

## TRADUCTION/TRANSLATION



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADE-MARKS

**Citation: 2012 TMOB 92**  
**Date of Decision: 2012-05-22**

**IN THE MATTER OF AN OPPOSITION  
by Paladin Labs Inc. to application  
No. 1,388,419 for the trade-mark  
KAOPECLIN in the name of Vetoquinol  
N.-A. Inc.**

[1] On March 25, 2008, Vetoquinol S.A. filed an application to register the trade-mark KAOPECLIN (the Mark) based on proposed use of the Mark in Canada in association with the following wares: “Veterinary pharmaceutical products, namely oral suspension made from kaolin and pectin for treating diarrhea and enteritis for cattle, calves and horses” (hereafter sometimes referred to as the Wares).

[2] By means of an assignment on August 1, 2008, registered by the Registrar on January 28, 2010, the application was assigned by Vetoquinol S.A. to Vetoquinol N.-A. Inc. I will refer indiscriminately to both corporations as the Applicant.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of May 14, 2008.

[4] Squire Pharmaceuticals Inc. (Squire) filed a statement of opposition against this application on October 14, 2008. Paladin Labs Inc., as Squire’s successor in title, then requested leave to file an amended statement of opposition in order to be substituted for Squire as the

opponent; leave was granted by the Registrar on April 28, 2009. I will refer indiscriminately to both corporations as the Opponent. The grounds of opposition may be summarized as follows:

1. The application does not conform to the requirements of section 30(e) of the *Trade-marks Act*, RSC, 1985, c T-13 (the Act), since, at the date of filing the application in Canada, the Applicant did not intend to use the Mark in Canada in association with the Wares, or, in the alternative, the Mark had previously been used in Canada by the Applicant;
2. The application does not conform to the requirements of section 30(i) of the Act in that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Wares since, at the date of filing the application, the Applicant was well aware of the Opponent's trade-mark KAOPECTATE, described below, which had been used continuously in Canada by the Opponent itself or its predecessors in title;
3. 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 trade-mark KAOPECTATE covered by registration UCA09974 since 1937 for the following wares: "a medicinal preparation to be used in the treatment of intestinal dysfunction";
4. Having regard to section 16(3)(a) of the Act, the Applicant is not the person entitled to the registration of the Mark in that, at the filing date of the application in Canada and at any other relevant date, the Mark was confusing with the Opponent's trade-mark KAOPECTATE, identified above, which had been previously used by the Opponent and had not been abandoned at the date of advertisement of the application;
5. Having regard to section 16(3)(c) of the Act, the Applicant is not the person entitled to the registration of the Mark in that, at the filing date of the application in Canada and at any other relevant date, the Mark was confusing with the trade-name KAOPECTATE, which had been previously used by the Opponent and had not been abandoned at the date of advertisement of the application; and
6. Having regard to the provisions of section 38(2)(d) of the Act, the Mark is not distinctive of the Applicant's Wares in that, at the date of the statement of opposition, the Mark was not (and still is not) adapted to distinguish and did not (and still does not) actually distinguish those wares from the wares and services of others, in particular the wares of the Opponent described above.

[5] The Applicant filed a counter statement denying each and every one of the grounds of opposition.

[6] In support of its opposition, the Opponent filed a certified copy of registration No. UCA09974 for the mark KAOPECTATE and a statutory declaration by Samira Sakhia, the Opponent's Chief Financial Officer, sworn on April 17, 2009. Ms. Sakhia was cross-examined on her statutory declaration. The transcript of her cross-examination and her answers to the undertakings given during that cross-examination were entered in the record. In support of its application, the Applicant filed a statutory declaration by Tom Robitaille, the Applicant's group director for North America, sworn on January 25, 2010, and an affidavit of Johanne Montpetit, a secretary for the firm of lawyers and trade-mark agents representing the Applicant, also sworn on January 25, 2010.

[7] Only the Applicant filed a written argument and participated in an oral hearing.

