IN THE MATTER OF AN OPPOSITION by Beiersdorf AG to application no. 1201819 for the trade-mark OLEVA filed by Sante Nova International Enterprises Inc.

On December 11, 2003, Sante Nova International Enterprises Inc. filed an application to register the trade-mark OLEVA based on proposed use in Canada in association with a variety of wares including personal hygiene and cosmetic products, clothing, fashion accessories and various household items.

The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated July 25, 2005, and was opposed by Beiersdorf AG on September 19, 2005. A copy of the statement of opposition was forwarded by the Registrar of Trade-marks to the applicant on October 26, 2005, as required by Section 38(5) of the *Trade-marks Act*. The applicant was granted a retroactive extension of time to file and serve a counter statement: see the Board ruling dated May 11, 2006.

The opponent's evidence consists of the affidavits of Hinnerk Ehers, Commercial Manager of Beiersdorf Canada Inc. ("BCI") and Tonia Morgan, law clerk. The applicant elected not to submit any evidence. Only the opponent submitted a written argument. Neither party requested an oral hearing.

STATEMENT OF OPPOSITION

Various grounds of opposition are pleaded, namely that (i) the applicant could not be satisfied that it was entitled to use the applied for mark OLEVA, pursuant to Section 30(i) of the *Trade-marks Act*, (ii) the applied for mark is not registrable because it is confusing with one or more of the opponent's family of NIVEA trade-mark registrations, pursuant to Section 12(1)(d) of the *Act*, (iii) the applicant is not entitled to register the applied for mark OLEVA because it is confusing with one or more of the opponent's family of NIVEA trade-marks previously used in Canada, pursuant to Section 16(3)(a), and (iv) the applied for mark OLEVA is not adapted to distinguish the applicant's wares from the wares of the opponent sold under its NIVEA marks, pursuant to Section 2.

The opponent's trade-mark registration for NIVEA and for other registrations in its family of NIVEA marks cover various items of personal hygiene and cosmetic products.

OPPONENT'S EVIDENCE

Mr. Ehers' evidence, as it pertains to the opponent's business activities in Canada, may be summarized as follows. Mr. Ehers oversees selling and marketing the opponent's products bearing the trade-mark NIVEA. His duties include print and media advertising, promotional programs, and distribution of NIVEA products. BCI is licensed to use the family of NIVEA marks for the sale of products in Canada and is the exclusive Canadian distributor of NIVEA products in Canada. The opponent's NIVEA trade-mark registrations are listed in paragraph 6 of Mr. Ehers affidavit and include, for example, NIVEA, NIVEA & Design, NIVEA VISAGE,

NIVEA MOISTURIZING LOTION & Design, NIVEA DEODORANT & Design, and NIVEA BATH CARE.

The opponent and its predecessors in title have used the family of NIVEA marks since as early as 1932. Sales in Canada for NIVEA products amounted to about $5.3 million in 1984, rising steadily to $27 million in 2005. NIVEA products are sold through retail outlet stores throughout Canada including Shoppers Drug Mart, Jean Coutu, Zellers, Walmart, Costco, Loeb and Loblaws. Since 1992 the opponent's advertising campaigns have focussed on national television and print advertising, and also on promotional campaigns, in-store displays and the distribution of redeemable coupons or free samples. The total cost of advertising and promotion amounted to about $5.2 million in 1993 rising steadily to $13.9 million in 2005.

I note that the manner of use of the opponent's marks as evidenced in exhibits attached to Mr. Ehers' affidavit indicates that the public would perceive the component NIVEA *per se* used as a trade-mark when the term NIVEA is combined with other terms or with design features: in this regard see *Nightingale Interloc v. Prodesign Ltd.* (1984), 2 C.P.R.(3d) 535 at 538 (TMOB) under the heading *Principle 1*.

Ms. Morgan's affidavit serves to introduce into evidence, among other things, copies of the opponent's trade-mark registrations.

MAIN ISSUE AND MATERIAL DATES

The main issue raised by the grounds of opposition is whether the applied for mark OLEVA, for use in association with personal hygiene and cosmetic products, clothing, fashion accessories and household items, is confusing with the opponent's mark NIVEA for use in association with personal hygiene and cosmetic products. The material dates to assess the issue of confusion are (i) the date of filing of the subject application with respect to the grounds of opposition alleging non-conformity with Section 30(i) and non-entitlement; the date of decision with respect to ground of opposition alleging non-registrability; and the date of opposition with respect to the 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 the present case, nothing turns on whether the issue of confusion is determined at any particular material date.

LEGAL ONUS AND EVIDENTIAL BURDEN

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 OLEVA and the opponent's mark NIVEA. 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.*, above, at 297-298. There is also, in accordance with the usual rules of evidence, an evidential

burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition. The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

TEST FOR CONFUSION

The test for confusion is one of first impression and imperfect recollection. 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*, namely: 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 the 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.).

Consideration of Section 6(5) Factors

The opponent's mark NIVEA possesses a fairly high degree of inherent distinctiveness as it is a coined word having no connection with the opponent's products which consist of various toiletry, cosmetic and personal care products, namely skin, body and face creams, soaps, gels and lotions. Based on the evidence of record, I find that the opponent's mark NIVEA and its family

of NIVEA marks have acquired a significant reputation in Canada at all material times. The applied for mark OLEVA also possesses a fairly high degree of inherent distinctiveness, however, there is no evidence showing that the applied for mark acquired distinctiveness. The opponent's evidence establishes that the mark NIVEA has been in substantial use in Canada since 1984, that is, for nineteen years prior to the filing of the subject application for OLEVA. The natures of the parties' wares are essentially the same or overlapping with respect to personal hygiene and cosmetic products, and I would expect that the parties' channels of trade would also be the same or overlapping with respect to such products.

There is a fair degree of resemblance between the marks NIVEA and OLEVA visually and in sounding owing to the letters E, V, and A which comprise the end portion of the marks. Further, both marks consist of five letters and three syllables. However, there is no resemblance in the ideas suggested by the marks as NIVEA and OLEVA are coined words which do not suggest any ideas in particular.

In its written argument the opponent has brought to my attention several decided cases which stand for the principle that the stronger a mark is, the greater the ambit of protection it should be accorded and the more difficult it will be for an applicant to discharge its legal onus. I agree with the opponent that the above principle has bearing in the instant case where the opponent's mark is a strong mark because it is inherently distinctive and has acquired a substantial reputation in Canada at all material times.

DISPOSITION

Having regard to the above, and (i) in the absence of evidence or legal argument on behalf of the applicant, and (ii) keeping in mind that the mark NIVEA is entitled to a wide ambit of protection, I find that the applicant has not met the legal onus on it to shown that, on a balance of probabilities, there is no reasonable likelihood of confusion between the opponent's mark NIVEA and the applied for mark OLEVA for the various wares specified in the subject application. Accordingly, the subject application is refused.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 8th DAY OF SEPTEMBER, 2008.

Myer Herzig,
Member,
Trade-marks Opposition Board