

**IN THE MATTER OF AN  
OPPOSITION by Biomune Company.  
to Application No. 877202 for the  
Trade-mark MATOL BIOMUNE  
OSF PLUS and Design filed by Matol  
Biothech Laboratories Ltd.**

**I The Pleadings**

On April 23, 1998, Matol Biotech Laboratories Ltd. (the «Applicant») filed an application, based on proposed use, to register the trade-mark MATOL BIOMUNE OSF PLUS and Design as hereinafter reproduced:



(the “Mark”), in association with food supplements containing a formula using a herb, colostrum and whey extract in capsule, liquid, powder and tablet form; nasal spray; homeopathic, namely preparations and remedies for human for relief of the symptoms associated with the common cold, influenza, sinusitis, otitis media and similar conditions.

Biomune Company, a partnership comprising RPJL Corporation and IPG International Pharma GmbH, (the “Opponent”) filed on March 12, 2001 a statement of opposition raising the following grounds of opposition:

- 1) In virtue of Sections 38(2)(a) and 30 (i) of the *Trade-Marks Act*, (the “Act”), the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in view of the Applicant’s knowledge of the Opponent’s trade-mark BIOMUNE, its prior use and making known of the BIOMUNE trade-mark and

the previously filed application for the registration of the trade-mark BIOMUNE.

- 2) In virtue of Sections 38(2)(b) and 12(1)(d) of the Act, the Mark is not registrable as it is confusing with the Opponent's trade-mark BIOMUNE, certificate of registration number TMA457553, registered on May 24, 1996, in Canada.
- 3) In virtue of Sections 38(2)(c) and 16(3)(a) of the Act, the Applicant is not the person entitled to registration of the Mark as it is confusingly similar with the Opponent's trade-mark BIOMUNE previously used or made known in Canada by the Opponent.
- 4) In virtue of Sections 38(2)(c) and 16(3)(b) of the Act, the Applicant is not the person entitled to registration of the Mark as it is confusingly similar with the Opponent's trade-mark BIOMUNE for which an application for registration has been previously filed by the Opponent in Canada on March 11, 1993.
- 5) In virtue of Sections 38(2)(c) and 16(3)(c) of the Act, the Applicant is not the person entitled to registration of the Mark as it is confusingly similar with the Opponent's trade-name BIOMUNE which has been previously used in Canada by the Opponent.
- 6) Pursuant to Sections 38(2)(d) and 2 of the Act, the Applicant's Mark is not distinctive, as it does not distinguish the Applicant's wares from the wares associated with the BIOMUNE trade-mark and the BIOMUNE trade-name, whether considered at the filing date of the application or the date of filing of the statement of opposition.

The Applicant filed on March 30, 2001 a counterstatement denying essentially all grounds of opposition and adding that the wares and the nature of the trade were different.

The Opponent's evidence consists of the affidavits of Mr. Ronald E. Phylar and Ms. Maya Bhusari. The Applicant filed the affidavit of Ms. Jennifer Petras and the Opponent filed as reply evidence the affidavit of Ms. Tonia Pedro.

On November 27, 2003, the Applicant filed an amended application to amend its list of wares to read:

“Food supplements destined to human containing a formula using a herb, colostrum and whey extract in capsule, liquid, powder and tablet form; nasal spray for humans; homeopathic preparations and remedies for humans for relief of the symptoms associated with the common cold, influenza, sinusitis, otitis media and similar conditions.” (the “Wares”)

On December 15, 2003, the Board granted permission to amend the list of wares as reproduced hereinabove.

Both parties filed written argument and neither party requested an oral hearing.

## **II The Opponent’s evidence**

Mr. Ronald E. Plylar has been the Opponent’s president. He filed a certified copy of the registration for the trade-mark BIOMUNE, registration number TMA457553, in association with avian and animal vaccines. He does list the vaccines sold by the Opponent since December 19, 1989. He filed a sample of the labels used in association with each of these vaccines. The Opponent’s trade-mark BIOMUNE clearly appears on each of these labels. He did provide the yearly sales figures in Canada of the Opponent’s vaccines bearing the trade-mark BIOMUNE. They vary from approximately \$600 US to over \$150,000 US during the period of 1990 to 2001. Samples of invoices issued to Canadian customers were also filed in the record. All these invoices bear the Opponent’s trade-name Biomune Company.

