

THE RECORD

[4] The Application was filed on January 7, 2016, in association with the following goods and services (the Goods and Services):

Goods

(1) Eye care preparations for cosmetic use; cosmetic preparations for the care of the eyes, skin and face; skincare preparations (non-medicated); eye masks and eye patches impregnated with non-medicated cosmetic preparations; face masks impregnated with cosmetic preparations; collagen containing skincare preparations; microdermabrasion skincare preparations for cosmetic use; preparations for cleaning spectacles and sunglasses, cloths impregnated with preparations for cleaning spectacles and sunglasses.

(2) Contact lens solutions, contact lens cleaning, rinsing or neutralising solutions and tablets, saline solutions; eyewash and eye sprays, preparations for treating dry eyes, eye drops; eye moisturisers and ointments for medical use; ocular vitamins; eye patches; eye care preparations for medical use; pharmaceuticals for treatment of eye disorders; mediated preparations for the care of the eyes, skin and face; vitamins for care of the eyes; vitamins for care of the skin and face; skincare preparations (medicated); eye masks and eye patches impregnated with medicated preparations; face masks impregnated with medicated preparations.

(3) Contact lenses; containers for contact lenses, holders for contact lenses, cases adapted for contact lenses; spectacles, sunglasses, reading glasses, glasses fitted with LED lights; parts, fittings and accessories, namely, cases, chains, straps, cleaning cloths, spectacle cases for spectacles or sunglasses; glasses cases; goggles, namely diving goggles, goggles for scuba diving, goggles for sports, cycling goggles, swimming goggles, prescription swimming goggles; ski goggles, prescription ski goggles; diver masks, prescription diver masks; protective eyewear, prescription protective eyewear; cords for spectacles or sunglasses; cases adapted for holding goggles or protective eyewear.

Services

(1) Retail services namely the sale of vision related products namely contact lenses, cases for contact lenses, contact lens cleaning, disinfecting and soaking solutions, eye wash solutions, artificial tears and saline solutions, eye wear and sunglasses; retail services in the field of sale of eyewear, glasses, sunglasses, contact lenses, goggles, diver masks, preparations and solutions for the care of eyewear and contact lenses, cases and travel packs for storing eyewear and contact lenses and cleaning preparations, eyewear accessories, eyecare preparations, cosmetics for use around the eye, medications for the eyes, medications for care of the skin and face, skincare preparations; online retail services in the field of eyewear, glasses, sunglasses, contact lenses, goggles, diver masks, preparations and solutions for the care of eyewear and contact lenses, cases and travel packs for storing eyewear and contact lenses and cleaning preparations, eyewear accessories, eyecare preparations, cosmetics for use around the eye, medications for the eyes, medications for care of the skin and face, skincare preparations; provision of advertising space on a website; Promoting the sale of goods and services through a

customer loyalty program; promoting the sale of goods and services through trial samples; administration of customer loyalty programs; provision of information, consultancy and advice relating to all eye care, eye-wear and vision-wear products, and eye medications.

[5] The Application is based on proposed use of the Mark in Canada, as well as use and registration in the EUIPO (EU) with the Goods and Services.

[6] The Application was advertised for opposition purposes in the *Trademarks Journal* of January 10, 2018. On March 9, 2018, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The Act was amended on June 17, 2019, and in accordance with section 70 of the Act, the grounds of opposition in this proceeding will be assessed based on the Act as it read prior to that date.

[7] The grounds of opposition pleaded by the Opponent include sections 12(1)(d), 16(2), 16(3), 2, 30(b) and 30(d) of the Act. For the grounds of opposition based on an alleged likelihood of confusion, the Opponent relies on its previous use and registration of the trademark and previous use of the trade name VISION CENTER DIRECT.

[8] The Applicant filed and served a counter statement denying the grounds of opposition.

[9] The Opponent filed a certified copy of registration No. TMA645,257 for the trademark VISION CENTER DIRECT. The Opponent also filed the affidavit of Dr. Bryan Robertson, sworn September 13, 2018, the co-founder and Vice President of the Opponent. Dr. Robertson was cross-examined on his affidavit and his transcript forms part of the record. The Applicant filed the affidavits of Richard Rust, sworn September 19, 2019, the Chief Finance Officer of the Applicant, and Robyn Benmore, sworn September 19, 2019, a trademark searcher.

[10] Only the Applicant filed written representations, and no hearing was held.

