



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

Citation: 2011 TMOB 151
Date of Decision: 2011-08-31

**IN THE MATTER OF AN OPPOSITION
by Cook Incorporated to application
No. 1,272,859 for the trade-mark
SILHOUETTE in the name of Applied
Medical Resources Corporation**

[1] On September 21, 2005, Applied Medical Resources Corporation (the Applicant) filed an application to register the trade-mark SILHOUETTE (the Mark) based on the dual basis of proposed use in Canada and registration in United States of America under number 78/603,755 and use in Australia in association with “urological surgical instruments used for ureteral patency, and not used in conjunction with catheter introducers”, as amended (the Wares). The application claimed a priority filing date of April 7, 2005.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of June 13, 2007.

[3] On November 13, 2007, Cook Incorporated (the Opponent) filed a statement of opposition. On January 10, 2008, the Opponent requested leave to file an amended statement of opposition pursuant to r. 40 of the *Trade-marks Regulations* SOR/96-195 (the Regulations) to correct a typographical error. The Opponent was granted leave on February 5, 2008.

[4] The grounds of opposition can be summarized as follows:

- non-compliance with s. 30(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) on the basis that the Mark had not been used in Australia since at least as early as the filing date.

- the Applicant is not entitled to registration of the Mark pursuant to s. 16(2) and 16(3) of the Act since at the date of filing the application for the Mark it was confusing with the Opponent's trade-mark SILHOUETTE which was previously used in Canada by the Opponent and had not been abandoned at the date of advertisement.
- the Mark is not distinctive in that it is not adapted to distinguish and does not actually distinguish the Wares from those of the Opponent, having regard to the use and advertisement by the Opponent of the Opponent's SILHOUETTE trade-mark.

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

[6] In support of its opposition, the Opponent filed an affidavit of Rick Mellinger, sworn September 30, 2008 with Exhibits 1-3 as its evidence pursuant to r. 41 of the Regulations. Mr. Mellinger was not cross-examined on his affidavit.

[7] In support of its application, the Applicant filed the affidavits of Matthew Petrine, sworn May 6, 2009 with Exhibits A to K and Steven Kennedy, sworn May 7, 2009 with Exhibits A to D. Neither affiant was cross-examined.

[8] The Applicant filed an amended application revising the Wares as set out above, on October 1, 2009. The amended application was accepted on November 6, 2009.

[9] Both parties filed written arguments and were represented at an oral hearing.

Opponent's Evidence

Rick Mellinger

[10] Mr. Mellinger is the Vice President of Global Marketing for the Opponent.

[11] Mr. Mellinger states that the Opponent was founded in 1963 and it manufactures and sells health care devices throughout the world. Mr. Mellinger states that among other fields, the Opponent conducts research and development and sells "minimally invasive medical device technology for diagnostic and therapeutic procedures".

[12] Mr. Mellinger states that the Opponent has a number of related companies and that any use of trade-marks owned by the Opponent by these related companies would be under license where the Opponent controls the character and quality of the associated goods and services.

[13] At the oral hearing, the Applicant submitted that Mr. Mellinger's use of the term "Cook" to refer to the Opponent and its related companies, and his failure to specifically identify these related companies is ambiguous and suggests that Mr. Mellinger does not know exactly which entity is using the Opponent's SILHOUETTE trade-mark. Furthermore, the Applicant submitted that Mr. Mellinger's failure to provide an explanation regarding the relationship between the related companies along with Mr. Mellinger's "bald statement" regarding the Opponent's exercise of control should lead to a finding that any use by "Cook" cannot be said to accrue to the Opponent in accordance with s. 50 of the Act.

[14] By contrast, the Opponent submits that while Mr. Mellinger has not specifically set out the steps taken by the Opponent to exert control over the character and quality of the Opponent's Wares, in the absence of internally inconsistent statements by Mr. Mellinger, and in light of the fact that he was not cross-examined, his statements can be taken at face value [see *Abbott Laboratories v. Nu-Life Nutrition Ltd.* (1998), 86 C.P.R. (3d) 505 (T.M.O.B.) at 507 and *Hero v. Gustus* (1997), 77 C.P.R. (3d) 258 at 263 (T.M.O.B.)].

[15] I agree with the Opponent's submissions. I have no reason to doubt Mr. Mellinger's sworn statements that the Opponent controls the character and quality of the associated goods and services. As a result, I am satisfied that any use by the Opponent or its related companies would accrue to the Opponent in accordance with s. 50 of the Act.

