

**IN THE MATTER OF AN OPPOSITION by Vision-Care
Limited to application No. 772,485 for the trade-mark
VISION CARE & Design filed by Hoya
Corporation**

On January 9, 1995, the applicant, Hoya Corporation, filed an application to register the trade-mark VISION CARE & Design based upon use of the trade-mark in Canada in association with lenses for eyeglasses since at least as early as 1962. By letter dated February 22, 1995, the applicant amended its date of first use to read “at least as early as December 20, 1993”. Pursuant to an examiner’s request, the applicant disclaimed the right to the exclusive use of the words VISION CARE apart from the trade-mark as a whole. The application was advertised for opposition purposes in the *Trade-marks Journal* of October 11, 1995. The mark is shown below:

The opponent, Vision-Care Limited, filed a statement of opposition on December 7, 1995. The applicant filed and served a counter statement.

The statement of opposition lists two grounds of opposition. The first is that the applicant is not the person entitled to registration of the trade-mark because “it is confusing with the trade-name of the opponent which, since June of 1980, has been in continuous use by the opponent in connection with its business of providing optical services including services of a registered optometrist and the prescription and sale of eye glasses (both frames and lenses) and contact lenses and related equipment”. The opponent has incorrectly referred to this ground of opposition as being based on Paragraph 16(3)(c) of the *Trade-marks Act*. The correct paragraph is 16(1)(c) but I shall treat this error as a technical deficiency.

The second ground of opposition is that the applicant’s trade-mark is not capable of being distinctive of the wares of the applicant in that it is likely to be confusing with the trade-name of the opponent as aforesaid.

In its pleadings the opponent has not specifically identified the trade-name on which it relies but as the applicant appears to have assumed that it is VISION-CARE LIMITED I am prepared to do the same.

In its counter statement the applicant denied the opponent's allegations and stated that it would rely in part on the fact that the words "VISION CARE" are very common in provincial and federal corporate and business names and that the term "VISION CARE" is one that is used descriptively in the optical industry.

As its evidence the opponent filed the affidavit of Sharon Goldberg. Ms. Goldberg is the President of the opponent. She provides a brief history of the opponent's business activities. Since 1980 the opponent has operated in Toronto, operating presently at five sites, with the busiest office servicing approximately 1500 clients annually. As exhibits, Ms. Goldberg has provided various examples of materials that the opponent uses which display "VISION CARE". Only one of these bears the trade-name VISION CARE LIMITED, although one does bear the name VISION CARE LTD. The rest refer to VISION CARE *simpliciter*. There is some inconsistency as to whether the opponent's name incorporates a hyphen or not, but as this is a minor variation I will consider use of either form as use of the opponent's trade-name.

As its evidence the applicant filed the affidavits of Mamoru Yamanaka and Arti Kane plus two affidavits of Herbert McPhail.

Mr. Yamanaka is the president of the applicant. He has been associated with the applicant for more than 34 years. He states that he is aware of "vision care" being used generically throughout the optical industry and throughout the world. He attaches various advertisements from optometry magazines that show the generic use of "vision care". These advertisements date from 1993 through 1997. All of the magazines but one are published in the United States of America but most of them do list subscription prices for Canada. The one magazine published in Canada is dated October 1994.

Mr. Yamanaka also provides Canadian sales figure for his company's VISION CARE & Design products for 1994, 1995 and 1996. They are \$370,000, \$560,000 and \$280,000 respectively.

Ms. Kane, a law student, provides the results of internet searches that she conducted to show use on the internet of "vision care" both generically and as part of company names.

Mr. McPhail, a trade-mark searcher, introduces copies of various Canadian trade-mark registrations for marks incorporating the word “vision” or “care”. Two of these include the words “vision care”. He also provides the results of a search of American Business Information “16 Millions Business Phone Book” database, namely Canadian telephone listings for about 20 businesses allegedly using VISION CARE in their business names. He also provides two NUANS search reports, one directed to the trade-name VISION CARE and the other directed to the trade-name CARE. In addition, Mr. McPhail provides print-outs alleging to be copies of ten articles from various Ontario newspapers that use the phrase “vision-care” or “vision care” in a generic sense. The articles date from 1994-1997.

No cross-examinations were conducted. Only the applicant filed a written argument and an oral hearing was not requested.

