

TRADUCTION/TRANSLATION

IN THE MATTER OF AN OPPOSITION by
Allergan Inc. to application No. 1176432 for
the trade-mark BELLATOX filed by Camille
Toutounghi

On May 12, 2003, Camille Toutounghi (the “Applicant”) filed an application for the registration of the trade-mark BELLATOX (the “Mark”) for proposed use in Canada in association with the following wares and services, as amended on March 18, 2004:

[TRANSLATION]

Cosmetic namely a topical anti-wrinkle cream and a topical anti-wrinkle patch. Retailing and wholesaling of topical anti-wrinkle cream, retailing and wholesaling of topical anti-wrinkle patch.” (the “Wares and Services”)

The application was advertised on May 12, 2004, in the *Trade-marks Journal*.

On June 28, 2004, Allergan Inc. (the “Opponent”) filed a statement of opposition against that application. At paragraph 4 of the introduction to this statement of opposition, the Opponent alleges that it holds several trade-marks in Canada, including the following registered trade-marks and a pending application, which have been in continuous use since as early as the dates stated in those registrations and application, namely:

1. BOTOX registered under TMA576,141 obtained on February 21, 2003, in association with the following wares: *(1) Pharmaceutical preparations for the treatment of smooth muscle disorders, headaches, wrinkles; hyperhydrosis, sports injuries, namely, injured or torn skin, muscle, ligaments or bone; tremors, namely, spasmodic smooth, striated or cardiac muscles; and pain, namely, smooth muscle pain, striated muscle pain, cardiac muscle pain, neuropathic pain, inflammatory pain, visceral pain, chronic pain, acute pain, traumatic injury pain, referred pain, growing pain, hunger pain, intractable pain,*

labour pain, organic pain, phantom limb pain, postprandial pain, psychogenic pain, back pain, post-stroke pain, cancer pain, nociceptive pain, headache pain, prostatic pain, and bladder pain (2) *Pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, nerve disorders, spasmodic striated, smooth or cardiac muscles* (3) *Pharmaceutical preparations for the treatment of cerebral palsy*. This registration alleges that the mark has been used in Canada since at least as early as May 5, 1992, in association with wares (2) and July 7, 1999, in association with wares (3). A declaration of use of the mark in Canada in association with wares (1) was filed on February 13, 2003;

2. BOTOX registered under TMA415,382 obtained on August 13, 1993, in association with the following wares: *Pharmaceuticals for the therapeutic treatment of neurologic disorders and muscle dystonias*. A declaration of use of the mark in Canada in association with the wares was filed on February 24, 1993;
3. ALLERGAN BOTOX registered under TMA427,565 obtained on May 20, 1994, in association with the following wares: *Pharmaceuticals for the therapeutic treatment of neurological disorders and muscle dystonias; transportable battery operated electromyogram machine and amplifiers for same; fluid injection needles for medical use; medical kits containing fluid injection needles*. A declaration of use of the mark in Canada in association with the wares was filed on February 28, 1994;
4. BOTOX COSMETIC registered under TMA572,207 obtained on December 12, 2002, in association with the following wares: *Pharmaceutical preparations for alleviating wrinkles and sweating*. A declaration of use of the mark in Canada in association with the wares was filed on December 4, 2002. This registration disclaims the right to the exclusive use of the word “COSMETIC” apart from the trade-mark;
5. BOTOX COSMETIC registered under TMA576,177 obtained on February 21, 2003, in association with the following wares: *Pharmaceutical preparations for alleviating wrinkles and sweating*. A declaration of use of the mark in Canada in association with the

wares was filed on February 13, 2003. This registration disclaims the right to the exclusive use of the word “COSMETIC” apart from the trade-mark;

6. BOTOX COSMETIC & Design (reproduced below) registered under TMA572,616 obtained on December 18, 2002, in association with the following wares: *Pharmaceutical preparations for alleviating wrinkles and sweating*. A declaration of use of the mark in Canada in association with the wares was filed on December 12, 2002. This registration disclaims the right to the exclusive use of the word “COSMETIC” apart from the trade-mark;



7. BOTOX COSMETIC & Design (reproduced below) registered under TMA576,267 obtained on February 24, 2003, in association with the following wares: *Pharmaceutical preparations for alleviating wrinkles and sweating*. A declaration of use of the mark in Canada in association with the wares was filed on February 13, 2003. This registration disclaims the right to the exclusive use of the word “COSMETIC” apart from the trade-mark;



8. IT'S NOT MAGIC, IT'S BOTOX & Design (reproduced below) registered under TMA579,977 obtained on April 28, 2003, in association with the following wares: *Pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles;*

hyperhydrosis; cerebral palsy, sports injuries, namely, injured or torn skin, muscle, ligaments or bone; tremors namely, spasmodic striated, smooth or cardiac muscles; and pain, namely, smooth muscle pain, striated muscle pain, cardiac muscle pain, neuropathic pain, inflammatory pain, visceral pain, chronic pain, acute pain, traumatic injury pain, referred pain, growing pain, hunger pain, intractable pain, labour pain, organic pain, phantom limb pain, postprandial pain, psychogenic pain, back pain, post-stroke pain, cancer pain, nociceptive pain, headache pain, prostatic pain, and bladder pain. A declaration of use of the mark in Canada in association with the wares was filed on April 8, 2003;

It's not magic, it's
The logo for BOTOX, featuring the word "BOTOX" in a stylized, serif font. The letter "B" is significantly larger and more prominent than the other letters, and it has a thick, black, curved underline that sweeps under the "O" and "T".

