



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

Citation: 2012 TMOB 184
Date of Decision: 2012-10-10

IN THE MATTER OF AN OPPOSITION
by Blistex Inc. to application
No. 1,345,735 for the trade-mark MEDEX
in the name of Smiths Medical ASD, Inc.

[1] On May 1, 2007, Smiths Medical ASD (the Applicant) filed an application to register the MEDEX trade-mark (the Mark). The application was filed on the basis of the Applicant's use of the Mark since at least as early as 1983 in Canada with the following wares (as amended):

Intravenous pressure monitoring and regulating apparatus and instruments; pressure transducers; intravenous administration apparatus and instruments; stopcocks and stopcock manifolds for medical use, central venous pressure monitors; blood sampling sites (sites used to extract samples); manometers for medical use; connectors for intravenous tubes, catheters and cannulae; intravenous lines; pressure monitors; injection lines for medical use; medical needles and medical needle assemblies and guards for medical needles and medical needle assemblies; intravenous fluid filters; infusion pumps for medical purposes; blood pressure monitors; nebulizers used for respiration therapy; breathing gas humidifiers; ventilators; intravenous tubes, catheters and cannulae (the Wares).

The application was advertised for opposition purposes in the *Trade-marks Journal* of April 9, 2008.

[2] On August 13, 2008, Blistex Inc. (the Opponent) filed a statement of opposition pleading the grounds summarized below:

- (a) contrary to sections 30(b) and 30(i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), the Applicant is not a legal entity and therefore, the Applicant could not have stated that it had used the Mark and that it was satisfied it was entitled to use the Mark;
- (b) contrary to section 30(b) of the Act, the Applicant has not used the Mark in association with each of the Wares;
- (c) contrary to section 30(b) of the Act, the Applicant has not used the Mark in association with each of the Wares since 1983;
- (d) contrary to section 12(1)(d) of the Act, the Mark is not registrable because it is confusing with registration No. TMA311,461;
- (e) contrary to section 16(1)(a) of the Act, the Applicant is not the person entitled to registration of the Mark because at the real date of first use in Canada by the Applicant, if any, the Mark was confusing with the trade-mark LIP MEDEX of the Opponent used in Canada since at least as early as December 30, 1985; and
- (f) contrary to section 2 of the Act, the Mark is not distinctive of the Applicant.

[3] An application amending the name of the Applicant to Smiths Medical ASD, Inc. was filed along with an affidavit of Jonathan M. Flint explaining that the Applicant should have been identified as Smiths Medical ASD, Inc. when the application was filed. This amended application was accepted on October 22, 2008.

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

[5] The Opponent subsequently amended its statement of opposition to add the ground that contrary to section 30(a) of the Act, the statement of wares is not a description in ordinary commercial terms, more particularly with respect to the following: "intravenous pressure monitoring and regulating apparatus and instruments; intravenous administration apparatus and instruments."

[6] In support of its opposition, the Opponent filed affidavits of David Arch and Zeina Waked and a certified copy of registration No. TMA311,461. Mr. Arch and Ms. Waked were cross-examined and the transcripts and answers to undertakings were filed. Both parties filed a written argument and attended a hearing held on September 13, 2012.

Onus and Material Dates

[7] 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 Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[8] The material dates with respect to the grounds of opposition are as follows:

- sections 38(2)(a)/30 of the Act - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];

- sections 38(2)(b)/12(1)(d) of the Act - the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];

- sections 38(2)(c)/16(1) of the Act – the date of first used alleged in the application;
and

- sections 38(2)(d) of the Act - the date of filing the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc.* (2004), 34 CPR (4th) 317 (FC)].

Section 30 Grounds of Opposition

[9] The Opponent pleads that the application is contrary to sections 30(a), 30(b) and 30(i) of the Act.

section 30(a) ground of opposition

[10] The Opponent submits that the Wares described as “intravenous pressure monitoring and regulating apparatus and instruments; intravenous administration apparatus and instruments” do

not comply with section 30(a) of the Act since “no one can order products with such description” and that it is not known what specific items these descriptions refer to (for example, hand instruments, syringes, catheters, canulae, transducers, sphygmomanometers, or pressure sensors).

[11] There are two issues to be determined under a section 30(a) ground of opposition, whether the statement of wares or services is in ordinary commercial terms and whether it adequately identifies the specific wares and services [*Whirlpool SA v Eurotherm Holdings Ltd*; 2010 CarswellNat 4282 (TMOB) at para 39].

