

TRADUCTION/TRANSLATION

**IN THE MATTER OF THE OPPOSITION
by Allergan Inc. against application for
registration no. 1,146,492 regarding the
trade-mark DERMOTOX filed by
Lancôme Parfums and Beauté & Cie,
general partnership**

On July 9, 2002, Lancôme Parfums and Beauté & Cie, general partnership (the Applicant) filed a application for the registration of the trade-mark DERMOTOX (the Mark) in association with the following wares:

“Cosmetics, namely milks, creams, gels, oils and powders for the face, body and hands.”
(the Wares)

This application claims the priority filing date of February 11, 2002, resulting from application no. 02 3146952 filed by the Applicant in France and is based on the registration of the Mark in France in association with the following wares: “Cosmetic and make-up products” and the use of the Mark in this same country in association with the wares.

The application was published on November 26, 2003, in the *Trade-marks Journal*.

Allergan Inc. (the Opponent) filed a statement of opposition against this application dated January 26, 2004. In paragraph 4 of the introduction to this statement of opposition, the Opponent alleges that it has several trade-marks registered in Canada, among them the following registered trade-marks with continuous use from as early as the dates stated in these registrations, namely:

1. BOTOX registered under TMA576,141 obtained on February 23, 2003, in association with the following wares: (1) *Pharmaceutical preparations for the treatment of smooth*

muscle disorders, headaches, wrinkles; hyperhydrosis, sports injuries, namely, injured or torn skin, muscle, ligaments or bone; tremors, namely, spasmodic smooth, striated or cardiac muscles; and pain, namely, smooth muscle pain, striated muscle pain, cardiac muscle pain, neuropathic pain, inflammatory pain, visceral pain, chronic pain, acute pain, traumatic injury pain, referred pain, growing pain, hunger pain, intractable pain, labour pain, organic pain, phantom limb pain, postprandial pain, psychogenic pain, back pain, post-stroke pain, cancer pain, nociceptive pain, headache pain, prostatic pain, and bladder pain (2) *Pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, nerve disorders, spasmodic striated, smooth or cardiac muscles* (3) *Pharmaceutical preparations for the treatment of cerebral palsy*. This registration alleges that the mark has been used in Canada since at least as early as May 5, 1992, in association with wares (2) and July 5, 1999, in association with wares (3). A declaration of use of the mark in Canada in association with wares (1) was filed on February 13, 2003;

2. BOTOX registered under TMA415,382 obtained on August 13, 1993, in association with the following wares: *Pharmaceuticals for the therapeutic treatment of neurologic disorders and muscle dystonias*. A declaration of use of the mark in Canada in association with the wares was filed on February 24, 1993;
3. ALLERGAN BOTOX registered under TMA427,565 obtained on May 20, 1994, in association with the following wares: *Pharmaceuticals for the therapeutic treatment of neurological disorders and muscle dystonias; transportable battery operated electromyogram machine and amplifiers for same; fluid injection needles for medical use; medical kits containing fluid injection needles*. A declaration of use of the mark in Canada in association with the wares was filed on February 28, 1994;
4. BOTOX COSMETIC registered under TMA572,207 obtained on December 12, 2002, in association with the following wares: *Pharmaceutical preparations for alleviating wrinkles and sweating*. A declaration of use of the mark in Canada in association with the

wares was filed on December 4, 2002. This registration includes a disclaimer of the right to the exclusive use of the word “COSMETIC” apart from the trade-mark;

5. BOTOX COSMETIC registered under TMA576,177 obtained on February 23, 2003, in association with the following wares: *Pharmaceutical preparations for alleviating wrinkles and sweating*. A declaration of use of the mark in Canada in association with the wares was filed on February 13, 2003. This registration includes a disclaimer of the right to the exclusive use of the word “COSMETIC” apart from the trade-mark;
6. BOTOX COSMETIC & Design (appearing below) registered under TMA572,616 obtained on December 18, 2002, in association with the following wares: *Pharmaceutical preparations for alleviating wrinkles and sweating*. A declaration of use of the mark in Canada in association with the wares was filed on December 12, 2002. This registration includes a disclaimer of the right to the exclusive use of the word “COSMETIC” apart from the trade-mark;



7. BOTOX COSMETIC & Design (appearing below) registered under TMA576,267 obtained on February 24, 2003, in association with the following wares: *Pharmaceutical preparations for alleviating wrinkles and sweating*. A declaration of use of the mark in Canada in association with the wares was filed on February 13, 2003. This registration includes a disclaimer of the right to the exclusive use of the word “COSMETIC” apart from the trade-mark;



8. IT'S NOT MAGIC, IT'S BOTOX & Design (appearing below) registered under TMA579,977 obtained on April 28, 2003, in association with the following wares: *Pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles; hyperhydrosis; cerebral palsy, sports injuries, namely, injured or torn skin, muscle, ligaments or bone; tremors namely, spasmodic striated, smooth or cardiac muscles; and pain, namely, smooth muscle pain, striated muscle pain, cardiac muscle pain, neuropathic pain, inflammatory pain, visceral pain, chronic pain, acute pain, traumatic injury pain, referred pain, growing pain, hunger pain, intractable pain, labour pain, organic pain, phantom limb pain, postprandial pain, psychogenic pain, back pain, post-stroke pain, cancer pain, nociceptive pain, headache pain, prostatic pain, and bladder pain.* A declaration of use of the mark in Canada in association with the wares was filed on April 8, 2003;



9. BOTOX BOTULINUM TOXIN TYPE A PURIFIED NEUROTOXIN COMPLEX & Design (appearing below) registered under TMA576,151 obtained on February 23, 2003, in association with the following wares: (1) *Printed educational materials, namely books, brochures, pamphlets, guides, outlines, charts and manuals* (2) *Pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles; hyperhydrosis; cerebral palsy, tremors, namely spasmodic striated, smooth or cardiac muscles; and*

pain, namely, smooth muscle pain, striated muscle pain, cardiac muscle pain, neuropathic pain, inflammatory pain, visceral pain, chronic pain, acute pain, traumatic injury pain, referred pain, growing pain, hunger pain, intractable pain, labour pain, organic pain, phantom limb pain, postprandial pain, psychogenic pain, back pain, post-stroke pain, cancer pain, nociceptive pain, headache pain, prostatic pain, and bladder pain. This registration alleges that the mark has been used in Canada since at least as early as June 29, 2000, in association with wares (1). A declaration of use of the mark in Canada in association with wares (2) was filed on February 13, 2003. This registration includes a disclaimer of the right to the exclusive use of the words “BOTULINUM TOXIN TYPE A “ and “PURIFIED NEUROTOXIN COMPLEX” apart from the trademark; and



10. BOTOX & Design (appearing below) the subject of the application for registration number 1,094,258 filed on February 27, 2001, in association with the following wares: *Pharmaceutical preparations for alleviating wrinkles and sweating.* It should be noted that this application, based on a proposed use, was included in the registrations listed in paragraph 4 of the statement of opposition when the registration was in fact obtained on March 18, 2004, after a declaration of use was filed on February 27, 2004.