#### Analysis

[8] The onus is on the Applicant to show that its application meets the requirements of the Act. However, it is up to the Opponent to ensure that each of its grounds of opposition is duly argued and to meet its initial evidentiary burden by establishing the facts used to support its grounds of opposition. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that none of these grounds of opposition prevents the registration of the Mark [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FC); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

[9] Applying those principles to this case, the grounds of opposition based on paragraphs (e) and (i) of section 30 of the Act may be summarily rejected since the Applicant failed to meet its initial burden of proof under the Act.

[10] Specifically with respect to the ground of opposition based on section 30(i) of the Act, where an applicant has filed the statement required by this provision, such a ground should only

succeed in exceptional cases, such as where there is evidence of bad faith on the applicant's part [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. There is no evidence of bad faith on the Applicant's part in this case.

[11] Specifically with respect to the ground of opposition based on section 30(e) of the Act, no evidence was filed that would allow me to conclude that the Applicant, when it filed the present application, did not intend to use the Mark in Canada or, in the alternative, had already started using the Mark. The Applicant's evidence, presented by Mr. Robitaille, does, in fact, confirm this intention. It should also be noted that when cross-examined on this subject, Ms. Sakhia replied that she had no personal knowledge of any fact that would allow the Opponent to allege that the Applicant did not intend to use the Mark in Canada [transcript, pp. 11-12, Q. 23].

[12] The four other grounds of opposition all hinge on the likelihood of confusion between the Mark and the Opponent's KAOPECTATE mark or trade-name. I will begin my analysis of the likelihood of confusion with regard to the ground of opposition based on the non-registrability of the Mark under section 12(1)(d) of the Act.

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

[13] The material date for the ground of opposition based on the non-registrability of a trade-mark as regards its being confusing with a registered trade-mark is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)]. I have exercised my discretion and checked that the Opponent's registration UCA09974 for the mark KAOPECTATE still appears as valid in the Register of Trade-marks. That being so, the Opponent has met its initial burden of proof. The Applicant must now show, on a balance of probabilities, that there is no likelihood of confusion between its Mark and this mark of the Opponent.

[14] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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.

[15] In deciding whether trade-marks are confusing, the Registrar must have regard to all of the surrounding circumstances, including those specifically 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 is not an exhaustive list, and different weight may be given to the various factors depending on the context [see *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401, (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 92 CPR (4th) 361 (SCC)].

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

[16] In his statutory declaration, Mr. Robitaille explains that the Mark was developed by the Applicant's employees and that it was created by placing the prefix "KAO" and the suffix "LIN", both of which come from the word "KAOLIN", around the central syllable "PEC", which comes from the word "PECTIN", the two ingredients in the composition of the Wares. Mr. Robitaille explains that the indirect reference to these two ingredients is used because these ingredients are traditionally known for their antidiarrheal properties, being used as ingredients in antidiarrheal products, and for the mutual reinforcement of these properties when the two ingredients are used together. To this effect, Mr. Robitaille filed Exhibit P-5, a copy of various relevant excerpts from dictionaries and encyclopedias describing the products known in French as "KAOLIN" and "PECTINE", and in English as "PECTIN", "PECTATE DISACCHARIDE-LYASE" and "PECTATE LYASE".

[17] As argued by the Appellant, it is conceivable that the Opponent's mark was created by joining the prefix "KAO", also from the word "KAOLIN", to the word "PECTATE".

[18] Under the circumstances, I agree with the Applicant that the parties' marks, to a certain extent, but each in their own way, call to mind the basic ingredients that generally make up the formulation of the type of products they are associated with. In that respect, I consider that they possess a relatively moderate, equivalent degree of inherent distinctiveness, albeit to a slightly lesser degree in the case of the KAOPECTATE mark since this mark includes the word "PECTATE" in its entirety.

[19] The strength of a trade-mark may be increased by making it known through promotion and use. In the present matter, as use of the Mark has not yet commenced, the extent to which it has become known is of no help to the Applicant. In contrast, the Opponent's evidence establishes that the KAOPECTATE mark has been used in Canada and has become known to some extent, as discussed below.