[12] The affidavit of Zeina Waked, a paralegal employed by the agents for the Opponent, attaches GOOGLE search results for the impugned descriptions (Exhibits ZW-10-15). Ms. Waked was cross-examined on the searches and, in its written argument and at the hearing, the Applicant attacked the manner in which the searches were carried out. It is unnecessary for me to comment on Ms. Waked’s evidence since the Opponent’s submissions in its written argument alone are sufficient for the Opponent to meet its light burden under this ground of opposition [*McDonald's Corp v MA Comacho-Saldana International Trading Ltd* (1984), 1 CPR (3d) 101 (TMOB) at 104]. Therefore, the Applicant has the onus of proving that the application is in compliance with section 30(a) of the Act.

[13] The Applicant argues that the impugned descriptions are in ordinary commercial terms and points to the Canadian Intellectual Property Office Wares and Services Manual which states that “in rare circumstances, wares including the term “apparatus” without further specification may be acceptable if the function or area of use can be reasonably understood to be very narrow.” The Manual provides the following acceptable examples: “blood pressure measuring apparatus” and “anaesthetic delivery apparatus”. I find that “intravenous pressure monitoring and regulating apparatus and instruments; intravenous administration apparatus and instruments” is acceptable since the area of use and function are narrowly specified. In the circumstances, the fact that the Applicant has not identified the exact equipment is not fatal since there is enough information to determine the nature of these wares and the specific wares at issue. Therefore, this ground of opposition is rejected.

section 30(b) grounds of opposition

[14] The Opponent alleges that the application contravenes section 30(b) of the Act since the Applicant had not used the Mark in association with each of the Wares since the date claimed.

[15] To meet its evidential burden, the Opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support the ground exist [*John Labatt Ltd, supra*]. The Opponent's burden is, however, lighter with respect to the issue of non-compliance with section 30(b) because the facts supporting no use of the Mark are particularly within the knowledge of the Applicant [*Tune Masters v Mr. P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89].

[16] At the outset, I note that the fact that the application as filed was in the name of Smiths Medical ASD does not form a valid ground of opposition since the application was amended to correct this inadvertent error [*Seven-Up Canada Co v Caribbean Ice Cream Co*; 2007 CarswellNat 1361 at para 11].

[17] In support of this ground of opposition, the Opponent relies on Internet printouts obtained by Ms. Waked. Ms. Waked attaches printouts from the *www.smiths-medical.com* website (Exhibits ZW-1-ZW-6) and GOOGLE search results and two directory entries for the Applicant from *www.answers.com* and *www.biz.yahoo.com* (Exhibits ZW-7-ZW-9). The printouts from *www.smiths-medical.com* are admissible even though they are hearsay since it was necessary for the Opponent to file them and they are reliable since the Applicant, being a party, has the opportunity to refute the evidence [*Reliant Web Hostings Inc v Tensing Holding BV*; 2012 CarswellNat 836 (TMOB) at para 35]. The GOOGLE search results and directory entries attached as Exhibits ZW-7-ZW-9 are not admissible since there is no evidence of the reliability of the GOOGLE search results or the third party directories [*Envirodrive Inc v 836442 Alberta Ltd*, 2005 ABQB 446 (Alta QB); *Institut National des Appellations d'Origine v Kohler Co*; 2010 TMOB 162 at para 11].

[18] The printouts obtained by Ms. Waked from the *www.smiths-medical.com* website are summarized below. I note that Ms. Waked did not obtain printouts of the "Products" portion of the website, or any pages from the website other than those listed below. Ms. Waked simply

provided the few pages from the website requested by the agent for the Opponent (paras 3-4; cross-examination questions 4-12).

- Exhibit ZW-1 – The home page of the website. It includes Medex in the list of brands along the left side.
- Exhibit ZW-2 – The about us page of the website which states that “Smiths Medical is a leading global provider of medical devices for the hospital, emergency, home and specialist environments”. Smiths Medical is noted to be part of the Smiths Group plc, a UK based company.
- Exhibit ZW-3 – A printout of the results for a search for Canada showing seven results.
- Exhibit ZW-4 – The contact us page which provides contact information for Smiths Medical International, Smiths Medical (UK), and Smiths Medical U.S.A. Customer Service Contacts.
- Exhibits ZW-5–ZW-6- The Smiths Medical Distributors List which lists two distributors in Canada including Smiths Medical Canada Ltd.

