

**IN THE MATTER OF AN OPPOSITION by  
Novalab Inc. to application No. 1,093,753 for  
the trade-mark NEVADENT filed by Lidl  
Stiftung & Co. Kg**

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On February 21, 2001, Lidl Stiftung & Co. Kg (the “Applicant”) filed an application to register the trade-mark NEVADENT (the “Mark”) in association with “dentifrice; tooth brushes” on the basis of registration and use in Germany.

The application was advertised in the *Trade-marks Journal* of June 30, 2004 for opposition purposes.

Novalab Inc. (the “Opponent”) filed a statement of opposition on August 27, 2004. Generally speaking, the grounds of opposition are that the Mark is not registrable pursuant to s. 12(1)(d) of the *Trade-marks Act*, R.C.S. 1985, c. T-13 (the “Act”) since it is confusing with the Opponent’s trade-mark NOVADENT of Registration No. TMA517,942 for “*solution nettoyante pour prothèses dentaires*” (cleaning solution for dental prosthesis); the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(2)(a) of the Act since, at the filing date of the application, the Mark was confusing with the Opponent’s trade-mark NOVADENT previously used in association with cleaning solution for dental prosthesis; the Mark is not distinctive and is not adapted to distinguish the Applicant’s wares from the Opponent’s wares.

The Applicant filed and served a counter statement on September 30, 2004. The Opponent’s evidence pursuant to Rule 41 of the *Trade-marks Regulations* (the “Regulations”), as it read on September 30, 2007, consists of an affidavit dated April 27, 2005 of Denis Lamothe (the “Lamothe Affidavit”). The Opponent obtained an order for the cross-examination of Mr. Lamothe, but the Opponent did not cross-examine Mr. Lamothe. The Applicant’s evidence pursuant to Rule 42 of the Regulations, as it read on September 30, 2007, consists of an affidavit dated August 9, 2005 of Karine Iskandar (the “Iskandar Affidavit”). Ms. Iskandar was not cross-examined. Only the Opponent filed a written argument. Each party was represented at an oral hearing.

As a preliminary matter, I note that the Opponent had filed two original copies of the Lamothe Affidavit. Since the Opponent was not required to file its evidence in duplicate, I have handed one original copy of the Lamothe Affidavit to the Opponent's agent at the oral hearing.

### **Material dates**

The material date for considering the issue of confusion pursuant to s. 12(1)(d) of the Act is the date of my decision [see *Park Avenue Furniture Corp v. Wickers/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)]. The material date for considering the circumstances respecting the issue of entitlement pursuant to s. 16(2)(a) of the Act is the filing date of the application. The material date with respect to the ground of opposition based upon distinctiveness has been generally accepted as the date of filing of the statement of opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

### **Analysis of the grounds of opposition**

There is an initial evidential burden on the Opponent to establish the facts relied upon in support of the grounds of opposition. Once this initial onus is satisfied, the Applicant has the burden to prove that the particular grounds of opposition should not prevent registration of the Mark [see *John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.) and *Wrangler Apparel Corp. v. The Timberland Company* (2005), 41 C.P.R. (4th) 223 (F.C.)].

### **Section 12(1)(d)**

Appended as Exhibit C to the Lamothe Affidavit is a copy of the Certificate of Registration for the trade-mark NOVADENT missing the extract of the register of trade-marks. I have exercised my discretion to check the Registrar's record [see *Quaker Oats Co. of Canada v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)]. I confirm that the Opponent owns Registration No. TMA517,942 of October 14, 1999 for the trade-mark NOVADENT

registered in association with “solution nettoyante for prothèses dentaires” (the “registered wares”) on the basis of use in Canada since at least as early as April 1991. Therefore, the burden of proof lies on the Applicant to convince the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion between the trade-marks at issue.

The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; b) the length of time the trade-marks or trade-names 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 or trade-names in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.) and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401 (S.C.C.) for a thorough discussion of the general principles that govern the test for confusion].

As a preliminary remark, I note that the Opponent in its written argument and at the oral hearing referred to numerous decisions in which this Board or the Court came to a finding of confusion between two trade-marks. As interesting as these precedents may be, they are not necessarily helpful to the Opponent since the issue of confusion between the Mark and the Opponent’s trade-mark is a question of probabilities and surrounding circumstances based on the particular facts of this case.

