

**IN THE MATTER OF AN OPPOSITION by
Jurak Holdings Ltd. to Application
No. 1,000,611 for the trade-mark JURAK filed
by Matol Biotech Laboratories Ltd.**

On December 23, 1998, Matol Biotech Laboratories Ltd. filed an application for registration of the trade-mark JURAK (the “Mark”). The application is based on proposed use in Canada in association with the following wares and services:

Wares: (1) minerals and vitamins preparations. (2) food supplements namely vitamin-enriched drinks; (3) Meal replacement bars, soya/flax bars and snack bars; (4) non- alcoholic beverages namely fruits juice, fruits drink, vegetables juice, vegetables drink and soft drink; (5) pharmaceutical preparations and products namely mineral and vitamin supplements; (6) dietary food products namely meal replacement shakers; (7) cosmetics namely soaps, toilet soap, bath oil, bath salts, bath foaming mousse, shower gel, shampoos, hair mousse, hair gel and hair conditioners; (8) skin care products namely cleansing lotion, cleansing cream, skin soap, tonic for the skin, moisturizing lotions, rejuvenating cream, night cream, toning lotion for the face, mask, revitalizing moisturizer for the shower, lotion for body and hands, cream for body and hands, lotion for feet, tanning accelerator, tanning cream, tanning oil, after tanning lotions, protective cream for the lips, balm for the lips, powder.

Services: (1) multi-level marketing; (2) manufacture, wholesale and direct selling and distribution of food products, food supplements, cosmetics, pharmaceuticals preparations and products for others on order.

The application was advertised in the *Trade-marks Journal* of April 5, 2000. Jurak Holdings Ltd. (the “Opponent”) filed a statement of opposition on August 8, 2000.

The first ground of opposition is that the application does not comply with the requirements of s. 30 of the *Trade-marks Act* R.C.S. 1985, c. T-13 (the “Act”) in that the Applicant could not have been satisfied that it was entitled to use the Mark as it had knowledge that JURAK is primarily merely a surname of an individual who is living or has died within the preceding thirty years and is therefore not registrable and incapable of functioning as a trade-mark. The second ground of opposition is that the Mark is not registrable pursuant to s. 12(1)(a) since it is primarily merely a surname of an individual who is living or has died within the preceding thirty years. The third ground of opposition is that the Mark is not distinctive in that it does not distinguish and is not adapted to distinguish the Applicant’s wares and services from the wares and services

of others since it is primarily merely a surname of an individual who is living or has died within the preceding thirty years.

The Applicant filed a counter statement. Both parties have filed evidence, written arguments and were represented at the oral hearing.

While the ultimate legal burden is always upon the Applicant, 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 Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); *Dion Neckwear Ltd. v. Christian Dior, S.A.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)]. I will therefore review the evidence.

Opponent's Rule 41 evidence

It consists of an affidavit of Arlene E. Siderius dated July 4, 2001 (the "first Siderius affidavit"). Ms. Siderius has been cross-examined and the transcript of her cross-examination forms part of the record. Rather than summarizing her cross-examination, I will refer to any portions that I consider relevant to my analysis of the evidence.

Ms. Siderius, a legal assistant with the Opponent's trade-mark agents, introduces into evidence the results of Internet searches that she conducted on June 28 and July 3, 2001. She provides as Exhibits "A" to "C" printouts of her searches of three websites for Canadian telephone and address directories with respect to the surname Jurak. The Canada 411 website (Exhibit "A") discloses 25 entries. The two other websites disclose respectively 25 entries (Exhibit "B", p. 13 of the cross-examination transcript) and 24 (Exhibit "C"). Ms. Siderius also provides pages of websites relating to Ed Jurak (Exhibits "D-1" to "D-3") and to Professor Ljudevit Jurak (Exhibits E-1 to E-4). While the Opponent apparently seeks to rely on these websites to establish some measure of public recognition of Jurak as a surname in Canada, I find that they are of no assistance to the Opponent's case. These exhibits may prove that the sites existed on the World Wide Web at the time of the searches, but they clearly do not evidence that the two individuals are known, or were known at any relevant time, in Canada. In addition to the hearsay deficiency

of Ms. Siderius' testimony based on the content of the websites, they clearly cannot serve as evidence of her allegation that these two individuals are famous people.