LEGAL ONUS AND EVIDENTIAL BURDEN

[11] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the Application complies 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 [*John Labatt Limited v The Molson Companies Limited* (1990), 1990 CanLII 11059 (FC), 30 CPR (3d) 293 (FCTD) at 298].

ANALYSIS OF THE GROUNDS OF OPPOSITION

Section 30(b) and 30(d) grounds of opposition – summarily dismissed

[12] The material date for considering a ground of opposition under section 30 of the Act is the date of filing of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475].

[13] The Opponent has not met its initial evidential burden with respect to the grounds of opposition based on sections 30(b) and 30(d) of the Act.

[14] The Opponent has pleaded that contrary to section 30(b) of the Act, the Applicant did not intend to use the Mark in Canada, by itself or through a licensee, in association with the Goods and Services. However, no evidence or argument was filed in support of this ground of opposition.

[15] The Opponent has pleaded that contrary to section 30(d) of the Act, the Applicant had not used the Mark in the European Union in association with each of the general classes of goods or services described in the Application. However, there is no evidence that puts into issue the correctness of the use and registration abroad basis claimed in the Application.

[16] Accordingly, these grounds of opposition are dismissed.

Section 12(1)(d) ground of opposition

[17] The Opponent has pleaded that the Mark is not registrable because it is confusing with its registration No. TMA645,257 for the trademark VISION CENTER DIRECT in association with the following services (the Opponent's services):

(1) Operating of a business for the retail sale and distribution of eye wear through the world wide web; Operation of a business selling contact lenses, glasses, sun glasses and eyecare products, namely, lens cleaning and storage solutions, lens storage containers, lens cleaning tissue, eyedrops and sterilizer.

(2) Optician services; Operation of a business fitting contact lenses, glasses, sun glasses.

[18] An opponent's initial burden is met with respect to a section 12(1)(d) ground of opposition if the registration relied upon is in good standing as of the date of the opposition decision. I have exercised my discretion and confirm that the registration relied upon by the Opponent was expunged on July 18, 2022 for failure to pay the additional prescribed renewal fee. Accordingly, the Opponent has not met its initial burden and this ground of opposition is dismissed.

Sections 16(2)(c) and 16(3)(c) grounds of opposition

[19] The sections 16(2)(c) and 16(3)(c) grounds of opposition allege that the Applicant is not the person entitled to register the Mark because as of the material date, the Mark was confusing with the VISION CENTER DIRECT trade name previously used in Canada by the Opponent.

[20] For these grounds of opposition, there is an initial burden on the Opponent to show use of its trade name prior to January 7, 2016 (the date of filing of the Application), and that it had not abandoned its trade name as of January 10, 2018, the date of advertisement of the Application [section 16(5) of the Act].

[21] With respect to assessing use of a trade name, the Act does not contain a definition of what constitutes such use. However, the topic was considered by the Federal Court in *Mr. Goodwrench Inc v General Motors Corp* (1994) 55 CPR (3d) 508 (FCTD), with Simpson J. stating:

There are no provisions in the Act which define and describe the use of a trade name. However, in his decision in *Professional Publishing Associates Ltd. v. Toronto Parent Magazine Inc.* (1986), 9 C.P.R. (3d) 207 Mr. Justice Strayer considered the problem and held that the principles in ss.2 and 4(1) apply to trade name use. In this regard, His Lordship said:

While there is no definition in the Trade Marks Act of "use" in relation to trade names, I am satisfied that consistent with the purposes of the Act

such "use" would have to be in the normal course of trade and in relation to the class or classes of persons with whom such trade is to be conducted.

Accordingly, use in the normal course of trade will be the test applied in these reasons.

[22] I also refer to the decision of *Pharmx Rexall Drug Stores Inc v Vitabrin Investments Inc*, (1995), 62 CPR (3d) 108, where Hearing Officer D. Martin stated that the mere formation or registration of a company under a particular name does not by itself constitute use of that name as a trade name. Accordingly, the mere fact of the registration of the Opponent's company name VISION CENTER DIRECT INC. (Robertson affidavit, Exhibits A, B) does not constitute trade name use.

[23] With these principles in mind, I will now turn to a review of the Opponent's evidence as of the material date, and an analysis of whether the Opponent has met its initial burden.

