

IN THE MATTER OF AN OPPOSITION  
by Knoll AG to application No.  
539,859 for the trade-mark  
BANJEMIN JAMINTON & Design  
filed by Lam Siu Yue trading  
as Lion Medicated Oil Co.

On April 11, 1985, the applicant, Lam Siu Yue trading as Lion Medicated Oil Co., filed an application to register the trade-mark BANJEMIN JAMINTON & Design (illustrated below) for "medicated oil for external use" based on use and registration in Hong Kong. The application as filed contained a disclaimer to the words HEALING OIL and LION MEDICATED OIL CO. The application was amended to change the basis for registration to proposed use in Canada and it was subsequently advertised for opposition purposes on October 3, 1990.

The opponent, Knoll AG, filed a statement of opposition on November 5, 1990, a copy of which was forwarded to the applicant on January 7, 1991. The first ground of opposition is that the application does not comply with the provisions of Section 30(i) of the Trade-marks Act on the basis that the applicant could not have been satisfied that it was entitled to use his mark because it was confusing with the opponent's trade-mark AKINETON.

The second ground of opposition 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 AKINETON registered under No. 119,040 for the following wares:

pharmaceutical preparations, namely preparations  
useful in the treatment of Parkinsonism and other  
brain-stem syndromes.

The third ground of opposition 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 AKINETON previously used in Canada by the opponent. The fourth ground is that the applicant's trade-mark is not distinctive in view of the foregoing.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavit of Christl Reeh. The applicant did not file evidence. Both parties filed a written argument but no oral hearing was conducted.

The success of each ground of opposition is contingent upon a finding of confusion between the two marks at issue, the opponent's strongest case being in respect of its second ground of opposition. Thus, a consideration of that ground will effectively decide the outcome of the present opposition.

As for the opponent's second ground of opposition, the opponent did not evidence a copy of its registration. However, I have exercised my discretion and checked the trade-marks register to determine the status of its registration No. 119,040: see the opposition decision in Quaker Oats Co. of Canada Limited v. Menu Foods Ltd. (1986), 11 C.P.R.(3d) 410. That registration is subsisting.

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.

The applicant's trade-mark is inherently distinctive although some of the secondary reading matter is descriptive of the applied for wares. There being no evidence from the applicant, I must conclude that his trade-mark has not become known at all in Canada.

The opponent's trade-mark is also inherently distinctive. The Reeh affidavit evidences some minor sales of the opponent's AKINETON product by its former registered user BASF K & F Canada Inc., the total sales for the period 1986 to 1990 being about \$150,000. Thus, I cannot ascribe any reputation of note for the opponent's mark.

The length of time the marks have been in use favors the opponent. The wares of the parties are different, the opponent's product being a specialized pharmaceutical preparation and the applicant's proposed product being an oil for external use. The opponent sought to characterize the wares of both parties as being pharmaceutical products. If the opponent means that both parties' products are drugs, I cannot agree. If the opponent simply means that both parties' products could be sold through pharmacies, I agree although such a connection is very tenuous.

There would appear to be some minor overlap in the channels of trade of the parties since both wares could be sold through retail pharmacies. However, it would also appear that the specific channels of trade would be quite different since the opponent's product is a prescription drug and the applicant's product would appear to be a non-prescription oil for use on the skin.

As for Section 6(5)(e) of the Act, I find there to be little resemblance between the marks at issue in any respect.

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 lack of resemblance between the marks at issue, the differences between the wares and trades of the parties and the minimal reputation associated with the opponent's registered mark, I find that the marks at issue are not confusing. It therefore follows that all four grounds of opposition are unsuccessful.

In view of the above, I reject the opponent's opposition.

DATED AT HULL, QUEBEC, THIS 31<sup>st</sup> DAY OF MAY 1994.

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