

**IN THE MATTER OF AN OPPOSITION by
Mansfield Medical Distributors, Ltd. to
application No. 893,588
for the trade-mark OVU-TRAC
filed by Colleen Biggs (now in the name of
The Natural Fertility Awareness Company Inc.)**

On October 19, 1998, Colleen Biggs filed an application to register the trade-mark OVU-TRAC.

The application is based upon use of the trade-mark in Canada since December 18, 1996 in association with the following wares and services:

Wares:

Women's natural fertility awareness test kit; optical apparatus for women's natural fertility test, namely, microscopes; medical diagnostic test kits consisting of saliva collection slides.

Services:

Provision of individual and couple's consulting and counseling services in the field of natural fertility awareness for women; providing information services on the Internet and world-wide-web in the field of natural fertility awareness for women; educational services, namely, providing classes, workshops and programs by means of and over the telephone and world-wide-web (Internet) in the field of natural fertility awareness for women; and information services, namely, information and tips in the field of natural fertility awareness for women delivered to visitors' e-mail addresses by means of and over the Internet.

The application was advertised for opposition purposes in the Trade-marks Journal of December 15, 1999. The opponent, Mansfield Medical Distributors, Ltd., filed a statement of opposition on February 3, 2000.

In the statement of opposition, the opponent alleges that the applicant is not the person entitled to register the trade-mark OVU-TRAC, that the trade-mark OVU-TRAC is not registrable and that

the trade-mark OVU-TRAC is not distinctive, all because there is a likelihood of confusion between the mark OVU-TRAC and the opponent's mark OVU-THERM. The opponent alleges that prior to the applicant's claimed date of first use, the opponent used the trade-mark OVU-THERM in Canada in association with clinical thermometers. In addition, it registered OVU-THERM under No. TMA432,417.

The opponent has also pleaded that the applicant's application does not conform to the requirements of section 30 of the *Trade-marks Act* because the trade-mark was not used by Colleen Biggs in association with the wares and services applied for since at least as early as December 18, 1996, the mark "having been used if used at all since December 18, 1996 by The National Fertility Awareness Company and not by the applicant Colleen Biggs."

On August 10, 2000, a confirmatory assignment was filed to record The Natural Fertility Awareness Company Inc. (hereinafter the applicant) as the owner of the application. The assignment was executed July 4, 2000 but was stated to be *nunc pro tunc* November 1, 1998. The change in title was recorded by the Canadian Intellectual Property Office on October 27, 2000.

On October 13, 2000, the applicant filed and served a counter statement in which it denied the opponent's allegations. With respect to the section 30 ground of opposition, the applicant stated:

The Trade Mark was used by Colleen Biggs operating in business as sole proprietor commencing December 18, 1996. Colleen Biggs subsequently incorporated The Natural Fertility Awareness Company and transferred rights in the Trade Mark to The Natural Fertility Awareness Company, the current Trade Mark owner.

The opponent filed as its evidence the affidavits of Sandra Vickers and Irwin Braude.

Ms. Vickers provides a copy of an advertisement for the OVU-TRAC natural fertility tester that she located on the Internet on January 26, 2000. The ad reads in part, “the Natural Fertility Awareness Company created the OVU-TRAC Natural Fertility Tester” and elsewhere refers to Colleen Biggs as President of The Natural Fertility Awareness Company. Ms. Vickers does not indicate if this was the only item that she located on the Internet with respect to OVU-TRAC.

Mr. Braude, the opponent’s president, confirms that his company has been selling OVU-THERM clinical thermometers since at least as early as 1984. He states that the annual sales of OVU-THERM thermometers in 1999 amounted to 3430 units or \$12,766. In 2000, such sales were 3090 units or \$12,416. He provides a sample of the packaging used in Canada for the OVU-THERM thermometer. The box refers to the product as a basal thermometer, which it describes as “a method of fertility awareness”. Since 1995, the opponent has purchased and used 22,200 boxes for its OVU-THERM thermometers. Mr. Braude also provides a copy of the opponent’s registration TMA432,417 for the OVU-THERM trade-mark.

The applicant's evidence consists of the affidavit of Colleen Biggs, the President of The Natural Fertility Awareness Company Inc. Ms. Biggs’ affidavit focuses on the OVU-TRAC fertility testing kit, which is the product offered for sale in the ad presented by Ms. Vickers.