Both grounds of opposition turn on the issue of confusion. The material date with respect to the Section 16 ground is the applicant’s date of first use, December 20, 1993. The material date with respect to non-distinctiveness is the date of filing of the opposition, December 7, 1995 [see *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.)].

There is a legal burden on the applicant to establish that there would be no reasonable likelihood of confusion between the marks in issue. This means that if a determinate conclusion cannot be reached, the issue must be decided against the applicant [see *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293].

Subsections 16(5) and 17(1) of the *Trade-marks Act* place a burden on the opponent to establish non-abandonment of its trade-name as of the date of advertisement of the applicant’s application. This burden has been satisfied.

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-mark and trade-name 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-mark and trade-name 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 term “VISION CARE” is not inherently distinctive, consisting as it does of two ordinary dictionary words that are commonly combined. Accordingly, the opponent’s trade-name is not inherently distinctive. The applicant’s trade-mark does have some inherent distinctiveness as a result of the design portion of its mark. Consideration of the inherent distinctiveness of the trade-mark and trade-name therefore favours the applicant.

Consideration of the extent to which the applicant’s mark and the opponent’s trade-name have become known and the length of time each has been used clearly favours the opponent as of the Section 16 material date. As of the material date with respect to the distinctiveness ground, the opponent’s trade-name had been in use longer but I cannot tell whether the opponent’s trade-name or the applicant’s trade-mark had at that point of time become more known. I therefore conclude that a consideration of this factor favours the opponent as of the date of filing of the opposition, but less so than it does as of the date of the applicant’s first use.

The wares/services of the applicant and the opponent overlap. There is no evidence of the applicant’s channels of trade but it is reasonable to assume that the applicant’s lenses would be sold through opticians, conceivably even through the opponent’s offices. The applicant’s channels of trade therefore overlap with that of the opponent.

The applicant’s mark resembles the opponent’s trade-name as a result of the common use of the words “VISION CARE”. If these words were not descriptive, I would find confusion to be likely. However, all of the applicant’s evidence points to the descriptive or generic nature of the term “vision care”. The opponent has not attempted to counter the applicant’s argument that “vision care” is a generic or descriptive term. In the circumstances, despite deficiencies in the way in which much of the applicant’s evidence of third party use has been introduced, I conclude that “vision care” is a term common to the parties’ industry. As such, consumers are not likely to rely on those words to distinguish one source from another. Nevertheless, one has to say that the applicant’s trade-mark greatly resembles the opponent’s trade-name in sound and in idea suggested. Visually there is less resemblance.

As other surrounding circumstances, the applicant has pointed to the state of the register and the state of the marketplace and the lack of evidence of confusion despite more than 6 years co-existence. Given that the opponent appears to have

only been active in the Toronto area and there is no evidence as to whether or not the applicant's product is promoted or sold in that geographic area, I do not consider the lack of confusion to be of any significance.

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.)]. Also of note is the decision in *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.) which is support for the proposition that inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located. The state of the register evidence here is insufficient to lead to a conclusion that the term "VISION CARE" is commonly used in the marketplace.

The state of the marketplace evidence provided by the applicant does not demonstrate that any business is actually operating in Canada in association with a name incorporating the term "VISION CARE". It instead demonstrates that there are many listings for such companies. Nevertheless, given the large number of such listings, I am prepared to accept that the term "VISION CARE" is commonly adopted in Canada.

Having considered all of the relevant circumstances, I conclude that there would be no reasonable likelihood of confusion between the applicant's trade-mark and the opponent's trade-name as of either of the material dates. This is simply because I am satisfied that the words "VISION CARE" are words that belong in the public domain. Given the descriptive nature of these words, I do not believe that the average consumer of optical wares and services will confuse the applicant's trade-mark with the opponent's trade-name. The following words of Mr. Justice Cattanach in *Questor Commercial Inc. v. Discoverer Services Ltd.* 46 C.P.R. (2d) 58 (F.C.T.D.) at p. 62 apply well to the case at hand:

"For the appellant's mark to be confusing with the respondent's the respondent cannot rely on the common feature to both it and to other traders but must rely on something peculiar to the respondent which the appellant has adopted. This has not been done by the appellant from which it follows that the appellant's trade-mark is not confusing with the respondent's registered mark."

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 23rd DAY OF MAY, 2000.

**Jill W. Bradbury
Hearing Officer
Trade-marks Opposition Board**