



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

**Citation: 2012 TMOB 76**  
**Date of Decision: 2012-04-23**

**IN THE MATTER OF AN  
OPPOSITION by Neuville Industries,  
Inc. to application No. 1,413,477 for the  
trade-mark ORTHO PEDS in the name  
of H.G. International (A Division of  
1157472 Ontario Ltd.)**

[1] On October 6, 2008, H.G. International (A Division of 1157472 Ontario Ltd.) (the Applicant) filed an application to register the trade-mark ORTHO PEDS for use in association with socks, medical socks (the Wares) based on proposed use in Canada.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of August 19, 2009.

[3] On October 19, 2009, Neuville Industries, Inc. (the Opponent) filed a statement of opposition pleading the grounds summarized below:

- (a) contrary to section 12(1)(d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), the Mark is not registrable because it is confusing with registration Nos. TDMA55715 and TMA704,942 for PEDS and MEDIPEDS;
- (b) contrary to section 16(3)(a) of the Act, the Applicant is not the person entitled to registration of the Mark because at the filing date it was confusing with the use of the Opponent's trade-marks PEDS and MEDIPEDS; and

(c) contrary to section 2 of the Act, the Mark is not distinctive of the Applicant.

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

[5] In support of its opposition, the Opponent filed an affidavit of Kathy Willis. In support of its application, the Applicant filed an affidavit of Kerry Biggs. Both parties filed a written argument. No hearing was held.

#### Preliminary Issue

[6] To the extent that the Applicant attempts to adduce evidence regarding use of "ped socks" by third parties in its written argument, I have not had regard to it as such evidence was not filed by way of affidavit or statutory declaration or in accordance with proper procedure [*Trade-marks Regulations*, SOR/96-195, s. 42].

#### Onus and Material Dates

[7] 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) 298].

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

- section 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 CPR (3d) 413 (FCA)];
- section 38(2)(c)/16(3)(a) of the Act - the filing date of the application; and
- section 38(2)(d) of the Act - the date of filing the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Section 12(1)(d) Ground of Opposition

[9] The section 12(1)(d) ground of opposition turns on the likelihood of confusion between the Mark and registration Nos. TMDA55715 and TMA704,942. I have exercised my discretion and checked the register to confirm that each of these registrations is extant [*Quaker Oats Co. of Canada v Menu Foods Ltd.* (1986), 11 CPR (3d) 410 (TMOB)]. Therefore, the Opponent has met its initial burden with respect to this ground. My review of the register confirms that these registrations were assigned on August 11, 2011 to 7933657 Canada, Inc. The impact of this assignment is considered in more detail in my conclusion for this ground of opposition. The particulars for these trade-marks are set out below.

Reg. No.	Trade-mark	Wares
TMDA55715	PEDS	An article known as stocking foot or foot glove.
TMA704,942	MEDIPEDS	Men's, women's and children's socks, hosiery, slippers, sandals, shoes, and insoles, inserts, liners and covers for shoes; and foot pads; and women's and girl's pantyhose, tights, knee-highs, thigh-highs, and stockings

[10] The test to determine the issue of confusion is set out in section 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 section 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.

[11] 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 SCR 772 (SCC) para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) para 49, where the

Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis:

...the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis ... if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar... As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start.

I will therefore consider this factor first.

*degree of resemblance in appearance or sound or in the ideas suggested*

[12] The Mark incorporates the whole of the PEDS mark and has the same suffix component as the MEDIPEDS mark. I can take judicial notice of dictionary definitions [see *Envirodrive Inc v 836442 Alberta Ltd*; 2005 ABQB 446 (Alta QB); *Tradall SA v Devil's Martini Inc* (2011), 92 CPR (4th) 408 (TMOB) para 29]. The Oxford Canadian Dictionary (1998 ed) states that *pes pedis* is foot in latin (see definition of pedal). While I accept that ped- suggests feet (for example pedestrian, pedal, pedicure), there is no evidence that PED or PEDS is a defined term or understood to be synonymous with socks or anklets.