Ms. Biggs explains that the OVU-TRAC fertility testing kit contains a microscope, microscopic slides, a tracking chart, a carrying case, batteries and instructions on how to use the microscope to analyse a woman’s saliva in order to determine fertility. The OVU-TRAC fertility testing kit sells

for a wholesale price of \$65.97, with a suggested retail price of \$109.95. Annual wholesale sales have been as follows: 1998 - \$9,901.07; 1999 - \$13,772.21; 2000 - \$20,620.15; 2001 (as of June) - \$7,590.30.

Ms. Biggs has provided a copy of the original 1996 packaging for the OVU-TRAC kit, as well as packaging used in June 2001. The former refers to The Natural Fertility Awareness Company, while the latter refers to The Natural Fertility Awareness Company, Inc. She also provides an invoice that she says is proof of her claimed date of first use. The invoice, Exhibit "I", is dated December 4, 1996 and refers to an OVU-TRAC fertility tester being sold to an individual in Alberta. However, there is only one name that appears on the invoice, Nu Focus Canada West which appears at the top.

As Exhibits "J" through "O", Ms. Biggs provides representative invoices regarding the sale of OVU-TRAC fertility testers to show on-going commercial activity since the date of first use. The invoices prior to April 1997 list Nu Focus Canada West as the issuer. After that, Treat Yourself Naturally is listed as the issuer and starting with the invoice dated October 23, 1997, there is the following statement that appears at the bottom of such invoices: "The Natural Fertility Awareness Company is a division of Treat Yourself Naturally." Beginning with an invoice dated October 21, 1998, the issuer is identified as The Natural Fertility Awareness Company, Inc., but this reverts to simply The Natural Fertility Awareness Company on the invoices issued in 2000 and 2001.

Ms. Biggs states that she started the business relating to OVU-TRAC as a sole proprietorship and upon incorporation of The Natural Fertility Awareness Company Inc. subsequently conducted

business through this company. She provides as Exhibit “R” a copy of “a form of assignment evidencing the transfer of the Trade Mark from myself to that company”, which is the *nunc pro tunc* assignment referred to above. We have not been told when The Natural Fertility Awareness Company Inc. was incorporated. In addition, it is unclear to me who/what is The Natural Fertility Awareness Company, given that this name appears associated with the product both before and after Ms. Biggs’ assignment to The Natural Fertility Awareness Company Inc. Altogether, there are three names, The Natural Fertility Awareness Company, Nu Focus Canada West, and Treat Yourself Naturally, associated with the OVU-TRAC kit whose role and legal status are unclear.

Ms. Biggs informs us that \$39,184.32 has been spent on development, package design, advertising and promotion with respect to OVU-TRAC and she provides some of the promotional materials and advertisements for the OVU-TRAC natural fertility tester. These items refer to The Natural Fertility Awareness Company, Inc.

Ms. Biggs explains that the suffix TRAC “was chosen as the testing kit enables a woman to ‘track’ her fertile phase.” She also states that the prefix OVU “is in use with products having to do with women’s fertility as it is the root for the words ‘ovule’, ‘ovum’, ‘ovular’, ‘ovulation’, and ‘ovulate’.” She provides dictionary definitions for ‘ovulate’, ‘ovulatory’, ‘ovule’, ‘ovum’, ‘track’ and ‘therm’.

Ms. Biggs states that there are other OVU prefixed marks “currently in use relating to women’s fertility which have nothing to do with either the present Applicant or Opponent.” She provides information about an OVUQUICK testing kit that she bought in Edmonton on May 23, 2001. She

also provides results of searches that she conducted on the Internet directed to OVU-TRAC, OVUQUICK, OVU-TECH and OVU. The Internet search that she conducted for OVU-THERM resulted in no hits.

Each party filed a written argument.

On January 16, 2002, the applicant requested that an oral hearing be scheduled. By letter dated July 18, 2002, the applicant requested leave to file a supplementary affidavit of Colleen Biggs. The Chair of the Trade-marks Opposition Board responded by pointing out that no request for leave to file additional evidence may be considered unless it is specifically agreed that the affiant will be made available for cross-examination at the request of the other party. As the applicant made no further attempt to obtain leave, the supplemental affidavit is not of record in the present proceedings.

An oral hearing was held at which both parties were represented.

Likelihood of Confusion

The material dates with respect to the grounds of opposition based on a likelihood of confusion are as follows: registrability under paragraph 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)]; entitlement under subsection 16(1) - the applicant's date of first use; non-distinctiveness - the date of filing of the opposition [see *Re Andres Wines Ltd. and E. & J. Gallo*

Winery (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.)].