[16] Mr. Mellinger's affidavit will be discussed in further detail below in the analysis of the non-entitlement and non-distinctiveness grounds of opposition.

Applicant's Evidence

Affidavit of Matthew Petrime

[17] Mr. Petrime is the Group Vice President of the Applicant. Mr. Petrime states that the Applicant is a highly integrated developer, manufacturer and marketer of specialized devices for Minimally Invasive Surgery, Cardiovascular, Vascular, Urology and General Surgery.

[18] Mr. Petrime states that since the Applicant was founded in 1987 it has been providing “innovative surgical products that enhance procedures and patient outcomes both clinically and economically”.

[19] Mr. Petrime states that he is not aware of any instances of confusion between the parties' businesses as they relate to products bearing the parties' marks in Canada.

[20] Mr. Petrime states that since August 1996 he has attended conferences and trade shows in which the Applicant has participated as well as all of the North American conferences at which the Wares have been promoted by the Applicant to medical professionals from Canada. Mr. Petrime states that to his knowledge the Opponent's SILHOUETTE products were not displayed or advertised by any of the exhibitors at the conferences and trade shows he discusses in his affidavit.

[21] Mr. Petrime's affidavit will be discussed in further detail below in the analysis of the non-entitlement and non-distinctiveness grounds of opposition.

Affidavit of Steven Kennedy

[22] Mr. Kennedy is a student-at-law with the Applicant's agents. Mr. Kennedy attaches to his affidavit a page from the Opponent's website labeled as “Ordering Information” printed May 5, 2009 from www.cookmedical.com/ordering.do (Exhibit A). Mr. Kennedy also attaches to his affidavit pages printed from the website of the *Journal of Urology* located at www.jurology.com (Exhibits B, C) as well as printouts of an online copy of the media kit provided by Elsevier Media Kits for advertising in the *Journal of Urology* (Exhibit D).

[23] Mr. Kennedy, being a student-at-law with the Applicant's agents and not directly knowledgeable regarding the Applicant's business, is not in a position to confirm the accuracy of the contents of the websites attached to his affidavit. Very little weight can be placed on Internet evidence of this nature [see *Candrug Health Solutions Inc. v. Thorkelson* (2007), 60 C.P.R. (4th) 35 (F.C.T.D.), reversed (2008), 64 C.P.R. (4th) 431 (F.C.A.), [*Candrug*]]. As a result, I am not willing to rely on these websites as evidence of the truth of the contents of the statements made thereon [see *Candrug, supra*].

Onus and Material Dates

[24] 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].

[25] The material dates that apply to the grounds of opposition are as follows:

- s. 38(2)(a)/30(d) - the date the application was filed [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 at 475 (T.M.O.B.) and *Tower Conference Management Co. v. Canadian Exhibition Management Inc.* (1990), 28 C.P.R. (3d) 428 at 432 (T.M.O.B.)].
- s. 38(2)(c)/16(2) and (3) - the date of filing the application [see s. 16(2) and (3) of the Act].
- s. 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Section 30(d) Ground

[26] The Opponent alleges that the Applicant has not used its Mark in Australia in association with the Wares prior to the filing date of the present application (September 21, 2005).

[27] The Opponent has not provided any evidence in support of this ground of opposition and furthermore, at the oral hearing, the Opponent conceded that it had failed to meet its evidential burden.

[28] I dismiss the ground of opposition based on s. 30(d) of the Act on the basis that the Opponent has failed to meet its evidential burden.

Non-distinctiveness Ground – s. 38(2)(d) of the Act

[29] I will begin my assessment of the likelihood of confusion by considering the distinctiveness ground of opposition.

[30] In order to meet its initial burden with respect to this ground, the Opponent must establish that its SILHOUETTE trade-mark was known at least to some extent in Canada as of November 13, 2007 [see *Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.) and *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.)].

[31] At the oral hearing, the Opponent acknowledged an omission in its evidence which had been highlighted by the Applicant in its written argument, namely that the Opponent had failed to provide evidence of the SILHOUETTE trade-mark appearing on the Opponent's wares and/or their packaging in order to satisfy s. 4(1) of the Act. I note that s. 4(1) of the Act can also be satisfied by establishing that the mark "is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred". The Opponent submitted that notwithstanding the highlighted evidentiary omission, there is sufficient evidence of record to enable the Opponent to meet its evidential burden.

