



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

Citation: 2010 TMOB 94
Date of Decision: 2010-06-22

**IN THE MATTER OF AN OPPOSITION
by Nu-Life Inc. to application
No. 1,237,487 for the trade-mark
MOOJO in the name Saputo Produits
Latiers Canada s.e.n.c./Saputo Dairy
Products Canada GP**

The Pleadings

[1] On November 9, 2004 George Weston Limited (GWL) filed an application to register the trade-mark MOOJO, application number 1,237,487 (the Mark), based on proposed use in Canada in association with non-alcoholic dairy beverages, namely milk, milkshakes, flavoured milk and milk smoothies (the Wares).

[2] The application was advertised on November 16, 2005 in the *Trade-marks Journal* for opposition purposes. Nu-Life Inc. filed a statement of opposition on April 18, 2006 which was forwarded by the Registrar on May 9, 2006 to the Applicant. The Applicant filed a counter statement on August 15, 2006 denying in essence all grounds of opposition listed below.

[3] The Opponent filed the affidavit of Tim Baker as its evidence while the Applicant filed those of Judith McCrie and Mary P. Noonan.

[4] Only the Applicant filed a written argument and both parties made representations at an oral hearing.

[5] Following successive assignments of the application, the applicant is now recorded as Saputo Produits Laitiers Canada SENC/ Saputo Dairy Products Canada GP (Saputo). I shall refer to GWL and its successors in title, including Saputo, indistinctively as the Applicant.

The Grounds of Opposition

[6] The grounds of opposition pleaded are:

1. The application does not comply with the requirements of s. 30(a) of the Trade-marks Act, R.S.C. 1985 c. T-13 (the “Act”) in that the application does not contain a statement in ordinary commercial terms of the specific wares in association with which the mark is proposed to be used;
2. The application does not comply with the requirements of s. 30(b) of the Act in that the Applicant has already used the Mark in association with the Wares;
3. The application does not comply with the requirements of s. 30(e) of the Act in that the Applicant did not by itself or through a licensee, nor by itself and through a licensee, intend to use the Mark in Canada in association with the Wares;
4. The application does not comply with the requirements of s. 30(i) of the Act in that the Applicant could not have been satisfied that it was entitled to the use and registration of the Mark in Canada;
5. The Mark is not registrable under s. 12(1)(d) of the Act as it is confusing with the following registered trade-marks:

MO, registration TMA570649 for non-alcoholic beverages;
TRUE TO MOO, registration TMA443385 for dairy products;
MUCH MOO & MORE & Design, registration TMA659645 for ice-cream and yogurt products;
MOOTASTIC, registration TMA618308 for dairy products;
MOOOO, official mark 0910001; and
MOOOO Design, official mark 0910002.

6. Pursuant to s. 38(2)(d) and s. 2 of the Act, the Mark is not distinctive in that the Mark does not actually distinguish the Wares from the wares and services of others, nor is it adapted so to distinguish them. In particular, the term MOO is common for a dairy-based product.

The Opponent's evidence

[7] Tim Baker was a student-at-law employed by the agent's firm acting on behalf of the Opponent at the time his affidavit was filed. He produced photocopies of extracts of the trade-mark database maintained by the Canadian Intellectual Property Office. The extracts filed correspond to the registrations listed under the ground of opposition based on s. 12(1)(d). That is the extent of the Opponent's evidence.

Burden of Proof in Trade-marks Opposition Proceedings

[8] The legal burden is upon the Applicant to show that its application complies with the provisions of the Act, but there is however an initial evidential onus 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. Once this initial onus is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325; *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company* [2005] F.C. 722].

Grounds of Opposition Summarily Dismissed

[9] As appears from the description of the Opponent's evidence, there has been no evidence filed to substantiate the first, second, third, fourth and sixth ground of opposition. Since the Opponent has not met its initial onus, those grounds of opposition are dismissed.

[10] At the oral hearing the Opponent, through its representative Mr. Shapero, did allege certain facts that may have supported some of these grounds of opposition or others not alleged in the statement of opposition filed. I mentioned to the Opponent's representative that during the oral hearing the Registrar can only take into consideration the facts appearing from the records and rule on the grounds of oppositions pleaded in the statement of opposition.

[11] On that basis, the Opponent acknowledged that the only ground of opposition that had to be assessed was the fifth ground of opposition (registrability of the Mark).