[20] Specifically, the evidence presented by Ms. Sakhia shows that the Opponent has been using the KAOPECTATE mark in Canada since July 8, 2008, the date on which this mark was assigned by Johnson & Johnson to Paladin Labs (Barbados) Inc., which, in turn, assigned the mark to Squire on the same day [see the assignment agreements filed as Exhibits C and D in support of Ms. Sakhia's statutory declaration]. The products marketed under the KAOPECTATE mark consist of an attapulgite oral suspension for the rapid relief of diarrhea and cramps, as illustrated by the photographs of the sample bottles filed as Exhibit E in support of Ms. Sakhia's statutory declaration, which show an attapulgite suspension for children in a 180 ml bottle and regular and extra strength attapulgite suspensions in 250 ml bottles displaying the KAOPECTATE mark. These products can be purchased over the counter in drug stores.

[21] According to Ms. Sakhia, KAOPECTATE product sales amounted to \$800,000 between July 2008 and the date of the statutory declaration in April 2009, the equivalent of some 120,000 bottles. Ms. Sakhia filed Exhibit G in support of her statutory declaration, namely, copies of invoices confirming the sale of these products to the Shoppers Drug Mart chain in Ontario, dated October 2008 and March 2009. KAOPECTATE products retail at \$9.99 to \$13.99 a bottle, depending on the formulation and the amount.

[22] Regarding the use of the KAOPECTATE mark prior to July 2008 by Johnson & Johnson, Ms. Sakhia states that, based on her “information and belief”, Johnson & Johnson achieved annual sales ranging from \$900,000 to \$970,000 between 2005 and 2008. She produced a chart setting out these sales per year, prepared using information obtained from IMS Health Canada Inc. (IMS), which Ms. Sakhia described as “a leading provider of market data to the pharmaceutical industry”. Also based on Ms. Sakhia’s information and belief, Johnson & Johnson marketed the KAOPECTATE products in the same manner as the Opponent marketed its product.

[23] It should be noted at this stage of my analysis that the Applicant did not challenge as such this part of the evidence presented by Ms. Sakhia regarding the use of the KAOPECTATE mark made by Johnson & Johnson. Considering that, on the one hand, the Applicant cross-examined Ms. Sakhia on this matter and did not question the validity and reliability of the sales figures compiled by IMS and that, on the other hand, Ms. Sakhia stated in her statutory declaration that the Opponent has, since it acquired the KAOPECTATE mark, gradually introduced new labels for its products noting that this mark is now owned by the Opponent, thus presupposing that Johnson & Johnson did in fact market KAOPECTATE in the same bottles as those illustrated in Exhibit E, above, I am prepared to consider this part of the evidence on the use of the KAOPECTATE mark by Johnson & Johnson, which would normally be inadmissible since it is based on hearsay.

[24] Ms. Sakhia states that because of the widespread, continuous use of the KAOPECTATE mark over the years, this mark has become well known in Canada without it being necessary to promote and advertise KAOPECTATE products. More particularly, Ms. Sakhia states that the KAOPECTATE mark has become widely recognized by Canadian consumers because of the quality of KAOPECTATE products and through word of mouth.

[25] Even though I acknowledge that the sales figures provided by Ms. Sakhia support to some extent her statements indicating that the KAOPECTATE mark enjoys a degree of recognition in Canada, I find that Ms. Sakhia’s evidence as a whole is insufficient to conclude that the KAOPECTATE mark has become widely recognized in Canada. That said, and keeping

in mind that the KAOPECTATE mark has been registered since 1937—even though the evidence of continuous use filed by Ms. Sakhia is dated no earlier than 2005—I find it reasonable to conclude that this mark has become known in Canada to some extent. In that respect, I find that the use made of the KAOPECTATE mark increases its distinctiveness.

[26] In conclusion on this first factor, I am of the opinion that the overall assessment of the inherent distinctiveness of the parties' trade-marks and the extent to which they have become known does not weigh significantly in either party's favour. Even though the Mark is slightly more inherently distinctive than the KAOPECTATE mark, the extent to which the KAOPECTATE mark has become known increases its distinctiveness and counterbalances the higher degree of inherent distinctiveness of the Mark.

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

[27] In light of my previous comments, this factor favours the Opponent.

