



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2012 TMOB 194
Date of Decision: 2012-10-25

**IN THE MATTER OF AN OPPOSITION
by Health4All Products Limited and
Pure-Li Natural Ltd. to application
No. 1,438,115 for the trade-mark
FIBERLICIOUS in the name of The
Nutraceutical Medicine Company Inc.**

[1] On May 13, 2009, The Nutraceutical Medicine Company Inc. (the Applicant) filed an application to register the trade-mark FIBERLICIOUS (the Mark) in association with “dietary supplement namely a fibre supplement” based on use in Canada since at least as early as 2007.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of March 10, 2010.

[3] On August 10, 2010, Health4All Products Limited (Health4All) and Pure-Li Natural Ltd. (PLN) filed a statement of opposition alleging, in summary, that:

- the application does not conform to the requirements of section 30(b) and section 30(i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act);
- the Mark is not registrable pursuant to section 12(1)(d) of the Act since it is confusing with PLN’s registered trade-mark FIBERRIFIC (No. TMA596,502);
- the Applicant is not the person entitled to registration of the Mark pursuant to section 16(1)(a) of the Act in view of confusion with the trade-mark FIBERRIFIC used by PLN prior to the date of first use claimed in the application; and
- the Mark is not distinctive pursuant to section 2 of the Act.

[4] The statement of opposition refers to Health4All and PLN as related companies. The term “Opponent” used throughout my decision is a collective reference to Health4All and PLN.

[5] The Applicant filed and served a counter statement essentially denying the allegations contained in the statement of opposition. Both parties filed evidence and no cross-examination was conducted. Only the Applicant filed a written argument. An oral hearing was not held.

Onus and Material Dates

[6] The Applicant bears the legal onus of establishing on a balance of probabilities that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

[7] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30(b) and 30(i) - the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)];
- sections 38(2)(b)/12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- sections 38(2)(c)/16(1)(a) - the date of first use claimed in the application; and
- sections 38(2)(d)/2 - the filing date of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Evidence

[8] I am reviewing below the parties’ evidence. In my review of the evidence, I am disregarding any opinion of an affiant that goes to the questions of fact and law to be determined by the Registrar in the present proceeding.

Opponent's Evidence

[9] In support of its opposition, the Opponent filed an affidavit dated February 16, 2011 of Joel Thuna, General Manager of Health4All and PLN. I note that Mr. Thuna introduces the evidence by referring to both companies as “the Opponent or the Companies” and so my collective reference to Health4All and PLN as the Opponent is in line with his affidavit.

[10] Mr. Thuna indicates that Health4All and PLN are Ontario corporations that are part of a group of privately owned corporations. Since their inception 35 years ago, both “have been among the foremost participants in the Canadian health food market” [paras. 1 and 2].

[11] Mr. Thuna files a copy of registration No. TMA596,502, for the trade-mark FIBERRIFIC for “dietary supplements, namely fiber supplements sold in powder form for use as an ingredient in foods and beverages” [Exhibit “A”]. At the date of the Thuna affidavit, the FIBERRIFIC products were sold at retail in all provinces and most territories in Canada by independent health stores, grocery stores, chain supermarkets, pharmacies and health practitioners, such as naturopaths, chiropractors and dieticians [para. 4].

[12] Mr. Thuna states that he attaches as Exhibit “B” to his affidavit “[s]amples of invoices we have sent to customers who have purchased FIBERRIFIC products”, with customer names and pricing having been obscured [para. 5]. I note that from the 18 invoices included in Exhibit “B”, 12 invoices were issued by Global Botanical Corporation Limited (Global) between March 3, 2008 and February 9, 2011; the remaining 6 invoices issued between June 28, 2002 and July 27, 2004 do not show the name of the issuing company.