9. BOTOX BOTULINUM TOXIN TYPE A PURIFIED NEUROTOXIN COMPLEX & Design (reproduced below) registered under TMA576,151 obtained on February 21, 2003, in association with the following wares: (1) *Printed educational materials, namely books, brochures, pamphlets, guides, outlines, charts and manuals*(2) *Pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles; hyperhydrosis; cerebral palsy, tremors, namely spasmodic striated, smooth or cardiac muscles; and pain, namely, smooth muscle pain, striated muscle pain, cardiac muscle pain, neuropathic pain, inflammatory pain, visceral pain, chronic pain, acute pain, traumatic injury pain, referred pain, growing pain, hunger pain, intractable pain, labour pain, organic pain, phantom limb pain, postprandial pain, psychogenic pain, back pain, post-stroke pain, cancer pain, nociceptive pain, headache pain, prostatic pain, and bladder pain.* This registration alleges that the mark has been used in Canada since at least as early as June 29, 2000, in association with wares (1). A declaration of use of the mark in Canada in association with wares (2) was filed on February 13, 2003. This registration disclaims the right to the exclusive use of the words “BOTULINUM TOXIN TYPE A” and “PURIFIED NEUROTOXIN COMPLEX” apart from the trade-mark;



10. BOTOX & Design (reproduced below) registered under TMA605,687 obtained on March 18, 2004, in association with the following wares: *Pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles; hyperhydrosis; cerebral palsy, sports injuries, namely, injured or torn skin, muscle, ligaments or bone; tremors, namely, spasmodic smooth, striated or cardiac muscles; and pain, namely, smooth muscle pain, striated muscle pain, cardiac muscle pain, neuropathic pain, inflammatory pain, visceral pain, chronic pain, acute pain, traumatic injury pain, referred pain, growing pain, hunger pain, intractable pain, labour pain, organic pain, phantom limb pain, postprandial pain, psychogenic pain, back pain, post-stroke pain, cancer pain, nociceptive pain, headache pain, prostatic pain, and bladder pain.* A declaration of use of the mark in Canada in association with the wares was filed on February 27, 2004;



11. BOTOX, the subject of application for registration No. 1,208,906 filed on March 9, 2004, in association with the following wares: *Cosmetics; namely, face creams and lotions, skin creams and lotions.* This application is based on the alleged use of the mark in Canada since as early as February 13, 2003. I note that this application has since been allowed and was in fact registered on April 19, 2005, under TMA637,689.

The grounds of opposition may be summarized as follows:

1. The application does not fulfill the requirements of section 30(i) of the *Trade-marks Act* (R.S.C. 1985, c. T-13, as amended) (the Act) in that the Applicant cannot be satisfied in all good faith that he is entitled to use the Mark in Canada in association with the Wares and Services based on his knowledge of the Opponent's marks listed above and previously used in Canada by the Opponent;
2. Having regard to the provisions of section 12(1)(d) of the Act, the Mark is not registrable in that it is confusing with the Opponent's registered marks;
3. The Applicant is not the person entitled to register the Mark having regard to the provisions of section 16(3)(a) of the Act because the Mark is confusing with the Opponent's registered and applied-for marks listed above and used prior to the filing date of the application; and
4. The Mark is not distinctive of the Applicant's Wares and Services within the meaning of section 2 of the Act in that the Mark is not adapted to distinguish and does not actually distinguish the Applicant's Wares and Services from the Opponent's wares in association with which the Opponent's marks are used.

On November 9, 2004, the Applicant filed a counter statement denying all of the grounds of opposition.

The Opponent's evidence is as follows:

Evidence in chief filed on June 9, 2005

- Affidavit of Dr. Kevin Smith (dermatologist practising in the city of Niagara Falls, in Canada), sworn May 27, 2005, and its attached exhibits "A" and "B";
- Affidavit of Alan Chan (Marketing Manager for BOTOX COSMETIC products for the Opponent in Canada), sworn June 6, 2005, and its attached exhibits "A" to "E";

- Affidavit of Jason Herod (Product Manager for “BOTOX” botulinum toxin type A for the Opponent in Canada), sworn May 27, 2005, and its attached exhibits “A” and “B”;
- Affidavit of Tonia Morgan (Law Clerk with the firm representing the Opponent for the purposes of this opposition), sworn June 9, 2005, and its attached exhibits “A” to “D”;
- Affidavit of Amy McFeely (Trade-mark Searcher with the firm representing the Opponent for the purposes of this opposition), sworn June 6, 2005, and its attached exhibits “A” and “B”.