The grounds for opposition can be summarized as follows:

1. The application does not fulfill the requirements of paragraph 30(d) of the *Trade-marks Act* (R.S.C. 1985, c. T-13, as amended) (the Act) in that the Mark was not used in France by the Applicant and/or its licensee in association with each and every one of the wares

described in the application. In the alternative, if the Mark was used, such use was discontinued and the Mark was abandoned;

2. The application does not fulfill the requirements of paragraph 30(i) of the Act in that the Applicant could not be satisfied in all good faith that it was entitled to use the Mark in Canada in association with the wares based on its knowledge of the Opponent's marks listed at paragraph 4 of the statement of opposition which were used earlier in Canada in association with the wares listed in this same paragraph 4;
3. The application does not fulfill the requirements of paragraph 12(1)(d) of the Act in that the Mark causes confusion with the Opponent's registered marks as described at paragraph 4 of the statement of opposition;
4. The Applicant is not the person entitled to register the Mark given the provisions of paragraph 16(2)(a) of the Act in that the Mark causes confusion with the Opponent's registered marks described at paragraph 4 of the statement of opposition, as they were used prior to the filing date of the application;
5. The Applicant is not the person entitled to register the Mark given the provisions of paragraph 16(2)(b) of the Act in that the Mark causes confusion with the Opponent's mark described at paragraph 4 of the statement of opposition for which an application for the registration was filed prior to the filing date of the application;
6. The Mark cannot be distinguished from the Applicant's Wares within the meaning of section 2 of the Act in that the Mark is not adapted to distinguish and does not actually distinguish the Applicant's Wares from the Opponent's wares in association with which the Opponent's marks described at paragraph 4 of the statement of opposition are used.

On March 16, 2004, the Applicant filed a counter-statement to opposition denying all of the grounds of opposition. It should be noted that at paragraph 4.4 of this counter-statement, the Applicant alleges that the Mark [TRANSLATION] "is distinctive of the Applicant's services as well as adapted so to distinguish them". There is every reason to believe that the use of the word

“services” rather than “wares” resulted from a clerical error, particularly as it was not raised by the Opponent.

The Opponent’s evidence is as follows:

Evidence in chief filed on November 15, 2004:

- Affidavit of Dr Kevin Smith (dermatologist practising in the city of Niagara Falls, in Canada), sworn on November 2, 2004, and its attached exhibits A and B;
- Affidavit of Alan Chan (Marketing Director of the Opponent’s Skin Care division in Canada – which includes the BOTOX COSMETIC products – and in charge of BOTOX products for the treatment of axillary hyperhidrosis), sworn on November 12, 2004, and its attached exhibits A to H;
- Affidavit of Jason Herod (Product Manager in Canada for “BOTOX” botulinum toxin type A for the Opponent), sworn on November 5, 2004, and its attached exhibits A and B;
- Affidavit of Tonia Morgan (Law Clerk with the firm representing the Opponent for the purposes of this opposition), sworn on November 12, 2004, and its attached exhibits A to E (hereinafter the “first affidavit of Tonia Morgan”);
- Affidavit of Lisa Léger (Trade-mark Searcher with the firm representing the Opponent for the purposes of this opposition), sworn on November 9, 2004, and its attached exhibits A and B.

Reply evidence filed on January 17, 2006:

- Affidavit of Tonia Morgan, sworn on January 16, 2006, and its attached exhibits A to G (hereinafter the “second affidavit of Tonia Morgan”).

The Applicant’s evidence filed on May 30, 2005, consists of the affidavit of Fabienne Le Charlès (paralegal with the firm representing the Applicant for the purposes of this opposition), sworn on May 20, 2005, and its attached exhibits 1 to 8.

None of the witnesses were cross-examined despite the fact that both parties requested and obtained orders for cross-examination.

Only the Opponent filed written arguments. No hearing was held.

Analysis

General principles and relevant dates:

It is the Applicant's responsibility to establish that the application complies with the requirements of the Act. The Opponent must nonetheless ensure that each of its grounds for opposition are duly argued and satisfy the initial burden of proof by establishing the facts on which the grounds for opposition are based, failing which it is possible that an opposition ground will not be taken into consideration. Once this initial burden of proof has been met, it falls on the Applicant to establish, on a balance of probabilities, that none of these grounds for opposition is an obstacle to the registration of the Mark [see on this point: *Massimo De Berardinis v. Decaria Hair Studio* (1984), 2 C.P.R. (3d) 319 (T.M.O.B.); *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.); *Joseph E. Seagram & Sons Ltd. and al v. Seagram Real Estate Ltd.*, (1984) 3 C.P.R. (3d) 325; *Dion Neckwear Ltd. v. Christian Dior, S.A. and al*, (2002), 20 C.P.R. (4th) 155 (F.C.A.); and *Wrangler Apparel Corp. v. The Timberland Company*, [2005] F.C. 722].

The relevant date for appreciating the circumstances in regard to each of the grounds for opposition in this case are the following:

- Grounds based on section 30 of the Act: the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)]; in this case, this date is February 11, 2002, considering the priority date claimed;
- Ground based on paragraph 12(1)(d) of the Act: the date of my decision [see on this point *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- Grounds based on paragraphs (a) and (b) of subsection 16(2) of the Act: the filing date of the application;

- Ground based on the Mark's absence of distinctiveness: generally accepted as being the filing date of the statement of opposition [see on this point *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)]; in this case this date is January 26, 2004.

I will now analyze the grounds for opposition in regard to the evidence filed in the record without necessarily respecting the order in which they were raised in the statement of opposition.

(i) Ground based on paragraph 12(1)(d) of the Act:

The Opponent satisfied its initial burden of proof by filing certificates of authenticity in regard to each of the alleged registrations; these certificates had been filed in support of the first affidavit of Tonia Morgan.

I will concentrate my analysis in regard to BOTOX (nominal and figurative versions) and BOTOX COSMETIC (nominal and figurative versions in French and English) marks of the Opponent, which appear to me to be the most relevant in this matter. Also, unless otherwise stated, I will not assign any importance to the marks BOTOX BOTULINUM TOXIN TYPE A PURIFIED NEUROTOXIN COMPLEX & Design, IT'S NOT MAGIC, IT'S BOTOX & Design, and ALLERGAN BOTOX, which to me appear to be the least relevant and moreover unnecessary in assessing the risk of confusion in this matter.

