



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

Citation: 2013 TMOB 226
Date of Decision: 2013-12-20

**IN THE MATTER OF AN OPPOSITION
by Jamieson Laboratories Ltd. to
application No. 1,446,885 for the trade-
mark JENSENS LABORATORIES &
Design, in the name of Jensens
Laboratories Inc.**

Introduction

[1] This opposition relates to an application filed by Jensens Laboratories Inc. (the Applicant) on August 3, 2009 to register the trade-mark JENSENS LABORATORIES & Design as illustrated hereinafter:



[2] The application covers the following wares:

- (1) Sanitizing preparations, namely hand sanitizers used to kill common germs, bacteria, viruses and biological agents.
- (2) Disposable sanitizing cloths to be used on the skin or common surfaces designed to kill common germs, bacteria, viruses and biological agents.
- (3) Skincare cleanser, namely cosmetic cleanser.
- (4) Cosmetics namely, blush, eyeliner, foundation, facial creams, facial lotions, body lotions , lipsticks and hair lotions.
- (5) Vitamins, namely multi vitamins.
- (6) Make up brushes, namely brushes for make up.
- (7) Tooth brushes, namely brushes for brushing teeth.
- (8) Household items for babies namely soap, shampoo, moisturizing cream , diapers, toys namely dolls and stuffed toys, milk bottle, milk powder, food preparation and

food items namely, hard candy, cookies, chocolate , ice cream and cereal.
(collectively referred to as the Wares)

[3] The application is based on use in Canada since at least as early as the following dates:

September 25, 2001 on wares (1), (4).

September 28, 2002 on wares (2), (3).

September 27, 2002 on wares (5).

October 04, 2002 on wares (6).

October 19, 2002 on wares (7).

May 16, 2003 on wares (8).

[4] The grounds of opposition raised by Jamieson Laboratories Ltd. (the Opponent) in a statement of opposition filed September 7, 2010 are based on sections 30(b), (h) and (i), 12(1)(d), 16(1)(a) and (c), and 2 (distinctiveness) of the *Trade-marks Act* RSC 1985, c T-13, (the Act). The specific grounds of opposition are detailed in Schedule A annexed to this decision. The Applicant filed a counterstatement denying all grounds of opposition but also containing detailed argumentation. I will not address arguments contained in the counterstatement not supported by admissible evidence in the record.

[5] The first issue is to determine if the Opponent has furnished sufficient admissible evidence to support each of its grounds of opposition. I conclude that the Opponent has met its initial burden with respect to grounds of opposition based on sections 30(b), 12(1)(d), 16(1) and 2 of the Act. I also conclude that the Applicant failed to discharge its onus with respect to section 30(b) ground of opposition. Finally I conclude that the Mark is confusing with the Opponent's registered trade-mark JAMIESON LABORATORIES & Design when used in association with the Overlapping wares (as defined hereinafter).

Legal Onus and Burden of Proof

[6] The legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate

conclusion cannot be reached in favour of the Applicant once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *Joseph E Seagram & Sons Ltd et al v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FCTD)].

Preliminary remarks

[7] In my decision I will refer only to the admissible evidence in the record. In its counterstatement and its written argument the Applicant raised arguments that are not supported by any evidence in the record. I do not intend to make a detailed list of them but as an example the Applicant argues that there have been no instances of confusion as to the source of the Wares [see paragraph 24 of the Applicant's written arguments]. Such fact has not been proven. Also the Applicant has referred to foreign case law as well as decisions rendered under the Uniform Domain Name Dispute Resolution Policy (UDRP). Foreign case law relates to foreign law that varies from one country to another. Canadian case law is quite exhaustive on the issue of confusion between two trade-marks. There is no need to refer to foreign case law. As for decisions rendered under UDRP, the latter has its own set of rules, different than those applicable in opposition proceedings under the Act.

[8] Permission was granted on May 31, 2012 to the Applicant to file as additional evidence an affidavit of Mr. Mahfuzur M. Ullah sworn on May 3, 2012. As it will appear from this decision I do not make reference to the content of that affidavit. The allegations contained therein do not affect any of my conclusions. In other words its content is not relevant to any of the issues to be discussed herein.

[9] Finally, I intend to address only the relevant issues raised by the parties in their respective written argument.

Admissibility Issues

[10] The Applicant has filed the affidavits of Charles Reiss, Giroux Laforest and Prasun Dhar as survey and expert evidence. The Opponent raised several arguments to support its objection to the inclusion of such evidence in the record. I do not need to address all the arguments raised by the Opponent to dispose of this question.

[11] There are general guidelines set out by the Supreme Court of Canada on the tendering of expert and survey evidence in trade-mark matters. In *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 96 CPR (4th) 361 (SCC) Rothstein J. stated:

75. Tendering expert evidence in trade-mark cases is no different than tendering expert evidence in other contexts. This Court in *R. v. Mohan*, [1994] 2 S.C.R. 9 (S.C.C.), set out four requirements to be met before expert evidence is accepted in a trial: (a) relevance; (b) necessity in assisting the trier of fact; (c) the absence of any exclusionary rule; and (d) a properly qualified expert.

