

IN THE MATTER OF AN OPPOSITION
by Bristol-Myers Squibb Company to
application No. 589,552 for the
trade-mark MINERAL ICE filed by The
Mentholatum Company of Canada, Limited

On August 11, 1987, the applicant, The Mentholatum Company of Canada, Limited, filed an application to register the trade-mark MINERAL ICE for "topical analgesics" based on proposed use in Canada. The application was amended to include a disclaimer to the word MINERAL and was subsequently advertised for opposition purposes on April 20, 1988.

Biopractic Group, Inc. ("Biopractic") filed a statement of opposition on May 2, 1988 and a revised statement of opposition on May 30, 1988. A copy of the revised statement was forwarded to the applicant. The applicant filed and served a counter statement. In view of an assignment of trade-mark rights from Biopractic to Bristol Myers Company (now Bristol-Myers Squibb Company), leave was requested to change the opponent in this opposition. Leave was subsequently granted pursuant to Rule 42 of the Trade-marks Regulations to amend the statement of opposition to change the opponent and to add an additional ground of opposition.

The first ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3) of the Trade-marks Act because, as of the applicant's filing date, the applied for trade-mark was confusing with the trade-mark MINERAL ICE previously used in Canada by the opponent's predecessor in title Biopractic with "an external mineral coolant gel for the relief of muscular aches and pains." The second ground is that the applicant is not the person entitled to registration because it is confusing with the trade-mark MINERAL ICE previously made known in Canada by the opponent's predecessor in title. The third ground is that the applied for trade-mark is not distinctive of the applicant in view of the activities of the opponent and its predecessor in title in respect of the trade-mark MINERAL ICE. The fourth ground is that the application does not comply with the provisions of Section 30(i) of the Act in that the applicant could not have been satisfied that it was entitled to use the mark MINERAL ICE in Canada.

As its evidence, the opponent filed the affidavits of Elaine K. Fortmeyer, Aileen M. Sullivan, Ross V. Stokes, Jacques Vaillancourt, Gerry Clinchy, Roland N. Karlen and John Sheedy. The applicant filed no evidence. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

As for the first ground of opposition based on Section 16(3) of the Act, it was incumbent on the opponent to evidence use of its trade-mark MINERAL ICE in Canada by its predecessor in title prior to the applicant's filing date. In view of Section 16(5) of the Act, it was also incumbent on the opponent to show its non-abandonment of its mark as of the applicant's date of advertisement (April 20, 1988). As for the former burden, the Stokes affidavit establishes that Biopractic sold its MINERAL ICE product to its Canadian distributor J. Vaillancourt Corp. Ltee/Ltd. beginning in March of 1982. The Vaillancourt affidavit establishes that the Canadian distributor resold the product in Canada up to February 1983. Thus, the opponent has established prior use of its trade-mark.

The latter burden on the opponent is to show non-abandonment of its mark MINERAL ICE in Canada by its predecessor in title Biopractic. Abandonment of a trade-mark is comprised of non-use and an intention to abandon: see, for example, the decision in Marineland Inc. v. Marine Wonderland (1974), 16 C.P.R. (2d) 97 at 110-111 (F.C.T.D.).

In the present case, the use of the trade-mark MINERAL ICE by Biopractic was discontinued in 1983 and there was no use of the mark in Canada by Biopractic up to and including the applicant's date of advertisement. However, the opponent's evidence does show the following:

(1) Biopractic commenced sales of its MINERAL ICE product in the United States in 1979. There have been continuing and substantial sales in the United States since that date. For example, sales in 1987 were in excess of \$4.5 million.

(2) Biopractic had to discontinue shipping its MINERAL ICE product to its Canadian distributor in 1983 because the Department of Health and Welfare objected to the use of the mark. Biopractic subsequently adopted the trade-mark THERA-ICE for its Canadian packaging. Biopractic shipped its MINERAL ICE product under the trade-mark THERA-ICE into Canada from July 1983 to August 1984 and from May 1987 on (see paragraph 6 of the Stokes affidavit).

(3) Biopractic wished to recommence using its mark MINERAL ICE on its Canadian packaging. Exhibit D to the Stokes affidavit is a copy of a letter dated January 10, 1985 from Biopractic's Board Chairman to the Department of Health and Welfare questioning the Department's original objection and reasserting his company's desire to resume using the trade-mark MINERAL ICE in Canada. Exhibit E to the Stokes affidavit is a copy of a letter dated April 2, 1986 from Mr. Stokes to a Canadian consumer indicating that Biopractic hoped to resume sales in Canada "...under the name of Mineral Ice or Thera Ice."

(4) From 1984 on, both Biopractic and its Canadian distributor associated the trade-marks MINERAL ICE and THERA-ICE in their advertising. For example, Exhibit J to the Vaillancourt affidavit is a Canadian advertising sheet with the notation: "In the U.S.A. THERA ICE is marketed under the trade name MINERAL ICE." According to Mr. Vaillancourt, 15,000 copies of that advertising sheet were distributed in Canada in 1987 and 1988.

