

**IN THE MATTER OF AN OPPOSITION by
Astra Aktiebolag to
application No. 854,777
for the trade-mark ASTRA
in the name of Astra Futtermittelhandels-GmbH**

On August 29, 1997, the applicant, Astra Futtermittelhandels-GmbH, filed an application to register the trade-mark ASTRA based upon use and registration of the trade-mark in Germany. The applicant claimed a convention priority filing date of March 21, 1997. The application was advertised for opposition purposes in the Trade-marks Journal of June 9, 1999. The wares covered by the application, when advertised, were “agricultural, horticultural and forestry products namely feed for ornamental fish, fertilizer for aquatic plants and filter material produced from chemical, mineral and vegetable, raw and plastic, or ceramic particulars exclusively used for aquatic purposes.”

The opponent, Astra Aktiebolag, filed a statement of opposition on November 9, 1999.

On September 8, 2000, the applicant filed and served a counter statement and also amended its application to remove “fertilizer for aquatic plants” from its statement of wares.

The opponent elected to not file any evidence in support of its opposition.

The applicant filed two affidavits of Roger Paul Britton in support of its application. Mr. Britton, a

trade-mark agent, provides the results of searches that he conducted of the Canadian Trade-marks Register for trade-marks comprising the element ASTRA. He states that he contacted the owners of three ASTRA registered trade-marks and was informed that the products listed in their respective trade-mark registrations were available for purchase in Canada.

Only the applicant filed a written argument.

Although the ultimate legal burden lies on the applicant in opposition proceedings, there is an evidential burden on the opponent to first adduce sufficient evidence to support the truth of its allegations.

Subsection 30(a) Ground of Opposition

This ground of opposition fails because there is no evidence or argument to support the allegation that the application does not contain a statement in ordinary commercial terms of the specific wares.

Subsection 30(e) Ground of Opposition

This ground of opposition fails because subsection 30(e) only applies to applications that are based on proposed use.

Subsection 30(i) Grounds of Opposition

These grounds of opposition fail because there is no evidence in support of the pleading that the applicant was, at the time of the application, aware of the opponent's registered trade-marks.

Paragraph 12(1)(d) Grounds of Opposition

The opponent pleads that the applicant's mark is not registrable because it is confusing with the following nine registered trade-marks, each of which is owned by the opponent:

- 1. ASTRA registered for medicines, chemical products for medicinal purposes, pharmaceutical drugs and preparations, plasters, bandages, material for bandaging, catgut, disinfectants;**
- 2. ASTRANEST registered for pharmaceutical preparations;**
- 3. ASTRA & Design registered for pharmaceutical preparations;**
- 4. ASTRA CARDIOVASCULAR & Design registered for printed matter on medical and pharmaceutical subjects; periodicals, books and photographs, and services of providing information activities on medical and pharmaceutical subjects at exhibitions, congresses, symposia of other conferences;**
- 5. ASTRA MEDITEC registered for medical equipment, namely suction sets and vein strippers;**
- 6. ASTRA STERILE-PACK registered for anaesthetics;**
- 7. ASTRA 1 STEP registered for pharmaceutical bottle caps for use on products of the registrant or its subsidiary or related companies;**
- 8. ASTRA IMPLANT SYSTEM registered for surgical apparatus and instruments for implant operations, bone implants, joint implants, dental implants, inter-oral implant, extra-oral implants;**
- 9. ASTRACAINE registered for local anaesthetics.**

Although the opponent has not evidenced the existence of these registrations, the Registrar does

have discretion to check the register in order to confirm the existence of registrations relied upon by the opponent [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.*, 11 C.P.R. (3d) 410 (T.M.O.B.)]. Having exercised this discretion, I confirm that each of the above registrations is currently in good standing.

The material date with respect to paragraph 12(1)(d) 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 (F.C.A.)]. There is a legal burden on the applicant to establish on a balance of probabilities that there would be no reasonable likelihood of confusion between its mark and each of the registered marks.

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in subsection 6(5) of the Act. Those factors specifically set out in subsection 6(5) are: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. The weight to be given to each relevant factor may vary, depending on the circumstances [see *Clorox Co. v. Sears Canada Inc.* 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

The applicant's mark ASTRA and each of the opponent's registered marks is inherently distinctive.

There is no evidence of the extent to which any of the marks have become known.

If we consider the dates of first use claimed in the registrations, then the registered marks appear to each have been used longer than has the applicant's mark. However, there is no evidence that there has been continuous use of the registered marks.

The nature of the wares associated with the applicant's mark is very different from those associated with the registered marks; the applicant's wares are related to fish and aquatic purposes while the opponent's are medical or pharmaceutical in nature. It is reasonable to assume that the businesses and trades associated with each would also differ.

The degree of resemblance among the marks is very high, ASTRA being either the first or only word in each of the marks.

As a further surrounding circumstance, we have the evidence of other ASTRA trade-marks on the Canadian Trade-mark Register. Of course, state of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [*Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432; *Del Monte Corporation v. Welch Foods Inc.* (1992), 44

C.P.R. (3d) 205 (F.C.T.D.)]. However, the decision in *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.) is support for the proposition that inferences about the state of the marketplace can be drawn from state of the register evidence where large numbers of relevant registrations are located. In the present case, there are sufficient numbers of registrations for trade-marks that either consist solely of the word ASTRA or begin with the word ASTRA owned by a variety of companies that I may accept that the Canadian public is accustomed to distinguishing between one ASTRA mark and another.

Having considered all of the surrounding circumstances, I conclude that the applicant has established on a balance of probabilities that confusion is not likely between ASTRA and each of the registered marks pleaded in the statement of opposition. My conclusion is based primarily on the differences between the parties' fields of interest but also rests in part on the lack of evidence of any reputation having accrued to the opponent's marks and the evidence of ASTRA having been adopted by various parties in diverse fields.

Entitlement Grounds of Opposition

The first arm of these grounds of opposition fails because the opponent has not evidenced any prior use or making known of any of its trade-marks. In addition, it has not established that it had not abandoned its trade-marks as of the date of advertisement of the application as required by section 17 of the Act. The second arm of these grounds of opposition, namely confusion with trade-marks for which applications had been previously filed, will be disregarded because such applications were not in fact pending at the date of advertisement of the applicant's application as required by

subsection 16(4): see *Governor and Co. of Adventurers of England trading into Hudson's Bay, commonly called Hudson's Bay Co. v. Kmart Canada Ltd.*, 76 C.P.R. (3d) 526 at 528.

Distinctiveness Grounds of Opposition

The distinctiveness grounds of opposition fail because the opponent has not met its evidential burden to prove the allegations of fact supporting its grounds of non-distinctiveness, namely that one or more of the trade-marks that it relies upon had become sufficiently known, as of November 9, 1999, to negate the distinctiveness of the applied-for mark. [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.), *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)]

Disposition

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

DATED AT TORONTO, ONTARIO, THIS 21st DAY OF JUNE 2004.

Jill W. Bradbury
Member

Trade-marks Opposition Board