(...)

83. Neither an expert, nor a court, should tease out and analyze each portion of a mark alone. Rather, it should consider the mark as it is encountered by the consumer — as a whole, and as a matter of first impression. In *Ultravite Laboratories Ltd. v. Whitehall Laboratories Ltd.*, [1965] S.C.R. 734 (S.C.C.), Spence J., in deciding whether the words "DANDRESS" and "RESDAN" for removal of dandruff were confusing, succinctly made the point, at pp. 737-38: "[T]he test to be applied is with the average person who goes into the market and not one skilled in semantics".

(...)

[12] It is with these general principles in mind that I shall now determine the admissibility and, if necessary, the probative value of the expert and survey evidence filed by the Applicant.

i) Affidavit of Prasun Dhar

[13] Mr. Dhar describes himself as a student at Concordia University in the Chartered Accounting Program. He states that he '[was] the designer, author and distributor of the Trade-mark Survey solicited by [the Applicant] which [he] submitted on December 30, 2010.'

[14] Without going into the merit of the content of the survey, this evidence is not admissible as Mr. Dhar has no qualifications as an expert in drafting and conducting surveys. For this reason alone the content of Mr. Dhar's affidavit has no probative value.

ii) *Affidavit of Giroux Laforest*

[15] Mr. Laforest is a certified translator. He was asked 'to pass an opinion on the Jensens trade name in light of the opposition raised by Jamieson as to its validity.' As admitted by Mr. Laforest in his affidavit, he is neither a linguist nor a specialist in trade name matters. He concurs with the Applicant 'that the two names are quite different in structure and in sound, i.e. the number of syllables, connotation, pronunciation, sound and appearance.'

[16] As with Mr. Dahr, Mr. Laforest is not an expert in trade-mark law. His conclusion goes far beyond the scope of his expertise, which is translation. Finally, it would appear from the content of his affidavit that he did not look at the trade-marks in issue as a whole, i.e. including the other word components and the design portion which are an integral part of the parties' respective trade-marks.

[17] Consequently this affidavit does not constitute admissible expert evidence and will be given no probative value.

iii) *Affidavit of Charles Reiss*

[18] Mr. Reiss holds a PhD in Linguistics from Harvard University. He is a full Professor at Concordia University. His specialty is Phonological Theory. He was asked by the Applicant to furnish a phonetic and phonological analysis of 'Jensens' and 'Jamieson' in the context of English phonology. He also provides results of several standard mathematical tests for measuring string similarity and dissimilarity of orthographic representations.

[19] There is no doubt that Mr. Reiss is an expert in linguistics. However, as stated in *Moran*, is the report necessary to assist the Registrar in his decision? After doing an analysis of all the possible pronunciations of these words he then states: 'This conclusion is suggested by a side by side comparison of representative phonetic transcriptions' (my underlines). Mr. Reiss concludes that 'Jensens' and 'Jamieson' are quite distinct and unlikely to be confused.

[20] I will afford very little weight to Mr. Reiss' report for the following reasons. Firstly he did not compare the marks in issue but one of their components. Secondly he did a side by side analysis of the word portion of the marks, which is not the proper test. Thirdly there was no need for an expert report to state that the word 'Jensens' has two syllables while 'Jamieson' has three syllables.

[21] I do not think that the content of his report will assist me in determining if, in the mind of a consumer who is vaguely aware of the Opponent's trade-marks, there is a likelihood he will think that the source of the Wares bearing the Mark originates from the Opponent. As it will be discussed later, the marks must not be dissected into their components but must be viewed as a whole.

Grounds of Opposition Summarily Dismissed

[22] Section 30(i) of the Act only requires the Applicant to declare that it is satisfied that it is entitled to use the Mark in Canada in association with the wares and services described in the application. Such a statement is included in this application. An opponent may rely on section 30(i) in specific cases such as where bad faith on the part of the applicant is alleged [see *Sapodilla Co Ld v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. There is no allegation of that nature in the statement of opposition or any evidence in the record to that effect.

[23] Consequently the ground of opposition based on section 30(i) of the Act is dismissed.

[24] The Opponent argues that the application should be rejected because it failed to comply with the requirements of section 30(h) of the Act and Rule 27 of the *Trade-marks Regulations*. The Opponent contends that the representation of the drawing submitted by the Applicant does not accurately depict the trade-mark used by the Applicant in that the drawing inappropriately contains the TM symbol.

[25] The purpose of section 30(h) of the Act is to assure that the Applicant has accurately depicted the Mark. I consider the illustration of the Mark as reproduced above to adequately define the substantive rights of the Applicant and thus complies with the requirements of section

30(h) of the Act. Therefore the ground of opposition based on section 30(h) of the Act is dismissed.

