



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 079

Date of Decision: 2022-04-26

IN THE MATTER OF AN OPPOSITION

**Mayo Foundation for Medical
Education and Research**

Opponent

and

Maló Clinic, S.A.

Applicant

1,660,753 for MALOCLINIC stylized

Application

OVERVIEW

[1] Mayo Foundation for Medical Education and Research (the Opponent or Mayo Clinic) is headquartered in Rochester, Minnesota, U.S.A. and operates a network of hospitals and health clinics under the trademark MAYO CLINIC.

[2] The Opponent has opposed application No. 1,660,753 (the Application) filed by Maló Clinic, S.A. (the Applicant) for the trademark MALOCLINIC stylized, depicted below (the Mark).

The image shows the stylized trademark "MALOCLINIC" in a bold, sans-serif font. The letters are white with a black outline, and the text is set against a dark, textured background. The word is enclosed in a thin black border.

[3] The Application lists a variety of services including medical clinic services and dentistry services.

[4] For the reasons set out below, the Application is refused as the Applicant has not met its burden to demonstrate that there is no likelihood of confusion between the parties' trademarks.

THE RECORD

[5] The Application was filed on January 23, 2014 in association with the following services:

(1) Dentistry services.

(2) Health services, namely medical clinic services; veterinary services; medical and health assistance services namely aesthetic and plastic surgery services; health spa services; beauty saloon services; spa services; agriculture, horticulture and forestry management consulting services.

[6] The Application is based on use of the Mark in Canada since at least as early as April 2013 in association with Services (1) and proposed use of the Mark in Canada in association with Services (2).

[7] The Application was advertised for opposition purposes in the *Trademarks Journal* on April 13, 2016. On May 12, 2017, the Opponent filed a statement of opposition against the Application pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). I note that the Act was amended on June 17, 2019, and pursuant to section 70 of the Act, the grounds of opposition in this proceeding will be assessed based on the Act as it read prior to June 17, 2019.

[8] The Opponent raises grounds of opposition based on registrability under section 12(1)(d), entitlement under sections 16(1)(a) and 16(3)(a), distinctiveness under section 2, and non-compliance with sections 30(a) and 30(b) of the Act. For the grounds of opposition based on an alleged likelihood of confusion, the Opponent relies on the following registered trademarks:

Reg. No.	Trademark	Goods/Services
TMA411,897	MAYO	<p>Goods</p> <p>(1) Medical journals; health care newsletters; patient education pamphlets.</p> <p>Services</p> <p>(1) Educational services namely, providing courses of instruction through a graduate medical school, medical school and school of health related sciences and providing continuing medical education; medical and health care services namely, clinical services, physician services, pharmacy services, medical laboratory and testing services, and nursing care services; health care services in the nature of a health maintenance organization; hospital services.</p>
TMA389,952	MAYO CLINIC	<p>Goods</p> <p>(1) Medical journals, health care newsletters and patient education brochures.</p> <p>Services</p> <p>(1) Educational services namely, providing courses of instruction through a graduate medical school, medical school and school of health-related sciences and providing continuing medical education</p> <p>(2) Medical and health care services namely, clinical services, physician services, pharmacy services, medical laboratory and testing services, and nursing care services, health care services in the nature of a health maintenance organization and hospital services.</p>
TMA551,565	MAYOLINK	(1) Medical testing services provided through a computer network.

[9] The Opponent also relies on a common law trademark MAYO MEDICAL LABORATORIES which it asserts has been previously used or made known in Canada in association with medical testing and medical consulting services.

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

[11] Only the Opponent filed evidence and written representations. No hearing was held.

EVIDENCE

[12] The Opponent filed as its evidence the affidavit of Daniel S. Goldman sworn July 26, 2018 (the Goldman Affidavit) and certified copies of its three registrations identified in the table above. Mr. Goldman was cross-examined on his affidavit and the transcript from that cross-examination forms part of the record.

[13] Mr. Goldman is the Assistant Secretary to and in-house legal counsel for the Opponent. The Opponent is a charitable organization incorporated under the laws of the United States of America and is principally located in Rochester, Minnesota.

[14] The Opponent operates medical campuses, including hospitals and clinics, under the name MAYO CLINIC in Rochester, Minnesota; Jacksonville, Florida; and Phoenix, Arizona. In addition, the Opponent owns and operates Mayo Clinic Health System that consists of more than 70 hospitals and clinics across Minnesota, Iowa, and Wisconsin. Mr. Goldman describes that the Opponent is recognized for providing the highest quality medical care through a physician-led team of diverse practitioners involved in providing clinical, educational, diagnostic, and research services in a unified multi-campus system.

