

**IN THE MATTER OF AN OPPOSITION by SmithKline  
Beecham Corporation to application No. 743,101 for the trade-  
mark IXEL filed by Pierre Fabre Médicament**

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On December 9, 1993, the applicant, Pierre Fabre Médicament, filed an application to register the trade-mark IXEL based upon proposed use of the trade-mark in Canada in association with “produits pharmaceutiques; antidépresseur” which was subsequently amended to cover: “produits pharmaceutiques nommément, antidépresseur”. The applicant was accorded a priority filing date of July 5, 1993 based upon its application for registration of the trade-mark IXEL filed in France under Serial No. 93/476,292. The applicant amended its application at the examination stage to provide that the applicant, through a licensee, intends to use the trade-mark IXEL in Canada in association with the wares covered in the application.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of August 24, 1994 and the opponent, SmithKline Beecham Corporation, filed a statement of opposition on November 22, 1994, a copy of which was forwarded to the applicant on March 15, 1995. The applicant served and filed a counter statement on April 13, 1995 in which it effectively denied the opponent’s grounds of opposition. The opponent submitted as its evidence the affidavits of Peter A. Reich and Martin Fisher while the applicant filed as its evidence the affidavit of Philippe E. Barbaud. The opponent submitted a second affidavit of Peter A. Reich as evidence in reply to the Barbaud affidavit. Both parties filed a written argument and the both were represented at an oral hearing.

As its first ground, the opponent alleged that the present application does not satisfy the requirements of Section 30 of the *Trade-marks Act* in that the applicant failed to specify whether or not it intends to use the trade-mark IXEL by itself or through a license, or by itself and through a licensee, contrary to Subsection 30(e) of the *Act*. As its second ground, the opponent alleged that the applicant could not have been satisfied that it is entitled to use its trade-mark in Canada, in view of the opponent’s PAXIL trade-mark registration, an application for which had been previously filed in Canada on July 11, 1991, and in view of the fact that the applicant does not appear to be a “person” within the meaning of the *Act*.

The third ground is based on Paragraph 12(1)(d) of the *Trade-marks Act*, the opponent alleging that the applicant's mark IXEL is confusing with its registered trade-mark PAXIL, registration No. 427,135, covering "pharmaceutical preparations, namely antidepressants" while the fourth ground is based on Paragraph 16(3)(b) of the *Act*, the opponent alleging that the applicant is not the person entitled to registration in that, as of the applicant's filing date or its alleged priority date, the applicant's trade-mark was confusing with the opponent's trade-mark PAXIL, an application for the registration of which was previously filed in Canada on July 11, 1991. Further, under the Section 16 ground, the opponent repeated its allegation that the applicant does not appear to be a "person" within the meaning of the *Act*. As its fifth and final ground, the opponent alleged that the applicant's trade-mark IXEL cannot serve to distinguish its wares from the wares sold by the opponent in association with the opponent's trade-mark PAXIL.

During the opposition, the applicant sought to amend its application in order to add "une société anonyme" to its name. The Opposition Board advised the applicant that such an amendment would appear to be contrary to Rule 31(a) of the *Trade-marks Regulations* and invited the applicant to make any submissions which it wished to make concerning this issue. The applicant responded by way of its correspondence of July 30, 1997 and August 18, 1997 and, on August 14, 1997, the opponent filed a letter objecting to the acceptance of the amended application. The Opposition Board advised the parties on September 29, 1997 that a final ruling on this issue would be made at the decision stage of this proceeding.

The first two grounds of opposition are based on Section 30 of the *Trade-marks Act* and, more specifically, on Subsections 30(e) and 30(i) of the *Act*. While the legal burden is upon the applicant to show that its application complies with Section 30 of the *Trade-marks Act*, there is an initial evidential burden on the opponent to establish the facts relied upon by it in support of its Section 30 grounds [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; and *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R.(3d) 293]. The material time for considering the circumstances respecting the issues of non-compliance with Section 30 of the *Act* is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R.(3d) 469, at p. 475] or, in the present case, the applicant's priority filing date

[July 5, 1993].