[32] In his affidavit, Mr. Mellinger states that the Opponent has annual worldwide sales in excess of 500 million and annual Canadian sales in excess of 10 million. He states that the Opponent sells many medical and surgical devices in Canada, including urological instruments. For example, Mr. Mellinger states that the Opponent has sold what he calls the "SILHOUETTE introducers" in Canada since at least as early as 1996. I understand, based on the evidence as a whole, that "SILHOUETTE introducers" are catheter introducers sold under the Opponent's SILHOUETTE trade-mark.

[33] Mr. Mellinger states that the Opponent has marketed its SILHOUETTE introducers to Canadian urologists and interventional radiologists, in a number of ways namely:

- a. representatives from the Opponent visit health care professionals, including, doctors, nurses and surgical technicians at their place of work and describe the Opponent's products and provide them with literature;
- b. literature is also available through the Internet and also provided through trade shows attended by the Opponent's personnel in Canada and elsewhere; and
- c. attendance at a number of conferences (Mr. Mellinger provides a list of such conferences in his affidavit), many of which are located in Canada and according to Mr. Mellinger would be attended by prospective purchasers of the Opponent's SILHOUETTE introducers.

[34] Mr. Mellinger states that every year, at trade shows and through its representatives, the Opponent distributes literature to health professionals including doctors, nurses and surgical technicians who are the purchasers and potential purchasers of the Opponent's SILHOUETTE introducers. Mr. Mellinger attaches to his affidavit a representative sample of literature that has been distributed by the Opponent to purchasers and potential purchasers in Canada (Exhibit 2).

[35] The literature provided in Exhibit 2 to Mr. Mellinger's affidavit is a selection of catalogues for the Opponent's various products as well as website printouts akin to catalogues featuring the Opponent's SILHOUETTE introducers. Mr. Mellinger clearly states that this literature is distributed to the Opponent's prospective customers in Canada. The catalogues range in date from 1994 to 2006 (i.e. 1994, 1999, 2001, 2003, 2004, 2006). The website printouts, which are similar to catalogues in the nature of the information that they provide, were printed in July 2008. I note that all of the sample catalogues are dated prior to the material date.

[36] I note that the catalogues provide photographs of the Opponent's SILHOUETTE introducers alongside the title: "SilhouetteTM Transitionless Peel-Away® Introducers". The catalogues provide "Order Number[s]" for the purpose of enabling customers to order the wares. The catalogues also provide contact information for the Opponent, presumably to enable parties to purchase the wares featured in the catalogues, as follows, "Distributed by: COOK (CANADA) INC. 111 Sandiford Drive, Stouffville, Ontario, L4A 7X5 CANADA Phone: 905 640-7110, Toll Free: 800 668-0300".

[37] The website printouts also feature photographs of the products, the text "SilhouetteTM Transitionless Peel-Away® Introducers" and "Order Number[s]" along with an 800 number to contact the Opponent at the bottom right-hand side of the webpage.

[38] Mr. Mellinger provides annual sales figures for the sale of Opponent’s SILHOUETTE introducers in Canada for years corresponding to the dates of the catalogues and website printouts, as follows:

Year	Sales Dollars (approx.)
1996	960
1997	480
1999	650
2000	1200
2001	3500
2002	1800
2003	7500
2004	5900
2005	7200
2006	5300
2007	16000
2008	2400

[39] The Opponent submits that the Mellinger affidavit is sufficient to support a finding of use of the Opponent’s SILHOUETTE trade-mark in association with the Opponent’s SILHOUETTE introducers, despite the omission of evidence showing the SILHOUETTE trade-mark on the packaging for the wares.

[40] The Applicant submits that the failure of the Opponent to provide evidence showing the SILHOUETTE trade-mark on the Opponent’s SILHOUETTE introducers or their packaging is fatal. I do not agree for the reasons that follow.

[41] As has been conceded by the Opponent, the evidence does not show the SILHOUETTE trade-mark on the Opponent’s SILHOUETTE introducers or their packaging. However, the evidence does show the SILHOUETTE trade-mark displayed in close proximity to the listings of the Opponent’s SILHOUETTE introducers (along with photographs of the Opponent’s SILHOUETTE introducers) in order catalogues. As such, the present circumstances appear similar to *Lapointe Rosenstein v. Elegance Rolf Offergelt GmbH* (2005), 47 C.P.R. (4th) 196

(T.M.O.B.), wherein the Hearing Officer accepted that notice of association between the trade-mark and the wares was made when customers placed orders by way of a catalogue that displayed the trade-mark in close proximity to the wares. In the present case, I am satisfied that customers in Canada are provided with these catalogues from which the Opponent's SILHOUETTE introducers are ordered and that this, in association with sales figures corresponding to the dates of the catalogues, supports a finding that the Opponent has used the SILHOUETTE trade-mark in association with the Opponent's SILHOUETTE introducers in Canada as of the relevant date.

