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

Citation: 2013 TMOB 103
Date of Decision: 2013-05-29

IN THE MATTER OF AN OPPOSITION by Boehringer Ingelheim International GmbH to application No. 1,441,647 for the trade-mark JONAIRO in the name of Glaxo Group Limited

[1] On June 16, 2009, Glaxo Group Limited (the Applicant) filed an application to register the trade-mark JONAIRO (the Mark) based on proposed use in Canada in association with pharmaceutical preparations (the full list of applied for wares is set out in Schedule A to my decision).

[2] The Applicant claims a priority filing date of January 12, 2009 based on an application filed in the United States of America.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of March 3, 2010.

[4] On July 30, 2010, Boehringer Ingelheim International GmbH (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- pursuant to sections 38(2)(a) and 30(a) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) some of the claimed wares do not meet the requisite degree of specificity to satisfy section 30(a) of the Act;
- pursuant to sections 38(2)(a) and 30(e) of the Act, the application does not comply with section 30(e) of the Act because at the material date the Applicant is deemed to have been aware of the Opponent's trade-mark ONYERO applied

for under application No. 1,389,203 for pharmaceutical preparations (the full specification of wares is set out in Schedule B to my decision) and thus the Applicant could not have had a *bona fide* intention to use the Mark which is confusing with the Opponent's ONYERO mark;

- pursuant to sections 38(2)(a) and 30(i) of the Act, the application does not comply with section 30(i) because the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Wares in view of the fact that at the material date the Applicant was aware or should have been aware of the Opponent's previously filed ONYERO mark (application No. 1,389,203);

- pursuant to sections 38(2)(c) and 16(3)(b) of the Act, the Applicant is not the person entitled to registration of the Mark because as of the date of filing the application for the Mark, as well as at the priority filing date, the Mark was confusing with the Opponent's trade-mark ONYERO subject to application No. 1,389,203;

- pursuant to sections 38(2)(d) and 2 of the Act, the Mark is not distinctive having regard to the provisions of section 2 of the Act in that the Mark does not distinguish nor is it adapted to distinguish the Wares from the wares and services of others, including the Opponent's wares and services in association with its ONYERO trade-mark.

[5] The Applicant served and filed a counter statement in which it denied the Opponent's allegations and put the Opponent to the strict proof thereof.

[6] In support of its opposition, the Opponent filed a certified copy of its application for the trade-mark ONYERO subject to application No. 1,389,203.

[7] In support of its application, the Applicant filed the affidavit of Barbara Gallagher, a law clerk employed by the Applicant's agent. Ms. Gallagher was not cross-examined on her affidavit.

[8] Both parties filed written arguments and were represented at an oral hearing.

Onus and Material Dates

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably

be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[10] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30 - the date of filing the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)].

- sections 38(2)(c)/16(3) - the date of filing the application [see section 16(3) of the Act; in this case the date is January 12, 2009 considering the priority date claimed pursuant to section 34 of the Act].

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

<u>Section 30 Grounds of Opposition</u>

Non-compliance with section 30(a) of the Act

[11] The Opponent failed to provide any evidence or argument in support of this ground of opposition and as a result I find that it has failed to meet its evidential burden. This ground of opposition is accordingly dismissed.

Non-compliance with section 30(e) of the Act

[12] Since the application contains a statement that the Applicant by itself or through a licensee intends to use the Mark in Canada, it formally complies with section 30(e) of the Act.

[13] The Opponent bases this ground of opposition on an allegation that by virtue of the Applicant's deemed knowledge of the existence of the Opponent's trade-mark ONYERO the Applicant could not have had a *bona fide* intention to use the Mark. I am of the view that the Applicant's knowledge or deemed knowledge of the existence of the Opponent's ONYERO mark would not serve as a bar to the Applicant having a *bona fide* intention to use the Mark in Canada. Furthermore, and more importantly, I note that there is no evidence of record to suggest a lack of intention to use the Mark on the part of the Applicant.

[14] I dismiss the ground of opposition based upon non-compliance with section 30(e) on account of the Opponent's failure to meet its evidential burden.

Non-compliance with section 30(i) of the Act

[15] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional cases 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 CPR (2d) 152 (TMOB) at 155]. The Applicant has provided the necessary statement and this is not an exceptional case; the section 30(i) ground is accordingly dismissed.

