



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

**Citation: 2012 TMOB 5**  
**Date of Decision: 2012-01-12**

**IN THE MATTER OF AN OPPOSITION  
by Whole Foods Market IP, L.P. to  
application No. 1,314,418 for the trade-  
mark NATURE'S MOST POWERFUL  
WHOLE FOOD in the name of Salba  
Corp. N.A.**

[1] On August 25, 2006, Salba Corp. N.A. (the Applicant) filed an application to register the trade-mark NATURE'S MOST POWERFUL WHOLE FOOD (the Mark) on the basis of its proposed use. The wares, as revised, are:

Nutrient dense unprocessed grain rich in Omega 3 derived from the plant species *salvia hispanica* (the Wares).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of March 5, 2008.

[3] On December 2, 2008, Whole Foods Market IP, L.P. (the Opponent) filed a statement of opposition pleading the grounds summarized below. As the Opponent did not include the specific subsections of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) allegedly contravened, I have included these in brackets.

(a) the application does not contain a statement in ordinary commercial terms of the specific wares with which the mark is proposed to be used (s. 30(a) of the Act);

- (b) the Applicant's statement that it is entitled to use the Mark is false having regard to its knowledge of the prior use of the Opponent's trade-marks (s. 30(i) of the Act);
- (c) the Applicant's statement that it intends to use the phrase NATURE'S MOST POWERFUL WHOLE FOOD as a trade-mark is false (s. 30(e) of the Act);
- (d) the Mark is not registrable because it is confusing with the Opponent's registration Nos. TMA561,203 and TMA565,489 (s. 12(1)(d) of the Act);
- (e) the Applicant is not a person entitled to registration of the Mark because at the date of filing the application, the mark was confusing with the Opponent's trade-names WHOLE FOODS and WHOLE FOODS MARKETS and the Opponent's trade-marks WHOLE FOODS MARKET, WHOLE FOODS MARKET & Design, and WHOLE FOODS WHOLE PEOPLE WHOLE PLANET (s. 16(3)(a) and (c) of the Act); and
- (f) the Mark is not distinctive (s. 2 of the Act).

[4] The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[5] Leave was subsequently granted to the Opponent to amend the s. 12(1)(d) ground to include registration No. TMA735,328 for WHOLE FOODS MARKET.

[6] The Opponent filed an affidavit of Roberta Lang and certified copies of its registrations. The Applicant did not file evidence. No cross-examination was conducted.

[7] Only the Opponent filed a written argument and attended a hearing.

Preliminary Issue: Grounds of Opposition Withdrawn

[8] In its written argument, the Opponent confirmed that it was withdrawing the grounds of opposition based on s. 30(a), 30(e), and 30(i).

Onus and Material Dates

[9] 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 C.P.R. (3d) 293 (F.C.T.D.) at 298].

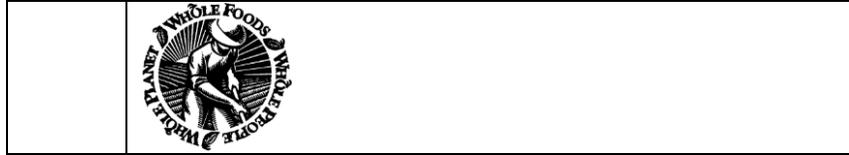
[10] The material dates with respect to the remaining grounds of opposition are as follows:

- s. 38(2)(b)/12(1)(d) of the Act - the date of my decision [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 38(2)(c)/16(3) of the Act - the date the application was filed; and
- s. 38(2)(d) of the Act - the date of filing the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Section 12(1)(d) Ground of Opposition

[11] I will first consider the s. 12(1)(d) ground of opposition. The Opponent has pleaded that the Mark is confusing with the following registered trade-marks:

i)	WHOLE FOODS MARKET Reg. No. TMA735,328
ii)	WHOLE FOODS MARKET & Design Reg. No. TMA561,203 
iii)	WHOLE FOODS WHOLE PEOPLE WHOLE PLANET Reg. No. TMA565,489



I have exercised my discretion and checked the register to confirm each of these registrations is extant [*Quaker Oats Co. of Canada v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)]. Therefore, the Opponent has met its initial burden with respect to this ground. My discussion will be focused on the Opponent's WHOLE FOODS MARKET & Design and WHOLE FOODS MARKET trade-marks (collectively the WHOLE FOODS MARKET Trade-marks) as these are closest in appearance to the Mark.