[13] Since being made aware of the application for the Mark, Mr. Thuna has had his sales forces in the provinces of Alberta, Québec and British Columbia periodically check a variety of stores, including the stores mentioned on the Applicant’s website; they have not seen products bearing the Mark on any store shelves [para. 6]. He has also made enquiries and could find no evidence of use of the Mark at the filing date of the application or at any prior time [para. 7]. Mr. Thuna goes on to state that under the Natural Health Products Directorate (NHPD) regulations, “the Applicant is not permitted” to sell wares bearing the Mark until the products

have been granted a product licence by the NHPD and the Applicant has apparently neither applied for a product licence nor been granted any licence [para. 8].

[14] According to Mr. Thuna's statements, large mass market chains and independent stores are the main retail channels of trade for health food supplements. In stores like Loblaws all health food supplements are sold in the same aisle; Loblaws carries the FIBERRIFIC products [para. 10]. Also, whether a retailer is an independent store or a major national food retailer like Loblaws, all the fiber-based products are displayed in the same shelf area [para. 11]. Mr. Thuna files a photograph of the fiber shelf in a representative Toronto Loblaws store [Exhibit "C"]. He goes on to state that the FIBERRIFIC products are sold to all of the independent health food stores listed on the Applicant's website as locations where products associated with the Mark are sold; he files a photograph of the fiber supplement area "in one of those stores" [para. 12, Exhibit "D"].

[15] While paragraphs 13 to 15 of the affidavit essentially consist of statements that I am disregarding as they amount to the affiant's opinion on the likelihood of confusion, I note that Mr. Thuna mentions in paragraph 14 that the FIBERRIFIC mark is also double-branded on the Opponent's line of EASY vitamins and minerals.

[16] The retail value of FIBERRIFIC products sold in Canada since the brand was launched in May 2002 "has been in the millions of dollars, and represents more than 10 million" servings [para. 16(a)]. Mr. Thuna files copies of current labels for the FIBERRIFIC products and pictures of bottles bearing the labels [Exhibit "E"]. I note that, as the case may be, the name "Pure-L \bar{e} Natural" or "Pure-L \bar{e} Natural" (my underlining) followed by an address appears in the lower left corner of the labels.

[17] The retail value of double-branded products sold in Canada has also been "in millions of dollars" [para. 16(b)]. Mr. Thuna files copies of the labels for the double-branded EASY products [Exhibit "F"]. I note that a logo comprising the word FIBERRIFIC is displayed, albeit not prominently, at the bottom of the labels beside the mention "Fiberrific is a trade-mark of Pure-L \bar{e} Natural Products Limited" (my underlining). Though the use of this logo may amount to use of the word mark FIBERRIFIC in association with a dietary supplement, it is apparent that the EASY products are vitamin and mineral supplements, not fiber supplements.

[18] Mr. Thuna states in paragraph 16(n) of his affidavit: “We have spent well in excess of \$250,000 on promotional efforts of all kinds that support of the FIBERRIFIC brand and products”. The promotional efforts described in paragraph 16 of the affidavit can be summarized as follows: (i) ads in major Canadian health food periodicals, in particular the *Alive* magazine issued ten times a year and the monthly publications *Vista*, *Healthy Directions* and *Tonic* [Exhibit “G”]; (ii) the Opponent’s newspaper style publication *Health4All* [Exhibit “H”]; (iii) product displays placed in retail stores [Exhibit “I”]; (iv) product samplers given out in stores [Exhibit “J”]; (v) promotional brochures [Exhibit “K”]; (vi) the company car [Exhibit “L”]; (vii) a recent year-and-a-half radio campaign on the CFRB station in Toronto; (viii) couponing; (ix) the Opponent’s websites, [Exhibit “N”]; and (x) a YouTube video. Mr. Thuna also references reviews of the FIBERRIFIC products on television shows and in health food publications [Exhibit “M”].

Applicant’s Evidence

[19] In support of its application, the Applicant filed affidavits dated June 15, 2011 of Jason Watkin and Rodney Sidoroff, respectively President and General Manager of the Applicant.

