

**IN THE MATTER OF AN OPPOSITION by
Jurak Holdings Ltd. to Application
No. 1,004,415 for the trade-mark KARL JURAK
filed by Matol Biotech Laboratories Ltd.**

I The Proceedings

On February 5, 1999 Matol Biotech Laboratories Ltd. (the “Applicant”) filed an application to register the trade-mark KARL JURAK (the “Mark”).

The application was met with an office action in which the Examiner took the position that the Mark would appear to be unregistrable in view of the provisions of s. 12(1)(a) of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the “Act”) as the Mark would be considered to be primarily merely the name of an individual who is living or who has died within the preceding thirty years. Moreover the Examiner requested that some of the wares be defined in ordinary commercial terms. The Applicant replied by filing an affidavit under s. 12(2) of the Act and revised the list of wares detailed in the original application. The Examiner withdrew on June 6, 2001 her preliminary objection based on s. 12(1)(a) of the Act not on the basis of the evidence filed by the Applicant under the provisions of s. 12(2), but justified her decision on a new Office practice without providing any further details. There was another office action, which is not relevant to the issues raised in this opposition. The Examiner accepted the revised application that now covers minerals and vitamins preparations for therapeutical uses (the “Wares”). The application is based on use in Canada since October 31, 1994 and was advertised in the *Trade-marks Journal* of August 1, 2001.

Jurak Holdings Ltd. (the “Opponent”) filed a statement of opposition on October 3, 2001, which the Registrar forwarded to the Applicant on March 19, 2002. The Applicant filed a counter statement on April 2, 2002 denying each and every ground of opposition. On May 1st 2002 the Opponent requested leave to amend its statement of opposition that the Registrar granted on July 18, 2002.

The Opponent filed the affidavits of Anthony Carl Jurak, Arlene E. Siderius and Glenn A. Berg while the Applicant filed the affidavits of Jennifer Perras and J.F. Robert Bolduc. The Registrar issued an order for the cross-examination of all of the Opponent's affiants. It would appear that only Anthony Carl Jurak was cross-examined and the transcript of his cross-examination was produced. The Registrar also issued on June 30, 2004 an order for the cross-examination of Mr. Bolduc. However there is no trace in the file of the transcript of such cross-examination. Either the cross-examination of Mr. Bolduc never took place or the transcript was not filed into the record.

Both parties filed written argument but no oral hearing was held. The Registrar received the Applicant's written argument on July 19, 2005 without any covering letter. This fact created some confusion in the mind of the Opponent as it contends that it was not filed within the deadline, probably due to the absence of a covering letter that would have confirmed its filing.

II The related Proceedings

The Applicant also filed applications to register the trade-marks KARL JURAK 1904-1993 & Design, application number 863,443, KARL JURAK 1904-1993, application number 1,004,414 and JURAK, application 1,000,611. My colleague Céline Tremblay in the latter file rendered on March 3, 2006 a decision (reported as *Jurak Holdings Ltd. v. Matol Biotech Laboratories Ltd.* (2006), 50 C.P.R. (4th) 337) rejecting the Opponent's opposition. Some of the affidavits produced in the present file appear to have been filed as reply evidence in application 1,000,611. Without going into the details of such decision suffice to quote at this stage an extract of her decision on the issue of the admissibility of such reply evidence:

For all intent and purposes, I note that even if these affidavits were to be considered as evidence under Rule 43, I would at best accept to consider the content directly relating to Karl Jurak because it is one of the individuals named in the Applicant's letter (Exhibit RB-1). I would disregard any other evidence for not being strictly confined to matter in reply to the Applicant's evidence. According to my analysis of these affidavits, which follows, I would not afford any weight to the evidence that I would accept under Rule 43. Thus, even if I have erred in accepting the affidavits in the present opposition or if I have erred in refusing them as evidence under Rule 43, the overall outcome of the present case would be the same. I should add that any of

my comments on the affidavits are made in the context of the present opposition, and not in the context of the opposition to Application No. 1,004,415. (My underlines)

