Ms. Mulhall's affidavit will have to be resolved against the Opponent [see *Cynde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)].

[15] I also noted that the expression "OPTI Marks", used for the first time in paragraph 5 of Ms. Mulhall's affidavit, is not defined in the affidavit. However, I find it reasonable to infer that these are marks listed by Ms. Mulhall in paragraph 4 of her affidavit discussed above.

[16] Ms. Mulhall continues her affidavit by affirming that Alcon develops and markets a vast eye care product line and technologies for human use in the fields of optometry and ophthalmology, covering pharmaceutical, surgical and diagnostic products, in particular.

[17] Ms. Mulhall affirms that Alcon distributes and sells ophthalmic preparations and contact lens preparations and solutions in Canada in association with the "OPTI Marks". She refers collectively to all the goods associated with the "OPTI Marks" as the "OPTI Products".

[18] Ms. Mulhall affirms that the Opponent distributes the goods in Canada through its wholly-owned subsidiary, Alcon Canada. She returns to the licence for use granted by the Opponent to Alcon Canada and specifies that the Opponent controls the nature of the quality of the "OPTI Products" sold in association with the "OPTI Marks", as used in Canada.

[19] Ms. Mulhall affirms that in addition to the "OPTI Products", Alcon Canada sells other ophthalmic preparations in Canada by prescription and without prescription, which are not directly related to contact lenses, and she draws up a list of these goods. I note that none of the trade-marks associated with any of these goods is closely or distantly related to the Mark. Moreover, no proof of use of any of these trade-marks has been filed.

[20] Ms. Mulhall affirms that Alcon Canada has sold and distributed the "OPTI Products" in Canada since April 1986. Alcon Canada employs approximately 220 people, including the personnel of the sales and marketing teams, for the purposes of maintaining and increasing the sales of "OPTI Products" across Canada to retailers, distributors, hospitals and healthcare professionals.

[21] Ms. Mulhall affirms that from 1986 to 2013, sales of "OPTI Products" realized in Canada by Alcon Canada exceeded 286,652,315 dollars, and she provides the amount of sales realized for each of those years. However, as noted by the Applicant, no details per product are provided. In other words, it is impossible to know to which of the "OPTI Products" and to which of the "OPTI Marks" these sales are attached.

[22] In support of her affidavit, as Exhibit "A", Ms. Mulhall files photocopies of packaging, labels and promotional material, showing the way the "OPTI Marks" are used. Although she adds that this is a representative sample, it is appropriate to mention, as the Applicant did at the

hearing, that this sample is far from proving the use of the trade-marks included in the Opponent's alleged family of "OPTI Marks". In fact, the only trade-marks apparently illustrated in the sample are OPTI-FREE, OPTIFREE® evermoist®, OPTI-FREE® EXPRESS®, OPTI-FREE® Replenish®, and AIR OPTIX. I will return to this point later, during my analysis of the grounds of opposition based on the likelihood of confusion between the parties' marks. As also noted by the Applicant, some of this packaging, these labels and this promotional material apparently refer to Alcon Laboratories, Inc. The relationship existing between that corporation and the Opponent is not explained by Ms. Mulhall. I note that Alcon Laboratories, Inc. also does not appear among the Opponent's predecessors-in-title mentioned in the registrations filed by Ms. Molina. I will also return to this point later.

[23] In support of her affidavit, as Exhibit "B", Ms. Mulhall also files a representative sample of invoices attesting to the sale of the "OPTI Products" by Alcon Canada. As noted by the Applicant, the only marks of the "OPTI" family referenced in this sample seem to be OPTI-FREE and OPTI FREE EXPRESS.

[24] Ms. Mulhall affirms that, in addition to direct advertising, Alcon Canada advertises the "OPTI Products" in the newspapers, in cooperation with various retailers. She draws up the list of these retailers, which includes Walmart, Jean Coutu, Uniprix, London Drugs, Sobeys, Lunetterie New Look, Optique Multivision. She also provides examples of the advertisements in question under Exhibit "C" of her affidavit. As noted by the Applicant, the only "OPTI Marks" advertised in this sample seem to be AIR OPTIX, OPTI-FREE and OPTI FREE® Replenish®.

[25] Ms. Mulhall provides the approximate sums of money allocated to this last type of advertising for each of the years 1998 to 2013. However, as noted by the Applicant, no details per product are provided. In other words, it is impossible to know to which of the "OPTI Products" and to which of the "OPTI Marks" these sales are attached.

[26] Ms. Mulhall affirms that Alcon Canada also promotes the "OPTI Products" by supplying product samples to various healthcare professionals and hospitals across Canada. She provides the sums of money allocated to this type of promotion for each of the years 1989 to 2013. However, as noted by the Applicant, no details per product are provided. In other words, it is

impossible to know to which of the "OPTI Products" and to which of the "OPTI Marks" these sales are attached.

[27] Ms. Mulhall affirms that Alcon has its own website at the address *www.alcon.com* and that this website has been operational since March 1998. She adds that the Canadian subsite at the address *www.alcon.ca* lists the different goods offered for sale in Canada by Alcon. Under Exhibit "D" of her affidavit, she files a list of some of these goods, including OPTI-FREE® Replenish®, OPTI-FREE® Express®, O2OPTIX, and AIR OPTIX.

