

TRADUCTION/TRANSLATION

**IN THE MATTER OF AN OPPOSITION BY
XS Energy, LLC to the application for
registration No. 1129235 for the trade-mark
ISO-PRO XS filed by Frank Petrillo**

I. The proceedings

Frank Petrillo (the applicant) filed an application for the registration of the trade-mark ISO-PRO XS (the Mark) on January 28, 2002, based on use since January 1, 2001, in association with the following wares: dietary supplements, food supplements, and meal replacements namely: protein enriched nutritional bar, high energy nutritional bar, protein enriched drink in the form of powder, crystals or liquid, protein powder, vitamins in the form of powder, crystal, capsule or liquid, proteins in the form of powder, crystal, capsule or liquid, protein and/or carbohydrate-based fortifiers and tonics and/or vitamins and/or minerals and/or amino acids in the form of powder, crystal, capsule or liquid (Wares).

This application was published on September 10, 2003, in the *Trade-marks Journal* for the purposes of opposition.

XS Energy, LLC (opponent) filed a statement of opposition on November 20, 2003. The grounds of opposition are essentially as follows:

- (1) Pursuant to the provisions of paragraph 38(2)(a) and section 30 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (Act), the application for registration does not satisfy the requirements of the Act in that the applicant did not use the Mark in association with the Wares on the date of first use alleged in the application for registration;
- (2) Pursuant to the provisions of section 2 of the Act, the Mark is not distinctive or adapted so to distinguish the Wares based on the use of similar trade-marks in the North American and Canadian markets.

On June 3, 2004, the applicant filed a counter statement of opposition essentially denying the grounds of opposition described above. The opponent filed into evidence the affidavit of

Katherine Busse and the applicant filed his own affidavit. Mr. Petrillo was cross-examined. The parties did not file written arguments and a hearing was held.

II. The evidence in the record

Ms. Busse is a trade-marks researcher. On December 1, 2004, she carried out a search using the database CDNameSearch, which contains the register of trade-marks information. She filed excerpts from this database regarding the following trade-marks:

XS and graphic, application for registration number 1160402;
XS POWER DRINK, certificate of registration TMA611309.

Mr. Petrillo alleges that he is the owner of the trade-mark ISO-PRO, certificate of registration number LMC584984 and filed a photocopy of an excerpt of the register of trade-marks from the Strategis website in support of his claims. He filed invoices attesting that they represented the purchase of labels bearing the Mark in order to prove use of the Mark since at least May 2000. The invoices filed are those of another entity, i.e. Custom Nutritionals Inc. and, contrary to the allegations made, it does not appear that these invoices represent the purchase of labels. Further, the invoices refer to the trade-mark ISO PRO and not the Mark. He filed a photocopy of a photograph of one of the Wares bearing the Mark. Finally, the other allegations are arguments on questions of law to be decided by the Registrar and I will therefore not consider these remarks.

During his cross-examination, he stated that Custom Nutritions [*sic*] Inc. manufactures Wares for the applicant. He stated that Ultimate Muscle Media Inc. and BNC Lasalle, two entities whose names appear on the invoices filed, are companies owned by him. He filed a label on which the Mark appears with LTN Development named as the manufacturer of the product in Canada. There is no information in the record regarding any existing legal connection between the applicant and LTN Development.

III. The applicable law

Procedurally, when opposing the registration of a trade-mark, the opponent must file sufficient evidence regarding the grounds of opposition raised by the opponent so that it is clear that there

are facts tending to support those grounds of opposition. If the opponent meets this requirement, the applicant must persuade the Registrar, on a preponderance of the evidence, that the grounds of opposition should not prevent the registration of the Mark. [See *Sunshine Biscuits Inc. v. Corporate Foods Ltd.* (1982), 61 C.P.R. (2d) 53, *Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 and *John Labatt Ltd. v. Molson Companies Limited*, (1990), 30 C.P.R. (3d) 293]

The relevant date for analysing the various grounds of opposition varies according to the ground of opposition raised. The relevant date for the ground based on section 30 is the filing of the application for registration [see *Georgia Pacific Corp. v. Scott Paper Ltd.*, (1984) 3 C.P.R. (3d) 469]. It is generally accepted that the filing date of the statement of opposition (November 20, 2003) represents the relevant date for analysing the ground of opposition based on the non-distinctiveness of the Mark. [See *Andres Wines Ltd. and E&J Gallo Winery* (1975), 25 C.P.R. (2d) 126 (F.C.A.) at page 130, *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at page 424 (F.C.A), and *Metro-Goldwyn-Meyer Inc v. Stargate Connections Inc.* [2004] F.C. 118]

IV. Analysis of the grounds of opposition

At the hearing, the opponent's agent stated that she did not intend to make any submissions on the second ground of opposition. This is understandable. On the one hand, I do not think that, as worded, it is a valid ground of opposition. Notwithstanding the foregoing, there is no evidence of use of trade-marks in Canada that would call the distinctiveness of the Mark into question. For all of these reasons, I dismiss the second ground of opposition because the opponent did not satisfy its initial burden of proof.

In regard to the first ground of opposition, the opponent raised two technical arguments:

- (a) The opponent could not state that it had used the Mark since January 1, 2001, because that day was a statutory holiday in Canada;
- (b) It appears from the evidence in the record that the Mark was used by LTN Development and not the applicant. There is no evidence in the record establishing that LTN Development manufactured the Wares under a licence with the applicant. Therefore, if there had been use of the Mark by LTN Development, the applicant cannot benefit from this use.

There is no evidence in the record that January 1 is a statutory holiday in Canada. I can however take judicial notice of this fact. Mr. Martin, member of the Trade-marks Opposition Board, in *Thomson Research Associates Ltd. v. Daisyfresh Creations Inc.*, (1983) 81 C.P.R. (2d) 27, determined that the reference to a date of first use of a trade-mark corresponding to a statutory holiday raised a serious doubt in regard to the veracity of this statement, especially in the absence of evidence of use of the Mark at that date [see also *Mexx International B.V. v. Poulin* (2004) 35 C.P.R. (4th) 241]. This doubt is deemed sufficient to reverse the onus of proof to the applicant. [See *Hearst Communications Inc. v. Nesbitt Burns Corp.*, (2000) 7 C.P.R. (4th) 161] The absence of evidence of use of the Mark as of January 1, 2001, under the circumstances described above, is such that I must allow the first ground of opposition.

Mr. Petrillo did not explain, in his affidavit or during his cross-examination, the relationship that may exist between him and LTN Development. He indeed attempted to do so during the hearing but I cannot accept testimony or evidence at this late stage. It follows that even if I could find that the Mark had been used as of January 1, 2001, this use could not benefit the applicant through section 50 of the Act because there is no evidence of a written, verbal or implied licence between the applicant and LTN Development. I would therefore allow the first ground of opposition for these additional reasons.

IV. Conclusion

Based on the powers delegated to me by the Registrar of Trade-marks pursuant to the provisions of subsection 63(3) of the Act, I refuse the applicant's application to register the Mark in accordance with the provisions of subsection 38(8) of the Act.

DATED AT BOUCHERVILLE, QUEBEC, DECEMBER 18, 2007.

Jean Carrière

Member, Trade-marks Opposition Board