



LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2018 TMOB 8

Date of Decision: 2018-01-30

IN THE MATTER OF AN OPPOSITION

Orion Corporation

Opponent

and

Cross Vetpharm Group Limited

Applicant

1,672,620 for ANTISEDAMED

Application

INTRODUCTION

[1] The Applicant has filed an application to register the trade-mark ANTISEDAMED (the Mark), based on proposed use in Canada in association with “veterinary pharmaceutical preparations and substances, namely agents for reversing the effects of analgesics and sedatives” (the Goods).

[2] The determinative issue in this proceeding is whether the Mark is confusing with the Opponent’s trade-mark ANTISEDAN, which is registered for use in association with “pharmaceutical preparations, namely a veterinary drug useful as an antidote against alpha-2 agonists”.

[3] For the reasons that follow, I refuse the application.

THE RECORD

[4] The application for the Mark was filed on April 14, 2014, and was advertised for opposition purposes in the *Trade-marks Journal* of May 20, 2015.

[5] On September 14, 2015 the Opponent filed a statement of opposition under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). On May 31, 2016, the Opponent sought leave to file an amended statement of opposition, which was granted by the Registrar on August 1, 2016. The grounds of opposition are based upon sections 12(1)(d) (registrability), 16(3)(a) (entitlement), and 2 (distinctiveness) of the Act.

[6] The Applicant filed and served a counter statement.

[7] In support of its opposition, the Opponent filed a certified copy of its registration No. TMA398,382 for the trade-mark ANTISEDAN; the declaration of Marylène Gendron; and the declaration of Arja Weckman and Mikko Kempainen (sworn in Finland; see paragraphs 11-15 below). In support of its application, the Applicant filed the declaration of Paul Brady. No cross-examinations were conducted.

[8] Both parties filed written arguments and were represented at a hearing.

ONUS AND MATERIAL DATES

[9] The legal onus is on the Applicant to show, on a balance of probabilities, that the application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an initial evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155; and *Wrangler Apparel Corp v The Timberland Company*, 2005 FC 722, 41 CPR (4th) 223].

[10] The material dates for the grounds of opposition are set out as follows:

- Sections 38(2)(b)/12(1)(d) – the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- Sections 38(2)(c)/16(3) – the filing date of the application [section 16(3) of the Act];
- Sections 38(2)(d)/2 – the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317 at 324].

PRELIMINARY ISSUE - ADMISSIBILITY OF THE WECKMAN/ KEMPPAINEN DECLARATION

[11] The Applicant submits that the declaration of Arja Weckman and Mikko Kempainen is not a proper statutory declaration, is inadmissible as evidence, and should be disregarded in its entirety. In the alternative, if considered admissible, the Applicant submits the declaration should be accorded minimal weight.

[12] In support of its submission, the Applicant argues that from the wording of the jurat, it is not clear that the declaration and exhibits were sworn in the presence of the notary; that the document does not meet the technical requirements to be admissible as a statutory declaration because it does not follow the standard form language or an equivalent statement; and that the declaration features language more properly used in an affidavit (as the document was “sworn” as opposed to declared).

[13] The Applicant also points out that the declaration was sworn before a notary public on January 11, 2016, but that the exhibits (A through F) were sworn the next day by a different notary public, and that moreover, there is no indication the exhibits are actually the exhibits to the Weckman/Kempainen declaration as they are not identified as such.

[14] Generally, the Registrar will accept affidavits (or declarations) sworn (or declared) in foreign jurisdictions as long as they meet the requirements of that jurisdiction [88766 *Canada Inc v Kabushiki Bandai Namco Entertainment (also trading as Bandai Namco Entertainment Inc)* 2016 TMOB 74; *Fasken Martineau De Moulin LLP v In-N-Out Burgers* 2007 CanLII

80990]. I note that there is nothing in the record to suggest that the declaration was sworn or declared contrary to the laws of Finland.

