



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 163

Date of Decision: 2022-08-23

IN THE MATTER OF AN OPPOSITION

**Gooddoctor Pharmaceutical Group
Co., Ltd.**

Opponent

and

**Ping An Insurance (Group) Company
of China, Ltd.**

Applicant

**1,900,431 for PING AN GOOD
DOCTOR design**

Application

INTRODUCTION

[1] Ping An Insurance (Group) Company of China, Ltd. (the Applicant) has filed application No. 1,900,431 to register the trademark PING AN GOOD DOCTOR design (the Mark), depicted below.

PING AN GOOD DOCTOR

[2] The application is based on proposed use of the Mark in Canada in association with the goods and services set out in Schedule A to this decision.

[3] Gooddoctor Pharmaceutical Group Co., Ltd. (the Opponent) has opposed the Application.

[4] For the reasons that follow, the opposition is rejected.

THE RECORD

[5] Application No. 1,900,431 (the Application) was filed on May 23, 2018, and was advertised for opposition purposes in the *Trademarks Journal* on April 1, 2020. On May 20, 2020, 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. As the Application in this case was advertised after June 17, 2019, the Act as amended applies (see section 69.1 of the Act).

[6] The Opponent raises grounds of opposition based on registrability under section 12(1)(d), distinctiveness under section 2, bad faith under section 38(2)(a.1), and non-compliance with section 38(2)(e) of the Act.

[7] For its grounds of opposition that are based on an alleged likelihood of confusion, the Opponent relies on its registered trademark entitled Chinese Characters HAO YI SHENG & Design (registration No. TMA721,718), depicted below.



[8] The Opponent's registration covers the goods and services set out in Schedule B to this decision. The Opponent pleads that there is a likelihood of confusion between the parties' trademarks because the Opponent's registered trademark will be understood by Chinese speaking Canadians to mean "good doctor".

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

[10] Neither party filed evidence. Only the Applicant filed written representations and no hearing was held.

ONUS

[11] The legal onus is on the Applicant to show that the Application complies with the provisions 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. Once this initial burden is met, the Applicant must satisfy the Registrar, on a balance of probabilities, that the grounds of opposition pleaded should not prevent the registration of the Mark [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

ANALYSIS

Preliminary comments regarding the statement of opposition

[12] The statement of opposition in this case was filed with the Registrar electronically and includes an attached document entitled “Support for each ground of Opposition”. I will refer to this latter document as the “supplementary document”. The supplementary document includes additional arguments in support of each of the Opponent’s grounds of opposition; however, in some instances the supplementary document also appears to seek to incorporate evidence.

[13] For example, as part of the Opponent’s bad faith ground of opposition under section 38(2)(a.1) of the Act, the supplementary document includes what appears to be an extract from the Canadian Intellectual Property Office online database listing fifteen trademark applications filed by Applicant (including the present Application), including some particulars of these applications and their status. In addition, in support of the Opponent’s ground of opposition under section 38(2)(e) of the Act, the supplementary document includes an extract from a Wikipedia entry relating to the Applicant.

[14] In the present case, I accept the supplementary document as part of the Opponent’s statement of opposition and consider its contents to constitute pleaded material facts in support of its grounds of opposition. However, I cannot consider anything in this supplementary document as evidence in this proceeding, for at least the reason that the document is not in the form of an affidavit or statutory declaration, and thus does not comply with the evidentiary

requirements set out in section 49 of the *Trademarks Regulations* (the Regulations). I note that the supplementary document also does not comply with the timing requirements for filing evidence set out in section 50(1) of the Regulations, and can be rejected as evidence on that basis as well.

