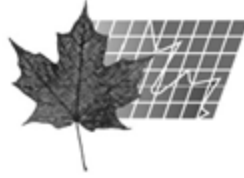


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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 230

Date of Decision: 2021-10-13

IN THE MATTER OF OPPOSITIONS

**Dermavita Company (Limited
Partnership) Parseghian & Partners**

Opponent

and

Allergan Holdings France SAS

Applicant

1,789,500 for JUVÉDERM

Applications

1,789,501 for JUVÉDERM & Design

INTRODUCTION

[1] Dermavita Company (Limited Partnership) Parseghian & Partners (the Opponent) opposes registration of the trademarks JUVÉDERM and JUVÉDERM & Design (shown below) (collectively, the Marks), which are the subject of application Nos. 1,789,500 and 1,789,501 respectively, filed by Allergan Holdings France SAS (the Applicant). For the reasons set out below, I reject both oppositions.



THE RECORD

[2] The Applicant's applications were filed on June 30, 2016 and were filed on the basis of proposed use in Canada in association with "Cosmetics, namely preparations for the treatment of glabellar lines, facial wrinkles, asymmetries and defects and conditions of the human skin, all to be sold and marketed only to licensed physicians, surgeons or healthcare professionals" (Nice Class 3).

[3] The Applicant's applications were subsequently advertised in the *Trademarks Journal* of April 5, 2017.

[4] The Opponent filed its statements of opposition regarding the applications on June 5, 2017, to which the Applicant then filed and served its counter statements denying all of the grounds of opposition.

[5] As the Act was amended on June 17, 2019, all references in this decision are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act as it read before it was amended (see section 70 of the Act which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised prior to that date).

[6] With respect to both applications, the Opponent alleges that (i) the applications do not conform to the requirements of section 30(a) of the *Trademarks Act*, RSC 1985, c T-13 (the Act); (ii) the applications do not conform to the requirements of section 30(i) of the Act; (iii) the Applicant is not the person entitled to the registration of the Marks under section 16 of the Act, and (iv) the Marks are not distinctive under section 2 of the Act. The last three grounds of opposition revolve around the likelihood of confusion between the Marks and the Opponent's priority filed trademark JUVEDERM, particulars of which are included under Schedule A to this decision.

[7] In support of its oppositions, the Opponent filed the affidavit of Mr. Houssam Adnan El-Tawil, sworn December 14, 2017. The Applicant filed a request to cross-examine Mr. Houssam,

and an order for cross-examination was issued on February 20, 2018. However, Mr. Houssam was not made available for cross-examination, and consequently, his affidavit does not form part of the evidentiary record in these proceedings [per Rule 44(5) of the *Trademarks Regulations*].

[8] In support of its applications, the Applicant filed the affidavits of Dane Penney, sworn January 18, 2019, and Nathaniel Barnes, sworn January 21, 2019. Neither affiant was cross-examined on their affidavit.

[9] Mr. Penney's affidavit includes photocopies of certified copies and Canadian Trademark Database (CTMD) printouts of the Applicant's registrations for JUVEDERM (TMA1,003,442), JUVEDERM (TMA768,844), JUVEDERM (TMA666,980), and JUVEDERM VOLITE (TMA1,006,410), as well as photocopies of a certified copy of the original application (and CTMD printouts) filed for the Opponent's application No. 1,805,896 for JUVEDERM, relied upon under its grounds of opposition, together with associated examiner's reports and responses. As discussed below, portions of Mr. Penney's affidavit are intended to refute the alleged priority filing date of the Opponent's JUVEDERM application. In this regard, Mr. Penney conducted a search of the European Union Intellectual Property Office website for registration No. 014016737 for JUVEDERM, and attaches to his affidavit a printout of the full registration particulars for this registration. Mr. Penney also conducted a search for the Opponent's Bulgarian application No. 2015136198N for JUVEDERM, as well as a search of the Norwegian Industrial Property Office website for registration No. 289642 for JUVEDERM (the Opponent's international application for registration relied upon for its priority filing date in Canada); he attaches particulars of this application and registration to his affidavit with translations of associated goods from Class 3 obtained from Google translate. Lastly, Mr. Penney conducted a search of the Goods and Services Manual on the CIPO website, with an "exact match" search under the heading "scope of searching words" to obtain a printout of the resulting page by a search for the term "cosmetics". He attaches as Exhibit G to his affidavit a printout of the results of this search.

[10] Mr. Barnes' affidavit details the Applicant's use of the Marks in Canada and around the world, including channels of trade, sales and advertising particulars. For the reasons below, it is unnecessary to address this evidence any further.

[11] The Opponent did not file reply evidence.

[12] A hearing was not requested and only the Applicant filed written representations.

