

**IN THE MATTER OF AN OPPOSITION
by Burnus Gesellschaft mbH
to application no. 868,969 for
the trade-mark GLYSOMED
filed by SL-special Laboratories Ltd.**

On February 11, 1998, the applicant SL-special Laboratories Ltd. filed an application to register the trade-mark GLYSOMED based on use of the mark in Canada since at least as early as October, 1994, in association with

skin care products namely, hand lotions.

The subject mark was advertised in the *Trade-marks Journal* issue dated September 23, 1998 and was opposed by Burnus Gesellschaft mbH on December 30, 1998. A copy of the statement of opposition was forwarded to the applicant on March 3, 1999. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

The statement of opposition asserts that the opponent is the owner of trade-mark reg. no. 225,397 for the mark GLYSOLID used in association with “cosmetic creams for the care of the skin.” The grounds of opposition are set out in paragraphs 1(f) to 1(h) of the pleadings, shown below:

The opponent's evidence consists of the affidavit of Stewart Ingles, a businessman involved in importing the opponent's cosmetic cream into Canada. The applicant's evidence consists of the affidavits of Stefan Hedler, President of the applicant company; Zak Patel, pharmacist; and Morine Choo, legal secretary. Only the applicant submitted a written argument and only the applicant attended at an oral hearing.

The opponent's evidence may be summarized as follows. The opponent's cosmetic cream has been sold in Canada under its mark GLYSOLID since at least as early as 1992. Exhibit material attached to Mr. Ingles' affidavit demonstrates that the mark GLYSOLID is prominently visible on product packaging and in print advertising of the wares. In the five year period 1993 -

1998, sales averaged in excess of \$137,000 annually representing about 35,000 “units” annually. It appears that a “unit” of the product is sold in a flat cylindrical container 100ml in volume. The opponent’s GLYSOLID product is advertised in several national publications. Advertising expenditures in such publications totalled about \$188,000 for the period 1993 -1999 and an additional \$99,000 was spend in co-op (i.e., with retailers) print advertising. I note that the back label on product packaging states that “GLYSOLID works by using Glycerin . . .”

The applicant’s evidence, as it pertains to this jurisdiction, may be summarized as follows. The applicant commenced using its GLYSOMED product in Canada in October 1994. The product is currently sold through drug stores, pharmacies and major chain stores across Canada. The applicant’s product is sold in 10 ml and 50 ml tubes, 150 ml jars and 250 ml bottles. Exhibit material attached to Mr. Hedler’s affidavit demonstrates that the applied for mark GLYSOMED is prominently visible on product packaging and in print advertising of the wares. The applicant estimates that GLYSOMED hand cream is sold in about 80% of retail outlets where skin cream care products are offered for sale in Canada. Wholesale value of sales increased sharply from \$54,000 in 1994-1995 to \$1.3 million in 1998- 1999. Unit sales increased from 16,000 to 552,000 over the same time period. Advertising and promotional costs are about 5% of sales for each fiscal year. A portion of paragraph 16 of Mr. Hedler’s affidavit is shown below:

The determinative issue raised by the grounds of opposition is whether the applied for mark GLYSOMED is confusing with the opponent's mark GLYSOLID. The material dates to assess the issue of confusion are the date of my decision with respect to the ground of opposition alleging non-registrability of the mark; the date of first use of the applied for mark, that is, October 31, 1994 with respect to the ground of opposition alleging that the applicant is not entitled to register its mark; and the date of opposition, that is, December 30, 1998 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.).

I will first consider the issue of confusion with the mark GLYSOLID at the earliest material date October 31, 1994 as the opponent's case is strongest at the time when the applied for mark had not become known through use and advertising.

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 GLYSOMED and the opponent's mark GLYSOLID. The presence of an 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 GLYSOLID possesses a relatively low degree of inherent distinctiveness. In this regard, when the mark GLYSOLID is used in association with skin cream, the mark is suggestive of the substance "glycerine" in a "solid" form. The mark is somewhat descriptive of the wares and therefore it is a weak mark. Similarly, the applied for mark is a weak mark because, when used in association with hand cream, the term GLYSOMED is suggestive of the "medicinal" effects of "glycerine." At the material date October 31, 1994 the applied for

mark had not acquired any reputation through use in Canada while the opponent's mark had acquired some reputation through sales and advertising of the opponent's skin cream product. In this regard, the opponent's sales of its GLYSOLID product were limited to about 140,000 units for a value of about \$250,000 prior to the introduction of the applicant's product GLYSOMED into the marketplace. The length of time that the marks have been in use slightly favours the opponent as its mark has been in use since about December 1992. The nature of the parties' wares are similar and there is a high probability that the parties' GLYSOLID and GLYSOMED products would be sold through the same retail outlets. There is a fair degree of resemblance between the marks visually and aurally owing to the common prefix GLY, although less so in ideas suggested. In this regard, the opponent's mark suggests a product in "solid" form while the applicant's mark suggests a product with "medicinal" properties.

The applicant has submitted that the significance of any resemblance between the marks is mitigated by the state of the register evidence introduced by means of the Choo affidavit. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R.(3d) 432 (TMOB) and *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). See also *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R.(3d) 349 (F.C.A.) which is support for the proposition that inferences about the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located. Ms. Choo's search locates about seven relevant registrations and, taken together with Mr. Hedler's evidence of actual marketplace use of competitive products sold under the

marks GLY DERM and GLYCERODERMINE (both located in Ms. Choo's search), I am prepared to find some third party adoption of the prefix GLY for skin care products at the earliest material date. Accordingly, the resemblance between the marks in issue attributable to the prefix GLY takes on less significance.

Having regard to all of the above, and considering in particular that the opponent's mark is a weak mark and not entitled to a wide ambit of protection, I find that the applicant has met the onus on it to show, on a balance of probabilities, that the applied for mark was not confusing with the opponent's mark at the earliest material date October 31, 1994. Accordingly, the second ground of opposition alleging that the applicant is not entitled to register the applied for mark is rejected.

The opponent's case is weaker at the later material dates because (1) the applied for mark acquired reputation through use and advertising, and (2) the opponent was unable to evidence any instances of actual confusion despite a long period of contemporaneous use of the marks in issue. Accordingly, the grounds of opposition alleging non-distinctiveness and non-registrability are also rejected.

In view of the above, the opponent's opposition is rejected.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 14th DAY OF NOVEMBER , 2003.

Myer Herzig,
Member,
Trade-marks Opposition Board