With respect to the first ground, Subsection 30(e) of the *Trade-marks Act* provides as follows:

**30.** An applicant for the registration of a trade-mark shall file with the Registrar an application containing  
(e) in the case of a proposed trade-mark, a statement that the applicant, by itself or through a licensee, or by itself and through a licensee, intends to use the trade-mark in Canada;

At the date of advertisement for opposition purposes of the trade-mark IXEL in the *Trade-marks Journal*, the present application included the statement that the applicant intended to use its trade-mark in Canada through a licensee. Thus, the present application included a statement in compliance with Subsection 30(e) of the *Act*. Furthermore, no evidence has been furnished by the opponent to support an allegation that the statement set forth in the applicant's amended application was inaccurate; and there is nothing in the applicant's evidence which is inconsistent with the applicant's claim that it intended to use the trade-mark IXEL through a licensee in Canada. I have therefore dismissed this ground.

The second ground relates to the applicant's application being in compliance with Subsection 30(i) of the *Trade-marks Act*, the opponent alleging that the applicant could not have been satisfied that it was entitled to use the trade-mark IXEL in Canada in view of the opponent's PAXIL trade-mark registration, an application for which had been previously filed in Canada on July 11, 1991. Furthermore, the opponent alleged that the applicant does not appear to be a "person" within the meaning of the *Act*. However, no evidence has been furnished by the opponent to show that the applicant could not properly have been satisfied that it was entitled to use its trade-mark IXEL in Canada on the basis *inter alia* that its trade-mark is not confusing with the opponent's trade-mark PAXIL. Thus, the success of this aspect of the second ground is contingent upon a finding that the trade-marks at issue are confusing [see *Consumer Distributing Co. Ltd. v. Toy World Ltd.*, 30 C.P.R. (3d) 191, at p. 195; and *Sapodilla Co. Ltd. v. Bristol-Myers Co.*, 15 C.P.R. (2d) 152, at p. 155]. I will therefore consider the remaining grounds of opposition which are based on allegations of confusion between the applicant's trade-mark IXEL and the opponent's trade-mark PAXIL.

The second aspect of the Subsection 30(i) ground relates to the opponent's allegation that the applicant does not appear to be a "person" within the meaning of the *Act*. "Person" is defined in Section 2 of the *Trade-marks Act* as follows:

"person" includes any lawful trade union and any lawful association engaged in trade or business or the promotion thereof, and the administrative authority of any country, state, province, municipality or other organized administrative area

The applicant has submitted that an applicant need not be a "person" in order to file for registration of a trade-mark. However, a mark must be used by a person in order to qualify as a "trade-mark", as defined in Section 2 of the *Trade-marks Act*. Thus, while Section 30 does not specifically indicate that an applicant be a "person", the definition of "trade-mark" necessitates that an applicant for registration of a trade-mark be a "person".

The opponent has argued that no evidence has been filed by the applicant to establish that it is a legal entity and, by submitting an amended application, the applicant has "essentially admitted that the issue is not obvious and is serious enough to warrant an attempt to amend the application". While no evidence has been furnished by the opponent to show that Pierre Fabre Médicament is not a "person" as defined in Section 2 of the *Trade-marks Act*, the opponent can also meet its evidential burden by reference to the applicant's evidence [see, in this regard, *Labatt Brewing Company Limited v. Molson Breweries, a Partnership*, 68 C.P.R.(3d) 216, at p. 230] and to the actions taken by the applicant during the prosecution of its application. Thus, in the present case, the filing by the applicant of an amended application to add "une société anonyme" to its name is arguably sufficient to meet the evidential burden on the opponent in relation to the issue of the applicant's identity as a "person".