[28] Ms. Mulhall continues her affidavit by expressing various personal opinions concerning the likelihood of confusion between the parties' trade-marks. I will not dwell on these opinions, because as the Applicant reminded us at the hearing, they involve a mixed question of fact and law, which it is up to the Registrar to resolve in view of the evidence of record.

Second affidavit of Pam Mulhall

[29] There is also no reason for me to dwell on Ms. Mulhall's second affidavit. This affidavit addressed the allegations of registration and use of the Mark abroad, contained in the Applicant's original registration application. Since these allegations have been withdrawn from this application, this aspect of the evidence is no longer applicable.

Affidavit of Monica Molina

[30] Ms. Molina holds the position of secretary with the firm of trade-mark agents representing the Opponent.

[31] Her affidavit simply has the purpose of filing, under Exhibit "A", a copy of the details of the registrations and registration applications alleged by the Opponent in support of this opposition, which she obtained by consulting the Canadian trade-marks database. I note that these registrations and registration applications correspond to those listed in paragraph 4 of Ms. Mulhall's affidavit.

Applicant's Evidence

Affidavit and Cross-examination of Thierry Cordovant

[32] I note at once that the Opponent emphasized in its written arguments during the hearing that little or no weight should be granted to Mr. Cordovant's affidavit. On the one hand, due to the fact that it is patterned on the previous affidavits sworn by Mr. Kotelnikoff, and that Mr. Cordovant does not have first-hand knowledge of the facts and exhibits referenced in his affidavit. On the other hand, because the evidence does not prove that the Applicant controlled, directly or indirectly, the character or quality of the goods used in association with the Mark, according to section 50 of the Act, governing the use of licensed trade-marks.

[33] I agree with the Opponent that several passages of Mr. Cordovant's affidavit pose problems. I will settle for mentioning only some of them.

[34] Mr. Cordovant holds the position of Director, Product Marketing with Essilor Canada Ltd. (Essilor Canada), which is a wholly-owned subsidiary of Essilor International.

[35] Mr. Cordovant affirms that Essilor International assigned its entire portfolio of OPTIFOG trade-marks held around the world to the Applicant on December 28, 2012. He explains that the Applicant is the wholly-owned Swiss subsidiary of Essilor International. He continues his affidavit by affirming that [TRANSLATION]:

Because of my title, functions and position with Essilor Canada, and its relationship with Essilor [International] and the Applicant, I am aware of the business pertaining to the OPTIFOG mark and I am more particularly aware of the events and circumstances pertaining to these proceedings, since I have access to all the documents and information relevant to it.

[36] Mr. Cordovant affirms that Essilor International is a French company that designs, develops and markets optical and ophthalmic equipment and corrective lenses. He affirms that Essilor International is present in more than 100 countries and that it is a world leader in the field of vision correction.

[37] Mr. Cordovant affirms that the Applicant is a Swiss company that supplies machines and consumables to laboratories for manufacturing of eyeglasses and optical lenses.

[38] Mr. Cordovant affirms that in 2011, Essilor International began the development and production of a complete line of solutions and other preparations for maintenance of optical lenses and ophthalmic lenses, marketed under the Mark (the "OPTIFOG Products"). He affirms that the "OPTIFOG Products" have a technology designed to counter fog on optical lenses.

[39] Mr. Cordovant affirms that the "OPTIFOG Products" constitute important assets of the Applicant and its predecessor-in-title, Essilor International, which do not hesitate to take the necessary steps to protect the Mark. In this regard, he files as Exhibit "XK-1", jointly, a copy of the trade-mark registrations obtained in various jurisdictions around the world.

[40] Mr. Cordovant argues these registrations were obtained without opposition, including without the opposition of the Opponent in this case, whereas the Opponent holds, inter alia, international registrations for marks comprising the prefix "OPTI". In this regard, as Exhibit "XK-2", jointly, he files a copy of the following registrations held by the Opponent:

- International registration No. 640853 for the OPTI-1 mark;
- International registration No. 729960 for the OPTI-CLEAN mark;
- International registration No. 530676 for the OPTI-FREE mark;
- International registration No. 654573 for the OPTI-PLUS mark; and
- International registration No. 522245 for the OPTI-SOFT mark.

[41] It is appropriate to note, at this stage of my review of Mr. Cordovant's affidavit, that it emerges from his cross-examination that all of Exhibits "XK-1" to "XK-9", filed in support of his affidavit, are taken from Mr. Kotelnikoff's previous affidavits and would have been printed by the latter's assistant working for Essilor International. It also emerges from the cross-examination of Mr. Cordovant that he has no access to the records of Essilor International. In the circumstances, I agree with the Opponent that this portion of Mr. Cordovant's testimony is based on hearsay. I will return briefly to this point during my analysis of the additional circumstances regarding the test of confusion between the parties' marks.