Because of this evidence by the Opponent, the Applicant must establish on a balance of probabilities that there is no risk of confusion between the Mark and the Opponent's marks.

The test in matters of confusion is that of first impression and of imperfect recollection. According to subsection 6(2) of the Act, the use of a trade-mark causes confusion with another trade-mark when the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

In deciding whether the trade-marks create confusion, the Registrar must take into account all of the circumstances of the matter, including those listed at subsection 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 and different weight will be assigned to different factors according to the context [see on this point *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321; and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée and al* (2006), 49 C.P.R. (4th) 401, [2006] 1 S.C.R. 824].

(a) the inherent distinctiveness of the trade-marks and the extent to which they have become known

The Mark consists of one invented word that does not have any particular meaning although the prefix “DERM” suggests a connection with the skin. Whatever the case, in my opinion the mark DERMOTOX has a certain inherent distinctiveness.

Based on the complete absence of evidence of the Applicant’s use or marketing of the Mark in France or in any other country or territory, I cannot find that the Mark became known in any way in Canada, which does not increase the distinctiveness of the Mark.

Considering now the Opponent’s marks, they all consist in the invented word “BOTOX” used alone or in combination with other graphic elements and/or the word “COSMETIC” (or “COSMÉTIQUE”). By its very “invented” nature and the absence of a suggestive prefix or suffix, the mark or the “element” BOTOX of which the Opponent’s marks is composed has an inherent distinctiveness superior to the Mark’s, though the word “BOTOX” seems to be derived from a contraction of the words “BOTULINUM TOXIN”, i.e. the name of the toxin produced by the bacteria *Clostridium botulinum* from which the products associated with the Opponent’s marks are manufactured, as will be explained later on.

Moreover, and as explained below, the Opponent's evidence indicates that the BOTOX (nominal and figurative versions) and BOTOX COSMETIC (nominal and figurative versions in French and in English) marks have become known in Canada, which, under the circumstances, increases the distinctiveness of the Opponent's marks and favours the Opponent in the assessment of this first factor.

According to the affidavit of Alan Chan and its attached exhibits, the Opponent (and its affiliates) is a pharmaceutical company specializing in the development and marketing of pharmaceutical products in ophthalmology, movement disorders and dermatology.

Alan Chan alleges that the Opponent is the world leader in matters of botulinum toxin type A therapy and that it is in first place in terms of market share in Canada.

Botulinum toxin type A blocks the release of acetylcholine at the neuromuscular junction, thereby preventing or limiting muscle contractions, for use in different types of cosmetic or therapeutic treatments as explained below.

Specifically, Alan Chan explains in his affidavit that the Opponent markets botulinum toxin type A under two marks, namely the BOTOX and BOTOX COSMETIC marks. The BOTOX mark is used to market therapeutic products while the BOTOX COSMETIC mark is used to market cosmetic products.

Also according to the statements of Alan Chan, BOTOX products have been approved by Health Canada for different therapeutic uses including the treatment of strabismus (since 1990), blepharospasm (since 1990), cervical dystonia (since 1995), talipes equinus in children with cerebral palsy (since 1999), hyperhidrosis (excessive sweating) of the axilla (since 2001) and focal spasticity (since 2001).

BOTOX COSMETIC products on the other hand were approved by Health Canada in 2001 for the treatment of glabellar lines. According to Alan Chan's affidavit, other aesthetic applications are being studied for the treatment of facial wrinkles and crow's feet. The products for cosmetic

use are marketed primarily with dermatologists, plastic surgeons and other physicians working in aesthetic medicine.

Later on I will return to the nature of the Opponent's products and business when assessing the third and fourth factors.

Still considering Alan Chan's affidavit, the sales of BOTOX COSMETIC products in Canada exceeded 35 million Canadian dollars for the period between 2001 and September 2004, namely 4 million in 2001, 8 million in 2002, 11 million in 2003 and 10 million up to September 2004 (the amounts provided in that respect were lower than the actual amounts to maintain confidentiality). During this same period, the Opponent spent more than 7 million dollars in advertising and marketing in Canada for these same products, the amounts allocated for this advertising and this marketing were also provided for each year and were lower than the actual amounts to maintain confidentiality.

The Opponent filed in this respect varied and considerable samples of marketing material, advertising, news features, newspaper and magazine articles in French and in English which circulated in Canada during this same period; it also produced excerpts from its Internet site, "allergan.ca". This material was in large part filed in support of Alan Chan's affidavit, the rest filed in support of the first affidavit of Tonia Morgan.

On that point, it would be appropriate to note that Alan Chan alleges that the Opponent purchased advertising space in different media such as radio, television, consumer magazines, billboards and bus shelters and that it sponsored different events intended for the female public to market its BOTOX and BOTOX COSMETIC marks. To this effect, Alan Chan filed several samples of printed advertisements displaying the BOTOX COSMETIC & Design mark (or its French version) including those circulating in February 2004 in the magazines "Toronto Life" and "Canadian House & Home" (for which the circulation numbers in Canada were provided by Tonia Morgan who obtained them from the "Audit Bureau of Circulation" – I will come back to this point later), an undated sample of a bus shelter advertisement displaying the BOTOX COSMETIC & Design mark, as well as a CD-ROM containing three samples of televised

commercials featuring stars Ben Stiller, Kim Katrall and Nathalie Cole. Specifically referring to these three televised advertisements, they display and broadcast the BOTOX COSMETIC and IT'S NOT MAGIC, IT'S BOTOX COSMETIC & Design marks and are alleged to have been broadcast between the months of February and April 2002 on City TV during the program "Fashion Television" hosted by Jeanne Beker. The broadcast of these televised advertisements is not corroborated by any sworn statement. Also, I am not prepared to assign weight to this evidence filed by the Opponent. It should also be noted that no sample of billboard advertising, radio advertising or advertising at events intended for the female public was filed into evidence and that some of the samples of marketing material and advertisements filed by the Opponent are undated.

Alan Chan also filed a copy of a report prepared by the firm "National Public Relations" dated May 31, 2002, and entitled "BOTOX Cosmetic TM 2002 Second Interim Media Coverage Report". This report provides, among other data, the names of the media (print, radio, television and online) in which the Opponent's BOTOX COSMETIC mark was mentioned in the course of March through May 2002. I have some difficulty admitting this report into evidence given that it should have been filed by its author rather than by the witness. This report also contains some inaccuracies regarding the manner in which the BOTOX COSMETIC mark had allegedly been mentioned. I will therefore not assign any weight to this evidence by the Opponent.

