

O P I C



C I P O

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 067
Date of Decision: 2022-04-11

IN THE MATTER OF AN OPPOSITION

Medvaris Inc.

Opponent

and

**Varimed Medikal Sanayi Ve Ticaret
Limited Sirketi**

Applicant

1,820,936 for VARIMED & DESIGN

Application

INTRODUCTION

[1] Medvaris Inc. (the Opponent) opposes registration of the trademark VARIMED & DESING (the Mark) reproduced below, which is the subject of application No. 1,820,936 (the Application), filed by Varimed Medikal Sanayi Ve Ticaret Limited Sirketi (the Applicant) on the basis of use and registration of the Mark in Turkey in association with the following goods, as revised by the Applicant (the Goods):

varimed

Goods:

Surgical, medical, dental, and veterinary apparatus and instruments namely orthopedic fixation devices used in orthopedic transplant and/or implant surgery; artificial limbs,

eyes and teeth; orthopedic articles namely orthopedic footwear, orthopedic joint implants, orthopedic belts, lymphoedema gloves, lymphoedema stockings, support stockings; suture materials: Medical compression stockings, anti embolism stockings, medical compression armsleeves, medical kneebraces, medical ankle braces, medical calf braces, surgical gloves, examination gloves.

[2] The main issue in this proceeding is whether there would be a likelihood of confusion between the Mark in association with the Goods and the Opponent's trademark MEDVARIS registered under No. TMA919,514 in association with the following services:

(1) Services médicaux de traitement des varices et varicosités; clinique médicale de traitement des varices et varicosités.

(2) Services de soins esthétiques, nommément soins et traitements des varices et varicosités.

[TRANSLATION]:

(1) Medical services for the treatment of varicose veins and varicosities; health clinic for the treatment of varicose veins and varicosities.

(2) Esthetic care services, namely care and treatment for varicose veins and varicosities.

[3] For the reasons that follow, the Application is refused in part.

THE RECORD

[4] The Application was filed on February 1, 2017 and advertised for opposition purposes in the *Trademarks Journal* on May 22, 2019.

[5] On November 22, 2019, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). This Act was amended on June 17, 2019. All references herein are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act 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 before that date).

[6] The grounds of opposition raised by the Opponent are based on non-compliance with section 30(d) of the Act; non-registrability under section 12(1)(b) of the Act; non-entitlement under section 16 of the Act; and non-distinctiveness under section 2 of the Act.

[7] The Applicant filed a counter statement denying the grounds of opposition.

[8] The Opponent elected not to file any evidence in support of its opposition. The Applicant's evidence consists of the affidavit of Anna Hengen, a legal assistant employed by the agent for the Applicant, sworn November 19, 2020. Her affidavit introduces into evidence the results of a series of searches of the Canadian trademarks database for issued registrations of trademarks which include words containing the syllables "MED" or "MED*". I will return to this affidavit below. Suffice it to note at this juncture that Ms. Hengen was not cross-examined on her affidavit.

[9] Only the Opponent filed written representations. Neither party requested an oral hearing. In this regard, I note that in its written representations, the Opponent makes various allegations that are not supported by any evidence. Consequently, I will not address in my analysis below those arguments that are not supported by the evidence of record.

ANALYSIS

The parties' respective burden or onus

[10] The Opponent has the initial evidential burden to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once that burden is met, the Applicant bears the legal onus of establishing, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [*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].

Grounds of opposition summarily rejected

Section 30(d) ground of opposition

[11] The Opponent's section 30(d) ground alleges that the Mark has not been used in Turkey by the Applicant as claimed in the Application. Since the Opponent has not filed any evidence in support of this ground of opposition, it has not met its initial burden.

[12] Accordingly, the section 30(d) ground of opposition is rejected.

Section 16 grounds of opposition

[13] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark because at the filing date of the Application, the Mark was confusing with:

- the Opponent's aforementioned trademark MEDVARIS which had been previously used in Canada by the Opponent [section 16(2)(a) of the Act];
- the Opponent's aforementioned trademark MEDVARIS in respect of which an application for registration had been previously filed by the Opponent [section 16(2)(b) of the Act]; and
- the Opponent's trade name MEDVARIS which had been previously used in Canada by the Opponent [section 16(2)(c) of the Act].

