



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2017 TMOB 27
Date of Decision: 2017-03-07

IN THE MATTER OF AN OPPOSITION

Orion Corporation	Opponent
and	
Cross Vetpharm Group Limited	Applicant
1,672,457 for DEXDOMED	Application

FILE RECORD

[1] On April 11, 2014, Cross Vetpharm Group Limited filed an application to register the trade-mark DEXDOMED, based on proposed use in Canada, in association with the following goods:

veterinary pharmaceutical preparations and substances,
namely anxiolytics, analgesics and sedatives

[2] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated December 24, 2014 and was opposed by Orion Corporation on February 5, 2015. The Registrar forwarded a copy of the statement of opposition to the applicant on February 5, 2015, as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant

responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[3] The opponent's evidence consists of the declaration of Marylène Gendron; the declaration of Arja Weckman and Mikko Kemppainen (co-signed in Finland as required by Finnish law); and a certified copy of trade-mark registration no. TMA 808,418 for DEXDOMITOR standing in the name of the opponent. The applicant's evidence consists of the affidavits of Carl Gauthier and Sylvie Nadaud. No cross-examinations were conducted. Both parties filed a written argument and both were represented at an oral hearing.

STATEMENT OF OPPOSITION

[4] The grounds of opposition are found in para. 3 of the statement of opposition, reproduced below:

(A) The Opponent bases its opposition on the ground . . . that the trade-mark DEXDOMED is not registrable in view of the provisions of Section 12(1)(d)[of the *Trade-marks Act*]. The trade-mark claimed in application no. 1,672,457 is confusing with the trade-mark . . . DEXDOMITOR registered on October 5, 2011 . . . in connection with “anesthetics and sedatives for veterinary use.”

(B) The Opponent further bases its opposition on the ground . . . that the Applicant is not the person entitled to registration . . . in view of the provisions of Section 16(3)(a). At the date of filing of the application . . . the trade-mark DEXDOMED was confusing . . . with the trade-mark . . . DEXDOMITOR . . . used in Canada since at least as[sic] October 5, 2011.

(C) The Opponent bases its opposition on the ground . . . that the trade-mark . . . [DEXDOMED] is not distinctive. The trade-mark DEXDOMED . . . does not and cannot act to distinguish the wares in association with which it is proposed to be used from the wares of the Opponent nor is it adapted so[sic] to distinguish them in view of the provisions of Section 2 since the trade-mark DEXDOMED creates confusion with the trade-mark DEXDOMITOR of the Opponent.

[5] Each of the grounds of opposition turns on the issue of confusion. The material dates to assess the issue of confusion are the date of my decision with respect to the first ground; the date of filing the application (April 11, 2014) with respect to the second ground; and the date of opposition (February 5, 2015) with respect to the third ground: for a review of case law

concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 CPR(3d) 198 at 206 - 209 (FCTD). In the circumstances of this case, nothing turns on whether the issue of confusion is assessed at a particular material date.

[6] I will first review the parties' evidence before assessing the issue of confusion between the parties' marks.

OPPONENT'S EVIDENCE

Declaration of Arja Weckman and Mikko Kemppainen

[7] The opponent is a Finnish corporation having its principal place of business in Espoo, Finland. Ms. Weckman identifies herself as a Director of IPR of the opponent company; Mr. Kemppainen identifies himself as Head of Legal Affairs. Both signatures appear on the declaration. In this regard, it appears that Finnish law requires two signatures on a document to bind a corporation.

[8] The opponent is engaged in developing, producing and selling pharmaceutical products including veterinary products. In 2014 the opponent manufactured and sold about 71 million Euros worth of animal sedatives under its mark DEXDOMITOR. Affiliates of the opponent in various countries have the right to promote, market, distribute and sell DEXDOMITOR products.