<u>Non-entitlement Ground – Section 16(3)(b) of the Act</u>

[16] The Opponent has the initial onus of proving that the application for ONYERO was pending at the filing date for the Mark, which in the present case is deemed to be the priority filing date (January 12, 2009) and that it remained pending at the date of advertisement of the application for the Mark (March 3, 2010) [section 16(4) of the Act].

[17] The Opponent has filed a certified copy of application No. 1,389,203 for the trade-mark ONYERO. The application was filed prior to January 12, 2009 and remained pending on March 3, 2010. The Opponent has thus met its evidential burden. I must now assess whether the Applicant has met its legal burden.

[18] 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.

[19] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 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 each has 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. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 96 CPR (4th) 361 (SCC).]

[20] In *Masterpiece*, the Supreme Court of Canada discussed the importance of the section 6(5)(e) factor in conducting an analysis of the likelihood of confusion between the parties' marks in accordance with section 6 of the Act (see para 49):

> …the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis … <u>if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion.</u> The other factors become significant only once the marks are found to be identical or very similar… As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start… [Emphasis is mine]

[21] Under the circumstances of the present case, I consider it appropriate to analyse the degree of resemblance between the parties' marks first.

6(5)(e) – the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[22] The law is clear that when assessing confusion it is not proper to dissect trade-marks into their component parts, rather, marks must be considered in their entirety [see *British Drug Houses Ltd v Battle Pharmaceuticals*, [1944] Ex CR 239, at 251, affirmed [1946] SCR 50 and *United States Polo Assn v Polo Ralph Lauren Corp* (2000), 9 CPR (4th) 51 at para 18, aff'd [2000] FCJ No 1472 (CA)].

[23] The parties have taken entirely opposite views on the issue of the degree of resemblance between the parties' marks.

[24] The Opponent submits that there is some degree of visual similarity between the parties' marks and that they are "virtually indistinguishable" when sounded. The Opponent submits that the only difference in sound is the addition of the letter "J". Both in its written argument and at the oral hearing the Opponent made submissions regarding specific linguistic concepts (i.e. "J is a soft sound that does not dominate the sound of the word, and indeed is easily misheard if spoken quickly") which the Applicant submits, and I agree, constitute evidence. As the evidence

regarding these linguistic concepts has not been adduced through a linguistic expert, rather it has merely been asserted in the Opponent's written and oral submissions, I am not placing any weight on any submissions which rely on these concepts.

[25] The Applicant submits that as a matter of first impression and imperfect recollection the parties' marks are immediately distinguishable from one another in appearance and sound as they begin with different and unrelated letters and the second syllable is also different by virtue of the inclusion of the letter Y in the Opponent's mark. I agree.

[26] Both parties submit that the marks have no particular meaning as they are both coined words. I agree.

[27] Ultimately, I am of the view that based on a first impression, when viewed as a whole, the trade-marks JONAIRO and ONYERO are entirely different in terms of appearance, sound and idea suggested.

[28] At the oral hearing, the Applicant relied on the Registrar's decision in *Trans Canadaderm Inc v Bio Actif Inc* 2010 TMOB 60 wherein the applicant was successful in establishing no likelihood of confusion as between the trade-marks PRÉFIX and PREVEX for similar wares. In that case the Registrar held that "even though the trade-marks under review have some phonetic similarities, on the whole, they are minor compared to their differences, both phonetically and with respect to the ideas they suggest". The Applicant submits that the same is true in the present case. The Opponent submitted that *Trans Canadaderm* is distinguishable as in that case there was evidence of coexistence of the marks in the marketplace and also in that case the marks had meanings which assisted in distinguishing between them.

[29] Every case is to be determined on its own facts. While I agree with the Opponent that *Trans Canadaderm* can be distinguished on the facts, this does not alter my finding that the parties' marks do not resemble each other to any significant extent.

[30] Having found that the parties' marks do not resemble each other to any significant extent, I must now assess the remaining relevant surrounding circumstances to determine whether any of these other factors are significant enough to find a likelihood of confusion [see *Masterpiece, supra* at para 49].

Section 6(5)(a) – inherent distinctiveness and the extent to which the marks have become known

[31] Both parties' marks are coined words and thus each possesses a high degree of inherent distinctiveness.