Affidavit of Dr. Bryan Robertson

[24] Dr. Robertson provides an overview of the Opponent's business and the services provided in association with VISION CENTER DIRECT. At the outset, I note that while Dr. Robertson introduces the evidence by reference solely to the Opponent's use of VISION CENTER DIRECT as a trademark in his affidavit, trademark and trade name usage are not necessarily mutually exclusive [see *Road Runner Trailer Manufacturing Ltd v Road Runner Trailer Co* (1984), 1 CPR (3d) 443 (FCTD)]. Accordingly, where appropriate, I accept that the display of VISION CENTER DIRECT on exhibited material could be perceived as both trademark and trade name use.

VISION CENTER DIRECT on outdoor signage

[25] Dr. Robertson states that the Opponent provides total eye care to its customers by performing exams for patients using the latest diagnostic equipment; providing high quality service to assist customers in selecting, fitting and delivering eyewear; and supplying eyewear, contact lenses and accessories (para 3). The Opponent has two locations in Regina, Saskatchewan. The first was established in 1983 (the Albert Street location), and the second was established in 2011 (the Star Lite location) (para 5). These stores offer for sale and sell eyewear

including glasses and contact lenses and eyewear accessories. In addition, these stores provide optician services, perform eye care exams and assist customers in the selection and purchase of eyewear (para 10). From 1994 to 2012, VISION CENTER DIRECT appeared on outdoor storefront signage of the Albert Street location (para 11, Exhibit C). Since 2012, the Opponent's signage has generally displayed "THE SPECTRUM by Vision Center Direct". In this regard, the Robertson affidavit includes:

- A copy of a photograph taken in August 2018 displaying "THE SPECTRUM by Vision Center Direct" on the entry door of the Albert Street location (Exhibit E). Dr. Robertson states that this photograph is representative of how VISION CENTER DIRECT has been and continues to be displayed on the door at this location since 2012.
- A copy of a photograph taken in August 2018 displaying "THE SPECTRUM EYE CENTER", "presented by Vision Center Direct" on signage in the lobby of the building of the Star Lite location (Exhibit F). Dr. Robertson states that this photograph is an accurate depiction of how VISION CENTER DIRECT has been and continues to be displayed on the sign in this location since 2012.

[26] I consider the use of VISION CENTER DIRECT on outdoor signage to be use of both the Opponent's trademark and trade name.

[27] Further, I consider the Opponent's use of Vision Center Direct in "THE SPECTRUM by/presented by Vision Center Direct" to constitute use of THE SPECTRUM and Vision Center Direct as two distinct trade names, and nothing prevents the display of multiple trade names in the normal course of trade.

VISION CENTER DIRECT on the Opponent's website

[28] Dr. Robertson states that through the Opponent's website located at *visioncenterdirect.com* (the Opponent's website), the Opponent has offered for sale and sold glasses, sunglasses, contact lenses and accessories to Canadians (para 12). Attached as Exhibit G are printouts of the Opponent's website as it was displayed from 2002 to 2018 (para 13). These printouts were taken from the Internet Archive website (*archive.org*). I note that the Internet

archive system WayBack Machine has been accepted as a reliable source for evidencing the state of websites in the past [see *Candrug Health Solutions Inc v Thorkelson* (2007), 60 CPR (4th) 35 (FC) at para 21; rev'd on other grounds 2008 FCA 100]. In reviewing these pages, I note that VISION CENTER DIRECT is displayed:

- at the top left corner of the webpage displayed as “VISIONCENTERDIRECT.COM” beside a design element (July 18, 2002; June 18, 2003). Notwithstanding that the spaces between the words have been removed and the top level domain “.com” has been added, I find this constitutes use of the trademark and trade name VISION CENTER DIRECT.
- at the top left corner of the webpage displayed as “Vision Center Direct” beside a V design (February 1, 2012; May 20, 2016; April 24, 2017; March 29, 2018). I find this constitutes use of the trademark and trade name VISION CENTER DIRECT. In this regard, I note that it is well established that multiple trademarks or trade names may be used at the same time if they are perceived as separate trademarks or trade names [*AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD)]. As long as they are not combined in a way that renders the individual marks or names indistinguishable (as is the case here), their validity is not affected [*Philip Morris Products SA v Marlboro Canada Ltd.*, 2010 FC 1099].
- at the top left corner of the webpage displayed as “THE SPECTRUM by Vision Center Direct” beside a V design (March 17, 2013; August 11, 2015). I find this constitutes use of the trade name VISION CENTER DIRECT as it would be perceived as a separate trade name.
- in the text of the webpages, for example “If you need to return lenses or frames to Vision Center Direct...” (July 18, 2002); “All contact lenses dispensed by Vision Center Direct are the exact lenses prescribed by your local eye care professional and are delivered to your door...” (June 18, 2003; March 24, 2007); “Vision Center Direct was founded by eye care professionals...” (March 24, 2007; February 1, 2012), and “A Sample of fine frames you will find at THE SPECTRUM by Vision Center Direct” (March 17, 2013;

August 11, 2015; April 24, 2017). I find these constitute use of the trade name VISION CENTER DIRECT.