[14] In order to meet its initial burden under sections 16(2)(a) and (c) of the Act, the Opponent must show that as of the date of filing of the Applicant's Application, its trademark and trade name had been previously used in Canada and had not been abandoned as of the date of advertisement of the Application [section 16(5) of the Act]. As the Opponent has not filed any evidence in support of these grounds, it has failed to meet its initial burden.

[15] In order to meet its initial burden under section 16(2)(b) of the Act, the Opponent must show that its application for registration had been filed prior to the date of filing of the Applicant's Application and was pending at the date of advertisement of the Application [section 16(4) of the Act]. The Opponent has failed to identify its relied upon previously filed application. Moreover, even assuming that the Opponent's previously filed application consists of the one having led to the aforementioned registration No. TMA919,514, this application was not pending as of the date of advertisement of the Application, but had already matured to registration on November 5, 2015.

[16] Accordingly, the sections 16(2)(a), (b) and (c) grounds of opposition are also rejected.

Section 2 ground of opposition

[17] The Opponent has pleaded that the Mark is not distinctive of the Applicant because it does not distinguish and is not adapted to distinguish the Goods from the Opponent's services offered in association with its MEDVARIS trademark.

[18] In order to meet its initial burden in support of the non-distinctiveness ground of opposition, the Opponent was required to show that as of the date of filing its statement of opposition, its MEDVARIS trademark was known in Canada to at least some extent and that the reputation of its trademark in Canada was substantial, significant or sufficient so as to negate the distinctiveness of the Mark [*Motel 6, Inc v No 6 Motel Ltd*, (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657]. As the Opponent has not adduced any evidence whatsoever of the extent to which its registered trademark MEDVARIS has become known in Canada, the Opponent has not met its initial burden.

[19] Accordingly, the section 2 ground of opposition is also rejected.

Remaining ground of opposition based on non-registrability of the Mark under section 12(1)(d)

[20] The Opponent has pleaded that the Mark is not registrable because it is confusing with the Opponent's aforementioned registered trademark MEDVARIS.

[21] I have exercised the Registrar's discretion to confirm that this registration is in good standing as of today's date, which is the material date for assessing a section 12(1)(d) ground of opposition [*Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[22] Hence, the Opponent has met its evidential burden in respect of this ground of opposition. The Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's MEDVARIS trademark.

The test for confusion

[23] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[24] Thus, section 6(2) of the Act does not concern the confusion of the trademarks themselves, but of the goods or services from one source as being from another. In the present case, the question is essentially whether a consumer, with an imperfect recollection of the Opponent's MEDVARIS trademark, who sees the Applicant's Goods in association with the Mark, would think that they emanate from, are sponsored by or approved by the Opponent.

[25] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time the trademarks have been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them. This list is not exhaustive, and all relevant factors are to be considered. Further, all factors are not necessarily attributed equal weight as the weight to be given to each depends on the circumstances [see *Mattel, Inc v 3894207 Canada Inc* 2006 SCC 22, 49 CPR (4th) 321; *Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée* 2006 SCC 23, 49 CPR (4th) 401; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 for a thorough discussion of the general principles that govern the test for confusion].

The inherent distinctiveness of the trademarks and the extent to which they have become known

[26] Although both parties' trademarks are coined words, they have a limited degree of inherent distinctiveness since they include the descriptive component "MED", especially the Opponent's trademark considering its greater suggestive connotation.

[27] Indeed, the prefix "MED" suggests "medical" and the suffix "VARIS" is the phonetic equivalent of the French word "*varices*" (which translates into English as "varicose veins"), that is precisely one of the health conditions treated by the Opponent's medical services. In comparison, while the suffix "MED" in the Mark still suggests "medical", the prefix "VARI" has no clear connotation in the context of the Goods, except arguably in respect of the Applicant's applied-for goods that may be recognized treatments for varicose veins, as discussed below when assessing the degree of resemblance between both the parties' trademarks and their associated goods or services. I shall add in this regard that I do not consider the geometric design elements comprising the Mark to lend any significant inherent distinctiveness.

[28] The degree of distinctiveness of a trademark may be increased by means of it becoming known through promotion or use. However, there is no evidence that either of the parties' trademarks has been used or become known in Canada in association with their respective goods or services to any extent.

[29] To sum up, given that the Mark is slightly more inherently distinctive, the overall consideration of this first factor tends to favour the Applicant, especially with respect to the applied-for goods that do not relate to the treatment of varicose veins.