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

[28] In considering the nature of the wares and services and the nature of the trade, I must compare the statement of the wares contemplated by this application for registration with the statement of the wares covered by registration UCA09974 [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by their wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[29] The statement of the Wares is very precise in this respect. As it indicates, the Applicant's veterinary pharmaceutical product is an oral suspension made from kaolin and pectin for treating diarrhea and enteritis for cattle, calves and horses. The sought-after exclusivity is limited to large



animals. In fact, Mr. Robitaille explains in his statutory declaration that the Applicant intends to market this product exclusively to veterinarians and agricultural supply stores. Based on the veterinary recommendations on the amount of suspension required per animal, the Applicant intends to market this product in containers of at least 4 litres, in other words, a format that is appropriate for the size of the target animals.

[30] In contrast, the statement of wares covered by registration No. UCA09974 consists of “a medicinal preparation to be used in the treatment of intestinal dysfunction”. As noted by the Applicant, this registration dates back to an era when the criteria governing the required description of the wares to be covered by a registration were not necessarily as detailed as those today, meaning that a broad description of wares was more likely to be approved. Moreover, in order to determine the type of business or trade targeted by the Opponent’s medicinal preparation, all of the evidence presented through Ms. Sakhia must be referred to.

[31] As indicated earlier, the Opponent’s KAOPTECTATE products are sold over the counter in drugstores. The cross-examination of Ms. Sakhia reveals in fact that these products must be sold in drugstores [transcript, p. 21, Q. 69]. The products sold by the Opponent and corresponding to the sales figures produced by Ms. Sakhia are limited to those described in Exhibit E, discussed above, and are intended for human use [transcript, p. 31, Q. 113 *et seq.*].

[32] The Opponent’s direct clients are limited to major drugstore chains and wholesalers supplying smaller drugstores [transcript, p. 20, Q. 64 *et seq.*]. The Opponent’s end users are Canadian consumers in general.

[33] The Opponent does not have any products approved for veterinary use in Canada. It is possible, however, that some products approved for human use are being used by veterinarians, but this is outside the Opponent’s control (“What the veterinarians do with [the Opponent’s] products is beyond [its] grasp . . .”) [transcript, p. 14, Q. 31 *et seq.*].

[34] Regarding, specifically, the veterinary use of the KAOPTECTATE mark, Ms. Sakhia filed Exhibit G in support of her statutory declaration, namely, a printout from a Health Canada database listing, among other things, the product “KAOPTECTATE SUSPENSION” in the

veterinary class in the name of Pharmacia Animal Health (Pharmacia); the other products listed on this printout are the Opponent's three products for human use mentioned above, namely "CHILDREN'S KAOPECTATE SUSPENSION"; "EXTRA STRENGHT KAOPECTATE" and "REGULAR STRENGHT KAOPECTATE". Ms. Sakhia adds in paragraph 20 of her statutory declaration that Pharmacia is a licensee of the Opponent for veterinary use of the KAOPECTATE mark.

[35] Yet, when cross-examined on this matter, Ms. Sakhia was unable to provide *any* information on Pharmacia's use of the KAOPECTATE mark or on any veterinary use of the KAOPECTATE mark. In this regard, it is worth reproducing certain excerpts of the cross-examination of Ms. Sakhia:

*Q. 138 . . . Now, I was looking at Exhibit G again and I see that there is a fourth name which appears on that document, which is Pharmacia Animal Health. What do you know of this particular company?*

*A. Pharmacia is a division of Pfizer.*

*Q. 139 Perfect. And you described this company in paragraph 20 of your affidavit as a licensee of the opponent. Could you be more specific as to the nature of that relationship between you and Pharmacia Animal Health?*

*A. J & J.*

*Q. 140 Johnson & Johnson?*

*A. Johnson & Johnson acquired Pfizer Consumer Health. And from what our understanding is that under that agreement they licensed the vet use. Since we acquired Kaopectate we become the licensor.*

*Q. 141 Your understanding is that this license for the vet use to Pharmacia would cover which territory?*

*A. With regard to Kaopectate?*

*Q. 142 Yes.*

*A. The J & J licenses...the J & J and Pfizer's agreement was a worldwide acquisition. This particular piece is Canada only.*

*Q. 143 To your knowledge, is there a written document to this effect?*

*A. I would think so.*

*Q. 144 Could you possibly...if you are now the holder to the rights of that agreement, would you happen to have a copy of it?*