Registrability of the Mark under s. 12(1)(d)

[12] The relevant date for the analysis of a ground of opposition based on s. 12(1)(d) of the Act is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424].

[13] The Opponent has met its initial burden by filing, through the affidavit of Mr. Baker, photocopies of extracts of CIPO Canadian Trade-marks database for:

MO, registration TMA570649 for non-alcoholic beverages;
TRUE TO MOO, registration TMA443385 for dairy products;
MUCH MOO & MORE & Design, registration TMA659645 for ice-cream
and yogurt products;
MOOTASTIC, registration TMA618308 for dairy products;
MOOOO, official mark 0910001; and
MOOOO Design, official mark 0910002.

[14] As a result I must determine if there is, on a balance of probabilities, a likelihood of confusion between the Mark and the registered trade-marks listed above. If the answer is affirmative then the Mark cannot be registered.

[15] The test to decide if there is a likelihood of confusion is set out in s. 6(2) of the Act wherein it is stipulated that the use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would likely 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. In making such assessment I must take into consideration all the relevant surrounding circumstances, including those listed in s. 6(5) of the Act: the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the wares, services, or businesses; the nature of the trade; and the degree of resemblance between the trade-marks or trade-names in appearance, or sound or in the ideas suggested by them. I refer to the decision of the Supreme Court of Canada in *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 for an analysis of those criteria.

[16] I note that the last two trade-marks identified in the statement of opposition and filed as exhibits to Mr. Baker's affidavit are official trade-marks. They were identified as such by the Opponent in its statement of opposition and in Mr. Baker's affidavit. Under these circumstances I shall treat those under the ground of opposition set out in s. 12(1)(e) of the Act and not s. 12(1)(d) of the Act.

[17] As it will appear from a reading of my decision, should I be wrong in this ruling, it would not have an impact on the outcome of the ground of opposition based on registrability of the Mark had they be considered under s. 12(1)(d) as registered trade-marks. For those two trade-marks, it is well known that under a ground of opposition based on s. 12(1)(e) the criteria listed in s. 6(5) of the Act are not applicable. I shall discuss later on the applicable test when comparing the Mark to those official marks.

[18] I shall determine the likelihood of confusion between the Mark and the first four registered trade-marks listed above.

[19] The Mark is a coined word and as such is inherently distinctive. However the first portion of the Mark, MOO, is defined in The Canadian Oxford Dictionary as "make the characteristic vocal sound of cattle". Therefore the Mark, when used in association with dairy products is suggestive of the characteristics of the Wares. The same reasoning applies for TRUE TO MOO, MUCH MOO & MORE & Design and MOOTASTIC. As for the trade-mark MO, it has no suggestive meaning when used in association with non-alcoholic beverages.

[20] The distinctiveness of a trade-mark may be enhanced through use or extensive promotion. Despite the fact that the Applicant's application is based on proposed use, it has filed evidence of use of the Mark. Since the relevant date is the date of the Registrar's decision, such evidence is relevant. On the other hand, there is no evidence of use of any of the trade-marks cited by the Opponent.

[21] Ms. McCrie has been the Vice-President and General Manager of William Nielson Ltd./William Neilson Ltée.(WNL), the licensee of the Mark in association with the Wares. She provides a history of the file including the assignment of the application from GWL to Weston

Foods (Canada) Inc (Weston). She explains the connection between WNL and GWL as well as with Weston, the latter being the successor in title to GWL.

[22] WNL started using the Mark in association with chocolate milkshakes in Canada in approximately April 2005. She filed copies of the packaging. She stated at the time of execution of her affidavit, namely on March 18, 2008, that WNL intended to use the Mark in association with milk, flavoured milk and milk smoothies. In January 2009 Saputo was recorded the owner of the present application.

[23] She states that WNL sold since 2005 in excess of \$2 million worth of products bearing the Mark in Canada. Those products are sold through grocery stores and other food retailers across Canada.

[24] She alleges that WNL spent between 2005 and March 2008 over \$100,000 on the design, marketing and advertising of the products bearing the Mark in Canada. Such advertising is published through in-stores posters, the Internet and store flyers of major retail supermarket banners.

[25] She filed samples of those flyers. However we do not have the dates and the names of the retail stores that published those flyers. Finally she filed copies of the web pages where the MOOJO branded chocolate milk has been advertised from April 16, 2007 to March 3, 2008 on WNL's website.

[26] Therefore there is evidence of use of the Mark in Canada since 2005 in association with milkshakes. The Mark is known to some extent in Canada. Overall, the first criteria listed under s. 6(5) of the Act favours the Applicant.