Reply evidence filed on March 30, 2006

- Affidavit of Angela Hiscock (Trade-mark Searcher with the firm representing the Opponent for the purposes of this opposition), sworn March 27, 2006, and its attached exhibits “A” and “B”.

The Applicant’s evidence in chief consists of the Applicant’s own affidavit, sworn December 16, 2005, and its attached exhibits “A” to “Q” (hereinafter the “Applicant’s first affidavit”). The Applicant also obtained permission to file as additional evidence a second affidavit of his own, sworn December 28, 2005, including exhibit “A”. Where one of the parties’ evidence arises from arguments rather than facts that are relevant to this matter, I focussed my analysis on those relevant facts.

Both parties filed written arguments and took part in an oral hearing.

Analysis

General principles and relevant dates

The legal burden is upon the Applicant to show that his or her application complies with the provisions of the Act, but there is however an initial evidential onus 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. Once this initial onus is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent

the registration of the Mark [see to this effect *Massimo De Berardinis v. Decaria Hair Studio* (1984), 2 C.P.R. (3d) 319 (T.M.O.B.); *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.); *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, (1984) 3 C.P.R. (3d) 325; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al*, (2002), 20 C.P.R. (4th) 155 (F.C.A.); and *Wrangler Apparel Corp. v. The Timberland Company*, 2005 FC 722].

The relevant dates for assessing the circumstances of each of the grounds of opposition in this case are the following:

- Ground based on section 30 of the Act: 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.)];
- Ground based on section 12(1)(d) of the Act: the date of my decision [see to this effect *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- Ground based on section 16(3)(a) of the Act: the filing date of the application; and
- Ground based on the non-distinctiveness of the Mark: generally accepted as being the filing date of the statement of opposition [see to this effect *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

I will now analyze the grounds of opposition in regard to the evidence filed in this case, without necessarily respecting the order in which they were raised in the statement of opposition.

i) Ground based on section 12(1)(d) of the Act

The Opponent discharged its initial burden of proof by filing, in support of the affidavit of Tonia Morgan, certificates of authenticity for each of the ten (10) registrations alleged in the statement of opposition.

I will focus my analysis on the Opponent's BOTOX (word and design versions) and BOTOX COSMETIC (word and design versions in French and English) marks (hereinafter collectively "BOTOX and BOTOX COSMETIC marks"), which appear to be the most relevant in this

matter. Also, unless otherwise stated, I will not attach any importance to the marks BOTOX BOTULINUM TOXIN TYPE A PURIFIED NEUROTOXIN COMPLEX & Design, IT'S NOT MAGIC, IT'S BOTOX & Design, and ALLERGAN BOTOX, which appear to be the least relevant and moreover unnecessary in assessing the likelihood of confusion in this matter.

Because of this evidence by the Opponent, the Applicant must establish on a balance of probabilities that there is no likelihood of confusion between the Mark and the Opponent's marks.

The test for confusion is one of first impression and imperfect recollection. According to section 6(2) of the Act, the 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.

In determining whether trade-marks are confusing, the Registrar shall have regard to all the surrounding circumstances, including those listed at section 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 the trade-marks have 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. This list is not exhaustive, and different circumstances will be given different weight in a context-specific assessment [see to this effect *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321; and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al* (2006), 49 C.P.R. (4th) 401, [2006] 1 S.C.R. 824].

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

The Mark consists of one coined word with no particular meaning, although the word "BELLATOX" is a contraction of the words "BELLADONNA TOXIN", i.e. the name of the toxin from which the Wares associated with the Applicant's Mark are manufactured, as will be

explained below. Therefore, I am of the opinion that the Mark does have a certain inherent distinctiveness.

Given the total lack of evidence of use or promotion of the Mark, I cannot find that the Mark became known in any way in Canada, which therefore does not increase the distinctiveness of the Mark.

Turning to the Opponent's marks, they all consist of the coined word "BOTOX", which has no particular meaning either (although the word "BOTOX" seems to be a contraction of the words "BOTULINUM TOXIN", i.e. the name of the toxin produced by the bacterium *Clostridium botulinum*, from which the products associated with the Opponent's marks are manufactured, as will be explained below), used alone or in combination with other design elements and/or the word "COSMETIC" (or "COSMÉTIQUE"). Therefore, I am of the opinion that the Opponent's marks have an inherent distinctiveness equivalent to that of the Applicant's Mark.

However, the Opponent's BOTOX and BOTOX COSMETIC marks have become known, even very well known, in Canada, which, under the circumstances, increases the distinctiveness of the Opponent's marks and favours the Opponent in the assessment of this first factor.

The affidavit of Alan Chan and its attached exhibits indicate that the Opponent (together with its subsidiaries) is a pharmaceutical company specializing in the development and marketing of pharmaceutical products in ophthalmology, movement disorders and dermatology.

