

**IN THE MATTER OF AN OPPOSITION by
Primalda Industries Corp.
to application No. 1,006,937 for the trade-mark TAHITIAN NONI Design
filed by Morinda, Inc.**

On March 2, 1999, the applicant, Morinda, Inc., filed an application to register the trade-mark TAHITIAN NONI Design, which is shown below:



The application, which has a convention priority filing date of November 19, 1998, is based upon proposed use of the trade-mark in Canada in association with the following wares:

Skin care preparations; namely, cleansers, lotions, gels, moisturizing creams, facial replenishers, aromatic mixtures of essential oils, sun screens and after sun skin lotions; hair care products; namely, hair shampoos, hair conditioners, hair rinses, hair reconstructors, hair moisturizers, and hair styling aids, namely, recovery complex, mousse, styling gel, hair spray; bath products; namely, bath soaps and bath oils.

The application was advertised for opposition purposes in the Trade-marks Journal of August 30, 2000. On October 30, 2000, Primalda Industries Corp., the opponent, filed a statement of opposition.

The grounds of opposition are summarized below:

- 1. The application is not in compliance with subsection 30(a) of the *Trade-marks Act*.**

2. The application is not in compliance with subsection 30(e) of the Act because the applicant does not intend to use TAHITIAN NONI Design as a trade-mark. TAHITIAN NONI Design is merely a generic clear description of the applied for wares and is not capable of functioning as a trade-mark.
3. The application is not in compliance with subsection 30(i) of the Act because the applicant could not have been satisfied that it was entitled to use the mark because it knew, or ought to have known, that TAHITIAN NONI Design is clearly descriptive of the applied for wares and has been used by others to describe similar wares.
4. The trade-mark is not registrable having regard to paragraph 12(1)(b) of the Act because TAHITIAN NONI Design “when used in association with the wares outlined in the applicant’s application no. 1,006,937, whether depicted, written or sounded, is clearly descriptive or deceptively misdescriptive of the applicant’s wares. The *Morinda Citrifolia* tree, is commonly known as ‘NONI’ in Polynesian and is a clear description of the wares in that an ingredient of the applicant’s wares are derived from the fruit of a ‘Tahitian NONI’ tree. The term TAHITIAN NONI is used in Canada, as a generic term used by others to describe similar wares. The fact that the applicant claims that the term TAHITIAN NONI has been used on its wares does not automatically render the term TAHITIAN NONI as capable of functioning as a trade mark. Rather, the term TAHITIAN NONI only functions as a descriptive element to describe an ingredient of the applicant’s wares in that they contain ‘Tahitian Noni’.”
5. The trade-mark is not registrable having regard to paragraph 12(1)(c) of the Act because TAHITIAN NONI is the name of the applicant’s wares.
6. The trade-mark is not distinctive within the meaning of section 2 of the Act because the term TAHITIAN NONI is a generic, descriptive term that is not capable of functioning as a trade-mark to distinguish the applicant’s wares from the wares of others.

The applicant filed and served a counter statement, in which it denied the opponent’s allegations.

The opponent filed an affidavit of Karin Binder, an employee of the opponent’s trade-mark agents, in support of the opposition.

Ms. Binder provides the results of Internet searches that she conducted in March 2002, directed

to the words NONI, TAHITIAN NONI and MORINDA CITRIFOLIA. Her search found 39 sites containing the words TAHITIAN NONI, of which she provides pages from the websites of two. Her search found 59 sites containing the words MORINDA CITRIFOLIA.

Ms. Binder also provides several pieces of printed materials that she obtained from health food stores in the Vancouver area concerning noni juice. In addition she provides information and packaging concerning noni juice that is available for purchase in Vancouver and which originates with Matrix Health Products.

The applicant filed the affidavits of J. Benjamin Tyler and Heather L. Boyd.

Mr. Tyler, the applicant's Corporate Secretary and General Counsel, discusses the Morinda Citrifolia plant which he says is indigenous to French Polynesia and Hawaii and produces a fruit referred to by the local population of French Polynesia, with the exception of the Marquesa Islands, as "nono".