[42] Mr. Cordovant then addresses the use of the Mark in Canada. He affirms that the "OPTIFOG Products" have been sold in Canada since January 2012 by Essilor International and

subsequently by the Applicant, through independent vision professionals and through vision professional chains. He files as Exhibit "XK-3", jointly, samples of certain packaging in which these goods are sold and on which the Mark appears. Although Exhibit "XK-3" is taken from one or the other of Mr. Kotelnikoff's affidavits, I find this does not render it inadmissible. Due to Mr. Cordovant's responsibilities, he is able to testify to the appearance of the packaging used in Canada. I also agree with the Applicant that the fact that one of these packagings apparently refers to Essilor International is not inherently problematic because it bears the mention "MFG date: AUG 2011" (meaning *Manufacture Date*) and because Essilor International was still the owner of the Mark in that period. Moreover, contrary to the Opponent's representations during the hearing, I find that the mere fact that the product in question was manufactured in August 2011 does not necessarily mean that it was offered for sale in Canada at the same time, instead of since January 2012, as affirmed by Mr. Cordovant.

[43] Mr. Cordovant affirms that for the period beginning on January 1, 2012 and ending on December 31, 2013, more than 1,144,526 optical lenses associated with the Mark were sold worldwide, including 26,585 in Canada by Essilor International and then by the Applicant. Such as it emerges from the cross-examination of Mr. Cordovant, this number was calculated taking into consideration that each eye is a distinct unit (i.e. one lens per eye). Mr. Cordovant confirms in this regard that he obtained the number of lenses sold in Canada by asking the "Statistics Department", to which he has access.

[44] Concerning the promotion and advertising relating to the Mark, Mr. Cordovant filed documentation, under Exhibit "XK-4", jointly, attesting to the promotion of the Mark in Europe and the United States and bringing together the television and movie theatre advertising campaigns, press conference photographs, presentations of "OPTIFOG Products" at the SILMO Fair (the International Optics and Eye wear Exhibition) in Paris in 2011 and at Vision Expo West in Las Vegas, and an advertising campaign in Times Square, New York in 2011. I agree with the Opponent that such promotion and advertising have little relevance in the case at bar, because they are not directed to Canada.

[45] Mr. Cordovant affirms that the "OPTIFOG Products" are promoted in Canada via the websites available at the following addresses: <http://www.optifog.ca> and

<http://www.essilor.ca/FR/PRODUITS/TRAIEMENTS/Pages/Optifog.aspx>. He files as Exhibit "XK-5", jointly, excerpts from these sites showing the Mark, accessible to Canadians. As noted by the Opponent, although these excerpts apparently were printed on July 7, 2014, they continue to refer to Essilor International as the owner of the Mark instead of to the Applicant.

[46] Mr. Cordovant affirms that the "OPTIFOG Products" are also promoted in Canada by distribution of brochures and display advertising. In this regard, as Exhibit "XK-6", jointly, he files a non-exhaustive sample of brochures and advertising material dating from 2012 and distributed and displayed in Canada via vision professionals, professional magazines, the Météo Média network and professional trade shows. I note this promotion still seems to refer to Essilor International instead of the Applicant. He adds that many videos containing advertising intended to promote the "OPTIFOG Products" are available on YouTube (Exhibits "XK-7" and "XK-8").

[47] Mr. Cordovant affirms that the Mark enjoys an enviable reputation and recognition in Canada. In this regard, as Exhibit "XK-9", he files a press release dating from April 3, 2012, attesting to the election of the optical lens associated with the Mark as "product of the year" by Canadian consumers, in the personal comfort category. If only due to the lack of information concerning the survey method that led to this award, I am not ready to give any weight to this press release.

[48] Mr. Cordovant ends his affidavit by affirming that [TRANSLATION]:

Any use of the [Mark] for the OPTIFOG Product of Essilor [International] or Essilor Canada, in Canada, is licensed by the Applicant, meaning that, directly or indirectly, the Applicant controls the quality and character of the OPTIFOG Products with which the [Mark] is associated.

[49] However, when questioned on this subject in his cross-examination, Mr. Cordovant answered as follows:

Q 262 Is this an oral licence or a written licence?

A. I don't know.

Q 263 Are you aware of...

A. I don't know what to answer to your question.

Q 264 Are you aware of a licence?

A. Essilor Canada uses the trademark OPTIFOG because of the fact that Essilor International gives us this right.

Q 265 And are you specifically aware of a licence between Essilor International and Essilor Canada?

A. No.

Q 266 Or between Satisloh and Essilor Canada?

A. Personally, no.

[50] I agree with the Opponent that, in the circumstances, Mr. Cordovant's assertion to the effect that the Applicant, as licensor, has direct or indirect control of the character or quality of the "OPTIFOG Products" with which the Mark is associated, poses problems. How can Mr. Cordovant affirm such control while not being specifically aware of the very existence of this licence? During the hearing, the Applicant argued that this was not necessarily the [TRANSLATION] "objective reality" and that Mr. Cordovant nonetheless had filed all the answers to the undertakings made during his cross-examination. However, I note that none of these undertakings pertained to the existence of such a licence. Although I do not doubt Mr. Cordovant's good faith, I find the Applicant's argument insufficient to satisfy the provisions of section 50 of the Act governing the use of licensed trade-marks. Consequently, I find that the portion of the evidence pertaining to the use of the Mark under license in Canada by Essilor Canada cannot benefit the Applicant. I will return to this point later, during my analysis of the grounds of opposition based on the likelihood of confusion between the parties' marks.

