



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

**Citation: 2013 TMOB 35**  
**Date of Decision: 2013-02-14**

**IN THE MATTER OF OPPOSITIONS  
by 911979 Alberta Ltd. and Shoppers  
Drug Mart Inc. to application  
Nos. 1,386,725 and 1,399,745 for the  
trade-marks NATIVIA GUARANI and  
NATIVIA NATIVIA GUARANI S.A., A  
WHOLE EARTH SWEETENER  
COMPANY & Design in the name of  
Whole Earth Sweetener Company LLC**

[1] On March 10, 2008, Whole Earth Sweetener Company LLC (the Applicant) filed application No. 1,386,725 for the trade-mark NATIVIA GUARANI (the Mark).

[2] On June 16, 2008, the Applicant filed application No. 1,399,745 for a trade-mark that has been referred to as NATIVIA NATIVIA GUARANI S.A., A WHOLE EARTH SWEETENER COMPANY & Design (the Design Mark), claiming a convention priority filing date of June 9, 2008. The Design Mark is shown below:



Colour is claimed as a feature of the trade-mark. The mark consists of a stylized depiction of a leaf in white, with the wording Nativia in green, against a green background. The wording

NATIVIA GUARANI S.A., A WHOLE EARTH SWEETENER COMPANY is in black at the bottom.

[3] Both applications were filed on the basis of proposed use in association with the following wares:

nutritional supplements principally comprised of stevia; nutritional supplements principally comprised of stevia extracts; natural sweeteners, sugar substitutes; agricultural seeds; stevia seeds; natural live plants, namely, stevia plants.

[4] Both applications were advertised for opposition purposes in the *Trade-marks Journal* of January 13, 2010. On March 9, 2010, 911979 Alberta Ltd. (911979) and Shoppers Drug Mart Inc. (Shoppers), individually and collectively the Opponent, filed a statement of opposition against each application. The grounds of opposition may be summarized as follows:

1. The applied-for mark is not registrable pursuant to section 12(1)(d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) because it is confusing with the trade-mark NATIVA registered by 911979 under No. TMA727,312 in respect of a variety of wares including evaporated cane sugar, maple syrup and liquid honey.
2. The Applicant is not the person entitled to registration of the mark pursuant to section 16(3)(b) of the Act because at the date of filing of the application, it was confusing with the trade-mark NATIVA which was the subject of previously filed application No. 1,361,422 (which issued to registration No. TMA727,312).
3. The mark is not distinctive because it does not distinguish and is not adapted to distinguish the Applicant's wares from the Opponent's wares.

[5] The Applicant filed and served counter statements in which it denied the Opponent's allegations.

[6] The evidence with respect to both opposition proceedings is essentially the same. Pursuant to section 41 of the *Trade-marks Regulations*, SOR/96-195 (the Regulations), the

Opponent filed an affidavit of Morné Van Wyck, Shoppers' Senior Vice-President, Corporate Brands & Global Sourcing. Mr. Van Wyck provides evidence concerning the use and promotion of the NATIVA mark.

[7] Pursuant to section 42 of the Regulations, the Applicant filed affidavits of Kanwarbir Singh (a student-at-law) and Lynda Palmer (a trade-mark searcher). Mr. Singh provides copies of pages printed from the Applicant's website plus dictionary definitions for GUARANI. Ms. Palmer provides copies of two Canadian trade-mark applications and nine Canadian trade-mark registrations owned by third parties.

[8] No cross-examinations were conducted.

[9] Only the Opponent filed a written argument and only the Opponent participated in an oral hearing.

#### Applicable Material Dates

[10] The material dates with respect to the grounds of opposition are as follows:

- section 12(1)(d) - today's date [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- section 16(3)(b) – the filing date of the application;
- distinctiveness - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

#### Onus

[11] 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 Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[12] The Opponent's initial burden is met regarding its section 12(1)(d) grounds because registration No. TMA727,312 is extant.