[13] I find that the marks at issue, when considered as a whole, visually and aurally resemble each other to a significant degree due to the shared PEDS component. While it is generally accepted that the prefix component of a mark is the most important for the purposes of distinguishing between marks [*Conde Nast Publications Inc v Union des éditions modernes* (1979), 46 CPR (2d) 183 (FCTD) 188], the importance of this factor diminishes if it is suggestive or descriptive [*Reno-Dépôt Inc v Homer TLC Inc* (2009), 84 CPR (4th) 58 (TMOB) para 58]. In this case, I find the component ORTHO suggests that the Wares are corrective. In this regard, I find that the Mark and MEDIPEDS both suggest a very similar idea namely a product that corrects or treats the feet and that the PEDS mark suggests a somewhat similar idea - a product for the feet.

*inherent distinctiveness*

[14] Neither PEDS, MEDIPEDS or the Mark are strong marks as they all evoke an association with feet.

*extent known and length of time in use*

[15] This factor favours neither party. The Applicant has not filed any evidence of use. While the Opponent has filed evidence of use of the PEDS and MEDIPEDS marks, the evidence does not support that they have become known to any significant extent as the Opponent's marks [*Petro-Canada v Air Miles International Holdings NV* (1998), 83 CPR (3d) 111 (TMOB) 119-120].

[16] The affidavit of Ms. Willis, sworn March 15, 2010, President and Chief Operating Officer of the Opponent, provides the following:

- The Opponent licensed Americal Corporation (Americal) to sell MEDIPEDS socks (para 9).
- Packaging of MEDIPEDS socks sold in Canada includes the following trade-marks notice: “Distributed by Americal Corporation P.O. Box 1419 Henderson, NC 27536 MediPeds is a registered trademark of Neuville Industries, Inc. used under license.” (Exhibits 3-7). Although Ms. Willis does not provide evidence of control by the Opponent over the character or quality of the Wares, such trade-mark notice is sufficient to have the use by Americal enure to the Opponent [s. 50(2) of the Act; *Neuville Industries Inc v KvG Group Inc*; 2011 CarswellNat 4787 (TMOB) para 29].
- The 2006-2009 sales of MEDIPEDS socks in Canada exceeded \$1 million USD (Exhibit 1). I note that the sales numbers provided are for Americal's sales of MEDIPEDS socks generally and are not specific to MEDIPEDS socks sold with the trade-marks notice set out above.
- The Opponent licensed Richelieu Hoisery International (Richelieu) to sell PEDS socks (para 18). As Ms. Willis does not indicate that the Opponent has care and control over the character or quality of the Wares and the packaging of the PEDS socks does not show trade-marks notice compliant with section 50(2) of the Act, I cannot conclude that the use of PEDS in Canada

enures to the Opponent [*Loblaws Inc v No Frills Auto & Truck Rental Ltd*; 2004 CarswellNat 3135 (TMOB) paras 10-14, 22; rev'd on other grounds].

[17] The affidavit of Ms. Biggs, sworn July 27, 2012, partner of the trade-mark agent of the Applicant, attaches packages of MEDIPEDS and PEDS socks purchased in Canada on July 27, 2010 (para 2; Exhibit B).

- The packaging of the MEDIPEDS small socks has the same trade-marks notice as those attached to Ms. Willis' affidavit (Exhibit A-1).
- The packaging of the MEDIPEDS large socks has the trade-marks notice "Distributed by Americal Corporation P.O. Box 1419, Henderson, NC 27536 Under license from The Peds Company, Division of International Legwear Group, Inc." (Exhibit A-2).
- The packaging of the PEDS socks has the trade-marks notice "Peds socks are distributed in Canada by Richelieu Hoisery Int'l under license from International Legwear Group Inc." (Exhibit A-3).

The use of the PEDS mark and the MEDIPEDS mark on the large socks does not enure to the Opponent as the trade-marks notice in each case does not meet the requirements of section 50(2) of the Act.