Grounds of Opposition Summarily Rejected

[51] The grounds of opposition set out in paragraphs a), b), c), l) and o) of the amended statement of opposition concerning the non-compliance of the application under section 30 of the Act can be summarily rejected, without it being necessary to reproduce them or discuss them at length. As rightly pointed out by the Applicant during the hearing, the Opponent has not provided any evidence or any representation in support of these grounds. Moreover, the grounds

pertaining to the Applicant's intentions at the time the application was filed must be appreciated not with regard to the Applicant but to its predecessor-in-title, Essilor International.

[52] The ground of opposition set out in paragraphs e), f), i), j) and m) of the amended statement of opposition, referring to the former basis of the registration application based on the use and registration of the Mark abroad, can be summarily rejected, without it being necessary to reproduce them or discuss them at length. As rightly pointed out by the Applicant during the hearing, these grounds have become inapplicable.

[53] The ground of opposition alleged in paragraph n) of the statement of opposition can also be summarily rejected, without it being necessary to reproduce it or discuss it at length. This ground of opposition, as argued, is unsustainable in that it combines an allegation to the effect that the Mark is not distinctive within the meaning of section 2 of the Act with the fact that the Applicant did not intend to use the Mark in Canada within the meaning of section 30 of the Act. As rightly pointed out by the Applicant during the hearing, such a combination is unsustainable within the meaning of section 38 of the Act [see *Scouts Canada v New PAPP International Inc*, 2011 TMOB 33].

Remaining Grounds of Opposition

[54] The remaining grounds of opposition all revolve around the question of the likelihood of confusion between the Mark and, essentially, one or more of the Opponent's marks listed in the appendix.

[55] More specifically, these grounds are of four types, namely that

- the Mark is not registrable within the meaning of section 12(1)(d) of the Act because it is confusing with one or more of the Opponent's registered marks listed in the appendix (with the exception of the OPTI-FREE PUREMOIST, OPTILASIK and OPTI-FREE EVERMOIST marks not alleged in support of this ground of opposition);
- the Applicant is not the person entitled to registration of the Mark, within the meaning of section 16(3)(a) of the Act, because at the date of filing of the application, the Mark was confusing with one or more of the marks listed in the appendix (with the exception of the

OPTIFIT, OPTI-FREE PUREMOIST, OPTILASIK and OPTI-FREE EVERMOIST marks not alleged in support of this ground of opposition), previously used by the Opponent in Canada;

- the Applicant is not the person entitled to registration of the Mark, within the meaning of section 16(3)(b) of the Act, because at the date of filing of the application, the Mark was confusing with one or more of the OPTI-FREE PUREMOIST, OPTILASIK and OPTI-FREE EVERMOIST marks detailed in the appendix, regarding which registration applications had been previously filed in Canada by the Opponent; and
- the Mark is not distinctive within the meaning of section 2 of the Act in that it is not adapted to distinguish the Applicant's goods from those of the Opponent offered in association with the marks listed in the appendix (with the exception of the OPTIFIT, OPTI-FREE PUREMOIST, OPTILASIK and OPTI-FREE EVERMOIST marks not alleged in support of this ground of opposition).

[56] As my analysis will reveal, although the test for confusion remains the same, the initial burden of proof incumbent on the Opponent and the relevant applicable dates vary according to each of these grounds. I will begin my analysis regarding the ground based on the non-registrability of the Mark within the meaning of section 12(1)(d) of the Act.

Non-registrability of the Mark

[57] The relevant date for deciding on a ground of opposition based on the non-registrability of a trade-mark in regard to the confusion created with a registered trade-mark is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)]. I exercised my discretion and checked that each of the registrations alleged by the Opponent in support of this ground is still in effect in the Register of Trade-marks. Since this is the case, the Opponent has met the initial burden of proof incumbent on it. The Applicant must now show, according to the balance of probabilities, that there is no risk of confusion between the Mark and these marks registered by the Opponent.

[58] Except where otherwise indicated, I will concentrate my analysis regarding the marks comprising the *prefix* "OPTI" combined with another word, namely the Opponent's OPTI-CLEAN, OPTI-FREE, OPTI-FREE EXPRESS, OPTI-ZYME, OPTI-FREE REPLENISH, OPTI-SOFT, OPTI-TEARS and OPTIFIT marks. If I conclude there is likelihood of confusion between one or more of these marks and the Mark, there would be even less likelihood of confusion between the Mark and the other marks alleged by the Opponent in support of this ground of opposition, which are farther away from the Mark.

The test for confusion

[59] The test for confusion is that of first impression and imperfect recollection. According to subsection 6(2) of the Act, 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.

[60] In deciding whether these trade-marks cause confusion, the registrar must take into account all circumstances in the case, specifically those listed in subsection 6(5) of the Act, i.e. 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 or trade-names have been in use; c) the nature of the goods, services or business; d) the nature of the trade; 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 different weight could be given to each of these factors, depending on the situation [see *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)].

