

IN THE MATTER OF AN OPPOSITION by Chesebrough-Pond's  
(Canada) Inc. to application No. 628,674 for the trade-mark CHECK  
UP Design filed by Rydelle-Lion Inc.

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On April 6, 1989, Rydelle-Lion Inc. filed an application to register the trade-mark CHECK UP Design, a representation of which appears below, based upon proposed use of the trade-mark in Canada in association with "toothpaste". The application was accompanied by an application for the registration of a person as a registered user of the trade-mark.

The opponent, Chesebrough-Pond's (Canada) Inc., filed a statement of opposition on March 8, 1990. In its statement of opposition, the opponent alleged the following grounds:

- (i) That the present application does not comply with Section 30(i) of the Trade-marks Act in that the statement that the applicant was satisfied that it was entitled to use the trade-mark in Canada was false in that the applicant's mark was confusing with a mark previously filed and pending, namely, application No. 569,752 for the trade-mark CHECK-UP filed by Minnetonka, Inc. on September 23, 1986 and covering a plaque-reducing chewing gum;
- (ii) That the applicant's trade-mark is not registrable in view of Section 12(1)(d) of the Trade-marks Act in that it is confusing with the following registered trade-marks: CLOSE-UP, registration No. 138,486 for oral antiseptic; CLOSE-UP, registration No. 150,357 for dental cream; CLOSE-UP IS FOR CLOSE-UPS, registration No. 167,654 for dentifrice; and CLOSE-UP TOOTHPASTE FOR THE CLOSE-UP SMILE, registration No. 179,163 for toothpaste;
- (iii) That the applicant is not the person entitled to registration of the trade-mark CHECK UP Design in that, as of the filing date of the present application, the applicant's trade-mark was confusing with the trade-mark CLOSE-UP which had been previously used by the opponent and its predecessors-in-title in Canada in association with toothpaste since 1963;
- (iv) That the applicant's trade-mark is not distinctive in that, as of the date of filing the opposition, the trade-mark CHECK UP Design could not actually distinguish the applicant's wares from the wares of others because it had not yet been used in Canada, nor was it adapted to distinguish the applicant's wares from the wares of others, and namely the opponent.

The applicant filed a counter statement in which it asserted that the applicant is an assignee of application No. 569,752. Further, the applicant denied the allegations of confusion set forth in the statement of opposition.

The opponent filed as its evidence the affidavits of Kevan Wilson, Robert W. Glen and Barbara Anne Gallagher. The applicant elected not to file any evidence.

Both parties filed written arguments and both were represented at an oral hearing.

The first ground of opposition is based on Section 30(i) of the Trade-marks Act, the opponent asserting that the statement that the applicant was satisfied that it was entitled to use the trade-mark CHECK UP Design in Canada was false in that the applicant's mark was confusing with a mark previously filed and pending, namely, application No. 569,752 for the trade-mark CHECK-UP filed by Minnetonka, Inc. on September 23, 1986 and covering a plaque-reducing chewing gum.

While the legal burden is upon the applicant to show that its application complies with Section 30 of the Trade-marks Act, there is an initial evidential burden on the opponent in respect of its Section 30 grounds of opposition (see Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd., 3 C.P.R. (3d) 325, at pages 329-330). To meet the evidential burden upon it in relation of a particular issue, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. In the present case, no evidence has been submitted by the opponent in respect of its Section 30(i) ground of opposition. As a result, the opponent has failed to meet the evidential burden upon it in respect of this ground. Further, in its counter statement, the applicant submitted that it is the assignee of application No. 569,752 and the opponent has not sought to contradict this allegation. I have therefore dismissed the first ground of opposition.

At the oral hearing, the agents for both the applicant and the opponent agreed that the main issue in this opposition is whether there would be a reasonable likelihood of confusion between the applicant's trade-mark CHECK UP Design as applied to toothpaste and the opponent's registered trade-mark CLOSE-UP, registration No. 150,357, covering dental cream. With respect to a ground of opposition based on Section 12(1)(d) of the Trade-marks Act, the material date would appear to be the date of my decision (see Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. et al, 37 C.P.R. (3d) 413 (F.C.A.) and Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, 37 C.P.R. (3d) 538 (TMOB)). Further, the material dates with respect to the non-entitlement and non-distinctiveness grounds are respectively the applicant's filing date (April 6, 1989) and the date of opposition (March 8, 1990).

In determining whether there would be a reasonable likelihood of confusion between the applicant's trade-mark CHECK UP Design and the registered trade-mark CLOSE-UP, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue.