Affidavit of Jason Watkin

[20] According to Mr. Watkin’s statements, the Applicant is a privately owned corporation organized on December 24, 1999 pursuant to the law of Canada [paras. 4 and 5, Exhibit “A”]. The Applicant is affiliated with Biomedica Laboratories Inc. (Biomedica), which was incorporated on April 25, 2001 and of which he is also President. The Applicant is the owner of the Mark and of the trade-mark PURICA “and is a licensor of its trade-marks” to Biomedica. The latter received its NHPD site licence to manufacture natural health products under number 300370 and is the owner of the domain name *www.purica.com* [para. 6].

[21] Mr. Watkin explains that the development of a chicory root fibre food extract, which initially formed a supplementary ingredient in another of the Applicant’s product line, began on or about 2000. It was later discovered that the fibre product could stand on its own. The Mark coined from the words “fiber” and “delicious” was chosen for the product [para. 7].

[22] Mr. Watkins files copies of a study and articles with respect to dietary fibers and the digestive system [paras. 9 to 11, Exhibits “B” to “D”]. He also files a proposed policy from Health Canada about the definition and energy value of dietary fibre [para. 12, Exhibit “E”].

[23] Mr. Watkin states that he was informed that the NUANS search conducted prior to the filing of the application for the Mark disclosed numerous trade-marks that contain “fiber”, “fibre” or “licious”, but no trade-mark that was confusingly similar to the Mark [para. 13].

Affidavit of Rodney Sidoroff

[24] Mr. Sidoroff states he is aware of hundreds of fiber products on the marketplace in Canada [para. 3]. Mr. Sidoroff states that he has reviewed the website of Finlandia, which has a retail store in Vancouver and is known to be one of the more reputable distributors of health and wellness products. Mr. Sidoroff goes on to state that this website alone shows 70 products categorized as “fiber” or “fibre” products [para. 5]. He files pages of the website for nine products, which he lists in his affidavit, that have the word FIBRE or FIBER in their names, namely: New Roots Super Fiber; Renew Life FibreSmart Powder; Platinum Natural Super Fiber Max Plus; Biomed Fiber FX; New Roots Psyllium Husks Powder, Super Fiber + F.O.S.; Garden of Life DetoxiFiber; Platinum Naturals FiberPlus; Renew Life Fruit & Veggie Fibre; and AOR Solu-Fibre Powder [para. 6, Exhibit “A”].

[25] Mr. Sidoroff states that the FIBERLICIOUS product derives the 100% natural soluble fibre inulin from the food source, chicory root [para. 7]. He files printouts of online dictionary definitions of the words “inulin” and “fiber” [Exhibit “B”].

[26] In paragraphs 8 and 9 of his affidavit, Mr. Sidoroff states as follows:

8. Prior to formal introduction of the FIBERLICIOUS fibre product to consumers in 2007, the Applicant contacted its licensing agent in January 2009 for the purpose of obtaining a license from the Natural Health Products Directorate (NHPD), the regulating authority through a division of Health Canada which requires a license to sell and manufacture health products. After filing the application for a product license, it was discovered that the Canadian Food Inspection Branch (CFIB) considered the chicory root extract as a food extract, which is deemed safe by the CFIB and does not necessitate an NHPD license. However, the NHPD license still is pending even though it is not required for such a food extract.

9. On or about September 2011 we received the EN number *EN-145143*, which is the interim number provided by Health Canada prior to qualifying for NHPD number.

[27] Given the apparent inconsistency in the statement that the Applicant's licensing agent was contacted in January 2009 prior to the introduction of the FIBERLICIOUS product in 2007, I wish to mention that I have reproduced paragraph 8 as in the affidavit.

[28] Mr. Sidoroff also states that the NUANS search conducted prior to the filing of the application for the Mark disclosed numerous trade-marks that contain "fiber", "fibre" or "licious", but no trade-mark that was confusingly similar to the Mark [para. 12]. He files a copy of the NUANS report [para. 13, Exhibit "D"].

[29] Mr. Sidoroff files a sample of the current label displaying the Mark and states that substantially the same label has been used since on or before 2007 [para. 14, Exhibit "E"]. I note that the label mentions "Product of Purica". I also note the mention "certified NHPD site license 300370", which corresponds to Biomedica's NHPD site licence number referenced in the Watkin affidavit [see paragraph 20 of my decision].