(5) Biopractic filed an application to register its trade-mark MINERAL ICE in Canada on April 13, 1988. The application claims use of the mark in Canada since March 9, 1982.

In the present case, there has been a period of non-use of the mark MINERAL ICE in Canada of approximately five years up to and including the applicant's advertisement date. In the absence of any additional evidence, such a lengthy period of non-use would, in most cases, lead to the presumption that the trade-mark owner had abandoned his mark. However, I consider that the evidence in this case establishes an ongoing intention by Biopractic not to abandon the mark MINERAL ICE in Canada. The opponent has therefore met its burden under Section 16(5) of the Act.

The first ground therefore remains to be decided on the issue of confusion as of the applicant's filing date. The onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks. Given that (1) the marks of the parties are identical, (2) the opponent's mark had acquired some reputation in Canada, (3) the nature of the opponent's product falls within the scope of the description "topical analgesics" and (4) the natures of the trades of the parties would presumably be the same, I find that the applicant's mark is confusing with the opponent's mark. The first ground of opposition is therefore successful.

In the event that I am wrong in my conclusion respecting the non-abandonment of the trade-mark MINERAL ICE in Canada by Biopractic, I have also considered the opponent's third ground of opposition. The material time for considering the circumstances respecting a ground of non-distinctiveness is as of the filing of the opposition: see

Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.). Although the onus or legal burden is on the applicant to show that its mark is adapted to distinguish its proposed wares from those of others throughout Canada, there is an evidential burden on the opponent to prove the allegations of fact supporting this ground. In this regard, the opponent need only establish that its trade-mark was known sufficiently in Canada to negate the distinctiveness of the applicant's mark: see Motel 6, Inc. v. No. 6 Motel Ltd. (1981), 56 C.P.R. (2d) 44 at 58.

As noted above, there had been some use of the trade-mark MINERAL ICE in Canada in 1982 and 1983. As also noted, in 1987 and 1988, Biopractic's Canadian distributor circulated about 15,000 copies of an advertising sheet containing a minor reference to the mark MINERAL ICE. The evidence also establishes the following:

(1) A number of issues of the magazine The American Chiropractor contained a full page ad for MINERAL ICE in 1987 and 1988. According to the President of the magazine's publisher, the Canadian circulation of that magazine in 1987 was about 500 per month (see paragraph 3 of the Fortmeyer affidavit).

(2) Biopractic's Canadian distributor placed advertisements in two Canadian trade journals in October of 1987 for the THERA-ICE product. Those advertisements contained the notation that THERA-ICE is marketed in the United States as MINERAL ICE.

(3) The Karlen affidavit establishes that Biopractic widely advertised its MINERAL ICE product in the United States by means of radio advertising. The product was advertised on different American radio networks from 1984 to 1986. From 1987 on, Mr. Karlen's company negotiated ads on various American radio stations having a Canadian audience. The MINERAL ICE ads broadcast on those particular stations were modified slightly to include the following "tag line": "In Canada, ask for THERA-ICE." Typically, the ads mentioned the trade-mark MINERAL ICE five times. Extensive advertising was conducted in this manner from 1987 on. Although there is no direct evidence that these ads were actually heard by Canadian consumers, the fact that they were widely broadcast on American stations with large potential Canadian audiences and the further fact that they were specifically tailored to reach such audiences allow me to conclude that some Canadians heard these ads.

(4) In his affidavit, Mr. Clinchy states that he was responsible for dealing with Biopractic's customer enquiries. He indicates that he received numerous enquiries by letter and telephone about his company's MINERAL ICE product from Canadian consumers for the period November 1985 to 1988. Appended to his affidavit are copies of more than sixty letters of enquiry from consumers throughout Canada. Three of those letters make reference to having heard ads for MINERAL ICE on the radio which, despite the hearsay nature of such evidence, might lend some minor support to my conclusion under (3) above.

In view of the foregoing, I find that the opponent has established that its predecessor in title Biopractic had acquired some reputation for its mark MINERAL ICE in Canada as of the filing of the present opposition. I consider that the opponent has met its burden. The applicant has submitted that the opponent must show that its trade-mark was widely or well known in Canada (see page 9 of the applicant's written argument). However, as discussed above, that is not the standard that the opponent has to meet. The opponent need only show sufficient reputation for its mark in Canada to negate the distinctiveness of the applicant's mark. The applicant having failed to file evidence, I find that it has failed to satisfy the onus on it to show that its proposed mark is adapted to distinguish its proposed wares from those of the opponent's predecessor in title. The third ground of opposition is therefore also successful and the second and

fourth grounds need not be considered.

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

DATED AT HULL, QUEBEC, THIS 29th DAY OF November, 1991.

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