Between 1989 and 2001, the Opponent attended, in the United States and in Canada, various poultry and bovine industry associations’ trade shows to promote the sale of its vaccines. At some of these trade shows, pharmaceutical companies are also present to advertise their products such as Bayer, Pharmacia and Pfizer. A copy of the literature provided by the Opponent at these trade shows, on which appears the Opponent’s trade-mark BIOMUNE, was also filed in the record.

The Opponent does also sell pharmaceuticals for human use, including a product sold under the trade-mark MAXIMUNE COQ-10, which is a dietary supplement. Its packaging (exhibit A-17 to Mr. Plylar’s affidavit) also bears, as a secondary mark, the trade-mark BIOMUNE.

The Opponent's products are distributed in Canada through the Henry Schein Company, acting as a distributor. A copy of the Henry Schein web page displaying a product category listing shows that it distributes veterinary products as well as dental and medical products for human consumption and use.

Maya Bhusari has been a student-at-law with the Opponent's agents firm. First she provides Canadian circulation figures of periodicals in which the Opponent's products were advertised. Those figures came from the *Standard Rate and Data Service* monthly directory. For any relevant issue of a periodical, the circulation figures vary from over 2500 to approximately 3600.

She conducted a trade-mark search of the Canadian Trade-mark database and located the following applications or registration:

- (1) Application number 710682 for the trade-mark BIOMUNE, owned by RPJL Corporation which has been abandoned.
- (2) Registration number TMA457553 for the trade-mark BIOMUNE, owned by the Opponent;
- (3) The present application;
- (4) Application number 877201 for the trade-mark BIOMUNE OSF, owned by the Applicant.

She also performed an Internet search of the United States trademark databases TESS and TARR but the results of such search will not be a determinant factor in my decision.

### **III The Applicant's evidence**

Ms. Petras has been an employee of the Applicant's agents firm. She conducted a search on the Internet on the company Biomune Systems, Inc. and filed a web page containing information on its merger with Donlar Corporation. This portion of the evidence is irrelevant to the grounds of opposition raised by the Opponent. In fact in its written argument the Applicant does not refer to such evidence. In any event, there is no evidence of use in Canada of the trade-name Biomune Systems, Inc. that could have an effect on the distinctiveness of the Opponent's trade-name.

She also provided extracts of the *Webster Ninth New Collegiate Dictionary, 1998*, containing the definition of the words “vaccine”, “supplement”, “spray” and homeopathic”.

#### **IV The Opponent’s reply evidence**

Tonia Pedro has been a law clerk with the Opponent’s agents firm. The relevant portions of her affidavit consist of extracts of medical dictionaries for the definition of the words “common cold”, “influenza”, “otitis media”, “remedy” and “sinusitis”. She also filed extracts of what purported to be web pages of the Applicant’s web site concerning the Applicant’s product sold under the trademark MATOL BIOMUNE OSF PLUS wherein it is mentioned that it is safe for pets and is a dietary supplement considered safe for pregnant and lactating women. It would therefore appear that such product is useful for animals and humans.

She also filed extracts of the Compendium of Veterinary Products and the Compendium of Pharmaceuticals and Specialties. She provided a list of products that are sold for human consumption and also used for the treatment and prevention of animal’s diseases.

#### **V Relevant dates and burden of proof**

The legal onus is upon the Applicant to show that its application complies with the provisions of Section 30 of the Act, but there is however an initial evidential burden on the Opponent to establish the facts relied upon by it in support of each ground of opposition. Once this initial burden is met, the Applicant still has to prove that the particular grounds of opposition should not prevent the registration of the Mark [See *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; and *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293].

The material time for considering the issue of non-entitlement based on Section 16(3) of the Act is the filing date of the application (April 23, 1998) [See Section 16 of the Act]. The material date for assessing the issue of distinctiveness is generally accepted to be the filing date of the statement of opposition (March 12, 2001). [See *Andres Wines Ltd. and E&J Gallo Winery (1975)*, 25 C.P.R.