It would be appropriate to point out the significant number of magazines and newspapers published during 2001 and 2002 dealing with the Opponent's BOTOX products, primarily those for cosmetic purposes and incidentally those for therapeutic purposes and filed into evidence by the Opponent including articles in "Newsweek", "The Globe and Mail", "The Toronto Star", "The Toronto Sun", "Ottawa Citizen", "The Windsor Star", "The Gazette", "Le Journal de Montréal", "Le Journal de Québec", "The Vancouver Sun", "The Calgary Sun", "The Calgary Herald", "The Edmonton Journal", "The Leader Post" (Regina, SK), "Cap Breton Post", "The Telegram" (St. John's, NF), and "Elle Canada", to name but a few. The circulation numbers for many of these newspapers and magazines were provided by Alan Chan or Tonia Morgan. As filed, these numbers must be taken as simple hearsay (the same is the case for the numbers provided above in regard to the magazines "Toronto Life" and "Canadian House & Home").

Nevertheless, I have no qualms about taking judicial notice of the fact that the majority of these newspapers and magazines have a certain circulation in Canada [see on this point *Northern Telecom Ltd. v. Nortel Communications Inc.* (1987), 15 C.P.R. (3d) 540 (T.M.O.B.)]. I would add in closing on this aspect of the evidence that most of these magazine and newspaper articles corroborate to a certain extent the allegations by Alan Chan regarding the growing popularity and the commercial success of BOTOX products in Canada since they were launched for commercial purposes in 2001.

Also according to Alan Chan's allegations, there was no other botulinum toxin based product on the market on September 1, 2004. Alan Chan estimates in that regard that approximately 120,000 Canadians have tried a treatment with BOTOX COSMETIC products.

The Opponent also filed the affidavit of Dr. Kevin Smith, who gave several conferences on the botulinum toxin type A and the Opponent's products. Dr. Smith began treating patients with BOTOX and BOTOX COSMETIC products for therapeutic and cosmetic purposes in June 2001. He also carried out more than 3,000 treatments. He generally treats between 20 and 40 patients per week with these products. He estimates that the number of vials of BOTOX and BOTOX COSMETIC products purchased from the Opponent was 2,220 vials since 2001 (in all valued at approximately 750,000 dollars).

Add to this the affidavit of Jason Herod, which also alleges that the Opponent holds first place in terms of market share in Canada in terms of botulinum toxin therapy and which provides the sales figures in Canadian dollars for BOTOX products (for therapeutic purposes) for the period between 2000 and 2004, inclusively, namely 8 million in 2000, 11 million in 2001, 15 million in 2002, 19 million in 2003 and 24 million in 2004 (this last amount is an estimate based on the projected sales and all of the amounts provided are below the actual amounts to maintain confidentiality) as well as samples of promotional brochures and pamphlets in French and English describing BOTOX products for therapeutic use.

In support of Alan Chan's affidavit, the Opponent also filed copies of excerpts of a survey carried out by the firm "IFOP Canada Market Research" in order to establish the progressive

awareness of the Canadian public in regard to the BOTOX mark from June 2000 to December 2002. I am not prepared to assign weight to this survey given that it was not filed into evidence by a competent expert and that it is impossible for me to determine whether this survey was properly developed and impartially effected [see on this point *Mattel, supra*, also discussing the admissibility of survey evidence]. For example, none of the questions asked during the telephone interviews conducted for the survey are attached to it.

In any event, even without this survey, in my opinion the Opponent established that its BOTOX and BOTOX COSMETIC marks (and to a lesser degree their figurative and/or French versions in the case of the BOTOX COSMETIC mark) are known, indeed very well known, in Canada.

(b) the length of time the trade-marks have been in use

This factor favours the Opponent given the total lack of evidence of use of the Mark in Canada.

(c) the nature of the wares, services or business; and (d) the nature of the trade

Considering the type of wares and the nature of the trade, I must compare the wording of the Wares in the application for registration with the wording of the wares in the registrations referred to by the Opponent [see on this point *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.)]. These descriptions must however be read in such a way as to determine the probable nature of the parties' business rather than all the potential businesses which could be included in these descriptions. The evidence of the parties' actual business is useful in this respect [see on this point *McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.); *Procter & Gamble Inc. v. Hunter Packaging Ltd.* (1999), 2 C.P.R. (4th) 266 (T.M.O.B.); *American Optional Corp. v. Alcon Pharmaceuticals Ltd.* (2000), 5 C.P.R. (4th) 110 (T.M.O.B.)].

The "cosmetic" branch of the Opponent's products discussed above is worded in one of the following manners: "*Pharmaceutical preparations for alleviating wrinkles and sweating*" or

“Pharmaceutical preparations for the treatment of ... wrinkles”. The “therapeutic” branch of the Opponent’s products discussed earlier is worded in different ways, such as *“Pharmaceuticals for the therapeutic treatment of neurological disorders and muscle dystonias”* and *“(1) Pharmaceutical preparations for the treatment of smooth muscle disorders, headaches, wrinkles; hyperhydrosis, sports injuries, namely, injured or torn skin, muscle, ligaments or bone; tremors, namely, spasmodic smooth, striated or cardiac muscles; and pain, namely, smooth muscle pain, striated muscle pain, cardiac muscle pain, neuropathic pain, inflammatory pain, visceral pain, chronic pain, acute pain, traumatic injury pain, referred pain, growing pain, hunger pain, intractable pain, labour pain, organic pain, phantom limb pain, postprandial pain, psychogenic pain, back pain, post-stroke pain, cancer pain, nociceptive pain, headache pain, prostatic pain, and bladder pain (2) Pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, nerve disorders, spasmodic striated, smooth or cardiac muscles (3) Pharmaceutical preparations”*. These descriptions include the treatments discussed in the affidavits of Alan Chan and Jason Herod.

As discussed above, Alan Chan’s affidavit indicates that the BOTOX COSMETIC products were approved by Health Canada in 2001 for the treatment of glabellar lines and that other aesthetic applications are being studied for treating facial wrinkles and crow’s feet. Alan Chan states that the products for cosmetic use are primarily marketed to dermatologists, plastic surgeons and other physicians working in the field of aesthetic medicine.

In their opinion, BOTOX products for therapeutic use were approved by Health Canada for different uses including the treatment of strabismus, blepharospasm, cervical dystonia, talipes equinus in children with cerebral palsy, hyperhidrosis of the axilla and focal spasticity. The affidavit of Jason Herod indicates that the marketing of products for therapeutic use is done through education using brochures and pamphlets given to the patients and physicians as well as through training programs, special events in the field of medical education, conferences, symposiums and information kiosks at conferences.

