



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 123

Date of Decision: 2025-06-06

IN THE MATTER OF AN OPPOSITION

Opponent: Farco-Pharma GmbH

Applicant: Gumeniuk Mykola Ivanovych vul. Klinichna

Application: 2073631 for INSTYLAN

INTRODUCTION

[1] Farco-Pharma GmbH (the Opponent) opposes the registration of the trademark INSTYLAN (the Mark), which is the subject of application No. 2,073,631 (the Application), filed by Gumeniuk Mykola Ivanovych vul. Klinichna (the Applicant).

[2] The Mark is applied for in association with pharmaceutical preparations and medical devices/apparatus as follows:

- CI 5 (1) Pharmaceutical preparations for the treatment of genitourinary diseases namely urological diseases and disorders; pharmaceutical preparations for the treatment of genitourinary diseases, namely, urological diseases, infertility, sexually transmitted diseases, inflammatory pelvic diseases; capsules made of dendrimer-based polymers sold empty for pharmaceuticals; pharmaceutical preparations for the treatment of incontinence, prostate diseases and disorders, bladder diseases and disorders; pre-filled syringes with sodium and hyaluronic acid for medical use.

CI 10 (2) Urethral probes; apparatus for washing out body cavities; appliances for washing body cavities; syringes for medical purposes; urethral catheters; urinals being vessels; uterine syringes; vaginal syringes.

[3] The opposition is primarily based on an allegation that the Mark is confusing with the Opponent's trademark INSTILLAGEL, registered and previously used in Canada in association with "lubricant local anesthetic and disinfectant for mucosa, for insertion".

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

THE RECORD

[5] The Application was filed on November 19, 2020, and was advertised for opposition purposes on July 26, 2023.

[6] On September 20, 2023, the Opponent opposed the Application by filing a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T 13 (the Act).

[7] The grounds of opposition relate to non-compliance with section 38(2)(e), entitlement to register under section 16(1)(a), registrability under section 12(1)(d), and distinctiveness under section 2 of the Act.

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

[9] In support of its opposition, the Opponent filed the affidavit of Dr. Marc Vollenbroeker, sworn on March 20, 2024, together with Exhibits A through G.

[10] The Applicant filed a statement on July 4, 2024 that it did not wish to submit evidence.

[11] Both parties filed written representations; however, only the Opponent made representations at an oral hearing.

ONUS

[12] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its 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 be reasonably concluded that the facts alleged to support each ground of opposition exist [*John Labatt Ltd v Molson Companies Ltd*, 1990 CanLII 11059 (FC)].

OVERVIEW OF THE EVIDENCE

The Opponent's Evidence – the affidavit of Dr. Vollenbroeker

[13] Dr. Vollenbroeker is the Managing Director of the Opponent, a pharmaceutical company headquartered in Cologne, Germany. He states that the Opponent has been a strong partner in urology for more than 50 years and specializes in medical lubricants and gels for use in urology, gynaecology, proctology, gastroenterology and anaesthesiology and other medical fields [paras 1, 5].

[14] Dr. Vollenbroeker attests that the INSTILLAGEL trademark has been used in Canada, in association with "lubricant local anesthetic and disinfectant for mucosa, for insertion" by the Opponent or through a licensee, since at least as early as 2007 [para 8]. He states that the Opponent sells INSTILLAGEL branded products to its Canadian licensee, Pharmascience Inc, who through its Pendapharm division, distributes/resells to hospitals and pharmacies throughout Canada for use by Canadian patients. He states that the Opponent has direct control over the character or quality of the goods used in association with the INSTILLAGEL trademark

by its Canadian licensee, as the INSTILLAGEL products are produced and packed under the production side of the Opponent in Germany [para 9].

[15] Dr. Vollenbroeker states that since 2016 and until at least 2021, annual Canadian sales of the INSTILLAGEL products by the Opponent to its Canadian licensee/distributor have consistently been valued in excess of EUR 285,000 [para 10]. He provides an annual breakdown of Canadian sales in Euros and volume in units [para 11] as well as printouts showing sales in Canada of the Opponent's INSTILLAGEL products for the years ending January 2019 to January 2024, including breakdowns by province, by product format, and by sales channel [Exhibit B].

[16] As further evidence of sales, Dr. Vollenbroeker provides representative invoices for the sale of INSTILLAGEL products by the Opponent to its Canadian licensee [Exhibit A]. He confirms that the invoices accompanied the products at the time of transfer of possession or property to the Opponent's licensee. He further confirms that these sales invoices relate to goods marked with or sold in packaging marked with the INSTILLAGEL trademark, and that the items listed on the invoices were actually shipped by the Opponent and delivered to its licensee [para 12].

