



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

**Citation: 2012 TMOB 125**  
**Date of Decision: 2012-06-06**

**IN THE MATTER OF OPPOSITIONS by  
Dairy Farmers of Canada/Les Producteurs  
Laitiers du Canada to application  
Nos. 1,382,642 and 1,402,812 for the trade-  
marks MUSCLE MLK and MIGHTY MLK  
in the name of Cytosport, Inc.**

[1] On February 8, and July 10, 2008, Cytosport, Inc. (the Applicant) filed applications to register the trade-marks MUSCLE MLK and MIGHTY MLK respectively (sometimes collectively referred to as the Marks), based on proposed use of the Marks in Canada in association with the following wares, as revised:

in the case of application No. 1,382,642:

meal replacement drinks; meal replacement drink mixes; protein based, nutrient-dense meal replacement bars; a protein based, nutritionally fortified pre-mixed beverages; and protein based, nutrient dense snack bars

in the case of application No. 1,402,812:

dietary and nutritional supplements, namely, protein based, nutrient dense meal replacement bars and pre-mixed nutritionally fortified beverages; protein based, nutrient dense snack bars; fortified food, namely protein based, nutrient dense pudding and oatmeal.

[2] Each application claims priority of a corresponding United States trade-mark application filed on January 24, 2008 under Nos. 77/379,392 (in the case of application No. 1,382,642) and 77/379,468 (in the case of application No. 1,402,812).

[3] The applications were advertised for opposition purposes in the *Trade-marks Journal* of March 11, 2009 (with respect to application No. 1,382,642) and June 10, 2009 (with respect to application No. 1,402,812).

[4] Dairy Farmers of Canada/Les Producteurs Laitiers du Canada (the Opponent) filed essentially identical statements of opposition against each application on the following dates: May 11, 2009 with respect to application No. 1,382,642; and July 28, 2009 with respect to application No. 1,402,812. The statements of opposition claim that the applications do not conform to the requirements of section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act); that the Marks are not registrable pursuant to sections 12(1)(b) and 38(2)(b) of the Act, and that they are non-distinctive of the Applicant pursuant to sections 2 and 38(2)(d) of the Act.

[5] The Applicant filed and served a counter statement in each case in which it denied the Opponent's allegations.

[6] As its evidence in each case, the Opponent filed an affidavit of Anne-Christine Boudreault, an articling student with the law firm representing the Opponent in the instant proceedings, sworn February 4, 2010. I will use the singular form to refer to the two affidavits of Ms. Boudreault filed in the instant cases as they are identical. The Boudreault affidavit serves to introduce into evidence various definitions for the word "milk" and its French equivalent "lait". The Opponent also filed certified copies of:

- Application No. 1,272,516 for the trade-mark MUSCLE MILK, which was abandoned on November 26, 2008;
- The Registrar's file No. 1,272,516 relating to the application for registration of the trade-mark MUSCLE MILK, which shows that such application was opposed by the Opponent on April 8, 2008, and was ultimately abandoned for the Applicant's failure to file and serve a counter statement;
- Application No. 1,292,712 for the trade-mark MIGHTY MILK, which was abandoned on May 27, 2009; and

- The Registrar’s file No. 1,292,712 relating to the application for registration of the trademark MIGHTY MILK, which shows that such application was opposed by the Opponent on September 9, 2008, and was ultimately abandoned for the Applicant’s failure to file and serve a counter statement.

[7] As its evidence in each case, the Applicant filed the single affidavit of Erin Creber, a summer student with the law firm representing the Applicant in the instant proceedings, sworn May 14, 2010. The Creber affidavit essentially serves to introduce into evidence various further dictionary definitions for the word “milk” as well as the results of visits made to various stores to purchase products, which include the word “milk” as part of the product name or brand name.

[8] Both parties filed written arguments in each case. Only the Applicant was represented by counsel at an oral hearing.

### Onus

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its applications comply with the requirements of the Act. However, there is an initial evidentiary 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); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

[10] Applying these principles to the instant cases, the section 30 grounds of opposition can be summarily dismissed as follows:

#### Non-compliance with section 30 of the Act

[11] The grounds of opposition pleaded by the Opponent in subparagraphs C.1.1 to C.1.3 of each of its statements of opposition all purport to take issue with the Applicant’s claim that it

intends to use the Marks in Canada in association with the applied-for wares.

[12] I do not wish to discuss in detail each and every of the specific grounds of opposition contained in the aforementioned subparagraphs C.1.1 to C.1.3. Suffice it to say that there is no evidence that puts into issue the correctness of the proposed use basis claimed in each of the Applicant's applications. As stressed by the Applicant, the mere abandonment of another application is in no way evidence as to whether or not the Applicant intended to use the Marks at the dates of filing the instant applications. Accordingly, each of the grounds of opposition pleaded by the Opponent in subparagraphs C.1.1 to C.1.3 of its statements of opposition is dismissed as the Opponent has failed to meet its initial evidentiary burden in respect thereof.

