



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

Citation: 2014 TMOB 290
Date of Decision: 2014-11-19

**IN THE MATTER OF AN OPPOSITION
by Société des Produits Nestlé S.A. to
application No. 1,423,632 for the trade-
mark PET PASSION & Design in the
name of Pet Passion Comércio de
Produtos para Animais Ltda**

[1] Société des Produits Nestlé S.A. (the Opponent) opposes registration of the trade-mark PET PASSION & Design (the Mark), shown below, that is the subject of application No. 1,423,632 by Pet Passion Comércio de Produtos para Animais Ltda (the Applicant).



[2] The application is based on registration and use of the Mark in Brazil as well as proposed use of the Mark in Canada in association with the following wares and services:

Animal cosmetic toiletry and hygiene products namely shampoos for pets, toothpaste for animal oral hygiene, pet soaps, talcum powders, bubble baths, animal bath foam except for medicinal use, animal conditioner, animal shampoo not for therapeutic purposes.
(the Wares)

Commercial and industrial management consulting services; retail and wholesale sales and service of foods for animals, products for animals, veterinary preparations, cosmetics and toiletries for animals.
(the Services)

[3] In its statement of opposition, the Opponent alleges that: (i) the application does not conform to section 30(e) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act); (ii) the Mark is not registrable under section 12(1)(d) of the Act; (iii) the Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act; and (iv) the Mark is not distinctive under section 2 of the Act. Aside from the non-conformity to section 30 ground of opposition, the remaining grounds all turn on the issue of confusion with the Opponent's trade-marks.

[4] For the reasons that follow, I refuse the application.

The Record

[5] The Opponent filed its statement of opposition on June 28, 2012. The Applicant filed and served its counter statement on September 11, 2012 denying all of the grounds of opposition.

[6] In support of its opposition, the Opponent filed the affidavit of Mary Siemiesz, Director of Consumer Communication of Nestlé Purina PetCare Canada. The Applicant did not file any evidence in support of its application. Ms. Siemiesz was not cross-examined.

[7] Both parties filed written arguments; only the Opponent was represented at a hearing.

The Parties' Respective Burden or Onus

[8] 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) at 298].

Section 30(e) of the Act

[9] Since the application contains a statement that the Applicant by itself or through a licensee intends to use the Mark in Canada, it formally complies with section 30(e) of the Act. Thus the issue becomes whether or not the Applicant has substantially complied with section 30(e) of the Act. There is an initial evidential burden on the opponent to establish the facts relied upon by it in support of its claim of non-compliance with section 30(e) of the Act, whether by relying on its own evidence or that of the applicant [*Molson Canada v Anheuser-Busch Inc* (2003), 29 CPR (4th) 315 (FC) at 334].

[10] The Opponent argues that the Applicant has not filed any evidence to establish that it intended, either by itself or through a licensee, at any time, to use its Mark in Canada. Consequently, the Opponent submits that the Applicant has failed to substantially comply with section 30(e) of the Act.

[11] I disagree. The application is based on registration and use of the Mark in Brazil and proposed use of the Mark in Canada. The Applicant is not obliged to commence use of the Mark in Canada until after the application has been allowed. Thus, the fact that the Applicant did not provide evidence of use of the Mark in Canada in association with the applied for wares and/or services to date is not enough to put into question its intention to use the Mark in Canada at the filing date of the application.

[12] Moreover, the Applicant is not required to positively evidence its stated intention to use the Mark in Canada until the Opponent has met its initial evidential burden. In the present case, the Opponent did not file any evidence in support of its claim and failed to point to any evidence that would suggest that the Applicant did not actually intend to use the Mark in Canada when it filed its application. Accordingly, the section 30(e) ground of opposition is dismissed on the basis that the Opponent has not met its initial evidential burden.

Is the Mark Confusing with the Opponent's Registered Trade-marks?

[13] In its statement of opposition, the Opponent alleges that the Mark is not registrable pursuant to section 12(1)(d) of the Act, on the ground that it is confusing with the Opponent's

registered trade-marks YOUR PET, OUR PASSION (TMA660,981) and VOTRE PETIT COMPAGNON, NOTRE PASSION (TMA702,308), the particulars of which are set out in Schedule “A” to this decision (the PASSION Trade-marks).

[14] The material date for considering this issue, which arises from the section 12(1)(d) ground of opposition, is 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)]. For reasons that follow, I accept this ground of opposition and decide this issue in favour of the Opponent.