Ground of Opposition Based on Section 30(b)

[26] The Opponent has an initial burden to file some evidence to support this ground of opposition. Alternatively, the Opponent may rely on the Applicant's evidence to meet its light evidential burden [see *York Barbell Holdings Ltd v ICON Health & Fitness, Inc* (2001), 13 CPR (4th) 156 (TMOB)]. However in that case the Applicant's evidence must be clearly inconsistent with the statements made by the Applicant in its application [See *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB), *Labatt Brewing Co v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD) and *Williams Telecommunications Corp v William Tell Ltd* (1999), 4 CPR (4th) 107 (TMOB)].

[27] In *Ivy Lea Shirt Co v Muskoka Fine Watercraft & Supply Co* (2001), 11 CPR (4th) 489 (FCTD) it was determined that in order to meet the requirements of section 30(b) of the Act, an applicant must have continuously used the mark in association with its wares and services in the normal course of trade from the alleged date of first use to the filing date of the application.

[28] As admitted in its written arguments, the Opponent has not filed any evidence to support its contention that the Applicant has not used the Mark as of the various alleged dates of first use mentioned in the application. However, the Opponent is relying on the Applicant's evidence and the cross-examination of Mr. Ullah, the President and CEO of the Applicant, to satisfy its initial burden.

[29] I reproduce the relevant allegations contained in Mr. Ullah's first affidavit dated July 8, 2011:

14. The company began using a trademark that incorporated the elements present in the trademark JENSENS LABORATORIES & LEAF Design on promotional materials on September 25, 2001. Exhibit 'E' includes an invoice from a graphic designer for logo design services as well as several sample logos he produced at the time. The logo that was chosen contains additional elements not included in the trade-mark JENSENS LABORATORIES & LEAF Design [the Mark], which have been removed over the years.

17. The Jensens Trade-mark has been advertised through print promotional materials since September 2001. Exhibit ‘G’ includes samples of print advertisements and sample labels used to promote its products.

18. Jensens products have been advertised through its online catalogues since 2005.

20. Jensens Laboratories has been advertising its vitamins products through its online catalogue since 2005 at jensensvitamins.com. Exhibit ‘I’ includes representative printouts of the different Jensens vitamin products from its website jensensvitamins.com.

21. Jensens Laboratories has been advertising its sanitizing products on the website www.jensenspure.com since 2009. Exhibit ‘J’ includes representative printouts of the different Jensens sanitizing products as they appear on the site jensenspure.com.

22. Jensens Laboratories has been advertising its toothbrush products on the website www.bristflex.com since 2008. Exhibit ‘K’ includes representative printouts of the different Jensens toothbrush products as they appear on the site bristflex.com.

25. The trade-mark JENSENS LABORATORIES & LEAF Design has served to distinguish the Company’s products in the marketplace. The Company received its first shipment of toothbrushes and sanitizing wipes on March 25, 2010. The company has been selling these informally since that date at its corporate headquarters (...).

[30] I note that the deponent is using different terminology such as:

- JENSENS LABORATORIES & LEAF Design
- Jensens Trade-mark
- Jensens products

[31] Nowhere in Mr. Ullah’s affidavit are those terms defined. I shall infer that the deponent meant to refer to different things if he used those different terms. In the absence of any explanation on the meaning of each of these terms I shall infer that JENSENS LABORATORIES & LEAF Design refers to the Mark; Jensens Trade-mark refers to the word mark Jensens; and Jensens products are the products being sold by the Applicant regardless of the trade-mark used by it.

[32] Moreover during his cross-examination Mr. Ullah made the following statements:

- Contrary to what is alleged in paragraph 17 of his affidavit, the labels filed as Exhibit G were never used on products but only in advertisements (Q136-137);
- Vitamins were sold only in September 2001 at Mr. Ullah's accounting office. Since then no sales of vitamins have been made as the Applicant is still in the process of obtaining the requisite NHP license numbers from Health Canada to legally sell vitamins in Canada (Q267-Q273);
- Those sales of vitamins were made prior to the change of logo that occurred in October 2001. The Mark was a subsequent version of the artwork submitted in August 2001 by Multispex Design (Q86-92);
- The Applicant has not sold any hand sanitizers (Q234-235);
- The Applicant has not sold any wipes, except for skincare wipes (Q237-Q258);
- He received orders for toothbrushes in 2005 and March 2010 only (Q292-299);

[33] All these facts are clearly inconsistent with the statements made by the Applicant in its application in so far as the date of first use for each category of wares is concerned. Moreover it raises the issue whether the Mark has been used on a continuous basis from the claimed date of first use up to the filing date of the application (August 3, 2009). Therefore the Opponent has met its initial burden.