[17] In addition, Dr. Vollenbroeker provides the following:

- Exhibit C – images of the packaging of the INSTILLAGEL goods, “as it has been distributed in Canada before and after November 2020.” The INSTILLAGEL mark clearly appears on the product packaging;
- Exhibit D – a copy of the INSTILLAGEL prescribing information (Product Monograph) used and distributed by the Opponent's Canadian licensee before November 2020;

- Exhibit E – a printout of the entry for the INSTILLAGEL product extracted from the Health Canada Drug Product Database;
- Exhibit F – printouts from the *Wayback Machine* internet archive of the Opponent’s Canadian licensee’s Pendopharm Division’s prescription catalogue showing the INSTILLAGEL product as displayed on their website prior to November 2020; and
- Exhibit G – photographs of various of the Opponent’s International trade fair appearances.

ASSESSMENT OF THE GROUNDS OF OPPOSITION

Section 12(1)(d) Ground

[18] The Opponent pleads that the Mark is not registrable because it is confusing with the Opponent’s registered trademark No. TMA252,035 (INSTILLAGEL), registered for use in association with “Lubricant local anesthetic and disinfectant for mucosa, for insertion”.

[19] As of the date of this decision, the Opponent’s relied upon registration is in good standing. Accordingly, the Applicant bears the onus of demonstrating that the Mark is not confusing with the Opponent’s INSTILLAGEL trademark (hereafter sometimes referred to as the Opponent’s Mark).

Test for Confusion

[20] In determining whether two trademarks are confusing, all the surrounding circumstances should be considered, including those listed in section 6(5) of the Act, namely: 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. These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 54; and *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at para 49, where the Supreme Court of Canada states that section 6(5)(e), the degree of resemblance between the trademarks, will often have the greatest effect on the confusion analysis.

[21] 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. This casual, hurried consumer does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the trademarks [*Veuve Clicquot, supra*, at para 20].

Section 6(5)(a) – inherent distinctiveness and the extent known

[22] The overall consideration of the section 6(5)(a) factor involves a combination of inherent and acquired distinctiveness of the parties' trademarks.

[23] The Applicant submits that the Mark is inherently distinctive. The Applicant submits that the word INSTYLAN has no known dictionary meaning in English or French and as such, it represents an original expression that does not have any particular meaning when considered in association with the Applicant's goods. Further, the Applicant submits that the Opponent has not provided any evidence to dispute the high level of inherent distinctiveness of the Mark.

[24] The Opponent similarly submits that the word INSTILLAGEL has no known dictionary meaning in English or French and as such, represents an original expression that does not have any particular meaning when considered in association with the Opponent's goods. The Opponent submits that the Applicant has not provided any evidence to dispute the high level of distinctiveness that the Opponent's mark possesses in association with the Opponent's goods.

[25] The Opponent submits that the Mark consists entirely of the word INSTYLAN and the Applicant has not provided any evidence the Mark is inherently distinctive. The Opponent submits that therefore, on balance, its trademark ought to be considered more inherently distinct than the Mark.

[26] I consider both parties' marks to be inherently distinctive as both are coined words. However, the "gel" ending of the Opponent's Mark may be considered descriptive in the context of the Opponent's goods, and together with the prefix "instilla" may be perceived as suggestive of the "instillation of gel" [see Exhibit D, page 10 of Product Monograph, wherein dosing instructions note to "instil" the product]. As such, I consider that the Applicant's Mark has greater inherent distinctiveness.

[27] With respect to acquired distinctiveness, the Opponent submits that Dr. Vollenbroeker provides information on the continuous use of the Opponent's Mark in Canada since at least as early as 2007 [referring to sales figures and evidence of marketing and promotion]. The Opponent submits that there is no question that the Opponent's Mark has acquired significant distinctiveness in Canada.

[28] The Opponent submits that, on the other hand, the Applicant has not filed any evidence of use of its Mark to support a finding that it has acquired

any distinctiveness in Canada since the filing date of the application, or at all.

[29] The Opponent submits that based on the foregoing, this is a significant factor which must be decided in favour of the Opponent.

[30] I accept that the Opponent's evidence shows that it has used the Opponent's Mark throughout Canada for a number of years. Indeed, the evidence shows sales of the Opponent's goods in Canada in excess of 285,000 Euros each year since 2016. Accordingly, I accept that the Opponent's Mark has acquired distinctiveness to some extent throughout Canada.