[30] According to the Sidoroff affidavit, the Applicant's products are sold to customers by way of distributors [para. 18]. The FIBERLICIOUS product has also been available to consumers for purchase on line since at least 2008 and online sales distributors can also be contacted through the website [para. 15]. Mr. Sidoroff files pages of the website, which are representative of website pages since 2008 [para. 16, Exhibit "F"]. As Mr. Sidoroff refers to the website at *www.purica.com* as that of the Applicant, I recall Mr. Watkin's testimony that Biomedica owns the domain name *www.purica.com* [see paragraph 20 of my decision].

[31] According to Mr. Sidoroff's statements, the Applicant promotes the product associated with the Mark through the website and point of purchase material, namely posters, brochures and rack cards, provided to the distributors. This material is also available through the website or by request online [paras. 21 to 25, Exhibits "H" to "K"]. Posters, brochures and rack cards were displayed at a conference and trade show held in Vancouver in May 2010 where the product was displayed and available for sale [para. 29].

[32] According to Mr. Sidoroff's statements, the FIBERLICIOUS product was first sold "on or about October 2006" in British Columbia [para. 19]. Sales grew as a result of an independent study on the effectiveness of providing inulin in a senior's home for long term care residents that was published in 2007 [paras. 18; paras. 10 and 11, Exhibit "C"]. The "total number of accounts", which was 190 at the filing date of the application for the Mark, had grown to 254 in 2011 [para. 26]. Mr. Sidoroff files a copy of the first invoice dated October 31, 2006 [para. 20 Exhibit "G"]. He also files a representative sampling of invoices for the years 2006 to 2011 with the specific customer name and address being blacked out in each invoice [para. 27, Exhibit "L"].

Analysis of the Grounds of Opposition

[33] I will analyze the grounds of opposition in regard to the evidence of record. To this end, I will first make preliminary remarks on the evidence submitted by the parties concerning the use of their respective trade-marks.

Preliminary Remarks

Use of the Trade-mark FIBERRIFIC

[34] I am satisfied that the affidavit of Mr. Thuna establishes use of the trade-mark FIBERRIFIC in Canada since May 2002 in association with dietary supplements, including fiber supplements, within the meaning of section 4(1) of the Act. However, since any ambiguities in the affidavit as to the user(s) of the trade-mark must be resolved against the Opponent [see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)], I am not satisfied that the affidavit establishes use of the FIBERRIFIC mark by its owner itself, namely PLN, and/or through a licensee pursuant to section 50 of the Act for the reasons that follow.

[35] First, besides the fact that Mr. Thuna's collectively refers to PLN and Health4All, he largely uses the pronoun "we" or "our" throughout his affidavit. It ensues that it is unclear as to whether the evidence is meant to be evidence of use of the FIBERRIFIC mark by PLN or Health4All or, by both. Moreover, Mr. Thuna's reference to "my Companies' FIBERRIFIC

mark” (my underlining) in paragraph 14 of the affidavit adds ambiguity since Health4All does not own the mark. Furthermore, even though PLN and Health4All are related companies, corporate structure alone is insufficient to establish the existence of a licence within the meaning of section 50(1) of the Act that requires PLN to have direct or indirect control of the character or quality of the wares in order to benefit from any use of the mark by Health4All [see *MCI Multinet Communications Corp v MCI Multinet Communications Inc* (1995), 61 CPR (3d) 245 (TMOB); *Loblaws Inc v Tritap Food Broker* (1999), 3 CPR (4th) 108 (TMOB)].

[36] Second, as rightly noted by the Applicant, Mr. Thuna does not explain the relationship between PLN and Global whose name appear on invoices. Also, since Mr. Thuna is silent on the role of Global in the marketing of the FIBERRIFIC products in Canada, I am not prepared to infer that Global solely acts as a distributor of the products. Even if I infer that PLN and Global are part of the group of corporations referenced by Mr. Thuna, again it would be insufficient to establish the existence of a licence between PLN and Global. Insofar as the invoices that do not show a company name are concerned, I am in no way prepared to infer that they have been issued by either PLN or a licensee.