[15] An opponent’s initial onus is met with respect to a section 12(1)(d) ground of opposition if a registration relied upon is in good standing. In this regard, the Registrar has the discretion to check the register in order to confirm the existence of the registration relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Having exercised the Registrar’s discretion, I confirm that both registrations are in good standing.

The test for confusion

[16] Since the Opponent has satisfied its initial evidential burden, the issue becomes whether the Applicant has met its legal burden to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent’s registered trade-marks.

[17] 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.

[18] In applying the test for confusion, the Registrar 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 each has 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 Cliquot 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.]

[19] Comparing the Mark and the trade-mark YOUR PET, OUR PASSION (TMA660,981) will effectively decide the section 12(1)(d) ground of opposition. In other words, if confusion is not likely between the Mark and YOUR PET, OUR PASSION, then it would not be likely between the Mark and VOTRE PETIT COMPAGNON, NOTRE PASSION.

[20] I will now turn to the assessment of the section 6(5) factors.

Section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[21] The overall consideration of the section 6(5)(a) factor, which involves a combination of inherent and acquired distinctiveness of the parties' trade-marks, favours the Opponent. Neither party's trade-mark is particularly strong. In this regard, both trade-marks share the words PET, a descriptive term in the context of the wares and services in question, and PASSION, an ordinary word in the English language. In its written argument, the Applicant submits that the word PASSION is "essentially laudatory", as it describes the importance placed upon the consumer's pet by the company selling the wares and services. I disagree. While the word PASSION might suggest enthusiasm, it is not a laudatory term that describes a level of quality or a degree of excellence of the parties' wares and services.

[22] In any case, I assess the overall inherent distinctiveness of the Applicant's Mark to be slightly higher than that of the Opponent's trade-mark YOUR PET, OUR PASSION, owing to the addition of the design element.

[23] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. The Applicant has not provided any evidence of promotion or use of

the Mark to date. Conversely, the Opponent introduced some evidence of promotion and use of its PASSION Trade-marks in Canada through the Siemiesz affidavit.

[24] According to Ms. Siemiesz, the Opponent is one of Nestlé S.A.'s (Nestlé) wholly-owned subsidiaries; it owns all the trade-marks used by the Nestlé subsidiaries, including the PASSION Trade-marks used by Nestlé Purina PetCare Canada (Purina), which is also a wholly-owned subsidiary of Nestlé. In terms of control, Ms. Siemiesz states that the Opponent exercises control over the character and quality of the wares and services used in association with its trade-marks.

[25] In its written argument, the Applicant submits that the Siemiesz affidavit does not explicitly state that Purina uses the PASSION Trade-marks under licence from the Opponent, nor are the particulars of the licensing agreement offered. Moreover, the Applicant points to the lack of information regarding how the Opponent controls the character or the quality of the wares and services sold in association with its trade-marks.

[26] In view of Ms. Siemiesz's clear assertions regarding the relationships between Nestlé, the Opponent and Purina, as well as her statements regarding the licensing and the control of the trade-marks by the Opponent, in the absence of cross-examination, I am prepared to accept that any use of the PASSION Trade-marks by Purina would enure to the benefit of the Opponent pursuant to section 50 of the Act.

[27] Turning to Purina, Ms. Siemiesz states that the company manufactures, imports, and sells pet food, pet treats, probiotic supplements for pets, and cat box filler, in addition to providing educational programming related to responsible pet care, all in association with the PASSION Trade-marks in Canada.

[28] In this regard, Ms. Siemiesz explains that the PASSION Trade-marks are used in association with various brands of Purina dog food, cat food, dog treat, cat treat, and cat box filler (Purina Products), as well as various services. The affiant further states that the PASSION Trade-marks are prominently and consistently displayed on the labels and packaging of Purina Products in Canada. Attached as Exhibit 5 to the Siemiesz affidavit are close-ups of dog food and cat food packaging bearing the trade-mark YOUR PET, OUR PASSION along with other

trade-marks including PURINA, said to be representative of those sold in Canada since at least as early as 2003.

[29] Attached as Exhibit 3 are printouts from Nestlé's website located at www.nestle.com/brands/petcare and Purina's website located at www.purina.ca showing the trade-mark YOUR PET, OUR PASSION. The printouts pertain to various Purina pet food, pet treat, and cat litter products, as well as a section entitled Purina Animal Hall of Fame where consumers can nominate pets that save lives. Ms. Siemiesz states that Nestlé's and Purina's various websites attract millions of visitors from Canada and around the world, totalling approximately 3.4 million visitors from 2008 to 2012. I note that the Opponent did not provide a breakdown of those numbers for visitors from Canada.