VISION CENTER DIRECT on promotional materials (glass cases, spray bottles)

[29] Dr. Robertson states that the Opponent has, since 1994, routinely displayed VISION CENTER DIRECT on glass cases, spray bottles, and bags that are provided to Canadian consumers. These promotional items serve as a reminder of where the customers purchased their glasses, sunglasses, contacts or other eyewear accessories (para 18). During the period from 1994 to 2012, glass cases displayed “VisionCenterDirect” (Exhibit I). Notwithstanding the removal of the spaces between the words, I find this constitutes use of the trade name VISION CENTER DIRECT. On cross-examination, Dr. Robertson advised that thousands of people would have left with one of these cases (page 42, Q20; page 48, lines 10-15).

[30] Since 2012, glass cases and spray bottles have displayed “THE SPECTRUM by VisionCenterDirect.com” (Exhibits J and K). Notwithstanding that the spaces between the words have been removed and the top level domain “.com” has been added, I find this constitutes use of the trade name VISION CENTER DIRECT, and that it would be perceived separately from the trade name THE SPECTRUM.

Advertisements in Fine Lifestyle Regina magazine from 2010-2012

[31] Dr. Robertson states that the Opponent has used magazine advertisements as a tool for advertising and promoting the Opponent’s retail stores, optician services and the Opponent’s website, and that these advertisements also display the VISION CENTER DIRECT mark (para 20). Exhibits L to O are copies of advertisements for the Opponent’s services and business appearing in the *Fine Lifestyle Regina* magazine from 2010-2012 (para 21). I note that Exhibits M and N (from 2011) display the trademark and trade name Vision Center Direct. I note that Exhibit O (from 2012) displays the “THE SPECTRUM by VisionCenterDirect.com”. Notwithstanding that the spaces between the words have been removed and the top level domain “.com” has been added, I find this constitutes use of the trade name VISION CENTER DIRECT, and that it would be perceived separately from the trade name THE SPECTRUM.

VISION CENTER DIRECT on invoices

[32] Exhibit P contains copies of four representative samples of invoices issued by the Opponent's retail locations (the Albert Street location and the Star Lite location) for the Opponent's services since 2013. These invoices are identical to those which would be issued to purchasers at the time of sale (para 24). I note that the invoices, which cover the sale of various items including contact lenses, frames, and lenses, are dated between June 2013 and September 2018. VISION CENTER DIRECT appears as a trade name at the bottom of each invoice as follows:

Thank you!

The Spectrum Eye Centre
by Vision Center Direct

Sales and advertising expenditures associated with VISION CENTER DIRECT

[33] Dr. Robertson states that the Opponent has generated more than \$30,000,000 CAD in revenue by selling and performing the Opponent's services in Canada in association with the VISION CENTER DIRECT mark since 1998 (para 23). On cross-examination, Dr. Robertson indicated that The Spectrum is a subdivision of Vision Center Direct, and all revenue generated goes through and is put through Vision Center Direct (page 22, Q23) (page 54, Q20).

[34] On cross-examination, Dr. Robertson confirmed that the Opponent has shipped products to customers all over North America (page 7, Q20-25).

[35] Dr. Robertson submits that in every year since 1994, the Opponent has spent more than \$90,000 annually on advertising expenditures associated with the Opponent's services provided under the VISION CENTER DIRECT mark (para 16). On cross-examination, Dr. Robertson further indicated that on average, the Opponent spent 3% of its gross sales on advertising (page 51, Q3).

Conclusion – the Opponent meets its onus for the grounds of opposition under section 16(2)(c) and 16(3)(c)

[36] When the evidence is viewed as a whole, I am satisfied that the Opponent has carried on business under the trade name VISION CENTER DIRECT selling contact lenses, glasses, sun glasses and eyecare products, providing optician services, and selling eyewear online through the Opponent's website since prior to January 7, 2016. Further, there is no evidence suggesting that the Opponent had abandoned its trade name as of the date of advertisement of the Application.