[15] The origins of the Opponent can be traced back to the surgeon Dr. William Worrall Mayo and his two sons who opened a private clinic in Rochester, Minnesota in the late 1880s.

[16] While the Opponent's medical campuses are located in the United States, as discussed below, Mr. Goldman describes that a significant number of patients at these medical campuses are Canadian residents that travel to the Opponent's facilities to be treated. In addition, Mr. Goldman describes multiple goods and services that are advertised, offered and sold by the Opponent in Canada in association with its MAYO trademarks, including the trademark MAYO CLINIC. Some examples are discussed below.

[17] Mr. Goldman describes that the Opponent has a large, global subscriber base for its health publications and related books. Exhibit 6 to the Goldman Affidavit is a printout showing examples of such health related publications bearing the trademark MAYO CLINIC. Since 2010, there have been over 3,087,587 publications issues or products sold via 296,862 individual orders for the Opponent's subscription or catalog products from Canada.

[18] The Opponent also provides medical laboratory services in association with its MAYO trademarks. Through its Mayo Medical Laboratories program, the Opponent advises and provides local delivery of laboratory medicine by providing clinical expertise and direct access to the Opponent's staff and resources. In this regard, the Opponent works with its international customers to arrange daily international specimen shipments to its affiliated laboratories. Between 2008 and 2017, 275 facilities throughout Canada have utilized Mayo Medical Laboratories. From these collaborations, the Opponent has generated over \$32 million in sales to Canadian entities. A list of Canadian clients of Mayo Medical Laboratories from 2008 to 2017 is included as Exhibit 8.

[19] The Opponent provides educational programs, including continuing medical education courses. The Opponent has recorded over 5,000 Canadian residents who have attended the Opponent's continuing medical education courses and other educational sessions either online or in person. Exhibit 10 to the Goldman Affidavit is a brochure bearing the trademark MAYO CLINIC sent to Canadian practitioners advertising a 2016 Dental Review course held at the Opponent's location in Rochester, Minnesota.

[20] Between 2011 and 2017, the Opponent sent over 1,147,684 printed mailings to learners in Canada advertising education and continuing medical education courses. Exhibit 11 to the Goldman Affidavit includes examples of these printed mailings bearing the trademark MAYO CLINIC.

[21] Between 2010 and 2016, the Opponent hosted four medical conferences in Canada, specifically in Whistler, British Columbia and Toronto, Ontario. Brochures from these conferences, bearing the trademark MAYO CLINIC, are included as Exhibit 30.

[22] Mr. Goldman states that from 2010, there were over 45,894 visits from Canadian residents to MAYO CLINIC healthcare facilities in Rochester, Scottsdale and Jacksonville out of which more than 11,000 have been unique visitors. A spreadsheet detailing these visits by year is included as Exhibit 17.

[23] In addition to its facilities in the United States, the Opponent has representative and liaison offices internationally, which cater to the needs of patients and their families, who have

engaged with the Opponent for healthcare. The Canadian liaison office, located in Thunder Bay, Ontario, assists Canadian residents over the telephone with making appointments and travel arrangements. The services provided by this facility are branded with the Opponent's MAYO trademarks and its quality is closely monitored and controlled by the Opponent. A printout from the Mayo Clinic Information Service in Canada webpage is attached as Exhibit 15.

[24] Mr. Goldman indicates that the Opponent's websites are frequently used as informational resources. Since 2010, 136,250,743 Canadian residents have used the Opponent's websites at *mayoclinic.org*, *mayo.edu*, or *mayoclinic.com* with over 610,701,324 unique page views.

[25] Since 2012, over 21,629 Canadian users have downloaded the MAYO CLINIC mobile application which provides daily health news and advice on fitness and healthy eating, and allows users to make appointments at the Opponent's facilities, communicate with their care team, view lab results and receive express care online.

[26] In addition, Mr. Goldman states that given the substantial number of Canadian patients, practitioners and students, the Opponent has a website dedicated to Canadian patients at *mayoclinic.org/canada*, a printout of which is attached as Exhibit 34, which includes appointment request information for Mayo Clinic facilities, links to Canadian information services, as well as information regarding how Mayo Clinic collaborates with local physicians.

[27] In 2010 and 2011, the Opponent ran a series of advertisements in Canadian publications including *The Financial Post*, *Maclean's*, *Walrus*, *Best Health*, *Canadian Business*, and *Report on Business*, telling stories from Canadian Mayo Clinic patients. These advertisements are attached as Exhibits 18 through 22, and prominently bear the trademark MAYO CLINIC.