[15] Moreover, it is well established that while desirable, there is no requirement, neither in the Act nor in the *Trade-marks Regulations*, for the Registrar to strictly adhere to the rules of practice of the Federal Court. It has also been held that where no objection is raised to un-notarized or incorrectly notarized exhibits when an affidavit is originally filed and served, the Registrar will not allow the opposite party to subsequently take advantage of such a technical objection, particularly if the opposition has reached a stage where there is no opportunity to correct the situation [*Boutique La Vie en Rose Inc v Unilever Canada Inc* 2005 CanLII 78190 (CA TMOB)]. I note the approach taken in *Maximilian Fur Co Inc v Maximillian for Men's Apparel Ltd* (1983), 82 CPR (2d) 146, where the Registrar accepted exhibits sworn to at a date different from the date upon which the affidavit itself was sworn, as well as sworn by a functionary different from the notary public who swore the affidavit. Under the circumstances, and based on a fair reading of the documents, I consider the Weckman/Kemppainen declaration to be admissible. I also consider exhibits A through F as part of the declaration, particularly since each exhibit is described in the declaration, and matches the description.

ANALYSIS OF THE GROUNDS OF OPPOSITION

Section 12(1)(d) Ground of Opposition

[16] The Opponent has pleaded that the Mark is not registrable because it is confusing with its registered trade-mark ANTISEDAN (see paragraph 7 above), for use in association with “pharmaceutical preparations, namely a veterinary drug useful as an antidote against alpha-2 agonists” (the Opponent’s goods).

[17] I have exercised the Registrar’s discretion to confirm that this registration is extant as of today [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB).] The Opponent has therefore met its initial evidential burden.

[18] As the Opponent has satisfied its initial burden, it is now incumbent on the Applicant to prove, on a balance of probabilities, that there is no reasonable likelihood of confusion between the parties’ trade-marks.

[19] Trade-marks are confusing when there is a reasonable likelihood of confusion within the meaning of section 6(2) of the Act:

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.

[20] Accordingly, the issue to be considered is not that of confusion between the trade-marks themselves, but confusion of goods from one source as being from another source. In the instant case, the question posed by section 6(2) of the Act is whether a consumer, with an imperfect recollection and on first impression, who sees the Applicant's Goods in association with the trade-mark ANTISEDAMED, would think that the Goods emanate from, or are sponsored by, or approved by the Opponent who sells a veterinary drug under the mark ANTISEDAN [*Glen-Warren Productions Ltd v Gertex Hosiery Ltd* (1990), 29 CPR (3d) 7 (FCTD) at 12].

[21] Factors to be considered in making an assessment as to whether two marks are confusing are "all the surrounding circumstances" including those specifically set out in section 6(5) 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; and the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, [2006] 1 SCR 772 (SCC) at para 54].

Inherent Distinctiveness

[22] The marks in issue are coined terms, which ordinarily have high degrees of inherent distinctiveness. However, the prefix portion of the Opponent's trade-mark ANTISEDAN, namely ANTI, has dictionary meanings including "opposed to; against (for example, anticlerical)", "preventing (as in antifreeze)", and "the opposite of (as in anticlimax)" (*Canadian Oxford Dictionary*, second edition). I consider that the letters following the ANTI prefix, namely SED or SEDA, could be perceived as a truncated reference to the dictionary word "sedative" and note that (i) the Opponent describes its products as "animal antidotes therefore for the reversal of

the *sedative* and analgesic effects...” (Weckman/Kemppainen declaration, paragraph 8, with emphasis added) and (ii) the meaning of the word antidote (which has the prefix “anti”), is a “medicine taken or given to counteract poison” (*Canadian Oxford Dictionary*, second edition). As the Opponent’s trade-mark is comprised in part of the components ANTI and SED, I find it to be somewhat suggestive of the Opponent’s Goods. This lessens the inherent distinctiveness of the Opponent’s trade-mark.

[23] Similarly, taking into account (i) the goods associated with the Applicant’s trade-mark ANTISEDAMED are “veterinary pharmaceutical preparations and substances, namely agents for *reversing* the effects of analgesics and *sedatives*” (emphasis added) and (ii) MED is an abbreviated reference to the word “medical”, thus suggestive of a medical product [*Orion Corporation v Cross Vetpharm Group Limited*, 2017 TMOB 27 at paragraph 26], I also consider the Applicant’s trade-mark to be suggestive of the Goods, perhaps even more so than the Opponent’s trade-mark given the suggestiveness of the suffix MED, but only slightly. The suggestive nature of the Applicant’s Mark lessens its inherent distinctiveness.