[18] In this case, as there is no evidence that the Opponent has direct or indirect control of the character or quality of the Wares sold under the license, nor to what extent there has been use of the MEDIPEDS and PEDS trade-marks on packaging which complies with section 50(2) of the Act, I am unable to conclude to what extent the use of the PEDS and MEDIPEDS marks enures to the Opponent [*Boehringer Ingelheim Pharma KG v Braintree Laboratories Inc*; 2004 CarswellNat 4704 (TMOB)], nor the length of time of such use. As such, I am unable to conclude that the PEDS and MEDIPEDS marks have become known to any real extent as the Opponent's marks. In so saying, I am not considering the validity of the relied upon registered trade-marks, merely the scope of protection to which they might be entitled by virtue of the evidence of use [*Vibe Ventures LLC v CTV Ltd*; 2010 CarswellNat 4273 (TMOB) para 81].

*nature of wares and trade*

[19] This factor favours the Opponent. The Wares and the registered wares covered by the PEDS and MEDIPEDS registrations are identical. The PEDS registration covers a stocking foot or foot glove which Ms. Willis explains are no-show or low cut socks (para 6). Furthermore, the evidence of Ms. Willis is that the Opponent's MEDIPEDS trade-mark is used in association with socks which are "ideal" for people with circulatory problems or diabetes (Exhibits 3-7). As the wares at issue are identical, presumably the channels of trade will overlap as well.

*surrounding circumstances*

[20] In its written argument, the Applicant argues that "due to irregularities and defects in the marking and notice structure of the Opponent its trade-marks are not in fact distinctive of the Opponent." The Registrar has previously held that the wide spread use of a mark does not preclude the registration of a some what similar mark [*Petro-Canada, supra*]. Unlike in the *Petro-Canada* case, however, the evidence in the subject proceeding does not support that there has necessarily been widespread use of the PEDS and MEDIPEDS marks by different entities. As such, I do not find this to be a significant surrounding circumstance.

*conclusion*

[21] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the Mark on the Wares at a time when he or she has no more than an imperfect recollection of the PEDS and MEDIPEDS marks, and does not pause to give the matter any detailed consideration or scrutiny [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC) para 20].

[22] In view of my findings above, and in particular the similarity between the wares and the degree of resemblance between the marks in appearance, sound, and idea suggested, it seems to me that such a consumer would, as a matter of first impression, be likely to believe that the wares associated with the Mark and the PEDS and MEDIPEDS marks were manufactured or sold by the same person. As such, this ground of opposition succeeds. While my review of the register indicates that these registrations were assigned on August 11, 2011, this assignment does not impact my decision as I have

not afforded great weight to the factors concerned with the Opponent's use in Canada and parties may rely on third party registrations in an opposition [*Oakwood Lumber & Millwork Co v. Fojtasek Cos* (1997), 75 C.P.R. (3d) 552 (TMOB) at 558]. Finally, I note that if I had evidence that PED or PEDS had been generally adopted as a word describing socks or similar items, I may well have reached a different conclusion.

#### *Section 16(3)(a) Ground of Opposition*

[23] The Opponent has also pleaded that the Applicant is not the person entitled to registration pursuant to section 16(3)(a) on the basis that the Mark is confusing with the Opponent's marks PEDS and MEDIPEDS. With respect to this ground of opposition, there is an initial burden on the Opponent to evidence use of its marks prior to the Applicant's filing date and non-abandonment of its marks as of the date of advertisement of the Applicant's application [s. 16(5) of the Act]. I note that as the assignment of the PEDS and MEDIPEDS registrations occurred well after the material dates (October 6, 2008 and August 19, 2009) it does not impact my assessment of this ground.

[24] For the reasons discussed above, I do not find that the Opponent has evidenced any use of the PEDS trade-mark which enures to it. As such, it has not met its burden with respect to this mark.

[25] The Opponent, however, has evidenced at least some use of its MEDIPEDS trade-mark which enures to it as of the material date pursuant to section 50(2) of the Act (Exhibits 3-7 of the Willis affidavit). For the reasons set out in the discussion of the section 12(1)(d) ground of opposition, 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 the Mark and the MEDIPEDS mark.

#### *Distinctiveness*

[26] As I have already found in favour of the Opponent under two grounds, I do not consider it necessary to address the remaining ground of opposition.



Disposition

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

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