

IN THE MATTER OF AN OPPOSITION by Sandoz Nutrition Ltd. and Novartis
AG to application No. 1006736 for the trade-mark NUTRIFORCE filed by
Nicolas Sirois

On February 25, 1999, the applicant, Nicolas Sirois, filed an application to register the trade-mark NUTRIFORCE based on use in Canada since March 1, 1993. The application, as amended, covers the following wares: “ Pains, pains de blé ou de céréales germées, gâteau de blé ou de céréales germées, pains contenant des céréales issues de culture biologique, de céréales entières, petits pains, gâteaux, galettes, céréales, nommément blé germé, blé trempé, blé mélangé avec d'autres ingrédients, frais séché ou congelé, en flocons ou en pâtons. ” [Translation: Breads, wheat breads or germinated cereals, cake made with wheat or germinated cereal, breads containing organic cereals, whole cereals, rolls, cakes, cookies, cereal, namely germinated wheat, wheat mash, wheat mixed with other ingredients, fresh, dried or frozen, in flakes or dough pieces]. The application was advertised for opposition purposes on May 10, 2000.

The opponents, Sandoz Nutrition Ltd. and Novartis AG, filed a statement of opposition on July 10, 2000. The first ground of opposition is that the applicant could not have been satisfied to his entitlement to use the trade-mark at the date the application was filed pursuant to s.30(i) of the Trade-Marks Act, R.S.C. 1985, c. T-13 (“the Act”) because he was aware of the opponents’ registered trade-mark NUTRISOURCE, Registration No. 403,467. The second ground of opposition is that the mark is not registrable pursuant to s.12(1)(d) of the Act, because it is confusing with the opponents’ NUTRISOURCE mark. The third ground is that the applicant is not the person entitled to registration of its mark pursuant to s.16(1)(a) of the Act because at the date the application was filed it was confusing with the opponents’ registered mark NUTRISOURCE which had been used extensively in Canada by the opponents and which has not been abandoned by the opponents. The final ground of opposition is that the applicant’s mark is not adapted to and does not distinguish the wares of the applicant in view of the extensive use in Canada by the opponents of the confusing mark NUTRISOURCE.

The applicant filed its counter statement on August 16, 2000. In denying the allegations asserted by the opponents, the applicant relies primarily on the previous registration of the mark NUTRIFORCE. In this regard, the applicant stated the following at paragraphs 5 and 6 of his affidavit:

4. The trade-mark NUTRIFORCE is registrable, as has been unequivocally demonstrated by the fact that it was initially registered on the 23 of May, 1980.
5. The applicant is entitled to proceed to the registration of the trade-mark NUTRIFORCE in conformity with the Trade-Marks Act, as the non renewal of the registration by the party who proceeded to the initial registration did not in any way affect the eligibility of the trade-mark registration to be renewed. It only affected the eligibility of the representative or agent of the trade-mark in question to register his right to the trade-mark. The objects of the trade-mark NUTRIFORCE are not created by the registration of application no. 1,006,736, they are simply continued as they existed since the original registration of May 23, 1980.

On March 15, 2001, the opponent Novartis AG asked that Sandoz Nutrition Ltd. be removed as a joint opponent in this case since Registration No. 403,467 for NUTRIFORCE as of that date stood only in the name of Novartis AG. Therefore, as of that date, the opposition stood only in the name of Novartis AG. As its evidence, the opponent submitted the affidavit of Michael Hill, as well as a certified copy of its registration no. 403,467 for the trade-mark NUTRISOURCE. The applicant's evidence consisted of the affidavit of Pierre Nicolas Sirois. Only the opponent filed a formal written argument, although I note that the affidavit of Mr. Sirois is essentially a sworn reproduction of the applicant's counter statement filed August 12, 2000. An oral hearing was not held.

With respect to the first ground of opposition, the mere fact that the applicant may have been aware of the opponent's registered trade-mark does not preclude the applicant from truthfully making the statement required by Section 30(i) of the Act. The opponent did not allege nor provide any evidence that the applicant was aware that its mark was confusing with the opponent's mark. Thus, the first ground is unsuccessful.

The remaining grounds of opposition turn on the issue of confusion between the applicant's NUTRIFORCE mark and the opponent's NUTRISOURCE trade-mark, as registered and previously used in Canada in association with various types of wearing apparel and accessories. Although the material time to consider the circumstances respecting this issue differs from ground to ground, in the present case it matters little which material time is used. Thus, a consideration of the issue of confusion between the applicant's mark and the opponent's registered mark pursuant to Section 12(1)(d) of the Act will effectively decide the outcome of this proceeding.