Extent Known and Length of Time in Use

[24] The application is based on proposed use, whereas the Opponent’s registration for the trade-mark ANTISEDAN is based on use and registration in Finland. Such registration in itself can establish no more than *de minimis* use and cannot give rise to an inference of significant or continuing use of the mark in Canada [*Entre Computer Centers, Inc. v. Global Upholstery Co.* (1992), 40 CPR (3d) 427 (TMOB)]. However, the Opponent has also set out evidence of use of the ANTISEDAN trade-mark in the Weckman/Kemppainen declaration.

[25] In the declaration, Arja Weckman identifies herself as the Director of IPR, and Mikko Kemppainen identifies himself as Head of Legal Affairs, of the Opponent (paragraph 1). I note that the signatures of both appear on the declaration. In this regard, it appears that Finnish law requires two signatures on a document to bind a corporation [*Orion Corporation v Cross Vetpharm Group Limited, supra*].

[26] Pertinent portions of the Weckman/Kemppainen declaration are summarized below:

- The Opponent, a Finnish corporation, is engaged in the business of developing, producing, and selling pharmaceutical products including veterinary products (paragraph 4).
- The Opponent's Animal Health Business division manufactures and sells the ANTISEDAN Products, and in 2014, the division had sales of approximately 71 million Euros (paragraph 5). I note that this figure is not broken down by product line or geographic region.
- The ANTISEDAN Products are listed in the Opponent's registration, and are animal antidotes indicated therefore for the reversal of the sedative and analgesic effects among the flagship proprietary products of the Opponent (paragraph 8).
- A copy of the extract of the Health Canada Web site identifying the ANTISEDAN Products is attached as Exhibit B (paragraph 9).
- The Opponent itself manufactures the ANTISEDAN Products. Zoetis Belgium SA and its affiliates have the exclusive right to promote, market, distribute and sell certain veterinary products, including the ANTISEDAN Products in countries including Canada. Zoetis Canada Inc. located at Kirkland, province of Quebec, Canada, is in charge of the sales and promotion of the ANTISEDAN products in Canada. The previous distributor in Canada was Pfizer Canada Inc. The grant of rights to Zoetis Belgium SA and its affiliates excludes any right whatsoever to manufacture or have manufactured the ANTISEDAN Products (paragraph 10).
- In Canada, the Products have been continuously sold across Canada under the trade-mark ANTISEDAN in connection with the Products since at least the year 2000 (paragraph 11).
- The trade-mark ANTISEDAN appears on labels affixed on the Products sold in Canada (paragraph 12). Exhibit C is a "reproduction of promotional literature where specimen

labels representative of the labels disseminated for the ANTISEDAN Products that have been sold in Canada during the last years are shown” (paragraph 12). I note that the literature in Exhibit C includes a depiction of a labelled product bottle clearly bearing the trade-mark ANTISEDAN. The literature, which introduces the ‘Comfort Care™ Program’ and its range of products, including the ANTISEDAN Product, appears to be from Pfizer Animal Health.

- Exhibit D to the declaration is an extract of the *North American Compendium of Veterinary Products* which provides details on the ANTISEDAN Products (paragraph 13).
- The declaration sets out approximate annual sales for the ANTISEDAN Products in Canada for the years 2009 – May 2015, which ranged between \$387,424 and \$765,089 CAD (paragraph 15).

[27] At the hearing, the Applicant argued that while the Opponent refers to the exclusive right of Zoetis Canada to sell product made by the Opponent, evidence of a license is conspicuously absent. The Applicant submits that there must be a license and evidence of control provided by the Opponent in order to meet the requirements of section 50, neither of which has been provided in this case.

[28] I do not consider the absence of a license to Zoetis Canada to be problematic, since it is well established that sales by intermediaries, such as a distributor, can be considered sales of a registrant, provided that the goods associated with the trade-mark originate with the registrant [*Manhattan Industries Inc. v. Princeton Manufacturing Ltd.* (1971), 4 CPR (2d) 6 (FCTD); *Osler Hoskin & Harcourt v. Canada (Registrar of Trade Marks)* (1997), 77 CPR (3d) 475 (FCTD)]. The Opponent has clearly stated that it manufactures the Opponent’s goods. In the absence of cross-examination and/or any evidence to the contrary from the Applicant, I am satisfied that the evidence of use of the trade-mark ANTISEDAN set out in the declaration shows use of this mark by the Opponent.