Considering the inherent distinctiveness of the trade-marks, I note that they both end with the suffix DENT, which is suggestive of dental hygiene products. However, since both trade-marks are coined words, I consider each of them to possess some measure of inherent distinctiveness.

Mr. Lamothe has been the Opponent's President since its incorporation. He deposes that the Opponent, which is specialised in the manufacture and distribution of dental hygiene products, has been operating under the name Novalab Inc. since its incorporation on December 22, 1993. Since then, 100% of the Opponent's revenues have been generated by the sales of the registered wares associated with the trade-mark NOVADENT. During the Opponent's last financial year, the total sales of the registered wares amounted to \$4.5 million. Since Mr. Lamothe in paragraph 6 of his affidavit refers to customers throughout the world ("*dans le monde*"), I conclude that the sales figures are not restricted to Canada. By the same token, I find it reasonable to conclude that the registered wares have been sold in Canada.

Mr. Lamothe deposes that the Opponent spends an approximate amount of \$255,000 annually for the promotion and advertising of the registered wares, primarily in Canada. He provides, *inter alia*, specimens of advertisements in retail store flyers [Exhibit B], in magazines for senior citizens [Exhibit F], in specialized periodical publications [Exhibit G] and specimens of advertisement in the October 26, 1997 and November 23, 1997 issues of *Le Journal de Montreal* [Exhibits H]. While there is no reliable evidence to show the extent of circulation of the flyers, magazines and specialized periodical publications, I can take judicial notice that *Le Journal de Montreal* has a substantial circulation [see *Northern Telecom Ltd. v. Nortel Communications Inc.* (1988), 14 C.I.P.R. 104 (T.M.O.B.)].

Paragraphs 9 and 10 of the Lamothe Affidavit read as follows:

9. *Voici maintenant, à titre d'illustration, plusieurs emballages, photos d'emballages et d'étalages en magasin des solutions nettoyantes pour prothèses hygiéniques commercialisées et vendues par la Compagnie [the Opponent] sous la marque NOVADENT. Ces photos et échantillons d'emballage sont produites [sic] en liasse sous la Cote D (de D-1 à D-6).*
10. *Les premières ventes en liaison avec la marque de commerce NOVADENT depuis le mois d'avril 1991 [sic], toutefois la Compagnie n'a pas pu retracer de factures antérieures au 3 juillet 1995 le tout, tel qu'il appert des exemples de factures illustrant des produits identifiés à la marque de commerce NOVADENT, produites en liasse sous la Cote E (de E-1 à E-3).*

I would remark that while Exhibit D does include photographs showing in-store displays of the registered wares, it includes one packaging, not several. Mr. Lamothe does not indicate when or where the photographs were taken, but it appears that at least one of them shows the registered wares in a pharmacy. The packaging, which apparently corresponds to packaging that can be seen on some photographs, displays the trade-mark NOVADENT. Although neither party commented on the packaging, I note that the company name Groupe NovaLab Inc., rather than the company name Novalab Inc., appears on the packaging. The Opponent's name appears at the top of the three invoices for the year 1995 evidencing sales of the registered wares [Exhibit E]. I would add that since the Opponent has been incorporated on December 22, 1993, I find it reasonable to conclude that the use of the trade-mark NOVADENT prior to that date would have been by a predecessor-in-title. However, there is not any reference in the Lamothe Affidavit to the use of the trade-mark NOVADENT by a predecessor-in-title. To the contrary, Mr. Lamothe states at paragraph 8 of the affidavit that the Opponent has been using the trade-mark NOVADENT in association with the registered wares since as early as April 1991.

There is no information in the Lamothe Affidavit with respect to the relationship between Groupe NovaLab Inc. and the Opponent. There is also no statement in the Lamothe Affidavit referring to the trade-mark being used, or having been used at any time, under license. I therefore have to conclude that the Opponent has not shown that it is entitled to the benefit of s. 50 of the Act so that use of the trade-mark NOVADENT by Groupe NovaLab Inc. amounts to use by the Opponent. It should be noted that this conclusion is based on the evidence filed in the present record, or lack thereof, and is not a finding with respect to the validity of the Opponent's registered trade-mark [see *Petro-Canada v. Air Miles International Holdings N.V.* (1998), 83 C.P.R. (3d) 111 (T.M.O.B.)]. Accordingly, while the trade-mark NOVADENT may have become known in Canada, the evidence shows that it may not have become known solely as the Opponent's trade-mark.

