



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2011 TMOB 61
Date of Decision: 2011-04-12

**IN THE MATTER OF AN OPPOSITION
by Johnson & Johnson to application
No. 1,141,065 for the trade-mark
ACCUVISION Design in the name of
Mahrukh Panthakey**

[1] On May 15, 2002, Mahrukh Panthakey (the Applicant) filed an application to register the trade-mark ACCUVISION Design (the Mark), as shown below:



Colour is claimed as a feature of the Mark. The word ACCUVISION is in blue lettering. The letter V is in a paler tone of blue. The disc beneath the letter V is in two tones of blue with the lighter tone beneath the darker tone.

[2] The application is based on proposed use of the Mark in Canada in association with:

wares

contact lens solutions; spectacles, spectacle frames, spectacle lenses, contact lenses, sunglasses, spectacle cases, contact lens cases and containers; parts and fittings for

all the aforesaid goods;

services

optician and ophthalmic services including sight testing and ophthalmic surgery; medical and surgical services relating to eyesight and visual correction; laser and LASIK (laser assisted in situ keratomileusis) eye surgery services; consultancy services relating to all the aforesaid services.

[3] The Applicant has disclaimed the right to the exclusive use of the word VISION apart from the Mark and has claimed a convention priority filing date of November 26, 2001.

[4] The application was advertised for opposition purposes in the *Trade-marks Journal* of October 1, 2003.

[5] On December 1, 2006, Johnson & Johnson (the Opponent) filed a statement of opposition. The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[6] Both the Opponent and the Applicant elected to not file any evidence.

[7] Both parties filed a written argument and were represented at an oral hearing.

Grounds of Opposition and Applicable Material Dates

[8] The statement of opposition pleads six grounds of opposition. However, at the oral hearing, the Opponent indicated that it was withdrawing all of the grounds of opposition other than the following:

contrary to s. 38(2)(b) and 12(1)(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), the Mark is not registrable because it is confusing with the following ten registered trade-marks owned by the Opponent:

- ACUVUE registration No. TMA342,767
- ACUVUE registration No. TMA640,706
- 1-DAY ACUVUE & Ovals Design registration No. TMA632,565
- ACUVUE & Parallel Lines Design registration No. TMA572,884

- ACUVUE 2 & Ovals Design registration No. TMA575,618
- ACUVUE 2 COLOURS & Design registration No. TMA632,737
- ACUVUE ADVANCE registration No. TMA662,743
- ACUVUE BIFOCAL & Ovals Design registration No. TMA632,514
- ACUVUE OASYS registration No. TMA675,718
- ACUVUE TORIC & Ovals Design registration No. TMA575,617

[9] The material date with respect to a s. 12(1)(d) ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

Onus

[10] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Section 12(1)(d) Grounds of Opposition

[11] I have exercised the Registrar's discretion to check the register in order to confirm the existence of the registrations relied upon by the Opponent under s. 12(1)(d) [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)]. The Opponent's initial burden under s. 12(1)(d) has been met because each of the registrations is extant.

[12] I consider the Opponent's word mark ACUVUE to present its strongest position. I will therefore focus my assessment on the likelihood of confusion between ACCUVISION Design and ACUVUE. If there is not a reasonable likelihood of confusion between these two marks, then there would not be a reasonable likelihood of confusion between the Applicant's Mark and any of the other marks pleaded by the Opponent.

[13] ACUVUE is the subject of two registrations owned by the Opponent: registration No. TMA342,767 for contact lenses and registration No. TMA640,706 for the following wares and services:

wares: CD-ROMS on eye care practice and vision correction; printed material, namely pamphlets, brochures and newsletters on the topics of eye health and vision correction.

services: Consulting services, namely advising others how to manage businesses related to all aspects of health, particularly vision correction and eye care, and the development and use of pharmaceuticals, medicaments and medical products of all kinds related to vision correction and eye care; educational services, namely providing all forms of education to the public and to professionals on the subjects of all aspects of health, particularly vision correction and eye care, and the development and use of pharmaceuticals, medicaments and medical products of all kinds related to vision correction and eye care; computer services, namely providing on-line information via the Internet on the subjects of all aspects of health, particularly vision correction and eye care, and the use of pharmaceuticals, medicaments and medical products of all kinds related to vision correction and eye care; computer services, namely designing and implementing Internet websites for others; medical services, namely vision correction eye care, diagnostic and laboratory services.

