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BRAND OWNER SUCCESSFULLY OPPOSES SERIAL FILER'S ATTEMPT TO REGISTER *BAYER* MARK

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In a recent case, Bayer, a renowned healthcare company succeeded in opposing an attempt by an individual to register the trade-mark BAYER in association with a variety of consumer health care products (*Bayer Aktiengesellschaft v. Marcon*, 2011 T.M.O.B. 9, Cindy R. Foltz, Member, January 24, 2011).

Facts

On December 11, 2003, Robert Victor Marcon (hereafter: "Marcon" or the "Applicant") filed an application to register the trade-mark BAYER (hereafter: the Trade-mark") based upon proposed use of said Trade-mark in Canada in association with toothbrushes, toothpaste, dental floss and floss wands, mouthwash, dental whitening strips and pastes, dental desensitizing strips and pastes, aerosol breath fresheners, sunscreens; tanning balms, lotions, creams and combinations thereof. This application was advertised for opposition purposes on November 8, 2006.

On April 10, 2007, Bayer (hereafter: "Bayer" or the "Opponent") opposed the Trade-mark filed by Marcon, alleging that Marcon's application did not conform to the requirements of section 30(i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (hereafter: the "Act") insofar as he could not have been satisfied that he was entitled to use the mark BAYER in Canada. The Applicant had filed applications for well-known and arguably famous trade-marks in identical or related fields in Canada. The opponent's evidence consisted of certified copies of the Applicant's applications for these other marks: BEEFEATER, BUDWEISER, COORS, CORONA, DOM PERIGNON, EVIAN, FINLANDIA, HEINEKEN, JACK DANIEL'S, NESCAFÉ, NESTLÉ, TIM HORTONS, ABSOLUT, CANADIAN CLUB, SENSODYNE, SOUTHERN COMFORT and CHANEL.

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Additional grounds of opposition alleged that the BAYER mark filed by Marcon was not registrable because of confusion with several of the Opponent's registered trade-marks contrary to section 12(1)(d) of the Act, including most notably, the BAYER trade-mark registered under registration number TMDA 24895 in association with pharmaceutical preparations used since January 1896 for the relief of pain and to reduce fever, composed of and/or containing acetylsalicylic acid and in association with nasal decongestants used since January 1956.

Trade-marks Opposition Board

In her reasons, Member Cindy R. Folz dealt first with the issue of confusion and the applicable statutory criteria upon which the risk of confusion is determined. She considered registrations TMDA 24895 and TMA 469,352 for the BAYER marks to be the most relevant to issue of confusion and hence focussed her discussion on these marks.

On the issue of the inherent distinctiveness of the marks, Marcon argued that the Opponent's trade-mark BAYER was a weak mark and supported his pretensions by filing Internet evidence showing listings of Bayer as a surname in Canada and the US, and listings of six geographical locations in Canada that begin with the word Bayer or Bayers, i.e. Bayer Lake, in addition to printouts from third party websites that relate to four businesses in the United States whose names include "Bayer".

Noteworthy, the Applicant has filed similar evidence in the opposition proceedings regarding the trade-marks CORONA, L'OREAL PARIS, CHANEL and EVIAN [see *Cerverceria Modelo, S.A. v. Marcon*, (2009), 70 C.P.R. (4th) 355 at 372 (T.M.O.B.), *L'Oréal v. Marcon*, 85 C.P.R. (4th) 381 (T.M.O.B.), *Chanel S. de R.L. v. Marcon* (2010), 85 C.P.R. (4th) 399 (T.M.O.B.) and *Société Anonyme des Eaux Minérales D'Evian v. Marcon*, 2010 TMOB 83].

In each of those decisions, as with this BAYER case, it was emphasized that the Registrar is to consider both the inherent distinctiveness and the acquired distinctiveness of the marks at issue. Member Cindy R. Foltz therefore disagreed with Marcon's argument, noting that even if Marcon's evidence were sufficient to show how the average Canadian would perceive the BAYER mark, on its own, it would be insufficient to show the Opponent's mark is entitled to a narrow ambit of protection. She thereafter commented that the Opponent's mark has acquired a high degree of distinctiveness through significant use in Canada over the years. The evidence revealed that total sales figures on an annual basis for consumer care products in Canada, for the period between 2000-2006, ranged between \$910 million to over 1.6 billion. The evidence also included surveys of the Canadian public conducted in 2006 and 2007 which indicated that BAYER was the most recognized health care brand in Canada and that Canadians had also voted Bayer as the top respected healthcare company in Canada. Member Cindy R. Foltz was therefore satisfied that the Opponent's BAYER trade-mark had become very well-known in Canada.

