



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

**Citation: 2014 TMOB 111**  
**Date of Decision: 2014-05-30**

**IN THE MATTER OF AN OPPOSITION  
by Gaspari Nutrition Inc. to application  
No. 1,479,156 for the trade-mark REAL  
MASS in the name of Body Plus  
Nutritional Products Inc.**

[1] On April 29, 2010, Body Plus Nutritional Products Inc. (the Applicant) filed an application to register the trade-mark REAL MASS (the Mark) in association with the wares “dietary weight gain supplement” (the Wares) based on use in Canada since April 28, 2005.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of October 6, 2010.

[3] On October 25, 2010, Gaspari Nutrition Inc. (the Opponent) filed a statement of opposition. The Applicant requested an interlocutory ruling prompting the Opponent to file an amended statement of opposition on March 15, 2011 leave for which was granted on May 11, 2011. The Applicant’s request for an interlocutory ruling striking some of the grounds of opposition was refused. The grounds of opposition can be summarized as follows:

- pursuant to sections 38(2)(a) and 30(b) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), the application does not comply with section 30(b) of the Act because the Applicant or its alleged predecessor did not use the trade-mark since the claimed date of first use, namely April 28, 2005;
- pursuant to sections 38(2)(a) and 30(i) of the Act, the Applicant could not have been satisfied that it was entitled to register the Mark in Canada in association with the Wares because the Applicant was aware of the extensive use of the

trade-mark REAL MASS by the Opponent in association with dietary weight gain supplements continuously promoted, offered for sale and sold to consumers in Canada since at least as early as April 20, 2009 and in the United States since at least as early as June 1, 2009;

- pursuant to sections 38(2)(d) and 2 of the Act, the Mark is not distinctive since it is not adapted to distinguish and does not distinguish the Wares from the dietary weight gain supplements in association with which the Opponent has extensively used and advertised the REAL MASS trade-mark in Canada since at least as early as April 20, 2009 and in the United States since at least as early as June 1, 2009.

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

[5] In support of its opposition, the Opponent filed an affidavit of Michael Spriggs, the Executive Vice President of the Opponent's exclusive Canadian distributor, dated May 12, 2011 and an affidavit of Jamie Cuthbertson, a law clerk employed by the Opponent's agent. The Opponent also filed a second affidavit of Michael Spriggs (dated October 1, 2012) and an affidavit of Michael Bates, a litigation clerk employed by the Opponent's agent, as its reply evidence. Mr. Spriggs was cross-examined on his October 1, 2012 affidavit and Mr. Bates was cross-examined on his affidavit.

[6] In support of its application, the Applicant filed an affidavit of Mr. Roy, the Vice President of Operations for the Applicant. Mr. Roy was cross-examined on his affidavit. The Applicant was also granted leave to file an affidavit of Karen Sue Blau in accordance with section 44 of the *Trade-marks Regulations* SOR/96-195 (the Regulations).

[7] Both parties filed written arguments but an oral hearing was not held.

#### Onus and Material Dates

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

[9] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30 - the date of filing the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)];
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

### Preliminary Matter

[10] I have reviewed and considered all of the evidence and submissions submitted by both parties; however, only evidence which is directly relevant to my findings will be discussed in my decision.

### Non-compliance with Section 30 Grounds of Opposition

#### *Non-compliance with section 30(b) of the Act*

[11] While the legal burden is upon the Applicant to show that the application complies with section 30 of the Act, there is an initial evidential burden on the Opponent to establish the facts relied upon in support of its section 30 ground of opposition. However, the evidential burden on the Opponent respecting the issue of the Applicant's non-compliance with section 30(b) is a light one. Further, the Opponent may rely on the Applicant's affidavit evidence to meet its evidential burden in relation to this ground. In such a case, however, the Opponent must show that the Applicant's evidence is 'clearly' inconsistent with the claimed first use date [see *Molson Canada v Anheuser-Busch Inc* (2003), 29 CPR (4th) 315 (FCTD), *Ivy Lea Shirt Co Ltd v 1227624 Ontario Ltd* (1999), 2 CPR (4th) 562 (TMOB); and *York Barbell Holdings Ltd v ICON Health and Fitness, Inc* (2001), 13 CPR (4th) 156 (TMOB)].