[34] The Applicant must show that there has been use of the Mark, within the meaning of section 4(1) of the Act, in association with each of the Wares at the alleged date of first use mentioned in the application up to the filing date of the application. A simple bald assertion of use is not sufficient. There has to be documentary evidence to support such allegation.

[35] From a reading of Mr. Ullah's affidavit and his cross-examination, there seems to be a misunderstanding on the Applicant's part as to what the term 'use' in section 4(1) of the Act means. As detailed above Mr. Ullah admits that, except for vitamins, skincare wipes and toothbrushes which I will discuss later, there has been no sales but there has been advertising and promotion on certain websites.

[36] In fact in its written argument the Applicant states at page 22 that the Mark ‘has been used in association with advertising and promotional development for the general classes of wares 1), 2), 3), 5), 7), 8)...’. A similar statement is made with respect to wares 4) and 6).

[37] Mere advertising and promotion of wares does not constitute evidence of use of a trade-mark in association with wares. There has to be evidence of a transfer of property [see *Gesco Industries Inc v Sim & McBurney* (2000), 9 CPR (4th) 480 (FCA)]. In addition to filing samples of wares bearing a trade-mark, or samples of packaging or labels, the filing of invoices issued by the owner of a trade-mark will serve as evidence of transfer of ownership of goods bearing that trade-mark. Consequently all this evidence would establish use of a trade-mark within the meaning of section 4(1) of the Act.

[38] There is no invoice filed in the record to support an allegation of use. The labels filed either do not bear the Mark or if so were used for advertising purposes. There is no documentary proof of sales of vitamins and skincare wipes. As for toothbrushes and wet wipes, the invoice filed was issued by the Applicant’s supplier. It shows that those items were purchased by the Applicant but it does not prove that they were ever sold in Canada by the Applicant afterwards. In any event such purchase by the Applicant occurred after the relevant date, namely on March 25, 2010. This documentation does not assist the Applicant in proving use of the Mark at the alleged date of first use for those wares (September 28, 2002 and October 22, 2002 respectively).

[39] I may add that even if I was to consider evidence of use of the Mark in association with vitamins, skincare wet wipes and toothbrushes, it is clear from the evidence filed that there has been no continuous use of the Mark from the alleged date of first use, for each of these wares, to the filing date of the application.

[40] Finally in so far as wares (4):cosmetics namely, blush, eyeliner, foundation, facial creams, facial lotions, body lotions , lipsticks and hair lotions; wares (6): make up brushes, namely brushes for make up; wares (8): household items for babies namely soap, shampoo, moisturizing cream , diapers, toys namely dolls and stuffed toys, milk bottle, milk powder, food preparation and food items namely, hard candy, cookies, chocolate , ice cream and cereal; there is no reference to them even in the promotional material filed by the Applicant.

[41] Consequently I conclude that the Applicant has failed to meet its burden to prove that it has used the Mark in Canada, within the meaning of section 4(1) of the Act in association with each of the Wares at the claimed date of first use alleged in the application. Even if I was to conclude that there was use of the Mark in association with vitamins as of the claimed date of first use, such use was not continuous up to the filing date of the application.

[42] The ground of opposition based on section 30(b) of the Act is therefore maintained.

Grounds of Opposition based on Confusion

[43] All the remaining grounds of opposition (sections 16(1), 12(1)(d) and 2 of the Act) are based on an allegation of likelihood of confusion between the Mark and the Opponent's trade-marks. They may have to be assessed at different material dates but in this case I do not think that the difference in those dates will be a determining factor. I may add that, since the Opponent has been successful under its ground of opposition based on section 30(b), the relevant date to assess the ground of opposition under section 16(1) is the filing date of the application [see *Everything for a Dollar Store (Canada) Inc v Dollar Plus Bargain Centre Ltd* (1998), 86 CPR (3d) 269 (TMOB)].

[44] Under these grounds of opposition the best chances of success for the Opponent is to determine if there is a likelihood of confusion between the Mark and the Opponent's registered trade-mark JAMIESON LABORATORIES & Design, registration TMA713,711 as illustrated hereinafter:



If I conclude that there is no likelihood of confusion between the Mark and the Opponent's Registered mark, the Opponent would not be successful if I choose in my analysis any of the other Opponent's registered trade-marks listed in its statement of opposition and reproduced in schedule A.

[45] I shall do my analysis of the likelihood of confusion between the marks in issue under the ground of opposition based on section 12(1)(d) of the Act at the date of my decision [see *Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[46] The Opponent has filed a certified copy of registration TMA713,711. I exercised my discretion to check the register and note that registration TMA713,711 is extant. Therefore the Opponent has met its initial burden with respect to this ground of opposition [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]

[47] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trade-marks are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the wares, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [See *Clorox Co v Sears Canada Inc* (1992), 41 CPR (3d) 483 (FCTD) and *Gainers Inc v Marchildon* (1996), 66 CPR (3d) 308 (FCTD)].