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in subsection 6(5) of the *Act*. Those factors specifically set out in subsection 6(5) are: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; and the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. The weight to be given to each relevant factor may vary, depending on the circumstances [see *Clorox Co. v. Sears Canada Inc.* 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

OVU-TRAC and OVU-THERM are both invented words and both have some degree of inherent distinctiveness. However, there is a significant element of suggestiveness in each of the marks when considered in association with the wares with which they are used.

Only the OVU-TRAC trade-mark appears to have acquired distinctiveness through advertising, but the extent of this is difficult to ascertain.

The OVU-THERM trade-mark has been used for a much longer period of time. As of December 18, 1996, the extent to which the marks had become known clearly favours the opponent. As of

February 3, 2000, at least 600 OVU-TRAC kits, with a wholesale value of approximately \$42,000, had been sold. At that date, at least 3430 OVU-THERM thermometers had been sold, with a value of \$12,000. As of today's date, the applicant's sales of kits have amounted to at least 750 units or \$50,000 while the opponent has had sales of at least 6500 units or \$25,000. The opponent's sales may in fact have been much greater than stated as of each of the material dates given that Mr. Braude has attested that 22,000 OVU-THERM packages have been used since 1995.

The wares covered by the registration for OVU-THERM, clinical thermometers, are not at first blush related to the applicant's wares or services. However, the wares with which OVU-THERM is being used, basal thermometers, are more obviously related given their common purpose of determining fertility. Nevertheless, as pointed out by the applicant's agent, there are differences between the parties' wares, *e.g.* thermometers versus microscopes, which should not be downplayed too much since the purpose of the wares may be similar but the means of achieving the goal are quite different.

Given that both parties' products are used by women to determine their fertility, it is safe to assume that they could travel identical channels of trade.

There is a fair degree of resemblance between OVU-TRAC and OVU-THERM but, as pointed out by Ms. Biggs, this similarity is largely due to the common prefix OVU, which is a logical prefix for trade-marks associated with fertility products. The idea suggested by the opponent's trade-mark is that its thermometers would be used to determine if one's temperature indicated ovulation was taking place. The idea suggested by the applicant's trade-mark is that the associated wares and

services can be used to track ovulation.

As a further surrounding circumstance, the applicant has submitted limited evidence of third party use of OVU prefix marks.

There is a legal burden on the applicant to establish on a balance of probabilities that there would be no reasonable likelihood of confusion between the marks in issue. This means that if a determinate conclusion cannot be reached, the issue must be decided against the applicant [see *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293]. I find that a consideration of all the surrounding circumstances leads to the conclusion that there is not a reasonable likelihood of confusion between the applicant's OVU-TRAC wares and services and the opponent's OVU-THERM wares. My conclusion is based primarily on the suggestiveness of the common prefix OVU, as well as the overall suggestiveness of each of the marks. I do not believe that the ordinary Canadian consumer or purchaser of fertility detecting products would be likely to think that OVU-THERM thermometers and the applied for OVU-TRAC wares and services share a common source. While the first component of a mark is often considered more important for the purpose of distinction, when a word is a descriptive or suggestive word, it is entitled to a narrower range of protection than an invented or unique word [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) and *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

As my conclusion is the same as of each of the material dates, the grounds of opposition based on registrability, entitlement and distinctiveness all fail.

Section 30

The burdens on each of the parties with respect to a subsection 30(b) ground of opposition were summarized as follows by the former Chair of the Opposition Board, Mr. Partington, in *Ivy Lea Shirt Co. v. Muskoka Fine Watercraft and Supply Co.* (1999), 2 C.P.R. (4th) 562 at 565-6 (T.M.O.B.), aff'd 11 C.P.R. (4th) 489 (F.C.T.D.):

While the legal burden is upon the applicant to show that its application complies with Section 30 of the *Trade-marks Act*, there is an initial evidential burden on the opponent to establish the facts relied upon by it in support of its Section 30 ground (see *Joseph E. Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 (T.M.O.B.) at pp. 329-330; and *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.)). However, the evidential burden on the opponent respecting the issue of the applicant's non-compliance with Subsection 30(b) of the *Act* is a light one (see *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.H.O.) at p. 89). Further, the opponent may rely upon the applicant's affidavit evidence to meet its evidential burden in relation to this ground. In such a case, however, the opponent must show that the applicant's evidence is "clearly" inconsistent with the applicant's claims set forth in its application.