[42] Based on the foregoing, I am satisfied that the Opponent has met its evidential burden.

[43] The onus now shifts to the Applicant to establish that the Mark is distinctive or is adapted to distinguish. Specifically, the onus is on the Applicant to establish that there is no likelihood of confusion between the parties' marks.

[44] 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.

[45] In applying the test for confusion, the Registrar 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.).]

[46] In most instances, the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in

the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2) 145, conf. 60 C.P.R. (2d) 70 (F.C.T.D.)].

[47] Recently, in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 96 C.P.R. (4th) 361 (S.C.C.) [*Masterpiece*], the Supreme Court of Canada discussed the importance of the s. 6(5)(e) factor in conducting an analysis of the likelihood of confusion between the parties' marks in accordance with s. 6 of the Act (see para 49):

...the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis ... if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar... As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start...

[48] Under the circumstances of the present case, I consider it appropriate to analyse the degree of resemblance between the parties' marks first.

s. 6(5)(e) – the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[49] The parties' marks are identical and as a result this factor overwhelmingly favours the Opponent.

[50] Having found that the parties' marks are identical, I must now assess the remaining relevant surrounding circumstances to determine whether any of these other factors are significant enough to shift the balance of probabilities in favour of the Applicant [see *Masterpiece, supra* at para 49].

s. 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[51] The word "silhouette" has no meaning with respect to either party's wares and as a result, the parties' marks, being identical, possess the same high degree of inherent distinctiveness.

[52] As the strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use, I will now turn to the extent to which the trade-marks have become known in Canada.

[53] In his affidavit, Mr. Petrimé states that the Applicant sells its products in the USA, Africa, the Middle East, the Americas (including Canada), the Caribbean, Asia, Australia and Europe.

[54] Mr. Petrimé states that the Mark is prominently featured on the packaging for the Wares. Mr. Petrimé attaches photographs of the packaging which he states are representative of the manner in which the Mark has been used and is used in association with the Wares in Canada since September 2006 (Exhibit B, C, D).

[55] In his affidavit, Mr. Petrimé states that the Applicant has sold the Wares around the world, including in Canada, since 2006. Mr. Petrimé provides a chart of approximate total revenue figures for North America and Canada for 2006-2009. The Canadian sales figures are as follows:

Year	Approximate sales in Canada (USD) (in excess of)
2006	700
2007	2,400
2008	9,000
2009 (projected)	18,000

[56] Mr. Petrimé attaches to his affidavit copies of invoices evidencing sales in Canada of the Wares bearing the mark from 2006 to 2009 (Exhibit G).

[57] Mr. Petrimé states that the Applicant has extensively advertised and continues to extensively advertise the Wares across North America including in Canada through various means, for example:

- a. participation in industry trade shows and medical conferences;
- b. advertising in medical publications;
- c. catalogues;

- d. brochures;
- e. website exposure; and
- f. distribution of press releases.

[58] Mr. Petrimé states that the Applicant's total advertising expenditures in North America including to Canadians since 2006 has been in excess of \$200,000.

[59] Mr. Petrimé states that the Applicant has advertised the Wares in various medical publications available and subscribed to across the world, including Canada. Mr. Petrimé attaches to his affidavit a sample of advertisements placed in *Journal of Endourology*, *Journal of Urology* and *Urology Times* in 2006 (Exhibit H). Mr. Petrimé states that these publications were at the time the advertisements were placed in them, and continued to be at the time he swore his affidavit, widely available and subscribed to by medical professionals from across the globe including Canada practicing in urology.

[60] Mr. Petrimé states that since approximately December 2005 the Applicant has provided significant exposure and information regarding the Wares on the Applicant's websites. Mr. Petrimé attaches to his affidavit excerpts from these websites as accessed by customers in Canada featuring the Wares current to the date of swearing his affidavit and from 2006 and 2007 (Exhibit I).

[61] Mr. Petrimé states that the Applicant's websites receive a significant number of "hits". For example, Mr. Petrimé states that the Applicant's website located at *www.appliedmed.com* (created on April 10, 1998) receives an average of 6000 hits per month and approx 75000 hits per year.