[15] Further, with respect to the status and particulars of the other applications filed by the Applicant which are referenced in the supplementary document, the Opponent has not filed any evidence relating to these applications (for example, certified copies of the applications or an affidavit attesting to the application particulars), and in my view it would not be appropriate for the Registrar to take judicial notice of the state of the Register (or otherwise exercise the Registrar's discretion to check the Register) to assist the Opponent in this context. By way of comparison, it is well established that the Registrar may exercise its discretion to check the Register to confirm the status of an opponent's registration or pending application that is relied on in a statement of opposition for a section 12(1)(d) or section 16 ground of opposition, respectively [see *Quaker Oats Co Ltd of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB) and *John Labatt Limited/John Labatt Limitée v WCW Western Canada Water Enterprises Inc* (1991), 39 CPR (3d) 442 (TMOB) at para 6]. However, the Registrar has regularly refused to take judicial notice of the state of the Register to assist an applicant in its arguments that the state of the Register renders its trademark registrable [for example, see *Molson Breweries v John Labatt Ltd (Labatt Brewing Co Ltd)* (1999), 3 CPR (4th) 543 (TMOB) at para 9]. The Registrar has also refused to exercise its discretion to verify the status of an applicant's registration relied on by an opponent for a ground of opposition under section 30(b) of the Act (as it read prior to June 17, 2019) [see *Hunter Douglas, Inc v Newell Industries Canada, Inc*, 1999 CanLII 19610 (TMOB)]. With this backdrop in mind, I do not think it would be appropriate for me to exercise my discretion to check the Register with regards to other applications filed by the Applicant to assist the Opponent with its allegations in this case. In any event, as will be discussed below, even if I had exercised that discretion, it would have had no impact on the outcome of this opposition.

[16] In closing on these preliminary points, I note that the Opponent has not argued that I should consider anything in the supplementary document to be evidence or that I should exercise any discretion or take judicial notice of any facts. Indeed, I have no written representations from

the Opponent and the Opponent filed a letter with the Registrar on November 18, 2020 confirming that it would not be filing evidence in this proceeding. However, in part because of the absence of any submissions from the Opponent on these issues, I wished to clarify at the outset my approach to the supplementary document.

Grounds of opposition summarily rejected – sections 2, 38(2)(e) and 38(2)(a.1)

Section 2

[17] The Opponent pleads that the Applicant's Mark is not distinctive because Canadian Chinese speaking consumers will associate the Mark with the Opponent's registered trademark set out above. However, the Opponent did not file any evidence of use or reputation of its trademark. Therefore, there is no evidence of record with which the Opponent could meet its initial evidential burden for the section 2 ground of opposition [for a discussion of an opponent's initial evidential burden under section 2, see *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427 at paras 33 and 34]. Accordingly, the section 2 ground of opposition is rejected.

Section 38(2)(e)

[18] With this ground of opposition, the Opponent pleads that at the Application filing date, the Applicant was not using or did not propose to use the trademark in Canada. However, the Opponent did not file any evidence to support this ground of opposition. The Opponent includes as part of its statement of opposition an extract from a Wikipedia entry to suggest that the scope of the Applicant's business is narrower than the goods and services listed in the Application, and pleads as a consequence that the Applicant did not propose to use the Mark in association with many of the goods and services in the Application. However, for the reasons discussed above, that Wikipedia entry is not evidence in this proceeding (as an aside, I will note that even if it was in evidence I would not have considered it sufficient for the Opponent to meet its initial evidential burden). The section 38(2)(e) ground is rejected as the Opponent has not met its initial evidential burden.

Section 38(2)(a.1)

[19] The Opponent pleads that the Application was filed in bad faith. In particular, the Opponent pleads that both parties are based in China, that they are competitors, and that the Applicant is attempting to profit from the goodwill of the Opponent's "Good Doctor" brand. In this regard, the Opponent references fourteen Canadian trademark applications filed by the Applicant in addition to the present Application.

[20] As discussed above, the Opponent has not filed any evidence relating to its bad faith allegation, and I am not prepared to exercise my discretion to check the state of the Register in order to assist the Opponent with such an allegation. The section 38(2)(a.1) ground of opposition is therefore rejected on that basis.