The Mark has been applied for registration on the basis of registration and use in Germany and there is no evidence that the Mark has become known to any extent in Canada. Although

there is evidence of use of the trade-mark NOVADENT, in view of the Opponent's failure to evidence use of the trade-mark by Groupe NovaLab Inc. enuring to its benefit, the length of time the trade-mark has been in use becomes of little significance.

In considering the nature of the wares and services and the nature of the trade, it is the statement of wares in the application and the statement of wares in the registration that govern the assessment of the likelihood of confusion under s. 12(d) of the Act [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe, Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)].

Although the parties' wares are not identical and are not used for the same purposes, they all correspond to dental hygiene products. According to the Lamothe Affidavit, the registered wares are sold through the Opponent's website and mail order as well as in pharmacies and retail stores. The Opponent's customers also include dentists and denturists. There is no evidence with respect to the Applicant's channels of trade. Nevertheless, I find that the likelihood of the Applicant using pharmacies to sell its wares is quite possible. Moreover, as argued by the Opponent, photographs to the Lamothe Affidavit show the registered wares either side by side or in close proximity to dentifrice. Accordingly, for the purpose of determining the likelihood of confusion, I find that the parties' channels of trade are either identical or overlap. Thus, the nature of the wares and the nature of the trade both favour the Opponent.

The remaining criterion is the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested. In most instances, it is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.*, (1980) 47 C.P.R. (2d) 145, conf. 60 C.P.R. (2d) 70 (F.C.T.D.)].

Overall, I find that there is an important degree of resemblance between the trade-marks when viewed and sounded. Since the prefix "neva" and "nova" do not have the same

connotation, I find that there is not a great degree of resemblance between the trade-marks with respect to their associated ideas.

The Applicant submits that the state of the register evidence introduced by the Iskandar Affidavit is an additional circumstance supporting a finding of no confusion.

State of the register evidence is usually introduced to show the commonality of a trade-mark or a portion of a trade-mark in relation to the register as a whole. Since it is only relevant insofar as one can make inferences from it about the state of the marketplace, it should be comprised of trade-marks which include both the applied for mark or portion of the applied for mark and that are used with wares or services similar to those at issue [see *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.)]. 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 [see *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

Ms. Iskandar, an articling law student employed by the Applicant's trade-marks agent firm, introduces into evidence the results of her searches of the *Onscope* database for locating active applications and/or registrations with respect to trade-marks incorporating: the suffix "adent" in classes 1, 3, 5 and 10 [Exhibit KIS-2] and in all classes [Exhibit KIS-3]; the suffix "dent" in classes 1, 3, 5 and 10 [Exhibit KIS-4]; the prefix "nev" in classes 1, 3, 5 and 10 [Exhibit KIS-5]; the prefix "nova" in classes 1, 3, 5 and 10 [Exhibit KIS-6]; and the prefix "nov" in classes 1, 3, 5 and 10 [Exhibit KIS-7]. Ms. Iskandar acknowledges that the same entries can be found in two different searches. For example, she notes that the 371 entries disclosed by the search for the prefix "nov" include the 218 entries disclosed by the search for the prefix "nova".

It is not an overstatement to note that the results of the searches are lengthy as the Iskandar Affidavit (presented in four volumes) amounts to 1325 pages, 1300 of which consist of Exhibit KIS-2 to KIS-7 providing the full particulars of approximately 637 trade-marks. At the oral hearing, I indicated being of the opinion that I should not be expected, as a Member

of the Trade-marks Opposition Board acting on behalf of the Registrar, to review such lengthy affidavit to make inferences from the state of the register. The Applicant's agent seemingly agreed with my opinion as he specifically identified the trade-marks listed hereafter as supporting the Applicant's contention with respect to the state of the register evidence:

- VIADENT, Registration No. TMA335,770 of December 31, 1987 for dentifrices, gum conditioner, mouthwashes and Registration No. TMA319,203 of October 3, 1986 for tooth paste and gum conditioner.
- VIVADENT, Registration No. TMA229,753 of August 18, 1978 for dental cements, cavity liners, filling materials.
- NATURADENT, Registration No. TMA170,623 of August 8, 1970 for artificial teeth.
- LAVEDENT, Registration No. TMA268,518 of April 30, 1982 for denture and partial denture cleaner.
- LEVER DENT, Registration No. TMA460,518 of July 26, 1996 for toothpaste.
- NATURE-DENT, Registration No. TMA307,149 of September 20, 1985 for tooth brushes, tooth pastes, denture cleaners, denture fasteners, tooth whiteners, and dental floss.
- NOVA, Registration No. TMA261,092 of July 24, 1981 for dental instruments.
- NOVA, Registration No. TMA463,860 of September 27, 1996 for handpiece for a dental drill.
- NOVADIOL, Registration No. TMA554,619 of November 29, 2001 for dentifrice.
- NOVAMIN, Registration No. TMA633,735 of February 24, 2005 for glass ceramic powders for use in dentifrices, tooth whitening treatments and tooth re-mineralizing treatments.
- NOVATECH NEW BIOTECHNOLOGY FOR LIFE & Design, Registration No. TMA502,269 of October 15, 1998 for tooth brushes.
- NOVATONE, Registration No. TMA311,603 of February 21, 1986 for pre-recorded audio cartridge tape players distributed to dentists in conjunction with a dental patient music service.

The Applicant's agent noted that the owner of Registration No. TMA463,860 also owns Registration No. TMA463,859 of September 27, 1996 for SUPERNOVA for handpiece for a dental drill. The Applicant's agent also noted Application No. 1,197,556 filed November 20, 2003 for the trade-mark RENOVA for dental implants and parts therefor.

I find that six (6) registrations do not allow me to conclude that the average consumer is accustomed to seeing various third party trade-marks incorporating the prefix "nova" with respect to dental products, in particular dental hygiene products, in the marketplace and



would therefore be able to distinguish the Mark from the Opponent's trade-mark. Insofar as trade-marks involving the suffix "dent" are concerned, there is arguably not much need to file state of the register evidence given the suggestive connotation of "dent" when considering the wares at issue. Overall, in my view, the state of the register evidence is not of assistance to the Applicant's case. I note that the Applicant correctly submitted that some photographs filed as Exhibit D to the Lamothe Affidavit show packaging displaying EFFERDENT, FIXODENT, STERADENT and POLIDENT and that a specimen included in Exhibit G shows an advertisement for the product LAVEDENT. Nevertheless, I have no information with respect to the use of these third parties' trade-marks in Canada.

In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. In weighing all the factors and their relative importance together, I arrived at the conclusion that the balance of probabilities is evenly balanced between a finding of confusion and a finding of no confusion. As the onus is on the Applicant to establish on a balance of probabilities that the Mark is not confusing with the registered trade-mark NOVADENT, I must find against the Applicant. I therefore find that the ground of opposition based upon s. 12(1)(d) of the Act is successful.

### **Non-entitlement**

Despite the onus of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion, the Opponent has the initial onus of proving that its alleged trade-mark was being used at the filing date of the application and that use had not been abandoned at the date of advertisement of the application [s. 16(5) of the Act].

As discussed, while there is evidence of use of the trade-mark NOVADENT, said use does not seem to benefit the Opponent. Thus, the Opponent has failed to meet its initial evidential burden respecting the ground of opposition based upon s. 16(2)(a) of the Act, which is therefore unsuccessful.

### **Distinctiveness**

As I have addressed two grounds of opposition and I have already found in favour of the Opponent under the ground of opposition based upon s. 12(1)(d) of the Act, I see no need to

address the issue of whether or not the ground of opposition based upon non-distinctiveness would be successful.

**Conclusion**

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

DATED AT BOUCHERVILLE, QUEBEC, THIS 16<sup>th</sup> DAY OF MAY 2008.

Céline Tremblay  
Member  
Trade-marks Opposition Board