More specifically, Alan Chan alleges that the Opponent is the world leader in botulinum toxin type A therapy and holds the largest market share in this respect in Canada.

Botulinum toxin type A blocks the release of acetylcholine at the neuromuscular junction, thereby preventing or limiting muscle contractions, and is used in various types of cosmetic or therapeutic treatments.

Alan Chan explains in his affidavit that the Opponent markets botulinum toxin type A under two marks, namely, the BOTOX and BOTOX COSMETIC marks. The BOTOX mark is used to market therapeutic products, while the BOTOX COSMETIC mark is used to market cosmetic products.

Still according to Alan Chan, BOTOX products have been approved by Health Canada for various therapeutic uses, including the treatment of strabismus (since 1990), blepharospasm (since 1990), cervical dystonia (since 1995), talipes equinus in children with cerebral palsy (since 1999), axillary hyperhidrosis (excessive underarm sweating) (since 2001) and focal spasticity (since 2001).

BOTOX COSMETIC products were approved by Health Canada in 2001 for the treatment of glabellar lines. According to Alan Chan's affidavit, other aesthetic applications are being studied for the treatment of facial wrinkles and crows' feet. The products for cosmetic use are marketed primarily to dermatologists, plastic surgeons and other physicians working in aesthetic medicine.

Later on, I will return to the nature of the Opponent's products and business when assessing the third and fourth factors.

Still considering Alan Chan's affidavit, the sales of BOTOX COSMETIC products in Canada exceeded 44 million Canadian dollars between 2001 and May 2005, namely, 4 million in 2001, 8 million in 2002, 11 million in 2003, 15 million in 2004 and 6 million up to May 2005 (the amounts provided in that respect were lower than the actual amounts to maintain confidentiality). During that period, the Opponent spent more than 13 million dollars in advertising and marketing in Canada for those products; the amounts allocated for advertising and marketing were also provided for each year and were lower than the actual amounts to maintain confidentiality. In this respect, the Opponent filed varied and extensive samples of promotional material, advertising, news features, and newspaper and magazine articles in French and English that circulated in Canada during that period; it also produced excerpts from its Internet site,

“allergan.ca”. This material was filed largely in support of Alan Chan’s affidavit, with the remainder in support of Tonia Morgan’s affidavit.

On that point, it would be appropriate to note that Alan Chan alleges that the Opponent purchased advertising space in various media such as radio, television, consumer magazines, billboards and bus shelters and that it sponsored various events for women to promote its BOTOX and BOTOX COSMETIC marks. To this effect, Alan Chan filed several specimens of printed advertisements displaying the mark BOTOX COSMETIC & Design (or its French version) including those circulating in February 2004 in the magazines “Toronto Life” and “Canadian House & Home” (for which the circulation figures in Canada were provided by Tonia Morgan, who obtained them from the “Audit Bureau of Circulation” – I will return to this point later), an undated specimen of a bus shelter advertisement displaying the mark BOTOX COSMETIC & Design, as well as a CD-ROM containing three specimens of televised commercials featuring stars Ben Stiller, Kim Katrall and Nathalie Cole. Specifically with respect to these three televised advertisements, they display and broadcast the marks BOTOX COSMETIC and IT’S NOT MAGIC, IT’S BOTOX COSMETIC & Design and are alleged to have been broadcast between February and April 2002 on City TV during the program “Fashion Television” hosted by Jeanne Beker. The broadcast of these televised advertisements is not corroborated by any evidence. Thus, I am not prepared to give any weight to this evidence filed by the Opponent. It should also be noted that no specimen of billboard advertising, radio advertising or advertising at events for women was filed into evidence and that some of the specimens of promotional material and advertisements filed by the Opponent are undated.

Alan Chan also filed a copy of a report prepared by the firm “National Public Relations” dated May 31, 2002, and entitled “BOTOX Cosmetic™ 2002 Second Interim Media Coverage Report”. This report provides, among other data, the names of the media (print, radio, television and online) in which the Opponent’s BOTOX COSMETIC mark had allegedly been mentioned from March to May 2002. I have some difficulty admitting this report into evidence given that it should have been filed by its author rather than by Mr. Chan. This report also contains some inaccuracies regarding the manner in which the BOTOX COSMETIC mark had allegedly been mentioned. I will therefore give no weight to this evidence by the Opponent.