In *Beauty Creations Limited v. EUGENE-GALLIA*, I considered an amendment to the identity of the applicant to add "une société anonyme" to its name and commented as follows:

Au cours de l'audition, l'agent de marques de commerce de la requérante a signalé que la requérante pourrait demander de modifier sa demande d'enregistrement pour indiquer que la requérante est « une société anonyme ». J'ai informé l'agent de la requérante que j'accordais à cette dernière une semaine pour décider si elle voulait procéder à la modification et pour déposer une demande modifiée auprès de la Commission des oppositions. La requérante a déposé une demande modifiée dans laquelle l'identité de la requérante figure comme étant « EUGENE-GALLIA, une société anonyme ». Attendu que la demande de modification proposée ne semblait donner lieu à aucune modification subséquente de la déclaration d'opposition, j'ai informé les parties que je trancherais la question de la demande modifiée dans le cadre de la décision finale que je rendrais dans la

présente opposition.

La modification à la demande effectuée par la requérante ne constitue pas un changement d'identité de la requérante et elle ne contrevient à aucune autre disposition des Règles 35 à 37 du Règlement sur les marques de commerce. En outre, la modification demandée par la requérante ne constitue pas une demande qui, autrement, devrait être refusée dans l'intérêt du public. J'ai, par conséquent, accepté la demande de modification de la requérante.

En ce qui concerne ses motifs d'opposition fondés sur l'article 30, l'opposante a allégué en premier lieu que la requérante n'est pas une personne morale et que, par conséquent, elle n'est pas une « personne » au sens de l'article 2 de la Loi sur les marques de commerce. Au paragraphe 6 de son affidavit, M. Féron déclare que la requérante, EUGENE-GALLIA, est « une société anonyme constituée en vertu des Lois de la République française ». M. Féron a annexé à son affidavit, à titre de pièce A-2, un document désigné comme étant « un certificat de l'inscription au Registre du Commerce de la Requirante » dans lequel la « RAISON SOCIALE (DÉNOMINATION) » de la requérante figure comme étant EUGENE GALLIA. En conséquence, la preuve de la requérante établit que EUGENE-GALLIA, sans le renvoi à "une société anonyme", constitue une désignation précise de la requérante. En outre, j'estime que la présence ou l'absence d'un trait d'union entre les mots EUGENE et GALLIA n'a aucune conséquence sur la situation de la requérante à titre de personne morale ou de « personne ».

[Translation of the decision appearing at 45 C.P.R. (3d) 278, pages 281 to 282]

During the oral hearing, the trade-mark agent for the applicant noted that the applicant may wish to amend its application in order to indicate that the applicant is "une société anonyme". I advised the applicant's agent that the applicant would have one week to decide whether it would be proceeding with the amendment and, if so, to file an amended application with the Opposition Board. The applicant submitted an amended application in which the identity of the applicant was amended to read "EUGENE-GALLIA, une société anonyme". As the proposed amendment to the application did not appear to call for any subsequent amendment to the statement of opposition, I advised the parties that I would rule upon the matter of the amended application as part of the final decision in this opposition.

The amendment sought by the applicant to its application does not constitute a change in the identity of the applicant, nor does it otherwise offend any of the other provisions of Rules 35 to 37 of the Trade-marks Regulations. Further, the amendment sought by the applicant is not one which otherwise ought to be refused in the public interest. I have therefore accepted the applicant's amended application.

The first issue raised by the opponent in respect of its Section 30 grounds is that the applicant is not a legal entity and therefore does not qualify as a "person" as defined in Section 2 of the Trade-marks Act. In paragraph 6 of his affidavit, Mr. Féron states that the applicant, EUGENE-GALLIA, is "une société anonyme constituée en vertu des Lois de la République française". As exhibit A-2 to his affidavit, Mr. Féron has annexed a document identified as "un certificat de l'inscription au Registre du Commerce de la Requirante" in which the "RAISON SOCIALE (DENOMINATION)" of the applicant is identified as EUGENE GALLIA. As a result, the applicant's evidence establishes that EUGENE-GALLIA, without the accompanying reference to "une société anonyme", is an accurate identification of the applicant. Further, I do not consider that the presence or absence of a hyphen between EUGENE and GALLIA has any effect on the status of the applicant as a legal entity or "person".