ONUS AND MATERIAL DATES

[28] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the Application complies with the requirements of the Act. 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 [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[29] The material dates for the grounds of opposition are as follows:

- Section 38(2)(a) / 30 – the filing date of the Application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Section 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)];
- Section 38(2)(c) / 16(1)(a) – the date of use claimed in the Application, namely, April 2013;
- Section 38(2)(c) / 16(3)(a) – the filing date of the Application;
- Sections 38(2)(d) and 2 - the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317 (FC)].

ANALYSIS OF THE GROUNDS OF OPPOSITION

Section 30(a) ground of opposition

[30] With respect to the ground of opposition under section 30(a) of the Act, the Opponent contends that the following descriptions of services in the Application are not in ordinary commercial terms: “beauty saloon services; spa services; agriculture, horticulture and forestry management consulting services”. The Opponent’s written representations relating to this ground are brief, with the Opponent arguing that these descriptions are broad and insufficiently clear.

[31] In my view, the description “beauty saloon services” will be readily understood as “beauty salon services”, which is among the acceptable descriptions listed in the Canadian Intellectual Property Office *Goods and Services Manual*. I suspect that the additional letter “o” in that description is simply a typographical error, and in any event I do not consider it to be of any consequence for the purpose of section 30(a).

[32] With respect to the description “spa services”, this is also listed among the acceptable descriptions in the *Goods and Services Manual*.

[33] With respect to the description “agriculture, horticulture and forestry management consulting services”, the Opponent has provided no evidence to suggest that this description is not in ordinary commercial terms, nor in my view has the Opponent provided a persuasive argument to that effect. I note that the similar description “forestry management consulting services” is among those listed as acceptable in the *Goods and Services Manual*.

[34] In view of the above, the section 30(a) ground of opposition is rejected.

Section 30(b) ground of opposition

[35] With this ground of opposition, the Opponent alleges that the Applicant has not used the Mark in Canada in association with dentistry services since the date claimed in the Application, namely, April 2013. However, the Opponent filed no evidence speaking to this ground and the Applicant filed no evidence at all in the proceeding. Consequently, there is no evidence from which the Opponent can meet its initial evidential burden. The section 30(b) ground of opposition is therefore rejected.

Section 12(1)(d) ground of opposition

[36] The Opponent pleads that the Mark is not registrable because it is confusing with the Opponent’s registered trademarks set out in the table above. I have exercised my discretion to check the Register and confirm that each of these registrations remain extant [see *Quaker Oats Co Ltd of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent has therefore met its initial evidential burden with respect to this ground of opposition. As a result, the Applicant bears the legal burden of demonstrating on a balance of probabilities that there is no likelihood of confusion between the Mark and any of the Opponent’s registered trademarks.

[37] In considering the issue of confusion, I will focus my analysis on the Opponent’s registered word mark MAYO CLINIC (TMA389,952), as in my view that represents the Opponent’s best case.

Test for confusion

[38] The test for confusion is set out in section 6(2) of the Act which provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods and services are of the same general class or appear in the same class of the Nice Classification. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them.

[39] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, 1 SCR 772 at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the trademarks, will often have the greatest effect on the confusion analysis.

[40] The test for confusion is assessed as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the applicant's trademark, at a time when they have no more than an imperfect recollection of the opponent's trademark, and do not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot, supra*, at para 20].

Degree of resemblance

[41] As noted above, the degree of resemblance is often the most important factor in the confusion analysis. In this case, there is a high degree of resemblance between the parties' trademarks. In particular, there is a high degree of similarity in appearance as the trademarks are essentially identical but for their third letter. I do not consider the simple design elements of the

Mark, or the absence of a space between the words “MALO” and “CLINIC”, to give rise to a meaningful difference in appearance as compared to the Opponent’s trademark MAYO CLINIC. While not identical when sounded, I nevertheless consider there to be a reasonable degree of resemblance between the parties’ trademarks when sounded, again as a result of the trademarks differing only in their third letter. With respect to idea conveyed, both convey the idea of a clinical setting for the parties’ services, in connection with the term “MAYO” and “MALO”, respectively.

[42] Overall, the degree of resemblance factor favours the Opponent.

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

[43] I consider the Opponent’s trademark MAYO CLINIC to have a low degree of inherent distinctiveness, largely because the Opponent’s evidence demonstrates that “MAYO” is the surname of the family that founded the clinic and the term “CLINIC” is descriptive.