[29] The Applicant also argued, both in its written argument and at the hearing, that there is no evidence on record of actual use of the ANTISEDAN trade-mark in Canada. In this regard, the Applicant asserts that the only label in evidence is Exhibit C of the declaration, which is described in the Weckman/ Kemppainen declaration (at paragraph 12) as “promotional literature” and “representative of the labels” of ANTISEDAN products sold in Canada. The Applicant further noted that the “promotional literature” is undated and emanates not from the Opponent but from Pfizer Animal Health, a company which is no longer affiliated with the Opponent (and there is no evidence on record as to when this relationship ended).

[30] While the product label shown in the promotional literature in Exhibit C is not a specimen of a standalone label, in the absence of cross-examination and/or any evidence to the contrary, I consider it to be acceptable to show how the trade-mark appears on the product labels. Further, while the promotional literature is undated, the Opponent provides some context by indicating that the labels are representative of labels for the ANTISEDAN products sold in Canada during the “last years” (paragraph 12, 15). Accordingly, the length of time in use favours the Opponent.

[31] The Opponent’s evidence establishes use of the ANTISEDAN trade-mark; however, there is little evidence of promotional efforts or advertising expenditures. I therefore conclude that the Opponent’s mark has acquired at least some reputation above a minimal level. Accordingly, the extent to which the Opponent’s mark is known does not significantly favour the Opponent.

Nature of the Goods and Trade

[32] It is the Applicant’s statement of goods as defined in its application compared to the Opponent’s goods as set out in its registration that govern my determination of this factor [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc.* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)]. However, these statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the

parties' actual trades is useful in this respect [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA) at 169].

[33] Both the Applicant and the Opponent make and sell veterinary pharmaceutical preparations (Weckman/Kemppainen declaration, paragraph 4; declaration of Paul Brady, paragraph 2).

[34] The Goods are "veterinary pharmaceutical preparations and substances, namely agents for reversing the effects of analgesics and sedatives". The Opponent's goods are "pharmaceutical preparations, namely a veterinary drug useful as an antidote against alpha-2 agonists". The Opponent explains that its goods are animal antidotes for the reversal of the sedative and analgesic effects among its flagship proprietary products, which appear to include the DEXDOMITOR product (Weckman/Kemppainen declaration at paragraph 8, Exhibit C, D).

[35] At the hearing, the Applicant indicated that the Opponent's ANTISEDAN product is only approved for treating dogs (referencing the Health Canada website extract at Exhibit B, which lists the species as 'dogs'). However, there is no such limitation in the statement of goods as set out in the Opponent's registration; the statement of goods is what is to be considered. Similarly, the Applicant's submission at the hearing that the Opponent's ANTISEDAN product label features a two dog design (shown in Exhibit C), whereas the Opponent's DEXDOMITOR product label features a design with 2 dogs in another position, perhaps suggesting that these two products are sold together (reference is also made at paragraph 25 of the Applicant's written argument to the ANTISEDAN product having been purchased specifically together with the DEXDOMITOR product) is not reflected in the Opponent's statement of goods.

[36] Accordingly, I consider the parties' goods to be nearly identical. Absent evidence to the contrary, I assume that the parties' goods would be sold through the same channels of trade. Both of these factors thus favour the Opponent.

Degree of Resemblance

[37] While the degree of resemblance is the last factor cited in section 6(5) of the Act, it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion

[*Masterpiece Inc v Alavida Lifestyles Inc* (2011), 2011 SCC 27 (CanLII), 92 CPR (4th) 361 (SCC)].

[38] When considering the degree of resemblance, the trade-marks must be considered in their totality. The appropriate test is not a side by side comparison but a matter of first impression of a consumer with an imperfect recollection of an opponent's trade-mark [*Veuve Cliquot Ponsardin v Boutiques Cliquot Ltée* (2006), 2006 SCC 23 (CanLII), 49 CPR (4th) 401 at para 20].

[39] In *Masterpiece*, the Supreme Court of Canada observed that while the first word of a trade-mark may, for purposes of distinctiveness, be the most important in some cases, [*Conde Nast Publications Inc. v. Union des éditions modernes* (1979), 46 CPR (2d) 183 (FCTD)] a preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique [*Masterpiece, supra*, at para 64].