[32] In its written argument the Opponent submits that in cases where both parties' marks possess a high degree of inherent distinctiveness this factor should be held in favour of the "senior mark" which in this case the Opponent submits is the Opponent's ONYERO mark. At the oral hearing the Applicant disagreed with this submission stating that an Opponent should not automatically be favoured where both parties' marks are coined words.

[33] I disagree with the Opponent's submission and find that, in light of the fact that both parties' marks possess the same degree of inherent distinctiveness and the fact that neither party filed any evidence of use or reputation for their respective marks, this factor does not favour either party.

Section 6(5)(b) – the length of time each has been in use

[34] As neither party has filed any evidence of use of their trade-mark and as both applications are based on proposed use, this factor does not favour either party.

Section 6(5)(c) and (d) – the nature of wares, services or business and trade

[35] The parties' marks are both applied for in association with pharmaceutical preparations. There is also some direct overlap in that some of the claimed pharmaceutical preparations are intended to treat the same medical conditions.

[36] While neither party has filed evidence of the nature of their trades, I am willing to infer that there could also be overlap in the nature of the parties' trades based on the overlap in the nature of the parties' wares.

Additional Surroung Circumstance – Coexistence on Foreign Registers

[37] The Applicant relies on particulars attached to the Gallagher affidavit which it submits support a finding that the parties' marks coexist on foreign registers including those of the United States, Australia, the European Community, Switzerland, Japan and Mexico.

[38] The Opponent submits that coexistence on foreign registers is not relevant; rather the Registrar is restricted to the Canadian marketplace. The Applicant submits that in cases like the present where the Opponent has not provided any evidence regarding the Canadian marketplace, the Registrar should be permitted to place some weight on evidence of coexistence on foreign registers.

[39] For the reasons set out above, and as will be summarized in my conclusion, I need not consider this additional surrounding circumstance in order to find in the Applicant's favour.

Conclusion

[40] As discussed above, in *Masterpiece* the Supreme Court of Canada highlighted the importance of the section 6(5)(e) factor in the analysis of the likelihood of confusion. In the present case, I have found significant differences between the parties' marks in terms of sound, appearance and ideas suggested such that, notwithstanding the similarity in the nature of the parties' wares and trades, I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the parties' marks. Having regard to the foregoing, the ground of opposition based on section 12(1)(d) of the Act is dismissed.

<u>Non-distinctiveness Ground – section 38(2)(d) of the Act</u>

[41] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its Wares from those of others throughout Canada [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness.

[42] Pursuant to its evidential burden, the Opponent is under an obligation to show that, as of the filing of the statement of opposition, its ONYERO trade-mark had become known sufficiently to negate the distinctiveness of the Mark [see *Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FC)].

[43] The Opponent has not filed any evidence showing use or reputation for its ONYERO trade-mark. The Opponent has thus failed to meet its evidential burden and the non-distinctiveness ground of opposition is dismissed accordingly.

Disposition

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

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Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Wares:

Pharmaceutical preparations for use as anti-infectives; Pharmaceutical preparations for the treatment of viral conditions, namely human immunodeficiency virus (HIV), HPV, RSV, hepatitis, herpes genitalis, herpes labialis, herpes simplex virus, varicella-zoster virus, Epstein-Barr virus and cytomegalovirus; Pharmaceutical preparations for the treatment and prevention of metabolic related diseases and disorders namely disorders of the endocrine system, diabetes, metabolic syndrome, obesity, weight loss and weight management; Pharmaceutical preparations for the treatment or prevention of cardiovascular, cardiopulmonary, cardio-renal, and renal diseases; Pharmaceutical preparations for the prevention and treatment of oncological diseases; Pharmaceutical preparations for the prevention and treatment of sequelae of oncologic diseases and their treatment namely nausea and vomiting, hematologic depression, mucositis, cachexia, pain and bone pain, fatigue; Pharmaceutical preparations for the treatment and prevention of respiratory diseases and their symptoms; Pharmaceutical preparations for the treatment of central nervous system diseases and disorders namely: central nervous system infections, brain diseases, central nervous system movement disorders, ocular motility disorders, spinal cord diseases, depression and anxiety and their related disorders namely schizophrenia and psychoses; Pharmaceutical preparations for the treatment of Parkinson's Disease, Alzheimers disease and dementia; Pharmaceutical preparations for the treatment of insomnia, restless leg, fibromyalgia, epilepsy, migraine, pain, stroke and multiple sclerosis; Pharmaceutical preparations for the treatment of pain namely neuropathic pain, inflammatory-related pain and fibromyalgia; Pharmaceutical preparations for the treatment of inflammation and inflammatory related diseases and disorders namely arthritis, inflammatory bowel diseases, inflammatory connective tissue diseases, COPD, asthma, atherosclerosis, vasculitis, synovitis, psoriasis, eczema, scleroderma, and other inflammatory-related skin disorders; Pharmaceutical preparations for the treatment of blood-related diseases and disorders namely thrombocytopenia, coagulation disorders, bleeding disorders, platelet disorders, blood vessel disorders, sickle-cell disease and its related disorders, anemias, and infections in or of the blood; Pharmaceutical preparations for the treatment of musculoskeletal diseases, disorders, and injuries namely connective tissue diseases, bone diseases, osteoporosis, spinal diseases, back pain, gout, fractures, sprains, sports injuries, osteogenesis imperfecta, muscle wasting (cachexia), renal osteodystrophy, cartilage injuries, joint replacement, and osteoarthritis; Pharmaceutical preparations for use in ophthalmology; Pharmaceutical preparations for the treatment of dermatological diseases and disorders namely dermatitis, skin and skin structure diseases, infections, and injuries, psoriasis, eczema, and sexually transmitted diseases; Pharmaceutical preparations for the treatment of hormonal related diseases and disorders namely pre-term labour, hypogonadism, testosterone/androgen disorders and estrogen disorders; Pharmaceutical preparations for the treatment of gastrointestinal related diseases and disorders namely irritable bowel disorders and symptoms, digestive disorders, and acid-related disorders; Pharmaceutical preparations for the treatment of sexual dysfunction namely erectile dysfunction, male and females sexual dysfunction disorders namely arousal disorder, pain disorder, desire disorder, and orgasm disorder; Pharmaceutical preparations for the treatment of genitourinary diseases namely urological diseases and disorders; Pharmaceutical preparations for the treatment of gynaecological diseases, reproductive health and fertility, contraception, bladder and continence disorders, prostate diseases and disorders; Pharmaceutical preparations for the treatment of sexually transmitted diseases, inflammatory pelvic diseases, pre-term labour, pre-eclampsia, vasomotor/menopausal symptoms, endometriosis/uterine fibroids, Leiomyoma, endourology/stone; Pharmaceutical preparations for the treatment of infectious diseases namely prostatitis, nephritis, cystitis, vaginitis, sexually transmitted diseases, renal disease; Pharmaceutical preparations for the treatment of PMDD/PMS, dysmenorrheal, male hypogonadism, and hormonal disorders namely polycystic ovary syndrome; Pharmaceutical preparations for the treatment of male pattern baldness; Pharmaceutical preparations for the treatment of hepatological related diseases namely hepatitis, non-alcoholic fatty liver disease (NAFLD), non-alcoholic steatohepatitis (NASH), liver fibroids, and cirrhosis; Pharmaceutical preparations for the treatment of obesity or to aid in weight loss or weight management; Pharmaceutical preparations for the treatment of sepsis; Pharmaceutical preparations for the treatment of alopecia; Pharmaceutical preparations for the treatment of psychiatric diseases and disorders namely mood disorders, anxiety disorders, cognitive disorders, schizophrenia, and psychoses; Pharmaceutical preparations for the treatment of immune system related diseases and disorders, namely immunosuppressants; Pharmaceutical preparations for the treatment of damaged skin and tissue; Pharmaceutical preparations for the treatment of immunologic diseases and disorders, namely, autoimmune diseases and disorders; Pharmaceutical preparations for the treatment of malaria; Pharmaceutical preparations for the treatment of tuberculosis; Allergy medications; Vaccines namely, prophylactic and therapeutic vaccines for humans.