[21] However, even if I had exercised discretion to check the fourteen other applications identified by the Opponent in its statement of opposition, that would not have been sufficient for the Opponent to meet its initial evidential burden for this ground of opposition. In particular, the Opponent focusses in its pleadings on three trademark applications, namely, 1,900,433, 1,900,435 and 1,900,434, which appear to include the Chinese characters of the Opponent's trademark, along with additional Chinese characters. The statement of opposition indicates that those three applications filed by the Applicant were each deemed abandoned under section 38(11) of the Act. Eight of the remaining applications referenced in the statement of opposition, including application No. 1,900,432 for the trademark PA GOODDOCTOR design, had already proceeded to registration as of the date of filing of the statement of opposition, and their status as registered is identified in the Opponent's pleadings. Three more of the Applicant's applications identified as pending in the statement of opposition have now also proceeded to registration (namely, application Nos. 1,938,639, 1,867,668 and 1,867,667). In these circumstances, in the absence of further evidence from the Opponent, I do not consider these fourteen other applications (the majority of which have already proceeded to registration) to be indicative of bad faith on the part of the Applicant with respect to the present Application.

[22] In short, even if I were to exercise discretion to check the Register to confirm the existence and status of the additional applications filed by the Applicant which are identified in the statement of opposition, I do not consider that to be sufficient to meet the Opponent's initial

evidential burden for the section 38(2)(a.1) ground of opposition. The ground is accordingly rejected on that basis as well.

Section 12(1)(d) ground of opposition

[23] The Opponent pleads that the Mark is not registrable because it is confusing with the Opponent's registered trademark entitled Chinese Characters HAO YI SHENG & Design (TMA721,718), depicted in paragraph 7 of this decision, above. I have reproduced below the specific argument included with the Opponent's statement of opposition in support of this ground:

As can be seen from the Applicant's Canadian trademark filings above, Applicant intends to target consumers in Canada who read and understand Chinese.

Canadian Chinese speaking consumers likely associate Applicant's "PING AN GOOD

好医生

DOCTOR design" mark with the Opponent's 好医生 mark, which means "good, medicine, living" or, when combined, "good doctor". This is more so because the first two words in the Applicant's mark, PING AN, means "peace and well" in English. Thus, when confronted with Applicant's mark, a Chinese speaking consumer will easily think of the Opponent's mark, "good doctor" in Chinese.

[24] The material date for this ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[25] As referenced above, it is well established that with a ground of opposition under section 12(1)(d) of the Act, I can exercise my discretion to check the Register and confirm that the registration on which an opponent relies remains extant, and in this way an opponent can meet its initial evidential burden [see *Quaker Oats, supra*]. I have done so and therefore the Opponent has 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 the Opponent's registered trademark.

Test for confusion

[26] 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, services or business; the nature of the trade; and the degree of resemblance between the trademarks, including in appearance, or sound or in the ideas suggested by them.

[27] 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, [2006] 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 marks, will often have the greatest effect on the confusion analysis.

[28] 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 mark, 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].

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

[29] I consider the Opponent's trademark to have at least some inherent distinctiveness, as it is comprised of characters which have no immediate meaning to a unilingual English, unilingual French or bilingual English/French speaking person. I note that the assessment of the inherent distinctiveness of the Opponent's trademark might be different if there was evidence that

relevant consumers in Canada would ascribe a particular meaning to the trademark; however, I have no such evidence in this case.

[30] With respect to the Applicant's Mark, I am satisfied that it has a reasonable degree of inherent distinctiveness, owing primarily to the presence of the term "PING AN" at the beginning of the Mark; the term "PING AN" having no descriptive connotation in English or French in association with any of the goods or services in the Application. I do not consider the "GOOD DOCTOR" component in the Mark to have much inherent distinctiveness, as it is suggestive in association with medical-related goods and services, nor do I consider the rudimentary design elements of the Mark to lend any inherent distinctiveness. However, because of the "PING AN" component, I consider the Mark as a whole to have a reasonable degree of inherent distinctiveness.

[31] Neither party filed evidence in this proceeding, and so there is nothing to indicate that either party's trademark is known at all in Canada.