As for the ground of opposition based on Section 12(1)(d) of the Act, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in **Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers** (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including, but not limited to, the following specifically set forth in Section 6(5) of the Act: (a) the inherent distinctiveness of the trade-marks and the extent to which the trade-marks 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. The weight to be given to each relevant factor may vary, depending on the circumstances (**Clorox Co. v. Sears Canada Inc.** (1992), 41 C.P.R. (3d) 483 (F.C.T.D.); **Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-Marks** (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)).

As for s.6(5)(a) of the Act, the prefix "nutri" is suggestive of the word "nutrition" and is

thus inherently weak in the context of the marks at issue (see the opposition decisions in Amway Corporation v. Nutravite Pharmaceuticals Inc. (1997), 84 C.P.R. (3d) 276 at 282 (TMOB) and Amway Corporation v. Nutravite Pharmaceuticals Inc. (unreported decision of TMOB - Application No. 790,667; February 16, 2001) (hereinafter Amway v. Nutravite #2). The opponent's NUTRISOURCE mark also suggests that the liquid dietary supplements are a source of nutrition. Therefore, that mark is inherently weak. As for the applicant's mark, I consider it to possess a slightly higher degree of inherent distinctiveness than the opponent's mark because the second component of the applicant's mark is not suggestive of its breads and cereal products.

As for the extent to which the trade-marks have become known, the applicant relies on the fact that the trade-mark NUTRIFORCE was initially registered on May 23, 1980. However, as pointed out by the opponent, the applicant has not shown that he was the owner of the previous NUTRIFORCE mark, nor that he was in any way associated with the previous registration of the mark. The applicant cannot claim that he is entitled to register the mark based on prior use unless he was the original user. In any case, as there was no use shown whatsoever for the mark NUTRIFORCE, while the opponent had shown use of its NUTRISOURCE mark for over 10 years in Canada with significant sales for the 5 year period between 1996 and 2001, this factor favours the opponent. The length of time the marks have been in use (s.6(5)(b)) therefore also favours the opponent.

As for Sections 6(5)(c) and (d) of the Act, I do not consider the applicant's bread and cereal products to be similar to the opponent's "liquid dietary food supplements, namely a nutritionally complete liquid formula for tube feeding". However, as neither the applicant nor the opponent have restricted the description of their wares to particular channels of trade, and given that the opponent's evidence shows that it does distribute its wares to food distributors, the parties' channels of trade could potentially overlap.

As for s.6(5)(e) of the Act, there is a high degree of resemblance in all respects between the marks at issue due to the common use of the prefix NUTRI. The visual, phonetic, and conceptual differences between the marks arise from the differences between the second components of the two marks, namely SOURCE and FORCE.

As an additional surrounding circumstance, I have considered the following statement made by Mr. Sirois in his affidavit at para.6(B):

“...Furthermore, if the pretensions of the opponent were to be accepted, it would mean that the dozens of trade-marks currently used and that begin with the letters “nutri” would be sources of confusion, making the vast field of nutrition the exclusive arrage of the opponent.”

In considering this statement, I had regard to several cases in which it was found that consumers have become used to seeing “nutri” prefixed marks in the field of vitamins, minerals and related wares and would therefore be able to distinguish such marks based on their other components (see **Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.** (1992), 43 C.P.R. (3d) 349 (F.C.A.); **Wyeth-Ayerst Canada Inc. v. Sunny Crunch Foods Limited** (unreported decision of TMOB; Application No. 740,514, January 8, 1999); and **Amway v. Nutravite #2**, *supra*. In each of those cases, the applied for “nutri” prefixed mark was found not to be confusing with the opponents’ “nutri” or “nutra” prefixed marks.

The present case is distinguishable from the above noted cases primarily because in each of the above noted cases the applicant had presented substantive state of the register evidence showing the existence of numerous “nutri” prefixed marks on the register for related wares. Evidence of use of “nutri” prefixed marks for related wares in the marketplace was also presented in two of the cases. In the present case, the applicant has filed no state of the register evidence nor any evidence of use of “nutri” prefixed marks in the relevant marketplace. As

there was no other support provided by the applicant to support the above statement of Mr. Sirois, and as I cannot take judicial notice of the existence of “nutri” prefixed marks on either the register or in the marketplace, Mr. Sirois’ statement is of no assistance in this proceeding.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the reputation associated with the opponent’s registered mark and the potential for overlap in the parties’ channels of trade, I do not find that the applicant has proved its case on a balance of probabilities. In other words, the applicant has failed to meet the legal onus upon it to show that there is no reasonable likelihood of confusion between the marks at issue.

Accordingly, and with the authority delegated to me under s. 63(3) of the Act, I refuse the applicant’s application pursuant to s.38(8) of the Act.

DATED AT HULL, QUEBEC, THIS 19th DAY OF November, 2002.

C. R. Folz
Member,
Trade-Marks Opposition Board