*(2d) 126 at 130 (F.C.A.), Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A) and Metro-Goldwyn-Meyer Inc v. Stargate Connections Inc. [2004] F.C. 1185*] while the issue of registrability must be determined as of the date of the Registrar's decision. [See *Park Avenue, supra*]. Finally, the ground of opposition based on Section 30 of the Act must be assessed as of the filing date of the application. [See *Georgia-Pacific Corp. v. Scott Paper Ltd., 3 C.P.R. (3d) 469*]

## **VI Analysis of the various grounds of opposition**

The first ground of opposition is improperly pleaded as the Opponent failed to allege that the Mark would be confusing with the Opponent's trade-mark BIOMUNE. As such this ground of opposition is dismissed.

The fourth ground of opposition described above is also dismissed. Section 16(4) of the Act stipulates that the previously filed application must be pending at the time of the advertisement of the Applicant's application (October 11, 2000). The certificate of registration for the Opponent's trade-mark BIOMUNE shows that the application filed on March 11, 1993, matured to registration on May 24, 1996 and thus was no longer pending at the date of advertisement of the present application. [See *Governor and Co. of Adventurers of England trading into Hudson's Bay, commercially called Hudson's Bay Co. v. Kmart Canada Ltd., 76 C.P.R. (3d) 526 at page 528*]

In order to be successful under the third and fifth grounds of opposition described above, the Opponent had the initial burden to prove that it used in Canada its trade-mark BIOMUNE and trade-name Biomune Company prior to April 23, 1998. The evidence, summarized hereinabove, clearly establishes that the Opponent did make prior use of such trade-name and trade-mark.

The grounds of opposition two, three and five will turn on the issue of the likelihood of confusion between the Mark and the Opponent's trade-mark BIOMUNE and its trade-name Biomune Company. The difference in the material dates of these grounds of opposition will not be a determining factor in this case.

In order to determine whether the Mark is confusing with the Opponent's registered trade-mark BIOMUNE and its trade-name BIOMUNE Company, Section 6(5) of the Act directs the Registrar to have regards to all of the surrounding circumstances, including:

- i) The inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;
- ii) The length of time the trade-marks or trade-names have been in use;
- iii) The nature of the wares, services, or business;
- iv) The nature of the trade; and
- v) The degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them.

It has been established that the criteria listed in Section 6(5) of the Act are not exhaustive and it is not necessary to give each one of them equal weight [See *Clorox Co. v. Sears Canada Inc. (1992)*, 41 C.P.R. (3d) 483 (F.C.T.D.) and *Gainers Inc. v. Marchildon (1996)*, 66 C.P.R.(3d) 308 (F.C.T.D.)].

As the Opponent met its initial burden, the Applicant must convince the Registrar, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's registered trade-mark BIOMUNE and its trade-name Biomune Company. [See *Sunshine Biscuits Inc. v. Corporate Foods Ltd. (1982)*, 61 C.P.R. (2d) 53 and *Christian Dior, S.A. v. Dion Neckwear Ltd [2002]* 3 C.F.405].

- i) The inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known

The Opponent's trade-mark BIOMUNE is a coined word. It has a certain degree of inherent distinctiveness. It is formed of the prefix BIO, for biologically, and the suffix MUNE, for immune. Therefore BIOMUNE could be suggestive of the character of the wares when used in association

with vaccines. The Mark, with the addition of the word “MATROL” and the letters ”OSF” has a certain degree of inherent distinctiveness.

There is no evidence of use of the Mark in association with the Wares. The Opponent has established use of its trade-mark BIOMUNE in Canada since at least 1989 in association with avian and animal vaccines. There is evidence (sales figures and appearances at various trade shows) that the Opponent’s trade-mark BIOMUNE and its trade-name Biomune Company are known to some extent in Canada. As such, this factor favors the Opponent.

ii)       The length of time the trade-marks or trade-names have been in use

As appears from the evidence described above, the Opponent has used its trade-mark BIOMUNE and its trade-name Biomune Company since at least 1989, while there is no evidence of use of the Mark by the Applicant.