[40] Further, while the first portion of a mark may often be the most important for the purpose of distinguishing between marks, when the first or dominant portion of a mark is a descriptive or suggestive word, its importance diminishes [*Sky Solar Holdings Co, Ltd v Skypower Global*, 2014 TMOB 262 (CanLII) at paras 48-50].

[41] In its written argument, the Opponent notes that the trade-marks share the same prefix and submits that this is significant, citing *Conde Nast, supra*. The Opponent further notes that apart from sharing the same prefix *per se*, the marks share the first 8 letters in the same order, namely "ANTISEDA". The Opponent submits that considering the parties' marks in their totalities, the most striking part of the parties' marks are the same, resulting in a very high degree of resemblance both visually and phonetically (written argument, page 12).

[42] In contrast, the Applicant in its written argument submits that "in applying these principles to the marks ANTISEDAN and ANTISEDAMED the unique portions of the marks are SEDAN and SEDAMED, and having regard to the differences in these terms visually, orally and in meaning there is no real tangible danger of confusion that would arise in the marketplace" (paragraph 20).

[43] When considering the trade-marks in their totality, I consider the most striking part of the applied for trade-mark ANTISEDAMED and the Opponent's trade-mark ANTISEDAN to be the

element “ANTISEDA” leading the trade-marks to have a considerable degree of resemblance in appearance and sound. While the suffixes of the parties’ trade-marks differ, I do not find this to be particularly significant given the suggestive nature of the suffix MED. Further, the ideas suggested by the parties’ trade-marks also share some similarity, namely, the idea of a product which counteracts the effects of a sedative.

Surrounding Circumstance: Average consumers are sophisticated

[44] In its written argument, the Applicant submits that regard should be had to the sophistication of the relevant consumer base being veterinarians, veterinary clinics and the like, and that the “knowledge and sophistication of the relevant consumer base is evident from the description of the goods covered by the Opponent’s ANTISEDAN registration, i.e., “*pharmaceutical preparations, namely a veterinary drug useful as an antidote against alpha-2 agonists*””. The Applicant submits that the average Canadian would not understand the meaning of alpha-2 agonists so “clearly the targeted consumer of the Opponent’s products is a select group of informed medical professionals in the veterinary field” which is not easily confused (paragraph 24).

[45] The Opponent, in its written argument, submits that it is not only the reaction of veterinarians and pharmacists to be considered, but also the “final consumers”, namely animal owners of all types (such as farmers and breeders, which frequently consult veterinarians, as well as individual owners), being the caretakers of the animals and the ones making the decisions in regards to the health of the animals. The Opponent asserts that animals owners would not be very willing to experiment and perhaps when a specific drug is efficient (or not) on their animals they would recollect the brand of the veterinary products (following the reasoning set out in *Ciba-Geigy Canada Ltd v Apotex Inc*, [1992] 3 SCR 120).

[46] In any event, there appears to be, at least partially, a fairly sophisticated clientele, which assists the Applicant to some extent.

Surrounding Circumstance: Section 37(3) Notice Issued

[47] In its written argument, the Opponent submits as a relevant surrounding circumstance that the application was accepted with a notice under section 37(3) of the Act informing the Opponent of the publication of the Mark (Gendron declaration, paragraph 12 and Exhibit MG-6). The Opponent submits that the issuance of the section 37(3) notice informed both the Applicant and the Opponent that the Registrar “entertained doubts about the likelihood of confusion between the Mark and the Opponent’s trade-mark”.

[48] In contrast, the Applicant, in its written argument, submits that no confusion citation respecting the Opponent’s ANTISEDAN trade-mark was raised throughout the examination of the application which supports the contention that as a matter of first impression the marks are not confusing, and that some degree of deference should be given to this assessment (paragraph 27 of written argument).