Having regard to the *EUGENE-GALLIA* decision, I have accepted the applicant's amended application in the present proceeding and have concluded that the identification of the applicant as Pierre Fabre Médicament is sufficient to accurately identify the applicant in this opposition. I have therefore rejected the second issue raised under the Subsection 30(i) ground.

The third ground of opposition is based on Paragraph 12(1)(d) of the *Trade-marks Act*, the opponent alleging that the applicant's trade-mark IXEL is not registrable in that it is confusing with the registered trade-mark PAXIL, registration No. 427,135, covering "pharmaceutical preparations, namely antidepressants". In determining whether there would be a reasonable likelihood of confusion between the trade-marks IXEL and PAXIL, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those specifically set forth in Subsection 6(5) of the *Trade-marks Act*. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the date of decision, the material date in respect of the Paragraph 12(1)(d) ground [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.)].

With respect to Paragraph 6(5)(a) of the *Act*, both the applicant's trade-mark IXEL and the opponent's trade-mark PAXIL appear to be coined terms and are therefore inherently distinctive. As no evidence relating to use of the trade-mark IXEL has been adduced by the applicant, its trade-mark must be considered as not having become known to any extent in Canada. The opponent, on the other hand, submitted the affidavit of Martin Fisher, Director of Marketing of SmithKline Beecham Pharma Inc., in support of its opposition. In his affidavit, Mr. Fisher states that his company "is a related company of SmithKline Beecham Corporation and is licensed by SmithKline Beecham Corporation to use the PAXIL trade-mark in Canada". However, the exhibits annexed to the Fisher affidavit clearly point to SmithKline Beecham Pharma Inc. being the source of the PAXIL antidepressants in Canada, there being no notice given to the public relating to the existence of a license arrangement between the opponent and Mr. Fisher's company or that the use by SmithKline Beecham Pharma Inc. of the trade-mark PAXIL is a licensed use of the mark. Moreover, Mr. Fisher is silent in his affidavit as to the control, whether direct or indirect, which the opponent has over the character or quality of the antidepressants associated with the PAXIL trade-mark.

The opponent has argued that the use by SmithKline Beecham Pharma Inc. of the trade-mark PAXIL has the same effect as use of the trade-mark by the opponent in view of Subsection 51(1) of the *Trade-marks Act*. Subsection 51(1) of the *Act* provides as follows:

**51.** (1) Where a company and the owner of a trade-mark that is used in Canada by that owner in association with a pharmaceutical preparation are related companies, the use by the company of the trade-mark, or a trade-mark confusing therewith, in association with a pharmaceutical preparation that at the time of that use or at any time thereafter,

(a) is acquired by a person directly or indirectly from the company, and

(b) is sold, distributed or advertised for sale in Canada in a package bearing the name of the company and the name of that person as the distributor thereof,

has the same effect, for all purposes of this Act, as a use of the trade-mark or the confusing trade-mark, as the case may be, by that owner.

However, the opponent has not shown that PAXIL antidepressant has been acquired by a person directly or indirectly from SmithKline Beecham Pharma Inc. and that PAXIL antidepressant has been sold, distributed, or advertised for sale in Canada in packages bearing the name of that person as a distributor thereof, as contemplated by Subsection 51(1) of the *Trade-mark Act*. As a result, Subsection 51(1) does not apply in the present case. Thus, for the purposes of this opposition, the use by SmithKline Beecham Pharma Inc. of the trade-mark PAXIL cannot be considered as having accrued to the benefit of the opponent and the trade-mark PAXIL has therefore not been shown to have become known in Canada as a trade-mark of the opponent. Thus, neither the extent to which the trade-marks at issue have become known [Para. 6(5)(a)] nor the length of time the marks have been in use [Para. 6(5)(b)] favour either party.