III The grounds of opposition

The amended statement of opposition raises the following issues:

- 1) The application does not comply with the requirements of s. 30(i) of the Act in that the Applicant could not have been satisfied that it was entitled to use the Mark as it had knowledge that Karl Jurak is primarily merely the name of a famous individual who died within the preceding thirty years. Therefore the mark is not registrable and is incapable of functioning as a trade-mark;
- 2) The application does not comply with the requirements of s. 30(b) of the Act as the Applicant has not used the Mark in Canada since October 31, 1994 in association with the Wares;
- 3) The Mark is not registrable pursuant to s. 12(1)(a) because it is primarily merely the name of a famous individual who has died within the preceding thirty years and is therefore not registrable. Furthermore, although there may be less than 25 entries for the name Karl Jurak in Canadian telephone directories, evidence will show that the name is that of a famous individual. Accordingly, although there may be less than 25 entries for the name in Canadian telephone directories the application is not saved by the practice Notice dated August 16, 2000 which the Examiner appears to have relied on in this matter;
- 4) The Mark is not distinctive in that it is not adapted to distinguish the Applicant's wares and services from the wares and services of others and is not capable of distinguishing the wares of the Applicant from the wares and services of others as it is primarily merely the name of a famous individual who has died within the preceding thirty years and is therefore not registrable and is incapable of functioning as a trade-mark. Furthermore, although there may be less than 25 entries for the name Karl Jurak in Canadian telephone directories, evidence will show that the name is that of a famous individual. Accordingly, although there may be less than 25 entries for the name in Canadian telephone directories the application is not saved by the practice Notice dated August 16, 2000, which the Examiner appears to have relied on in this matter.

IV Discussion of the issues raised by the Opponent

The legal burden is upon the Applicant to show that its 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 still has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark. [See *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company*, [2005] F.C. 722]

The relevant dates for the analysis of the remaining grounds of opposition are:

- Compliance to the requirements enumerated under s. 30(b) and (i) of the Act: the filing date of the application (February 5, 1999); [See *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293 and *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469]
- Registrability of the Mark under s. 12(1)(a) of the Act: also the filing date of the application; [See *Calvin Klein Trademark Trust v. Wertex Hosiery Inc.* (2005), 41 C.P.R. (4th) 552]
- Distinctiveness of the Mark: the filing date of the statement of opposition is generally accepted as the relevant date (October 3, 2001). [See *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)]

- i) Compliance to the requirements of s. 30(b) of the Act

The Opponent has an evidential onus but it has been characterized as a light one. Moreover the Opponent can rely on the evidence filed by the Applicant itself. However in the latter case the Applicant's evidence must raise serious doubts on the accuracy of the statements made by the

Applicant in its application. [See *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986) 10 C.P.R. (3d) 84 (T.M.O.B.), *Labatt Brewing Co. v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.) and *Williams Telecommunications Corp. v. William Tell Ltd.*, (1999) 4 C.P.R. (4th) 107 (T.M.O.B)].

I shall summarize hereinafter the relevant evidence on this issue.

Mr. Anthony Carl Jurak is the Opponent's president and C.E.O. of Jurak Corporation World Wide Inc. He was a co-founder of Matol Botanical International Ltd ("Matol Botanical") with Mr. Bolduc, the Applicant's representative. He is the son of the late Dr. Karl Jurak who died in 1993.

He filed as Exhibits GG-1 to GG-6 to his affidavit photographs of the Applicant's products bearing the trade-mark MATOL. He did explain in paragraph 54 of his affidavit that while involved with Matol Botanical between 1984 and 1997 he was responsible for the production of its goods. Each product bore an expiration date. It coincides with a two-year period after its production. He also states that Exhibit GG-1 is representative of the products manufactured while he was still involved with Matol Botanical. According to its expiration date it would have been manufactured on or about August 29, 1996 and it does not bear the Mark or any reference to Karl Jurak or Dr. Karl Jurak. However Exhibit GG-2 does bear the Mark and would have been manufactured on or about June 5, 1997 if we apply Mr. Jurak's theory. The Mark also appears on Exhibit GG-6, which would have been manufactured on or about July 4, 2002.