[30] According to Ms. Siemiesz, the approximate sales figures for Purina Products in Canada bearing the PASSION Trade-marks vary between \$220 million and \$400 million annually from 2004 to 2011, totaling more than \$2.47 billion during that period of time. Attached as Exhibit 6 to the Siemiesz affidavit are sample invoices evidencing sales of various brands of Purina Products to customers in Canada between April 2003 and December 2012, said to be sold in association with the PASSION Trade-marks.

[31] Ms. Siemiesz states that the approximate advertising expenditures for Purina Products and Purina services in Canada promoted in association with the PASSION Trade-marks vary between \$3 million and \$11 million annually from 2007 to 2012, totaling approximately \$37 million during that period of time. According to the affiant, promotion and advertising are done through print, online and television marketing campaigns, magazine advertisements, news releases and websites. Attached as Exhibits 8-A to 8-H are sample ads extracted from the 2005 to 2012 issues of magazines entitled *Dogs in Canada Annual* and *Cats in Canada*, in which the trade-mark YOUR PET, OUR PASSION can be seen. The ads appear to be educational in nature and relate to responsible pet care including topics such as dog food, dog training, puppy proofing, cost of dog ownership, dog dental care, breed selection, exercising with dogs, puppy socialization, puppy health, kittens, responsible pet ownership, etc. I note that there is no information regarding the extent to which these publications have been circulated in Canada.

[32] Attached as Exhibits 9 and 10 to the Siemiesz affidavit are two print ads for Purina dog food which include the trade-mark YOUR PET, OUR PASSION. According to the affiant, the ads were published in 2004 in magazines entitled *Canadian Living* and *Canadian House & Home*; readership numbers of the magazines for the years 2010 and 2011 as they appear on the magazines' websites are attached as Exhibits 9-A and 10-A respectively. Attached as Exhibit 11 are sample print ads, online banner ads, contest ads, as well as in-store displays from 2007, bearing the trade-mark YOUR PET, OUR PASSION for Purina pet food and pet treats. Once again, I note that there is no information regarding the extent to which these ads have been seen by Canadians.

[33] In its written argument, the Applicant submits that there is a hearsay issue with respect to the readership numbers provided by Ms. Siemiesz in her affidavit. Setting aside the hearsay issue, I note that the readership numbers pertain to the years 2010 and 2011, while the sample ads from the *Canadian Living* and *Canadian House & Home* magazines are dated 2004. Without any evidence to suggest that these readership numbers are representative of those in 2004 nor any evidence that Purina placed similar ads in these magazines in 2010 or 2011, I am not prepared to accord any weight to the readership numbers.

[34] Even if I were to disregard the sample ads, based on a fair reading of Ms. Siemiesz's affidavit, I find it reasonable to conclude that the Opponent's trade-mark YOUR PET, OUR PASSION has, in conjunction with the trade-mark PURINA, acquired substantial reputation in association with pet food, pet treats, and pet litters, through extensive sales in Canada for the last ten years. As there is no evidence of promotion or use of the Mark in Canada, it can only be concluded that the Opponent's trade-mark YOUR PET, OUR PASSION has become known in Canada to a greater extent than the Mark.

Section 6(5)(b) – the length of time the trade-marks have been in use

[35] The overall consideration of the section 6(5)(b) factor clearly favours the Opponent. As per my review of the Siemiesz affidavit discussed above, the Opponent has provided evidence of use of the trade-mark YOUR PET, OUR PASSION dating as far back as 2003. In contrast, the application for the Mark is based on registration and use in Brazil with proposed use in Canada, with no evidence of use of the Mark to date.

Sections 6(5)(c) and (d) – the nature of the wares, services, trade and business

[36] The sections 6(5)(c) and (d) factors, which involve the nature of the wares, services, trade and business of the parties, favour the Opponent.

[37] When considering sections 6(5)(c) and 6(5)(d) of the Act, it is the statement of wares and services as defined in the application for the Mark and the statement of wares in the Opponent's registration that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[38] There are overlaps and close connections between the parties' wares and services. Both parties' trade-marks are associated with animal food and hygiene. In particular, the Opponent's trade-mark YOUR PET, OUR PASSION is registered for use in association with pet food, pet treats, and pet litters, while the Applicant's Mark is applied for use in association with animal toiletry and hygiene products, as well as the sale of food, veterinary preparations, cosmetics and toiletries for animals. As for the applied for services "commercial and industrial management consulting services", when viewed in connection with the Mark and in the absence of any evidence from the Applicant, I find that there could be a close connection with pet related wares and services as well.