[9] The Canadian affiliate is Zoetis Canada Inc. located in Kirkland, Quebec. DEXDOMITOR products have been sold in Canada since October 2010. The opponent's mark appears clearly on product packaging illustrated in Exhibit C of the joint declaration. Information regarding the DEXDOMITOR product appears on a Health Canada web site (as shown in Exhibit B) as well as in the *North American Compendium of Veterinary Products* (as shown in Exhibit D).

Marylène Gendron

[10] Ms. Gendron identifies herself as an employee of the firm representing the opponent. Her affidavit serves to introduce into evidence the results of computer searches of various data bases,

which results are attached as exhibits to her affidavit. Her evidence establishes that the opponent has registered its mark DEXDOMITOR, for use in association with sedatives for animals, in numerous countries worldwide.

APPLICANT'S EVIDENCE

Carl Gauthier

[11] Mr. Gauthier identifies himself as a trade-mark researcher working for an intellectual property research firm. At the request of the agents for the applicant, he conducted a search of the Canadian trade-marks register for “occurrences of the term DEX” for pharmaceutical and veterinary preparations. His search reported 32 such marks, including the parties’ marks DEXDOMITOR and DEXDOMED.

[12] I have included as Schedule 1 to these reasons for decision the summary of findings (the Citation Matrix) that Mr. Gauthier included at the beginning of his report.

[13] The applicant’s submission at para.18 of its written argument, based on Mr. Gauthier’s search results, is shown below:

Given the co-existence on the Canadian register and in the Canadian marketplace of DEX- marks and names for pharmaceutical and veterinary preparations, the Opponent's mark DEXDOMITOR cannot be considered to possess a high degree of inherent distinctiveness and small differences in the respective marks are sufficient to distinguish the source of the goods of the respective parties.

[14] In my view, even if there was some merit to the argument that Mr. Gauthier’s findings lead to the conclusion that the opponent’s mark does not possess a high degree of inherent distinctiveness, it does not follow that “small differences in the respective marks are sufficient to distinguish the source of the goods of the respective parties.” In this regard, while small differences may be sufficient to distinguish between weak marks, it does not follow that a mark which does not possess a high degree of inherent distinctiveness is necessarily a weak mark. There is a continuum to consider.

[15] I am more inclined to agree with the opponent’s perspective, at page 16 of its written submissions, concerning Mr. Gauthier’s evidence:

-the trade-marks at play in the present opposition proceeding do not share only the particle DEX: they share the particle DEXDOM. There is an important distinction to be drawn between the two situations;

-when we analyze the 32 trade-marks kept by Mr. Carl Gauthier in his report, we find out that none of them, except the trade-marks of the Opponent and the Applicant, share the particle DEXDOM. If Carl Gauthier had made the correct analysis, no result apart from the two trade-marks at play in this opposition proceeding would have been identified in his search report;

- . . . when we examine the products covered by the trade-marks identified in Carl Gauthier's affidavit we also find that many of these trade-marks do not cover veterinary products, which is a feature shared by the Opponent and the Applicant's products. Apart from the two trade-marks at play, only 4 other trade-marks are aimed at veterinary use;

[16] In my view, the mark DEXDOMITOR, when considered as a whole, possesses a significant degree of inherent distinctiveness because it is a coined term and no marks having the prefix portion DEXDOM, for use in association with pharmaceutical or veterinary preparations, have been evidenced. I do not consider the opponent's mark to be a weak mark.

Sylvie Nadaud

[17] Ms. Nadaud is also a trade-marks researcher, employed by the same firm as Mr. Gauthier. She searched various computer databases to discover if the term DEX has any significance as a dictionary word, geographic place name, or surname. The results of her searches indicate that the term DEX does not have such significance.

[18] I accept that the term DEX is a coined word, which to some extent supports my finding that the opponent's mark possesses a significant degree of inherent distinctiveness.

MATERIAL FACTS SUPPORTING THE SECOND GROUND OF OPPOSITION

[19] In order to support a ground of opposition based on s.16(3)(a), the opponent is required to establish that it had used its mark in Canada prior to the filing date of the subject application (April 11, 2014), and to establish that its mark had not been abandoned as of the date of advertisement of the subject application (December 24, 2014): see s.16(3), 16(5), and 17(1).