SCHEDULE B

Wares:

Pharmaceutical preparations for the treatment of cardiovascular diseases; pharmaceutical preparations for the treatment of central nervous system diseases and disorders, namely central nervous system infections, brain diseases, central nervous system movement disorders, ocular motility disorders, spinal cord diseases, encephalitis, epilepsy, Alzheimer's, cerebral palsy, Parkinson's disease; pharmaceutical preparations for the treatment of neurological diseases and disorders, namely brain injury, spinal cord injury, seizure disorders, Alzheimer's, Huntington's disease, cerebral palsy; pharmaceutical preparations for the treatment of genitourinary diseases, namely urological diseases, infertility, sexually transmitted diseases, inflammatory pelvic diseases; pharmaceutical preparations for the treatment of gastrointestinal / diseases and disorders; pharmaceutical preparations for the treatment of musculoskeletal diseases and disorders, namely connective tissue diseases, bone diseases, osteoporosis, spinal diseases, back pain, fractures, sprains, cartilage injuries; pharmaceutical preparations for the treatment of diabetes; pharmaceutical preparations for the treatment of hypertension; pharmaceutical preparations for the treatment of erectile dysfunction; pharmaceutical preparations for the treatment of sexual dysfunction; pharmaceutical preparations for the treatment of cancer; pharmaceutical preparations for the treatment of migraines; pharmaceutical preparations for the treatment of pain, namely headaches, migraines, back pain, pain from burns, neuropathic pain; pharmaceutical preparations for the treatment of obesity; pharmaceutical preparations for the treatment of inflammatory bowel diseases, inflammatory connective tissue diseases, inflammatory pelvic diseases; pharmaceutical preparations for the treatment of infectious diseases, namely eye infections; pharmaceutical preparations for the treatment of immunological diseases and disorders, namely autoimmune diseases, immunologic deficiency syndromes, Acquired Immune Deficiency Syndrome (AIDS); pharmaceutical preparations for the treatment of viral diseases and disorders, namely herpes, hepatitis, Acquired Immune Deficiency Syndrome (AIDS); pharmaceutical preparations for the treatment of stroke; pharmaceutical preparations for the treatment of psychiatric diseases and disorders, namely mood disorders, anxiety disorders, panic disorders, cognitive disorders, schizophrenia, depression; pharmaceutical preparations for the treatment of substance abuse disorders, namely alcoholism and drug addiction; pharmaceutical preparations for the treatment of carpal tunnel syndrome; pharmaceutical preparations for the treatment of varicose veins; pharmaceutical preparations for the treatment of dental and oral diseases; pharmaceutical preparations for the treatment of osteoporosis; pharmaceutical preparations for the treatment of arthritis; pharmaceutical preparations for the treatment of multiple sclerosis; pharmaceutical preparations for the treatment of yeast infections; pharmaceutical preparations for the treatment of prostate disorders; pharmaceutical preparations for use in oncology; pharmaceutical preparations for use in dermatology, namely dermatitis, skin pigmentation diseases; pharmaceutical preparations for use in ophthalmology; pharmaceutical preparations for use in ocular disorders; pharmaceutical preparations for use in gastroenterology; pharmaceutical preparations for the treatment of gynecological disorders, namely premenstrual syndrome, endometreosis, yeast infections, menstrual irregularities; pharmaceutical preparations, namely cholesterol preparations, namely preparations to lower cholesterol; pharmaceutical preparations namely smoking cessation preparations; pharmaceutical preparations namely tissue and skin repair preparations;

pharmaceutical preparations namely acne medication; pharmaceutical preparations namely antacids; pharmaceutical preparations namely anthelmintics; pharmaceutical preparations namely antiarrhythmics; pharmaceutical preparations namely antibiotics; pharmaceutical preparations namely anticoagulants; pharmaceutical preparations namely anticonvulsants; pharmaceutical preparations namely antidepressants; pharmaceutical preparations namely antiemetics; pharmaceutical preparations namely antiflatulants; pharmaceutical preparations namely antihistamines; pharmaceutical preparations namely antihypertensives; pharmaceutical preparations namely anti-infectives; pharmaceutical preparations namely antiparasitics; pharmaceutical preparations namely antibacterials; pharmaceutical preparations namely antifungals; pharmaceutical preparations namely antivirals; pharmaceutical preparations namely burn relief medication; pharmaceutical preparations namely calcium channel blockers; pharmaceutical preparations namely central nervous system depressants; pharmaceutical preparations namely central nervous system stimulants; pharmaceutical preparations namely cough treatment medication; pharmaceutical preparations namely diarrhea medication; pharmaceutical preparations namely gastrointestinal medication; pharmaceutical preparations namely glaucoma agents; pharmaceutical preparations namely hydrocortisone; pharmaceutical preparations namely hypnotic agents; pharmaceutical preparations namely sedatives.