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

[61] The parties' marks have an equivalent inherent distinctiveness in the context of the goods associated with them. The all have a character that is suggestive, to say the least, due to the prefix "OPTI" derived from the word "optique" (in English, "*optical*") related to vision,

combined with another equally suggestive word. In this respect, I believe that their distinctiveness is weak.

[62] It is possible to increase the strength of a trade-mark by making it known through promotion or use.

[63] As indicated above, this application is based on the proposed use of the Mark in Canada. Although the Applicant has filed evidence concerning its use and promotion in Canada by Essilor Canada effective from the year 2012, I am not ready to conclude that such use and promotion benefit the Applicant, in view of the problems discussed above concerning licensed use with regard to the provisions of section 50 of the Act.

[64] Concerning the Opponent's evidence, the use proved by all the exhibits filed in support of Ms. Mulhall's first affidavit essentially concerns the marks OPTI-FREE (and its declensions OPTI-FREE EXPRESS and OPTI-FREE REPLENISH) and AIR OPTIX. I will add on this subject that I am far from convinced that the declensions OPTI-FREE EXPRESS and OPTI-FREE REPLENISH have been perceived as having been used as such. Due to the marking described above in my review of Ms. Mulhall's first affidavit, and the use of different fonts and character sizes, I agree with the Applicant that the use proved instead has been perceived as two distinct trade-marks, namely the OPTI-FREE mark and the EXPRESS or REPLENISH "sub-mark", as applicable. Whatever the case may be, due to the absence of a breakdown of the sales and advertising figures provided by Ms. Mulhall, it is impossible, as mentioned above, to know precisely to which of the "OPTI Products" and to which of the "OPTI Marks" these figures are attached. Added to these deficiencies is the fact that it is not clear that the use of the OPTI-FREE and AIR OPTIX marks by Alcon Laboratories, Inc. benefits the Opponent according to the provisions of section 50 of the Act. As previously indicated, Ms. Mulhall provided no explanation concerning the relationship existing between this corporation and the Opponent. The fact that Ms. Mulhall was not cross-examined does not prevent me from appreciating the value of evidence she filed.

[65] Consequently, I am not ready to conclude, contrary to the position taken by the Opponent, that any or all of the "OPTI Marks" have become extremely well-known in Canada. At most I am ready to infer, in the circumstances, that a large part of the sales and promotion

carried out in Canada regarding the "OPTI Products" concerned the AIR OPTIX mark (in association with contact lenses) and the OPTI-FREE mark (in association with contact lens solutions). Once again, I cannot break down such sales and promotion between the AIR OPTIX and OPTI-FREE marks. Moreover, I cannot conclude that such sales and promotion have necessarily benefited the Opponent, in view of the deficiencies discussed above concerning licensed use with regard to the provisions of section 50 of the Act. In short, I cannot determine the extent to which one of the Opponent's marks has become known in Canada.

[66] My overall assessment of this first factor, which is a combination of the inherent and acquired distinctiveness of the marks in question, does not favour either of the parties.

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

[67] As indicated in the appendix, most of the trade-mark registrations alleged in support of this ground of opposition claim dates of first use in Canada, some dating back as far as 1986.

[68] However, in the absence of evidence of continuous use of each of the marks concerned by these registrations, such claims of use cannot alone favour the Opponent significantly. The mere existence of these registrations cannot establish more than a use *de minimis* of the trade-marks [see *Entre Computer Centers, Inc v Global Upholstery Co* (1992), 40 CPR (3d) 427 (TMOB)].

Type of goods, services or enterprises and the nature of the trade

[69] In considering the type of goods and services, and the nature of the trade, I must compare the statement of goods and services covered by the application under opposition with the statement of goods covered by the registrations alleged in the statement of opposition [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, these descriptions must be read so as to determine the likely type of trade of the parties instead of all the possible trades they may include. The evidence of the parties' real trade proves useful in this regard [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 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)].

[70] I agree with the Opponent that a certain overlap exists between the parties' goods in that they both concern, in particular, solutions and other cleaning and maintenance preparations in the vision field. The Applicant's solutions are intended for eyeglass lenses and for ophthalmic lenses (other than contact lenses), and the Opponent's solutions are intended for contact lenses.

[71] I also agree with the Opponent that a certain overlap exists between the parties' trade niches, in that the goods of both of them are sold, in particular, through vision professionals, such as opticians and optometrists.

The degree of resemblance between the trade-marks in the presentation or sound, or in the ideas they suggest

[72] As recalled by the Supreme Court in the *Masterpiece* case cited above, in paragraph 49, the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them is a factor that is often likely to have the greatest effect on the confusion analysis and the one that proves decisive in most cases.

[73] Moreover, as previously mentioned, it is well-established in case law that the 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), 80 CPR (3d) 247 (FCA), in paragraph 34].

[74] Also, it is true that in certain cases the first word will be the most important element in establishing the distinctiveness of a trade-mark, the Supreme Court stipulates in paragraph 64 of the *Masterpiece* case that “a preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique.”