[12] The test to determine the issue of confusion is set out in s. 6(2) of the Act where 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 and services associated with those trade-marks are manufactured, sold or leased by the same person, whether or not the wares and services are of the same general class. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in s. 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the wares and services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them.

[13] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Mattel, Inc. v. 3894207 Canada Inc.*, [2006] 1 S.C.R. 772 (S.C.C.) at para. 54]. I also refer to *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.) at para. 49, where the Supreme Court of Canada states that s. 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis. I will assess the s. 6(5)(a) and (e) factors first.

*Inherent distinctiveness and extent that the mark has become known*

[14] I can take judicial notice of dictionary definitions [see *Envirodrive Inc. v. 836442 Alberta Ltd.*, 2005 ABQB 446 (Alta. Q.B.); *Tradall S.A. v. Devil's Martini Inc.* (2011), 92 C.P.R. (4th)

408 (T.M.O.B.) at para. 29] and note that WHOLE FOOD is a defined term. The *Canadian Oxford Dictionary* (1998 ed.) includes the following definition “*n.* food that has not been unnecessarily processed or refined, such as brown rice”. As such, the WHOLE FOODS MARKET Trade-marks possess little, if any, inherent distinctiveness. The descriptiveness of the WHOLE FOODS MARKET trade-mark is confirmed by the fact that its registrability has been recognized under s. 14 of the Act.

[15] The Applicant’s mark is not inherently strong since it contains the laudatory phrase NATURE’S MOST POWERFUL [*Vitality Products Inc. v. Melaleuca Inc.* (2009), 81 C.P.R. (4th) 68 at para. 17 (T.M.O.B.)]. Furthermore, the term WHOLE FOOD appears to be descriptive of the Wares which are described as an unprocessed grain. There being no evidence from the Applicant, I must conclude that its mark has not become known at all in Canada.

[16] The affidavit of Roberta Lang, President of the Opponent, evidences use of the WHOLE FOODS MARKET Trade-marks by the Opponent’s licensee in association with the registered wares and/or services in Canada from May 2002 onwards. The WHOLE FOODS MARKET Trade-marks appear on interior and exterior store signage, sample tables, gift cards, on packaging and labels for bakery items, bulk and prepared food, bags, flyers, and on the website *www.wholefoodsmarket.com* (Exhibits C, D, E, G and H). While no sales or advertising information specific to Canada has been provided, Ms. Lang attaches a considerable number of articles published in periodicals such as *The National Post*, *The Toronto Star*, *The Toronto Sun*, *The Calgary Herald*, *The Gazette*, *The Globe and Mail*, and *The Ottawa Citizen* referencing the Opponent’s stores (Exhibit J1), allowing me to conclude that the WHOLE FOODS MARKETS Trade-marks are known to at least some extent. While stores are only in the Toronto and Vancouver areas, the fact that articles about these stores have appeared in national newspapers and local newspapers in other cities suggests that the Opponent’s reputation may extend beyond these areas.

*Degree of resemblance between the trade-marks*

[17] I consider there to be a fair degree of similarity between the Mark and the Opponent’s WHOLE FOOD MARKET Trade-marks visually and aurally due to the fact that the Mark ends with WHOLE FOOD. However, I do not find that the ideas suggested by each mark are similar.

