



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

Citation: 2011 TMOB 121

Date of Decision: 2011-07-18

**IN THE MATTER OF AN OPPOSITION by
Biotest AG to application No. 1,374,538 for
the trade-mark ERYTRA in the name of
Grifols, S.A.**

[1] On December 4, 2007, Grifols, S.A. (the Applicant) filed an application to register the trade-mark ERYTRA (the Mark) based upon proposed use of the Mark in Canada in association with the following wares:

Reagents for blood banks. Self-analyzers to determine blood groups and pretransfusional tests, namely automatic analysis apparatus for blood group determinations and pretransfusional tests.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of January 21, 2009.

[3] On March 20, 2009, Biotest AG (the Opponent) filed a statement of opposition claiming that the application does not conform to the requirements of s. 30(d) and (i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act). The statement of opposition also claims that the Mark is not registrable pursuant to s. 12(1)(d) of the Act, that it is non-distinctive of the Applicant pursuant to s. 2 and 38(2)(d) of the Act, and that the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a) of the Act in view of the fact that the Mark is confusing with the Opponent's trade-mark ERYTYPE, previously used in Canada by the Opponent since at least as early as April 16, 2007, and registered under No. TMA689,143 in association with "pharmaceutical products for blood-serology namely sera for blood-group serology".

[4] The Applicant filed and served a counter statement in which it denies the Opponent's allegations. Leave was sought by the Opponent to amend its statement of opposition so as to correct typographical errors, and such leave was granted by the Registrar on September 1, 2009. The Applicant filed a revised application on October 5, 2009, deleting the reference to "reagents for blood banks" in the applied-for statement of wares.

[5] In support of its opposition, the Opponent filed a certified copy of registration No. TMA689,143 for its ERYTYPE trade-mark. In support of its application, the Applicant filed the affidavit of Jean-François Journault, an articling student with the law firm representing the Applicant in the present opposition proceeding, sworn December 3, 2009. The Opponent further filed, as reply evidence, the affidavit of Markus Bernard, Director Sales International Subsidiaries, at Biotest Medial Diagnostic GmbH (a subsidiary of the Opponent), sworn February 5, 2010.

[6] Only the Opponent filed a written argument. An oral hearing was not requested.

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[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 evidentiary 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.); and *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

Summary of the parties' evidence

[8] As indicated above, the Opponent's evidence consists of a certified copy of the registration secured for the ERYTYPE trade-mark. The Opponent also filed, as reply evidence, the affidavit of Markus Bernard. According to Rule 43 of the *Trade-marks Regulations*, SOR/96-

195 (the Regulations), such evidence must be strictly confined to matters in reply. I am satisfied that it does. In order to put my comments regarding Mr. Bernard's affidavit in context, I will first briefly go over the Applicant's evidence introduced through the affidavit of Jean-François Journault.

[9] The affidavit of Mr. Journault consists of dictionary and Web references that he located. More particularly, Mr. Journault states in section A of his affidavit that he consulted the Canadian Intellectual Property Office trade-marks database and produces as Exhibit JF-1 copies of the particulars pertaining to the following trade-mark application and registration respectively:

- Trade-mark application No. 1,387,023 for ERYtech PHARMA in association with the following wares: “produits pharmaceutiques sous forme de poche de sang de thérapie cellulaire à base de globules rouges encapsulant un enzyme thérapeutique pour traiter des patients atteints de leucémie ou atteints de cancer solide”; and
- Trade-mark registration No. TMA327,165 for ERYPUR in association with the following wares: “apparatus for the filtration of red blood cell concentrates”.

[10] As pointed out by the Opponent, no explanation of the search terms employed or the methodology that was used is provided. I will revert to this point below when assessing the surrounding circumstances under the s. 12(1)(d) ground of opposition.

[11] Section B of Mr. Journault's affidavit pertains to a search he conducted on the United States Patent and Trademark Office website. Mr. Journault attaches as Exhibit JF-2 copy of a patent application bearing Serial No. 2008/0098830, and states that this is the patent covering the device to which the Applicant's Mark is directed.

[12] As pointed out by the Opponent, it is not stated that Mr. Journault is speaking as someone knowledgeable of the above facts, nor how he is aware of the fact that the patent he cites is related to the Mark. In any event, and as put forward by the Opponent, all that can be gleaned from such patent is that it relates to a device for loading reagent cards for clinical analysers. The cards consist of a support element provided with various microtubes or small cups of variable

cross-section to provide wells for clinical analysis reactions. By placing the cards side by side, a vertical orientation of the cards is obtained when inserted into the clinical analyzer.