[37] As I am satisfied that the Opponent has met its evidential burden under these grounds of opposition, I must now determine whether the Applicant has met its onus of proving no reasonable likelihood of confusion on a balance of probabilities.

Test for confusion

[38] Section 6(3) of the Act indicates that use of a trademark causes confusion with a trade name if the use of both the trademark and trade name in the same area would be likely to lead to the inference that the goods or services associated with the trademark and those associated with the business carried on under the trade name 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.

[39] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trademark and trade name and the extent to which they have become known; (b) the length of time each has 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 or trade names in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, 49 CPR (4th) 321 (SCC); *Masterpiece v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 (SCC) (*Masterpiece*)]. However, as noted by the Supreme Court of Canada in *Masterpiece*, although 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*, para 49).

[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 (or trade name), and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks and/or names [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401 at para 20].

Inherent distinctiveness of the trademark and trade name

[41] The Opponent's trade name VISION CENTER DIRECT holds a low degree of inherent distinctiveness. The phrase that comprises the trade name is highly suggestive of vision-related services coming from a place specializing in the provision of such services and offering these services directly to consumers.

[42] Similarly, the Applicant's trademark VISION DIRECT holds a low degree of inherent distinctiveness in that it suggests that the Applicant's vision-related goods and services are provided directly to consumers. However, I do not consider the Mark to hold any suggestive connotation in respect of those goods and services which do not fall into or relate to the general category of eyewear, eyecare, or eyecare accessories such as skincare preparations, vitamins for care of the skin and face, and cosmetics.

Extent known and length of time in use

[43] The strength of a trademark or trade name may be increased by means of it becoming known through promotion or use. The Opponent has submitted evidence through the Robertson affidavit generally establishing that from 1994-2012 VISION CENTER DIRECT appeared as the sole trademark and trade name on outdoor storefront signage, promotional items, and magazine advertisements. From 2012 onwards, the trade name VISION CENTER DIRECT has generally appeared on signage, promotional items and invoices along with the trade name "THE SPECTRUM".

[44] The Robertson affidavit further establishes that the VISION CENTER DIRECT trademark and trade name have been displayed on the Opponent's website from 2002-2018, as discussed above. On cross-examination, Dr. Robertson indicated that the average traffic of the Opponent's website was 79,000 unique visitors (page 37, Q3), though the frequency of this statistic (monthly, yearly) was not provided.

[45] Based on the foregoing, and taking into account the previously discussed sales and advertising information provided by Dr. Robertson, I am satisfied that the Opponent's trade name has become known to at least some extent in Canada. I make this finding notwithstanding that the Opponent has not provided a breakdown of the sales or advertising for each of its sales/service categories.

[46] The Application is based on proposed use of the Mark in association with the Goods and Services. While evidence relating to the use of the Mark is provided in the Rust affidavit, none of it had occurred by the material date with the result that I am unable to consider it.

[47] Accordingly, these factors favour the Opponent.

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

[48] There is a high degree of overlap between the Applicant's retail and online retail services in the field of vision, eyewear, and eye care products and accessories (which includes the sale of contact lenses, glasses, sunglasses, eye care products including eye wash solutions, artificial tears and saline solutions), and the Opponent's business, which involves selling eyewear, contact lenses, glasses, sunglasses and eyecare products, and operating a business selling eyewear online through the Opponent's website. I do not consider there to be any overlap with respect to those services of the Applicant that do not relate to vision, eyewear, or eye care including: retail and online retail services in the field of sale of ... medications for care of the skin and face, skincare preparations; provision of advertising space on a website; promoting the sale of goods and services through a customer loyalty program; promoting the sale of goods and services through trial samples; administration of customer loyalty programs.

[49] There is also some overlap or connection between the services associated with the Opponent's business and the Applicant's Goods consisting of eyewear (including contact lenses

and glasses), eyewear accessories, and eye care preparations, particularly insofar as the Applicant's Goods could be sold by the Opponent. However, I do not consider there to be any overlap with respect to those goods of the Applicant that do not relate to vision or eye care generally, including: cosmetic preparations for the care of the skin and face; skin care preparations (non-medicated); face masks impregnated with cosmetic preparations, collagen containing skincare preparations, microdermabrasion skincare preparations for cosmetic use, medicated preparations for the care of the skin and face, skincare preparations (medicated), and face masks impregnated with medicated preparations.