[14] 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.

[15] In applying the test for confusion, I 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 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. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.).]

inherent distinctiveness of the trade-marks and the extent to which they have become known

[16] Neither mark is inherently strong. The prefix “acu” or “accu” infers the word accurate. The Applicant’s suffix VISION clearly relates to the parties’ field of interest; as does the Opponent’s suffix VUE, either as the French word that translates to English as “eyesight” or as a homonym for the English word “view”.

[17] The design and colour features of the Applicant’s Mark add somewhat to its distinctiveness.

[18] A trade-mark may acquire distinctiveness through use or promotion, but neither party has filed evidence to show use or promotion of its mark. While it is true that the Opponent’s registrations issued on the basis of declarations of use, at most this entitles me to assume *de minimis* use of the Opponent’s trade-mark [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.)]. *De minimis* use does not support a conclusion that the mark has become known to any significant extent.

length of time each trade-mark has been in use

[19] A consideration of the length of time that each mark has been in use technically favours the Opponent, but I do not consider this factor to be significant since there is no evidence that the Opponent continued to use its mark after it filed its declarations of use.

nature of the wares, services, business or trade

[20] When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties’ trade-mark application or registration that govern in respect of the issue of confusion arising under s. 12(1)(d) [*Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe, Inc. v. Dale Bohna* (1984), 58 C.P.R. (3d) 381 (F.C.A.)].

[21] According to the parties’ statements of wares and services, both parties appear to be in the eye care business; they both sell contact lenses and offer services related to vision correction,

including medical services. In the absence of evidence to the contrary, it is reasonable to conclude that their channels of trade, like their wares and services, could overlap.

degree of resemblance between the trade-marks

[22] The marks should be assessed in their entirety but it is still acceptable to "focus on a particular feature of the mark that may have a determinative influence on the public's perception of it" [see *United Artists Corp. v. Pink Panther Beauty Corp.* (1998), 80 C.P.R. (3d) 247 (F.C.A.) at 263].

[23] For all intents and purposes, the parties' marks share the same prefix and it is a well accepted principle that the first portion of a trade-mark is the most important for assessing the likelihood of confusion [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 at 188 (F.C.T.D.)].

[24] ACUVUE and ACCUVISION Design resemble each other when sounded. Although only the Applicant's Mark has design features, the enlargement of the letter "v" in the Applicant's Mark seems to ensure that the Mark will be seen as ACCU (not ACCUV) followed by the dictionary word VISION (not ISION). The first portion of each party's mark (ACCU and ACU) might suggest the word "accurate", while the ending of each party's mark (VISION and VUE) connotes a connection with eyesight. Thus they resemble each other highly in ideas suggested.

other surrounding circumstances

[25] At the oral hearing, the Applicant's agent presented me with a copy of an OHIM decision concerning an opposition between the present parties with respect to a related trade-mark. As stated in *Vivat Holdings Ltd. v. Levi Strauss & Co.* (2005), 41 C.P.R. (4th) 8 (F.C.) at paragraph 65, "evidence of foreign opposition on unproven records under foreign law is not probative." I have therefore accorded no weight to the OHIM decision.

conclusion

[26] I find that the resemblance between the marks, combined with the overlap between the wares and services associated with each, results in the balance of probabilities weighing in

favour of the Opponent insofar as the likelihood of confusion is concerned. Therefore the Mark is not registrable pursuant to s. 12(1)(d), based on registrations Nos. TMA342,767 and TMA640,706.

Disposition

[27] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

Jill W. Bradbury
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office