[13] In section C of his affidavit, Mr. Journault attaches as Exhibit JF-3 definitions of the word “erythrocyte” in both French and English. The second edition of the *Canadian Oxford Dictionary* defines “erythrocyte” as follows: “one of the principal cells in the blood of vertebrates, containing the pigment hemoglobin and transporting oxygen and carbon dioxide to and from the tissues”.

[14] In section D of his affidavit, Mr. Journault attaches as Exhibit JF-4 to JF-10 printouts from various websites, namely:

- Exhibit JF-4 that consists of a main page for the Opponent’s website at *www.biotest.de*, which states that:

Biotest is a world-wide operating specialist in immunology and hematology. Our products save lives, offer new perspectives to the chronically ill, ensure proper diagnostics and ensure purity in sensitive production processes. We take these responsibilities very serious every day and can count on the knowledge, experience and commitment of over 2,000 employees in in [sic] major European countries as well as in the US and Japan.

- Exhibit JF-5 that contains pages from the Opponent’s website discussing “Blood Group Determination” under the trade-marks ERYTYPE and ERYTYPE S, the latter being used for fully automatic processing using the TANGO optimo branded fully automated blood group analyser;
- Exhibits JF-6 to 8 and JF-10 that contain pages from the Opponent’s website and the website *www.intermedico.com* concerning the Opponent’s “Country Representative Diagnostics” in Canada, namely Inter Medico, from Markham, Ontario. Inter Medico acts as a distributor of instruments used in laboratory analysis and immunodiagnostic kits; and
- Exhibit JF-9 that contains pages from the website *www.eddadesign.com* wherein

reference is made to the Applicant's analyzer as follows:

GRIFOLS has officially presented the new Erythra analyser at the ISBT (International Society of Blood Transfusion) conference in Macao and it was received with a very warm welcome. Erythra is an auto analyser which determines blood groups and undertakes transfusion compatibility testing. The development of the product was focussed on creating a much closer relationship between the user and the product through a more friendly and intuitive design.

[15] Again, no explanation or context of the searches conducted by Mr. Journault is provided. It is unclear what the Applicant wants to put forward with these exhibits. Furthermore, the documents printed from the above websites cannot be relied upon for the truth of their contents [see *Candrug Health Solutions Inc. v. Thorkelson* (2007), 60 C.P.R. (4th) 35 (F.C.T.D.), reversed (2008), 64 C.P.R. (4th) 431 (F.C.A.)].

[16] Now, reverting to Mr. Bernard's affidavit, I agree with the Opponent that Mr. Bernard replies directly to some of the exhibits attached to Mr. Journault's affidavit. More particularly, Mr. Bernard states the following in paragraphs 3 to 6 of his affidavit:

3. I confirm that Biotest's slides and strips for manual and automated sample processing, sold under the trademark Erytype/Erytype S are sold and advertized in Europe, the United States and Canada using the flyers as attached to this affidavit and marked as Exhibit A [...].

4. I confirm that Biotest's strips bearing the "Erytype" S trademark are used in fully automated sample processing with Biotest's automated blood group analyzer "TANGO optimo". For instance, Erytype S strips are used for fully automated high throughput routine blood grouping before transfusions using the "TANGO optimo" analyzer.

5. I confirm that Grifols' blood group analyzer "Erytra" serves the same purpose as Biotest's "TANGO optimo" analyzer, both are manufactured for testing blood groups: Biotest's analyzer uses Erytype S strips and Grifols' analyzer "Erytra" uses cards. The major difference between both systems appears to be that the Erytype S strips are inserted horizontally into a plate holder, and Grifols' cards are inserted in a vertical orientation, into a card holder of the analyzer.

6. I confirm that it is common in our business that the manufacturer of a blood group analyzer is also the manufacturer of the fitting reagents for testing blood groups.

[17] While the Opponent elected not to file evidence in chief pursuant to r. 41 of the Regulations showing use of the ERYTYPE trade-mark in Canada, I am of the view that the above statements of Mr. Bernard are confined to matters in reply. The confirmations given by Mr. Bernard provide pertinent clarifications considering the specialized and technical nature of the parties' wares and the absence of any explanation or context provided by the Applicant with respect to the various exhibits attached to Mr. Journault's affidavit.