[50] With respect to the channels of trade, I find there to be overlap in that both parties are in the business of selling vision, eyewear, and eyecare related products and thus would appear to target the same consumer.

Degree of resemblance

[51] In *Masterpiece, supra*, the Court observed that while the first word (or syllable) of a trademark (or trade name) may, for purposes of distinctiveness, be the most important in some cases [*Conde Nast Publications Inc v Union des editions moderns* (1979), 46 CPR (2d) 183 (FCTD)], a preferable approach is to first consider whether there is an aspect of the trademark (or trade name) that is particularly striking or unique.

[52] When considering the Opponent's trade name VISION CENTER DIRECT in its totality, I do not find any of the elements of this trade name to be particularly striking or unique given their suggestive or descriptive nature. For the same reason, I do not find either element of the Applicant's Mark to be striking or unique.

[53] In its written representations, the Applicant takes the position that the Opponent's mark (trade name) has the word CENTER as its second component and thus serves to make the marks dissimilar in appearance, sound and ideas suggested. While the inclusion of the word "CENTER" in the Opponent's trade name does have an impact in that it renders the Mark slightly different from the trade name of the Opponent, I find that there remains a significant degree of resemblance between the parties' trademarks and trade names given they share the prefix VISION and the suffix DIRECT.

Surrounding circumstance – extended period of co-existence with the VISION DIRECT trademark in Canada

[54] In its written representations, the Applicant takes the position that the “Applicant and its predecessors” have used the VISION DIRECT trademark in Canada since 2001, and that this extended period of co-existence ought to be a factor strongly favouring the Applicant (paras 42, 43). As I understand it, the “predecessor” that the Applicant is referring to does not qualify as a predecessor-in-title of the Applicant but is instead an unrelated party, Walgreens, which was allegedly active in Canada between 2001 and May 2017. The Applicant also relies on its use of the Mark which commenced in summer 2016.

[55] To support its position that Walgreens previously used the VISION DIRECT trademark in Canada, the Applicant relies on:

- an allegation by Mr. Rust that prior to the Applicant entering the Canadian market, Walgreens was using the mark VISION DIRECT in association with the online sale of contacts and other products to Canadians since at least as early as May 16, 2001. Mr. Rust alleges that the Walgreens contact lenses and other products were available for purchase at *www.visiondirect.com* in association with the VISION DIRECT trademark, and that these products were also available to be shipped into Canada (para 18, Rust affidavit). In this regard, Mr. Rust provides an archived copy of a page from the Walgreens website dated May 16, 2001, from the Internet Archive Wayback machine (Exhibit I).
- a statement by Mr. Rust that it is his understanding that by May 19, 2017, Walgreens had rebranded and had ceased use of its VISION DIRECT trademark, redirecting consumers from *visiondirect.com* to *walgreens.com* (Rust affidavit, para 19). Mr. Rust cites a third party article for an explanation of the move and Walgreens’ discontinuance of use of the VISION DIRECT mark (Exhibit J).
- acknowledgements on cross-examination by Dr. Robertson that he has no recollection of instances of customer testimonials of confusion between Walgreens’ Vision Direct mark and the Opponent’s Vision Center Direct (page 72, Q25); and that it appears that the

Opponent co-existed with visiondirect.com in the Canadian marketplace for almost 15 years (page 73, Q11).

[56] I find that the Applicant's evidence is of no assistance in supporting its position on use by Walgreens as it is inadmissible hearsay. Indeed, I note that Mr. Rust does not have any direct knowledge of the length and extent of use by Walgreens of the VISION DIRECT trademark in Canada. Rather, Mr. Rust relies on an internet article that is hearsay and cannot be relied on as evidence of the truth of its contents. Further, even if I was to assume that Walgreens was active at the *visiondirect.com* website between 2001 and 2017, the evidence provided (printout of an archived webpage) is minimal. Without more evidence - at a minimum, volume of sales in Canada by Walgreens and some indication of the mark's exposure to Canadian consumers, I am not prepared to assume that Walgreens had a meaningful presence in the Canadian market during this period.

[57] In order to give extended co-existence meaningful weight as a factor in the confusion analysis, there should be evidence of sufficient volume of actual concurrent use of the trademarks and trade names. In this case, the very limited evidence of use of the VISION DIRECT trademark by Walgreens could very well explain the absence of actual instances of confusion.

[58] As for the Applicant's evidence of use of the Mark in Canada, I am unable to consider it as it postdates the material date of January 7, 2016.