[75] In the case at bar, given the descriptive and ordinary character of the prefix "OPTI", derived from the word "optique" ("*optical*"), in the context of goods in the vision field, I find

what stands out the most for each of the marks under study is their second portion. Although this second portion is suggestive, to say the least, I find that it plays a determining role in the public's perception by emphasizing the main characteristic or particularity of the optical goods associated with them, namely:

- the suffix "FOG" indicates the "*anti-fog*" property of the Applicant's goods;
- the suffix "CLEAN" indicates the cleaning property of the Opponent's solutions ("*solution for cleaning contact lenses*");
- the suffixes "FREE", "FREE EXPRESS", "FREE EXPRESS REPLENISH" and "SOFT" have a laudatory connotation in relation to the characteristics of the Opponent's contact lens solutions;
- the suffix "ZYME" indicates the enzymatic component of the Opponent's enzymatic solutions ("*Enzymatic contact lense [sic] cleaning preparation*");
- the suffix "TEARS" suggests that the Opponent's ophthalmic preparations for contact lenses have some connection with the secretion of tears; and
- the suffix "FIT" suggests that the Opponent's contact lenses are well suited to or perfectly fit the eyes.

[76] Given the significant differences in visual, phonetic and idea terms suggested by the second portion of the Mark and each of the second portions of the Opponent's marks, I find that the parties' marks differ more from each other than they resemble each other, when considered as a whole.

Additional Circumstances

Family of "OPTI" marks

[77] The Opponent submits that it holds a family of trademarks comprising the distinctive element "OPTI." Accordingly, the Opponent claims that the average consumer would react to the Mark in wrongly believing that the Applicant's goods are approved by, or otherwise associated

with the Opponent. In other words, the Mark would be perceived, at first sight, as another member of the Opponent's family of "OPTI" marks.

[78] As the Applicant reminded us at the hearing, the existence of a family of trade-marks cannot be presumed [see *Techniquip Ltd v C.O.A.* (1998), 3 CPR (4th) 298 (FCA)]. In this instance, the Opponent, at best, has established the use of the OPTI-FREE, OPTI-FREE EXPRESS, OPTI-FREE REPLENISH, OPTI-FREE EVERMOIST and AIR OPTIX trade-marks. I say "at best" because, as previously indicated, I am far from convinced that the "declensions" OPTI-FREE EXPRESS, OPTI-FREE REPLENISH and OPTI-FREE EVERMOIST have been perceived as such and not as two distinct marks, namely the OPTI-FREE mark and the EXPRESS, REPLENISH or EVERMOIST "sub-marks", as applicable. Whatever the case may be, in my opinion the fact remains that this cannot be a family of "OPTI" trade-marks, strictly speaking. At best it would be a family of "OPTI-FREE" trade-marks, composed of the common denominator "OPTI-FREE", and not the broader family "OPTI" (discussed below).

[79] I will add on this subject that the mere fact that the AIR OPTIX mark contains the letters "OPTI" is not sufficient, in my opinion, to consider it to be part of a "family" of trade-marks comprised of the element "OPTI", strictly speaking. This would amount to dissecting the AIR OPTIX mark, whereas the "OPTIX" element forms an inseparable whole.

[80] The Opponent instead holds a portfolio of trade-marks, including those associated with the contact lens solutions, comprising the prefix "OPTI" as the common denominator (such as the OPTI-CLEAN, OPTI-FREE, OPTI-ZYME, OPTI-SOFT marks, etc.), whereas the marks associated with contact lenses comprising the word "OPTIX" as the common denominator (such as O2OPTIX and AIR OPTIX).

[81] A family of trade-marks is generally composed of more than two trade-marks [see *Retail Royalty Company and American Eagle Outfitters, Inc v Hawke & Company Outfitters LLC*, 2011 TMOB 139 at para. 51, upheld on appeal 2012 FC 1539]. Consequently, even presuming that the AIR OPTIX and OPTI-FREE marks are part of the same family of "OPTI" marks, the evidence of use of only two of them is insufficient in itself to prove the existence of such an alleged family.

[82] In this, the facts of the present case are distinguished from those in *Alcon Pharmaceuticals, Ltd v Akorn Pharmaceuticals Canada Limited* (1997), 84 CPR (3d) 241 (TMOB), cited by the Opponent, in which the Registrar had concluded the existence of family of "OPTI" marks in the following terms:

As an additional surrounding circumstance, I have considered the opponent's family or series of OPTI-prefixed marks. In accordance with the decision in McDonald's Corp. v Yogi Yogurt Ltd. (1982), 66 CPR (2d) 101 (FCTD), in order for the opponent to rely on the concept of a family of marks, it was incumbent on the opponent to evidence use of the family members. This the opponent has done. The first Gorshenin affidavit establishes extensive use of the marks OPTI-FREE and OPTI-ZYME, some use of OPTI-PURE, OPTI-TEARS, OPTI-TAB and OPTI-SOFT and minor use of OPTI-SOAK. Thus, the opponent has established the existence of an extensive family of OPTI-prefixed marks for cleaning and disinfecting solutions and the like for contact lenses. It therefore follows that consumers would be more likely to assume that a new OPTI-prefixed mark for similar wares belonged to the opponent.

