

Montreal, November 10, 2015

The Registrar
Canadian Intellectual Property Office
Trade-Marks Office
EXAMINATION SECTION
Place du Portage I, Room C-114
50 Victoria Street
Gatineau, Quebec
K1A 0C9

Attention: Michelle Yu, Examiner

Trademark : **ON!**
Application : 1 672 960
Applicant : WM17 HOLDING AG
O/Ref. : 000158-0194 BHS/GUB

Dear Registrar,

We acknowledge receipt of the Examiner's report of November 10, 2014 and would like to make the following observations in response to the objections raised therein.


AMENDED APPLICATION

Firstly, please find enclosed an amended application in which we have respecified the objected goods and services.

CONFUSION


In your report, you were of the opinion that the above-cited trademark application **ON!** (No. 1 672 960) would be confusing with the trademark registration **ON (& DESIGN)** in the name of GIAMBIA NUTRITIONALS (No. 716,480) and trademark application **ON (& DESIGN)** in the name of BRITISH AMERICAN TOBACCO (BRANDS) LIMITED (No. 1 632

531). We respectfully submit that these objections should be withdrawn for the reasons hereafter explained.

 (TMA716,480)
Giambia Nutritionals (Ireland) Limited

- **NATURE OF THE GOODS**

Further to the revised description of goods of the applicant's trademark, we submit that the applicant's goods are very different from the cited trademark's goods:

<p style="text-align: center;">ON!</p> <p style="text-align: center;">Appl. No. 1 672 960</p>	<p>Medical nicotine chewing gum for use as an aid to stop smoking, medical transdermal plasters for use as an aid to stop smoking;</p> <p>Smokeless tobacco products, namely snuff and snus; pouches containing smokeless tobacco for oral use, electronic cigarettes</p>
<p style="text-align: center;"></p> <p style="text-align: center;">Reg. No. 716,480 GIAMBIA NUTRITIONALS</p>	<p>Dietary and nutritional supplements, namely, dietary and nutritional supplements in capsule, powder, tablet, liquid, softgel and meal replacement bar forms, all for promoting weight loss, improving body strength and recovery and building body mass; dietary food supplements, namely, protein drink mixes, protein powders, meal replacement drink mixes, meal replacement bars, protein snack bars, fish oil and flax seed softgels; nutritional bars; vitamin and mineral nutritional supplements; meal replacement and dietary supplement drink mixes; powdered nutritional supplement drink mixes; and nutritional ingredients for various powdered and ready-to-drink beverages, namely, whey proteins, casein proteins, egg proteins and soy proteins.</p>

Indeed, applicant's trademark is filed in association with smokeless products for use as an aid to stop smoking while the cited trademark is registered in association with dietary and nutritional supplements.

We respectfully submit that these products are completely different and shall not be found in or offered in the same stores and, if they do, they will not be found or offered in the same store department. They address different needs and respond to different goals. The probability of finding both marks in the same store is therefore virtually non-existent.

For these reasons, we respectfully submit that the Examiner's objection based on alleged confusion with the registration No. 716,480 should be withdrawn.

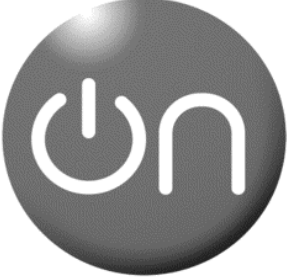


(1,632,531)

British American Tobacco (Brands) Limited

1. NATURE OF THE GOODS

Further to the revised description of goods of the applicant's trademark, we submit that the applicant's goods are very different from the cited trademark's good, in fact, they are diametrically opposed:

<p style="text-align: center;">ON!</p> <p style="text-align: center;">Appl. No. 1 672 960</p>	<p>Medical nicotine chewing gum for use as an aid to stop smoking, medical transdermal plasters for use as an aid to stop smoking;</p> <p>Smokeless tobacco products, namely snuff and snus; pouches containing smokeless tobacco for oral use, electronic cigarettes</p>
 <p style="text-align: center;">Appl. No. 1 632531 (in opposition) BRITISH AMERICAN TOBACCO (BRANDS) LIMITED</p>	<p>Cigarettes, tobacco, tobacco products, lighters, matches, smokers' articles, namely ashtrays and cigarette cases; cigarette filters</p>

Indeed, applicant's trademark is filed in association smokeless products for use as an aid to stop smoking while the cited trademark is registered in association with cigarettes and tobacco products. In fact, the applicant's products are used to reduce consumption of the cited trademark's products.