*A. Because it forms part of a much bigger agreement between Pfizer and Johnson & Johnson, and there's confidentiality between those two companies, I don't have access to it.*

*Q. 145 So you have a licensee that does not report to you?*

*A. Not at all.*

*Q. 146 And it pays no royalty?*

A. No.

*Q. 147 Do you have any information on the sales, if any, that Pharmacia Animal Health has in Canada?*

A. No.

. . . [Discussion between counsel resulting in the formulation of objections and the making of undertakings]

*Q. 150 You testified a few minutes ago that it's your understanding that there's a license agreement between... or that there was a license agreement between Pfizer Consumer Products, if I remember the name correctly that you gave us, and Johnson & Johnson for the worldwide vet use of Kaopectate...*

*A. No, sorry, not the worldwide use of Kaopectate. Their agreement is a worldwide agreement.*

*Q. 151 Okay.*

*A. Period. How the other...*

*Q. 152 So do you know exactly, for the vet use, exactly what rights were granted to Pfizer in terms of territory for the Kaopectate product?*

*A. I have no idea.*

*Q. 153 All right. Do you know...*

*A. I just know with regards to Canada.*

*Q. 154 Canada. Okay.*

*A. Right.*

*Q. 155 And how did you become aware, or how were you told that there was a right granted to Pfizer by Johnson & Johnson for the Canadian territory?*

*A. They told us.*

. . . [Discussion between counsel resulting in the formulation of objections and the making of undertakings]

*Q. 162 Have you ever seen the product as distributed or sold by Pharmacia Animal Health in Canada for Kaopectate for the vet market?*

*A. Have I ever seen it?*

*Q. 163 Yeah, have you seen a bottle or how it's ...what it looks like, how it's...*

*A. No.*

*Q. 164 ...marketed? All right. So you don't know if the label is similar to yours in any way, shape or form in terms of the visual impact, of how the name is...*

*A. No, I didn't.*

[36] The answers to the undertakings given during the cross-examination of Ms. Sakhia to provide clarifications of this so-called licence are useless since the Opponent essentially maintains its objection to providing any clarification whatsoever of the agreement entered into between Johnson & Johnson and Pfizer, on the basis that the Opponent is not authorized to disclose such an agreement.

[37] It should be noted, moreover, that Mr. Robitaille states in his statutory declaration that he has no knowledge of any presence in the veterinary market of wares sold under the KAOPECTATE mark to the Applicant's clients or suppliers or otherwise. It should also be noted, as emphasized by the Applicant, that the printout produced as Exhibit G in support of Ms. Sakhia's statutory declaration is dated April 16, 2009, and mentions that the information listed on the printout was modified on "2009-03-04", that is, after the statement of opposition was filed in this case; however, the nature of the modifications made is not specified. Lastly, it should be noted that, as also pointed out by the Applicant, the Opponent's annual report for 2008, filed as Exhibit A in support of Ms. Sakhia's statutory declaration, describes a corporate approach focussing on the drug market, without referring to any activity in the veterinary market whatsoever.

[38] Having considered all of the circumstances described above, I find that the Opponent has not established use of the KAOPECTATE mark in the veterinary field: the Opponent's evidence on this aspect is unclear to say the least and cannot, moreover, accrue to the Opponent's benefit under section 50 of the Act.

[39] To sum up, considering the differences between the Opponent's over-the-counter medicinal preparations sold in drugstores for human use and the Applicant's veterinary product, which is expressly limited to large animals and intended to be marketed exclusively to veterinarians and agricultural supply stores, I am of the opinion that the assessment of the third and fourth factors favours the Applicant.

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

[40] The marks at issue resemble one another to a certain extent, in that both include the prefix "KAO" followed by the syllable "PEC". Their ending portions differ significantly however. Not only do they sound completely different, but they also do not have the same number of syllables. Moreover, as indicated earlier, the KAOPECTATE mark includes the word "PECTATE", which is in the dictionary, in its entirety. In contrast, nothing in the Mark comes

directly from the dictionary since various syllables from the words “KAOLIN” and “PECTIN” were joined together to suggest rather than name something.