[37] Finally, considering the Thuna affidavit as a whole, the reference to Pure-L \bar{e} Natural or Pure-L \underline{e} Natural (my underlining) on the labels for the FIBERRIFIC products adds to the ambiguities. Indeed, there is no mention in the affidavit that PLN, whose corporate name is shown in the registration and the statement of opposition as Pure-Li Natural Ltd., does business under another name. Also, there is no evidence of a public notice of the nature discussed in section 50(2) of the Act. These comments also apply to the reference to Pure-L \underline{e} Natural Products Limited (my underlining) on the labels for the double branded EASY products, also relied upon by the Opponent relies as evidence of use of the FIBERRIFIC mark.

[38] Having regard to the foregoing, while I am satisfied that the Opponent’s evidence establishes use of the trade-mark FIBERIFFIC in Canada since May 2002. However, given the ambiguities ensuing from the lack of specificity in Mr. Thuna’s affidavit as to the users of the mark FIBERRIFIC, I find that the evidence does not satisfactorily establish use by PLN itself and/or through a licensee pursuant to section 50 of the Act.

Use of the Mark

[39] I am satisfied that the Applicant's evidence establishes use of the Mark in Canada since October 31, 2006, within the meaning of section 4(1) of the Act, in association with a fiber supplement. Since the Applicant's evidence is to the effect that the Mark is used by Biomedica as a licensee of the Applicant, the question becomes whether such use meets the requirements of section 50 of the Act.

[40] As previously indicated, corporate structure alone is insufficient to establish the existence of a licence within the meaning of section 50(1) of the Act. Furthermore, there is no evidence as to the terms of the licence, be it written or verbal, regarding the Applicant's control over the character and quality of the wares for which Biomedica is licensed to use the Mark. Also, there is not any statement from Mr. Watkins that the Applicant controls directly or indirectly the character and quality of the wares. Finally, the labels do not show a public notice of the nature discussed in section 50(2) of the Act.

[41] Having regard to the foregoing, while I conclude that the Applicant's evidence establishes use of the Mark in Canada since October 31, 2006, I conclude that it does not satisfactorily establish that the use of the Mark by Biomedica has accrued to the benefit of the Applicant pursuant to section 50 of the Act.

Non-conformity to section 30(b) of the Act

[42] As a preliminary matter, I note that since the application does not state a precise date during the calendar year of 2007, the alleged date of first use is considered by the Registrar to be December 31, 2007 [see *Khan v Turban Brand Products Ltd* (1984), 1 CPR (3d) 388 (TMOB)].

[43] To the extent that the relevant facts are more readily available to the applicant, the evidentiary burden on an opponent with respect to a section 30(b) ground of opposition is lower [see *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. Also, an opponent may rely upon the applicant's evidence to meet its initial burden, but an opponent must show that the evidence is clearly inconsistent with the applicant's claim as set forth in the application [see *York Barbell Holdings Ltd v. ICON Health & Fitness Inc* (2001), 13

CPR (4th) 156 (TMOB)]. Furthermore, section 30(b) of the Act requires that there be continuous use of the applied for trade-mark in the normal course of trade from the date claimed to the date of filing of the application [see *Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD)].

[44] For the reasons that follow, I deem it unnecessary to consider whether the Opponent has met its light evidential burden in order to dismiss the ground of opposition.

[45] First, I have already found that the Applicant's evidence establishes use of the Mark in Canada since October 31, 2006. Second, although the actual date of first use is earlier than December 31, 2007, the case law recognizes that an applicant may claim a date subsequent to the actual date of first use "out of an abundance of caution" and "in the interest of greater certainty" [see *Marineland Inc v Marine Wonderland & Animal Park Ltd* (1974), 16 CPR (2d) 97 (FCTD)].