[59] Accordingly, this factor does not assist the Applicant.

Surrounding circumstance – state of the register

[60] State of the register evidence is relevant only to the extent that inferences may be drawn concerning the state of the marketplace [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Del Monte Corporation v Welch Foods Inc* (1992), 44 CPR (3d) 205 (FC)]. Further, inferences concerning the state of the market may be drawn from this evidence only if a large number of relevant registrations are located [*Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA); *McDowell v Laverana GmbH & Co KG*, 2107 FC

327 at paras 41-46]. If sufficient state of the register evidence is provided, the Registrar may infer that the likelihood of confusion is reduced by following the well-recognized principle that where two trademarks contain a common element that is also contained in a number of other marks in the same market, this tends to cause consumers to pay more attention to the other non-common features to distinguish them [*K-Tel International Ltd v Interwood Marketing Ltd* (1997), 77 CPR (3d) 523 (FCTD)].

[61] The Benmore affidavit contains the results of various searches of the trademark records of the Canadian Intellectual Property Office conducted by Ms. Benmore, using the CorSearch database. Ms. Benmore's findings are that as of September 18, 2019:

- There are over 863 registered trademarks containing the term “vision” (para 3, Exhibit A).
- There are also over 78 registered trademarks containing the term “vision” that include “contact” in their description of goods and services (para 4, Exhibit B).
- There are also over 137 registered trademarks containing the term “vision” that include “eye” in the description of goods and services (para 5, Exhibit C).
- There are 3002 registered trademarks containing the term “center” (para 6, Exhibit D).
- There are 23 registered trademarks containing the term “center” that also include “contact” services (para 7, Exhibit E).
- There are 8 registered trademarks containing the terms “vision” and “center” (para 8, Exhibit F).
- There are 54 registered trademarks containing the term “center” that also include “eye” in the description of goods and services (para 9, Exhibit G).

[62] I note that the particulars of the registrations cited in the above Exhibits A to G, including listings of the associated goods/services, have not been provided in the evidence, and the Registrar generally declines to exercise discretion to take cognizance of their own records except to verify whether claimed trademark registrations and applications identified in a statement of opposition are extant [see *Quaker Oats of Canada Ltd/Cie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. While some of the trademark searches have been narrowed to cover those registrations including the term “contact” or “eye” in the goods/services, these search terms are broad (in that they do not correspond to a specific good or service). Thus,

without a list of the goods/services in the registrations, I cannot confirm whether they include goods/services relating to “contact lenses” or “eyeglasses” as opposed to unrelated goods/services including the term “contact” or “eye”, such as “contact paper”, “customer contacts”, or “eye nuts”. Further, without information on the dates of registration for these marks, it is not possible to ascertain whether these registrations existed as of the material date of January 7, 2016. Accordingly, the state of the register evidence does not assist the Applicant.

[63] Further, even if I was to overlook the above deficiencies, this state of the register evidence would not significantly assist the Applicant given that Ms. Benmore’s searches only located trademarks including the words VISION and CENTER, but not registered trademarks incorporating both the terms VISION and DIRECT, which are the elements shared by the Mark and trade name at issue. Further, apart from basic Google search results (Rust affidavit, Exhibits K and L) which postdate the material date, there is no evidence regarding the use of any of the third party marks on the Canadian market.

Surrounding circumstance – Applicant’s registration of VISION DIRECT & Design

[64] The Rust affidavit contains the particulars of the Applicant’s application No. 1,762,322 for VISION DIRECT & Design, which issued to registration under No. TMA1,036,462 on July 5, 2019 (Rust affidavit, para 9, Exhibit C). The application for this composite trademark was filed on the same date and in association with the same Goods and Services as the subject Application for the Mark.

[65] As the registration of this trademark postdates the material date, I am unable to consider it as a surrounding circumstance in this case.

Conclusion

[66] Having considered all of the surrounding circumstances, and in particular the degree of resemblance between the parties’ trademarks and trade names, the overlap in the parties’ goods, services and business, and the extent known and length of time in use of the Opponent’s trade name, I find that at best for the Applicant, the probability of confusion between the Mark and the Opponent’s trade name is evenly balanced between a finding of confusion and no confusion in

respect of the goods and services set out in Schedule “A” to this decision. In reaching this conclusion, I have afforded the Opponent’s trade name only a narrow scope of protection. That said, a narrow scope of protection is not the same as having no protection at all. As the onus is on the Applicant to demonstrate on a balance of probabilities that there is no reasonable likelihood of confusion between the trademark and trade name, I must therefore find against the Applicant.

