

**IN THE MATTER OF AN OPPOSITION by
Medical Developments Australia Pty. Ltd.
to application No. 1,029,405
for the trade-mark BREATH ALERT
filed by Kabushiki Kaisha Tanita**

On September 17, 1999, the applicant, Kabushiki Kaisha Tanita, filed an application to register the trade-mark BREATH ALERT. The application is based upon proposed use of the trade-mark in Canada in association with analyzers for measuring the quantity of chemicals causing bad breath for medical purposes and analyzers for measuring the quantity of chemicals causing body odors for medical purposes. The applicant has disclaimed the right to the exclusive use of the word BREATH apart from the trade-mark as a whole.

The application was advertised for opposition purposes in the Trade-marks Journal of June 6, 2001. On August 1, 2001, the opponent, Medical Developments Australia Pty. Ltd., filed a statement of opposition against the application.

The grounds of opposition are reproduced below:

- a. The application does not conform to the requirements of Section 30 of the *Trade-marks Act* in that the applicant could not have been satisfied that it was entitled to use the trade-mark BREATH ALERT in Canada in association with the wares described in the application.
- b. The trade-mark is not registrable in view of section 12(2)(b) of the *Trade-marks Act* in that the trade-mark is clearly descriptive in the English language of the character or quality of the wares in association with which it has been claimed to have been used by the applicant;
- c. The applicant is not the person entitled to registration of the trade-mark

BREATH ALERT, because it is confusing with the trade-mark BREATH-ALERT, which has previously been used in Canada by the Opponent in association with peak flow respiratory meters and has been so registered in Canada on July 22, 1997 under registration number TMA478835.

The applicant filed and served a counter statement. In addition to denying the opponent's allegations, the applicant pleaded,

- a. The application complies fully with the requirements of Section 30 of the *Trade-marks Act*.**
- b. The trade-mark is not clearly descriptive in the English language of the character or quality of the applicant's wares in association with which it is proposed to be used in Canada. The applicant's subject trade-mark BREATH ALERT as a whole is inherently distinctive and has been coined by the applicant for trade-mark purposes. The portion of the trade-mark consisting of the word BREATH has been disclaimed, but the portion consisting of the word ALERT, even though at worst it may be said to be somewhat suggestive, is not clearly descriptive of either the character or quality of the applicant's applied for wares;**
- c. The applicant's said trade-mark BREATH ALERT is registerable in the name of the applicant and registration thereof is not prevented by section 12(1)(d) as the said trade-mark is not confusing with any registered trade-mark in Canada; more particularly, the applicant says and the fact is that the said trade-mark BREATH ALERT is not confusing within the meaning of sections 2 and 6 to the registrant's trade-mark BREATH-ALERT of registration No. 478,835. In this connection, the opponent's registration No. 478,835 was cited during the course of examination of the subject trade-mark but the citation was subsequently withdrawn, which withdrawal was not at all surprising, since differences exist and are apparent in all the aspects mentioned in section 6(5)(c) and (d) as regards to the nature of the respective wares and trades of both parties. In this connection, the applicant's subject trade-mark BREATH ALERT specifically identifies "analyzers for measuring the quantity of chemicals causing bad breath for medical purposes; analyzers for measuring the quantity of chemicals causing body odors for medical purposes." On the other hand, the opponent's mark is specifically applied to "peak flow respiratory meters". Moreover, the goods of both parties can only be administered by specialized individuals, being individuals who are used to examining trade-marks and their respective products very carefully.**

Clearly, insufficient care was taken in drafting both the statement of opposition and the counter statement. First, the statement of opposition refers to the non-existent section 12(2)(b), instead of 12(1)(b). I will treat this as a mere typographical error as it has clearly not misled the applicant. Next, the opponent's reference to its trade-mark registration in its second ground of opposition has been understood by the applicant to support a registrability ground of opposition, even though the second ground begins by referring to entitlement, not registrability. Finally, the last sentence in paragraph (c) of the counter statement is clearly garbled but would be ignored in any event because it is argument and therefore does not belong in the pleadings. I take this opportunity to note that a decision by the examination section of the Trade-marks Office is not binding on this Board and does not have precedential value for this Board.

As rule 41 evidence, the opponent filed a certified copy of registration TMA478,835, for the trade-mark BREATH-ALERT for peak flow respiratory meters.

The applicant filed the affidavit of John D. Miller, a trade-mark agent, as its rule 42 evidence. Mr. Miller provides copies of pages that he obtained on November 26, 2002 from the Internet website at www.tanita.com, which he says is the website of the applicant. The pages include a description of a palm-size monitoring device for use by individuals who wish to check if their breath is fresh, which is referred to as the BREATH ALERT bad breath detector.