Coexistence of the Parties' Marks in the Registers of Foreign Countries

[83] As indicated above in my review of Mr. Cordovant's affidavit, the Applicant filed evidence according to which the Mark and some of the Opponent's marks coexist in the trade-mark registers of foreign countries. I find such an additional circumstance to be irrelevant in the case at bar.

[84] As indicated above, this portion of Mr. Cordovant's testimony is based on hearsay. Moreover, it is appropriate in this regard to cite the observation formatted by the Registrar in *Quantum Instruments Inc v Elinca SA* (1995), 60 CPR (3d) 264 (TMOB):

As yet a further surrounding circumstance in respect of the issue of confusion, the applicant submitted evidence of registrations obtained by both parties in Great Britain and in the United States of America for the trade-marks QUANTA and QUANTUM. However, as noted [...] in *Re Haw Par* [...], little can be drawn from the fact that the trade-marks at issue co-exist in other jurisdictions. [...] the Registrar must base his decision on Canadian standards, having regard to the situation in Canada. Further, in *Sun-Maid* [...] [the Court] pointed out that "no significance can be attached to failure to oppose or object to registrations in other jurisdictions since such actions, of necessity, have their basis entirely in foreign law and procedure". Additionally, while the applicant has relied upon evidence of co-existence of the trade-marks at issue on the registers in Great Britain and the United States of America, no evidence has been adduced of the co-existence of the trade-marks at

issue in the marketplace in either of these countries. [...] Accordingly, I do not consider this evidence to be persuasive in this proceeding.

[85] As in the *Quantum* case, no evidence that the trade-marks in question coexist on the market in these other countries was filed in the case at bar.

Conclusion – Likelihood of Confusion

[86] As indicated on page 163 in the *Dion Neckwear* case cited above, the registrar does not have to be convinced beyond all doubt that there is no likelihood of confusion. Indeed, "[t]he "beyond doubt" standard imposes an insurmountable burden because certainty in matters of likelihood of confusion is rare". [Also see *John Labatt Ltd v Molson Companies Ltd*, supra].

[87] Considering the well-established principle in case law that in the presence of weak marks, small differences between the trade-marks are generally sufficient to avoid any likelihood of confusion, it is my opinion that the Applicant has established, according to the balance of probabilities, that a consumer with an imperfect memory of one of the Opponent's OPTI-CLEAN, OPTI-FREE, OPTI-FREE EXPRESS, OPTI-ZYME, OPTI-FREE REPLENISH, OPTI-SOFT, OPTI-TEARS or OPTIFIT marks would not be likely to conclude that the Applicant's goods come from the same source or are otherwise related to or associated with the Opponent's goods.

[88] As indicated previously, I find that the trade-marks in question appear particularly weak. In the absence of evidence allowing me to conclude that one or more of the Opponent's trade-marks were used in such manner as to increase their distinctiveness significantly, I find that the differences existing between the Mark and each of the Opponent's trade-marks considered in isolation (and not as a "family" of "OPTI" trade-marks, since the existence of such a family has not been proved in the case at bar) are sufficient to counterbalance the factors favouring the Opponent.

[89] Having previously concluded that the Opponent had its best chances of success by raising the likelihood of confusion between the Mark and one or more of the OPTI-CLEAN, OPTI-FREE, OPTI-FREE EXPRESS, OPTI-ZYME, OPTI-FREE REPLENISH, OPTI-SOFT, OPTI-TEARS and OPTIFIT marks, and that it did not prevail, I conclude even more strongly that there

is no likelihood of confusion between the Mark and the other marks alleged by the Opponent in support of this ground of opposition.

[90] Consequently, I reject the ground of opposition based on the non-registrability of the Mark.

Non-entitlement to Registration

(i) Pursuant to section 16(3)(a) of the Act

[91] To meet its initial burden of proof in regard to section 16(3)(a) of the Act, the Opponent must show that one or more of the marks listed in the appendix (with the exception of the OPTIFIT, OPTI-FREE PUREMOIST, OPTILASIK and OPTI-FREE EVERMOIST marks not alleged in support of this ground) had been used in Canada prior to the date of filing of this application and had not been abandoned as at the date of its advertisement in the *Trade-marks Journal*, in this instance July 11, 2012 [section 16(5) of the Act]. Such as it emerges from my analysis above, I find this initial evidentiary burden was satisfied only with regard to the OPTI-FREE and AIR OPTIX marks.

[92] The difference between the relevant dates really has no impact on my preceding analysis regarding the ground of opposition based on the non-registrability of the Mark under section 12(1)(d) of the Act.

[93] Consequently, I reject the ground of opposition based on non-entitlement to registration pursuant to section 16(3)(a) of the Act.

ii. Pursuant to section 16(3)(b) of the Act

[94] To discharge its initial evidentiary burden concerning section 16(3)(b) of the Act, the Opponent must prove that its registration applications for the OPTI-FREE PUREMOIST, OPTILASIK and OPTI-FREE EVERMOIST marks were filed prior to the date of filing of the Applicant's application and that such applications were pending at the date of publication of the Applicant's application [section 16(4) of the Act]. This initial burden has been satisfied in the case at bar only regarding the OPTI-FREE PUREMOIST and OPTILASIK marks.