[20] The applicant argues that the opponent's evidence does not establish that the opponent had used its mark in Canada prior to April 11, 2014. Rather, the applicant argues that, on a careful reading of the evidence of Arja Weckman and Mikko Kemppainen, the opponent provides "a mere assertion of use [which] is not sufficient to meet the Opponent's burden in respect of this [s.16(3)(a)] ground of opposition."

[21] I agree with the applicant only to the extent that the declaration of Arja Weckman and Mikko Kemppainen provides scant information regarding the opponent's use of its mark in Canada. Their evidence might have been expected to be far more comprehensive and explanatory. However, on a fair reading of the declaration together with the exhibit materials, and without the benefit of cross-examination by the applicant, I find that the evidence of Arja Weckman and Mikko Kemppainen suffices to meet the opponent's statutory requirements to support the s.16(3)(a) ground of opposition. It should be noted that their evidence does no more than that; their evidence is not sufficient to establish that the opponent's mark had, at any material date, acquired any more than a minimal reputation in Canada.

[22] Accordingly, I will proceed to assess the issue of confusion central to each of the three grounds of opposition.

Meaning of Confusion between Trade-marks

[23] The determinative issue for decision is whether the applied-for mark DEXDOMED, for use in association with veterinary anxiolytics, analgesics and sedatives, is confusing with the opponent's mark DEXDOMITOR for use in association with veterinary anesthetics and sedatives. Trade-marks are confusing when there is a reasonable likelihood of confusion within the meaning of s.6(2) of the *Trade-marks Act*, shown below:

The 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 goods or services . . . associated with those trade-marks are manufactured . . . or performed by the same person, whether or not the goods or services . . . are of the same general class.

[24] Thus, s.6(2) does not concern mistaking one mark for the other, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by s.6(2) is whether purchasers of the applicant's veterinary pharmaceuticals, sold under the mark DEXDOMED, would believe that those goods were produced or authorized or licensed by the opponent who sells similar veterinary pharmaceuticals under the mark DEXDOMITOR. The legal onus is on the applicant to show, on the usual civil balance of probabilities standard, that there would be no reasonable likelihood of confusion.

Test for Confusion

[25] 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 "all the surrounding circumstances including " those specifically mentioned in s.6(5)(a) to s.6(5)(e) 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 goods, 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 and all relevant factors are to be considered. Further, all factors do not necessarily have equal weight as 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 CPR(3d) 308 (FCTD). However, as noted by Mr. Justice Rothstein in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 CPR(4th) 361 (SCC), although the degree of resemblance is the last factor cited in s.6(5), it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

CONSIDERATION OF S.6(5) FACTORS

inherent and acquired distinctiveness of the parties' marks

[26] As discussed earlier, in my view the opponent's mark DEXDOMITOR possesses a significant degree of inherent distinctiveness because it is a coined term and there is no evidence to indicate that similar third party marks, for veterinary products, exist in the marketplace. Similarly, the applied-for mark possesses a significant degree of inherent distinctiveness, although somewhat less than the opponent's mark, as the suffix MED is suggestive of a medical product. Neither party has shown that its mark had acquired any significant distinctiveness at any

of the material dates. Accordingly, the first factor does not favour either party to any significant extent at any material date.

length of time the parties' marks have been in use

[27] The opponent commenced using its mark in Canada in 2010, while there is no evidence to show that the applicant commenced using the applied-for proposed mark at any time. The second factor therefore favours the opponent at all material dates.

nature of the parties' goods and trades

[28] The parties' goods are the same (veterinary sedatives) or related (veterinary anxiolytics, analgesics and anesthetics). In the absence of evidence to the contrary, I assume that the parties' goods would be sold through the same channels of trade and to the same classes of customers. The third and fourth factors decidedly favour the opponent at all material dates.

resemblance of the parties' marks in appearance, sound and ideas suggested

[29] In considering the degree of resemblance, the Supreme Court of Canada in *Masterpiece*, above, gave guidance that resemblance is defined as the quality of being either like or similar (at para. 62) and that the approach to assessing resemblance should involve a consideration of whether there is an aspect of a trade-mark that is particularly striking or unique (para. 64). In my view, the beginning portion of the parties' marks, that is, the term DEXDOM, is that unique feature.