[46] Finally, while I have found that the evidence does not establish use of the Mark that has accrued to the benefit of the Applicant pursuant to section 50 of the Act, the pleading alleges that the application does not conform to the requirements of section 30(b) of the Act "because the Applicant's Mark has never been used in Canada and certainly has not been used in Canada since as early as the 2007 date of first use stated" in the application. In the decision *Massif Inc v Station Touristique Massif du Sud (1993) Inc* (2011), 95 CPR (4th) 249 (FC), we were reminded by the Federal Court that an opposition is to be assessed in view of the grounds of opposition as pleaded. Where an opponent has pleaded that the application fails to comply with a section of the Act based on a particular set of circumstances, it is not permissible to refuse it on the basis that it does not comply with that section of the Act for reasons different than those pleaded. In paragraphs 27-29 of *Massif*, Justice Bédard states:

27. It is settled law that the Board is not authorized to allow an opposition on the basis of a ground that has not been raised by the opposing party. In *Imperial Developments Ltd. v. Imperial Oil Ltd.* (1984), 26 A.C.W.S. (2d) 155, 79 C.P.R. (2d) 12 (Justice Muldoon), the Court stated that an organization such as the Registrar of Trade-Marks is a creature of statute and that it has no inherent or extrinsic jurisdiction in its constituting legislation. The Court also stated that the Registrar called on to dispose of an opposition could not base its decision on a ground that had not been stated in the statement of opposition.

28. More recently, in *Procter & Gamble Inc. v. Colgate-Palmolive Canada Inc.* 2010

FC 231, 364 F.T.R. 288, at paragraph 26, Justice Boivin also adopted this jurisprudential principle:

... The Respondent submits it is settled law that there is no jurisdiction to deal with an issue not found in a Statement of Opposition and this Court does not have jurisdiction to entertain issues that were not raised before the Board (*McDonald's Corp. v. Coffee Hut Stores Ltd.* (1994), 76 F.T.R. 281, 55 C.P.R. (3d) 463, aff'd (1996) 199 N.R. 106, 68 C.P.R. (3d) 168 (F.C.A.)). I agree with the Respondent....

29. I agree with these principles. In this case, even if the Board refused the application for registration on the basis of a failure to meet the requirements of paragraph 30(b) of the Act and the respondent's opposition had also been based on the failure to respect this paragraph, the respondent's opposition referred to a "failure" that is different from that on which the Board based its decision.

[47] In my opinion, the section 30(b) ground of opposition as pleaded does not encompass an allegation that the Mark has not been used by the Applicant. As such, it does not matter that the use of the Mark since the claimed date of first use did not accrue to the Applicant's benefit of the Applicant. I would add that there are no submissions from the Opponent that could convince me otherwise. Had the pleading included an allegation that the Mark *has not been used by the Applicant*, I would have found in favour of the Opponent given that the Applicant's evidence establishes that the use of the Mark did not accrue to its benefit [see *Rooxs Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB)]. I note that nothing would have prevented the Opponent from requesting leave to amend its statement of opposition after being served with the Applicant's evidence.

[48] Having regard to the foregoing, I dismiss the ground of opposition.

Non-conformity to section 30(i) of the Act

[49] The ground of opposition as pleaded is based on the allegation that the application does not conform to section 30(i) of the Act "in light of the circumstances mentioned [in the statement of opposition]". Having read the pleading in conjunction with the remainder of the statement of opposition, I conclude that the ground of opposition is based upon an allegation that the parties' marks are confusing. Such an allegation does not support a section 30(i) ground of opposition.

[50] Section 30(i) of the Act requires an applicant to include a statement in the application that the applicant is satisfied that it is entitled to use the trade-mark in Canada. Where an applicant has provided the required statement, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of the applicant or if specific federal statutory provisions prevent the registration of the mark applied for [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155; and *Canada Post Corporation v Registrar of Trade-marks* (1991), 40 CPR (3d) 221 (FCTD)]. This is not such a case.

[51] Having regard to the foregoing, I dismiss the ground of opposition.

Registrability pursuant to section 12(1)(d) of the Act

[52] Having exercised the Registrar's discretion, I confirm that registration No. TMA596,502 alleged in support of the ground of opposition is extant and so the Opponent's initial burden under section 12(1)(d) of the Act has been met. The question becomes whether the Applicant has met its legal onus to show that, as of today's date, the Mark is not reasonably likely to cause confusion with the registered trade-mark FIBERRIFIC.