[62] Mr. Petrimé states that since approximately December 2005, an Applied Medical Catalogue that includes the Wares has been accessible in Canada on the Applicant's websites. Mr. Petrimé attaches to his affidavit excerpts from the 2006 and 2008 catalogues as accessible in Canada on the Applicant's websites (Exhibit J).

[63] Mr. Petrimé states that since 2005, the Wares have been marketed and promoted to medical professionals from North America including Canada at urology conferences.

[64] Mr. Petrimé states that the Applicant has undertaken significant advertising at conferences attended by medical professionals from Canada at which the Wares have been promoted. Mr. Petrimé attaches to his affidavit a sample of photographs from urology conferences in 2006 and 2007 attended by medical professionals from Canada featuring the Applicant's promotional displays for the Wares (Exhibit K).

[65] Based on the foregoing, I am satisfied that the Applicant has acquired a reputation for the Mark since approximately December 2005 when the Applicant began promoting its Wares on its website.

[66] As set out above, the Opponent has provided evidence of sales and promotion of the Opponent's SILHOUETTE introducers since as early as 1996.

[67] Based on the foregoing, this factor favours the Opponent.

s. 6(5)(b) – the length of time each has been in use

[68] The application for the Mark is based on proposed use as well as foreign registration and use. As discussed in further detail above in the analysis of the s. 6(5)(a) factor, the Applicant has evidenced use of the Mark in association with the Wares in Canada since 2006.

[69] The Opponent provides evidence that its SILHOUETTE mark has been used in Canada since as early as 1996.

[70] Based on the foregoing, this factor favours the Opponent.

s. 6(5)(c) – the nature of the wares

[71] Mr. Petrimé states that the Wares are:

...sophisticated ureteral patency devices utilized only by highly trained surgeons during and for urology-related surgeries – soft, indwelling, coil reinforced, tubular devices that are inserted into the lumen of a ureter (a duct) in order to, for example: (1) support urine drainage through obstructed or strictured ureters, (2) prevent obstruction in the ureter due to surgical edema or following accidental or planned ureteral perforation/incision and (3) provide urine drainage and a scaffold for a

healing ureter. They are the fastest growing replacement of conventional ureteral stents.

[72] Mr. Petrimé states that unlike the Opponent's introducers, which are used by doctors, nurses and other medical personnel for non-surgical and non-urological procedures, the Wares are only used and inserted by highly trained surgeons during and for urology-related surgeries.

[73] The Opponent has established that its trade-mark SILHOUETTE has been used in association with catheter introducers which can be used for urological purposes. Mr. Mellinger states that since at least as early as 1996, these introducers have been used as urological instruments and by interventional radiologists. Specifically, Mr. Mellinger states that these introducers are used to perform the "Seldinger Technique" which is a technique used "to obtain safe access to hollow organs within the body". Mr. Mellinger summarizes the technique as follows, "first a hollowed needle is inserted into the patient, then a guided wire is inserted into the middle of the needle. The needle is then removed and an introducer is inserted over the guide wire and the guide wire is then withdrawn. The introducer is then used to introduce catheters or stents, for example."

[74] Mr. Mellinger also attaches to his affidavit material printed from Wikipedia regarding the Seldinger Technique. At the oral hearing, the Applicant submitted that the Wikipedia entry made no mention of the Seldinger Technique being used for urological purposes. I do not find this to be determinative, however, as I am satisfied that Mr. Mellinger's sworn statements are sufficient to enable me to accept that the Opponent's SILHOUETTE introducers are used for urological purposes.

[75] Mr. Mellinger states that it is also worth noting that the Opponent is well known in the urological field. Mr. Mellinger attaches to his affidavit a catalogue providing an indication of the many different types of urological products sold by the Opponent in Canada (Exhibit 3). Annual sales of urological products in Canada by the Opponent are in excess of \$3 million. I note that the Opponent's SILHOUETTE trade-mark is not present in this catalogue.

[76] The Applicant made substantial submissions in both its written argument and at the oral hearing attempting to make fine distinctions between the nature of the parties' wares. The Applicant's submissions are based in part on Mr. Petrimé's statements that the Wares differ

from the Opponent's catheter introducers because the Wares are indwelling and cannot be used in connection with, or inserted by, catheter introducers or the Seldinger Technique. Mr. Petrimé states that catheters cannot be placed through the lumen of the Wares.