Mr. Anthony Carl Jurak alleges in paragraph 56 of his affidavit that Matol Botanical only referred to his father in 1994 on the products sold in association with the trade-mark MATOL. It was a special packaging that was used up by the end of that year. Exhibit GG-2 contradicts such statement. Moreover Mr. Bolduc in his affidavit has produced invoices going back to 1995 (Exhibit RB-1 and paragraph 7 of his affidavit), as he was unable to track down invoices for the year 1994 (paragraph 8 of his affidavit), evidencing the sale of products bearing the trade-mark MATOL. Mr. Bolduc filed as Exhibit RB-2 a representative sample of the bottle bearing the trade-mark MATOL (paragraph 9 of his affidavit) on which also appears the Mark. The

Opponent argues that the affiant failed to state that the Applicant continuously used such sample since October 1994. I do not consider this omission as raising a serious doubt such that the Opponent's initial onus would be met. Paragraphs 7 to 9 to Mr. Bolduc's affidavit must be read as a whole. Moreover, Mr. Jurak admitted in his affidavit that reference was made to his father in 1994 on the products sold by Matol Botanical under the trade-mark MATOL. Therefore I dismiss the second ground of opposition.

ii) Registrability of the Mark

As pointed out by the Applicant in its written argument the remaining grounds of opposition turn on the issue of whether the Mark is a word primarily merely the name or surname of an individual who has died in the preceding thirty years. The bulk of the evidence filed relates to this issue. There is no doubt that there was an individual by the name of Karl Jurak who died in 1993. Reference was made to the Practice Notice of August 16, 2000 entitled "Section 12(1)(a) of the Act- Name or Surname" that provides some guidelines with respect to the interpretation of s. 12(1)(a). Such guidelines or any subsequent ones might be applicable at the examination stage of the application but they are not binding on the Registrar at the decision stage of an opposition.

The leading cases on the issue of non-registrability of a trade-mark consisting of primarily merely the name or surname of an individual who is living or has died in the preceding thirty years are *Canada (Registrar of Trade-marks) v. Coles Book Stores Limited* [1974] S.C.R. 438, *Gerhard Horn Investments Ltd. v. Registrar of Trade-marks* (1983), 73 C.P.R. (2d) 23 and *Standard Oil Company v. The Registrar of Trade-marks*, (1968) 2 Ex. C. R. 523. As set out in those cases the test under s. 12(1) (a) is two fold:

- 1) The first and foremost condition is whether the Mark is the name or surname of a living individual or an individual who has recently died;
- 2) If the answer to the first question is affirmative, then the Registrar must determine if in the mind of the average Canadian consumer the Mark is "primarily merely" a name or surname rather than something else.

The first part of the test is met. Therefore I must decide if the average consumer would consider the Mark as "primarily merely" the name of an individual or something else.

The Opponent filed a lot of material in order to establish that Karl Jurak was a famous person. The Mark is composed of the name JURAK that is apparently not found at least 25 times in Canadian telephone directories as admitted by the Opponent in its statement of opposition. Therefore in order to succeed under the provisions of s. 12(1)(a), the Opponent argues that if the Mark is the name of a famous person, then the average Canadian consumer would automatically consider the Mark as “primarily merely” the name or surname of a person. On this issue the evidence filed can be summarized as follow:

- Dr. Karl Jurak was born in Austria and emigrated to Canada in 1926;
- He created sometime in 1943 a whole body tonic formulation that was sold in Canada between 1943 and 1960, the year of his wife’s death;
- Such product was sold under the trade-mark MATONOL and was so popular that Dr. Karl Jurak started a business known as Matrol Reasearch Ltd.;
- Dr. Jurak also created a product sold under the trade-mark FLOGRIP that eliminates lead in paint. The documentation filed to support such allegation (Exhibit J) does not contain any reference to Dr. Karl Jurak;
- He also co-invented an aluminium electric car as it appears from an extract of the newspaper Le Soleil published in late 1947. We have no date of publication of this article. It is three paragraphs long and the name Karl Jurak appears once in this article with other individual names;
- Most of the evidence filed relates to The Karl Jurak Foundation (“Foundation”) created in 1989-90 to help physically or sexually abused children. Matol Botanical, co-founded by Dr. Karl Jurak, donated money to the Foundation;
- The Foundation built in Tulsa, Oklahoma, in or around 1990-91 a first centre on the campus of the University of Oklahoma College of Medicine;
- The Foundation built in 1993 a second centre in San Antonio, Texas;
- The whole body tonic was reintroduced in 1998 in Canada under the trade-mark JURAK CLASSIC. On the picture of the bottle filed there is no reference to Karl Jurak.

The affiant filed the following exhibits:

- Sample letters addressed to Matrol Research Ltd. in the 1950's were filed but there is no reference in these letters to Dr. Karl Jurak;
- Several pictures taken at annual meetings of Matol Botanical held at various places in the United States of America;
- Sample of letterhead used by the Foundation but we have no information as to what extent it was used in Canada;
- Four letters from professionals in Canada containing comments on a video entitled "Secret Suffering". Those letters are addressed to or make reference to The Foundation and not to Dr. Karl Jurak specifically;
- Numerous paper clips of American newspapers were filed to evidence the creation of those centres. We have no evidence that those newspapers ever circulated in Canada;
- Labels and advertisements showing the product sold under the trade-mark MATONOL. None of this material referred to Dr. Karl Jurak;
- Extracts of the website located at www.jurak.com but we have no information on the number of Canadians who visited such website prior to any of the relevant dates;
- Copy of a letter from Dr. Mowrey, President of the American Pythotherapy Research Laboratory, located in Utah, undated, that refers to Carl (sic) Jurak. Again this emanates from an American source;
- Videotapes of conferences given by Karl Jurak, all in the United States. There is no information on the distribution of these videotapes in Canada;

During his cross-examination, Mr. Anthony Carl Jurak was asked: on what factual basis he concludes that Karl Jurak was a famous person. According to the answer given, his opinion is based on the following facts:

- He developed a popular whole body tonic;
- He also developed a product that neutralized lead in paint;
- Two centres for child abuse bore his name.

He provided the sale figures of whole body tonic bottles sold during the period between 1999 and 2003. I note that the yearly Canadian sales figures for each of those years, except for 2003, were less than \$100,000. (See the reply to the undertakings given during his cross-examination)

Mr. Glenn Berg has been a library technician working for the Opponent's agents. He did searches using various databases to locate newspaper articles in which there is reference to Karl Jurak or Jurak. Forty-one (41) articles were located and all but four (4) were written between 1990 and 1994. They are extracts of American newspapers, most of them from The Tulsa World, but we have no information on the circulation figures of these publications in Canada.

Arlene E. Siderius has been working as a legal assistant for the Opponent's agents firm. She conducted three searches between October 18, 2002 and November 4, 2002 on the Internet to locate sites containing references to Karl Jurak. Not only the content of the web pages filed constitute inadmissible hearsay evidence [see *Envirodrive Inc. v. 836442 Alberta Inc.* 2005 ABQB 446], the searches were done after the relevant dates. I would add that the civic addresses mentioned on the websites are mostly located in the United States of America. She also filed extracts of the file wrapper of the present application as well as of related applications 863443 and 1004414.

With all due respect for the late Dr. Karl Jurak I do not think that the evidence described above is sufficient to conclude that he was a famous person known to the average Canadian consumer. He might be known in Tulsa, Oklahoma or even in San Antonio, Texas in view of the centres opened in these cities by The Foundation but there is no evidence that enables me to conclude that his fame in the United States is of such a magnitude that it spilled over in Canada. His whole body tonic might have been popular in the 1950's but there is no evidence that such popularity carried over the relevant dates such that Canadians when confronted with the name Karl Jurak would immediately associate the late Dr. Karl Jurak to such product. The Canadian sales figures provided were not of a magnitude that they would infer an association amongst the Canadian consumers between such trade-mark and the late Karl Jurak.

