

**IN ASSESSING THE RISK OF CONFUSION DISTINCTIVE SUFFIXES MAY BE OF
GREATER IMPORTANCE THAN WEAK COMMON PREFIXES, FEDERAL COURT OF
CANADA RULES**

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A recent decision of the Federal Court of Canada held that when assessing the risk of confusion between trade-marks, distinguishing suffixes can be of greater significance than common weak prefixes (*Merial LLC vs. Novartis Animal Health Canada Inc.* F.C.J. No. 136, T-1260-99, January 31st, 2001, Hansen, J.).

Facts. On February 14th, 1995, Merrick and Company Inc. filed an application to register the trade-mark ELIMINEX in association with veterinary anti-parasitic preparations. During the opposition proceedings the application stood in the name of the Applicant Merial LLC (“Merial”).

On January 2nd, 1996, the Respondent, (as a result of a merger) Novartis Animal Health Canada Inc. (“Novartis”) opposed the proposed registration primarily on the ground that the proposed trade-mark was confusing with its trade-mark, ELIMINATOR under application number 704,405 filed on proposed use in association with insecticidal ear tags.

Both Merial and Novartis filed affidavit evidence before the Opposition Board but no cross examinations were conducted.

On May 10th, 1999, the Opposition Board refused the registration of Merial’s mark, hence the present appeal to the Federal Court of Canada. No further evidence was adduced on appeal by Merial while Novartis filed additional evidence. There was no cross-examination on this additional affidavit evidence.

The Opposition Board’s decision. In assessing the risk of confusion, the Opposition Board considered the factors enumerated in Section 6(5) of the *Trade-Marks Act*. In rendering its decision that the marks were confusing, the Opposition Board considered that the marks in question were both suggestive

of the result of the use of the products, (i.e. the elimination of parasite's/insects from animals), that the wares of the parties were similar since they were both medical preparations for veterinary use for similar purposes and that the trades of the parties could overlap.

With regards to the degree of resemblance between the mark ELIMINEX and the mark ELIMINATOR, the Opposition Board ruled that there is "a fair degree of visual and phonetic resemblance due to the common prefix "ELIMIN-". The degree of resemblance with respect to the ideas suggested is greater since both mark suggest the concept of elimination".

As a surrounding circumstance, Merial tendered affidavit evidence in an attempt to demonstrate that there was a common adoption of the prefix "ELIM-". The Opposition Board considered that the state of the register evidence filed by Merial was irrelevant and proceeded to reject the registration of Merial's trade-mark.

Federal Court Trial Division Decision. On January 31st, 2001, the Federal Court Trial Division granted the appeal. The additional evidence filed by Novartis was disregarded since it did not disclose significant new material evidence to be considered by the Court.

In the eyes of the Court, Merial's strongest argument rested on its assertion that the Opposition Board erred in its analysis of the degree of resemblance between the parties' respective marks. Merial advanced that the Opposition Board did not respect the well established principle that when assessing the degree of resemblance between two marks, they are to be examined as totalities and not dissected.

The Federal Court agreed with Merial's contention that the Opposition Board's finding of confusion was predicated on its dissected analysis and emphasis on the common prefix "ELIMIN-" as well as the common connotation of the marks (i.e. elimination). Such an analysis, the Court ruled, failed to take into account the totalities of the two marks.

In rendering its decision, the Court seemingly created a nuance to the general principle that the first syllable of a trade-mark is far more important for the purposes of establishing confusion. When faced with a situation where distinctive suffixes are used in conjunction with common prefixes, the first syllable may no longer be of a significant factor.

The analysis of the suffixes. In comparing the suffixes in question, the Court made the following assessment: the suffix of Merial's trade-mark "-EX" in conjunction with the prefix "ELIMIN-" creates a coined word. The suffix of Novartis' trade-mark "-ATOR" creates a common vocabulary word.

As such, the Court concluded that the suffix "-EX" as opposed to the suffix "-ATOR", *when considering the totality of the two marks in question, has a greater impact and importance when the common prefix is weak and non-distinctive.* Moreover, the marks were, as a result, also phonetically dissimilar.

It is trite law that in assessing the risk of confusion trade-marks are to be examined in their totalities. This case serves as a reminder to trade-mark practitioners that the importance of this principle may be particularly relevant when faced with a situation where two trade-marks consist of common prefixes but dissimilar and distinctive suffixes.

Published at (2001), 15-6 W.I.P.R. 4-5 under the title *Distinguishing Suffixes May Be More Important Than Weak Common Prefixes.*

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