[77] I am not persuaded by the Applicant's submissions on this point. Rather, I am of the view that both parties' wares being medical devices, share some degree of similarity. Furthermore, I am satisfied that in order to find an overlap in the nature of wares in the present case it was sufficient that the parties' medical devices are both used in the same medical specialty area (i.e. urology) regardless of whether or not the parties' wares are identical or could be used together.

[78] Based on the foregoing, this factor favours the Opponent.

s. 6(5)(d) – nature of the trade

[79] With respect to the nature of the trade, the Applicant relies on statements from Mr. Petrimé that the Wares are only available in Canada by order via the Applicant's Canadian distributor, Southmedic, located in Barrie, Ontario. Mr. Petrimé attaches to his affidavit excerpts from Southmedic's website located at www.southmedic.com (Exhibit F). At the oral hearing, the Applicant submitted that it was relevant to note that the Opponent's wares were not distributed through Southmedic and that as a result the parties' trades do not overlap.

[80] I do not agree. The evidence is clear that both parties' wares are medical devices which are sold to healthcare institutions. Given the overlap in the nature of the wares and their intended consumers and in the absence of restrictions on the nature of the Applicant's trade, I find that the channels of trade could overlap. The fact that the Opponent sells its wares directly to its customers and not through the distributor Southmedic is not determinative.

[81] Given that the parties' wares both belong to the general class of medical devices, and in the absence of any restrictions regarding channels of trade in the specification of the Wares, I am satisfied that the parties' channels of trade would likely overlap.

[82] The Applicant also submitted that, due to the technical nature of the parties' wares and the target customers being highly trained medical professionals, additional care will be taken to avoid a likelihood of confusion.

[83] I am not persuaded by the Applicant's submissions on this point. The test for confusion is one of first impression [*Polo Ralph Lauren Corp. v. United States Polo Assn.* (2000), 9 C.P.R. (4th) 51 (F.C.A.)]. Any subsequent steps taken by highly trained consumers in an attempt to remedy any such first instance confusion are irrelevant [by analogy see paragraphs 68-74 of *Masterpiece, supra*]. Regardless of the level of sophistication or training of the parties' target consumers, the fact remains that these consumers will be confronted with the identical trade-mark being used in association with the same type of wares (i.e. medical devices for urological purposes). Under the circumstances, a consumer, no matter how sophisticated, with an imperfect recollection of the Opponent's Mark, might, on first impression, reasonably infer that the Applicant's Wares share the same source as the Opponent's SILHOUETTE introducers.

[84] Based on the foregoing, this factor favours the Opponent.

Conclusion

[85] Despite the fact that the Applicant's evidence supports a finding that the Mark had developed a reputation in Canada in association with the Wares since approximately 2005, I am not satisfied that this reputation is sufficient to shift the balance of probabilities in favour of the Applicant. Particularly in view of the fact that the Opponent had developed a reputation in Canada for an identical mark in association with similar wares since approximately 1996.

[86] Having considered all of the surrounding circumstances, in particular the fact that the parties' marks are identical and that there is overlap in the nature of the parties' wares, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's SILHOUETTE mark.

[87] Based on the foregoing, I find that the non-distinctiveness ground of opposition is successful.

Non-entitlement Grounds – Sections 16(2) and (3) of the Act

[88] Despite the onus of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's

SILHOUETTE trade-mark, the Opponent has the initial onus of proving that the trade-mark alleged in support of its grounds of opposition based on s. 16(2) and (3) of the Act was used in Canada prior to the filing date for the Applicant's application (April 5, 2007, the priority filing date) and had not been abandoned at the date of advertisement of the application for the Mark (June 13, 2007) [s. 16(5) of the Act].

[89] As discussed in more detail above in the analysis of the non-distinctiveness ground of opposition, I am satisfied that the Mellinger affidavit provides sufficient evidence to support a finding that the Opponent's SILHOUETTE trade-mark was in use as of the priority filing date and had not been abandoned as of the date of advertisement for the Mark.

[90] The considerations under the non-entitlement grounds are essentially the same as those under the non-distinctiveness grounds. Furthermore, the earlier material date for the non-entitlement ground has the effect of weakening the Applicant's position as it prevents the Applicant from relying on its evidence of use and reputation for the Mark. Based on the foregoing, and in view of my earlier conclusion that, based on the evidence of record, there is a likelihood of confusion between the parties' marks, the grounds of opposition based on s. 16(2) and (3) of the Act are also successful.

Disposition

[91] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office