

**IN THE MATTER OF AN OPPOSITION by  
Novartis Crop Protection Canada Inc. to application  
No. 811,236 for the trade-mark DUO SHOT\_  
filed by Rohm and Haas Company**

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**On April 30, 1996, the applicant, Rohm and Haas Company, filed an application to register the trade-mark DUO SHOT based upon proposed use of the trade-mark in Canada in association with fungicides, herbicides, insecticides and pesticides.**

**The application was advertised for opposition purposes in the *Trade-marks Journal* of October 30, 1996. On March 27, 1997, the opponent, Ciba-Geigy Canada Ltd., filed a statement of opposition. The applicant filed and served a counter statement in which it denied the grounds of opposition and advised that one of the registrations relied on by the opponent (No. 275,743) had been cancelled.**

**In 1998, the opponent advised that the mark relied upon had been assigned to Novartis Crop Protection Inc. and this company accordingly replaced Ciba-Geigy Canada Ltd. as the opponent.**

**The opponent filed as its evidence the affidavit of Gregory Jack Dunlop. As its evidence, the applicant filed the affidavit of Carol Luciani. No cross-examinations were conducted. Each party filed a written argument and an oral hearing was held at which both parties were represented.**

**Mr. Dunlop is the Vice-President of Sales & Marketing for Eastern Canada for Novartis Crop Protection Canada Inc. He provides a certified copy of registration No. 358,115 for the trade-mark DUAL. The opponent uses DUAL in association with herbicides for agricultural use. It sells the DUAL product through a distributorship network of retail sales outlets which sell the product to corn and soy bean growers.**

**Mr. Dunlop states that the opponent's predecessor began using DUAL in 1978. In 1982, it began to also use the trade-mark DUAL-CIBA-GEIGY, but use of this second mark was phased out and the registration for that mark was allowed to lapse.**

**Mr. Dunlop provides various exhibits showing how DUAL and DUAL-CIBA-GEIGY have been displayed on promotional wares and in advertising materials. The majority of these wares and materials were distributed prior to 1996. Some of these materials (such as the brochure identified as exhibit L which was distributed in 1992 and the brochure identified as exhibit M which was distributed in 1994) show how DUAL appears on the herbicide's packaging.**

The applicant has pointed out that exhibit S to the Dunlop affidavit refers to the introduction in 1997 of a product referred to as DUAL II. However, I do not consider this to contradict the opponent's claim that it used its DUAL trade-mark in 1997 as there is no indication that the original DUAL product was discontinued. In addition, I note that the packaging for the new product displays the word DUAL in different colouring from that used for II, and the symbol ® appears immediately after the word DUAL. One can therefore conclude that, despite the addition of "II", the mark DUAL is being used with the new product.

Mr. Dunlop has provided annual sales figures for DUAL herbicides for each of the years 1987 through 1997. Sales have ranged between 12 and 27 million dollars annually. In the years 1987 through 1994, in excess of 3% of sales was spent on advertising the DUAL product. In each of the years 1995, 1996 and 1997, more than half a million dollars was spent on advertising the DUAL product. Advertisements have been placed on radio and television in addition to print, and storyboards and a cassette tape evidencing same have been provided.

Ms. Luciani, a trade-mark searcher, provides what she refers to as "printouts" of Registration No. TMA 233,813 for the trade-mark VITAVAX DUAL and the particulars of application No. 838,131 for the trade-mark DUOGUARD.

#### Grounds of Opposition

At the oral hearing, the opponent withdrew its first ground of opposition.

The second ground of opposition alleges that the application does not comply with Subsection 30(i) of the *Trade-marks Act* because at the time of the application, the applicant was aware of certain registered marks of the opponent and could not therefore have been satisfied as to its entitlement to use the applied for mark. As the opponent has not filed any evidence to show that the applicant was aware of the opponent's marks, it has not satisfied its evidentiary burden and this ground of opposition therefore fails.

The third ground of opposition is based on Paragraph 12(1)(d) of the *Act*, the opponent alleging that DUO SHOT is not registrable because it is confusing with the registered marks DUAL Registration No. 358,115, DUAL-CUSTOM Registration No. 391,154 and DUAL-CIBA-GEIGY Registration No. 275,743. The Registrar has discretion to check the register in order to confirm the existence of the registrations relied upon by the opponent [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v.*

*Menu Foods Ltd.*, 11 C.P.R. (3d) 410] and I have done so. Registration No. 391,154 was expunged on November 5, 1999. Registration No. 275,743 was cancelled on January 7, 1997. Accordingly, this ground of opposition need only be considered in so far as it relates to registration No. 358,115.