[53] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[54] In applying the test for confusion, I must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time the trade-marks have been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée et al* (2006), 49 CPR (4th) 401

(SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion.]

The inherent distinctiveness of the trade-marks and the extent to which they have become known

[55] Although each mark is a coined word, each begins with the descriptive word FIBER and ends with a suffix derived from a superlative. In that regard, I agree with the Applicant that it is reasonable to react to the suffix RIFIC in the Opponent's mark as being derived from the adjective "terrific". As for the Mark, we know that its suffix LICIOUS comes from the adjective "delicious". In the end, I consider that each mark possesses a low degree of inherent distinctiveness and so is a weak mark.

[56] I agree with the Applicant that there are deficiencies in the evidence introduced by Mr. Thuna with respect to advertising and promotional activities. However, I disagree with the Applicant that it cannot be concluded that the FIBERRIFIC mark has become known to any extent in Canada. That being said, the Opponent's evidence does not establish use of the mark by PLN or use that enured to PLN's benefit through the licensing provisions of section 50 of the Act. Thus, I am unable to conclude that the FIBERRIFIC mark has acquired any measurable reputation in the hands of its owner [see *Warner-Lambert Co v Lander Co Canada* (2000), 10 CPR (4th) 112 (TMOB)]. Likewise, I am unable to conclude that the Mark has acquired any measurable reputation in the hands of the Applicant whose evidence fails to establish that it benefited of the use of the Mark by Biomedica.

[57] Having regard to the foregoing, I conclude that the section 6(5)(a) factor, which is a combination of the inherent and acquired distinctiveness of the marks, favours neither party.

The length of time each trade-mark has been in use

[58] To the extent that each party has failed to establish its use or use that accrued to its benefit, as the case may be, I conclude that the section 6(5)(b) factor favours neither party.

The nature of the wares, services or business; and the nature of the trade

[59] The Mark is associated with “dietary supplement namely a fibre supplement”. The FIBERRIFIC mark is registered in association with “dietary supplements, namely fiber supplements sold in powder form for use as an ingredient in foods and beverages”. Further, there is no debate that the parties’ wares travel through the same channels of trade. Thus, the consideration of the section 6(5)(c) and (d) factors clearly favours the Opponent.

The degree of resemblance between the marks in appearance or sound or in the ideas suggested by them

[60] The degree of resemblance between the marks is often likely to have the greatest effect on the confusion analysis [see *Masterpiece, supra*; and *Beverley Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2d) 145 at 149 (FCTD), aff’d 60 CPR (2d) 70 (FCA)].

[61] The marks in issue resemble each other to some degree owing to the term FIBER forming the prefix of each of the marks. However, it is the marks in their entirety that must be considered. Ordinarily it is the first portion of a mark that is the most important for the purpose of distinguishing between marks and in the instant case the component FIBER may be considered as the dominant first portion of the marks in issue. However, when the first or dominant portion of a mark is a common descriptive word, its importance diminishes [see *Conde Nast Publications Inc, supra* at 188]. Accordingly, in the present case there would be a tendency to discount the importance of the prefix FIBER in the parties’ marks and by corollary to focus more on their respective suffix. As noted in *United Artists Pictures Inc v Pink Panther Beauty Corp* (1998), 80 CPR (3d) 247 (FCA) at 263:

While the marks [in issue] must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public’s perception of it.

[62] Further, when marks are inherently weak, comparatively small differences will suffice to distinguish one mark from another [see *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD)]. In the instant case, besides the fact that the suffix RIFIC forming the

registered mark is not particularly striking, it differs from the suffix LICIOUS forming the Mark. Given the diminished importance of the component FIBER, the differences between the marks when considered in their entirety mitigate the last factor in section 6(5) of the Act.

Additional surrounding circumstances

[63] The Applicant's evidence and submissions advance the state of the marketplace and the absence of evidence of instances of confusion as additional surrounding circumstances.

