

**IN THE MATTER OF AN OPPOSITION by
Colgate-Palmolive Canada Inc. to
Application No. 1 208 083 for the trade-mark
WALEX & Design filed by Lohmann Haas
Pharmaceuticals (China) Limited.**

On March 1, 2004, Lohmann Haas Pharmaceuticals (China) Limited (the “Applicant”) filed an application to register the trade-mark WALEX & Design (the “Mark”) reproduced below:



The application is based on proposed use in Canada in association with the applied-for wares as amended on May 19, 2005 “Leather bleaching preparations; non-medicated mouth washes and rinses; dietetic supplements, namely, vitamins, minerals, lecithin; medicated mouth washes and rinses; sanitary sponges; sanitary pads; sanitary napkins; aseptic tissues; aseptic cotton; adhesive tapes for medical purposes; veterinary vaccines; baby food, namely milk, fruit puree, breakfast cereal; materials for dressings; disinfectants; fungicides; pesticides.”

The application was advertised for opposition purposes in the *Trade-marks Journal* of July 20, 2005. On December 20, 2005, Colgate-Palmolive Canada Inc. (the “Opponent”) filed a statement of opposition against the application. An assignment dated December 29, 2006 of the Opponent’s registered trade-marks was recorded by the Canadian Intellectual Property Office in favour of The Clorox Company of Canada Ltd. The word “Opponent” will therefore be used to refer to both Colgate-Palmolive Canada Inc. and the current owner of the registered marks namely, The Clorox Company of Canada Ltd. The Applicant filed and served a counter statement generally denying the allegations in the statement of opposition. I am disregarding the portions of the counter statement which appear to constitute written argument.

The Opponent filed as its evidence, the affidavit of Andrew Striso, Vice-President of Marketing for Colgate-Palmolive Canada Inc., responsible for managing the JAVEX business in Canada. Mr. Striso was not cross-examined on his affidavit. The Applicant elected not to file any evidence. Only the Opponent filed a written argument. Neither party requested a hearing.

The grounds of opposition can be summarized as follows:

The first ground of opposition is that the application does not meet the requirements of s. 30(e) of the *Trade-marks Act*, R.C.S. 1985, c. T-13 (“the Act”) in that the Applicant did not intend to use the Mark in Canada as of the filing date of the application or did not intend to use the Mark as a trade-mark.

The second ground of opposition is that the application does not comply with the requirements of s.30(i) of the Act in that the Applicant was, at the time of filing the application, aware of the Opponent’s family of JAVEX trade-marks and could not have been satisfied as to its entitlement to use the Mark.

The third ground of opposition is that the Mark is not registrable pursuant to s. 12(1)(d) of the Act because it is confusing with the Opponent’s family of trade-marks listed in Schedule “A” of the statement of opposition.

Schedule “A” lists the following registered trade-marks:

1. registration no. UCA 039140 JAVEX LABEL & Design
2. registration no. TMA 120,689 JAVEX
3. registration no. TMA 133,522 JAVEX & Design
4. registration no. TMA 145,179 JAVEX & Design
5. registration no. TMA 150,067 JAVEX & Design
6. registration no. TMA 203,852 JAVEX & Design
7. registration no. TMA 234,695 JAVEX FOR THE UNBLEACHABLES
8. registration no. TMA 234,697 JAVEX POUR LES NON-JAVELLISABLES

9. registration no. TMA 244,012 JAVEX CHASSE TACHES
10. registration no. TMA 244,683 JAVEX STAIN AWAY
11. registration no. TMA 422,208 JAVEX CLEAN PLUS
12. registration no. TMA 447,461 JAVEX 2
13. registration no. TMA 544,551 JAVEX FIBREGARD LABEL
14. registration no. TMA 544,592 JAVEX FIBREGARD LABEL
15. registration no. TMA 544,593 JAVEX FIBREGARD LABEL

The fourth ground of opposition is that the Applicant is not the person entitled to registration pursuant to s. 16(3)(a) of the Act, because, as of the filing date of the application, the Mark was confusing with the Opponent's family of marks.

The fifth ground of opposition is that the Applicant's trade-mark is not distinctive and is not adapted so as to distinguish the Applicant's wares from the wares of the Opponent, having regard to the use by the Opponent of its trade-marks referred to above.

The material date for assessing the first and second grounds of opposition is the filing date of the application [*Georgia Pacific Corporation v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)]. While the legal onus is on the Applicant to show that its application complies with s. 30 of the Act, 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 [*John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) affirmed (1992), 42 C.P.R. (3d) 495 (F.C.A.)].