[13] The Opponent's initial burden is not met regarding its section 16(3)(b) grounds because 911979's application No. 1,361,422 issued to registration on October 29, 2008 and therefore was not pending as of January 13, 2010 as required by section 16(4). The section 16(3)(b) grounds are accordingly dismissed.

[14] The Opponent's initial burden is met regarding its distinctiveness grounds because Mr. Van Wyck's evidence is that sales of NATIVA wares have extended across Canada, with sales in 2009 exceeding \$17 million and spending for related advertisements exceeding \$500,000 [see *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)].

#### Likelihood of Confusion

[15] Each of the surviving grounds of opposition turns on the issue of whether there is a likelihood of confusion between the parties' marks. I consider the section 12(1)(d) grounds of opposition to present the Opponent's strongest case, due to the later material date. I will begin by assessing the likelihood of confusion between the Mark and the registered mark NATIVA.

[16] 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. Section 6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source.

[17] The test for confusion is one of first impression and imperfect recollection. 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, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC), *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC).]

*inherent distinctiveness of the marks*

[18] The Opponent's mark is an invented word and therefore is inherently distinctive.

[19] The Applicant has provided evidence that the word GUARANI has three meanings: a member of an American Indian people of Paraguay and adjacent regions; an indigenous language of Paraguay; and the basic monetary unit of Paraguay.

[20] The Opponent submits that the inclusion of the word GUARANI in the Mark suggests that Paraguay is the source of the Applicant's wares. In fact, the Applicant's website states that the manufacturing site of Nativia Guarani is in Luque, Paraguay and that stevia, which is referred to in various ways in the Applicant's statement of wares, is a natural herbal sweetener that is native to Paraguay [Exhibit A, Singh affidavit]. Nevertheless, given that the first portion of the Mark is the invented word NATIVIA, the Mark has some inherent distinctiveness.

*the extent to which each mark has become known*

[21] A mark's distinctiveness can be enhanced through use and promotion.

[22] There is no evidence that the Mark has been used or promoted to date in Canada. On the other hand, there is evidence that sales of NATIVA wares have exceeded \$31 million and more than \$1,575,000 has been spent on related advertisements and promotions.

*the length of time the marks have been in use*

[23] Use of NATIVA began at least as early as October 7, 2008 whereas there is no evidence that use of the Mark has begun.

*the nature of the wares, services, business and trade*

[24] When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark application and registration that govern in respect of the issue of confusion arising under section 12(1)(d) [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe, Inc v Dale Bohna* (1984), 58 CPR (3d) 381 (FCA)].

[25] The statement of wares in the registration for NATIVA reads: ground coffee; microwave popcorn; cookies; potato chips; crackers; salsa; popcorn; cheese puffs; tortilla chips; pretzel twists, sticks and sourdough nuggets; macaroni & cheese; chocolate bars; teas; chocolate syrup; cereal; hot chocolate powder; hot instant oatmeal; quick oats; apple sauce; canned soups; pasta sauce; breakfast cereals; raisins; rice-based beverages; broths; peanut butter; almond butter, cashew butter; jams; salad dressings; maple syrup; fruit juices; dried pasta; rice; evaporated cane sugar; trail mixes; dried fruit; chocolate covered peanuts, almonds and raisins; edible nuts; rice cakes; candy; yogurt covered banana chips, cherries, raisins, cashews and chocolate covered peanuts; mueslis; biscotti; fruit bars; hazelnut spread; liquid honey; spices; salt; noodles & sauce mix; olives; olive oil; vinegar; soy sauce; mustard; relish; mayonnaise; sun dried tomatoes in olive oil; pesto; soy-based beverages; pancake mix; ketchup.

[26] According to the Applicant's evidence, stevia is a natural herbal sweetener with zero calories. The Opponent has accordingly pointed out the wares covered by its registration that are sweeteners, namely evaporated cane sugar, maple syrup and liquid honey, in order to emphasize the connection between the parties' wares. At the oral hearing, the Opponent submitted that there is an additional connection between the parties' wares in that the Applicant's website says that stevia is used to sweeten a variety of food products including some that overlap with other wares of the Opponent, in particular beverages, cookies, condiments, sauces, candies, and chocolates.