In his affidavit dated June 19, 1991, Kevan Wilson, Senior Brand Manager of the opponent since May, 1990, states that he is responsible for dental care products and that, as a consequence of his employment and duties, he is familiar with the business activities and records of the opponent. In its written argument, the applicant raised a number of objections concerning the Wilson affidavit. In particular, the applicant noted that Mr. Wilson is a manager, and not an officer, of the opponent who has only been employed by the opponent for a relatively short period of time. As a result, the applicant submitted that matters predating May of 1990 are not within the affiant's personal knowledge. Additionally, the applicant argued that Kevan Wilson has not established that the corporate records which are the bases for a number of the statements made in his affidavit are within his care. However, as Senior Brand Manager responsible for dental care products even for a relatively short period of time, I would certainly assume that Kevan Wilson would be knowledgeable with respect to the matters attested to in his affidavit and that he would have access to the business records of the opponent which would be of relevance to the opponent's marketing and sales of CLOSE-UP toothpaste. Further, while I doubt that Mr. Wilson was responsible for the preparation of the business records of the opponent, I would nevertheless expect that Mr. Wilson would have personal knowledge of those records insofar as they relate to dental care products. In any event, if the applicant had any doubts as to any of these matters, it could have cross-examined Mr. Wilson on his affidavit.

At the oral hearing, the agent for the applicant submitted that, based on the certified copy of the opponent's registration adduced as evidence by way of the Gallagher affidavit, it is apparent that the opponent only acquired its rights in the trade-mark CLOSE-UP from Lever Brothers Limited in January 1989 and that there is no evidence that the opponent and Lever Brothers Limited were related companies. As a result, the applicant argued that Mr. Wilson could not have had access to the business records of the opponent's predecessor. However, in paragraph 4 of his affidavit, Mr. Wilson states the following:

"4. CPCI's records show that for more than nineteen (19) years, the opponent, CPCI, or its predecessor-in-title, Lever Brothers Limited, manufactured, sold, distributed and advertised continuously throughout Canada, a brand of dental cream, or toothpaste, as it is more commonly known, in association with the trade-mark CLOSE-UP."

While paragraph 4 of the Wilson affidavit is not specific in stating that the opponent acquired the business records of its predecessor-in-title at the time of the assignment of the rights in the trade-mark CLOSE-UP, I am prepared to infer that such was the case in view of the wording of paragraph 4. In this regard, I am mindful of the fact that the applicant did not seek to cross-examine Mr. Wilson on his affidavit and that the applicant only raised this issue for the first time at the oral hearing.

With respect to the inherent distinctiveness of the trade-marks CHECK UP Design and CLOSE-UP, both marks comprise words which appear in Webster's Third New International Dictionary. Thus, "close-up" as a noun includes as one of its definitions: "**2a**: a close or intimate view or examination of anything" while "checkup [check up]" as a noun is defined as: "act of checking up: EXAMINATION, INSPECTION, VERIFICATION, < a is made of the physical condition of every child >". While the applicant's trade-mark CHECK UP Design as applied to toothpaste suggests a dental checkup, I consider that the applicant's mark as applied to such wares does possess some measure of inherent distinctiveness. Likewise, the opponent's trade-mark CLOSE-UP possesses some measure of inherent distinctiveness in relation to dental cream even though it conveys some suggestion of intimacy or closeness which one might associate with the use of the opponent's toothpaste.

As no evidence has been furnished by the applicant, its trade-mark CHECK UP Design must be considered as not having become known to any extent in Canada. On the other hand, the Wilson affidavit establishes that the opponent's registered trade-mark CLOSE-UP has become well known in Canada in association with toothpaste with annual sales throughout Canada exceeding 5,000,000 units for a net sales value exceeding \$63,000,000. over the six year period prior to the date of the Wilson affidavit. Accordingly, the extent to which the trade-marks at issue have become known clearly favours the opponent in this opposition, as does the length of time that the trade-marks at issue have been in use.

The wares of the parties are identical, as would be the channels of trade associated with these wares.

The trade-marks CHECK UP Design and CLOSE-UP bear little similarity in sounding and no similarity in the ideas suggested by them. I also find there to be little similarity in appearance between the trade-marks at issue. While the opponent has argued that the applicant has adopted as a second syllable of its trade-mark the word UP which is also a dominant element of its trade-mark CLOSE-UP, I do not believe that the average consumer of toothpaste would dissect the trade-marks at issue and notice the element UP as being common to the two marks, bearing in mind that both marks are known words in the English language having distinctly different meanings.

In view of the above, I have concluded that there would be no reasonable likelihood of confusion between the applicant's trade-mark CHECK UP Design as applied to toothpaste and the opponent's trade-mark CLOSE-UP as applied to toothpaste. As a result, I have rejected the

remaining grounds of opposition.

I reject the opponent's opposition pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 29th DAY OF April, 1994.

G.W.Partington,  
Chairman,  
Trade Marks Opposition Board.