[48] The test under section 6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether there would be confusion of the Applicant's Wares, associated with the Mark, as wares emanating from or sponsored by or approved by the Opponent.

[49] Mr. Justice Binnie of the Supreme Court of Canada commented on the assessment of these criteria [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 and *Mattel Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321]. Each factor may be assessed different weight but the most important factor is often the degree of resemblance between the marks [see *Masterpiece*, above].

Inherent distinctiveness of the trade-marks and the extent to which they have become known

[50] Mr. Lucchetta has been the Opponent's Executive Vice President and has been employed by it since January 1989. He explains in his affidavit that the Opponent was founded by Dr. Claire Edwin Jamieson. The Opponent's name evolved over the years but always contained the family name Jamieson. As stated by the Opponent in its written arguments, names of people are, by nature, not inherently distinctive. However the Opponent's Registered mark contains a design feature and as such does possess some inherent distinctiveness.

[51] Mr. Ullah explains in his affidavit that the component Jensens was chosen to evoke the idea of 'essences of Jen-Shen'; 'Essences' meaning plant extracts and 'Jen-Shen' meaning *ginseng* in Chinese. He filed an extract of a Chinese-English dictionary for the word 'ginseng'. However I am not sure that the average Canadian consumer would make such connection. Consequently, as a whole, both marks are inherently distinctive.

[52] However any mark may acquire distinctiveness through extensive use. I shall now review the evidence of use of the parties' marks to determine if each one of them has acquired distinctiveness in Canada and if so to what extent.

[53] The Opponent has filed voluminous evidence of use of the various Opponent's Trade-marks. I shall focus on the evidence of use of the Opponent's Registered mark. I will discuss later the issue of use of a family of JAMIESON marks.

[54] Mr. Lucchetta explains that the Opponent is a manufacturer of vitamins, minerals and nutritional supplements in Canada. He alleges that the Opponent has been using the Opponent's Registered mark since 2001. To support such contention he filed the following:

- Packaging of vitamins, skin care products and herbal supplements [see exhibits A & B to Mr. Lucchetta's affidavit dated February 28, 2011 (Lucchetta#1)];
- Invoices bearing the Opponent's Registered mark issued by the Opponent between January 2001 and November 2010 [see exhibit C to Lucchetta#1 and exhibits A & B to Mr. Lucchetta's affidavit dated March 11, 2011 (Lucchetta#2)];
- Photographs of store displays and custom display units [see exhibit D to Lucchetta#1];
- Advertisements in magazines and newspapers such as Famous, Shoppers Drug Mart Beauty Guide, SmartSouce, Uniprix flyer, Canadian Retailer, Prelude, Golf Canada, Viva

Magazine, The Vancouver Sun, Guide Ressources, 7 Jours, The Windsor Star, Pharmacy Post, The Chronicle Herald [see exhibits I and M to Lucchetta#1];

- Advertisements on Sympatico MSN, Google and Canoe websites [see exhibits J to Lucchetta#1].

[55] Mr. Lucchetta also provides the sums of money annually spent by the Opponent to promote its vitamins, mineral, herbs and nutritional supplements (Supplements) and cosmetics, creams, lotions, oils, moisturizers, cleansers, gels, astringents, toners and medicated creams (Skin Care Products) between 2001 and 2010. However there were no expenditures on Skin Care Products advertising in 2002. The Opponent has spent over these years at least 2 million dollars annually in advertising.

[56] Mr. Lucchetta supplies the Opponent's yearly sales figures of Supplements and Skin Care Products between 2000 and 2010. They are not less than 72 million dollars for Supplements and not less than 2 million dollars for Skin Care Products.

[57] Mr. Lucchetta asserts that the Opponent's Supplements and Skin Care Products bearing the Opponent's Registered mark are sold in the following retail outlets: Costco, Brunet, Atlantic Superstores, Pharmachoice, Pharmasave, Provigo, Proxim, S.D.M./Pharmarix, Safeway, Jean Coutu, Loblaw, Maxi, Metro, People Drug Mart, Safeway, Shoppers Drug Mart, Sobeys, SuperC, The Bay, Uniprix, Walmart to name some of them.

[58] To determine its market share in respect of vitamins and supplements the Opponent purchases 'Market Track' POS (point of sale) data from ACNielsen. Mr. Lucchetta then states that he understands that ACNielsen obtains POS data from cash register records from grocery, drug and mass retailers across the country. He further states that ACNielsen formats the data and provides it to the Opponent on a monthly basis. Finally Mr. Lucchetta's affidavit contains a table showing the percentage of the total units sold in the product categories selected.

[59] I consider the evidence described in the previous paragraph to be inadmissible hearsay evidence. The data is compiled by ACNielsen. There is no supporting document emanating from ACNielsen annexed to Mr. Lucchetta's affidavit. There is no explanation provided as to why a representative of ACNielsen could not have filed an affidavit containing that information.