It would be appropriate to point out the significant number of magazine and newspaper articles published in 2001 and 2002 dealing with the Opponent's BOTOX products, primarily those for cosmetic use and incidentally those for therapeutic use, and filed in evidence by the Opponent, including articles in "Newsweek", "The Globe and Mail", "The Toronto Star", "The Toronto Sun", "Ottawa Citizen", "The Windsor Star", "The Gazette", "Le Journal de Montréal", "Le Journal de Québec", "The Vancouver Sun", "The Calgary Sun", "The Calgary Herald", "The Edmonton Journal", "The Leader Post" (Regina, SK), "Cape Breton Post", "The Telegram" (St. John's, NL), and "Elle Canada", to name but a few. The circulation figures for many of these newspapers and magazines were provided by Alan Chan or Tonia Morgan. As filed, these figures must be taken as hearsay (the same can be said for the figures discussed above in regard to the magazines "Toronto Life" and "Canadian House & Home"). Nevertheless, I have no difficulty in taking judicial notice of the fact that most of these newspapers and magazines have some circulation in Canada [see to this effect *Northern Telecom Ltd. v. Nortel Communications Inc.* (1987), 15 C.P.R. (3d) 540 (T.M.O.B.)]. I would add in closing on this aspect of the evidence that most of these magazine and newspaper articles corroborate to a certain extent Alan Chan's allegations regarding the growing popularity and the commercial success of BOTOX products in Canada since they were launched for cosmetic purposes in 2001.

Still according to Alan Chan's allegations, there was no other botulinum toxin-based product on the Canadian market in May 2005. Alan Chan estimates in that regard that approximately 120,000 Canadians have tried a BOTOX COSMETIC treatment.

The Opponent also filed the affidavit of Dr. Kevin Smith, who has given several conferences on botulinum toxin type A and the Opponent's products. Dr. Smith began treating patients with BOTOX and BOTOX COSMETIC products for therapeutic and cosmetic purposes in June 2001. He has thus carried out more than 4,000 treatments. He generally treats between 20 and 40 patients per week with these products. He estimates that he has purchased 2,900 vials of BOTOX and BOTOX COSMETIC products from the Opponent since 2001 (totalling approximately one million dollars).

Add to this Jason Herod's affidavit, which also alleges that the Opponent holds the largest market share in Canada for botulinum toxin therapy and which provides the sales figures in Canadian dollars for BOTOX products (for therapeutic purposes) for 2000 to 2004, namely, 8 million in 2000, 11 million in 2001, 15 million in 2002, 19 million in 2003 and 24 million in 2004 (this last amount is an estimate based on the projected sales, and all of the amounts provided are lower than the actual amounts to maintain confidentiality) as well as representative samples of promotional brochures and pamphlets in French or English describing BOTOX products for therapeutic use.

In support of Alan Chan's affidavit, the Opponent also filed excerpts of a survey carried out by the firm "IFOP Canada Market Research" to establish the Canadian public's growing awareness of the BOTOX mark between June 2000 and December 2002. I am not prepared to give any weight to this survey given that it was not filed into evidence by a qualified expert and that it is impossible for me to determine whether this survey was properly designed and conducted in an impartial manner [see to this effect *Mattel, supra*, also discussing the admissibility of survey evidence]. For example, none of the questions asked during the telephone interviews conducted for the survey are attached to the survey.

In any event, even without this survey, I am of the opinion that the Opponent has established that its BOTOX and BOTOX COSMETIC marks are known, indeed very well known, in Canada. I would add in this regard that the Applicant himself acknowledged the fame of the Opponent's BOTOX marks in his written argument (cf. "*widespread consumer awareness of the BOTOX marks also diminishes the possibility of confusion between BOTOX and BELLATOX*") and at the oral hearing, by describing the marks as being "*extremely well-known*", for example.

(b) the length of time the trade-marks have been in use

This factor favours the Opponent, given the total lack of evidence of use of the Mark in Canada.

(c) the nature of the wares, services or business; and (d) the nature of the trade

Considering the nature of the wares and/or services and the nature of the trade, I must compare the wording of the Wares and Services in the application for registration with the wording of the wares in the registrations referred to by the Opponent [see to this effect *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.)]. However, these descriptions must be read with a view to determining the parties' probable type of trade rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful [see to this effect *McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.); *Procter & Gamble Inc. v. Hunter Packaging Ltd.* (1999), 2 C.P.R. (4th) 266 (T.M.O.B.); *American Optional Corp. v. Alcon Pharmaceuticals Ltd.* (2000), 5 C.P.R. (4th) 110 (T.M.O.B.)].

The "cosmetic" branch of the Opponent's products discussed above is worded in one of the following manners: "*Pharmaceutical preparations for alleviating wrinkles and sweating*" or "*Pharmaceutical preparations for the treatment of . . . wrinkles*". The "therapeutic" branch of the Opponent's products discussed earlier is worded in various ways, including "*Pharmaceuticals for the therapeutic treatment of neurological disorders and muscle dystonias*" and "*(1) Pharmaceutical preparations for the treatment of smooth muscle disorders, headaches, wrinkles; hyperhydrosis, sports injuries, namely, injured or torn skin, muscle, ligaments or bone; tremors, namely, spasmodic smooth, striated or cardiac muscles; and pain, namely, smooth muscle pain, striated muscle pain, cardiac muscle pain, neuropathic pain, inflammatory pain, visceral pain, chronic pain, acute pain, traumatic injury pain, referred pain, growing pain, hunger pain, intractable pain, labour pain, organic pain, phantom limb pain, postprandial pain, psychogenic pain, back pain, post-stroke pain, cancer pain, nociceptive pain, headache pain, prostatic pain, and bladder pain (2) Pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, nerve disorders, spasmodic striated, smooth or cardiac muscles (3) Pharmaceutical preparations*". These descriptions include the treatments discussed in the affidavits of Alan Chan and Jason Herod.

