

IN THE MATTER OF AN OPPOSITION by American Cyanamid Company to application No. 685,052 for the trade-mark SPECTRUM FORTE filed by Stanley Pharmaceuticals Ltd., carrying on business under the name and style KSL

On July 10, 1991, Stanley Pharmaceuticals Ltd., carrying on business under the name and style KSL, filed an application to register the trade-mark SPECTRUM FORTE based upon proposed use of the trade-mark in Canada in association with “vitamin and mineral supplements for human consumption”. The applicant disclaimed the right to the exclusive use of the word FORTE apart from its trade-mark.

The application was advertised for opposition purposes in the *Trade-marks Journal* of September 2, 1992 and the opponent, American Cyanamid Company, filed a statement of opposition on February 2, 1993. As its grounds of opposition, the opponent alleged that the applicant’s trade-mark is not registrable and not distinctive, and that the applicant is not the person entitled to its registration, in that the trade-mark SPECTRUM FORTE is confusing with its registered design trade-mark, registration No. 296,086, a representation of which appears below, which had previously been used by the opponent in Canada in association with a “vitamin/mineral preparation”.

Registration No. 296,086

The applicant filed a counter statement in which it denied the allegations of confusion set forth in the statement of opposition. The opponent filed as its evidence the affidavit of Charles A. Butt while the applicant submitted as its evidence the affidavits of Kendra Preston-Brooks and Beth Allard, together with a certified copy of registration No. 408,778 for the trade-mark SPECTRUM. Both parties filed written arguments and, while an oral hearing was requested by the opponent, that request was subsequently withdrawn and the oral hearing which had been scheduled was cancelled by the Board.

With respect to the second ground of opposition based on Section 16(3)(a) of the *Trade-marks Act*, there is an initial burden on the opponent in view of Sections 16(5) and 17(1) of the *Trade-marks Act* to establish its prior use of its design trade-mark in Canada, as well as showing that it had not abandoned its trade-mark as of the date of advertisement of the applicant's application in the *Trade-marks Journal* [September 2, 1992]. Having regard to the Butt affidavit, I am satisfied that the opponent has met this burden. As a result, this ground, as well as the remaining grounds of opposition, remain to be decided on the issue of confusion between the applicant's trade-mark SPECTRUM FORTE and the opponent's design trade-mark.

The material date for considering the non-entitlement ground is the filing date of the applicant's application while the material date for assessing the Section 12(1)(d) ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (FCA)]. Finally, the material time for considering the non-distinctiveness ground is the date of opposition. In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue within the scope of Section 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those which are specifically enumerated in Section 6(5) of the Act. Further, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue.

The applicant's trade-mark SPECTRUM FORTE as applied to "vitamin and mineral supplements for human consumption" and the opponent's design trade-mark as applied to "vitamin/mineral preparation" are inherently distinctive. The present application is based upon proposed use of the trade-mark SPECTRUM FORTE in Canada and no evidence has been furnished by the applicant to establish that its trade-mark has become known to any extent in Canada. On the other hand, the Butt affidavit establishes that Cyanamid Canada Inc., a wholly owned subsidiary of the opponent, has applied the Band Design trade-mark to packaging and labels of its CENTRUM vitamin and mineral products in Canada since as early as July of 1983. In his affidavit, Mr. Butt states that the opponent has direct control over the character and quality of the vitamin/mineral preparation manufactured by his company, the Lederle Division of Cyanamid Canada Inc., and that

the latter manufactures the preparation using specifications and analytical methods for quality control provided by the opponent. Also, according to the affiant, a representative of the opponent makes periodic visits to Cyanamid Canada's plant to check on product manufacture. In paragraph 12 of his affidavit, Mr. Butt provides annual sales figures in Canada of vitamin/mineral preparations bearing the opponent's Band Design trade-mark from 1983 to 1992 inclusive, the total sales being in excess of \$57,000,000 while promotional expenditures during this time exceeded \$8,200,000.

Specimens of packaging and labels bearing the opponent's Band Design trade-mark, together with photocopies of representative invoices relating to sales of its CENTRUM vitamin/mineral preparations, are annexed as exhibits to the Butt affidavit. However, from the specimens annexed to the Butt affidavit, it is apparent that Cyanamid Canada uses the design trade-mark as a secondary mark on packaging and labelling which prominently feature the trade-mark CENTRUM. Nevertheless, both the extent to which the trade-marks at issue have become known and the length of use of the trade-marks of the parties weigh in the opponent's favour.

The applicant's "vitamin and mineral supplements for human consumption" and the opponent's "vitamin/mineral preparation" are closely related, if not identical; and I would expect that the channels of trade associated with these wares could or would overlap.

As for the degree of resemblance between the trade-marks at issue, I consider there to be no similarity in appearance or in sounding between the applicant's trade-mark SPECTRUM FORTE and the opponent's design trade-mark. Further, I do not consider that the average consumer would, as a matter of immediate impression, identify the opponent's design trade-mark as consisting of a "spectrum". Rather, I would expect the average consumer to identify the opponent's mark as consisting of a coloured band or bar. In this regard, I would note that Mr. Butt in his affidavit identifies the opponent's mark as being a Band Design. As a result, I consider there to be no similarity in the ideas suggested by the trade-marks at issue.

As a further surrounding circumstance in respect of the issue of confusion, the applicant has adduced evidence of the state of the register by way of the affidavit of Kendra Preston-Brooks.

However, apart from those trade-marks which cover wares and services completely unrelated to the wares of the parties, the results of the search failed to reveal the existence of any registered trade-marks as applied to vitamins, minerals or similar related wares of particular relevance to this opposition. Moreover, the Allard affidavit introduces into evidence packaging and labelling from four vitamin and mineral products purchased by the affiant in Vancouver. However, the marks appearing on the packages and labels bear little similarity to the trade-marks at issue. As a result, the applicant's state of the register and marketplace evidence is of little assistance in assessing the issue of confusion in this proceeding.

As yet a further surrounding circumstance in respect of the issue of confusion, the applicant adduced evidence of the existence of a trade-mark registration standing in its name for the trade-mark SPECTRUM, registration No. 408,778, covering "vitamin and mineral supplements for human consumption". However, as pointed out by the hearing officer in *Coronet-Werke Heinrich Schlerf GmbH v. Produits Menagers Coronet Inc.*, 4 C.P.R. (3d) 108, at pg. 115, Section 19 of the *Trade-marks Act* does not give the owner of a registration the automatic right to obtain any further registrations no matter how closely the trade-marks may be related to the trade-mark covered in the original registration [see also *Groupe Lavo Inc. v. Proctor & Gamble Inc.*, 32 C.P.R. (3d) 533, at pg. 538]. While the decision of the hearing officer was reversed on appeal [see *Produits Menagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH*, 10 C.P.R. (3d) 482], it was on the basis of new evidence filed on appeal that the applicant had used its previously registered trade-mark in Canada.

In view of the above, and having regard to the absence of any resemblance between the trade-marks at issue in appearance, sounding or ideas suggested, I have concluded that the applicant has met the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between its trade-mark SPECTRUM FORTE and the opponent's design trade-mark.

Having been delegated by the Registrar of Trade-marks pursuant to Section 63(3) of the *Trade-marks Act*, I reject the opponent's opposition pursuant to Section 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC THIS 20TH DAY OF DECEMBER 1996.

G.W.Partington,
Chairman,
Trade Marks Opposition Board.