As rule 43 evidence, the opponent filed an affidavit of Alex Sweezey, the opponent's solicitor and trade-mark agent. He provides the results of a "WHOIS" search that he conducted on November 29, 2002, which indicates that the registrant associated with the domain name tanita.com is

Tanita Corporation of America.

Each party filed a written argument. I will disregard those portions of the applicant's written argument that refer to information that was not included in the evidence.

Although the ultimate legal burden lies on the applicant in opposition proceedings, there is an evidential burden on the opponent to first adduce sufficient evidence to support the truth of its allegations.

The first ground of opposition fails because the opponent has not pleaded or shown that the applicant was aware of the opponent's alleged rights when it filed its application. Without knowledge of the opponent's alleged rights, the applicant certainly could have been satisfied that it was entitled to use the applied for mark. Even with knowledge of the opponent's alleged rights, the applicant might have been satisfied that it was entitled to use the applied for mark on the basis that it considered the two marks to not be confusing.

The material date with respect to the paragraph 12(1)(b) ground of opposition is the date of filing of the application [see *Zorti Investments Inc. v. Party City Corporation* re application No. 766,534, January 12, 2004; *Havana Club Holdings S.A. v. Bacardi & Company Limited* re application No. 795,803, January 12, 2004; *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)].

Paragraph 12(1)(b) is reproduced below:

12. (1) Subject to section 13, a trade-mark is registrable if it is not

...

(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;

The issue as to whether the applicant's mark is clearly descriptive must be considered from the point of view of the average purchaser of the associated wares. Furthermore, the mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks*, 40 C.P.R. (2d) 25 at 27-8; *Atlantic Promotions Inc. v. Registrar of Trade Marks*, 2 C.P.R. (3d) 183 at 186]. Character means a feature, trait or characteristic of the ware and "clearly" means "easy to understand, self-evident or plain" [see *Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968), 55 C.P.R. 29 at 34].

I conclude that the mark BREATH ALERT is not clearly descriptive of any character or quality of the applicant's wares because it is not self-evident upon first impression what character or quality the mark is referring to. The mark is suggestive but that does not preclude its registration under paragraph 12(1)(b). The paragraph 12(1)(b) ground of opposition is therefore rejected.

As both parties have treated the third ground of opposition as a registrability ground, rather than an entitlement ground, I will adopt that approach. I will mention however that an entitlement ground of opposition would have failed as a result of the opponent not having met its

associated initial burden.

The opponent has met its initial burden with respect to registrability through the filing of its registration.

The material date with respect to paragraph 12(1)(d) is the date of my decision [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.)]. 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: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has 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. The weight to be given to each factor depends on the circumstances [see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1966), 66 C.P.R. (3d) 308 (F.C.T.D.)].

Both marks have the same degree of inherent distinctiveness. Neither has a great degree of inherent distinctiveness given that they both are somewhat suggestive of the associated wares.

There is no evidence that anyone in Canada other than Mr. Miller has ever accessed www.tanita.com. Thus, there is no evidence that either of the party's marks have become known to any extent in Canada.

While the opponent's trade-mark registration refers to a declaration of use having been filed on June 3, 1997, there is no evidence of the actual use or confirmation that use has continued. Nevertheless, given that the applicant's application was filed based on proposed use and it has not filed any evidence that shows that use of the mark has commenced in Canada in accordance with section 4 of the Act, a consideration of the length of time each mark has been used favours the opponent.

In the absence of evidence on the nature of the opponent's wares, it is difficult for me to fully comprehend what is the nature or purpose of "peak flow respiratory meters." However, given the reference to respiratory, it appears that the opponent's wares measure some aspect of breathing and thus their purpose/nature seems to overlap somewhat with that of the applicant's wares. Again, given the absence of evidence concerning the opponent's business, it is difficult to know if the same type of company is likely to make both types of devices, whether the opponent's devices would travel the same channels of trade as the applicant's wares, who would purchase or use the opponent's wares, or the cost of such wares. As a result, I cannot distinguish the marks based on a consideration of these factors.

The resemblance between the two parties' marks is of the highest degree, in appearance, sound and idea suggested.

Having considered all of the surrounding circumstances, I conclude that the applicant has failed to meet its onus of showing that, on a balance of probabilities, there is not a reasonable likelihood of confusion between the applicant's BREATH ALERT analyzers and the opponent's BREATH-ALERT meters. My conclusion is based primarily on the high degree of resemblance between the marks and the fact that they are both associated with "breath" related measuring devices.

Having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the *Trade-marks Act*, I refuse the application pursuant to subsection 38(8) of the Act.

DATED AT TORONTO, ONTARIO, THIS 28TH DAY OF JUNE 2004.

**Jill W. Bradbury
Member
Trade-marks Opposition Board**