[31] In view of the above, although I have found the Applicant's Mark to have greater inherent distinctiveness, the Opponent's Mark remains a coined word, and in view of the acquired distinctiveness of the Opponent's Mark, I consider this factor, on balance, favours the Opponent.

Section 6(5)(b) – the length of time of use

[32] The Opponent submits that Dr. Vollenbroeker has provided unchallenged evidence of the ongoing use of the Opponent's Mark since at least as early as 2007, with Canadian sales figures dating back to 2016.

[33] The Applicant has not provided any evidence of use of the Mark.

[34] Accordingly, this factor favours the Opponent.

Sections 6(5)(c) and (d) – the nature of the goods, services, business and trade

[35] It is the Applicant's statement of goods as defined in the Application versus the Opponent's registered goods and services that govern my determination of this factor [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr*

Submarine Ltd v Amandista Investments Ltd (1987), 19 CPR (3d) 3 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA)].

[36] The Applicant submits that per the Opponent's evidence, the Opponent's goods are not pharmaceutical preparations to treat diseases, but rather, the Opponent's goods consist of a gel for "topical use only" that is used to assist with the insertion of medical instruments.

[37] The Applicant submits that its goods, in contrast, are pharmaceutical preparations used to treat diseases and medical apparatuses and appliances used to deliver the pharmaceutical preparations. In brief, the Applicant submits that its goods are the medicine to treat disease and the tools used to deliver the medicine – while the Opponent's good is the gel that makes the tools easier to use. Thus, the Applicant submits that there is little similarity between the parties' goods. Moreover, the Applicant submits that the Opponent has provided no evidence regarding the similarity of the parties' goods, and in fact, admitted in their written submissions that the goods were not identical.

[38] Lastly, the Applicant submits that the target consumers in this case are health care professionals, namely pharmacies and hospitals – who would be informed and very discriminating, such that there would be little likelihood of confusion between the trademarks [citing *United Artists Corp v Pink Panther Beauty Corp* (1998), 80 CPR (3d) 247 (FCA)].

[39] The Opponent submits that it is not necessary that the parties' goods be identical for there to be a likelihood of confusion and whether trademarks

are likely to be confusing must be considered if the applicant were to operate in the area that is in any way open to it if the application were granted [citing among other cases: *Mr Submarine Ltd v Amandista Investments Ltd*, 1987 CanLII 8953 (FCA)].

[40] The Opponent submits that its goods are used with the insertion of medical devices/instruments in and around the various mucous membranes (“mucosa”) of the body, to provide lubrication, anesthetic action and antiseptic protection during, before, and after insertion. Further, the Opponent submits that Dr. Vollenbroeker indicates that the Opponent’s products are medical lubricants and gels which find use in urology, gynaecology, proctology, gastroenterology and anaesthesiology and other medical fields. These goods, the Opponent submits, are used in conjunction with procedures involving the diagnosis and treatment of genitourinary and urological issues such as insertion of a medical instrument into the urethra (cystoscopy), catheterization and exploration by sound and other endourethral operations. Lastly, the Opponent submits that its goods can comprise pharmaceutical preparations, are for use by both healthcare professionals and ordinary consumers, and are used in hospital settings and as a take-home product from drugstores for self-insertion procedures, such as catheterization [Dr. Vollenbroeker affidavit, para 15, Exhibit C product label and Exhibit D Product Monograph].

[41] The Opponent submits that the Applicant did not provide any evidence as to the nature of the Applicant’s goods, however, the Opponent submits it is clear that the Applicant’s goods are apparatus and pharmaceuticals used in the genitourinary and urological medical fields and which could be used in conjunction with the Opponent’s goods. The Opponent submits that the Applicant’s class 5 goods are almost all for use in insertion in body canals and cavities having mucous membranes. Further, the Opponent submits that

the Applicant's class 1 goods are often used following procedures for diagnosing those diseases and disorders involving insertion of instruments, probes and catheters. Accordingly, the Opponent submits that the Applicant's goods, while not identical, are highly related, are used in the same areas by the same consumers/patients and healthcare personnel and that therefore, there is a strong association and potential for overlap with the Opponent's goods.

[42] Moreover, the Opponent submits that confusion is not to be assessed from the perspective of a sophisticated client or of a consumer looking at both parties' goods side by side. It is rather to be assessed as a matter of first impression on a casual consumer who does not give pause to give the matter any detailed consideration or scrutiny.

[43] The Opponent submits that since the onus is on the Applicant to establish possible distinctions between the parties goods and since the Applicant has not filed any evidence in this regard, the Applicant has not met its burden and this factor should be assessed in favour of the Opponent.