[13] The ground of opposition pleaded by the Opponent in subparagraph C.1.4 of each of its statements of opposition purports to take issue with the Applicant's statement in its applications that it is satisfied that it is entitled to use the Marks in Canada in association with the applied-for wares. More particularly, the Opponent contends that such statement "is false in view of the content of the present opposition and in light of the content of several federal and provincial legislations."

[14] As stressed by the Applicant, the Opponent has not referred to any specific legislation that would be contravened by the use of the Marks. Accordingly, each of the grounds of opposition pleaded by the Opponent in subparagraph C.1.4 of its statements of opposition is dismissed as being insufficiently pleaded.

[15] In any event, where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional circumstances such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. There is no such evidence in the instant cases. The mere abandonment of the Applicant's prior trade-mark application Nos. 1,272,516 and 1,292,712 for the MUSCLE MILK and MIGHTY MILK trade-marks respectively, does not preclude the Applicant from making the statement in each of its applications required by section 30(i) of the Act, not to mention that the instant applications were

filed prior to the filing of the aforementioned statements of opposition in these other files.

[16] I shall now turn to the other grounds of opposition.

### Non-registrability of the Marks

[17] The statements of opposition set out that:

[...] the [Marks are] not registrable since the [Marks], whether depicted, written or sounded, [are] deceptively misdescriptive in the English language of the character or quality of the wares in association with which [they] are proposed to be used. Indeed, when depicted, written or sounded, the average consumer is likely to believe that the wares associated with the [Marks] are made of real milk or contain real milk. Accordingly, the opposed application[s] should be refused pursuant to paragraphs 38(2)(b) and 12(1)(b) of the Act.

[18] As noted by the Applicant, with respect to the Opponent's use of the phrase "real milk" in its statements of opposition, there are different meanings of the word "milk" as set out in the Creber affidavit discussed below. However, in view of the identity of the Opponent, the Applicant assumes that the references to "real milk" in the statements of opposition are referring to cow's milk. I will assess the non-registrability ground accordingly.

[19] The issue as to whether a mark is clearly descriptive or deceptively misdescriptive must be considered from the point of view of the average purchaser of the associated wares or services. Furthermore, the mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression. A mark is clearly descriptive if it describes a feature, trait or characteristic of the wares or services in a way that is "easy to understand, self evident or plain" [see *Wool Bureau of Canada Ltd v Registrar of Trade Marks* (1978), 40 CPR (2d) 25 (FCTD); *Atlantic Promotions Inc v Registrar of Trade Marks* (1984), 2 CPR (3d) 183 (FCTD); *Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 (Can Ex Ct)]. The material date to assess this issue is the date of filing of the application for the mark [see *Fiesta Barbecues Ltd v General Housewares Corp* (2003), 28 CPR (4th) 60 (FCTD)].

[20] As noted by the Applicant, the Opponent has only pleaded that the Marks are deceptively misdescriptive of the character or quality of the wares in association with which they are proposed to be used; the Opponent has not pleaded that that the Marks are clearly descriptive of the character or quality of such wares. In fact, as the instant applications are based on proposed use of the Marks in Canada, and in the absence of evidence on that point, we do not know whether the applied-for wares will be made of or contain cow's milk or not.

[21] That said, the Applicant submits that each of the Marks is not deceptively misdescriptive of the character or quality of the wares in association with which it is proposed to be used for several reasons. First, it is possible that the "MLK" portion of each of the Applicant's Marks would not be pronounced by the average consumer as "milk". Rather, it is possible that such portion would be viewed by consumers as an acronym involving the initials M-L-K. There is no evidence to suggest that the average consumer for the applied-for wares would assume that "MLK" means "milk". I agree.

[22] Second, the Applicant submits that even if a consumer were to interpret "MLK" to mean "milk", it would not be clear to a consumer what meaning of "milk" would be applicable. As evidenced by the Creber affidavit, the dictionary word "milk" has numerous meanings other than referring to cow's milk. The dictionary definitions attached as Exhibits "M" to "Q" to the Creber affidavit, all of which predate the material date, include, among others, the following:

1. an opaque white or bluish-white fluid secreted by the mammary glands of female individuals of the Mammalia including man, and adapted for nourishment of their young;
2. as a type of what is pleasant and nourishing;
3. a milk-like juice or sap secreted by certain plants, e.g. in the coconut;
4. a culinary, pharmaceutical, or other preparation of herbs, drugs or the like, having some more or less resemblance to milk;
5. to drain away the contents of;
6. to elicit, draw out;
7. to extract juice, virus, etc. from;

8. to instill with mother's milk;
9. something that suggests an abundance of goodness or blessings;
10. a liquid like milk in appearance; etc.

[23] The Applicant submits that these definitions make it clear that that word "milk" could mean many different things and would not, in the mind of an average consumer, necessarily refer to cow's milk. I agree.