[67] However, the Applicant has satisfied its legal burden to show that there is no reasonable likelihood of confusion between the parties’ trademarks and trade names for the remaining goods and services set out in Schedule “B” to this decision.

[68] Consequently, the sections 16(2)(c) and 16(3)(c) grounds of opposition succeed in respect of the goods and services set out in Schedule “A” of this decision, but fail in respect of the goods and services set out in Schedule “B”.

Remaining grounds of opposition

[69] As the Opponent has already partially succeeded under two grounds, I will not address the sections 16(2)(a), 16(3)(a) and 2 grounds of opposition other than to say that had it been decided that the Opponent met its evidentiary burden under these remaining grounds, they would likely also have succeeded in part for reasons similar to those set out under the previously discussed grounds of opposition.

DISPOSITION

[70] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the Application with respect to the goods and services set out in Schedule “A” to this decision, and I reject the opposition with respect to the goods and services set out in Schedule “B” to this decision, pursuant to section 38(12) of the Act.

Jennifer Galeano
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE "A"

Goods:

(1) Eye care preparations for cosmetic use; cosmetic preparations for the care of the eyes; eye masks and eye patches impregnated with non-medicated cosmetic preparations; preparations for cleaning spectacles and sunglasses, cloths impregnated with preparations for cleaning spectacles and sunglasses.

(2) Contact lens solutions, contact lens cleaning, rinsing or neutralising solutions and tablets, saline solutions; eyewash and eye sprays, preparations for treating dry eyes, eye drops; eye moisturisers and ointments for medical use; ocular vitamins; eye patches; eye care preparations for medical use; pharmaceuticals for treatment of eye disorders; mediated preparations for the care of the eyes; vitamins for care of the eyes; eye masks and eye patches impregnated with medicated preparations;

(3) Contact lenses; containers for contact lenses, holders for contact lenses, cases adapted for contact lenses; spectacles, sunglasses, reading glasses, glasses fitted with LED lights; parts, fittings and accessories, namely, cases, chains, straps, cleaning cloths, spectacle cases for spectacles or sunglasses; glasses cases; goggles, namely diving goggles, goggles for scuba diving, goggles for sports, cycling goggles, swimming goggles, prescription swimming goggles; ski goggles, prescription ski goggles; diver masks, prescription diver masks; protective eyewear, prescription protective eyewear; cords for spectacles or sunglasses; cases adapted for holding goggles or protective eyewear.

Services:

(1) Retail services namely the sale of vision related products namely contact lenses, cases for contact lenses, contact lens cleaning, disinfecting and soaking solutions, eye wash solutions, artificial tears and saline solutions, eye wear and sunglasses; retail services in the field of sale of eyewear, glasses, sunglasses, contact lenses, goggles, diver masks, preparations and solutions for the care of eyewear and contact lenses, cases and travel packs for storing eyewear and contact lenses and cleaning preparations, eyewear accessories, eyecare preparations, medications for the eyes; online retail services in the field of eyewear, glasses, sunglasses, contact lenses, goggles, diver masks, preparations and solutions for the care of eyewear and contact lenses, cases and travel packs for storing eyewear and contact lenses and cleaning preparations, eyewear accessories, eyecare preparations, medications for the eyes; provision of information, consultancy and advice relating to all eye care, eye-wear and vision-wear products, and eye medications.

SCHEDULE "B"

Goods:

(1) cosmetic preparations for the care of the-skin and face; skincare preparations (non-medicated); face masks impregnated with cosmetic preparations; collagen containing skincare preparations; microdermabrasion skincare preparations for cosmetic use;

(2) mediated preparations for the care of the skin and face; vitamins for care of the skin and face; skincare preparations (medicated); face masks impregnated with medicated preparations.

Services:

(1) retail services in the field of sale of cosmetics for use around the eye, medications for care of the skin and face, skincare preparations; online retail services in the field of cosmetics for use around the eye, medications for care of the skin and face, skincare preparations; provision of advertising space on a website; Promoting the sale of goods and services through a customer loyalty program; promoting the sale of goods and services through trial samples; administration of customer loyalty programs;

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

HEARING DATE No hearing held

AGENTS OF RECORD

No agent of record

FOR THE OPPONENT

DLA Piper (CANADA) LLP

FOR THE APPLICANT