Paragraphs 6(5)(c) and (d) of the *Trade-marks Act* require the Registrar to have regard to the nature of the wares of the parties and their respective channels of trade. The present application covers “produits pharmaceutiques nommément, antidépresseur” which are identical to the wares covered in the opponent’s registration, that is, “pharmaceutical preparations, namely antidepressants”. Further, I would expect the channels of trade associated with the wares of the parties to be the same. In this regard, Mr. Fisher states in his affidavit that PAXIL antidepressant medication is a prescription medication and, since virtually all antidepressant medications are prescription drugs, the applicant’s IXEL antidepressant would also likely be a prescription drug. As this evidence has neither been challenged nor contradicted by the applicant, I will proceed on the basis that the applicant’s wares will be distributed in Canada as a prescription medication and that medical doctors and pharmacists will be involved in the prescribing and dispensing of the wares of the parties. Further, in paragraph 11 of his affidavit, Mr. Fisher states that physician’s prescriptions are typically given either in handwritten form or by telephone. Also, in addition to doctors and pharmacists, patients must also be considered as part of the relevant public in assessing the issue of confusion when medication is dispensed under prescription [see *Ciba-Geigy Canada Ltd. v. Apotex Inc.*, [1992] 3 R.C.S. 120].

As indicated in *Cyanamid Canada Inc. v. Smith Kline & French Canada Ltd.*, 23 C.P.R. (3d) 189, at p. 196, the prescribing of medication by a medical doctor may, itself, not technically constitute a use of a trade-mark in respect of which confusion would arise although it does constitute an element in the process involving the transfer of possession in the product from the pharmacy to the patient, be it in a hospital environment or in the community. Also, as was pointed out in *Johnson & Johnson v. William H. Rorer (Canada) Ltd.*, 44 C.P.R. (2d) 90, at pp. 96-97, the possibility of errors in the prescribing and dispensing of pharmaceutical products is not directly related to the likelihood of confusion as to the source of the products, which is the issue for determination under Section 6 of the *Trade-marks Act*.

During the oral hearing, the agent for the opponent relied upon the decision in *Mead Johnson & Co. v. Searle & Co.*, 58 C.P.R. 1, with respect to the issue of confusion involving trade-marks in the medical field. However, I would refer to the decision of the Hearing Officer in *American Home Products Corp. and Wyeth Ltd. v. William H. Rorer (Canada) Ltd.*, 42 C.P.R. (2d) 225, at pages 231-232 where the *Mead Johnson* decision was discussed:

In the opponent's argument reference was also made to the judgment of Dumoulin, J., in *Mead Johnson & Co. v. G. D. Searle & Co.* (1968), 53 C.P.R. 1, where he cited with approval the decision of the United States Court of Appeals (Third Circuit) in *Morgenstern Chemical Co. Inc. v. G. D. Searle & Co.* (1958), 253 F. 2d. 390, where Circuit Judge Maris stated [at p. 393]:

In the field of medical products, it is particularly important that great care be taken to prevent any possibility of confusion in the use of trade-marks. The test as to whether or not there is confusing similarity in these products even if prescribed and dispensed only by professionally trained individuals does not hinge on whether or not the medicines are designed for similar ailments.

I have not examined the statutory provision governing the issue of confusion that was under consideration in that case, but it seems to me that the possibility of confusion in prescribing and dispensing pharmaceutical products is not directly related to the likelihood of confusion as to source of product, which is the issue for decision under s. 6 of our Act.

Reference should also be made to *Endo Laboratories Inc. v. Dow Chemical Co.* (1972), 8 C.P.R. (2d) 149, where Noel, A.C.J., said at p. 154:

I fully appreciate counsel for the respondent's submission that one must be particularly careful in the pharmaceutical field as to what marks may co-exist on the register as the overriding consideration must always be the protection of the public and, of course, confusion in medicine must always be avoided.

I do not read that passage as suggesting that, in opposition proceedings relating to pharmaceuticals, the standard of confusion is different than that applicable to other wares. There is only one statutory standard fixed by s-s. (2) of s. 6 of the *Trade Marks Act*, and the essential question to be determined is expressly related to source of product: *Rowntree Co. Ltd. v. Paulin Chambers Co. Ltd.*, supra, at p. 136.