Applicant's Rule 42 evidence

It consists of an affidavit of Robert Brouillette dated May 24, 2002. Mr. Brouillette has been cross-examined and the transcript of his cross-examination and reply to undertakings form part of the record. Rather than summarizing his cross-examination, I will refer to any portions that I consider relevant to my analysis of the evidence.

Mr. Brouillette, a partner with the agents for the Applicant, deposes that on April 30, 2002 he sent a letter (Exhibit RB-1) to all individuals with the surname Jurak listed in the first Siderius affidavit. I note that the listing corresponds to Exhibit "B" to the first Siderius affidavit (reply to undertaking E-1). The letter enquired as to whether the recipient had knowledge of Karl Jurak, Ed Jurak or Prof. Dr. Ljudevit Jurak and asked for any further information concerning the recipient's family roots. Five persons responded to the letter. Four persons indicated not knowing Karl Jurak, Ed Jurak and Prof. Dr. Ljudevit Jurak (Exhibits RB-4 and RB-5, reply to undertaking E-6). The fifth person, Bruno Jurak, indicated being the grandson of Ljudevit Jurak, a scientist living in Zagreb, Croatia (reply to undertaking E-4). Three letters have been returned by the Post Office (Exhibits RB-2, RB-3 and RB-6; reply to undertaking E-3).

Opponent's Rule 43 evidence

It consists of copies of an affidavit of Anthony Carl Jurak dated October 1, 2002, of an affidavit of Arlene E. Siderius dated November 4, 2002 (the "second Siderius affidavit"), and of an affidavit of Glen E. Berg dated November 4, 2002. The original of each affidavit has been filed by the Opponent in an opposition to Application No. 1,004,415 for the trade-mark KARL JURAK filed by the Applicant on February 5, 1999.

The Applicant did not object to the form in which the affidavits have been filed, i.e. photocopies, but the Applicant did object to the affidavits being accepted in the present opposition because they relate to another opposition. Furthermore, the Applicant submitted that if accepted in the present opposition, the affidavits should be disregarded because they do not constitute proper

evidence pursuant to Rule 43. Accordingly, I should first consider whether these affidavits are acceptable in the present opposition. If so, then I should consider whether they constitute proper evidence in reply to the Applicant's evidence.

In considering whether these affidavits are acceptable in the present opposition, I acknowledge that the Registrar has accepted copies of affidavits filed in other opposition proceedings where the circumstances of the case justified such a course of action [see *Beachcombers Restaurant Ltd. v. Vita-Park Citrus Products Co.* (1976), 26 C.P.R. (2d) 282 (T.M.O.B.)]. In this regard, I note that (a) whether or not the parties are the same; (b) whether or not the trade-mark applied for is the same; (c) the availability of the deponents for cross-examination; and (d) whether or not all or most of the issues in both proceedings are the same, are amongst the circumstances that have to be considered [see *Springwall Sleep Products Ltd. v. Ther-A-Pedic Associates, Inc.* (1984), 79 C.P.R. (2d) 227 (T.M.O.B.)].

The co-pending opposition involves the same parties as applicant and opponent. Since the Opponent has filed the affidavits in the co-pending opposition, I find it is reasonable to conclude that the deponents could have been made available for cross-examination in the present opposition. The trade-marks are not the same, but they both involve the term JURAK. The Opponent has failed to file any submissions on whether all the issues, or most of them, are the same in both proceedings. At the hearing, the Opponent's agent argued that these affidavits are relevant to the present opposition because they clearly show, or at least the Jurak affidavit does, that Jurak is a surname in Canada. I believe the Opponent's argument is not without merit in considering whether the evidence is relevant to the issues in the present proceedings. Having considered the overall circumstances, I am willing to accept that the photocopies of the three affidavits filed in opposition proceedings to Application No. 1,004,415 be filed as affidavits in the present proceedings. I should now consider their acceptability as Rule 43 evidence.

In its written argument, the Opponent submits that the Brouillette affidavit introduced into evidence the Applicant's attempt to learn more about the name Jurak by asking individuals with that surname information concerning their family roots. As such, its evidence "*...is proper reply evidence in a broad sense and provided additional information concerning the surname Jurak. It*

is in the interest of justice to accept this reply evidence.” (my underlining). The Applicant argues that the affidavits do not respond or deal in any way to matters raised in its evidence since not a thing in it turns on the question as to whether Jurak is a surname in Canada.

