

**IN THE MATTER OF AN OPPOSITION  
by Warner-Lambert Company LLC and  
Johnson & Johnson to application No.  
1104980 for the trade-mark PURELL filed  
by Chris Farrell Cosmetics GmbH**

On May 31, 2001, Chris Farrell Cosmetics GmbH (the “Applicant”) filed an application to register the trade-mark PURELL (the “Mark”) based upon proposed use of the Mark in Canada. The statement of wares currently reads: “cosmetics, namely blush, eyeliner, foundation, facial creams, facial lotions and hair lotions”. The application was advertised for opposition purposes in the Trade-marks Journal of March 17, 2004.

On May 17, 2004, Warner-Lambert Company LLC filed a statement of opposition against the application. The Applicant filed and served a counter statement, in which it denied the Opponent’s allegations. Warner-Lambert Company LLC subsequently requested and was granted leave to add Johnson & Johnson as a joint opponent. Both Warner-Lambert Company LLC and Johnson & Johnson will be referred to together as “the Opponents”.

The Opponents’ evidence consists of the affidavits of John Hands and Graham Robertson, and certified copies of Registration No. 499,624 and Application No. 1,326,788. The Applicant elected not to file any evidence. Neither affiant was cross-examined.

Only the Opponent filed a written argument. Neither party requested an oral hearing.

The first ground of opposition is that the Applicant could not have been satisfied that it was entitled to use the Mark pursuant to s.30(i) of the *Trade-Marks Act*, R.S.C. 1985 c.T-13 (hereinafter “the Act”) in view of the use of the mark PURELL by Johnson & Johnson, or their predecessors-in-title, in association with hand sanitizing and disinfecting preparations. As its second ground, the Opponents plead that the Mark is not registrable pursuant to s.12(1)(d) of the Act as it is confusing with Johnson & Johnson’s registered mark PURELL which is registered for the following wares: “Hand sanitizing and disinfecting preparation with anti-bacterial and anti-microbial properties and anti-bacterial and anti-microbial soaps.” As its third ground of opposition, the Opponents maintain that the Applicant is not the person entitled to registration of

the Mark pursuant to s.16(3)(a) of the Act because at the date of filing, the Mark was confusing with the trade-mark PURELL which had been previously used by Johnson & Johnson's predecessor-in-title. The Opponents allege as their fourth ground of opposition under s.16(3)(b) that the applied for mark was confusing, at the date of filing, with application no. 849,358 which had been previously filed in Canada by Johnson & Johnson's predecessor-in-title. The final ground of opposition is that the Mark is not distinctive pursuant to s. 38(2)(d) of the Act as it does not distinguish the wares proposed to be used by the applicant from those of others, including Johnson & Johnson, and their predecessors-in-title.

#### Onus

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is, however, an initial burden on the Opponents 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 Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)).

#### Section 30(i) Ground of Opposition

Where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant (see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155). As this is not such a case, I am dismissing this ground of opposition.

#### Section 16(3)(b) Ground of Opposition

As application no. 849,358 was not pending at the date of advertisement of the Mark, the Opponents have not met their burden under this ground of opposition (see s.16(4)). This ground is therefore unsuccessful.

#### Section 12(1)(d) Ground of Opposition

The Opponents' initial burden with respect to this ground has been satisfied because registration No. TMA 499,624 is in good standing. The material time for considering the circumstances

respecting the issue of confusion with a registered trade-mark pursuant to s.12(1)(d) of the Act is the date of my decision (see *Park Avenue Furniture Corporation v. Wickes/ Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)).

*the 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 or trade-names 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 or trade-names in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight.

The Supreme Court of Canada has discussed the appropriate process for assessing all the surrounding circumstances to be considered in determining whether two trade-marks are confusing in its decisions in *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401. It is with these general principles in mind that I shall now assess all of the surrounding circumstances.

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

Both marks are inherently strong because they consist of an identical coined word. The strength of Johnson & Johnson's mark has been further increased by means of it becoming known as a result of continuous use in the Canadian marketplace for over 10 years. The Opponents' evidence shows that sales of Johnson & Johnson's PURELL products in Canada by Johnson & Johnson or their predecessors-in-title, Warner-Lambert Company, LLC and Gojo Industries Inc. (A Corporation of Ohio), have increased annually since 1998, and have been between

\$1,000,000 and \$5,000,000 annually since 2002. The Opponents have also advertised the PURELL wares in print and television advertisements since 2002.

There is no evidence that the Applicant's mark has been used in Canada. This factor therefore favours the Opponents.

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

The evidence shows that Johnson & Johnson's mark has been in continuous use by Johnson & Johnson and their predecessors-in-title since at least 1998. As the Applicant's application is based on proposed use, and the Applicant has not filed any evidence of use, this factor also favours the Opponents.

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

When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark application and registration that govern in respect of the issue of confusion arising under s. 12(1)(d) (see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *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.)).

The Applicant's cosmetic products are different from Johnson & Johnson's hand sanitizing and disinfecting preparations. The parties' wares are similar, however, to the extent that they both comprise consumer products used on the body.

The Opponent has shown that its wares are inexpensive and generally retail to the consumer for between \$2 and \$5. The Opponents submit that with less expensive goods, more reliance may be placed on the marks and less care to ensure that the product is truly from the source that the consumer expects. I agree.

With respect to the channels of trade, the evidence shows that Johnson & Johnson's wares are sold in drug stores, grocery and food stores, club stores, gas and convenience stores. As the Applicant has not evidenced the nature of its proposed trade in Canada, nor limited itself to a channel of trade different than that of the Opponents, I presume the parties' channels of trade would likely overlap.

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

The parties' marks are identical in all respects.

*conclusion re likelihood of confusion*

The issue is whether a consumer who has a general and not precise recollection of Johnson and Johnson's PURELL mark, will, upon seeing the Applicant's PURELL mark, be likely to think that the related wares share a common source. I find that a consideration of all the surrounding circumstances leads me to conclude that, on a balance of probabilities, there is a reasonable likelihood of confusion between the marks as of today's date. I reach this conclusion based on the parties' overlapping wares and channels of trade, the distinctiveness acquired by Johnson & Johnson's mark through use and advertisement, the fact that the parties' marks are identical and the failure of the Applicant to file any evidence.

The s. 12(1)(d) ground is therefore successful.

#### Remaining Grounds of Opposition

The remaining grounds of opposition also turn on a determination of the issue of the likelihood of confusion between the Mark and Johnson & Johnson's mark. The material dates for assessing the likelihood of confusion in respect of the non-entitlement and non-distinctiveness grounds are, respectively, the Applicant's filing date and the date of opposition. In my view, the differences in material dates do not have any significant impact on the determination of the issue of confusion between the trade-marks of the parties. Thus, my finding above that the trade-marks are likely to be confused applies to these grounds of opposition which also succeed.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the application pursuant to s. 38(8).

DATED AT Gatineau, Quebec, THIS 8th DAY OF January, 2009.

Cindy R. Folz  
Member  
Trade-marks Opposition Board