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As for the nature of the parties' respective goods, Member Cindy R. Folz acknowledged that while they may be different, she agreed with the Opponent's contention the goods are nevertheless related to the extent that they all comprise consumer health care products. In the absence of any evidence to the contrary, it was decided there was a connection between the parties' goods.

As for the parties' respective fields of trade, Member Cindy R. Folz noted the Opponent's evidence showed that its consumer care products, including those sold under the BAYER trade-mark, were sold in retail pharmacies, supermarkets and department stores, while the Applicant did not file any evidence with regards to where its products would be sold. As a result, given the Applicant's goods also comprised consumer care products, it was decided the parties' channels of trade would presumably overlap.

In refusing Marcon's application for the Trade-mark, Member Cindy R. Folz noted the extensive reputation and use of the Opponent's BAYER mark in Canada, the overlap between the channels of trade and the fact that the marks were identical, before concluding that Marcon had not discharged his burden of showing, on a balance of probabilities, that there was no reasonable likelihood of confusion between his Trade-mark, and the Opponent's registered BAYER marks. The ground of opposition based on confusion was therefore successful.

T.M.O.B. silent on Marcon's satisfaction as to his entitlement to use BAYER mark

It is interesting to note that having already refused Marcon's application on all associated grounds relating to confusion, Member Cindy R. Folz did not address the ground of opposition based on Section 30(i) of the Act that requires that an applicant include in his application for registration of a trade-mark a statement that he is satisfied that he is entitled to use the trade-mark in Canada in association with the listed wares or services described in its application.

Other T.M.O.B. decisions relating to Marcon's applications

There are nevertheless at least two other decisions where Marcon's serial filer conduct was put into question in relation to this ground. In her decision refusing Marcon's application for the trade-mark CORONA in 2008, after reviewing the evidence, Member Folz allowed this ground in consideration of Marcon's having filed 18 other arguably well-known marks for related wares and/or services which raised suspicion about his good faith in submitting his application for the trade-mark CORONA.

In her decision refusing Marcon's application for the trade-mark L'OREAL PARIS in 2010, Chairperson Carreau reminded the parties that the presence of an Applicant's statement as to its satisfaction that it is entitled to use the applied for mark is more than a formal requirement, it is confirmation of the applicant's good faith in submitting its application for registration of a trade-mark in Canada. Accordingly, this ground usually succeeds under exceptional circumstances.

The evidence demonstrated that in 2003, when the L'OREAL PARIS application was filed, the Applicant also filed in his name several other applications to register these other trade-marks in Canada: BAYER, BEEFEATER, BUDWEISER, COORS, CORONA, DOM PERIGNON, EVIAN, FINLANDIA, HEINEKEN, JACK DANIEL'S, NESCAFÉ, NESTLÉ, SENSODYNE, TIM HORTONS, ABSOLUT, CANADIAN CLUB, SOUTHERN COMFORT and CHANEL. The evidence also illustrated, by way of certified copies of several Canadian trade-mark registrations, that the trade-marks filed by Marcon in 2003 had already been registered in Canada, some several decades earlier, in the name of third parties. Chairman Carreau held that the evidence showed the particular facts of the L'OREAL PARIS case were exceptional and that the evidence did not allow her to be satisfied that Marcon's statement required by s.30(i) of the Act was made in good faith.

Conclusion

Excluding this most recent BAYER decision, there are five other T.M.O.B. decisions where Marcon's applications for registration have been refused: CORONA (August 12, 2008), BEEFEATER (March 24, 2009), L'OREAL PARIS (May 17th, 2010; opponent represented by ROBIC, LLP), EVIAN (June 4th, 2010; opponent represented by ROBIC, LLP) and CHANEL (June 21, 2010), none of which were appealed. The same number of trade-mark applications are tied up in varying stages of opposition proceedings pending before the T.M.O.B.: HEINEKEN, COORS, FINLANDIA, DOM PERIGNON (opponent represented by ROBIC, LLP), and JACK DANIEL'S.

As shown by previous T.M.O.B. decisions involving Marcon's applications, the BAYER decision equally illustrates that a brand owner may successfully defend its well-known marks based on grounds of opposition relating to confusion. However, while the BAYER decision remained silent on the issue of an applicant's intent when attempting to register a mark, some of these same previous decisions illustrate an increasing willingness by the T.M.O.B. to entertain claims challenging the truthfulness of statements contained in applications, thereby allowing opponents to cumulatively succeed on grounds of opposition relating to non conformity with s. 30 of the Act.

Time will tell if the pending Marcon oppositions will result in decisions that arguably may breathe new life into the ability of opponents to challenge applications on the basis of an applicant's good faith. In the interim, applicant's are best advised to be prepared and able to support their claim regarding their entitlement to use their applied-for mark.

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