BOTOX and BOTOX COSMETIC products are sold in vials, these vials themselves are packaged in individual boxes, such as those represented in the photographs filed in support of

Alan Chan's affidavit. The vials and the boxes bear the figurative versions of the BOTOX and BOTOX COSMETIC marks. A toxin which taken in large quantities is above all known as a cause of food poisoning (botulism), botulinum toxin type A BOTOX is manufactured in a very strictly controlled laboratory and is administered in very small doses, as explained in the marketing brochures and pamphlets filed in support of the affidavits of Alan Chan or Jason Herod.

Specifically, the BOTOX (or BOTOX COSMETIC) toxin is administered to patients by a medical practitioner in the form of needle injections in the muscles. The practitioner must locate and inject the proper muscles. By blocking the release of acetylcholine, the toxin inhibits the transmission of the electrical signal emitted by the brain to the muscles. Accordingly, the muscles do not receive the message to contract (the muscular action causing the wrinkles is weakened or blocked depending on the dose administered). Temporary paralysis follows, then dissipates gradually after several months.

By comparison, the Wares associated with the DERMOTOX Mark consist of cosmetic products, namely milks, creams, gels, oils and face, body and hand powders. As pointed out earlier, no evidence was filed regarding use of the Mark in association with any of the Wares. Typically, one could expect that these types of products would be sold in cosmetic departments or at cosmetic counters in stores or pharmacies.

Although the BOTOX COSMETIC products are intended to smooth out facial wrinkles for aesthetic purposes, they are nonetheless pharmaceutical products which must be administered by medical practitioners to well-informed patients. By contrast, the Applicant's Wares consist of cosmetic products (milks, creams, gels, oils and powders) applied on the skin for the face, body and hands. These are different products involving different distribution channels (all the more so with BOTOX products for therapeutic use).

According to the Opponent's arguments, the clientele targeted by the DERMOTOX Wares would be the same as the clientele targeted by BOTOX products for cosmetic use, namely a clientele made up of men and women between 30 and 60 years of age concerned by visible signs

of aging. Moreover, according to the Opponent there is every reason to believe that the DERMOTOX Wares will be marketed as anti-wrinkle creams. It would now be appropriate to refer to paragraph 28 of Alan Chan's affidavit as well as paragraphs 9 and 10 of Kevin Smith's affidavit:

Paragraph 28 – Alan Chan

“The target market for the Applicant’s DERMOTOX creams, gels, oils and powders for the face, body and hands is identical to Allergan’s target market for the BOTOX Cosmetic Product; namely, men and women between their 30’s and 60’s who are concerned about visible signs of aging. The Applicant’s DERMOTOX products will likely be marketed as “anti-wrinkles” creams, thereby targeting the same conditions as Allergan’s BOTOX COSMETIC Product”

Paragraphs 9 and 10 – Kevin Smith

“9. Patients come to me having tried commercially available topical products in pharmacies and cosmetic counters in the hopes that the skin preparations will produce effects similar to those obtained from BOTOX Product.

10. In my experience, cosmetic products such as creams, lotions and gels, are targeted at the same types of consumers who are concerned about visible signs of aging and wrinkles and who would be interested in BOTOX cosmetic treatments. I have reviewed a copy of a printout from the CIPO Trade-marks Database of the DERMOTOX application (No. 1,146,492), which is attached as Exhibit B to this my affidavit. In my view, patients could mistakenly believe that DERMOTOX products and BOTOX products are somehow related and that the DERMOTOX products will offer effects similar to those obtained from the BOTOX products.”

Not only is it up to the Registrar to determine the probability of confusion between the marks at issue but, in addition, these arguments by the Opponent are not supported by any evidence. At most, through the first affidavit of Tonia Morgan the Opponent filed into evidence several extracts from the Applicant's Internet site "www.lancome.fr" according to which the Applicant markets various types of products listed under the classes [TRANSLATION] "skincare", "makeup", "fragrance", "body & suncare", "haircare" and "men"; the class of "skincare" is itself subdivided into the subclasses "cleansers", "moisturisers", "anti-aging", "eyes and lips", etc. As discussed later, in these excerpts there is no information about the Applicant's DERMOTOX Wares.

The fact that the BOTOX COSMETIC products and the DERMOTOX Wares could potentially both be used for cosmetic purposes on the face and be advertised in magazines such as “Canadian House & Home” and “Elle Canada” mentioned earlier, militates in favour of some potential overlapping of the parties’ products. However, given the different intrinsic nature of the parties’ products, which involves different distribution channels as explained above, in my opinion such a potential overlap does not necessarily result in, under the circumstances of this case, a likelihood of confusion regarding the source of these products in the consumer’s mind given the differences that also exist between the marks at issue, as explained below.

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

As discussed above, the confusion test is a matter of first impression. It would now be appropriate to refer to the remarks of Mr. Justice Deneault in *Pernod Ricard v. Molson Breweries* (1992), 44 C.P.R. (3d) 359 (F.C.):

The test of confusion is one of first impression. The trade marks should be examined from the point of view of the average consumer having a general and not a precise recollection of the earlier mark. Consequently, the marks should not be dissected or subjected to a microscopic analysis with a view to assessing their similarities and differences. Rather, they should be looked at in their totality and assessed for their effect on the average consumer as a whole: *Ultravite Laboratories Ltd. v. Whitehall Laboratories Ltd.* (1965), 44 C.P.R. 189 at pp. 191-2, 53 D.L.R. (2d) 1, [1965] S.C.R. 734; *Oshawa Group Ltd. v. Creative Resources Co.* (1982), 61 C.P.R. (2d) 29 at p. 35, 46 N.R. 426 sub nom. *Oshawa Group Ltd. v. Registrar of Trade Marks* (F.C.A.); *Cantine Torresella S.r.l. v. Carbo* (1987), 16 C.P.R. (3d) 137 at p. 146, 14 C.I.P.R. 234 (F.C.T.D.).

Although the marks are not to be dissected when determining matters of confusion, it has been held that the first portion of a trade mark is the most relevant for purposes of distinction: *Molson Companies Ltd. v. John Labatt Ltd.* (1990), 28 C.P.R. (3d) 457 at p. 461, 32 F.T.R. 152, 19 A.C.W.S. (3d) 1369 (F.C.T.D.); *Conde Nast Publications Inc. v. Union Des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) at p. 188. I believe the following words of President Thorson in the case of *British Drug Houses Ltd. v. Battle Pharmaceuticals* (1944), 4 C.P.R. 48 at pp. 57-8, [1944] 4 D.L.R. 577, [1944] Ex.