In attempting to meet its burden under the s. 30(e) ground of opposition, the Opponent relies on argument submitted by the Applicant in its counter statement. As I have disregarded these portions of the counter statement, I consider that the Opponent has not satisfied its initial onus. Thus, the first ground of opposition is dismissed.

As for the second ground of opposition, where an Applicant has provided the statement required by s. 30(i), this ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the Applicant [*Sapodilla Co. Ltd. v. Bristol-*

Myers Co. (1974), 15 C.P.R. (2d) 152 T.M.O.B.]. As this is not such a case, I am dismissing this ground of opposition.

The third ground of opposition turns on the issue of the likelihood of confusion between the Mark and the Opponent's registered marks listed above. The material date that applies to this ground of opposition is the date of my decision [*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.)]. The Opponent has met its initial onus by filing certified copies of its registrations. I note that as of this date, the Opponent's registrations are in good standing with the exception of the mark JAVEX CLEAN PLUS under number TMA 422,208 which was cancelled on January 17, 2007. For the purpose of applying the test for confusion, the most relevant of the Opponent's registered marks is the mark JAVEX & Design in association with bleach and laundry products for application to soil and stains before main wash, under registration number TMA 203,852, shown below:



and thus the third ground essentially succeeds or fails based on that registration.

As the Opponent has met its initial evidential burden, the onus is therefore on the Applicant to show on a balance of probabilities that there is no likelihood of confusion. 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 [*John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) affirmed (1992), 42 C.P.R. (3d) 495 (F.C.A.)].

Test for confusion

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.

In applying the test for confusion, the Registrar 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.)]

s. 6(5)(a) - inherent distinctiveness of the marks and the extent to which each has become known

(i) the inherent distinctiveness of the trade- mark

As the Applicant's Mark in a coined word, it possesses a high degree of inherent distinctiveness.

The Opponent's mark, JAVEX & Design, consists in part of the word JAVEL (eau de), which is the French word for bleach (*Larousse Dictionnaire français / anglais*). The word JAVEX is therefore suggestive in the French language of the Opponent's wares. I also note that the Opponent listed JAVEL water concentrate as the wares under its registrations UCA039140 and TMA 150,067.

(ii) the extent to which each has become known

The strength of a mark may increase by means of it becoming known through promotion or use. The Opponent's evidence establishes that the trade-mark JAVEX for liquid

bleach was introduced in Canada in 1935 and other JAVEX marks have since then been developed and used in the Canadian marketplace. Sales figures show JAVEX products sales from 1997 to 2005 range from over \$32,000,000 per year to over \$37,000,000 per year. For that same period, advertising and promotion figures range from over \$9,000,000 to over \$15,000,000 annually. On the other hand, the Applicant filed an application based on proposed use and elected not to file evidence.

s. 6(5)(b) - the length of time each mark has been in use

This factor favours the Opponent since its registration claims use in Canada as early as May 1968 and the evidence establishes use of the mark since 1935. Use of the Applicant's Mark has not been evidenced.

s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

When assessing the nature of the wares, it is the Applicant's statement of wares and the statement of wares appearing in the Opponent's registration that govern [*Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A), *Miss Universe, Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)]. Upon review of the respective statements of wares, I find the only wares in the Applicant's statement, which overlap with the Opponent's are: "Leather bleaching preparations and disinfectants". The remaining wares listed in the Applicant's statement, cannot be considered to overlap with the Opponent's wares as they consist of goods that fall within significantly different general classes, such as baby food, mouth wash, veterinary vaccines, sanitary pads, dietary supplements.

In terms of the nature of the trade, the evidence demonstrates that the Opponent's wares are sold in numerous stores ranging from large grocery stores to small corner stores. The Applicant has not filed any evidence in this regard; nonetheless I consider it likely that the overlapping wares would be sold in similar stores.

s. 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

I quote from the Opponent's written argument the following submissions:

...there are significant similarities between the marks in question in appearance and sound. Both marks end in "ex", and are five letters. In addition the "a" in both marks appears the same and is located in the same place in the mark. Finally, we note that the design element in the Applicant's mark is highly similar visually to the design elements incorporated in several of the Opponent's JAVEX design marks (...).

As a result of the similarities of the marks both visually and phonetically, a customer, having an imperfect recollection, would assume that the wares associated with the WALEX AND DESIGN trade-mark and the wares associated with the JAVEX marks are sold by the same company.