THE PARTIES' RESPECTIVE BURDEN OR ONUS

[13] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the applications comply with the requirements of the Act. This means that if a determinate conclusion cannot be reached in favour of the Applicant after a consideration of all of the evidence, then the issue must be decided against the Applicant. However, there is an initial evidential burden on the Opponent 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 Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

ANALYSIS

Section 30(a) and 30(i) Grounds of Opposition

[14] The Opponent pleads that the applications do not conform to the requirements of section 30(a) of the Act, as the statements of goods in the applications are not set out in ordinary commercial terms or in sufficient detail to enable the average person or consumer to ascertain the nature of the goods.

[15] The Opponent also pleads that the applications do not conform with the requirements of section 30(i) of the Act as the Applicant could not have been satisfied that it was entitled to use the Marks in Canada in association with the Class 3 goods as the Marks because at the time the applications were filed, they were confusing with the Opponent's priority application for JUVEDERM. Further to this, the Applicant had received a decision of a foreign court with respect to this same Opponent and their goods indicating that the Opponent's goods in Class 3 were not the same as the Applicant's goods in Class 5 and the Applicant was not entitled to seek protection for the mark in Class 3.

[16] The Opponent did not make any submissions with respect to these grounds of opposition, nor as previously mentioned is there any evidence of record to support the allegations.

[17] Moreover, with respect to the section 30(a) ground of opposition, the Applicant submits that the term “cosmetics” *per se* is listed as acceptable in the Goods and Services Manual, and as such, the Applicant’s goods, which are more specific than “cosmetics”, should certainly comply with the requirements under section 30(a) of the Act. In the absence of evidence and submissions to the contrary, I agree. Consequently, the ground of opposition based on section 30(a) of the Act is dismissed, as the Opponent has failed to satisfy its initial evidentiary burden.

[18] With respect to the ground of opposition based on section 30(i) of the Act, where an applicant has provided the statement required by of the Act, a section 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 CPR (2d) 152 (TMOB) at 155]. In this case, there is no evidence of bad faith or exceptional circumstances. Furthermore, even if the Opponent had shown that the Applicant knew of its trademark at the filing date of its application, I note that it has been held that mere knowledge of the existence of an opponent’s trademark does not in and of itself support an allegation that an applicant could not have been satisfied of its entitlement to use a mark at the time that it filed its application [*Woot, Inc v Woot Restaurants Inc Les Restaurants Woot Inc*, 2012 TMOB 197].

[19] The section 30(i) ground of opposition is therefore also dismissed for the Opponent’s failure to meet its initial evidential burden.

Section 2 Ground of Opposition

[20] The Opponent pleads that as of the filing date of the oppositions, the Marks are not distinctive by virtue of the Opponent’s priority filing of application No. 1,805,896 in Canada (particulars of which are included under Schedule A to this decision).

[21] With respect to the ground of opposition based on non-distinctiveness, in order to meet its initial burden, the Opponent must establish that its pleaded mark was known to some extent in Canada as of the filing date of the statement of opposition [see *Bojangles International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC) and *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD)].

[22] The Opponent has not filed any evidence of use or making known of its trademark; consequently, the Opponent has not met its evidential burden, and the ground of opposition based on non-distinctiveness is also dismissed.

Section 16(3)(b) Ground of Opposition

[23] The Opponent pleads that the Applicant is not the person entitled to the registration of the Marks, because at the time the applications were filed, they were confusing with the Opponent's trademark JUVEDERM, under application No. 1,805,896, that had claimed priority from its earlier filed Norwegian application No. 201605042, that was filed on April 22, 2016. In its pleadings the Opponent states that it has a real and effective commercial establishment in Norway and has used the trademark extensively throughout Bulgaria and other jurisdictions in association with the goods listed in the application (particulars of which are included under Schedule A to this decision).

[24] With respect to the ground of opposition based on section 16(3)(b) of the Act, the Opponent must establish that its application relied upon was filed (or deemed filed in Canada) prior to the deemed filing date of the Applicant's application(s), and was pending at the dates of advertisement of the Applicant's applications [section 16(4) of the Act].

[25] The Opponent did not evidence its application No. 1,805,896. However, I have exercised my discretion and checked the Registrar's records for that application [see *Royal Appliance Mfg Co v Iona Appliances Inc* (1990), 32 CPR (3d) 525 (TMOB) at 529]. I confirm that application No. 1,805,896 was filed by the Opponent with a priority filing date of April 22, 2016, and was still pending on June 30, 2016, as is required by section 16(4) of the Act.

[26] However, while the Opponent's application was not abandoned at the dates of advertisement of the applications for the Marks (having been abandoned subsequently on November 19, 2019), I am not satisfied that the Opponent has met its initial burden of establishing that its trademark alleged in support of this ground of opposition was deemed filed prior to the filing date of the Applicant's applications.