[32] In these circumstances, I consider this factor to be fairly evenly matched between the parties and thus it has little impact on the confusion analysis.

Length of time the trademarks have been in use

[33] Neither party filed evidence that their trademarks are in use. Consequently, this factor also favours neither party.

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

[34] The Opponent's registration covers a variety of medical-related goods, including medical supplies and various pharmaceutical preparations and dietary supplements.

[35] The Application includes some medical-related goods and services, such as pain relief medicines, nutritional supplements, medical instruments and pharmacy advice. The Application also includes a variety of goods and services seemingly unrelated to the medical field, such as clothing rental, dating services, and litigation services.

[36] In these circumstances, I consider the nature of the goods, services and trade to favour the Opponent with respect to at least the medical-related goods and services listed in the Application. However, even if I were to weigh the section 6(5)(c) and (d) factors in the Opponent's favour for all of the goods and services in the Application, I do not consider this to be sufficient to find in the Opponent's favour on the issue of confusion, in view of the low degree of resemblance between the parties' trademarks, as discussed below.

Degree of resemblance

[37] Based on the evidence of record in this proceeding (or more specifically, the total absence of an evidentiary record), I assess the parties' trademarks to have a low degree of resemblance. The Opponent's trademark is in Chinese characters that bear no resemblance to the Mark in appearance, and I have no evidence before me to suggest that the parties' trademarks would be similar in sound or idea.

[38] While the Opponent has pleaded that its trademark would be understood by a Chinese speaking person as "good doctor", the Opponent filed no evidence to support that position. The absence of evidence on this point is particularly notable given that the transliteration/translation included as part of the Opponent's registration does not expressly reference "good doctor" and instead reads as follows: "As submitted by the applicant, the transliteration of the Chinese characters is HAO, YI, SHENG and the translation of HAO is good, fine, nice, the translation of YI is cure, medicine and the translation of SHENG is accrue, living." The Opponent also pleads that the "PING AN" component of the Applicant's Mark would be understood to have a particular meaning by a Chinese speaking person, but has provided no evidence to this effect.

[39] I note that the fact that the Opponent's trademark is in Chinese characters while the Applicant's Mark is comprised of characters from the Latin alphabet does not alone resolve the question of the degree of resemblance. The Federal Court has held that a likelihood of confusion can be found in such circumstances where there is evidence that demonstrates the resemblance (e.g. in sound and idea) between the parties' trademarks and there is evidence that the parties target a market comprised of Chinese speaking people in Canada [see *Cheung Kong (Holdings) Ltd v Living Realty Inc* (1999), 4 CPR (4th) 71 (FC); see also *Saint Honore Cake Shop Ltd v Cheung's Bakery Products Ltd*, 2015 FCA 12, 132 CPR (4th) 258]. However, I have no such

evidence in this case. As noted above, there is no evidence of record to support the Opponent's pleading as to how the parties' trademarks would be understood by a Chinese speaking Canadian, and moreover there is no evidence that either party conducts any business at all in Canada in association with their respective trademarks, let alone business which targets a particular linguistic community.

[40] With the above in mind, the degree of resemblance factor strongly favours the Applicant.

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

[41] As noted above, in *Masterpiece*, the Supreme Court of Canada stated that the resemblance between the marks will often have the greatest effect on the confusion analysis. I consider that to be the dispositive factor here. In view of the low degree of resemblance between the parties' trademarks, and in the absence of any evidence from the Opponent to support the allegations of resemblance set out in its pleadings, in my view, the Applicant has satisfied its legal burden of demonstrating on a balance of the probabilities that there is no likelihood of confusion. The section 12(1)(d) ground of opposition is therefore rejected.

DISPOSITION

[42] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

Timothy Stevenson
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Application No. 1,900,431 - PING AN GOOD DOCTOR design

Goods

(1) Pain relief medicines; nutritional supplements for general health and well-being; dietetic substances consisting of vitamins, minerals, amino acids and trace elements; diagnostic reagents for veterinary purposes; preparations for destroying noxious animals; Sanitary tampons; cotton swabs for medical purposes; dental abrasives.