[49] It is well established that a decision by an Examiner of the Canadian Intellectual Property Office has no precedential value for the Opposition Board because both the onus and evidence before an Examiner differs from that before the Opposition Board [*Thomas J Lipton Inc v Boyd Coffee Co* (1991), 40 CPR (3d) 272 (TMOB) at 277 and *Procter & Gamble Inc v Morlee Corp* (1993), 48 CPR (3d) 377 (TMOB) at 386]. I must come to a decision based solely on the evidence of record in the subject opposition proceeding. Accordingly, I do not consider the examination history, including the issuance of a section 37(3) notice, to be a relevant surrounding circumstance.

Surrounding Circumstance: Opponent’s foreign registrations and pending applications

[50] The Opponent, in its written argument, notes that Ms. Gendron’s declaration provides information about the fact that the Opponent’s trade-mark ANTISEDAN is pending or registered in approximately forty-nine countries around the world (Gendron declaration, paragraphs 1-10, Exhibits MG-3, MG-5). The Opponent submits that this provides the international context in which the Opponent sought protection of its trade-mark ANTISEDAN.

[51] It has been established that in assessing the issue of confusion, foreign registrations are irrelevant and evidence thereof should be disregarded [*Ex Hacienda Los Camichines, SA v Centenario Internacional, SA*, 2010 TMOB 215; *Pitman-Moore Ltd v Cyanamid of Canada Ltd*

(1977), 38 CPR (2d) 140 (TMOB)]. Accordingly, I do not consider this to be a relevant surrounding circumstance.

Surrounding Circumstance: Co-existence in other jurisdictions

[52] The Applicant notes that the parties' marks were not considered confusing in other jurisdictions such as the United States and Mexico (Brady declaration, paragraphs 7, 8). The Applicant submits that while not binding, the decisions of foreign trade-mark offices should have some persuasive value especially those jurisdictions in close geographical proximity and having similar laws respecting confusion (Applicant's written argument, paragraph 27). However, the mere co-existence of marks on foreign registers is not relevant to the issue of the likelihood of confusion in Canada [*Vivat Holdings Ltd v Levi Strauss & Co* (2005), 2005 FC 707 (CanLII), 41 CPR (4th) 8 (FC) at para 65]. Accordingly, I do not consider this to be a relevant surrounding circumstance.

Conclusion

[53] Having considered all of the surrounding circumstances, and in particular the high degree of resemblance between the trade-marks in issue, the length of time the trade-marks have been in use, and the strong similarity in the nature of the goods and trade, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's registered trade-mark ANTISEDAN.

[54] Accordingly, the ground of opposition based on section 12(1)(d) is successful.

Section 16(3)(a) Ground of Opposition

[55] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark because at the date of filing of April 14, 2014, the Mark was and is still confusing with the Opponent's trade-mark ANTISEDAN registered since May 22, 1992 under No. 398,382 in association with the Opponent's goods, and used in Canada since at least as early as 2000. I note the amended statement of opposition was filed to replace the Opponent's claimed date of first use from March 5, 1985 to "since at least as early as 2000".

[56] In order to meet its initial burden under section 16(3)(a) of the Act, the Opponent must show that it used the ANTISEDAN trade-mark prior to April 14, 2014 and had not abandoned such use as of May 20, 2015, the date of advertisement of the application for the Mark [section 16(5) of the Act].

[57] As discussed above in paragraphs 26 to 30, I am satisfied that the Opponent has provided evidence of use of its trade-mark ANTISEDAN in association with the Opponent's goods since prior to April 14, 2014, and that such mark was not abandoned at the date of advertisement of the application for the Mark. In particular, I note that the Opponent has provided sales figures in Canada covering the period 2009 – May 2015, which precede the filing date of the Applicant's application and carry through to approximately the date of advertisement. Thus, I am satisfied that the Opponent has met its initial burden under this ground of opposition.

[58] Since the difference in the relevant date has no impact on my previous assessment of the factors as set out in section 6(5) of the Act, I conclude that the Applicant has not discharged its onus of establishing, on a balance of probabilities, that as of April 14, 2014, there was no reasonable likelihood of confusion between the Mark and the Opponent's trade-mark ANTISEDAN.

[59] Accordingly, the ground of opposition based on section 16(3)(a) is successful.

Remaining Ground of Opposition

[60] As I have already found in favour of the Opponent under two grounds, I do not consider it necessary to address the remaining ground of opposition under section 38(2)(d) and 2 of the Act.

DISPOSITION

[61] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Jennifer Galeano
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: 2017- 09- 21

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