In July 1996, Morinda, Inc. was created to market various personal care and nutritional products under the trade-marks TAHITIAN NONI, TAHITIAN NONI Design and MORINDA, manufactured using a method whereby the essential elements of the fruit were extracted and processed into a more palatable and consumable format. Mr. Tyler provides examples of his company's packaging, which show that the applicant uses the trade-mark TAHITIAN NONI Design on the front of its packaging.

Mr. Tyler explains that the applicant's products are sold through a network of personal distributors operating as independent contractors who use a direct selling method to individual consumers. Mr. Tyler has provided invoices/purchase tickets/pick-up slips, all dated 2002/02/04, which he says relate to the sale of skin and hair care products under the trade-mark TAHITIAN NONI Design. Each of these documents displays the TAHITIAN NONI Design trade-mark at the top.

Mr. Tyler estimates the Canadian sales of skin and hair care products under the TAHITIAN NONI Design trade-mark as follows: 2000 - \$270,000US; 2001 - \$410,000US. According to Mr. Tyler, the applicant spends approximately \$100,000US annually on the production and dissemination of advertising materials in Canada relating to the trade-mark TAHITIAN NONI Design, primarily by way of catalogue advertisement.

Ms. Boyd, a paralegal, conducted dictionary searches for the terms NONI, TAHITIAN NONI and MORINDA but did not find any listings in the four English language and four French language dictionaries that she selected at random. She also visited the 39 website addresses that Ms. Binder's search reported as having references to TAHITIAN NONI. Three of the websites appeared inactive, while 26 of the remaining 36 referred specifically to products originating from the applicant. Ms. Boyd concludes by providing the particulars of other Canadian trade-mark applications/registrations owned by the applicant.

Only the applicant filed a written argument. An oral hearing was not requested.

Although the applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act*, there is an initial 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 Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)] The material dates with respect to the grounds of opposition are as follows: section 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469 at 475]; paragraph 12(1)(b) - the filing date of the application [see *Zorti Investments Inc. v. Party City Corporation* re application No. 766,534, January 12, 2004; *Havana Club Holdings S.A. v. Bacardi & Company Limited* re application No. 795,803, January 12, 2004; *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)]; non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.*, 2004 FC 1185].

The first two grounds of opposition fail because the opponent has not satisfied its initial burden in respect thereof. There is no evidence to support the claim that the wares have not been described in accordance with subsection 30(a) or that the applicant did not intend to use TAHITIAN NONI Design as a trade-mark. Regarding the latter, there is in fact evidence from the applicant to the contrary.

Regarding the third ground of opposition, there is no evidence that others have used the term TAHITIAN NONI in association with skin care preparations, hair care products or bath products as of the material date of November 19, 1998. Therefore the success of the subsection

30(i) ground of opposition turns on the issue of whether TAHITIAN NONI Design is clearly descriptive of the applied for wares.

Paragraph 12(1)(b) is reproduced below:

12. (1) Subject to section 13, a trade-mark is registrable if it is not

...

(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;

It is self-evident from the legislation that words that might be descriptive in a language other than French or English are not subject to paragraph 12(1)(b). As the opponent alleges in its statement of opposition that “noni” is a Polynesian word and there is no evidence that it is an English or French word, I conclude that TAHITIAN NONI Design cannot be unregistrable pursuant to paragraph 12(1)(b). The fourth ground of opposition therefore fails.

Paragraph 12(1)(c) is reproduced below:

12. (1) Subject to section 13, a trade-mark is registrable if it is not

...

(c) the name in any language of any of the wares or services in connection with which it is used or proposed to be used;

As I do not see how TAHITIAN NONI Design can be the name in any language of the applicant’s various skin care, hair care and bath products, I reject the fifth ground of opposition.

The distinctiveness ground of opposition also fails. The opponent has not satisfied its initial burden to show that TAHITIAN NONI was a generic, descriptive term which was not capable of functioning as a trade-mark in association with the applied for wares as of the date of filing the opposition. In any event, I note that the trade-mark in issue is TAHITIAN NONI Design, not simply TAHITIAN NONI.

Having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the *Trade-marks Act*, I reject the opposition pursuant to subsection 38(8) of the Act.

DATED AT GATINEAU, QUEBEC THIS 10th DAY OF SEPTEMBER 2004.

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