

**IN THE MATTER OF AN OPPOSITION  
by Bayer AG to application No. 707,482 for the  
trade-mark ASAPHEN filed by Pharmascience Inc.**

**On June 19, 1992, the applicant, Pharmascience, Inc., filed an application to register the trade-mark ASAPHEN for “analgesic preparation” based on proposed use in Canada. The application was advertised for opposition purposes on February 3, 1993.**

**Sterling-Winthrop Inc. filed a statement of opposition on March 31, 1993, a copy of which was forwarded to the applicant on May 4, 1993. The current opponent of record is Bayer AG. The first ground of opposition is that the applicant’s application does not comply with the provisions of Section 30(i) of the Trade-marks Act in that the applicant could not have been satisfied that it was entitled to use its applied for mark because the applicant was aware of the opponent’s registered trade-mark ASPIRIN.**

**The second ground is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with the opponent’s trade-mark ASPIRIN registered under No. TMDA06889 for “acetylsalicylic acid tablets.” The third ground is that the applicant is not the person entitled to registration pursuant to Section 16(3) of the Act because, as of the applicant’s filing date, the applied for trade-mark was confusing with the trade-mark ASPIRIN previously used by the opponent. The fourth ground is that the applied for trade-mark is not distinctive in view of the foregoing.**

**The applicant filed and served a counter statement. As its evidence, the opponent filed an affidavit of Stephen Hugh Crawley. As its evidence, the applicant filed the affidavits of Robert William Sterling and Philippe E. Barbaud. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.**

**All four grounds of opposition turn on the issue of confusion between the marks of the parties. Although the material time to consider the circumstances respecting that issue differs from ground to ground, it matters little which material time is used. Thus, a consideration of**

**the issue of confusion between the applicant's mark and the opponent's registered mark pursuant to Section 12(1)(d) of the Act will effectively decide the outcome of this proceeding.**

**As for the ground of opposition based on Section 12(1)(d) of the Act, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.**

**As for Section 6(5)(a) of the Act, the marks of both parties are coined words and are inherently distinctive. There being no evidence of use of the applicant's mark, I must conclude that it has not become known at all in Canada. The Crawley affidavit evidences extensive sales and advertising throughout Canada of the trade-mark ASPIRIN for the period 1986 to 1993. Thus, I am able to conclude that the opponent's mark has become very well known.**

**The length of time the marks have been in use favors the opponent. As conceded by the applicant, the wares and trades of the parties are the same.**

**As for Section 6(5)(e) of the Act, I consider there to be little resemblance between the marks at issue in all respects. If one dissects the two marks, similarities do appear such as the fact that both marks have three syllables, both commence with the letters AS and both end with the letter N. However, the test for confusion is one of first impression and not one of prolonged examination and detailed dissection. Visually, the marks do not resemble one another to any significant degree. Furthermore, the marks do not resemble one another as to the ideas suggested. The opponent submitted that the applicant's mark includes the designation ASA which is a known abbreviation for the ingredient of the applicant's product, namely acetylsalicylic acid. There is no evidence to that effect. However, even if there were,**

I doubt that the average consumer would make such a connection as a matter of first impression.

In considering the degree of phonetic resemblance, I have been assisted by the affidavit of Mr. Barbaud who identifies himself as a professor of linguistics. I have considered his evidence as to the likely pronunciations of the marks at issue by both francophones and anglophones. I have, however, given little consideration to his detailed differentiation between the two marks. As noted above, the test for confusion is one of first impression rather than detailed dissection.

The degree of resemblance (including phonetic resemblance) is to be assessed from the standpoint of the average bilingual consumer. In this regard, I find that the average bilingual consumer would likely pronounce the opponent's mark as "ass-per-in" whereas he or she would likely pronounce the applicant's mark as "as-a-fen", both marks having the accent on the first syllable. In my view, there is little resemblance in those two pronunciations.

As an additional surrounding circumstance, the applicant has relied on the state of the register evidence in the Sterling affidavit. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see the opposition decision in Ports International Ltd. v. Dunlop Ltd. (1992), 41 C.P.R.(3d) 432 and the decision in Del Monte Corporation v. Welch Foods Inc. (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). Also of note is the decision in Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd. (1992), 43 C.P.R.(3d) 349 (F.C.A.) which is support for the proposition that inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.

As noted by the opponent, the Sterling affidavit is deficient in several respects in that Mr. Sterling did not indicate what a "CD name search" is, did not indicate that he checked the trade-marks register and did not provide full particulars of the marks located. Thus, the results of Mr. Sterling's search must be given reduced weight. However, even if I could given

**full weight to those search results, they do not advance the applicant's case since they reveal less than half a dozen AS-prefixed trade-marks registered for analgesic products. Such a small number of marks does not allow me to conclude that any of those marks are being used to any significant extent.**

**In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the low degree of resemblance between the marks at issue, I find that the applicant's trade-mark ASAPHEN is not confusing with the registered mark ASPIRIN. Thus, all four grounds of opposition are unsuccessful.**

**In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I reject the opponent's opposition.**

**DATED AT HULL, QUEBEC, THIS 24th DAY OF JANUARY, 1997.**

**David J. Martin,  
Member,  
Trade Marks Opposition Board.**