IN THE MATTER OF AN OPPOSITION
by Maria Clementine Martin Klosterfrau Gmbh & Co.
to application no. 837,008 for the mark
MELISA filed by Melisa Medica Foundation

On February 19, 1997 the applicant Melisa Medica Foundation filed a application to register the trade-mark MELISA, based on proposed use in Canada, for the wares

diagnostic pharmaceutical preparation for the treatment of allergies

and for

diagnostic services.

The Examination Section of the Trade-marks Office raised the objections that (i) the mark was not registrable because it was confusing with registration no. 121,021 for the mark MELISANA covering the wares liniments, carminatives and skin lotions, (ii) “diagnostic services” was not adequately specific, and (iii) it was not clear whether the applicant was a legal entity.

The applicant overcame the above objections by amending the services to “diagnostic services relating to allergies and the treatment thereof;” by advising the Office that the applicant is a legal entity; and by arguing against the objection that the applied for mark was confusing with regn. no. 121,021. Portions of the argument presented to the Examination Section are shown below:

The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated November 10, 1999 and was opposed by Maria Clementine Martin Klosterfrau and MCM Klosterfrau Gmbh & Co. The opponent subsequently advised the Board that the first opponent had changed its name to Maria Clementine Martin Klosterfrau Gmbh & Co. and that the second opponent was not necessary as a party to the proceeding. The proceedings therefore continued in the name of Maria Clementine Martin Klosterfrau Gmbh & Co. as the opponent: see the Board ruling dated April 4, 2001 accepting an amended statement of opposition dated November 6, 2000.

It is also noted that the applicant amended its application to delete the above mentioned wares: see the Board ruling dated October 19, 2001. Thus, the application of record covers only diagnostic services relating to allergies and the treatment thereof.

The grounds of opposition are set out in paragraphs 3(a)-(c) of the statement of opposition, shown below:

The last ground of opposition has not been shown in its entirety as commentary in the nature of legal argument has been omitted.

The applicant responded by filing and serving a counter statement. The opponent's evidence consists of the affidavits of Axel Schaus, an executive of the opponent company

headquartered in Koeln, Germany; and Stewart Ingles, an executive with the sole Canadian company importing the opponent's MELISANA product. The applicant's evidence consists of the affidavits of Vera Stejskal, President of the applicant company headquartered in Stockholm, Sweden; and Kathryn Anne Marshall, law clerk. Both parties submitted a written argument and both were represented in an oral hearing.

Mr. Ingles' affidavit evidence, filed on behalf of the opponent, may be summarized as follows. Mr. Ingles is the vice-president of a company which is the sole importer of products into Canada under the mark MELISANA, trade-mark regn. no. 121,021. The opponent's product sold under the mark MELISANA is a Carmelite water, which can be applied topically or ingested. Information on product packaging indicates that the product is useful "against pains caused by gas and dietary indiscretions." Advertising indicates that the product contains "etherical oils of melissa, orange peel, myristica, cinnamon plus 9 additional herbal extracts." Mr Ingles company has been importing the MELISANA product into Canada for over forty years, and the product is currently available in more than fifty retail and/or wholesale outlets across Canada. The opponent's product is sold in 95 ml and 235 ml sized containers. In the period 1990 - 2000 inclusive, the volume of sales averaged about 1500 units of the 95 ml size and about 1800 units of the 235 ml size annually. For the same period, the value of sales averaged about $59,000 annually. Total advertising expenses for the opponent's MELISANA for the period 1990 - 2000 amounted to about $3000 annually. The exhibit material attached to Mr. Ingles' affidavit shows that the opponent's mark MELISANA is prominently featured on product packaging and in print advertising. Mr. Schaus' affidavit evidence corroborates Mr. Ingles' evidence.

Ms. Marshall's evidence reveals that "carminative" is an agent found in a variety of herbs that aid in the expulsion of gas from the gastrointestinal tract thereby soothing the gut wall and reducing pain and the production of gas in the digestive tract. Carmelite water is a fragrant herbal water used *inter alia* for the relief of gas and dietary problems. It is composed of a variety of herbal ingredients, usually with one or more carminative. Melissa is a herb and is a member of the mint family which may be used as a carminative. I would add that Ms. Marshall's evidence contains hearsay aspects which I have disregarded.

Ms. Stejskal's affidavit evidence explains that the applicant is a non-profit organization founded in Sweden in 1992. The applicant provides information and sponsors research about the harmful effects of metals on man and on the environment. Paragraphs 3 - 5 of her affidavit are reproduced below:

The determinative issue raised by the statement of opposition is whether the applied for mark MELISA is confusing with opponent's mark MELISANA. The material dates to assess the issue of confusion are (i) the date of my decision with respect to the first ground of opposition alleging non-registrability, (ii) the date of filing the subject application namely, February 19, 1997 with respect to the second ground of opposition alleging non-entitlement, and (iii) the date of filing the statement of opposition namely, February 19, 1997 with respect to the last ground of opposition alleging non-distinctiveness: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 C.P.R.(3d) 198 at 206 - 209 (F.C.T.D.). In the circumstances of this case, nothing turns on whether the issue of confusion is assessed at any particular material date.

The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2) of the *Trade-marks Act*, between the applied for mark MELISA and the opponent's mark MELISANA. In determining whether there would be a reasonable likelihood of confusion, I am to have regard to all the surrounding circumstances, including those enumerated in Section 6(5) of the *Act*. The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.).

The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in Section

6(5) of the *Act*: the inherent distinctiveness of the marks 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; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D).

The opponent's mark MELISANA is a coined word which possesses a fair degree of inherent distinctiveness. However, the distinctiveness of the mark is lessened to the extent that the mark is suggestive of the ingredient melissa comprising the opponent's product. The opponent's mark MELISANA had acquired at least some reputation in Canada at all material times through sales under the mark and advertising since at least as early as 1990. The applied for mark MELISA also possesses a fair degree of inherent distinctiveness although the distinctiveness of the mark is lessened to the extent that it would be recognized as an acronym.

The length of time that the marks have been in use in Canada favours the opponent. In my view the applicant's evidence establishes that the nature of the opponent's wares and the applicant's services are substantially dissimilar. Further, the applicant is targeting its services to a specialized medical group while the opponent's target population is the general public. The marks resemble each other to a high degree visually as the applied for mark incorporates the entirety of the opponent's mark. However, the marks are pronounced differently and neither mark suggests

any particular idea.

Having regard to the above, and keeping in mind in particular the differences between the opponent's wares and the applicant's services, that the parties' would be dealing with different classes of consumers, and that the opponent has not established a significant reputation for its mark at any material date, I find that the applicant has met the onus on it to show that the marks in issue are not confusing.

Accordingly, the opponent's opposition is rejected.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 26th DAY OF NOVEMBER, 2003.

Myer Herzig,
Member,
Trade-marks Opposition Board