[27] In this regard, the Opponent's application was filed in Canada with a claimed priority date of April 22, 2016, based upon a previously filed Norwegian application No. 20160542 for JUVEDERM. However, the particulars of such applications filed under Mr. Penney's affidavit show that the Norwegian application was not the Opponent's earliest application for JUVEDERM for use in association with the same kind of goods or services, as both the Opponent's Bulgarian application and European Union applications were earlier filed applications for the same kind of goods or services. In addition, the Applicant submits, there is no evidence that the Opponent has or had a real and effective commercial establishment in Norway. The Applicant submits that therefore, the Opponent cannot rely on the April 22, 2016 priority filing date; rather, its entitlement date is the October 21, 2016 filing date of its Canadian application for JUVEDERM (application No. 1,805,896), which is nearly four months after the Applicant's June 30, 2016 entitlement date. The Applicant submits that as a result, all of the grounds of opposition claimed by the Opponent which are reliant on the Opponent's application having had priority over the Applicant's applications, were never valid and should be dismissed.

[28] For ease of reference, I will reproduce section 34 of the Act:

34 (1) Despite subsection 33(1), when an applicant files an application for the registration of a trademark in Canada after the applicant or the applicant's predecessor in title has applied, in or for any country of the Union other than Canada, for the registration of the same or substantially the same trademark in association with the same kind of goods or services, the filing date of the application in or for the other country is deemed to be the filing date of the application in Canada and the applicant is entitled to priority in Canada accordingly despite any intervening use in Canada or making known in Canada or any intervening application or registration, if

(a) the filing date of the application in Canada is within a period of six months after the date on which the earliest application was filed in or for any country of the Union for the registration of the same or substantially the same trademark in association with the same kind of goods or services;

(b) the applicant files a request for priority in the prescribed time and manner and informs the Registrar of the filing date and country or office of filing of the application on which the request is based;

(c) the applicant, at the filing date of the application in Canada, is a citizen or national of or domiciled in a country of the Union or has a real and effective industrial or commercial establishment in a country of the Union; and

(d) the applicant furnishes, in accordance with any request under subsections (2) and (3), evidence necessary to fully establish the applicant's right to priority.

[29] Indeed, the Applicant's evidence supports the position that the Opponent cannot rely on the priority filing date of April 22, 2016, as the Opponent's claim to priority does not appear to satisfy sections 34(1)(a) and (c) of the Act.

[30] In any event, I note from the file history of the Opponent's application [Penney affidavit, Exhibit B], that the Opponent did not fulfill the requirement indicated in the examiner's report of March 17, 2017 to file a certified copy of the Opponent's international registration relied upon in order to establish its claim to priority [section 34(1)(d)]; the Opponent's application was later abandoned. Moreover, the Opponent has not provided any evidence to support a deemed filing date of April 22, 2016 under section 34 of the Act, nor has the Opponent provided any submissions whatsoever. Consequently, I am only prepared to accept the date of filing of the Opponent's application in Canada as the relevant date for the purposes of this ground pursuant to section 16 of the Act, and such date, namely, October 21, 2016, post-dates the filing dates of the applications for the Marks. Therefore, the Opponent has failed to meet its burden under this ground of opposition as well, and the section 16(3)(b) ground of opposition is dismissed.

Disposition

[31] Having regard to the aforementioned, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the oppositions pursuant to section 38(12) of the Act.

Kathryn Barnett
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A – OPPONENT’S JUVEDERM APPLICATION

Application No. 1,805,896

Filed: 2016-10-21

Abandoned: 2019-11-19

Goods (Nice class & Statement)

3

(1) Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; Cosmetics for professional use and for use by the end consumer; Cosmetic creams, emulsions, lotions, liquids, solutions, milks, gels and oils for the skin (of the face, body, hands, feet, and neck), oils for cosmetic purposes; cosmetic kits; cosmetic products and preparations for skin care; cosmetic masks; cosmetics, cosmetic preparations for slimming purposes; cosmetics for exfoliation, cosmetic peelings; cosmetics for smoothing the skin; cosmetics for hair conditioning and care of the hair and scalp; cosmetic sunscreen products and preparations (emulsions, lotions, milks, gels, oils, liquids); cosmetic preparations for skin whitening, skin whitening creams; bleaching preparations (decolorants) for cosmetic purposes; cosmetics for lightening the skin; cosmetics for perfecting the complexion; anti-wrinkle cosmetics, skin rejuvenation cosmetics, skin lightening cosmetics; cosmetic preparations for skin hydration; cosmetics for toning the skin; essential oils and aromatic extracts; toiletries; cleaning and fragranting preparations

Claims

- Priority Filing Date: April 22, 2016, Country: NORWAY, Application No. 201605042 in association with the same kind of goods
- Used in BULGARIA
- Filed in NORWAY on April 22, 2016, under No. 201605042

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No hearing held.

AGENTS OF RECORD

No agent appointed

For the Opponent

Bereskin & Parr LLP/S.E.N.C.R.L., S.R.L.

For the Applicant