[27] It is not clear what the Applicant's specific channels of trade would be but its website provides the following information concerning its business: "...the Whole Earth Sweetener Company was born – to bring the world 100% natural sweeteners and a new generation of sweetened food and beverage products."

[28] Regarding the Opponent, the evidence is that Shoppers is licensed by 911979 to use NATIVA pursuant to a licence agreement whereby 911979 exercises direct control over the character and quality of the wares. Shoppers operates drug stores but its business includes the private labelling, distribution, retail sale and marketing of a wide variety of goods and products in association with the NATIVA trade-mark. The Opponent's labels identify its NATIVA wares as organic.

[29] There is no evidence that the parties' wares would not be sold through similar channels of trade and it is reasonable to accept that sugar substitutes and related products would travel through the same channels of trade as other food products.

*the degree of resemblance between the marks*

[30] The resemblance between the marks in appearance, sound and ideas suggested is primarily due to the first word of each mark (NATIVA versus NATIVIA). The first component of a mark is often considered more important for the purpose of distinction [*Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)].

[31] NATIVA and NATIVIA bear a high degree of resemblance in appearance, sound, and idea suggested. Although neither word has a defined meaning, both are reminiscent of the word "native".

[32] Although the addition of the word GUARANI serves to distinguish the Mark from NATIVA to some extent, the Opponent submits that the geographic connotation of GUARANI diminishes the effectiveness of this addition which it submits merely results in the Mark suggesting that the wares are native to Paraguay.

*other surrounding circumstances*

[33] The Applicant's evidence includes copies of 9 registrations for trade-marks that include the word NATIVE. However, the Applicant has not explained why it considers such evidence to be relevant.

[34] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located. [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Del Monte Corporation v Welch Foods Inc* (1992), 44 CPR (3d) 205 (FCTD); *Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)]

[35] The evidence of the state of the register is not a significant surrounding circumstance in the present case for a number of reasons: not all of the registrations cover food products (let alone sweeteners); the word NATIVE is often accompanied by other words that would serve to distinguish the third party marks; and the number of relevant registrations is insufficient to draw an inference about the state of the marketplace.

*conclusion regarding section 12(1)(d) ground*

[36] Having considered all of the surrounding circumstances and bearing in mind that the Applicant bears the legal burden, I am not satisfied that confusion between NATIVA and the Mark is not likely. This is because there is a fair degree of resemblance between the marks, they are associated with similar wares, and only the Opponent's NATIVA mark has acquired a reputation.

[37] Turning to the likelihood of confusion between the Design Mark and the registered mark NATIVA does not improve the Applicant's position. Instead, the Opponent's position is stronger vis-à-vis the Design Mark because in that mark NATIVIA is not only the first component but it also appears in a font that is many times larger than that used for the remaining words, which appear almost as fine print at the bottom of the mark. To put it another way, when the Design Mark is considered as matter of first impression, the additional words appearing at the bottom are not likely to impact the overall degree of resemblance given that they are so subordinate to the word NATIVIA. I therefore reach a similar conclusion with respect to the Design Mark, i.e. that the section 12(1)(d) ground succeeds because the Applicant has not satisfied its legal burden.



*distinctiveness ground of opposition*

[38] The outcome of the distinctiveness grounds of opposition is the same as that of the section 12(1)(d) grounds since the different material dates for assessing the likelihood of confusion does not affect the outcome of the section 6(5) analysis. Regarding the Design Mark, the distinctiveness ground is in fact stronger than is the section 12(1)(d) ground because in the marketplace NATIVA has been associated with a leaf design and the colour green, which further increases the resemblance to the Design Mark.

[39] The distinctiveness grounds of opposition therefore also succeed on the basis that the Applicant has not satisfied me that confusion between the marks was not likely as of March 9, 2010.

Disposition

[40] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse both application Nos. 1,386,725 and 1,399,745 pursuant to section 38(8) of the Act.

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Jill W. Bradbury  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office