As discussed above, Alan Chan's affidavit indicates that the BOTOX COSMETIC products were approved by Health Canada in 2001 for the treatment of glabellar lines and that other aesthetic applications are being studied for treating facial wrinkles and crows' feet. Alan Chan states that the products for cosmetic use are primarily marketed to dermatologists, plastic surgeons and other physicians working in the field of aesthetic medicine.

BOTOX products for therapeutic use were approved by Health Canada for various uses, including the treatment of strabismus, blepharospasm, cervical dystonia, talipes equinus in children with cerebral palsy, axillary hyperhidrosis and focal spasticity. Jason Herod's affidavit indicates that products for therapeutic use are marketed through educational brochures and pamphlets given to patients and physicians, and at training programs, special events in the field of medical education, conferences, symposiums and information kiosks at conferences.

BOTOX and BOTOX COSMETIC products are sold in vials, which are themselves packaged in individual boxes, such as those shown in the photographs filed in support of Alan Chan's affidavit. The vials and the boxes bear the design versions of the BOTOX and BOTOX COSMETIC marks. As it is a toxin that is best known for causing food poisoning (botulism) when taken in large quantities, botulinum toxin type A BOTOX is manufactured under very tightly controlled laboratory conditions and is administered in extremely small doses, as explained in the promotional brochures and pamphlets filed in support of the affidavits of Alan Chan or Jason Herod.

More specifically, the BOTOX (or BOTOX COSMETIC) toxin is administered to patients by a medical practitioner through intramuscular needle injections. The practitioner must locate and inject the proper muscles. By blocking the release of acetylcholine, the toxin inhibits the transmission of the electrical signal emitted by the brain to the muscles. Consequently, the muscles do not receive the message to contract (the muscular action that causes wrinkles is weakened or blocked depending on the dose administered), resulting in a temporary paralysis that lasts a number of months before gradually disappearing.

By comparison, the Wares and Services associated with the BELLATOX Mark consist of cosmetics, namely, a topical anti-wrinkle cream and topical anti-wrinkle patch, as well as retailing and wholesaling of topical anti-wrinkle creams and topical anti-wrinkle patches. As stated earlier, the Wares associated with the BELLATOX Mark are manufactured from a toxin. The Applicant explains in his first affidavit that this toxin comes from a plant named “*Atropa belladonna*” and that this toxin, like the Opponent’s botulinum toxin, acts at the neuromuscular junction. However, the Applicant adds in his first affidavit that these two toxins and their respective mechanisms of action are completely different. As pointed out earlier, no evidence was filed regarding use of the Mark in association with the Wares and Services. Typically, one could expect these types of wares to be sold in cosmetic departments or at cosmetic counters in stores or pharmacies. As for wholesale services, one could expect them to be marketed to those same cosmetic departments or counters and to beauty clinics, among others, although I note that the Applicant alleges only in his written argument that the BELLATOX products “*are to be sold exclusively through retail outlets*”.

BOTOX products are “pharmaceutical” products (to be administered by medical practitioners to well-informed patients) rather than “cosmetic” products, strictly speaking. However, both the BOTOX products and the Applicant’s Wares aim specifically to alleviate wrinkles for aesthetic purposes, among other things, and they both target, to a certain extent, the same clientele (namely, women and men worried about the signs of aging), not to mention the fact that both are derived from toxins acting on the neuromuscular junction. In addition, the fact that the “cosmetic” branch of the BOTOX products and the BELLATOX Wares could potentially both be used for cosmetic purposes on the face and be advertised in magazines such as “Canadian House & Home” and “Elle Canada” mentioned earlier suggests a potential overlap of the parties’ products.

(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

As discussed above, the test of confusion is one of first impression. It would now be appropriate to refer to the remarks of Mr. Justice Deneault in *Pernod Ricard v. Molson Breweries* (1992), 44 C.P.R. (3d) 359 (F.C.):

The test of confusion is one of first impression. The trade marks should be examined from the point of view of the average consumer having a general and not a precise recollection of the earlier mark. Consequently, the marks should not be dissected or subjected to a microscopic analysis with a view to assessing their similarities and differences. Rather, they should be looked at in their totality and assessed for their effect on the average consumer as a whole (*Ultravite Laboratories Ltd. v. Whitehall Laboratories Ltd.*, [1965] S.C.R. 734 at p. 737; *Oshawa Group Ltd. v. Creative Resources Co. Ltd.* (1982), 61 C.P.R. (2d) 29 at p. 35 (F.C.A.); *Cantine Torresella S.R.L. v. Carbo* (1987), 16 C.P.R. (3d) 137 at p. 146 (F.C.T.D.)).

