



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

Citation: 2011 TMOB 60
Date of Decision: 2011-04-12

**IN THE MATTER OF AN OPPOSITION
by Johnson & Johnson to application
No. 1,141,824 for the trade-mark
ACCUWAVE in the name of Mahrukh
Panthakey**

[1] On May 24, 2002, Mahrukh Panthakey (the Applicant) filed an application to register the trade-mark ACCUWAVE (the Mark) based on proposed use of the Mark in Canada in association with:

wares

contact lens solutions; spectacles, spectacle frames, spectacle lenses, contact lenses, sunglasses, spectacle cases, contact lens cases and containers; parts and fittings for all the aforesaid goods;

services

optician and ophthalmic services including sight testing and ophthalmic surgery; medical and surgical services relating to eyesight and visual correction; laser and LASIK (laser assisted in situ keratomileusis) eye surgery services; consultancy services relating to all the aforesaid services.

[2] The Applicant has claimed a convention priority filing date of January 7, 2002.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of June 25, 2003.

[4] On November 25, 2003, Johnson & Johnson (the Opponent) filed a statement of opposition. Leave to amend the statement of opposition was subsequently granted.

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

[6] Both the Opponent and the Applicant elected to not file any evidence.

[7] Only the Applicant filed a written argument, but both parties were represented at an oral hearing.

Summary of Grounds of Opposition and Applicable Material Dates

[8] The Opponent has pleaded multiple grounds of opposition. However, at the oral hearing, the Opponent indicated that it was withdrawing all of the grounds of opposition other than the following:

contrary to s. 38(2)(b) and 12(1)(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), the Mark is not registrable because it is confusing with four trade-marks registered by the Opponent for contact lenses, namely ACUVUE (No. TMA342,767), ACUVUE & Parallel Lines Design (No. 572,884), ACUVUE 2 & Ovals Design (No. TMA575,618), and ACUVUE TORIC & Ovals Design (No. TMA575,617).

[9] The material date with respect to a s. 12(1)(d) ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

Onus

[10] 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 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Section 12(1)(d) Grounds of Opposition

[11] I have exercised the Registrar's discretion to check the register in order to confirm the existence of the registrations relied upon by the Opponent under s. 12(1)(d) [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)]. The Opponent's initial burden under s. 12(1)(d) has been met because each of the registrations is extant.

[12] I consider the Opponent's word mark ACUVUE to present its strongest position. I will therefore focus my assessment on the likelihood of confusion between ACCUWAVE and ACUVUE. If there is not a reasonable likelihood of confusion between these two marks, then there would not be a reasonable likelihood of confusion between the Applicant's Mark and any of the other marks pleaded by the Opponent.

[13] 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.

[14] In applying the test for confusion, I must have regard to all the surrounding circumstances, including those specifically enumerated in s. 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 C.P.R. (4th) 321 (S.C.C.).]

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

[15] The Opponent's ACCUVUE mark is not inherently strong. The prefix "acu" or "accu" infers the word "accurate" while the suffix "vue" infers the idea of "vision", either as the French

word that translates to English as “eyesight” or as a homonym for the English word “view”.

[16] The Applicant’s Mark has a greater degree of inherent distinctiveness than does the Opponent’s mark because its suffix, “wave”, has no apparent meaning that is relevant to the Applicant’s wares or services.

[17] A trade-mark may acquire distinctiveness through use or promotion, but neither party has filed evidence to show use or promotion of its mark. While it is true that the Opponent’s registration issued on the basis of a declaration of use, at most this entitles me to assume *de minimis* use of the Opponent’s trade-mark [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.)]. *De minimis* use does not support a conclusion that the mark has become known to any significant extent.

length of time each trade-mark has been in use

[18] A consideration of the length of time that each mark has been in use technically favours the Opponent, but I do not consider this factor to be significant since there is no evidence that the Opponent continued to use its mark after it filed its declaration of use.

nature of the wares, services, business or trade

[19] When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties’ trade-mark application or registration that govern in respect of the issue of confusion arising under s. 12(1)(d) [*Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe, Inc. v. Dale Bohna* (1984), 58 C.P.R. (3d) 381 (F.C.A.)].

[20] According to the parties’ statements of wares and services, both parties appear to be in the eye care business; they both sell contact lenses. In the absence of evidence to the contrary, it is reasonable to conclude that their channels of trade, like their wares, could overlap.

degree of resemblance between the trade-marks

[21] ACUVUE and ACCUWAVE only resemble each other to the extent that their first two syllables are phonetically equivalent. Although the first portion of each party's mark (ACU and ACCU) might suggest the word "accurate", their very different endings result in there being little resemblance between the marks in ideas suggested.

other surrounding circumstances

[22] At the oral hearing, the Applicant's agent presented me with a copy of an OHIM decision concerning an opposition between the present parties with respect to the Applicant's Mark. As stated in *Vivat Holdings Ltd. v. Levi Strauss & Co.* (2005), 41 C.P.R. (4th) 8 (F.C.) at paragraph 65, "evidence of foreign opposition on unproven records under foreign law is not probative." I have therefore accorded no weight to the OHIM decision.

conclusion

[23] In the circumstances of this case, I am satisfied that the differences between the final components of each mark are sufficient that confusion between the marks as a whole is not likely. I note that while the trade-marks must be assessed in their entirety, it is still possible to focus on particular features that may be a determinative influence on the public's perception [see *Pink Panther Beauty Corp. v. United Artists Corp.* (1998), 80 C.P.R. (3d) 247 (F.C.A.) at para. 34] and that, in the case of weak marks, small differences may suffice to distinguish one mark from the other [see for example: *GSW Ltd. v. Great West Steel Industries Ltd. et al.* (1975), 22 C.P.R. (2d) 154 (F.C.T.D.); *Associated Brands Inc. v. Scott Paper Ltd.* (2004), 43 C.P.R. (4th) 361 (T.M.O.B.)].

[24] While the first component of a mark is often considered more important for the purpose of distinction, when a word is a common, descriptive word, it is entitled to a narrower range of protection than an invented or unique word [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) and *Park Avenue Furniture, supra*]. It seems inappropriate to grant the Opponent a broad scope of protection in association with the

prefix ACU/ACCU given the suggestive character of that prefix and the fact that the Opponent has not evidenced that its mark has acquired any distinctiveness.

[25] As stated in *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.) at 149, affirmed 60 C.P.R. (2d) 70: “Realistically appraised it is the degree of resemblance between trade marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a subservient role in the over-all surrounding circumstances.” Therefore, even though both parties’ marks are associated with contact lenses, I have concluded that the Applicant’s Mark is sufficiently different from the Opponent’s mark to make confusion unlikely.

[26] The s. 12(1)(d) grounds are therefore dismissed.

Disposition

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

Jill W. Bradbury
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office