[60] The Applicant argues that there is no evidence of use of the Opponent's Registered mark after 2007 and as such it would be subject to section 45 proceedings as there has been no use of that mark over the last 3 years. The validity of the Opponent's Registered mark is not in issue in these opposition proceedings. If the Applicant thinks that the Opponent's Registered mark ought to be expunged on the basis of non-use, it can initiate section 45 proceedings. The Opponent's Registered mark is still on the register and shall be treated as such.

[61] From the evidence described above I consider the Opponent's Registered mark to be known in Canada to some extent in association with Supplements and Skin Care products.

[62] As for the Mark, as discussed above, except for some alleged token sales of vitamins in Mr. Ullah's accounting office in 2001 there has been no evidence of sales of any of the Wares. As for the advertisement and promotion of the Wares bearing the Mark it has been limited to specific websites and we have no information on the number of Canadian hits on these websites. I conclude that the Mark is not known in Canada.

[63] Overall the first criterion favours the Opponent because the Opponent's Registered mark has acquired distinctiveness that goes beyond the inherent distinctiveness of the Mark.

The length of time the trade-marks have been in use

[64] There is no evidence of use of the Mark within the meaning of section 4(1) of the Act in the record. The Opponent has shown use of the Opponent's Registered Mark since 2001 up to at least 2007 in association with Supplements and Skin Care products. This factor also favours the Opponent.

The nature of the wares, services, or business; the nature of the trade

[65] Under this ground of opposition I must compare the Wares as described in the application with the wares covered by the Opponent's registrations [See *Mr. Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 at 10-11 (FCA); *Henkel Kommanditgesellschaft v Super Dragon* (1986), 12 CPR (3d) 110 at 112 (FCA); *Miss Universe Inc v Dale Bohna* (1994), 58 CPR (3d) 381 at 390-392 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible

trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble In. v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[66] There is clearly an overlap between the Opponent's Supplements and Skin Care products and the Applicant's skincare cleanser, namely cosmetic cleanser, facial creams, facial lotions, body lotions; vitamins, namely multi vitamins (Overlapping wares). As for the other Wares I do not see any overlap with the Opponent's wares.

[67] There is no restriction in the application as to the Applicant's channels of trade. However in his affidavit Mr. Ullah states: ' Given that some of the wares sold by Jensens are similar to the wares sold by the Opponent and these wares could be circulated in the same trade-channels, the ways that consumers purchase these wares are relevant when considering the matter of consumer confusion'. This is a clear admission that the Overlapping wares could circulate through the same channels of trade.

[68] The Applicant filed as exhibit P to Mr. Ullah's affidavit two reports on consumer studies providing information on their purchasing behaviours of vitamins. The first report concerns the United Kingdom and only an extract of the report has been filed. These reasons are sufficient to exclude that report from the record. In any event, it constitutes inadmissible hearsay evidence.

[69] The second report is entitled 'Exploring consumer and pharmacist views on the professional role of the pharmacist with respect to natural health products: a study of focus groups'. Even if I was to admit the content of this report as proper evidence, I do not believe that it is very helpful to the Applicant. The latter, based on that report, argues that the average purchaser of vitamins, is informed to some extent on which type of vitamin they want and what its benefits are. As a consequence, argues the Applicant, 'consumers are also likely to have had the opportunity to distinguish between brands before making a purchase decision'. This is quite a quantum leap that the Applicant is trying to make. The fact that a consumer may be knowledgeable of what type of vitamins he needs does not necessarily imply that the same consumer has some knowledge of the different providers of those types of vitamins.

[70] The Applicant also argues that its target market is a consumer seeking a higher end product. It asserts that its products are too expensive to be sold in pharmacy and supermarket. Therefore the Applicant states in its written argument that ‘[it] will focus on establishing itself as a higher end brand for health food store and online markets’. There is no evidence in the record of the selling price of the Applicant’s vitamins compared to the selling price of the Opponent’s vitamins. Also there is no limitation in the description of the Wares as to their channels of distribution. The Applicant’s Wares could very well be sold in pharmacies and supermarkets.

[71] Under Canadian trade-marks law the test for confusion still remains: would a consumer with an imperfect recollection of the Opponent’s Register mark, which sees products bearing the Mark, think that those wares emanate from the Opponent?

[72] I consider that these factors also favour the Opponent in so far as the Overlapping wares are concerned.

The degree of resemblance

[73] As stated earlier, in its judgment in *Masterpiece* the Supreme Court of Canada has clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks.

[74] The Applicant has taken the wrong approach to measure the degree of resemblance between the marks. It has dissected the Opponent’s Registered mark into each single element namely, the word components (JAMIESON and LABORATORIES), the font of the letter J, the leaf design and argued at length that none of them are distinctive. The Opponent’s Registered mark must be viewed as a whole.