The length of time the trademarks have been in use

[30] As the Applicant has not filed any evidence of use of the Mark since its date of filing, and there is no evidence for concluding to continuous use of the Opponent's registered trademark in Canada, this factor does not favour either party. Indeed, the mere existence of the Opponent's registration can establish no more than *de minimis* use and cannot give rise to an inference of significant or continuing use [*Entre Computer Centers, Inc v Global Upholstery Co* (1992), 40 CPR (3d) 427 (TMOB)].

The nature of the goods, services or business; and the nature of the trade

[31] When considering the nature of the goods, services or business and the nature of the trade, I must compare the Applicant's statement of Goods with the statement of services in the registration relied upon by the Opponent [*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)]. However, those 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. 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); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[32] The Opponent submits that the nature of the Applicant's Goods and the Applicant's trade is very similar to the nature of the Opponent's Services and the Opponent's trade in that both entities are in the field of medical treatment. In addition, the Opponent submits that the Applicant's applied-for goods described as "lymphoedema gloves, lymphoedema stockings, support stockings; medical compression stockings, anti-embolism stockings, medical compression armsleeves" are all recognized treatments for varicose veins and spider veins. The Opponent further submits that the Applicant's Goods and the Opponent's services are intended for the same clientele, that is a clientele with medical needs. Finally, the Opponent submits that the Applicant's Goods constitute a natural extension of the Opponent's services in that it is reasonable to conclude that the Opponent could conceivably expand the scope of its business to offer products such as the Applicant's Goods.

[33] In the absence of any evidence or representations to the contrary from the Applicant, I agree with the Opponent that there is seemingly some overlap between the applied-for goods described as "lymphoedema gloves, lymphoedema stockings, support stockings; medical compression stockings, anti-embolism stockings, medical compression armsleeves" and the Opponent's registered services relating to the care and treatment of varicose veins and varicosities. However, I disagree with the Opponent's position with respect to the remaining applied-for goods. In my view, the mere fact that both parties are in the field of medical

treatment is insufficient to render the parties' goods and services and their corresponding channels of trade similar.

[34] In view of the foregoing, these third and fourth factors favour the Opponent only insofar as the Applicant's applied-for goods described as "lymphoedema gloves, lymphoedema stockings, support stockings; medical compression stockings, anti-embolism stockings, medical compression armsleeves" are concerned.

The degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them

[35] In *Masterpiece, supra*, the Supreme Court of Canada considered the importance of section 6(5)(e) in conducting an analysis of the likelihood of confusion (see para 49):

...the degree of resemblance, although the last factor listed in s. 6(5) is the statutory factor that is often likely to have the greatest effect on the confusion analysis ... if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion...

[36] When considering the degree of resemblance between trademarks, they must be considered in their totality; it is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the marks [*Veuve Clicquot, supra*, at para 20].

[37] In *Masterpiece, supra* at paragraph 64, the Court further advised that while in some cases, the first word or syllable of a trademark will be the more important for the purpose of distinction, the preferable approach to considering resemblance "is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique".

[38] Considering first the Opponent's trademark, I do not find either part of it to stand out as being more striking or unique in the context of the Opponent's registered services. As mentioned above, although the Opponent's trademark is a coined word, it is highly suggestive of the nature of the medical services associated therewith.

[39] Turning to the Mark, I find the most striking or unique aspect of it arguably resides, at least in terms of appearance, in the first part of the Mark. As indicated above, the prefix VARI

has no clear connotation in the context of the applied-for goods that do not relate to the medical treatment of varicose veins and spider veins, in addition to appearing in the first most dominant position of the Mark in a white lettering on a black rectangle, together with a triangle pointing downward dotting the letter “I”.

[40] Accordingly, contrary to the Opponent’s position submitted in its written representations, I do not find the Mark to be [TRANSLATION] “extremely similar” to the Mark of the Opponent visually and phonetically, as well as in the suggested idea, when considered in the context of the applied-for goods that do not relate to the medical treatment of varicose veins and spider veins. To the contrary, I find the parties’ trademarks to be more different than alike.