The Opponent's marks suggest a market where a consumer can acquire unprocessed and natural foods. In contrast, the Mark suggests an unprocessed natural food with desirable properties.

[18] With respect to the WHOLE FOODS WHOLE PEOPLE WHOLE PLANET & Design trade-mark, there is less similarity. The marks have a very different appearance due to the fact that the Mark does not contain the repeating element WHOLE. Due to this low degree of similarity, there is no likelihood of confusion between the Mark and this mark (*Masterpiece*, para. 49).

*Remaining s. 6(5) factors*

[19] In *Masterpiece* the Supreme Court stated that the other s. 6(5) factors would only become significant once the marks are found to be identical or very similar (at para. 49). In this case, the remaining factors do not overcome the lack of resemblance with respect to the Opponent's WHOLE FOOD MARKET Trade-marks. The Opponent's WHOLE FOOD MARKET Trade-marks have only been in use since 2002. Furthermore, while there is some overlap between the Wares and the Opponent's registered wares and services they are not identical.

*Conclusion*

[20] Accordingly, this ground of opposition is dismissed.

Section 16 Grounds of Opposition

[21] The Opponent has also pleaded that the Mark is confusing with its WHOLE FOODS MARKET Trade-marks and WHOLE FOODS WHOLE PEOPLE WHOLE PLANET trade-mark and the WHOLE FOODS and WHOLE FOODS MARKET trade-names under s. 16(3) of the Act. The assessment of this ground of opposition differs from that under s. 12(1)(d) in that the material date under s. 16(3) is August 25, 2006, the filing date of the application. In order to meet its initial burden under s. 16, the Opponent must provide evidence that it was using these trade-marks and trade-names in Canada and had not abandoned them as of March 5, 2008, the date of advertisement of the application (s. 16(5) of the Act).

[22] Ms. Lang provides evidence of use of the WHOLE FOODS MARKET trade-name and the WHOLE FOODS WHOLE PEOPLE WHOLE PLANET trade-mark in association with retail grocery store and in-store restaurant services and the WHOLE FOODS MARKET Trade-marks in association with these services as well as milk, baked goods, nuts, soup, cheese, water bottles, insulated bags and mugs (Exhibits C,D,E,G). The reasons discussed with respect to the s. 12(1)(d) ground apply despite the earlier material date and I do not find that there is a likelihood of confusion between this trade-name and these trade-marks and the Mark.

[23] With respect to the WHOLE FOODS trade-name, I do not find that the Opponent has met its burden with respect to demonstrating its use of this trade-name. Ms. Lang's evidence refers to the use of the WHOLE FOODS MARKET trade-name. I do not find use of the WHOLE FOODS MARKET trade-name to be use of the WHOLE FOODS trade-name as MARKET is a dominant component of this trade-name as it evokes a very specific idea for consumers [*Durand v. Consumers Distributing Co./Cie distribution aux consommateurs*; 1987 CarswellNat 1477 (T.M.O.B.) at paras. 9-11]. I also do not find that use of the WHOLE FOODS MARKET & Design trade-mark is use of the trade-name WHOLE FOODS as this design mark is used to distinguish the opponent's services and not to identify the business [*Road Runner Trailer Manufacturing Ltd. v. Road Runner Trailer Co. Ltd.* (1984), 1 C.P.R. (3d) 443 (F.C.T.D.); *Markus Cohen Law Office v. Café Napoléon Inc.* (2009), 77 C.P.R. (4th) 94 (T.M.O.B.) at 96].

[24] Accordingly, this ground of opposition is dismissed.

#### Distinctiveness Ground of Opposition

[25] The Opponent pleaded that the Mark is not distinctive having regard to the trade-names and trade-marks referenced in the Statement of Opposition. With the exception of the WHOLE FOODS trade-name, I have already concluded that there is no likelihood of confusion between the Mark and each of the other trade-names and trade-marks in the Statement of Opposition. Although the relevant date, December 2, 2008, is different for this ground of opposition, there is no change in my conclusion for the trade-marks and trade-names already considered.