[30] It follows that the applied-for mark DEXDOMED resembles the opponent's mark DEXDOMITOR to a high degree visually, and in sounding, as the first portion and unique portion DEXDOM is common to both marks: see *Conde Nast Publications Inc. v. Union Des Editions Modernes* (1979) 26 CPR(2d) 183 at 188 (FCTD). Neither mark suggests any idea in particular as both marks are coined terms having no discernable meaning. The fifth factor decidedly favours the opponent owing to a high degree of resemblance in the first two aspects of resemblance.

[31] I am also mindful of the following observation, which originated in United States jurisprudence, referred to approvingly in *Source Perrier (Societe Anonyme) v. Canada Dry Ltd.* (1982), 64 CPR(2d) 116 at 121(Ont. H.C.):

. . . few would be stupid enough to make exact copies of another's mark or symbol. It has been well said that the most successful form of copying is to employ enough points of similarity to confuse the public with enough points of differences to confuse the courts.

DISPOSITION

[32] Having regard to the foregoing and in particular to the five factors discussed above, I find that the applied-for mark DEXDOMED was at all material dates confusing with the opponent's mark DEXDOMITOR. The opponent therefore succeeds on each of the three grounds of opposition. This is an example of the type of case referred to by Mr. Justice Rothstein where the degree of resemblance between the parties' marks has the greatest effect in deciding the issue of confusion.

[33] The subject application is therefore refused.

[34] This decision has been made pursuant to a delegation of authority by the Registrar of Trade-marks under s.63(3) of the *Trade-marks Act*.

Myer Herzig, Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office

APPEARANCES AND AGENTS OF RECORD

HEARING DATE: 2017-02-17

APPEARANCES

Lynda Conway FOR THE OPPONENT

Chantal Desjardins FOR THE APPLICANT

AGENTS OF RECORD

Goudreau Gage Dubuc FOR THE OPPONENT

Kirby IP Canada FOR THE APPLICANT

Schedule 1

Citation Matrix

MARK SEARCHED: DEX (DILUTION SEARCH)	CANADA	PHARMIN-USE	TOTAL
DEXO	1	0	1
DEXADRESON	1	0	1
DEXAFER	1	0	1
DEXASONE	1	0	1
DEXDOMED	1	0	1
DEXDOMITOR	1	0	1
"DEXEDRINE"	1	0	1
DEXIRON	1	0	1
DEXTROSOL	1	0	1
DEXERYL	1	0	1
DEXACILLIN	1	0	1
DEXILANT	1	0	1
DEXILANT LT	1	0	1
DEXILANT MELT	1	0	1
DEXILANT PROMELT	1	0	1
DEXILANT SOLUTAB	1	0	1
DEXILANT & DESIGN	1	0	1
DEXILANT FMT	1	0	1
DEX4	1	0	1
DEX4 & Design	1	0	1
DEXERIALS	1	0	1
DEXTRALIP	1	0	1
DEXATRIM	1	0	1
DEXATRIM NATUREL	1	0	1
DEXTRO ENERGY	1	0	1
DEXTRO ENERGY & DESIGN	1	0	1
DEXTERITY	1	0	1
DEXTRI-MALTOSE	1	0	1
SAB-DEXAMETHASONE	1	0	1
CAL-DEXTRO	1	0	1
DEX MEDICAL DISTRIBUTION	1	0	1
DEX MÉDICALE DE DISTRIBUTION	1	0	1
DEX	0	1	1
DEX 4	0	1	1
TOTAL	32	2	34