[44] The Opponent submits that the likelihood of confusion is generally greater where the parties' goods or services, even if dissimilar, are offered through the same types of venues or the same kind of customers [see *Tribu Experientiel Inc v JKLP IP Pty Ltd*, 2021 TMOB 218 at para 76].

[45] The Opponent submits that in assessing the nature of the trade, the proper emphasis is on the parties' entitlement to sell the products through a given channel rather than whether they in fact do so [citing *Pink Panther, supra*; *Liverton Hotels International Inc v Diva Delights Inc*, 2015 TMOB 53]. Where an Applicant has provided no evidence about its customers or its channels of trade, the Board has been willing to find that the parties' channels of trade overlap. Further, the Opponent submits that given that the

Applicant's goods include pharmaceutical preparations and medical apparatus, it is not unreasonable to conclude that the channels of trade for such goods would be hospitals and drugstores. The Opponent submits that Dr. Vollenbroeker has provided evidence that the Opponent's goods are sold to hospitals and pharmacies throughout Canada for use by Canadian patients. Accordingly, the Opponent submits, the channels of trade for the Applicant's and Opponent's goods are identical and this factor strongly favours the Opponent.

[46] As per the above, both parties agree that their respective goods are not identical, but differ with respect to their degree of relatedness. However, I agree with the Opponent that as both parties' goods are used within the genitourinary and urological medical fields, there appears to be overlap [see *Evonik Industries AG v Glaxo Group Limited*, 2019 TMOB 49]. Furthermore, I accept that there is potential for the parties' goods to be used in conjunction with one another – as for example, the Applicant's goods include "catheters", while the Opponent's goods are used during catheterization.

[47] Moreover, in view of the Applicant's onus and the lack of evidence to the contrary, I accept that the parties' goods have potential to travel through the same channels of trade. That is, sold to the same healthcare professionals, institutional consumers including hospitals and pharmacies, and even more broadly, to the same end consumer or patient. Certainly, there are no restrictions on either party in this regard. Furthermore, with respect to the sophistication the parties' average consumers, the test for confusion is one of first impression. Therefore, any additional steps taken by a consumer to exercise due diligence in the purchasing decision are irrelevant [by analogy see paragraphs 68-74 of *Masterpiece, supra*].

[48] Accordingly, these factors favour the Opponent.

Section 6(5)(e) – the degree of resemblance

[49] When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality. The appropriate test is not a side by side comparison but an imperfect recollection in the mind of a consumer of an opponent's goods. Furthermore, in considering the degree of resemblance, it is preferable to start by considering whether there is an aspect of the trademark that is particularly striking or unique [*Masterpiece, supra* at paragraph 64].

[50] The Opponent submits that the proper approach is to identify and compare the "dominant" element of the marks, that is, the aspect of the marks that is particularly striking or unique.

[51] The Opponent submits that its mark includes a readily recognizable word ending "GEL", and as its product comes in "gel" form, this renders the portion "GEL" descriptive or otherwise non-distinctive. Thus, the Opponent submits the more dominant element of its trademark is the initial element "INSTILLA", which it submits does not have any particular meaning when considered in association with its goods.

[52] The Opponent submits that the Applicant's Mark consists of the word INSTYLAN, which it submits is highly similar in appearance to the dominant portion INSTILLA of the Opponent's mark, sharing both the first four letters INST and the two letters LA and having the same total number of letters. The Opponent submits that the parties' marks are also highly phonetically similar – where the "Y" could be sounded as a short "i". The Opponent submits that as the Applicant has provided no evidence of pronunciation of the Mark, it is not unreasonable to conclude that consumers and healthcare professionals could pronounce the Mark in this manner, making the parties' trademarks phonetically identical except for the end. Thus, the Opponent submits that the parties' marks bear unquestionable similarity in

appearance, in sound and in ideas suggested (if any). Moreover, the Opponent submits, the likelihood of confusion is to be determined on a balance of probabilities, with any doubt resolved in favour of the Opponent.

[53] The Applicant responds that the Opponent has improperly analyzed and dissected the subject marks into their component parts. I agree.

[54] Furthermore, the Applicant argues when considering the striking component of the Opponent's trademark, that as submitted by the Opponent, there are three recognizable letters at the end ("GEL") which would draw the consumer's attention and easily distinguish the marks from one another. However, as also submitted by the Opponent, the word GEL is suggestive, which diminishes its significance.

[55] With respect to ideas suggested, the Applicant submits that both parties' marks are word marks, each without meaning in English or French.

[56] The Applicant submits that the parties' marks have such a low degree of resemblance that it would be virtually impossible for the Mark to be confused with the Opponent's mark.