I want to first address the Opponent’s argument regarding the “interest of justice” by reminding the Opponent of Rule 46(1) that allows for the filing of additional evidence with leave from the Registrar. Generally speaking, leave will be granted if the Registrar is satisfied that it is in the interest of justice to do so having regard to all the surrounding circumstances. The only consideration in deciding on the acceptability of evidence filed pursuant to Rule 43 is whether it is strictly confined to matter in reply to the Applicant’s evidence. With all due respect for the Opponent, its argument that the evidence provided additional information regarding the surname Jurak only supports the Applicant’s submission that the affidavits, if acceptable, should have been filed as part of the Opponent’s evidence in chief. In my view, the Opponent is unfairly splitting its case by seeking to rely on Rule 43 to introduce evidence that should have been filed as part of its evidence in chief. I find that the affidavits do not constitute proper reply evidence and I shall disregard their content [see *Prouvost S.A. v. Haberdashers Ltd.* (1987), 18 C.I.P.R. (3d) 232 (T.M.O.B.)].

For all intent and purposes, I note that even if these affidavits were to be considered as evidence under Rule 43, I would at best accept to consider the content directly relating to Karl Jurak because it is one of the individuals named in the Applicant’s letter (Exhibit RB-1). I would disregard any other evidence for not being strictly confined to matter in reply to the Applicant’s evidence. According to my analysis of these affidavits, which follows, I would not afford any weight to the evidence that I would accept under Rule 43. Thus, even if I have erred in accepting the affidavits in the present opposition or if I have erred in refusing them as evidence under Rule 43, the overall outcome of the present case would be the same. I should add that any of my comments on the affidavits are made in the context of the present opposition, and not in the context of the opposition to Application No. 1,004,415.

The Jurak affidavit

Mr. Jurak is the Opponent's President and the Chairman and CEO of Jurak Corporation World. He is also the son of Karl Jurak, "*a brilliant inventor and a leader in the field of herbal medicine, who passed away in 1993*". The affidavit is divided in three parts, i.e. paragraphs 2 to 47: *Karl Jurak as a Famous Person*; paragraphs 48 to 52: *References to "Jurak" on the Opponent's Products and Materials*; and paragraphs 53 to 60: *References to "Karl Jurak" on the Applicant's Products*. From the outset, I would find that the second and third parts of the affidavit do not qualify as proper reply evidence. As for the first part, I would disregard most of the allegations and corresponding exhibits because they mostly deal with The Dr. Karl Jurak Foundation or with evidence that, if material to the issue in the present opposition, should have been filed as evidence in chief. Suffice to say that the allegations that I would accept as evidence in reply would not cause me to conclude that Karl Jurak has a significant public reputation in Canada, although he may be known in the field of herbal medicine.

The second Siderius affidavit

I would accept the printout of pages from websites that "*refer to Karl Jurak and discuss his life and many accomplishments*" but I would find that they may only serve as evidence that the sites existed on the World Wide Web when Ms. Siderius accessed them. They certainly cannot serve as evidence of the allegations contained therein. I would find that in addition to the hearsay deficiency of Ms. Siderius' statements based on the content of the websites, there is no evidence with respect to the extent to which Canadians would have accessed the websites, at any time whatsoever. I would find the reference to Dr. Karl Jurak in a book to be of no value to the Opponent's case because we do not know when and where the book has been published or how many copies would have circulated in Canada, if any. Finally, I would disregard the copy of the affidavit obtained from the file relating to Application No. 1,004,415, the copies of Application No. 863,444, No. 863,443 and No. 1,004,414, and the copies of partial file history relating to these applications on the grounds that they do not constitute proper reply evidence.

The Berg affidavit

Mr. Berg, a library technician employed by the Opponent's trade-mark agents, introduces into evidence the results of his search of the Publications Library of the InfoGlobe – Dow Jones

Interactive database to locate all articles with the words “Karl” and “Jurak”, or “Carl” and “Jurak”, in combination. Copies of the search summary report and of the full text of each article are appended as exhibits to the affidavit. Although I would accept this evidence, I would remark that Mr. Berg’s statement that the database includes articles from 6000 different newswire services, newspapers, magazines and trade journals is by no means evidence that any of the data originate from Canada. Further, according to my cursory review of the summary report, the search turned up 41 articles that were mostly published in *Tulsa World* and *The Tulsa Tribune*, whereas there is no evidence of their circulation in Canada.