[26] This leaves the Opponent's trade-name WHOLE FOODS. There is an initial burden on the Opponent to establish that, as of December 2, 2008, this trade-name was known to such an

extent that it could negate the distinctiveness of the Mark. The following propositions summarize the relevant jurisprudence on distinctiveness [*Bojangles' International, LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.) at para. 33].

- The evidential burden lies on the party claiming that the reputation of its mark prevents the other party's mark from being distinctive;
- However, a burden remains on the applicant for the registration of the trade-mark to prove that its mark is distinctive;
- A mark should be known in Canada to some extent at least to negate another mark's distinctiveness;
- Alternatively, a mark could negate another mark's distinctiveness if it is well known in a specific area of Canada; and
- A foreign trade-mark owner cannot simply assert that its trade-mark is known in Canada, rather, it should present clear evidence to that effect.

[27] Finally, an attack based on non-distinctiveness is not restricted to the actual performance of services or sales of goods in Canada. It may also be based on evidence of knowledge or reputation of the Opponent's trade-mark or trade-name spread by means of word of mouth and evidence of reputation and public acclaim and knowledge by means of newspaper or magazine articles as opposed to advertising [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.) at 58-59].

[28] Ms. Lang's evidence is that as of the relevant date there were two sizeable Whole Foods Market stores in the Toronto area (para. 6, Exhibit H). Each of these Whole Foods Market stores had prominent signage displaying the WHOLE FOODS MARKET Design trade-mark (Exhibit C). Due to the fact that there is considerable emphasis on the WHOLE FOODS component in this design mark, I find that consumers are likely to take notice of the dominant component WHOLE FOODS [*Masterpiece*, para. 64].

[29] A review of the articles attached to Ms. Lang's affidavit evidences that in addition to numerous references to "Whole Foods Market", there were also considerable references to "Whole Foods" prior to the relevant date. For example, in 2007 "Whole Foods" was referenced in ten articles in the Globe and Mail, nine articles in the Toronto Star, and five articles in the

National Post. While the Opponent has not provided any admissible evidence of the circulation of these newspapers, I take judicial notice that each of the publications had fairly substantial circulation in the Toronto area [*Northern Telecom Ltd. v. Nortel Communications Inc.* (1987), 15 C.P.R. (3d) 540 (T.M.O.B.) at 543]. As such, I am satisfied that the general public in Toronto has been exposed to various publications which the Opponent is referred to by the Whole Foods trade-name. I am satisfied that the Opponent has met its evidential burden of demonstrating a sufficient reputation [*Lifestyles Improvement Centres, LLP v. Chorney* (2007), 63 C.P.R. (4th) 261 (T.M.O.B.) at 273-274]

[30] As the Applicant has not filed any evidence, it fails to meet its burden of proving that the Mark is distinctive or is adapted to distinguish the Wares. Even though “whole food” is a defined term, the Applicant has done nothing to evidence third party use and adoption of it [*Reckitt & Colman (Overseas) Ltd. v. Brass Magic Inc.* (1988), 20 C.P.R. (3d) 382 (T.M.O.B.) at 384; *Rust-Oleum Corp. v. Kpr Adcor Inc.*, 2007 CarswellNat 2292 (T.M.O.B.)]. Had the Applicant filed such evidence, my conclusion might well have been different. Furthermore, the phrase “NATURE’S MOST POWERFUL” may not be sufficient to distinguish the Mark as it is laudatory [*United Artists Pictures Inc. v. Pink Panther Beauty Corp.*, [1998] 3 F.C. 534 (F.C.A.) at para. 23; *Frisco-Findus S.A. v. Walker* (1993), 49 C.P.R. (3d) 361 at 364-365 (T.M.O.B.)]. Accordingly, this ground of opposition is successful.

### Disposition

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

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Natalie de Paulsen  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office