[12] The Opponent filed evidence in support of its allegation that the Applicant had not used the Mark since the claimed date. Firstly, the Opponent relies on the first affidavit of Mr. Spriggs in which he states that despite his involvement in the dietary supplements industry he had no knowledge of the Applicant's product before the current opposition proceeding was commenced (Spriggs affidavit, paras 18-20). The Applicant's Vice President of Operations, Mr. Roy,

admitted on cross-examination that REAL MASS was not the Applicant's biggest brand and that the Wares were not available in some of the large nutritional supplement retail chains (Roy cross-examination Q235-254, 267-268, Q271-274). It is thus not surprising that Mr. Spriggs was unaware of the Applicant's Wares sold in association with the Mark. I do not find Mr. Spriggs' statement to support a finding that the Applicant has not used the mark since the claimed date of first use.

[13] The Opponent also filed the Cuthbertson affidavit, in which she provides evidence that the earliest online reference to the Applicant's Wares on the QSE Supplements website was December 10, 2006 (Cuthbertson affidavit, paras 3-5, Exhibit A). The Opponent submits that this is clearly inconsistent with the Applicant's claimed first use date of April 28, 2005. I disagree. At most, this supports a finding that the Mark may not have appeared on the QSE Supplements website until December 10, 2006. However, this fact is not determinative of whether the Mark was in use in association with the Wares prior to this date as the Wares may have been available for sale in Canada in association with the Mark prior to appearing on the website.

[14] The Opponent also filed other evidence to support its section 30(b) ground of opposition including the Bates affidavit which was filed as part of the Opponent's reply evidence. However, this evidence which includes online searches and telephone calls conducted by Mr. Bates post-dates the material date for this ground of opposition such that the Opponent may not rely on it in support of the section 30(b) ground of opposition.

[15] The Opponent's evidence on its own is not sufficient to enable it to meet its evidential burden. However, the Opponent also relies on inconsistencies in the Applicant's evidence.

[16] The evidence relied upon by the Applicant in support of its claimed first use date is found in the Roy affidavit, namely an invoice showing sales of the Wares to a Canadian consumer dated April 28, 2005 (Roy affidavit, para 5 and Exhibit A); a sample label displaying the Mark (Roy affidavit, paras 6 and 11, Exhibits B and D) and yearly Canadian sales figures from 2005 to the date of the affidavit (Roy affidavit, para 13).

[17] The Opponent submits that this evidence was undermined on cross-examination when Mr. Roy (the Applicant's Vice President of Operations) was unable to confirm whether the

sample label attached to his affidavit as Exhibit B represented the style of label which was used at the time of the first use of the Mark. To this end, I reproduce the following exchange:

Q320 – You don't know what label was applied because you weren't aware of the product back then. Correct?

A320 – No. I have a label that says a certain size and flavour and an invoice that says a certain size and flavour. Whether it was the actual version of the label, I couldn't know for sure.

Q321 – But you swore to it in your affidavit even though you didn't know for sure. Is that correct?

A321 – I didn't witness the labels being put on the bottles back in 2005, no.

Q322 – Right.

A322 – I swore that that was the label that you use on QSE products.

Q323 – At a time when you don't know what the label was that you used on the QSE product. Correct?

A323 – Correct.

[18] This exchange demonstrates that Mr. Roy was not in a position to swear that the labels he attached as Exhibit B were the ones attached to the Wares at the claimed first use date.

[19] Also on the issue of product labels, Mr. Roy characterizes Exhibit D to his affidavit as being “a collection of labels on REAL MASS products sold by Body Plus since the date of first use” (see Q315-317). However, on cross-examination, it was established that Exhibit D was actually the same document as Exhibit B, mentioned above. Furthermore, Mr. Roy admitted that one of the images found in Exhibits B and D was actually an image of the Opponent's product, not the Applicant's product (this was admitted by the Applicant's agent prior to commencement of direct examination by the Opponent's agent). While the foregoing suggests that the Applicant's evidence preparation could have been better, it does not support a finding that the Applicant was not using the Mark at the claimed first use date.