C.R. 239 (Ex. Ct.), to be particularly useful in explaining why attention should be drawn to the first portion of the appellant's mark in this case:

. . . the Court should rather seek to put itself in the position of a person who has only a general and not a precise recollection of the earlier mark and then sees the later mark by itself; if such a person would be likely to think that the goods on which the later mark appears are put out by the same people as the goods sold under the mark of which he has only such a recollection, the Court may properly conclude that the marks are similar.

The DERMOTOX mark and the Opponent's BOTOX (nominal and figurative versions) and BOTOX COSMETIC (nominal and figurative versions in French and in English) marks have in common the suffix "OTOX".

As stated earlier in the assessment of the inherent distinctiveness of the marks under review, the DERMOTOX and BOTOX marks consist of invented words which do not suggest any particular idea for the average consumer while the word "BOTOX" appears to be derived from a contraction of the words "BOTULINUM TOXIN" and the prefix "DERM" suggests a connection with the skin.

The first of the trade-marks at issue is very different phonetically and in terms of the ideas (or the absence of particular ideas) that they suggest. Yet, as discussed above, the first part of a trade-mark is the most relevant for the purposes of distinguishing trade-marks. I am of the opinion that the differences existing between the DERMOTOX mark and the BOTOX and BOTOX COSMETIC marks combined with the existing differences in regard to the type of wares and the nature of the parties' trade are adequate under the circumstances to avoid any likelihood of confusion regarding the source of these wares in the consumer's mind.

Additional circumstances

- State of the register

The parties both raised the state of the register of the trade-marks in regard to the suffix "TOX".

The affidavit of Fabienne Le Charlès for the Applicant sets out the computer searches on the Onscope system database, which reproduces the information contained on Canada's register of trade-marks.

Specifically, Fabienne Le Charlès introduced into evidence the result of searches that she carried out in order to identify (1) all of the active trade-marks including the suffix "TOX" in classes 3 (including cosmetics, *inter alia*) and 5 (including pharmaceutical products, *inter alia*) and (2) all of the active trade-marks including the suffix "TOX" in classes 14 (including jewellery and clocks, *inter alia*), 18 (including leather goods, bags and umbrellas, *inter alia*) and 21 (including kitchen utensils and dishes, *inter alia*) separately. That was all of the evidence filed by the Applicant in this matter.

The evidence filed by the Opponent in this respect consists in the affidavit of Lisa Léger and the second affidavit of Tonia Morgan.

Specifically, Lisa Léger introduced into evidence the result of the searches that she carried out in order to identify all of the active trade-marks with the suffix "OTOX" in the pharmaceutical or cosmetic fields registered on the register of trade-marks for Canada in the name of owners other than the Opponent.

With regard to the second affidavit of Tonia Morgan, first we must decide whether all or part of this reply evidence is admissible.

Section 43 of the *Trade-marks Regulations* (the Regulations) requires that the reply evidence be strictly confined to matters in reply. No further evidence can be adduced except with leave of the Registrar on such terms that the Registrar deems to be appropriate, as required by section 44.

As stated earlier, all of the evidence filed by the Applicant for the purposes of this opposition consists of the affidavit of Fabienne Le Charlès and bears only on the state of the register of trade-marks. The Opponent's reply evidence bears in part on the state of the Canadian register of trade-marks and in part on the additional verifications carried out by the witness in regard to the

Applicant's different Internet sites, while also attempting to file into evidence a copy of a notice of abandonment issued on February 9, 2004 by the United States Patent & Trademark Office ("USPTO") with respect to an application for registration filed by the Applicant for the same DERMOTOX mark, as well as a copy of an *inter partes* decision dated February 6, 2004, by the USPTO regarding an opposition involving the same parties; that application for the registration of the DERMOTOX mark in the United States was voluntarily abandoned with the consent of the Opponent.

Although the Applicant did not object to the filing of all or part of this second affidavit, the reply evidence must nevertheless satisfy the rules set out in the Regulations. In my opinion, with the exception of the part bearing on the State of the register of trade-marks of Canada, the other parts of the second affidavit of Tonia Morgan must not be taken into consideration in assessing the evidence filed by the Opponent in this matter. The Opponent should have proceeded to request and obtain leave to adduce this additional evidence based on section 44 of the Regulations, which it failed to do [see on this point *Prouvost S.A. v. Haberdashers Ltd.* (1987), 18 C.I.P.R. (3d) 232 (T.M.O.B.)].

Returning to the evidence of the State of the register of the trade-marks contained in the affidavits of Fabienne Le Charlès, Lisa Léger and Tonia Morgan, after analyzing the different statements and/or arguments filed by the parties, I understand that the register of trade-marks includes about 10 marks with the suffix "TOX" registered in association with "cosmetic" products in class 3 or "pharmaceutical" products in class 5 (including for the purposes of this analysis vitamins and dietary food supplements and excluding products strictly for veterinary use); this number excludes the registration applications in this case which include the same suffix as well as the registrations or registration applications of the parties to this opposition. No evidence of use was adduced about the use of any of the 10 or so trade-marks.

Based on the relatively low number of relevant registrations combined with the absence of evidence of use of the marks contemplated in the registrations, I cannot find in the circumstances that the suffix "TOX" (and even less so the suffix "OTOX") is used extensively in the cosmetic or pharmaceutical fields [see on this point *Ports International Ltd. v. Dunlop Ltd.* (1992), 41

C.P.R. (3d) 432; *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.); *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.)). Whatever the case, for the reasons explained above, I do not consider the common suffix “OTOX” sufficient in the circumstances to find that the marks at issue are so similar that there is a resulting likelihood of confusion between them.

- *Notoriety and “family” of trade-marks*

The Opponent raises the notoriety of its BOTOX trade-marks and the fact that they are a “family” of trade-marks which, as in other circumstances, should result in a finding of confusion between the trade-marks at issue.

As discussed above, the Opponent’s trade-marks which to me appear to be the most relevant in assessing the risk of confusion in this matter are the BOTOX (nominal and figurative versions) and the BOTOX COSMETIC (nominal and figurative versions in French and in English) marks for which relatively ample evidence of use was adduced by the Opponent.