(2) Recorded computer operating programs, for use in medical consultancy; Pedometers; Weighing scales for medical use; Global positioning system (GPS) consisting of computers, computer software, transmitters, receivers, and network interface devices; Eyeglasses.

(3) Medical instruments for general examination; dental instruments; X-ray apparatus for medical purposes; high frequency electromagnetic therapy apparatus; Hearing aids for the deaf; Feeding bottles; Condoms; Artificial limbs; tips for crutches; Suture materials; magnetic bracelets for medical purposes; Teeth aligners.

(4) Paper; advertising signs of cardboard; Calendars; periodical publications; Newspapers; paper bags for use in the sterilization of medical instruments; envelope sealing machines for offices; office paper stationery; Writing instruments; educational books.

Services

(1) Business management and organization consultancy; Market analysis and research; Psychological testing for the selection of personnel; Relocation services for businesses; Computerized database management; Accounting; Promoting goods and services through the distribution of discount cards; Retail services for pharmaceutical, veterinary and sanitary preparations and medical supplies.

(2) Real Estate management; trustee services; providing stock securities market information; advisory services in the field of credit and debit control, investment, grants and financing of loans; charitable fund raising; pawn brokerage; insurance brokerage; Art Appraisal; financial guarantee and surety; insurance underwriting.

(3) Television broadcasting; electronic exchange of messages using chat lines, chatrooms and Internet forums; providing chatrooms on the Internet; operation of an electronic bulletin board in the field of community social events; e-mail transmission services; Providing user access to global computer networks; electronic transmission of digital photo files via a peer-to-peer network; videoconferencing services; providing multiple use access to global computer information networks for the transfer and dissemination of a wide range of information; providing access to a global computer network.

(4) Conducting courses of instruction at the college level; educational services in the field of financial planning; organization of seminars, working groups, research groups and conventions, in the field of medicine; Lending libraries; providing on-line non-downloadable general feature magazines; providing films, not downloadable, via video-on-demand services; entertainment services in the nature of non-downloadable videos and images featuring television shows and movies transmitted via wireless computer networks; Gymnastic instruction; Zoological garden services; organization of lotteries.

(5) Cosmetic research; Computer system design, for use in financial and IT industries; providing search engines for the internet; Authenticating works of art; Materials testing and evaluation;

Software as a service (SAAS) provider in the field of providing customer relations management; Scientific research in the field of genetics and genetic engineering; Cloud computing provider services for general storage of data; Conversion of data or documents from physical to electronic media; Providing information on computer technology and programming via a web site.

(6) Dietary and nutritional guidance; Pharmacy advice; Telemedicine services; Medical equipment rental; public health counselling; Medical clinic services; beauty salon services; veterinary services; hospital services; medical equipment rental.

(7) Clothing rental; Dating services; Litigation services; Legal document preparation services; Alternative dispute resolution services; Funerary undertaking; Planning and arranging of wedding ceremonies; Security guard services for the protection of property and individuals; Chaperoning.

SCHEDULE B

Opponent's Registration No. TMA721,718 - Chinese Characters HAO YI SHENG &

Design

Goods

(1) Portable cases to hold medical supplies; portable bags to hold medical supplies; pharmaceutical preparations for the treatment of the respiratory system and the spine; dietary supplements, namely, edible plant fibers for promoting general well being; dietetic substances derived from plants adapted for medical use, namely, food for medically restricted diets in the form of liquids and tablets; herbal teas, namely, loose leaf teas and tea bags; pharmaceutical preparations, namely, lotions for the treatment of skin diseases; biological preparations for clinical, research and medical use, namely, proteins, DNA, RNA and modifications thereof; food for medically restricted diets, namely, meal replacement bars, meal replacement powder mixes, salad dressings, fruit drinks, candy; nutritional additives based on carbohydrates, crude fibers, flavonoids and phenols.

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

HEARING DATE No Hearing Held

AGENTS OF RECORD

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