This factor also favors the Opponent.

iii) and iv)       The nature of the wares, services, or business

The evidence filed by the Opponent does establish that the trade-mark BIOMUNE and the trade-name Biomune Company are primarily used in association with avian and animals vaccines. There is, however, uncontradictory evidence that they are also used in association with dietary products for human consumption. [See exhibit B-17 and paragraph 3 of Mr. Plylar’s affidavit]

The Opponent’s distributor sells products for animal and human use and dental applications. There exists on the market medicines that can be used in the treatment of both humans and animals. [See Exhibit E to Tonia Pedra’s affidavit] There is evidence that pharmaceutical companies associated with human pharmaceuticals also attend veterinary health symposia. [See Exhibit N to Mr. Plylar’s affidavit]



The Applicant did argue in its written submissions that there exists a difference in the nature of the wares and the channels of trade as the Wares are intended for human use while the Opponent's wares are for avian and animal consumption. However, the Applicant is ignoring the fact that the Opponent does sell dietary supplement for human use. There is also evidence from the Applicant's website that the Wares are safe for pets.

I conclude that there is a potential overlap in the channels of trade and the nature of the parties' respective businesses. Therefore, this factor also favors the Opponent.

v) The degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them

Mr. Justice Cattanach made the following comments in *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd. (1980)*, 47 C.P.R. (2d) 145, *conf.* 60 C.P.R. (2d) 70:

“Realistically appraised it is the degree of resemblance between the trade-marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a subservient role in the over-all surrounding circumstances.”

The marks in issue must be viewed as a whole and should not be dissected into several components in order to determine the similarities and differences. The test to apply is: would the average consumer with an imperfect recollection of the Opponent's trade-mark or trade-name, in the presence of the Applicant's Wares bearing the Mark, think that they emanate from the same source than the wares bearing the Opponent's trade-mark or trade-name? [*Canadian Schenley Distilleries Ltd. v. Canada's Manitoba Distillery Ltd. (1975)*, 25 C.P.R. (2d) 1]

Finally, the first portion of the marks in issue is an important element in determining the likelihood of confusion between them. [See *Molson Companies Ltd. v. John Labatt Ltd. (1990)*, 28 C.P.R. (3d) 357, *Conde Nast Publications Inc. v. Union des Editions Modernes (1979)*, 46 C.P.R. (2d) 183 *et* *British Drug Houses Ltd. v. Battle Pharmaceuticals (1944)*, 4 C.P.R. 48]

The dominant factor of the Mark is BIOMUNE as it is written in the centre portion of the design and in larger size letters than the words MATOL and PLUS and the letters OSF. The addition of OSF to BIOMUNE is not sufficient to distinguish the Mark from the Opponent's trade-mark BIOMUNE and its trade-name Biomune Company. Visually and phonetically, the main element of the Mark is the word BIOMUNE. This factor does also favour the Opponent.

## **VII Conclusion**

My analysis of the relevant factors leads me to conclude that the Applicant has not discharged its burden to prove, on a balance of probabilities, that the grounds of opposition two, three and five should not prevent the registration of the Mark. I based my conclusion on the fact that the dominant feature of Mark is the entire Opponent's trade-mark BIOMUNE [See *Conde Nast Publications v. Union des Editions Modernes (1979)*, 46 C.P.R. (2d) 183] and the fact that there exists a potential overlap in the channels of trade of the Wares and the Opponent's products described above.

As for the last ground of opposition, the legal burden is on the Applicant to demonstrate that the Mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada. [See *Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985)*, 4 C.P.R.(3d) 272 (T.M.O.B.)] This ground of opposition essentially turns on the issue of confusion as of the filing date of the opposition. For the reasons discussed above with respect to the second, third and fifth grounds of opposition, I find that the Applicant's Mark does not distinguish the Applicant's Wares from the Opponent's wares nor is it apt to distinguish them as it is confusing with the Opponent's trade-mark BIOMUNE and its trade-name Biomune Company. Thus, the last ground is also maintained.

Having been delegated authority by the Registrar of Trade-marks by virtue of Section 63(3) of the Act, I refuse the Applicant's application for the registration of the Mark in association with the Wares, the whole pursuant to Subsection 38(8) of the Act.

DATED, IN MONTREAL, QUEBEC, THIS 29th DAY OF JUNE 2005.

Jean Carrière,  
Member,  
Trade-marks Opposition Board.