While the Opponent produced certificates of authenticity for the marks “ALLERGAN BOTOX”, “IT’S NOT MAGIC, IT’S BOTOX & Design” and “BOTOX BOTULINUM TOXIN TYPE A PURIFIED NEUROTOXIN COMPLEX & Design”, it did not file any detailed evidence of their use when it had the burden of doing so in order to argue the existence of a “family” of trade-marks [see on this point *Techniquip Ltd. v. C.O.A.* (1998), 3 C.P.R. (4th) 298 (F.C.A.)]. In fact, none of the Opponent’s witnesses provided specific data regarding these three trade-marks. At most, we find among the excerpts that the Opponent filed from its Internet site, an isolated reference to the BOTOX mark BOTULINUM TOXIN TYPE A PURIFIED NEUROTOXIN COMPLEX & Design as registered. The only other references to any of these three trade-marks in all of the Opponent’s evidence were variants of the mark BOTOX BOTULINUM TOXIN TYPE A PURIFIED NEUROTOXIN COMPLEX & Design found in some of the Opponent’s brochures and some of its marketing pamphlets namely the variants “BOTOX BOTULINUM TOXIN TYPE A HELPING RESTORE FORM AND FUNCTION & Design” or “BOTOX BOTULINUM TOXIN TYPE A THE STRENGTH OF EXPERIENCE & Design” or “BOTOX BOTULINUM TOXIN DU TYPE A AIDE À RÉTABLIR LA FORME ET LA FONCTION &

Design” or “BOTOX COSMETIC BOTULINUM TOXIN TYPE A & Design” found in advertisements or the words “(Botulinum Toxin Type A For Injection) Purified Neurotoxin Complex” found as generic terms on the boxes and vials containing BOTOX and BOTOX COSMETIC products (BOTOX and BOTOX COSMETIC marks identified as such) and the samples of televised advertisements described earlier (and not admitted in evidence) for the mark “IT’S NOT MAGIC, IT’S BOTOX COSMETIC & Design”, which also differs from the mark as registered.

I will add in closing on the concept of “family” of trade-marks that the Opponent does not own a family of marks composed of the suffix “OTOX” or “TOX”, but rather of the element “BOTOX”. Based on the evidence of use of the marks, I would acknowledge that the Opponent owns a family of trade-marks composed of the BOTOX (nominal and figurative versions) and BOTOX COSMETIC (nominal and figurative versions in French and in English) marks.

Without deciding on the notoriety of the BOTOX and BOTOX COSMETIQUE trade-marks in Canada, it would be appropriate to point out that the notoriety of a trade-mark is not decisive. On this point, it is fitting to refer to certain passages from *Mattel, supra*:

It may be, as the appellant argues, that “the nature of wares or services should have less weight because the famous mark more likely will lead to the inference that the source of the two is the same” (factum, at para. 70) and “. . . fame itself can and does *create* a connection in the mind of the ordinary consumer who first sees a famous mark in a new context” (factum, at para. 73 (emphasis in original)), but in *Pink Panther*, Linden J.A. clearly said that “[t]he key factor here is the gaping divergence in the nature of the wares and in the nature of the trade” (para. 50 (emphasis added)). The jurisprudence is clear that different factors may be given different weight in different situations. . . .

On a more general level, however, it seems to me that it is the appellant, not the Federal Court of Appeal, which seeks to sidestep the “all the surrounding circumstances” test in the case of a famous trade-mark and place fame in the ascendent. I agree with the appellant that a difference in wares or services does not deliver the knockout blow, but nor does the fame of the trade-mark. Each situation must be judged in its full factual context.

As stated above, I am of the opinion that the differences between the DERMOTOX mark and BOTOX and BOTOX COSMETIC marks combined with the differences there are in terms of the

nature of the wares and the nature of the trade of the parties are sufficient in the circumstances to avoid any likelihood of confusion in regard to the source of these wares in the mind of the consumer.

In concluding on this point, I would add that I do not assign any weight to the allegations of the Opponent's witnesses to the effect that in their personal opinion, there is a risk of confusion between the marks at issue. It falls on the Registrar to decide whether there is a likelihood of confusion between the marks after analyzing the circumstances of the case.

(ii) Grounds based on paragraphs (a) and (b) of subsection 16(2) of the Act:

The Opponent can discharge its initial burden of proof in regard to paragraph 16(2)(a) by establishing that its trade-marks were used or made known in Canada prior to the filing date of the application and that it had not abandoned the use at the date of advertisement of the application [subsection 16(5)].

The Opponent can discharge its initial burden of proof under paragraph 16(2)(b) by establishing that its application for registration was filed prior to the filing date of the application of the Applicant and that this application was pending at the date of the advertisement of the Applicant's application [subsection 16(4)].

For the reasons explained above, I am of the opinion that the Opponent discharged its initial burden in regard to the BOTOX (nominal and figurative versions) and BOTOX COSMETIC (nominal and figurative versions in French and in English) marks.

The difference between the relevant dates for the grounds for opposition based on paragraphs 12(1)(d) and 16(2)(a) and (b) does not really affect my earlier analysis following which I determined that there was no confusion between the Mark and the marks raised by the Opponent.

I therefore reject the grounds for opposition to the effect that the Applicant is not the person entitled to register the Mark under paragraphs (a) and (b) of subsection 16(2) of the Act.

(iii) Grounds based on the Mark's lack of distinctiveness:

As stated above, the relevant date for this ground of opposition, which is also based on the issue of confusion between the Mark and the Opponent's trade-marks, is generally accepted to be the filing date of the statement of opposition.

The Opponent can discharge its initial burden of proof in regard to the Mark's lack of distinctiveness by establishing that its trade-marks had become sufficiently known in Canada at the date of the statement of opposition that it negated the distinctiveness of the Mark [see on this point *Motel 6, Inc. v. No.6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.)].

Although the Opponent did establish that its BOTOX (nominal and figurative versions) and BOTOX COSMETIC (nominal and figurative versions in French and in English) trade-marks were known in Canada at the date of the statement of opposition, in my opinion there is no risk of confusion between the trade-marks at issue based on the evidence in the record, and the fact that there is a difference between the relevant dates does not really affect my earlier findings. I therefore reject this ground of opposition as well.

(iv) Ground based on paragraph 30(i) of the Act:

As argued, the ground of opposition based on paragraph 30(i) is incomplete in that it alleges only that the Applicant could not in good faith have been satisfied that it had the right to use the Mark in Canada in association with the wares based on its knowledge of the prior use in Canada of the Opponent's marks listed at paragraph 4 of the statement of opposition. The alleged knowledge of the Opponent's marks in itself is not a valid ground of opposition. The Opponent must allege that the Mark causes confusion with the Opponent's.

I would also add that there was no evidence in the record to find that the Applicant could not have been satisfied that it had the right to use the Mark.

Accordingly, I am of the opinion that the ground of opposition based on paragraph 30(i) must be dismissed.