Having concluded that the evidence filed falls short of establishing that the Mark is recognized in Canada as the name of a famous person, I do not think that such conclusion puts an end to the test applicable when s. 12(1)(a) is raised as a ground of opposition. In fact s. 12(1)(a) of the Act does not require the individual to be famous in order for the prohibition to apply. Evidence that a name would appear at least 25 times in Canadian telephone directories only gives an indication that such name could be viewed by the average Canadian consumer as a name of an individual. The absence of such proof is not fatal to an opposition based on s. 12(1)(a). In our case there is no evidence that JURAK has any other meaning.

The burden is on the Applicant to show that the Mark is registrable despite the prohibition under s. 12(1)(a). There is no evidence that would demonstrate that the combination of the given name KARL with the surname JURAK would have in the minds of the average Canadian consumer of the Wares any other meaning than the Wares originate from an individual by the name of Karl Jurak.

Given that there is evidence that Karl Jurak was an individual who has died during the preceding thirty years and the Mark would be viewed in the mind of the average Canadian consumer as “primarily merely” as a name, I conclude that the Mark is not registrable as prohibited under the provisions of s. 12(1)(a) of the Act.

(ii) Compliance with the requirements of s. 30(i)

I am not convinced that the first ground of opposition as drafted constitutes a proper ground of opposition. The Applicant could have been satisfied that the Mark was registrable as names of individuals could be registrable, provided certain conditions are met. Therefore the first ground of opposition is dismissed.

(iii) Distinctiveness

The Opponent argues that the Mark is not distinctive on the basis that it is primarily merely the name of a famous individual who has died within the preceding thirty years. The Applicant has a

legal onus to show that its mark is adapted to distinguish or actually distinguishes its wares from the wares and/or services of the Opponent throughout Canada. [See *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (T.M.O.B.)] There is no evidence in the file to that effect.

Mr. Bolduc states in his affidavit that the Mark has been used as an associated mark with the trade-mark MATOL. The evidence described above falls short from establishing that the Mark has been used in Canada prior to the relevant date, namely October 3, 2001, in such a way that it does serve to distinguish the Applicant's Wares from the wares and services of others. As an example the Applicant failed to provide the annual sales figures from 1994 to 2002. The only reference to sales in Mr. Bolduc's affidavit is with respect to 2003. As noted earlier some of the containers bearing the trade-mark MATOL filed by Mr. Jurak and allegedly used by the Applicant since 1994 do not have any reference to the Mark. Therefore it is impossible to ascertain the percentage of the sales of the Wares in 2003 associated with the Mark as opposed to the trade-mark MATOL alone, even if such evidence was relevant.

I also note that the Applicant did not rely on the provisions of s. 12(2) of the Act in its counter statement or in its written arguments. The evidence filed by the Applicant at the examination stage to claim the benefit of s. 12(2) of the Act does not form part of the opposition file. [See *Molson Breweries, A Partnership v. The Registrar of Trade-marks* (1992), 41 C.P.R. (3d) 234] The Applicant's evidence does not address the issue that the Mark would have acquired distinctiveness at the relevant date.

As the Mark consists primarily merely the name of an individual who has died within the last thirty years and in the absence of evidence that would prove that the Mark acquired distinctiveness at the relevant date, I conclude that the Mark could not served to distinguish the Wares from the wares and services of others. The fourth ground of opposition is therefore maintained.

V Conclusion

Having regard to the foregoing, and with the authority delegated to me under s. 63(3) of the Act, I refuse the Applicant's application to register the Mark pursuant to s. 38(8) of the Act.

DATED IN BOUCHERVILLE, QUEBEC, THIS 14th DAY OF SEPTEMBER 2007.

Jean Carrière,
Member,
Trade-marks Opposition Board