Analysis of the grounds of opposition

I find that Exhibit “A” to the first Siderius affidavit is clearly sufficient for the Opponent to discharge its burden of evidencing that Jurak is a surname of a living individual in Canada. Since all the pleaded grounds of opposition turn on the surname issue, I shall now consider whether the Applicant has met its ultimate burden of proving that none of the grounds of opposition should prevent registration of the Mark.

Section 30

The material date for considering the circumstances with respect to the ground of opposition based upon non-compliance with s 30(i) is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)]. I believe it is reasonable to conclude that the results of the Canada 411 search would have been roughly the same, if not identical, if the search had been conducted on or before the material date [December 23, 1998].

The search by itself falls far from establishing that the Applicant was aware of the surname connotation attaching to Jurak nor does it evidence that the Applicant did not truthfully make the statement required by Section 30(i). I therefore dismiss the first ground of opposition as pleaded.

Section 12(1)(a)

I consider the filing date of the application as the material date for deciding on the s. 12(1)(a) ground of opposition. As such, I agree with the reasoning of my colleagues in *Calvin Klein*

Trademark Trust v. Wertex Hosiery Inc. (2005) 41 C.P.R. (4th) 552 and *Waterford Wedgwood PLC v. Forma-Kutzscher GmbH* (S.N. 1,013,012, January 9, 2006).

In considering this ground of opposition, I am guided by the comments of Mr. Justice Cattanach in *Gerhard Horn Investments Ltd. v. Canada (Registrar of Trade Marks)* (1983), 73 C.P.R. (2d) 23 (F.C.T.D.) at p. 30:

“The first and foremost consideration is whether the word or words sought to be registered in the name is the name or surname of a living individual or an individual who has recently died.

It is when that condition precedent is satisfied, and only then, that consideration need be given to the question whether the trade mark applied for is “primarily merely” a name or surname rather than something else.”

While I agree with the Opponent that there is no evidence that the Mark has any connotation other than a surname, the question that needs to be answered is whether a person in Canada of average intelligence and average education in English or French would respond to the Mark as being primarily merely the surname of a living individual.

I agree with the Opponent’s submission that there may be a number of individuals sharing the same surname within a family with one phone line, but I disagree with its submission that 25 listings show that Jurak is a fairly common surname. I find that the Opponent’s evidence establishes that the Mark is a relatively rare surname throughout most of Canada, although some minor recognition of the Mark as a surname may be inferred based on telephone listings. Furthermore, the Opponent has not adduced any evidence that would point to a significant public recognition of Jurak as a surname in Canada. In my view, the Opponent’s evidence does not support the conclusion that the majority of Canadians, or even the majority in one province, that would recognize "Jurak" as a surname would be greater than the number of Canadians who would react to "Jurak" by thinking of it as an invented word.

Having regard to the evidence of record, I find that a person in Canada of ordinary intelligence and of ordinary education in English or French would be as likely, if not more likely, to respond to the Mark by thinking of it as a brand of some business as to respond to the Mark by thinking

of it as being a surname of one or more individuals [see *Standard Oil Company v. The Registrar of Trade Marks*, (1968) 55 C.P.R. 49] Therefore, I dismiss the second ground of opposition.

Distinctiveness

It is generally accepted that the material date for that ground of opposition is the filing date of the statement of opposition, i.e. August 8, 2000 [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

In *Clarco Communications Ltd. v. Sassy Publishers Inc.* (1994), 54 C.P.R. (3(d)) 417 (F.C.T.D.), at p. 428, Mr. Justice Denault commented as follows:

“While distinctiveness is quite often determined as part of an evaluation of whether the proposed trade mark is confusing with another trade mark...it is possible to refuse an application for registration on the basis of non-distinctiveness independent of the issue of confusion, provided the ground is raised in opposition...The quality of distinctiveness is a fundamental and essential requirement of a trade mark and the ground of the lack of distinctiveness may be raised in opposition by any person and may be based on a failure to distinguish or to adapt to distinguish the proposed trade mark from the wares of others.”

The difference in the relevant dates does not affect my analysis that a person in Canada of average intelligence and average education in English or French is as likely, if not more likely, to react to the Mark by thinking of it as a brand or coined word. Therefore, I dismiss the last ground of opposition.

Conclusion

Having regard to the foregoing, and with the authority delegated to me under s. 63(3) of the Act, I reject the Opponent’s opposition pursuant to s. 38(8) of the Act.

DATED AT MONTREAL, QUEBEC, THIS 3rd DAY OF MARCH 2006.

Céline Tremblay
Member
Trade-marks Opposition Board