The BELLATOX Mark and the Opponent's BOTOX (word and design versions) and BOTOX COSMETIC (word and design versions in French and English) marks have the initial letter "B" and the suffix "TOX" in common. The Opponent also submits that the "BELL" or "BELLA" portion is not unlike the French adjective "*bel*"/"*belle*" [beautiful], which is echoed in the "BO" portion of the BOTOX mark, which is phonetically similar to "*beau*"/"*beauté*" [beautiful/beauty].

Moreover, although on their face the BELLATOX and BOTOX marks are both coined words suggesting no particular idea to the average consumer, each of these marks is a contraction of the name of the toxin from which the parties' respective products are manufactured, as discussed earlier and as stated by the Applicant in his written argument (cf. "*The BELLATOX mark is simply a contraction of the words BELLAdonna and TOXin, as BOTulinum and TOXin were contracted to create the BOTOX marks. Both names simply intend to convey the message that they include toxins in their formulation. BOTOX and BELLATOX share the same derivative nomenclature only because they are both toxins, and only because they both affect nerve-to-muscle transmission. That is the full extent of their similarity as their respective toxins and individual mechanisms of action are completely different*") and in his first affidavit

(cf. “. . . both *BOTOX* and *BELLATOX* intend to convey the idea that they include toxins in their formulation, and they share the same “tox” suffix only because they are both toxins”).

In these circumstances, I am of the opinion that there is a certain degree of resemblance between the trade-marks at issue.

Other surrounding circumstances

- State of the register

Both parties raised the state of the register of the trade-marks in regard to the suffix “TOX”.

After analyzing the various statements and/or arguments filed by the parties, I note that, although the register of trade-marks includes a fair number of trade-marks with the suffix “TOX”, none of those marks involve pharmaceutical or cosmetic products similar to those of the parties. In fact, except for the *DERMOTOX* and *MYOTOX* marks that were successfully opposed by the Opponent (cf. *Allergan Inc. v. Lancôme Parfums & Beauté & Cie, general partnership* (2007), 64 C.P.R. (4th) 147 and *Allergan Inc. v. Lancôme Parfums & Beauté & Cie, general partnership* 2007 CarswellNat 4030), none of the trade-marks identified by the parties are relevant given that they all relate to completely different wares and/or services. Therefore, I am of the opinion that the evidence of the state of the register does not significantly assist either party.

MIRABOTEX mark and other marks identified on the Internet

In support of his first affidavit, the Applicant filed a copy of a default judgment (also filed in support of Alan Chan’s affidavit) that the Opponent obtained in the United States regarding the *MIRABOTEX* mark, submitting that there are differences between that case and this one. I agree with the Opponent that such an argument is irrelevant and does not assist the Applicant in this case, especially since the Opponent was successful in that American case.

Also in support of his first affidavit, the Applicant filed excerpts from Web sites concerning the products allegedly marketed under the *NEUTOX*, *INSTA-TOX*, *DERMATOX* and *NO-TOX*

marks. As filed, these excerpts must be considered to be hearsay. As argued by the Opponent, these excerpts establish no sales, much less indicate by whom, where, when and how these products are allegedly marketed. These excerpts do not assist the Applicant, particularly since some of the products described therein specifically claim to be an “alternative” to the Opponent’s BOTOX products.

- Fame and “family” of trade-marks

The Opponent submits the fame of its BOTOX trade-marks and the fact that they form a “family” of trade-marks as other circumstances that must lead to a finding of confusion between the trade-marks at issue.

As discussed above, the Opponent’s trade-marks that seem most relevant in assessing the likelihood of confusion in this matter are the BOTOX (word and design versions) and the BOTOX COSMETIC (word and design versions in French and English) marks for which relatively ample evidence of use was adduced by the Opponent.

While the Opponent produced certificates of authenticity for the marks “ALLERGAN BOTOX”, “IT’S NOT MAGIC, IT’S BOTOX & Design” and “BOTOX BOTULINUM TOXIN TYPE A PURIFIED NEUROTOXIN COMPLEX & Design”, it did not file any detailed evidence of their use even though it had the burden of doing so in order to argue the existence of a “family” of trade-marks [see to this effect *Techniquip Ltd. v. C.O.A.* (1998), 3 C.P.R. (4th) 298 (F.C.A.)]. In fact, none of the Opponent’s witnesses provide exact data regarding these three trade-marks. Among the excerpts that the Opponent filed of its Internet site, there is at most one isolated reference to the mark BOTOX BOTULINUM TOXIN TYPE A PURIFIED NEUROTOXIN COMPLEX & Design as registered. The only other references to any of these three trade-marks in all of the Opponent’s evidence were variants of the mark BOTOX BOTULINUM TOXIN TYPE A PURIFIED NEUROTOXIN COMPLEX & Design found in some of the Opponent’s brochures and promotional pamphlets, namely, the variants “BOTOX BOTULINUM TOXIN TYPE A HELPING RESTORE FORM AND FUNCTION & Design” or “BOTOX BOTULINUM TOXIN TYPE A THE STRENGTH OF EXPERIENCE & Design” or “BOTOX BOTULINUM TOXIN DU TYPE A AIDE À RÉTABLIR LA FORME ET LA FONCTION &