When applying the test for confusion, the marks must be considered in their entirety, they must not be dissected for minute comparison, nor should they be compared side by side. It is the combination of elements that constitute the trade-mark and it is the effect of the trade-mark as a whole that must be considered [*Sealy Sleep Products v. Simpson Sears* (1960) 33 C.P.R. 129 Can.Ex.Ct.].

Further, the first word of syllable in a trade-mark is more important for the purposes of distinction than those that follow [*Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)].

In applying these principles to the facts, it is clear that the first syllable of each mark is significantly different: JAV versus WAL. Although the design element in each trade-mark is similar, I find the oval shaped design to be a mere background simply framing the words and holds very little inherent distinctiveness.

In terms of the ideas suggested by the marks, the Opponent's mark is suggestive of the wares, whereas the Applicant's mark is a coined word with no apparent meaning.

In most instances, it is the resemblance between the marks in appearance, sound and ideas suggested that is the dominant factor in assessing the likelihood of confusion. [*Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.)] at 149, affirmed (1982), 60 C.P.R. (2d) 70 (F.C.A.)]. Realistically appraised, I find that the overall differences in appearance, sound and ideas suggested between JAVEX & Design and WALEX & Design are significant and that the marks bear little resemblance to one another.

Surrounding circumstances

Family of marks

As a surrounding circumstance, I have considered the Opponent's alleged use of a family of JAVEX marks. In order to support its claim that it has a family of JAVEX marks, the Opponent must show use of the alleged members of the family [*McDonald's Corp. v. Alberto-Culver Co.* (1995), 61 C.P.R. (3d) 382 (T.M.O.B.)]. There is no evidence before me of use, in accordance with s. 4 of the Act, with each of the members of the Opponent's alleged family of marks. In any event, I would not have considered the existence of the Opponent's family of marks to be relevant with respect to the issue of confusion since the Mark does not use a common feature or element of the Opponent's trade-marks [*McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.)].

Famous marks

As an additional surrounding circumstance, the Opponent argues that, as its JAVEX marks are famous they are capable of carrying the mark across product lines, and that a consumer would likely assume that the Applicant's wares are sold or authorized by the Opponent. In support of its argument, the Opponent relies on the following excerpt from

the Supreme Court of Canada in *Mattel, Inc. v. 3894207 Canada Inc.* 2006 (2006), 49 C.P.R. (4th) 321 (S.C.C.) at paragraph 63:

...fame is capable of carrying the mark across product lines where lesser marks would be circumscribed to their traditional wares or service.

However, in the same judgement, the Supreme Court of Canada continues by stating:

[63] The correct test is that which Linden J.A earlier stated at para. 33:

The totality of the circumstances will dictate how each consideration should be treated.(...)

[72] I agree with the appellant that a difference in wares or services does not deliver the knockout blow, but nor does the fame of the trade-mark. Each situation must be judged on its full factual context. (...)

[73]... the view is correct that “all of the surrounding circumstances” must be taken into consideration but that in some cases some circumstances (such as different wares) will carry greater weight than others.

Therefore, when applying the test for confusion, it is the totality of the circumstances that will dictate how each consideration must be treated. I have considered that it is a matter of first impression and imperfect recollection. I have also had regard to all the surrounding circumstances including those enumerated in s. 6(5) of the Act. The basic issue to be decided is whether a consumer who has a general and not precise recollection of the Opponent’s mark will, upon seeing the Applicant’s mark be likely to think that the parties wares originate from a common source.

In view of my conclusions above, I find that there is no reasonable likelihood of confusion between the Applicant’s mark WALEX & Design and the Opponent’s registered trade-mark, JAVEX & Design. The third ground is therefore unsuccessful.

The fourth and fifth grounds of opposition essentially turn on the issue if confusion as of the date of filing of the application and as of the date of filing the opposition. My conclusions in respect of the third ground of opposition are, for the most part applicable regarding grounds four and five. As I find that the Applicant’s mark WALEX & Design

not confusing with the Opponent's mark JAVEX & Design, these grounds are respectively dismissed.

In keeping with the spirit of the *Trade-marks Act*, and bearing in mind the public interest, it is plainly desirable that valid applications for registration should succeed.

Disposition

Having been delegated authority by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the Opponent's opposition pursuant to s. 38(8) of the Act.

DATED AT GATIENAU, QUÉBEC, THIS 10th DAY OF OCTOBER 2008.

Lynne Pelletier
Member
Trade-marks Opposition Board