[18] That said, the fact remains that the Opponent has not established use of the ERYTYPE trade-mark in Canada pursuant to s. 4 of the Act. The extent of use of the ERYTYPE trade-mark in Canada is far from having been established by the Opponent. Mr. Bernard's statements provide only general information as to the nature of the parties' wares.

Analysis of the grounds of opposition

[19] The s. 30(d) and (i) grounds of opposition can be summarily dismissed as follows:

- The s. 30(d) ground, as pleaded, does not raise a proper ground of opposition. The Opponent has pleaded that "the application does not comply with the requirements of s. 30(d) [of the Act] in that the Applicant had no intention to use the [Mark] in Canada in association with the wares recited in the application". Assuming that the Opponent meant to refer to s. 30(e) of the Act rather than s. 30(d), such ground of opposition still ought to be dismissed on the basis that the Opponent has failed to meet its initial evidentiary burden in respect thereof. There is no evidence whatsoever that puts into issue the correctness of the proposed use basis claimed in the Applicant's application; and
- The s. 30(i) ground of opposition, as pleaded, does not raise a proper ground of opposition. The Opponent has pleaded that "the application does not comply with the requirements of s. 30(i) [of the Act] in that the Applicant could not have been satisfied that it was entitled to use the [Mark] in Canada in association with the wares named therein in view of the Opponent's prior use of the confusing trade-mark

ERYTYPE for the same and/or allied wares, which had been previously used, applied-for and registered in Canada”. However, the mere fact that the Applicant may have been aware of the existence of the Opponent’s ERYTYPE trade-mark does not preclude it from making the statement in its application required by s. 30(i) of the Act.

Even if the ground had been properly pleaded, where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional circumstances such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.)]. There is no such evidence in the present case.

[20] The remaining grounds of opposition, namely the s. 12(1)(d) (non-registrability), s. 16(3)(a) (non-entitlement) and s. 2 (non-distinctiveness) grounds of opposition all revolve around the issue of the likelihood of confusion between the Mark and the Opponent’s trade-mark ERYTYPE. I will assess the s. 12(1)(d) ground of opposition first.

Section 12(1)(d) ground of opposition

[21] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of s. 12(1)(d) of the Act in that it is confusing with the Opponent’s afore-described trade-mark ERYTYPE registered under No. TMA689,143.

[22] The material date to assess a ground of opposition based on s. 12(1)(d) is the date of my decision [see *Park Avenue Furniture Corp. v. Wickers/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

[23] The Opponent has provided a certified copy of its registration. I have exercised the Registrar’s discretion to confirm that it is in good standing as of today’s date.

[24] As the Opponent’s evidentiary burden has been satisfied, the Applicant must therefore

establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's ERYTYPE trade-mark.

[25] 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.

[26] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at s. 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time the trade-marks have been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered, and are not necessarily attributed equal weight [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401 (S.C.C.) for a thorough discussion of the general principles that govern the test for confusion].

[27] Both of the parties' marks are coined words. As such, they are inherently distinctive. However, in the context of the parties' wares, the prefix ERY suggests that the associated wares relate to erythrocytes. The suffix TYPE in the Opponent's mark further suggests, when combined with ERY, that the Opponent's reagents are used to identify blood groups. As such, I consider the parties' marks to be relatively weak marks, especially the Opponent's.

[28] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. However, there is no evidence that the Applicant has commenced use of its proposed use Mark in Canada or that the Mark has become known to any extent whatsoever in Canada. The mere fact that the Applicant may have presented its ERYTRA analyzer at the ISBT conference in Macao [re Exhibit JF-9] cannot lead to an inference that the applied-for wares have

been sold by the Applicant in association with the Mark and become known in Canada, not to mention that I find the Applicant's evidence on this point weak to say the least [see *Candrug Health Solutions, supra*].

[29] Turning to the Opponent's trade-mark, the Opponent's registration No. TMA689,143 issued on June 5, 2007, following the filing on April 24, 2007, of a declaration of use of the mark. Such registration in itself can establish no more than *de minimis* use and cannot give rise to an inference of significant or continuing use of the mark in Canada [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1992), 40 C.P.R. (3d) 427 (T.M.O.B.)]. Furthermore, as per my review above of Mr. Bernard's affidavit, I cannot ascribe any reputation of note to the Opponent's trade-mark in Canada.