[95] It is thereupon incumbent on the Applicant to prove, according to the balance of probabilities, that there was no risk of confusion between the Mark and each of the OPTI-FREE PUREMOIST and OPTILASIK marks.

[96] Having previously concluded the absence of confusion between the Mark and each of the Opponent's registered marks listed in the appendix, I do not intend to repeat the test for confusion at length. It is sufficient to mention that the differences existing between the Mark and the OPTI-FREE PUREMOIST mark are more pronounced than they were with the OPTI-FREE mark.

[97] As for the OPTILASIK mark, it is distinguished not only in terms of ideas (the "suffix" "LASIK" not suggesting any particular idea, apart from possibly being reminiscent of the word "laser"), but also in terms of the nature of the goods associated with it. Whereas a certain overlap exists between each party's solutions and other cleaning and maintenance preparations in the vision field, such overlap cannot be concluded between the Applicant's goods and the Opponent's print publications and information services, apart from the mere fact that they are attached to the vision field.

[98] Consequently, I reject the ground of opposition based on non-entitlement to registration within the meaning of section 16(3)(b) of the Act

Non-distinctiveness of the Mark

[99] To meet its initial burden of proof with regard to non-distinctiveness, the Opponent must show that one or more of its the marks alleged in support of this ground had become sufficiently known in Canada on the date of the statement of opposition, namely December 11, 2012, such as to deny the distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FCTD)]. This initial evidentiary burden has been met only in regard to the OPTI-FREE and AIR OPTIX marks.

[100] The difference between the relevant dates really has no impact on my preceding analysis regarding the ground of opposition based on the non-registrability of the Mark under section 12(1)(d) of the Act.

[101] Accordingly, I reject the ground of opposition based on non-distinctiveness of the Mark.

Decision

[102] In exercising the authority delegated to me pursuant to section 63(3) of the Act, I reject the opposition in application of section 38(8) of the Act.

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

Certified true translation
Arnold Bennett

Appendix

| Mark | Registration or application no. | Date of registration or filing of the application | Goods or services covered by the registration or the application / Date of first use in Canada |
|------------------------|---------------------------------|---|--|
| OPTI-CLEAN | TMA317,939 | Sept. 5, 1986 | <i>Solution for cleaning contact lenses.</i> June 23, 1986 |
| OPTI-FREE | TMA361,883 | Nov. 3, 1989 | <i>Solution for use with contact lenses.</i> August 4, 1989 |
| OPTI-FREE EXPRESS | TMA514,609 | June 21, 1999 | <i>Solutions for use with contact lenses.</i> June 21, 1999 |
| OPTI-ZYME | TMA315,814 | June 27, 1986 | <i>Enzymatic contact lense (sic) cleaning preparation.</i> April 29, 1986 |
| OPTI-FREE REPLENISH | TMA708,239 | Feb. 26, 2008 | <i>Solutions for use with contact lenses.</i> February 4, 2008 |
| OPTI-SOFT | TMA334,811 | Dec. 4, 1987 | <i>Solution for rinsing, storing and disinfecting contact lenses.</i> September 28, 1987 |
| OPTI-TEARS | TMA334,810 | Dec. 4, 1987 | <i>Ophthalmic preparation for use with contact lenses.</i> September 28, 1987 |
| O2OPTIX | TMA696,766 | Sept. 18, 2007 | <i>Contact lenses.</i> August 31, 2007 |
| O2 OPTIX CUSTOM DESIGN | TMA690,516 | June 21, 2007 | <i>Contact lenses.</i> June 1, 2007 |
| O2 OPTIX & DESIGN | TMA681,627 | Feb. 13, 2007 | <i>Contact lenses.</i> January 9, 2007 |
| O2 OPTIX | TMA680,580 | Jan. 29, 2007 | <i>Contact lenses.</i> January 9, 2007 |
| AIR OPTIX | TMA717,340 | June 23, 2008 | <i>Contact lenses.</i> May 27, 2008 |
| AIR OPTIX & DESIGN | TMA717,339 | June 23, 2008 | <i>Contact lenses.</i> May 27, 2008 |
| OPTIFIT | TMA359,547 | August 18, 1989 | <i>Contact lenses</i> |
| OPTI-FREE PUREMOIST | 1,459,228 | Nov. 16, 2009 | <i>Ophthalmic pharmaceutical preparations; solutions for use with contact lenses.</i> |

| Mark | Registration or application no. | Date of registration or filing of the application | Goods or services covered by the registration or the application / Date of first use in Canada |
|------------------------|---------------------------------|---|---|
| OPTILASIK | 1,473,585 | March 17, 2010 | <i>Printed educational materials in the field of ophthalmology, namely, brochures, posters, folders, placemats, journals, magazines and medical publications; printed newsletters in the field of ophthalmology. Providing medical information.</i> |
| OPTI-FREE EVERMOIST | 1,471,450 | March 2, 2012 | <i>Contact lens solutions</i> |

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

HEARING DATE: 2016-08-09

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