The opponent's evidence in support of its section 30 ground of opposition comprises a January 26, 2000 advertisement for the OVU-TRAC fertility awareness test kit that says, "the Natural Fertility Awareness Company created the OVU-TRAC Natural Fertility Tester." Given that Colleen Biggs assigned her rights to The Natural Fertility Awareness Company Inc., I do not consider it appropriate to accord much significance to this ad copy.

The applicant's evidence concerning the first use of OVU-TRAC in association with a women's natural fertility awareness test kit is more pertinent. This evidence comprises an invoice dated December 4, 1996 for one OVU-TRAC Fertility Tester and one FREESKIN Botanical Formula. In general, an invoice that refers to a trade-mark in its body is not use of a trade-mark in accordance with section 4 of the *Act*, unless there is evidence that the invoice accompanied the wares. In the

present case, the invoice states that the product was shipped on the same day by Express Post and there is also evidence that packaging used in 1996 for the OVU-TRAC product displays the trade-mark. The evidence is therefore not clearly inconsistent with the conclusion that the trade-mark was used in association with fertility tester kits as of December 18, 1996.

The question then becomes, is this invoice clearly inconsistent with the claim that Colleen Biggs herself used the trade-mark. Ms. Biggs' name does not appear anywhere on the invoice. Instead the name and address at the top is Nu Focus Canada West, P.O. Box 249, Coronation, Alberta. That happens to also be the address given in the original trade-mark application for Colleen Biggs, as well as the address of the current owner The Natural Fertility Awareness Company Inc. If we turn to the original packaging used for the OVU-TRAC product in 1996, we see no address and no reference to either Colleen Biggs or Nu Focus Canada West. Instead there is the name "The Natural Fertility Awareness Company". The final available piece of the puzzle is Ms. Biggs' sworn, uncontradicted statement that she started the business relating to OVU-TRAC as a sole proprietorship and conducted business through The Natural Fertility Awareness Company Inc. once it was incorporated.

At the oral hearing, the opponent's agent commented that we do not know the role of Nu Focus Canada West and that it is possible that it is a retailer. If that were the case, then it is the name on the packaging used for the first sale that would be perceived by the purchaser as the source of the OVU-TRAC wares. However, is it fair to conclude that packaging said to have been used in 1996 was in fact used for the product shipped December 4, 1996? I think so. Accordingly, I conclude that the opponent's evidential onus is satisfied with respect to women's natural fertility awareness

test kits by the applicant's own evidence. Moreover, the applicant has failed to meet the burden on it to show that Colleen Biggs was herself using the trade-mark OVU-TRAC in association with women's natural fertility awareness test kits as of her claimed date of first use. The evidence suggests that the public would have identified The Natural Fertility Awareness Company or Nu Focus Canada West as the source of the kits in 1996. It would have been a simple matter for Ms. Biggs to explain what her relationship was with each of these entities. Her failure to do so results in the applicant failing to satisfy its burden under section 30, at least so far as "women's natural fertility awareness test kits" are concerned.

The opponent has commented that there is no evidence concerning the first use, or any other use, of OVU-TRAC in association with the services and wares applied for, other than the "women's natural fertility awareness test kit". While this is true, there is no obligation on the applicant to file such evidence in the absence of any evidence which could support a conclusion that the applicant did not use the mark for these other wares and services as of the claimed date of first use. In other words, the opponent has not met its initial evidential burden, light as it is, with respect to the remaining wares and services.

The section 30 ground of opposition therefore succeeds with respect to only "women's natural fertility awareness test kit".

Distinctiveness

Before concluding, I wish to address the submissions made by the opponent with respect to the applicant's mark not being distinctive as a result of other, unexplained names being associated

with the product at various points of time. I need not determine the validity of such an argument for the simple reason that the ground of opposition based on non-distinctiveness was not pleaded broadly enough to consider such an issue. The opponent should have requested leave to amend its statement of opposition if it wished to plead that the applicant's trade-mark was not distinctive because other names have been associated with the OVU-TRAC products.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the *Trade-marks Act*, pursuant to subsection 38(8) of the *Act* I refuse the application with respect to the wares "women's natural fertility awareness test kit". The opposition is rejected with respect to the remaining wares and services. Authority for a split decision is set out in *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH*, 10 C.P.R. (3d) 492 (F.C.T.D.).

DATED AT GATINEAU, QUEBEC, THIS 7TH DAY OF OCTOBER, 2003.

**Jill W. Bradbury
Member
Trade-marks Opposition Board**