We respectfully submit that these products are completely different and shall not be found in the same channel of trade. Indeed, the applicant's products will be sold in pharmacies or specialized stores to help stop smoking, while the cited mark's products are sold in many different stores but not in pharmacies. In fact the sale of tobacco is prohibited in pharmacies in all provinces and territories of Canada, except for British Columbia.

The tobacco industry is extremely regulated in Canada in terms of how tobacco products are sold and their branding and promotion. This is an additional circumstance in support of applicant's position.

Also, one must take into consideration that a consumer is not devoid of all intelligence and that given today's consumers, there can be no confusion as to the source of the goods of the trademarks. To this effect, in the matter of *Michelin & Cie v. Astro Tire & Rubber Co. of Canada Ltd.*, (1982), 69 C.P.R. (2d) 260 (F.C.T.D.), Justice Addy stated the following, at page 263:

In determining whether two trade marks are or are not confusingly similar (under section 6(2)), one must avoid arriving at that conclusion by a detailed examination of both marks, but, by the same token, one must not proceed on the assumption that the prospective customers or members of the public in general are completely devoid of intelligence or of normal powers of recollection or are totally unaware or uninformed as to what goes on around them.

In applying this principle, we are of the opinion that there is no likelihood of confusion between the applicant's mark and the cited mark because of the difference as to the nature of the goods and therefore, it is submitted that no confusion is lightly within the meaning of subsection 6(2) of the *Trade-marks Act*.

For all these reasons, we respectfully submit that the Examiner's objection based on alleged confusion with application No. 1,632,531 should be withdrawn.

2. LETTER OF CONSENT AND COEXISTENCE AGREEMENT

Finally, please find enclosed a letter of consent signed by BRITISH AMERICAN TOBACCO (BRANDS) LIMITED, owner of the cited application, to the registration and use of the applicant's trademark in Canada. We are aware that such document is not binding upon the Registrar but we think that it should be taken into consideration.

As to this point, reference can be made to James Van Santen and R. Denis Claessens in *Consents to Register in Ex Parte cases under Section 2(d) of the Lanham Act – A Forty Year Debate*, (1989), 79 TMR 89. Mr. Van Santen and Mr. Claessens review the US Courts position on the subject of letters of consents signed by the owner of a trademark in favour of the applicant of a similar mark. The authors make the following comments concerning the *Lanham Act* (*i.e.* the US equivalent of our *Trade-Marks Act*) at pages 130-131:

As stated in the opinions of Judge Rich in *National Distillers*, *Continental Baking*, *Zildjian* and *Ultra-White*, and adopted by the court in *du Pont*, one of the purposes of the *Lanham Act* was to liberalize registration so that marks in use would be reflected on the Register. Thus, registration should follow use as closely as possible, and registration should not be denied to anyone who has the right to use a mark, either by a court decree, settlement agreement or the registrant's well-reasoned, bona fide consent, and the right to exclude others from such use. A denial of registration in any of the above circumstances fosters rather than prevents confusion because the mark most likely will be used, and such denial deprives the owner/applicant of the use of *Lanham Act* remedies against subsequent users who do not have the right, as against it, to use the mark. Such a denial also deprives the public of notice of a mark in use in commerce through the public record.

As you may notice, the authors believe that the assessment of the risk of confusion between two trademarks must be evaluated while taking into account the consequence of a trademark application on the owner of a previously registered trademark. The presence of a consent signed by the owner of the previously registered trademark should be a key element in favour of the registration of the requested trademark since

the owner of the previously registered mark is often the best one to evaluate the risk of confusion between its mark and the mark of others.

For all these reasons, we respectfully submit that the Examiner's objection based on alleged confusion with the registration No. 716,480 and with application No. 1,632,531 should be withdrawn.

May we remind the Examiner that any doubt concerning the registrability of the applied for trademark must be resolved in favour of the applicant, pursuant to subsection 37(3).

We shall await confirmation that the above-mentioned trademark has been approved to publication and, in the meantime, we remain,

Yours very truly,

A handwritten signature in blue ink that reads "Robic". The signature is written in a cursive, flowing style.

ROBIC, LLP
Trade-Marks Agents and
Attorneys for the Applicant
(No. 4779)
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Encls.