[19] I agree with the Applicant that the apparent absence of the Applicant on the *www.smiths-medical.com* website is insufficient to meet the Opponent’s evidentiary burden. I note that the Opponent’s evidence does not lead to the inference that the Applicant has not used the Mark in Canada since the date claimed in the application. The Opponent’s allegation implies an unsubstantiated assumption that use of a trade-mark by an applicant necessarily will include reference to that applicant on the Internet. I do not consider this to be the case. Failure to locate the Applicant, the Wares or goods branded with the Mark on a very limited search of a website which includes reference to numerous related corporate entities, the brand at issue and Canadian distributors does not meet the Opponent’s burden.

[20] The subject opposition can be distinguished from the cases relied upon by the Opponent at the hearing. In each of these cases, evidence was adduced that raised doubts as to whether the applicant had used the applied-for mark at the date claimed. In *Guevin v Tall Dark and Handy Handyman Services Ltd*; 2011 TMOB 222, the applicant’s evidence was that there was use since

“in about 2001” or “on or about 2001” when the claimed date was 2001 (therefore as of December 31, 2001). The Registrar found that this phrasing could be interpreted as use beginning in 2001-2002 (paras 14-17). In *Pillsbury Co v Alantra Imports Co* (1999), 1 CPR (4th) 252 (TMOB), the opponent’s affiant’s evidence was that he knew the relevant marketplace and had not heard of the applicant. He asked the opponent’s sales force and brokers to further check the marketplace to see if any one had heard of the applicant or the ROLLED PIZZA mark. No one had (256-258).

[21] The section 30(b) grounds of opposition are therefore rejected.

section 30(i) grounds of opposition

[22] The section 30(i) ground of opposition may be summarily dismissed since the Applicant has provided the statement required by section 30(i), and this ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB); *Multi-Marques Inc v Gesfor Aktiengesellschaft* (2008), 74 CPR (4th) 15 (TMOB) at 89]. As the application includes the required statement and there is no allegation or evidence of bad faith or other exceptional circumstances, this ground of opposition is rejected.

Section 12(1)(d) Ground of Opposition

[23] I have exercised my discretion and checked the register to confirm that the registration relied on by the Opponent, and set out below, is extant [*Quaker Oats Co Ltd of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Therefore, the Opponent has met its initial burden with respect to this ground.

Registration No.	Trade-mark	Wares
TMA311,461	LIP MEDEX	Medicated lip preparations.

[24] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated that the use of a trade-mark causes confusion with another trade-mark if the use of

both trade-marks in the same area would likely lead to the inference that the wares and services associated with those trade-marks are manufactured, sold or leased by the same person, whether or not the wares and services are of the same general class. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the wares and services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them.

[25] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Mattel, Inc v 3894207 Canada Inc*, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

inherent distinctiveness and extent known

[26] A trade-mark is not inherently distinctive if it is suggestive of a characteristic of the associated wares or services. I can take judicial notice of the meaning of the words comprising the trade-marks of each party [*Tradall SA v Devil's Martini* (2011), 92 CPR (4th) 408 (TMOB) at para 29]. The Canadian Oxford Dictionary (1998 ed) includes the following definitions of MED: “medical; (usu in plural) medication”. Since both parties’ wares include the component “med”, and both parties’ wares are medical in nature, I find that the parties’ marks have a limited degree of distinctiveness.

[27] A trade-mark may acquire distinctiveness by becoming known through use or promotion. There is no evidence that the Mark has acquired distinctiveness. In contrast, the evidence of Mr. Arch, Chairman/Chief Executive of the Opponent, provides that:

- The LIP MEDEX brand lip care products were introduced in Canada in 1985 (para 9). These products are sold in a jar and stick format (para 10). The LIP MEDEX trade-mark appears on packaging (Exhibit 2) which further identifies the products as medicated BLISTEX.

- Over 1 Million units of LIP MEDEX products have been sold in Canada each year between 2004-2009 (para 17), with over 1 Million units being sold by March of 2009 (para 17).
- The Opponent's LIP MEDEX products are sold at drug stores, grocery stores, mass merchandisers, gas and convenience stores (para 15).
- The LIP MEDEX products have been promoted in publications, in material distributed to customers and retailers, by way of coupons and flyers, and point of sale displays (paras 12-15; Exhibits 3-5).