[30] In view of the foregoing, the overall consideration of the inherent distinctiveness of the parties' marks and the extent to which they have become known does not significantly favour one party over the other.

[31] As for the nature of the wares and the nature of the trade, I agree with the Opponent that they clearly overlap. In the absence of evidence to the contrary, there is no reason to conclude that the parties' wares would not travel through the same channels of trade and be directed to the same types of health professionals and care facilities requiring blood group testing.

[32] Turning to the degree of resemblance between the marks, the marks have to be looked at in their entireties. Further, although the first component of a mark is often considered the most important for the purposes of distinction, when that component is common, descriptive or suggestive, the significance of the first component decreases [see *Conde Nast Publications Inc. v. Union Des Éditions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.); *Phantom Industries Inc. v. Sara Lee Corp.* (2000), 8 C.P.R. (4th) 109 (T.M.O.B.)].

[33] Considering the suggestive connotation of the prefix ERY in the context of the parties' wares, the significance of this shared component is diminished. As indicated above, the idea

suggested by the Opponent's mark is that the Opponent's reagents are used to identify blood groups. By comparison, while the Applicant's Mark also calls to mind the word "erythrocyte" in the context of the applied-for wares, the Mark as a whole has no particular meaning.

[34] This brings me to consider as a surrounding circumstance, the state of the register evidence submitted by way of Mr. Journault's affidavit. State of the register evidence is introduced to show the commonality or distinctiveness of a mark or portion of a mark in relation to the register as a whole. Evidence of the state of the register is only relevant insofar as inferences may be made on it concerning the state of the marketplace, and inferences about the state of the marketplace can only be drawn when a significant number of pertinent registrations are located [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Welch Foods Inc. v. Del Monte Corp.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); and *Maximum Nutrition Ltd. v. Kellogg Salada Canada Inc.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

[35] As indicated above, Mr. Journault has attached as Exhibit JF-1 to his affidavit the particulars obtained for the trade-marks ERYtechPHARMA and ERYPUR, without any explanation of the search terms employed or the methodology that was used. In any event, while the existence of this trade-mark application and this registration tends to support the finding made above as to the suggestive connotation of the prefix ERY in the context of wares related to blood analysis or treatment, their number is not significant enough for inferences about the state of the marketplace to be drawn.

Conclusion regarding the likelihood of confusion

[36] Considering my analysis above, and particularly in view of the relatively low inherent distinctiveness of the parties' marks in the context of their associated wares and specialized clientele, the Opponent's default in establishing a significant reputation for its mark in Canada, and the differences existing between the parties' marks, I find that the Applicant has satisfied its burden to show that there is not a reasonable likelihood of confusion between the marks in issue.

[37] Accordingly, the s. 12(1)(d) ground of opposition is dismissed.

Section 16(3)(a) ground of opposition

[38] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark having regard to the provisions of s. 16(3)(a) of the Act in that at the date of filing of the Applicant's application, the Mark was confusing with the ERYTYPE trade-mark of the Opponent, which trade-mark has been previously used or made known in Canada by the Opponent since at least as early April 16, 2007.

[39] An opponent meets its evidentiary burden under such a ground if it shows that as of the date of filing of the applicant's application, its trade-mark had been previously used in Canada and had not been abandoned as of the date of advertisement of the applicant's application [s. 16(5) of the Act]. As per my review above of the Opponent's evidence, the Opponent has failed to meet its burden. As indicated above, the mere filing of a certified copy of registration No. TMA689,143 can establish no more than *de minimis* use of the ERYTYPE trade-mark. Such use does not meet the requirements of s. 16(3)(a) of the Act.

[40] Accordingly, the s. 16(3)(a) ground of opposition is dismissed.

Non-distinctiveness ground of opposition

[41] The Opponent has pleaded that the Mark is not distinctive of the Applicant nor does it actually distinguish the applied-for wares of the Applicant from the wares of the Opponent, nor is it adapted to distinguish them.

[42] An opponent meets its initial onus with respect to a non-distinctiveness ground if it shows that as of the filing date of the statement of opposition its trade-mark had a substantial, significant or sufficient reputation in Canada so as to negate the distinctiveness of the applied-for mark [see *Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)]. As per my review above of the Opponent's evidence, the Opponent has failed to meet its burden.

[43] Accordingly, the non-distinctiveness ground of opposition is dismissed.

Disposition

[44] In view of the foregoing and pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

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