[27] As for the length of time the trade-marks have been in use, there is no evidence of use of the trade-marks cited by the Opponent. However in *Cartier Men's Shop Ltd. v. Cartier Inc.* (1981), 58 C.P.R. (2d) 68 it was ruled that for the purpose of assessing the criteria described in s. 6(5)(b) the Registrar could refer to the date of first use alleged in the certificate of registration of the cited marks of the Opponent. Nevertheless, the Registrar can only conclude to *de minimis* use of those trade-marks [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1992), 40 C.P.R. (3d) 427]. Even though this factor might favour the Opponent as the claimed date of first

use in all instances, except for the trade-mark MUCH MOO & MORE & Design, is before the date of first use of the Mark, I do not consider it as a determining factor in the absence of evidence of their use.

[28] The application covers dairy beverages. Ms. McCrie states in her affidavit that milkshakes bearing the Mark are sold in grocery stores and food retailers across Canada. The registrations for the trade-marks TRUE TO MOO, MUCH MOO & MORE & Design and MOOTASTIC do cover dairy products. As such there is some overlap between the Wares and their channels of trade and the wares covered by those three registrations. In the absence of evidence of the channels of trade used to sell the wares covered by those registrations I have to assume that they would be similar to those used by the Applicant to sell its Wares since they are dairy products.

[29] As for the trade-mark MO, the registration covers a long list of wares that includes non-alcoholic vegetable based beverages. For those wares, I find that a distinction could be made between non-alcoholic dairy beverages and non-alcoholic vegetable based beverages. However the registration also covers vegetable-based milk substitute made from soya beans. It also covers ice cream and frozen yogurt. Therefore there is also some overlap between the Wares and some of the wares covered by such registration as well as with their respective channels of trade.

[30] The degree of resemblance between two trade-marks is one of the most important criteria when assessing the likelihood of confusion between them [see *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145]. One must look at the marks in their totalities and should not dissect each one of them into its components.

[31] It has been held that the first portion of a trade-mark is the most relevant for the purpose of distinction [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183]. Nevertheless in this case it adds little inherent distinctiveness to the Mark. As mentioned earlier, the prefix “MOO” is suggestive when associated with dairy products.

[32] When comparing the Mark with the trade-mark TRUE TO MOO, the only similarity is the presence of the term MOO, but as a whole I do not see any resemblance in sound, appearance

and ideas suggested by those marks. The same conclusion applies when comparing the Mark to MUCH MOO & MORE & Design and MOOTASTIC.

[33] I have no evidence on the pronunciation of the Mark. It is therefore difficult to make an assessment on the degree of similarity in sound when comparing the Mark to MO. The suffix JO is a distinct feature in the Mark. Therefore as a whole the Mark do not resemble to the trade-mark MO, in sound and visually.

[34] Overall I conclude, no matter which of the four registered trade-marks cited by the Opponent is concerned, that the Mark does not resemble, within the meaning of s. 6(5)(e) of the Act, to any of those trade-marks. This factor clearly favours the Applicant.

[35] As an additional surrounding circumstance the Applicant relies on the Opponent's evidence of the state of the register to argue that the term MOO is a component of many registered trade-marks. Even if I were to consider the official marks as part of this argument, there are only five trade-marks cited by the Opponent. This number is insufficient to draw an inference that MOO is widely used in the trade in association with dairy products and therefore the average Canadian consumer is accustomed to differentiate them.

[36] From this analysis I reach the conclusion that the Applicant has discharged its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the registered trade-marks MO, TRUE TO MOO, MUCH MOO & MORE & Design and MOOTASTIC. Even though there might be some overlap in the wares and their channels of trade, I consider that the differences in the marks, visually, phonetically, and for some of them in their meaning, are enough to negate any likelihood of confusion.

[37] As for the two official marks, the applicable test is whether the Mark nearly resembles the official marks cited as to likely to be mistaken for them [see *Canadian Council of Professional Engineers v. APA- The Engineered Wood Assn.* (2000), 7 C.P.R. (4th) 239]. The addition of the suffix JO is sufficient to distinguish the Mark from any of those two official marks. I conclude that the Applicant has met its burden to prove, on a balance of probabilities, that the Mark does not resemble any of the official marks cited by the Opponent so as to likely be mistaken for them.

[38] The fifth ground of opposition is dismissed.

Conclusion

[39] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office