In view of the evidence furnished by the Opponent, I am satisfied that the LIP MEDEX trade-mark has become known to some extent in Canada in association with the registered wares.

length of time each has been in use

[28] Mr. Arch asserts that the LIP MEDEX trade-mark has been used in Canada since at least as early as 1985 and provides proof of use from at least 1994 forward (answers to undertakings, OQ-26); there is no evidence that the Applicant has used the Mark.

degree of resemblance

[29] In considering the degree of resemblance, the Supreme Court of Canada in *Masterpiece*, supra sets out that the approach to assessing resemblance should involve a consideration of whether there is an aspect of a trade-mark that is particularly striking or unique (para 64). I find that there is resemblance between the parties' marks in appearance and sound due to the shared component MEDEX. However, the ideas suggested by the marks are different. The Opponent's LIP MEDEX trade-mark suggests a medication for the lips whereas the Mark suggests medical products in general.

nature of the wares, services or business; the nature of the trade

[30] When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark application and registration that govern in respect of the issue of confusion arising under section 12(1)(d). These statements must be read with a view to determining the probable type of business or trade intended by the parties [*Esprit International v Alcohol Countermeasure Systems Corp* (1997), 84 CPR (3d) 89 (TMOB) at 98-99].

[31] The Opponent argues that there is a great deal of overlap between Wares and the Opponent's wares. Specifically, the Opponent argues that the application "covers products which could be portable and used at home by ordinary Canadians, ... people who go to pharmacies and drugs stores to make their purchases ... the same people could at the same place find the Opponent's products LIP MEDEX and believe that the same source is at the root of both products".

[32] While I accept the Opponent's submissions that there is some overlap with respect to the nature of trade and the potential for some of the Wares to be sold in drug stores, I do not find that the nature of the wares overlap. The Applicant's wares are medicated lip preparations used "to relieve the discomfort of cold sores, fever blisters, severely dry, cracked lips" (Arch affidavit, Exhibit 2). In contrast, the Applicant's website states that its products are used "during critical and intensive care, surgery, post-operative care during recovery and in a series of high-end home infusion therapies" (Waked Affidavit, Exhibit ZW-2). The Wares are all highly specialized medical products that would require significant education to be used. None of the Wares appear to be used in the treatment of conditions affecting the lips, nor the skin in general. As the parties' wares do not have overlapping uses it is unlikely that consumers would think that there would be a common source for them [*Wyeth v Fempro Inc* (2004), 37 CPR (4th) 261 (TMOB) at 275-276].

surrounding circumstance: lack of evidence of confusion

[33] An adverse inference concerning the likelihood of confusion may be drawn when concurrent use on the evidence is extensive and no evidence of confusion has been given by an opponent [*Christian Dior, SA v Dion Neckwear Ltd* (2002), 20 CPR (4th) 155 (FCA) at para 19].

As there is no evidence of extensive concurrent use of the marks by the parties that would support no likelihood of confusion at the material date, this is not a relevant surrounding circumstance.

conclusion

[34] Section 6(2) of the Act does not concern confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether there would be confusion of the Wares sold under the Mark such that they are thought to be provided by the Opponent. I conclude that, on a balance of probabilities, given all the surrounding circumstances there is not a reasonable likelihood of confusion. The differences between the marks and their associated wares are sufficient to make confusion unlikely. This ground of opposition is therefore rejected.

Section 16(1)(a) Ground of Opposition

[35] The Opponent has alleged that the Applicant is not the person entitled to register the Mark as it is confusing with its prior use of the LIP MEDEX trade-mark. As the section 30(b) grounds of opposition were rejected, the relevant date remains the date of use claimed in the application [*Spirits International BV v Distilleries Melville Ltée* (2011), 96 CPR (4th) 277 (TMOB) at para 91]. In order to satisfy its evidential burden, the Opponent must evidence use of its LIP MEDEX trade-mark predating the Applicant's claimed date of first use of 1983 and that such use had not been abandoned at the date of advertisement of the application of the Mark. In his affidavit, Mr. Arch states that LIP MEDEX products were launched in 1985 and have been continuously sold across Canada since that date (para 9). As the Opponent's use does not predate the Applicant's claimed date of use, the section 16(1)(a) non-entitlement ground of opposition must be rejected on the basis that the Opponent has failed to meet its evidential burden. I note that even if the Opponent had met its burden it would not have succeeded for the reasons set out with respect to the section 12(1)(d) ground.

Distinctiveness

[36] I will not discuss this ground of opposition in detail as it does not favour the Opponent any more than the above grounds. As discussed above, given the difference in the Opponent's wares and the Wares and the parties' marks, the Opponent's use and advertising of LIP MEDEX is insufficient to negate the distinctiveness of the Mark. This ground of opposition is therefore rejected.

Disposition

[37] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office