The fourth ground of opposition is based on Paragraphs 16(3)(a) and (b) of the *Act*, the opponent alleging that the applicant is not the person entitled to register the mark because the mark is confusing with the opponent's trade-marks DUAL, DUAL-CUSTOM and DUAL-CIBA-GEIGY which have been used by the opponent prior to the filing of the applicant's application and for which applications were previously filed in Canada by the opponent.

With respect to the Paragraph 16(3)(a) part of this ground of opposition, there is an initial burden on the opponent to evidence use of its trade-marks prior to the applicant's filing date and to establish non-abandonment of its marks as of the date of advertisement of the applicant's application. The opponent has only succeeded in satisfying this initial burden in respect of its DUAL mark.

The second arm of the Subsection 16(3) ground of opposition, namely confusion with marks for which applications had been previously filed, will be disregarded because none of the three applications was in fact pending at the date of advertisement of the applicant's application, the applications all having issued to registration as of such date [see *Governor and Co. of Adventurers of England trading into Hudson's Bay, commonly called Hudson's Bay Co. v. Kmart Canada Ltd.*, 76 C.P.R. (3d) 526 at p. 528].

The fifth ground of opposition claims that the applicant's trade-mark is not and cannot be distinctive of the applicant because DUO SHOT is confusing with the opponent's aforementioned marks.

The material date with respect to the Paragraph 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*, 37 C.P.R. (3d) 413 (FCA)]. The material date with respect to the Paragraph 16(3)(a) ground of opposition is the date of filing of the application. The material date with respect to the non-distinctiveness ground is the date of filing of the opposition [see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.)].

#### Likelihood of Confusion

**There is a legal burden on the applicant to establish that there would be no reasonable likelihood of confusion between the marks in issue. This means that if a determinate conclusion cannot be reached, the issue must be decided against the applicant [see *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293].**

**The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in Subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Subsection 6(5) of the *Act*. Those factors specifically set out in Subsection 6(5) are: the inherent distinctiveness of the trade-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; and the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. The weight to be given to each relevant factor may vary, depending on the circumstances [see *Clorox Co. v. Sears Canada Inc.* 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].**

**Both parties' marks are inherently distinctive as neither has any meaning in association with the parties' wares. The applicant's mark has not become known to any extent whereas the opponent's DUAL mark has become known to a considerable extent as of each of the material dates.**

**The length of time the marks have been in use favours the opponent as its DUAL mark has been in use since 1978 whereas there is no evidence of any use of the applicant's mark.**

**A consideration of the nature of the wares also favours the opponent as the parties' wares are closely related and overlap with respect to herbicides.**

**Given the similarity of the wares and the absence of any evidence to the contrary, it is reasonable to assume that the parties' channels of trade are the same or would overlap.**

**The overall degree of resemblance between the marks is significant. Although the applicant's mark comprises two words, the first word of the applicant's mark is remarkably similar to the opponent's DUAL mark in appearance, sound and idea suggested. As stated in *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) at p. 188, "It is axiomatic that the first word or the first syllable in a trade mark is far the more important for the purpose of distinction."**

Another surrounding circumstance is the state of the register as evidenced in the affidavit of Ms. Luciani. However, state of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace and such inferences can only be drawn where large numbers of relevant registrations are located [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432; *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)]. Ms. Luciani's evidence of two registrations, one of which is not even for wares closely related to those in issue, is certainly insufficient to draw any inferences about the state of the marketplace.

Having considered all of the surrounding circumstances, I conclude that the applicant has failed to meet its burden of showing that there is no reasonable likelihood of confusion between its DUO SHOT mark and the opponent's DUAL mark as of any of the material dates. Accordingly, the third, fourth and fifth grounds of opposition succeed to the extent that they rely on the DUAL trade-mark.

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

DATED AT TORONTO, ONTARIO THIS 17<sup>th</sup> DAY OF JANUARY, 2001.

Jill W. Bradbury  
Hearing Officer  
Trade-marks Opposition Board