Design” or “BOTOX COSMETIC BOTULINUM TOXIN TYPE A & Design”, which was found in an advertisement, or the words “(Botulinum Toxin Type A For Injection) Purified Neurotoxin Complex”, found as generic terms on the boxes and vials containing BOTOX and BOTOX COSMETIC products (BOTOX and BOTOX COSMETIC marks identified as such) and the specimens of televised advertisements described above (and not admitted in evidence) for the mark “IT’S NOT MAGIC, IT’S BOTOX COSMETIC & Design”, which also differs from the mark as registered.

Based on the evidence of use of the marks, I would acknowledge that the Opponent holds a family of trade-marks composed of the BOTOX (word and design versions) and BOTOX COSMETIC (word and design versions in French and English) marks rather than a family of marks composed of the suffix “OTOX” or “TOX”.

Returning to the fame of the Opponent’s BOTOX trade-marks, I would acknowledge that, as stated above, they have become very well known in Canada.

Conclusion – likelihood of confusion

Firstly, in view of the fame of the Opponent’s marks and particularly of the fact that, with their growing popularity among the general Canadian public, they have acquired the reputation of being a “cosmetic treatment” rather than merely a “pharmaceutical product”, as shown by the commercial success of the Opponent’s products, and, furthermore, in view of the potential overlap of the parties’ products and the certain degree of resemblance between the marks at issue, especially in the ideas they suggest, I find that the Applicant has not established, on a balance of probabilities, that a consumer with an imperfect recollection of the Opponent’s BOTOX et BOTOX COSMETIC marks would not be likely to infer that the BELLATOX Wares and Services come from the same source or are otherwise related or associated with the Opponent’s products. I am of the opinion that the differences between the marks at issue and their respective products are not enough to counterbalance the arguments above and that the most that can be said in the Applicant’s favour is that the balance of probabilities favours neither

party. Since the legal burden is on the Applicant, I must find in favour of the Opponent. I therefore allow the ground of opposition based section 12(1)(d) of the Act.

(ii) Ground based on section 16(3)(a) of the Act

The Opponent can discharge its initial burden of proof in regard to section 16(3)(a) by establishing that its trade-marks were used or made known in Canada prior to the filing date of the application and that it had not abandoned the use at the date of advertisement of the application [section 16(5)].

For the reasons explained above, I am of the opinion that the Opponent discharged its initial burden in regard to the registrations of the BOTOX (word and design versions) and BOTOX COSMETIC (word and design versions in French and English) marks. However, the Opponent failed to discharge its initial burden regarding the BOTOX mark that is the subject of the application for registration No. 1,208,906, listed as the last item at paragraph 4 of the introduction to its statement of opposition, since it filed no evidence of use in association with the wares listed in that application.

The difference between the relevant dates for the grounds of opposition based on sections 12(1)(d) and 16(3)(a) does not have any significant impact on my conclusions above. I would therefore also allow the ground of opposition based on section 16(3)(a) regarding the registrations cited above.

iii) Ground based on the non-distinctiveness of the Mark

As stated above, the relevant date for considering this ground of opposition, which is also based on the issue of confusion between the Mark and the Opponent's trade-marks, is generally accepted to be the filing date of the statement of opposition.

The Opponent can discharge its initial burden of proof in regard to the Mark's non-distinctiveness by establishing that, at the date of the statement of opposition, its

trade-marks had become sufficiently known in Canada to negate the distinctiveness of the Mark [see to this effect *Motel 6, Inc. v. No.6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.)].

Given the evidence in the record and the fact that the difference between the relevant dates does not have any significant impact on my conclusions above, I would also allow the ground of opposition based on non-distinctiveness.

iv) Ground of opposition based on section 30(i) of the Act

As argued, the ground of opposition based on section 30(i) is incomplete in that it alleges only that the Applicant could not in good faith have been satisfied that he was entitled to use the Mark in Canada in association with the Wares and Services by reason of his knowledge of the prior use in Canada of the Opponent's marks listed at paragraph 4 of the statement of opposition. The alleged knowledge of the Opponent's marks in itself is not a valid ground of opposition.

I would also add that there is no evidence in the record to find that the Applicant could not have been satisfied that he was entitled to use the Mark.

Accordingly, I am of the opinion that the ground of opposition based on section 30(i) must be dismissed.

Conclusion

Having regard to the foregoing and pursuant to the authority delegated by the Registrar of Trade-marks by virtue of section 63(3) of the Act, I reject the application for the registration of the Mark pursuant to section 38(8) of the Act.

DATED AT MONTRÉAL, QUEBEC, THIS 22nd DAY OF JANUARY 2009.

Annie Robitaille
Member, Trade-marks Opposition Board

Certified true translation
Tu-Quynh Trinh