

**IN THE MATTER OF AN OPPOSITION
by Shaklee Corporation to application No.
664,066 for the trade-mark LIQUI-E filed
by Twin Laboratories, Inc.**

On August 6, 1990, the applicant, Twin Laboratories, Inc., filed an application to register the trade-mark LIQUI-E for "dietary supplement containing vitamin E" based on use and registration in the United States. The application was advertised for opposition purposes on June 12, 1991.

The opponent, Shaklee Corporation, filed a statement of opposition on October 15, 1991, a copy of which was forwarded to the applicant on December 2, 1991. The grounds of opposition are that the applied for trade-mark is not registrable, the applicant is not the person entitled to registration and the applied for mark is not distinctive because it is confusing with the trade-mark LIQUI-LEA registered under No. 218,447 for "vitamin and mineral dietary food supplement" and previously used by the opponent in association with such wares.

The applicant filed and served a counter statement. As its evidence, the opponent filed a certified copy of its registration No. 218,447. The applicant's evidence comprises the affidavits of Neil Blechman and Linda Thibeault. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented. In its written argument, the opponent withdrew its second ground of opposition and, during the oral hearing, the opponent's agent conceded that the third ground was not supported by the evidence of record.

At the oral hearing, the agent for the applicant contended that the Registrar was "functus officio" respecting the first ground of opposition since the Registrar has already found the applicant's mark to be registrable during the initial examination of the present application and the opponent has done nothing beyond filing a copy of its registration. As noted by the opponent's agent, there is no evidence that the Registrar considered the issue of confusion between the applicant's mark and the opponent's registered mark during the initial

examination of the applicant's application. Even if he had, however, the onus remains on the applicant in opposition proceedings to show that its mark is registrable: see Molson Companies Ltd. v. Carling Breweries Ltd. (1988), 19 C.P.R.(3d) 129 at 130 (F.C.A.).

As for the first ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark pursuant to Section 12(1)(d) of the Trade-marks Act 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 LIQUI-E appears to be derived from the word "liquid" and the designation "E" from vitamin E. Thus, the applicant's mark is suggestive of a liquid dietary supplement containing vitamin E and is therefore an inherently weak mark. The applicant has not evidenced any reputation for its mark in Canada.

The opponent's trade-mark is derived from the word "liquid" and the component "lea" which does not appear to have any meaning associated with the opponent's registered wares. The opponent's mark is therefore inherently distinctive although it is not inherently strong since it suggests that the related wares are in a liquid form. There being no evidence of use of the opponent's mark, I must conclude that it has not become known at all in Canada.

The length of time the marks have been in use in Canada is not a material circumstance in the present case. The wares of the parties are similar since the applicant's statement of wares and the opponent's statement of wares overlap. Presumably the trades of the parties would also be similar.

As for Section 6(5)(e) of the Act, I consider that there is some resemblance in the ideas

suggested by the two marks since they both suggest something liquid. More importantly, the marks at issue bear a fair degree of visual resemblance since both are three-syllable marks commencing with the component LIQUI- and ending with a third syllable comprising or including the letter E. The opponent contends that the degree of phonetic resemblance is even greater since the final syllable of its mark is like such common English words as "pea", "sea" and "tea" and would therefore be pronounced "lee." Webster's New Collegiate Dictionary defines "lea" as grassland or pasture and indicates that the word is pronounced as "lee."

At the oral hearing, the applicant's agent relied on several dictionaries of names which refer to the French given name Léa (pronounced "lay ah") and to the English given name Lea (pronounced "lee ah"). He contended that francophones would be more likely to identify the final syllable of the opponent's mark as the French given name and to pronounce it accordingly.

The relevant test is how the marks at issue would be pronounced by the average bilingual consumer. Given the pronunciation of the English word "lea", given that it is common in the English language for short words formed with the letter combination "ea" to be pronounced with the "ee" sound and given that it is unlikely that the component LEA would be recognized as a given name in the context of the opponent's wares, I consider that it is most likely that the average bilingual consumer would pronounce the opponent's mark as "liqui lee." The degree of phonetic resemblance between the marks at issue would therefore be high.

I consider that it is somewhat less likely that the average bilingual consumer would view the component LEA as a given name. If he did, however, I suspect that he would be more likely to pronounce it as "lee ah" given the fact that the letter E in the opponent's mark is unaccented. Even if the opponent's mark were pronounced in such a fashion, there would still be a fair degree of phonetic resemblance between the marks of the parties.

The applicant has submitted that the significance of any resemblance between the marks is mitigated by the state of the register evidence introduced by means of the Thibeault 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.

The Thibeault affidavit purports to summarize the results of a state of the register search conducted in respect of trade-marks containing the prefix "liqui" applied for or registered in association with "vitamin and mineral dietary food supplements." I have discounted the pending applications located by Ms. Thibeault since almost all of them are based on proposed use and/or cover unrelated wares.

As for the registrations located by Ms. Thibeault, most cover unrelated wares and/or the trade-marks do not commence with the prefix "liqui." My review of the Thibeault search results reveals only two relevant registrations covering the marks LIQUISEAL and LIQUITARD. In the absence of evidence of use of those marks, I am unable to conclude that either is in use to any substantial extent. I am therefore unable to conclude that consumers have become accustomed to seeing such marks in the marketplace such that they would be more likely to differentiate such marks based on their other components.

The applicant also submitted that the contemporaneous use of the two marks at issue in the United States without incidents of actual confusion having arisen is a circumstance suggesting that confusion in Canada is unlikely. However, contrary to the applicant's

submissions, the applicant has not evidenced the use of the two marks at issue in the same area in the United States. Furthermore, the applicant has failed to evidence the extent to which either mark has been used in that country. Thus, Mr. Blechman's observation, in his affidavit, that he has not been aware of any incidents of actual confusion between the two marks in the United States is of no value in this case.

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 similarities between the wares, trades and marks of the parties, I find that the applicant has failed to satisfy the onus on it to show that its mark LIQUI-E is not confusing with the opponent's registered mark LIQUI-LEA. The first ground of opposition is therefore successful.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 31st DAY OF JULY, 1995.

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