[44] With respect to the Applicant’s Mark, I have no evidence before me to suggest that the term “MALO” has any dictionary meaning in English or French, or that it is likely to be perceived as a surname. Consequently, I consider the Applicant’s trademark to have a slightly higher degree of inherent distinctiveness than the Opponent’s trademark.

[45] However, when it comes to the question of the extent to which the parties’ trademarks have become known, this consideration strongly favours the Opponent. I am satisfied that the Opponent’s trademark MAYO CLINIC is known to a significant extent in Canada by virtue of the evidence of advertising of the Opponent’s services in Canada for many years, the volume of goods purchased by Canadians from the Opponent, and the number of Canadians that have availed themselves of the Opponent’s medical-related services. In contrast, there is no evidence to suggest that the Applicant’s Mark has been used or become known at all in Canada.

[46] Taking into account both the inherent distinctiveness of the parties’ trademarks and the extent to which they have become known, on balance, this factor favours the Opponent due to the significant extent to which the Opponent’s trademark MAYO CLINIC has become known.

Length of time the trademarks have been in use

[47] The evidence indicates that the Opponent's trademark MAYO CLINIC has been used and known for well over a decade in Canada. The Applicant did not file any evidence to demonstrate that use of its Mark had commenced in Canada. Therefore, this factor also favours the Opponent.

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

[48] The Opponent's registration for the trademark MAYO CLINIC covers medical journals and health care newsletters, as well as a variety of medical and health care services, including clinical services, physician services, pharmacy services, and medical laboratory and testing services. The Application includes some medical services that directly overlap with the services in the Opponent's registration, and other services in the Application such as dental services are still closely connected to the medical field. Also, the Applicant has not filed any evidence to demonstrate that its services or channels of trade would differ in any meaningful way from the goods and services of the Opponent.

[49] In view of the above, I consider the nature of the goods, services and trade factors to favour the Opponent for all of the services listed in the Application, with one exception discussed below.

[50] The one exception is the service described as "agriculture, horticulture and forestry management consulting services", which appears to be somewhat of an outlier in subject matter when compared to the other services in the Application. With this service only, the nature of the goods, services and trade factors weigh in favour of the Applicant, given that this service appears to be different from those of the Opponent. However, I do not weigh this difference strongly in the Applicant's favour, given the absence of any evidence from the Applicant as to how this service would be offered in association with the Mark, nor do I consider this difference to be dispositive, given the other factors under section 6(5) of the Act which weigh in the Opponent's favour.

Conclusion regarding the section 12(1)(d) ground

[51] Having considered all of the surrounding circumstances, I conclude that the Applicant has not satisfied its legal burden to show that there is no reasonable likelihood of confusion between the parties' trademarks. I reach this conclusion particularly in view of the high degree of resemblance between the parties' trademarks and the extent to which the Opponent's trademark MAYO CLINIC is known in Canada.

[52] Therefore, I find that the section 12(1)(d) ground of opposition is successful in respect of all of the services listed in the Application.

Section 2 ground of opposition

[53] The Opponent alleges that the Mark is not distinctive in view of the Opponent's MAYO trademarks, including the trademark MAYO CLINIC. In order to meet its initial evidential burden for the distinctiveness ground of opposition, the Opponent must show that its trademark had a substantial, significant or sufficient reputation in Canada in association with relevant goods and services [see *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427 (FC) at paras 33-34]. The Opponent's evidence, as discussed above, amply demonstrates a sufficient reputation in Canada in its trademark MAYO CLINIC as of the material date (*i.e.* May 12, 2017), and therefore the Opponent has met its initial evidential burden for the section 2 ground of opposition.

[54] The legal burden then shifts to the Applicant to demonstrate that its Mark is distinctive in Canada. In considering whether a trademark is distinctive, one may consider whether it is likely to cause confusion with another party's trademark [see *Bensusan Restaurant Corp v Blue Note Restaurant Inc* (2000), 10 CPR (4th) 550 (TMOB) at para 30]. For essentially identical reasons to the analysis of confusion for the section 12(1)(d) ground of opposition, I conclude that the Applicant has not satisfied its legal burden under section 2. Therefore, the section 2 ground of opposition also succeeds.

Remaining grounds of opposition

[55] As I have already found in the Opponent's favour with respect to its grounds of opposition under sections 12(1)(d) and 2, I will refrain from addressing the remaining grounds of opposition under sections 16(1)(a) and 16(3)(a).

DISPOSITION

[56] 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.

Timothy Stevenson
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: No hearing held

AGENTS OF RECORD

MLT Aikins LLP

For the Opponent

No Agent Appointed

For the Applicant