[75] The dominant feature of the Opponent’s Registered mark is obviously the word JAMIESON. As for the Mark, its dominant feature is the word JENSENS. However it is the overall impression of the marks in issue that must be assessed. The Opponent’s Registered mark has a capital J in serif font with a rounded loop bottom. It contains the word ‘LABORATORIES’ which suggests the idea of research. That word is spaced out directly underneath the ‘JAMIESON’. It has a leaf design with a middle vein which suggests the idea of ‘nature’ or

‘natural’ when used in association with the Opponent’s products. All these design features are also found in the Mark. Consequently there is definitely some visual resemblance between the marks in issue. Moreover the inclusion of the word ‘LABORATORIES’ in both marks not only creates some resemblance phonetically but also in the ideas suggested by them.

[76] As for the phonetic resemblance, Dr. Reiss did a side by side comparison of representative phonetic transcriptions of the words JAMIESON and JENSENS. However the overall test is the ‘imperfect recollection’ of the Canadian average consumer. I am of the opinion that there exists some phonetic resemblance between those names to the extent that they sound similar at the beginning and the end.

[77] With respect to the leaf design the Applicant tried to introduce state of the register evidence (exhibit Q to Mr. Ullah’s affidavit) to argue that it is a common feature of trade-mark designs used in association with vitamins. However, excluding all maple leaf designs that suggests a different idea, namely products of Canadian origin, and the Opponent’s trade-marks, there are only 8 relevant citations (1505268, 1451312, TMA777188, TMA756758, TMA611699, TMA557539, 1410809, TMA776363) owned by 6 different entities. Moreover, out of those eight citations, one application has been declared abandoned and another one is at the search stage.

[78] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD)]. Inferences about the state of the marketplace can only be drawn from state of the register evidence where a large number of relevant registrations have been located [see *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)]. Six relevant citations are not sufficient to infer that Canadian consumers are accustomed to see numerous trade-marks comprising a leaf design used in association with vitamins such that they can distinguish them.

Additional surrounding circumstances

[79] The Opponent argues that it owns a family of registered trade-marks. Registrations TMA774424 and TMA713,713 also include the word JAMIESON, written with a capital J, and

have a leaf design. The fact that the Opponent is the registered owner of three trade-marks in Canada incorporating those features is not sufficient to benefit from a wider scope of protection associated to the concept of the existence of a family of trade-marks. There must be evidence of actual prior use of those trade-marks in the record [see *MacDonald's Corporation v Yogi Yogurt Ltd* (1982), 66 CPR (2d) 101].

[80] Exhibits B, D, E to Lucchetta#1 and exhibit D and E to Lucchetta#2 contain illustrations of packaging, store displays and shelf talkers bearing the abovementioned registered trade-marks of the Opponent. As such I consider that there exists a family of trade-marks owned by the Opponent comprising the word 'JAMIESON', written with a capital J and having a leaf design used in association with Supplements and Skin Care products.

Conclusion

[81] I conclude that the Applicant has failed to meet its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's Registered mark when used in association with the Overlapping wares. As for the other wares I conclude that there is no likelihood of confusion between the Mark and the Opponent's Registered mark as the difference in the nature of the Applicant's other wares is sufficient to conclude in favour of the Applicant.

[82] My conclusion is based on the fact that; there exists some resemblance visually, in the ideas suggested, and phonetically between the marks in issue; there is an overlap between the Opponent's Supplements and Skin Care products and the Overlapping wares of the Applicant; the Opponent's Registered mark is known in Canada and has been used by the Opponent for a longer period of time than the Mark and finally the Opponent owns a family of trade-marks comprising the word JAMIESON, written with a capital J, and having leaf design.

[83] As mentioned earlier the relevant dates associated with the grounds of opposition of entitlement (section 16(1): the filing date of the application as discussed above) and distinctiveness (section 2: the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FCTD)]) would not have an impact on the analysis of the relevant criteria outlined above. Consequently I would come to the

same conclusion when assessing each of those other grounds of opposition. They are therefore all maintained in part in so far as the Overlapping wares are concerned.

Disposition

[84] Given that the Opponent has been successful in whole under its ground of opposition based on section 30(b) of the Act, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application to register the Mark in association with the Wares pursuant to section 38(8) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule A

The grounds of opposition can be summarized as follow:

1. The application does not comply with the requirements of section 30(b) of the *Trade-marks Act* RSC 1985, c T-13, (the Act) in that the Applicant has not used the Mark in association with each of the Wares in Canada since the claimed date of first use;
2. The application does not comply with the requirements of section 30(h) of the Act in that the representation of the drawing does not accurately depict the trade-mark as allegedly used by the Applicant. More specifically, Rule 27 of the *Trade-mark Regulations* indicates that the drawing should not include any matter that is not part of the trade-mark. The subject mark inappropriately contains the TM symbol. This symbol should not be included in the drawing;
3. The application does not comply with the requirements of section 30(i) of the Act in that 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 time of filing such application, namely, August 3, 2009, the Mark was confusing within the meaning of Section 6(2) of the Act with the Opponent's trade-marks;
4. The Mark is not registrable in view of section 12(1)(d) of the Act since the Mark is confusing with the following Opponent's registered trade-marks:

TMA749,255 for JAMIESON in association with (1) Vitamin and mineral supplements. (2) Cosmetics and skin care products, namely creams, lotions, oils, moisturizers, cleansers, gels, astringents, toners and medicated creams used for first aid treatment;

TMA774,424 for JAMIESON & Design as illustrated hereinafter in association with (1) Vitamins, minerals and nutritional supplements, namely a source of vitamins, minerals, lipids or essential fatty acids, fibre, protein, carbohydrates, enzymes, phytochemical compounds, amino acids, bacterial cultures, natural and modified plant compounds and extracts, herbal preparations or any other nutritional or medicinal active compounds, namely nucleic acids, electrolytes, coenzymes, esters and yeast cultures and herbal supplements, namely , bilberry, echinacea, elderberry, garlic, ginkgo biloba, ginseng, milk thistle, saw palmetto, St. John's wort, valerian root, glucosamine and chondroitin sulfate, herbal diuretic, green tea phytosome complex, laxative complex combining cascara sagrada and senna leaves, lutein and zeaxanthin. (2) Cosmetics and skin care products, namely creams, lotions, oils, moisturizers, cleansers, gels, astringents and toners:

The logo for Jamieson, featuring the word "Jamieson" in a bold, sans-serif font. A small leaf icon is positioned above the letter 'i'.

TMA713,711 for JAMIESON LABORATORIES & Design as illustrated hereinafter in association with (1) Cosmetics and skin care products, namely creams, lotions, oils, moisturizers, cleansers, gels, astringents, toners and medicated creams used for first

aid treatment.

(2) Vitamins; minerals; herbs and herbal supplements, namely, Bilberry, Echinacea, Elderberry, Ginkgo Biloda, Milk Thistle, Saw Palmetto, St. John's Wort, Valerian, Green Tea Phytosome, Ginseng; herbs for use as a diuretic; herbs for use as a laxative; herbs for use as a relaxant and sleep aid; and nutritional supplements, namely a source of vitamins, minerals, lipids or fatty acids, fibre, protein, carbohydrates, enzymes, phytochemical compounds, amino acids and bacterial cultures:



TMA713,713 for JAMIESON NATURAL SOURCES & Design as illustrated hereinafter in association with (1) Vitamins; minerals; herbs and herbal supplements, namely, Bilberry, Echinacea, Elderberry, Ginkgo Biloda, Milk Thistle, Saw Palmetto, St. John's Wort, Valerian, Green Tea Phytosome, Ginseng; herbs for use as a diuretic; herbs for use as a laxative; herbs for use as a relaxant and sleep aid; and nutritional supplements, namely a source of vitamins, minerals, lipids or fatty acids, fibre, protein, carbohydrates, enzymes, phytochemical compounds, amino acids and bacterial cultures.

(2) Cosmetics and skin care products, namely creams, lotions, oils, moisturizers, cleansers, gels, astringents, toners and medicated creams used for first aid treatment:



TMA750,314 for JAMIESON DIRECT & Design as illustrated hereinafter in association with (1) Vitamins; minerals; herbal supplements for nutritional purposes, namely bilberry, echinacea, elderberry, garlic, ginkgo biloba, ginseng, milk thistle, saw palmetto, St. John's wort, valerian root, glucosamine and chondroitin sulfate, herbal diuretic, green tea phytosome complex, laxative complex combining cascara sagrada and senna leaves, lutein and zeaxanthin; nutritional food supplements, namely a source of vitamins, minerals, lipids or fatty acids, fibre, protein, carbohydrates, enzymes, phytochemical compounds, amino acids, bacterial cultures; skincare products, namely creams, lotions, oils, moisturizers, toners, gels and cleansers; and the services of Direct marketing and sale of the products of the applicant over the Internet:



(collectively referred to as the Opponent's Trade-marks)

5. The Applicant is not the person entitled to the registration of the Mark pursuant to section 16(1)(a) and (c) of the Act since at the dates the Applicant allegedly first used the Mark

in Canada, it was confusing with or likely to be confusing with the Opponent's trade-marks listed above that had been previously used and made known in Canada by the Opponent in association with the wares described above as well as the trade name Jamieson Laboratories Ltd., which has been in prior use in Canada and continues to be used in Canada on a widespread basis in association with vitamins, minerals, and nutritional supplements and cosmetics and skin care products;

6. Pursuant to section 38(2)(d) of the Act, the Mark is not, and at all material times has not been and could not be, distinctive of the Wares of the Applicant from the wares of the Opponent sold in association with the Opponent's Trade-marks.