I assume that all that Noel, A.C.J., was suggesting in the passage above quoted was that particular care should be exercised in applying that statutory standard in the pharmaceutical field.



As for the degree of resemblance between the trade-marks at issue [Para. 6(5)(e)], the trade-marks IXEL and PAXIL bear at least some similarity in appearance when considered in their entireties as a matter of immediate impression and imperfect recollection. Further, the trade-marks at issue appear to be coined terms and therefore do not convey any particular ideas in common. With respect to the sounding of the trade-marks at issue, the opponent has relied upon the affidavits of Peter A. Reich, a Professor of Linguistics at the University of Toronto, while the applicant has submitted the affidavit of Philippe E. Barbaud who identifies himself as being a Professor of Linguistics at the University of Quebec in Montreal. Both Mr. Reich and Mr. Barbaud have qualified themselves as experts in linguistics and their opinions are therefore admissible as expert opinion evidence. As well, having regard to the decision in *Ethicon Inc. v. Cyanamid of Canada Ltd.*, 35 C.P.R. (2d) 126, at pp. 135-136, expert evidence relating to the pronunciation of a word would appear to be admissible evidence.

While Mr. Reich has qualified himself to give expert opinion evidence in respect of the pronunciation of the trade-marks at issue in the English language, he has not qualified himself to give expert opinion evidence relating to the pronunciation of the trade-marks at issue in the French language. Likewise, Mr. Barbaud has qualified himself to give expert opinion evidence relating to the pronunciation of the trade-marks at issue in the French language but has not established that he is qualified to give expert opinion evidence relating to the pronunciation of the trade-marks at issue in the English language. Consequently, neither affiant has satisfied me that he is qualified to give expert opinion evidence relating to the pronunciation of the trade-marks at issue in both official languages. Furthermore, the Registrar of Trade-marks is not justified in adopting an expert's opinion simply on the basis of his or her expertise. As Mr. Justice Mahoney pointed out in *William H. Rorer (Canada) Ltd. v. Johnson & Johnson*, 48 C.P.R. (2d) 58, at p. 62, the adjudicator must know the facts and/or assumptions upon which the expert bases his or her opinion so that he can assess the validity of the opinion and the process by which it was reached. Furthermore, the conflicting opinions of linguistics experts relating to the pronunciation of trade-marks in the present and other opposition proceedings suggests to me that perhaps little weight ought to be accorded such expert evidence by the Registrar of Trade-marks [see, for example, *Coca-Cola Ltd. v. Brasseries*

*Kronenbourg, une société anonyme*, 55 C.P.R. (3d) 544; and *Chantelle v. Kabushiki Kaisha Chandeal*, application No. 730,153, decision dated March 19, 1998, yet unreported].

Having regard to the bilingual character of Canada, it is the average bilingual consumer, either anglophone or francophone, who must be considered in assessing the issue of confusion. Moreover, equal importance must be accorded to the English language as to the French language in assessing this issue [see *Boy Scouts of Canada v. Alfred Strenjakob GmbH & Co. KG et al*, 2 C.P.R. (3d) 407, at pp. 412-413; *Scott Paper Co. v. Beghin-Say S.A.*, 5 C.P.R. (3d) 225, at p. 231; *Ferrero S.p.A. v. Les Produits Freddy Inc.*, 22 C.P.R. (3d) 346]. In *Les Vins La Salle Inc. v. Les Vignobles Chantecler Ltée*, 6 C.P.R. (3d) 533, at pp. 535-536, the Hearing Officer commented on the issue of the average bilingual consumer as follows:

In the present case, the most important circumstances in determining whether the applicant's trade mark is confusing with the opponent's trade mark are the inherent distinctiveness of the trade marks and the degree of resemblance between them in appearance and sound and in the ideas suggested by them. The significance of these circumstances is naturally very dependent upon the linguistic context in which they are considered. The applicant submitted as reasons for concluding that the trade marks are not confusing that as used in association with wines, the word "plaisir" in French suggests that the drinking of the wine will result in pleasure and that therefore it is a weak part of both the applicant's and the opponent's trade marks in terms of inherent distinctiveness. The applicant also submitted that the ideas suggested in French by the trade marks are quite different. At p. 8 of the applicant's argument it is stated:

D'une part, la marque "PLAISIR DIVIN" de l'Opposante employée en liaison avec des vins connote un vin fournissant une joie ou une émotion agréable réservée aux dieux. ... Par contre, la marque "PLAISIR D'AMOUR" connote plutôt le caractère romantique et intime associé à la consommation du vin."