[24] Third, the Applicant submits that as evidenced by the Creber affidavit, the word "milk" is frequently used in the Canadian marketplace in reference to foods and dietary supplements that do not contain cow's milk (or any dairy product). More particularly, the Applicant relies on Ms. Creber's visits made at various stores in Ottawa in May 2010, namely Nutrition House, Shoppers Drug Mart, Loblaws and T & T, where she purchased the following products, none of the ingredients of which includes any dairy product:

1. milk thistle [Exhibit "A" to the Creber affidavit];
2. Milk-Bone dog biscuits [Exhibit "C" to the Creber affidavit];
3. milk of magnesia [Exhibit "D" to the Creber affidavit];
4. coconut milk [Exhibit "F" to the Creber affidavit];
5. black bean milk [Exhibit "H" to the Creber affidavit];
6. sesame seed soya milk [Exhibit "I" to the Creber affidavit];
7. Vegemil black sesame soymilk [Exhibit "J" to the Creber affidavit]; and
8. Sweet Vegemil B soy milk [Exhibit "K" to the Creber affidavit].

[25] While Ms. Creber's purchases were made after the material date, I note that except for the Milk-Bone dog biscuits, the products so purchased by Ms. Creber essentially illustrate some of the dictionary definitions outlined above. Relying on these definitions, I find it fair to agree with the Applicant that consumers are accustomed to encountering the word "milk" in association with foods or the like that do not necessarily contain cow's milk (or any dairy product).

[26] Fourth, the Applicant submits that, as noted above, each of the Marks as a whole must be considered. The term “MLK” is not to be isolated and considered apart from the remainder of the trade-mark when considering whether each of the Marks is deceptively misdescriptive. Viewed as a whole, neither of the trade-marks MUSCLE MLK or MIGHTY MLK clearly describes the character or quality of the Applicant’s applied-for wares. Rather, the Marks could suggest several meanings or ideas. For example, even if “MLK” were interpreted to mean “milk”, the Marks could suggest:

in the case of application No. 1,382,642:

- a product that is nutritious, nourishing or beneficial for muscles (wherein “MLK” is understood as being a metaphor for something beneficial or nourishing); or
- a product that helps muscles grow, similar to how a mother’s milk helps a baby grow (again “MLK” is understood in a metaphorical sense); or

in the case of application No. 1,402,812:

- a product that is nutritious, nourishing or beneficial for the body (wherein “MLK” is understood as being a metaphor for something beneficial or nourishing); or
- a product that helps one grow stronger (more “mighty”), similar to how a mother’s milk helps a baby grow stronger (again “MLK” is understood in a metaphorical sense).

[27] I agree. As further submitted by the Applicant, the fact that the Marks contain “MLK” and not “milk” further adds to the impression in the minds of consumers that the Marks are intended to be metaphorical.

[28] As can be seen from the above, the Marks do not have any clear meaning that would be readily understood by an average consumer. They do not promise that the applied-for wares are made of or contain cow’s milk. Accordingly, the Marks do not clearly describe the character or quality of the Applicant’s applied-for wares, nor can they be considered deceptively misdescriptive, that is to mislead the public as to the character or quality of such wares.

[29] In view of the foregoing, the non-registrability ground of opposition is dismissed in each case.



## Non-distinctiveness of the Marks

[30] The statements of opposition set out that:

[...] the [Marks are] not distinctive of the wares of the Applicant, since the [Marks do] not actually distinguish the wares in association with which [they are] proposed to be used by the Applicant, nor [are they] adapted to so distinguish them.

[31] As noted by the Applicant, the individual paragraph that pleads the non-distinctiveness ground of opposition does not itself set out sufficiently specific reasons for which the Marks are not distinctive. However, when that paragraph is read as part of the whole statements of opposition and in conjunction with the evidence of record, it is apparent that the non-distinctiveness ground of opposition should be understood to encompass the pleading that the Marks are not distinctive by reason of the fact that they are deceptively misdescriptive of the character or quality of the wares in association with which they are intended to be used (re the non-registrability ground discussed above) [see *Novopharm Ltd v Astrazeneca AB* (2002), 21 CPR (4th) 289 (FCA)]. A trade-mark that is deceptively misdescriptive of its associated wares is *prima facie* not distinctive.

[32] Having regard to my earlier finding under the non-registrability ground of opposition, the difference in material date having no effect on this issue, I conclude that each of the Marks was adapted to distinguish the applied-for wares of the Applicant from those of others within the meaning of section 2 of the Act as of the filing date of the statements of opposition. Accordingly, the non-distinctiveness ground of opposition is dismissed in each case.

## Disposition

[33] In view of the foregoing and pursuant to the authority delegated to me under

section 63(3) of the Act, I reject the oppositions pursuant to section 38(8) of the Act.

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Annie Robitaille  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office