[20] While the cross-examination of Mr. Roy does serve to create some uncertainty as to the appearance of the actual labels used at the claimed first use date, I am of the view that this is not

sufficient to create a clear inconsistency with the claimed first use date. Specifically, Mr. Roy's admissions on cross-examination did not establish that the Mark did not appear on the Wares at the first use date, rather simply that he was unable to swear that the sample labels provided were the exact labels used at that time.

[21] The Opponent raised a further issue arising on cross-examination. Specifically, the Opponent notes that in response to an undertaking given on cross-examination, the Opponent provided a binder full of invoices from 2005. The April 28, 2005 invoice was not included in the binder of invoices, rather the earliest invoice therein was dated May 3, 2005. In his affidavit, however, Mr. Roy swore to the existence of the April 28, 2005 invoice and provided a copy thereof. The mere fact that the binder of invoices provided does not include another copy of the April 28, 2005 invoice is therefore not sufficient evidence to establish that the April 28, 2005 sale did not occur.

[22] The Opponent submits that the above-noted defects in the Applicant's evidence are sufficient for it to meet its evidential burden under the non-compliance with section 30(b) ground of opposition. For the reasons set out above, I disagree, and I dismiss this ground of opposition accordingly.

#### *Non-compliance with section 30(i) of the Act*

[23] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. The Applicant has provided the necessary statement and this is not an exceptional case; the section 30(i) ground is accordingly dismissed.

#### Non-distinctiveness Ground of Opposition – sections 38(2)(d) and 2

[24] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its Wares from those of others throughout Canada [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd.* (1985), 4 CPR (3d) 272 (TMOB)],

there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness.

[25] Pursuant to its evidential burden, the Opponent is under an obligation to show that, as of the filing of the statement of opposition (October 25, 2010), its pleaded REAL MASS mark had become known sufficiently to negate the distinctiveness of the Mark [see *Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FC)].

[26] In his first affidavit, Mr. Spriggs states that True North Nutrition Ltd. (True North) is a distributor of the Opponent's weight gain supplement sold under the trade-mark REAL MASS. He states that True North had continuously sold the Opponent's REAL MASS weight gain supplement in Canada since April 2009 with sales amounting to over \$750,000.00. Mr. Spriggs states that the Opponent's REAL MASS weight gain products are sold across Canada through sport nutrition supplement retailers like GNC, Sport Nutrition Depot Canada, Popeye's Supplements Canada and Reflex. Mr. Spriggs also provides evidence that the REAL MASS mark is displayed on packaging for the Opponent's weight gain supplements and on associated invoices (Exhibits A and B to the first Spriggs affidavit). Mr. Spriggs also states that the Opponent's REAL MASS weight gain supplements have been advertised in True North's product catalogues, at trade shows and via the distribution of over 35,000 product samples since April 2009.

[27] Based on the foregoing, I am satisfied that the Opponent has established the requisite level of reputation for its REAL MASS trade-mark at the relevant date in order to satisfy its evidential burden under the non-distinctiveness ground of opposition.

[28] I must now determine whether the Applicant has satisfied its legal burden.

[29] 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.

[30] 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) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC).]

[31] This is a clear-cut case of confusion. The parties' marks are identical and the wares associated therewith are also identical. While the Mark may have been used for longer than the Opponent's, according to the evidence of record the Opponent's wares have been sold in greater quantities over a greater geographic range such that the Opponent's Mark has become known to a greater extent than the Mark.

[32] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, I find that the fact that the parties' marks are identical and cover identical wares overwhelmingly favours the Opponent. The other factors do not significantly favour either party. As a result, the Applicant has failed to satisfy its onus of establishing on a balance of probabilities that there is no reasonable likelihood of confusion between the Mark and the Opponent's REAL MASS trademark. Based on the foregoing, the non-distinctiveness ground of opposition is successful.

#### Disposition

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

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Andrea Flewelling  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office