As pointed out by the opponent, however, the reaction of a unilingual anglophone to these trade marks would be quite different. A unilingual anglophone would likely react to the word "plaisir" as a coined word. He might guess that it is a French word but he would have no knowledge as to its meaning.

Given the bilingual nature of Canada and bearing in mind the recent comments of Joyal J. in *Boy Scouts of Canada v. Alfred Sternjakob GmbH & Co. KG et al.* (1984), 2 C.P.R. (3d) 407 at pp. 412-3 and Strayer J. in *Scott Paper Co. v. Beghin-Say S.A.* (F.C.T.D., May 21, 1985, unreported, T-1543-84) at pp. 9-10 [since reported 5 C.P.R. (3d) 225 at p. 231] it is evident that the question of confusion should be assessed in a bilingual context in which both the English and French languages are accorded equal importance. It appears to me that there are two basic ways in which this goal might be accomplished: i) assess the question of confusion in the context of unilingual francophones, unilingual anglophones and bilingual persons and then if two trade marks are confusing to the average member of any of these groups conclude that the trade marks are confusing, or ii) assess the question of confusion in the context of bilingual persons only. The former approach would appear to be flawed in that it is inconsistent with the long established principle that trade marks which are descriptive in English or French of the wares or services with which they are associated are weak and only entitled to a narrow ambit of protection: see, e.g., *General Motors Corp. v. Bellows* (1949), 10 C.P.R. 101. If one followed the former approach, one would have to conclude that most trade marks which are descriptive in the English language only are still strong because they would have no meaning for an average unilingual francophone and *vice versa*. This could effectively permit individuals to obtain monopolies in descriptive words which would clearly be contrary to the public interest and to the intent of the Trade Marks

Act. The latter approach of considering the question of confusion in the context of bilingual persons only is somewhat artificial in that only a minority of Canadians are actually bilingual; however, because of the above discussed flaw with the former approach, I consider it much more reasonable to follow the latter approach.

In view of the above, I find that the evidence of both Mr. Reich and Mr. Barbaud is at least of some assistance in the present case as it related to the pronunciation of the trade-marks at issue from the point of view of the average anglophone and the average francophone, bearing in mind that the assessment of the pronunciation of the trade-marks at issue from the perspective of the average bilingual Canadian is based in part on the pronunciation of the trade-marks by the average anglophone and the average francophone. I have concluded that the trade-marks IXEL and PAXIL, when considered in their entireties from the perspective of the average bilingual consumer, would bear a fair degree of similarity in sounding, even bearing in mind that greater emphasis is placed on the initial components of trade-marks when considering the degree of similarity between them in their sounding.

Having regard to the degree of similarity in sounding between the trade-marks at issue as applied to identical wares which could travel through the same channels of trade, and considering that care must be exercised in applying the standard under Subsection 6(2) of the *Act* in the pharmaceutical field, I am left in doubt on the issue of confusion and therefore find that the applicant has failed to meet the legal burden upon it of satisfying the Registrar that there would be no reasonable likelihood of confusion between its trade-mark IXEL and the opponent's registered trade-mark PAXIL. Consequently, the applicant's trade-mark is not registrable in view of Paragraph 12(1)(d) of the *Trade-marks Act*.

Having been delegated authority by the Registrar of Trade-marks pursuant to Subsection 63(3) of the *Trade-marks Act*, I refuse the applicant's application pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC THIS 11<sup>th</sup> DAY OF SEPTEMBER, 1998.

G.W.Partington,  
Chairperson,  
Trade-marks Opposition Board.