(v) Ground based on paragraph 30(d) of the Act:

The Opponent can discharge its initial burden of proof in regard to section 30 by relying not only on the evidence that it adduced but also on the evidence filed by the Applicant [see on this point *Labatt Brewing Company Limited v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.)].

To the extent that the Applicant has easier access to the facts, the burden of proof on the Opponent in regard to the ground of opposition based on the failure to respect paragraph 30(d) is less onerous [see on this point, *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.)].

As stated earlier, the Applicant did not adduce any evidence of use of the Mark in France or in any other country or territory. The Opponent for its part filed, for the first affidavit of Tonia Morgan, excerpts from the Applicant's Internet site.

Specifically, Tonia Morgan searched the Applicant's "lancome.fr" Internet site in order to identify all references to the Applicant's Mark. The results of this research (filed in the form of references to the Internet site "lancome.fr" printed on November 12, 2004) served to establish that the Applicant appears to promote its products on its Internet site. The Applicant's products can be researched through this site *inter alia* by product class or by product name. The searches using the keyword "DERMOTOX" or bearing on the products included in the class of "skincare" products and its subcategories (which include a great many of the Applicant's products) proved to be in vain, suggesting that the Mark is not used in France or that it was abandoned by the Applicant.

The Opponent indirectly attempted to introduce additional evidence on this point through the second affidavit of Tonia Morgan. For the reasons explained above, the evidence which consists of additional verifications carried out by the witness on the Applicant's Internet sites "www.lancome.fr", "www2.lancome.com/_int/", "www.lancome.ca" and "www.lancome-usa.com", as well as the notice of abandonment and the *inter partes* decision regarding the application for the registration in United States for the DERMOTOX mark in the USPTO's records are not admissible in this matter considering the fact that they were not properly adduced into evidence.

Nevertheless, I am of the opinion that the Opponent nevertheless discharged its initial burden of proof in regard to the ground of opposition based on paragraph 30(d) of the Act to the effect that the Mark was not used in France by the Applicant and/or its licensee in association with each and every one of the Wares. The searches described in the first affidavit of Tonia Morgan raise, in the circumstances, serious questions regarding the use of the Mark in France by the Applicant.

On this point it is appropriate to refer to a few passages drawn from the case law, including decisions of the Opposition Board in *Canadian Medical Association v. Soldan* (2004 CarswellNat 5154) and *105272 Canada Inc. v. Grands Moulins de Paris, S.A.* (1990), 31 C.P.R. (3d) 79, indeed not cited by the Opponent:

105272 Canada Inc.:

"The first ground of opposition is that the applicant had not used its trade-mark DELIFRANCE in France in association with either the wares or services covered in its application prior to the filing date of the present application (March 29, 1985). With respect to a ground of opposition based on Section 30 of the Trade-marks Act, there is a legal burden on the applicant to establish that its application is in compliance with Section 30 of the Act. Further, the material date for considering a Section 30 ground is as of the filing date of the applicant's application. However, while the legal burden is on the applicant, there is an initial evidential burden on the opponent to establish the facts which it alleges in support of the ground of opposition (see *Joseph E. Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 (T.M. Opp. Bd.) , at pg. 329). Further, as pointed out by the hearing officer in *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M. Opp. Bd.) , at pg. 89, "it is difficult for an opponent to prove an allegation of non-use by an applicant, the relevant facts being

readily available to an applicant". While the comments of the hearing officer related to a ground of opposition based on Section 29(b) (now Section 30(b)) of the Trade-marks Act, these comments are equally applicable in respect of a ground of opposition based on Section 30(d) of the Act. Also, in *Canadian Council of Professional Engineers v. 407736 Ontario Corp.* (1987), 15 C.P.R. (3d) 551 (T.M. Opp. Bd.), at pg. 553, the hearing officer noted that "the amount of evidence required to discharge this evidential burden may be very slight".

[Emphasis added.]

Canadian Medical Association:

"The opponent relies on the applicant's website to meet its evidential burden with respect to the ground of opposition based on subsection 30(d). In its written argument, the opponent relied at page 7 on the Gervais affidavit in support of its submission that the applicant's website does not refer to a number of the applied for wares. The applicant responded by deleting a number of wares from its application following the exchange of written arguments. Therefore, the only wares remaining in the statement of wares that the opponent says were not being offered for sale on the website as of July 30, 2002 are perfumery, cosmetics, namely creams, powders and lotions, cosmetic soap. The applicant submits that the ongoing sales of cosmetics and perfumery are established by the listing of the following products on the applicant's website: activ (sic) gel, begapinol foot balm, rheumatism ointment, liniment spirit and shower gel. I am willing to accept that "balms" are a type of "perfumery" and that a "shower gel" might qualify as a "cosmetic soap" but I do not recognize any of the remaining advertised wares as "cosmetics, namely creams, powders and lotions".

I appreciate that the wares listed on the applicant's website as of July 30, 2002 do not necessarily reflect the wares that the applicant was selling in association with its mark in Germany prior to the filing of the present application. However, it is trite to say that it is not an easy matter for a third party to evidence the absence of sales by an applicant in a foreign country at any time, let alone several years ago. I therefore believe that the opponent's evidence satisfies its light evidential burden. It should have been a relatively easy matter for the applicant to respond by filing evidence showing use of its mark in Germany as of the relevant date with respect to the contested wares. As it has not, I find that it has not met its burden, with the result that this ground of opposition succeeds with respect to "cosmetics, namely creams, powders and lotions".

It is to be noted that I do not agree with the opponent's position that its evidence is sufficient to require the applicant to evidence use in Germany prior to March 12, 1999 in association with all of the applied for wares. In addition, I would point out that the applicant's comment that it is readily apparent that the applicant does in fact use its mark in Germany in association with cosmetics from the website information that the opponent chose not to evidence cannot assist its case; if there were relevant pages not provided by the opponent, the applicant should have either cross-examined the opponent's affiant on this point or submitted such pages through its own affiant."

[Emphasis added.]

The Applicant did not even attempt to adduce any evidence regarding the use of the Mark in France in order to counter the Opponent's evidence on this point. Indeed it would have been easy for the Applicant to adduce such evidence of use if there is or was use. I consider that the Applicant did not discharge its burden of proof in regard to this last ground of opposition. I therefore allow the ground of opposition based on paragraph 30(d) of the Act.

Conclusion

Considering the foregoing and exercising the powers that were delegated to me by the Registrar of trade-marks pursuant to the provisions of subsection 63(3) of the Act, I refuse the application for the registration of the Mark, in accordance with the provisions of subsection 38(8) of the Act.

DATED AT MONTRÉAL, QUEBEC, SEPTEMBER 26, 2007.

Annie Robitaille
Member
Trade-marks Opposition Board