[64] The Applicant is seemingly relying upon the Nuans report [Exhibit "D" to the Sidoroff affidavit] as state of the register evidence establishing that the component FIBER is a common element of trade-marks used in Canada. Further, the Applicant relies on the printouts of the website of Finlandia [Exhibit "A" to the Sidoroff] as evidence of common use by third parties of FIBER as a component of trade-marks in association with fiber products in Canada.

[65] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); and *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD)] Also, inferences about the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located [see *Kellogg Salada Canada Inc v. Maximum Nutrition Ltd* (1992), 43 C.P.R. (3d) 349 (FCA)]. In the present case, apart from the hearsay deficiency attaching to the introduction of the evidence by Mr. Sidoroff, the Nuans report provides incomplete particulars of registrations. That said, while proper state of the register evidence might have served the Applicant's interests, it is not necessary to rely on state of the register evidence to apply the principle that small differences may serve to distinguish marks that have a low degree of inherent distinctiveness [see *Gemological Institute of America, Inc v Gemology Headquarters International LLC*, 2012 TMOB 172].

[66] Insofar as the printouts of the website of Finlandia are concerned, a website is not evidence of the truth of its contents and the mere existence of a website does not show that it has been accessed by Canadians [*Candrug Health Solutions Inc v Thorkelson* (2007), 60 CPR (4th) 35 (FCTD)]. I am not however prepared to discount the website evidence completely as I consider it to be of some value in showing that the nine fiber products referenced by Mr. Sidoroff

were available for sale in Canada when he accessed the website: Still, I am unable to determine from the website pages whether the products are those of nine different entities. Hence, I do not consider this evidence to be determinative of the outcome of this case, although I believe it lends support to my finding as regard to the weakness of the marks in issue.

[67] I deem it not necessary to address the Applicant's submissions concerning the absence of evidence of instances of confusion to find in its favour.

Conclusion on the likelihood of confusion

[68] The legal onus is on the Applicant to show that, as of today's date, the Mark is not reasonably likely to cause confusion with the registered trade-mark FIBERRIFIC.

[69] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. In the circumstances of this case, considering the weakness of the marks, I am satisfied that the differences between the Mark and the FIBERRIFIC mark as a whole are sufficient to distinguish the Mark from the FIBERRIFIC mark. Hence, I conclude that the Applicant has discharged the legal onus resting upon it to show that confusion between the marks is not likely.

[70] Having regard to the forgoing, I dismiss the ground of opposition.

Non-entitlement pursuant to section 16(1)(a) of the Act

[71] In order to meet its initial burden in support of this ground of opposition, the Opponent is required to show that the trade-mark FIBERRIFIC had been used in Canada by PLN prior to the date of first use alleged in the application and had not been abandoned at the date of advertisement of the application [section 16(5) of the Act].

[72] I have previously concluded that the Opponent's evidence does not establish use of the FIBERRIFIC mark since May 2002 by PLN or use that has accrued to its benefit pursuant to section 50 of the Act. It follows that the Opponent has failed to discharge its initial burden pursuant to section 16(1)(a) of the Act. Accordingly, the ground of opposition is dismissed.

Non-distinctiveness

[73] The Opponent alleges that the Mark is not adapted to distinguish and does not distinguish the Applicant's wares from the wares in association with which PLN has previously adopted and used the trade-mark FIBERRIFIC.

[74] In order to meet its burden under the ground of opposition as pleaded, the Opponent has to show that the trade-mark FIBERRIFIC used by PLN had become known sufficiently as of August 10, 2010 to negate the distinctiveness of Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)].

[75] My previous finding that the Opponent's evidence does not establish use of the mark FIBERRIFIC by PLN or use that has accrued to its benefit pursuant to section 50 of the Act remains applicable. It follows that the Opponent has failed to discharge its initial burden to show that the trade-mark FIBERRIFIC had been used by PLN so as to negate the distinctiveness of the Mark as of August 10, 2010 and so I dismiss the non-distinctiveness ground of opposition.

Disposition

[76] Having regard to the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office