[39] Neither the Opponent's registration nor the subject application contains any restriction on the channels of trade. According to Ms. Siemiesz, Purina sells and distributes its products through a wide variety of retail stores, including PetSmart Inc., Sobeys Capital Inc., Loblaw Companies Limited, and Wal-Mart Canada Corp. No evidence was filed regarding the nature of the trade engaged in by the Applicant.

[40] In the absence of evidence from the Applicant, since the parties' wares and services either overlap or are closely related in nature, for the purpose of assessing confusion, I conclude that there is potential for overlap between the parties' channels of trade.

Section 6(5)(e) – the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[41] When considering the degree of resemblance, the law is clear that the trade-marks must be considered in their totality. While it is not correct to lay them side by side and to compare and observe similarities or differences among the elements or components of the trade-marks, it is nevertheless possible to focus on particular features of a trade-mark that may have a determinative influence on the public's perception of it [see *United Artists Corp v Pink Panther Beauty Corp* (1998), 80 CPR (3d) 247 at 263 (FCA)]. The preferable approach when comparing trade-marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique [see *Masterpiece* at para 64].

[42] There is necessarily a fair degree of resemblance in appearance and sound between the parties' trade-marks considering that the written component of the Mark, the words PET and PASSION, form part of the Opponent's trade-mark YOUR PET, OUR PASSION. In the case of the Opponent's trade-mark, I consider the latter portion OUR PASSION to be the relatively more unique aspect of the trade-mark, even though it consists of ordinary words in the English language. In the case of the Mark, I find that the design element and the word element to be equally influential in appearance owing to their relative sizes. However, the addition of a design has no impact on the degree of resemblance between the parties' trade-marks when sounded, in which case the relatively more striking feature of the Mark remains the word PASSION. There are also similarities between the ideas suggested by the parties' trade-mark as both suggest passion in the context of pets. While the Opponent's trade-mark refers to its passion for its consumers' pets, the Mark refers to a general passion for pets.

[43] In the end, when the trade-marks are assessed in their entirety, I am of the view that they share a fair degree of similarity. In this regard, I am of the view that the differences in the parties' trade-marks are not significant enough to outweigh their similarities in appearance, sound and ideas suggested. The section 6(5)(e) factor therefore favours the Opponent.

Additional surrounding circumstance – Secondary marks

[44] The Applicant submits that the evidence shows that the Opponent's PASSION Trade-marks merely appear as secondary marks on Purina Products, in conjunction with PURINA, making it unlikely for the average consumer to infer that the parties' wares and services are manufactured or sold by the same person. The Act does not distinguish between primary and secondary marks [see *Groupe Procycle Inc v Chrysler Group LLC* (2010) 87 CPR (4th) 123 (FC)]. In any case, the Opponent's registrations do not restrict the use of the trade-marks in association with a house mark; neither does the application for the Mark. Thus, I do not consider this to be a significant surrounding circumstance.

Conclusion in the likelihood of confusion

[45] Having considered all of the surrounding circumstances, in view of the fair degree of similarities between the parties' trade-marks in appearance and sound, some similarities in ideas suggested, evidence of the Opponent's trade-mark having been used extensively in Canada, overlaps and close connection between the parties' wares and services, and the potential for overlap between of the parties' channels of trade, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between Mark and the trade-mark YOUR PET, OUR PASSION of registration No. TMA660,981.

[46] Since I accept the section 12(1)(d) ground of opposition based on registration No. TMA660,981, I am not considering the ground of opposition based on the other registered trade-mark alleged by the Opponent, VOTRE PETIT COMPAGNON, NOTRE PASSION (TMA702,308). Accordingly, I accept the ground of opposition based on section 12(1)(d) of the Act to the extent that it is based on registration No. TMA660,981.

Non-entitlement and Non-distinctiveness grounds of opposition

[47] Although the material dates for the section 16 and distinctiveness grounds of opposition fall earlier than today's date, on August 12, 2008 and June 28, 2012 respectively, the different dates do not result in a different outcome. The evidence summarized above is sufficient to meet

the Opponent's burden. For the reasons set out with the section 12(1)(d) ground of opposition, there is a reasonable likelihood of confusion and these grounds succeed.

Disposition

[48] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application under section 38(8) of the Act.

Pik-Ki Fung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule "A"

Opponent's Registered Trade-mark	Reg. No.	Wares
YOUR PET, OUR PASSION	TMA660,981	(1) Pet food, pet treats, pet litter.
VOTRE PETIT COMPAGNON, NOTRE PASSION	TMA702,308	(1) Pet food. (2) Edible pet treats. (3) Pet litter.