[41] However, when considered in the context of the applied-for goods that apparently relate to the medical treatment of varicose veins and spider veins, I find that the parties’ trademarks are somewhat more similar than different. Indeed, while less evident than in the case of the Opponent’s trademark MEDVARIS, the Mark may arguably be similarly perceived as having been coined from the French word “*varices*” and the word “medical”. As such, there is visual and contextual similarity between the parties’ trademarks to the extent that that they both contain the components “MED” and “VARI”, albeit not in the same order.

Other circumstance - State of the register

[42] As mentioned above, Ms. Hengen’s affidavit introduces into evidence the results of a series of searches of the Canadian trademarks database. More particularly, Ms. Hengen carried out searches for issued registrations of trademarks which include words containing the syllables “MED” or “MED*” for use on either goods of class 10 of the Nice classification (that includes mainly surgical, medical, dental and veterinary apparatus, instruments and articles generally used for the diagnosis, treatment or improvement of function or condition or persons and animals) or services in class 44 (that includes mainly medical care, including alternative medicine, hygienic and beauty care given by persons or establishments to human beings and animals, as well as services relating to the fields of agriculture, aquaculture, horticulture and forestry).

[43] State of the register evidence can be introduced to show that a mark or portion of a mark is common among different traders, and thus that consumers are accustomed to distinguishing

between the marks based on relatively small differences. However, state of the register evidence is only relevant insofar as inferences may be made from it concerning the state of the marketplace in Canada, and inferences about the state of the marketplace can only be drawn when a significant number of pertinent registrations are located [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

[44] In the absence of submissions, I assume that the Applicant wishes me to conclude from Ms. Hengen's search results that trademarks comprising the syllable "MED" are so common in Canada that (i) consumers will be able to distinguish the Mark from the Opponent's trademark and (ii) the Opponent's trademark should only be granted a very narrow scope of protection. However, as noted by the Opponent in its written representations, the state of the register evidence does not allow me to conclude that the syllable "VARI" is commonly used in association with goods and services related to the medical field. In my view, the results of Ms. Hengen's searches only underscore the descriptive character of the component "MED" in the context of goods and services related to the medical field.

Conclusion regarding the likelihood of confusion

[45] As indicated above, the Applicant bears the legal onus of establishing, on a balance of probabilities, that there is not a reasonable likelihood of confusion as to the source of the parties' goods or services. The presence of an onus on the Applicant means that if, after all the evidence is in, a determinate conclusion cannot be reached, the issue must be decided against the Applicant [see *John Labatt, supra*].

[46] Having considered all of the surrounding circumstances, I arrive at the conclusion that the probability of confusion is evenly balanced between a finding of confusion and of no confusion insofar as the Applicant's applied-for goods described as "lymphoedema gloves, lymphoedema stockings, support stockings; medical compression stockings, anti-embolism stockings, medical compression armsleeves" are concerned. While I have found that the Opponent's trademark is inherently weak, given the parties' marks are somewhat more similar than different in the context of these goods which directly overlap with the Opponent's registered services, I am not

satisfied that the Applicant has sufficiently distinguished its Mark from MEDVARIS. In the absence of any additional surrounding circumstances favouring the Applicant, I must therefore find against the Applicant with respect to such goods.

[47] Accordingly, the section 12(1)(d) ground of opposition is successful with respect to the goods described as “lymphoedema gloves, lymphoedema stockings, support stockings; medical compression stockings, anti-embolism stockings, medical compression armsleeves”. It is otherwise rejected with respect to the remaining applied-for goods due to the lesser degree of resemblance when the Mark is considered in the context of the Applicant’s goods which do not overlap with the Opponent’s services.

DISPOSITION

[48] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the Application pursuant to section 38(12) of the Act in respect of the following goods:

“lymphoedema gloves, lymphoedema stockings, support stockings; medical compression stockings, anti-embolism stockings, medical compression armsleeves”

and I reject the opposition with respect to the remaining goods:

“Surgical, medical, dental, and veterinary apparatus and instruments namely orthopedic fixation devices used in orthopedic transplant and/or implant surgery; artificial limbs, eyes and teeth; orthopedic articles namely orthopedic footwear, orthopedic joint implants, orthopedic belts; suture materials: medical kneebraces, medical ankle braces, medical calf braces, surgical gloves, examination gloves.”

Annie Robitaille
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

No Hearing Held

AGENTS OF RECORD

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For the Opponent

Furman IP Law & Strategy PC

For the Applicant