### Additional circumstances

#### State of the register

[41] The Applicant submits that the searches conducted by Ms. Montpetit in the Register of Trade-marks, filed as evidence with her statutory declaration, demonstrate that some 85 entries in the Register include the word “KAO”, including the following:

- Three entries containing the prefix “KAO” with the word “veterinary” in the description of the wares, including the registered marks KAObIOTIC BOLUS and KAObIOTIC;
- Three entries containing the prefix “KAO” with the word “intestinal” in the description of the wares, including the registered marks KAObIOTIC and KAOMYCIN;
- Nine entries containing the prefix “KAO” with the word “pharmaceutical” in the description of the wares, including the registered marks KAObChLOR-TAB and KAOMAGMA; and
- Three entries containing the prefix “KAO” with the word “medicinal” in the description of the wares, including the registered marks KAOMAGMA and KAOMYCIN;.

[42] The Applicant also submits that these searches indicate that there are six entries for trade-marks containing the syllable “PEC” and the word “pharmaceutical” in the description of the wares, including the registered mark UNIPECTINE.

[43] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Welch Foods Inc. v. Del Monte Corp.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); and *Maximum Nutrition Ltd. Nutrition Ltd. v. Kellogg Salada Canada Inc.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

[44] In the present case, even though I agree with the Applicant that the registrations located through Ms. Montpetit's searches, particularly those concerning the marks KAObIOTIC (registered in association with "a veterinary preparation for the treatment of intestinal dysfunction") and KAOMYCIN (registered in association with "a medicinal preparation for the treatment of intestinal conditions") support the Applicant's argument that the suggestive character of the prefix KAO, evoking the ingredient kaolin, in the context of preparations for the treatment of intestinal conditions, it is my opinion that the number of relevant registrations located is insufficient to make inferences about the state of the marketplace.

#### Conclusion – likelihood of confusion

[45] In light of my analysis above and considering, more specifically, the fact that the parties' wares are intended for two different markets, namely the human consumption market and the veterinary consumption market, and the differences between the parties' marks, it is my opinion that the Applicant has established, on a balance of probabilities, that a consumer having an imperfect recollection of the Opponent's mark KAOPECTATE would be unlikely to conclude that the Applicant's Wares are from the same source or are otherwise related to or associated with the Opponent's wares.

[46] Consequently, I reject the ground of opposition alleging non-registrability.

#### Ground of opposition based on non-distinctiveness

[47] To meet its initial evidentiary burden for non-distinctiveness, the Opponent must show that its mark KAOPECTATE had become sufficiently known in Canada at the date of the statement of opposition to negate the distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FC); and *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)]. Since this initial burden has been met in the present matter, the Applicant must now show, on a balance of probabilities, that there is no likelihood of confusion between its Mark and this mark of the Opponent's at the date of the statement of opposition.

[48] As I came to the conclusion that, based on the record, there is no likelihood of confusion under section 12(1)(d) of the Act and since the difference in material dates does not affect my analysis, I dismiss the ground of opposition based on the Mark's lack of distinctiveness.

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

[49] To discharge its initial burden of proof in regard to section 16(3)(a), the Opponent must show that its trade-mark KAOPECTATE was used 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) of the Act]. Since this initial burden has been met in the present matter, the Applicant must now show, on a balance of probabilities, that there was no likelihood of confusion between its Mark and this mark of the Opponent's at the date of the statement of opposition to the present application.

[50] As I came to the conclusion that, based on the record, there is no likelihood of confusion under section 12(1)(d) of the Act and since the difference in material dates does not affect my previous analysis, I dismiss the ground of opposition based on section 16(3)(a) of the Act.

Ground of opposition based on section 16(3)(c) of the Act

[51] To discharge its initial burden of proof in regard to section 16(3)(c), the Opponent must show that its KAOPECTATE trade-name had been used 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 Applicant's application [section 16(5) of the Act]. Since the Opponent's evidence relates exclusively to the use of the trade-mark KAOPECTATE rather than the trade-name KAOPECTATE, this initial burden has not been satisfied in the present matter. Consequently, the ground of opposition based on section 16(3)(c) of the Act is dismissed.

Disposition

[52] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition under section 38(8) of the Act.

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Annie Robitaille  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

Certified true translation  
Johanna Kratz, Translator