[57] While the first portion of a mark will in some cases be the most significant when assessing a likelihood of confusion [see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 1979 CanLII 4571 (FC), 46 CPR (2d) 183 at 188 (FCTD)], the resemblance must be assessed with a consideration of whether there is an aspect of the mark that is particularly striking or unique [see *Masterpiece, supra*, at para 64]. In the present case, in my view, the striking element of each party's trademark is the coined word that comprises each trademark in its entirety.

[58] There is a degree of resemblance between the marks visually, but only insofar as both marks begin with "INST" and include an "L". When sounded,

however, the marks as a whole appear quite different – differing in syllables, potentially and likely in the difference between a short “i” (in IN-STILL-A-GEL) versus a “y” with a long “i” sound (in IN-STY-LAN), and a much different ending. Furthermore, as previously indicated, it would appear that the Opponent’s trademark, although coined, in context of the Opponent’s goods, may be perceived as suggestive of the “instillation of gel”. On the other hand, there is no clear meaning or suggestive connotation with respect to the Mark – thus, there is no resemblance in the ideas conveyed.

[59] Having regard to the above, I find this factor strongly favours the Applicant.

Conclusion

[60] Having considered all of the surrounding circumstances, I find that the Applicant has met its onus to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent’s trademark. I reach this conclusion as I find that the lack of resemblance between the trademarks at hand outweighs all the other relevant factors which favour the Opponent combined. As was confirmed by the Supreme Court in *Masterpiece, supra* at para 49, “[...] if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion”.

[61] Accordingly, the section 12(1)(d) ground of opposition is rejected.

Section 16(1)(a) and Section 2 Grounds

[62] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark pursuant to section 16(1)(a) of the Act, because the Mark was confusing with the Opponent’s trademark INSTILLAGEL, which had been previously used in Canada in association with “lubricant local anesthetic and disinfectant for mucosa, for insertion”.

[63] The Opponent also pleads that the Mark is not distinctive within the meaning of section 2 of the Act. More specifically, the Opponent pleads that the Mark is not distinctive of the goods of the Applicant and is not capable or adapted to distinguish the Applicant's goods from those of others, including the goods with which the Opponent's INSTILLAGEL trademark has been used, advertised, registered and made known in Canada, and continues to be used.

[64] While the material dates differ, the section 2 and 16 grounds of opposition also turn on the issue of confusion. Thus, even if I were to find the Opponent has met its initial burden under these grounds, they would still fail for reasons analogous to those discussed under the section 12(1)(d) ground. That is, on a balance of probabilities, there is no reasonable likelihood of confusion between the Mark and the Opponent's trademark due to the insufficient degree of resemblance between them.

[65] Accordingly, these grounds of opposition are also rejected.

Section 38(2)(e) Ground

[66] The Opponent pleads that pursuant to paragraph 38(2)(e), at the filing date of the Application in Canada, the Applicant was not using and did not propose to use the Applicant's Mark in association with the Applicant's goods in Canada as the Applicant knew or ought to have known its trademark was confusing and lacked distinctiveness in view of the Opponent's registered and used trademark INSTILLAGEL.

[67] The Opponent submits that it has submitted sufficient evidence to establish that the Applicant's Mark was confusing and lacked distinctiveness in view of the Opponent's registered and used trademark INSTILLAGEL – and is, therefore, believed to have discharged its initial burden. The Opponent submits that the onus therefore shifts to the Applicant and as the

Applicant has filed no evidence, the Applicant has not established on a balance of probabilities that it was using and proposed to use the Mark in association with the goods in Canada.

[68] The Applicant, on the other hand, submits that the Opponent did not submit any evidence to refute the fact that the Applicant is using or is intending to use the Mark in Canada in association with all the goods noted in the application. The Applicant submits that by submitting its application, it has implicitly stated that it is using or is intending to use the Mark in association with the goods listed in the application and that the Registrar confirmed this as fact by accepting and approving the application. Thus, the Applicant submits that this ground ought to be disregarded and dismissed.

[69] An allegation of confusion alone, does not appear to support a ground of opposition based on section 38(2)(e) of the Act. In any event, even if I were to consider that this ground was properly pleaded, I have concluded that the parties' trademarks are not confusing.

[70] Accordingly, the ground based on section 38(2)(e) of the Act is rejected.

DISPOSITION

[71] Having regard to the aforementioned, 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.

Kathryn Barnett
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2025-05-05

APPEARANCES

For the Opponent: Kevin M. O'Brien

For the Applicant: No one appearing

AGENTS OF RECORD

For the Opponent: Macrae & Co.

For the Applicant: Timothy Weiss