



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

**Citation: 2015 TMOB 115**  
**Date of Decision: 2015-06-26**

**IN THE MATTER OF AN OPPOSITION  
by Normerica Inc. to application  
No. 1,541,813 for the trade-mark  
VITALITY in the name of Arthur  
Dogswell, L.L.C.**

The Record

[1] Arthur Dogswell, L.L.C. (the Applicant) filed application No. 1,541,813 for the Mark VITALITY (the Mark) based on:

- (1) use of the Mark in Canada in association with
  - (a) Pet treats excluding all kinds of horse feed and/or livestock products; dog treats excluding all kinds of horse feed and/or livestock products, since at least as early as August 2005;
  - (b) Pet food excluding all kinds of horse feed and/or livestock products; dog food excluding all kinds of horse feed and/or livestock products since at least as early as June 2008.
- (2) use and registration of the Mark in association with dog food excluding all kinds of horse feed and/or livestock products; dog treats excluding all kinds of horse feed and/or livestock products in the United States of America.

[2] The application for the Mark was advertised on February 6, 2013. Normerica Inc. (the Opponent) opposes the application based on the following grounds of opposition set out under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act): non-entitlement under sections 16(1)(a) and 16(1)(b) of the Act, and non-registrability under section 12(1)(d) of the Act. The determinative issue in this proceeding is the likelihood of confusion between the Mark and the Opponent's mark VITALIFE MADE WITH LOVE. NATURALLY, registration No. 666,245, previously used and registered in association with dog food snacks.

[3] The Applicant filed a counter statement on August 23, 2013, denying each of the grounds of opposition.

[4] In support of its opposition, the Opponent filed two affidavits of Suganthy Sriskandarajah (dated December 20, 2013 and March 7, 2014). Mr. Sriskandarajah was not cross-examined.

[5] As its evidence, the Applicant filed the affidavit of Lynda Palmer. Ms Palmer was not cross-examined.

[6] Both parties filed a written argument. Neither party requested an oral hearing.

#### 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. There is however an initial 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 [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

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

- Section 38(2)(b)/Section 12(1)(d) - 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)]; and
- Section 38(2)(c)/Section 16(1)(a) and (b) – the Applicant’s dates of first use.

### Ground of Opposition Summarily Dismissed

#### Non-entitlement – Section 16(1)(b)

[9] Section 16(1)(b) of the Act requires the Opponent to have filed a trade-mark application in Canada prior to the Applicant’s claimed dates of first use of August 2005 and June 2008. While the Opponent’s registration No. TMA666,245 was filed on June 1, 2005, section 16(4) requires that an application relied upon pursuant to section 16 be pending at the date of advertisement of the Applicant’s application (i.e. February 6, 2013) [*Governor and Co of Adventurers of England trading into Hudson’s Bay v Kmart Canada Ltd* (1997), 76 CPR (3d) 526 (TMOB) at p 528]. Given that the Opponent’s application issued to registration on June 19, 2006, it was not pending as of the date of advertisement of the Mark and therefore cannot support a section 16(1)(b) ground of opposition. Accordingly, this ground of opposition is dismissed.

### Remaining Grounds of Opposition

#### Main Issue

[10] As noted above, the two remaining grounds of opposition are based on the allegation that there is a likelihood of confusion between the Mark and the Opponent’s mark. The material date with respect to the registrability ground is the latest, being today’s date. I will therefore address that ground first.

#### Non-registrability – Section 12(1)(d)

[11] I have exercised the Registrar’s discretion to confirm that the Opponent’s registration is in good standing as of today’s date and, as such, the Opponent has met its burden under this ground

[*Quaker Oats Co of Canada Ltd/Cie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410, (TMOB) at 411-412].

[12] The legal onus is on the Applicant to show that there would be no reasonable likelihood of confusion between the Mark and the Opponent's mark, within the meaning of section 6(2) of the Act. 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. In the instant case, the question posed by section 6(2) is whether there would be confusion of the Applicant's goods provided under the Mark as emanating from or sponsored by or approved by the Opponent [*Glen-Warren Productions Ltd v Gertex Hosiery Ltd* (1990), 29 CPR (3d) 7 (FCTD) at 12].

*test for confusion*

[13] 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 goods, 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.

[14] This list of enumerated factors is not exhaustive and it is not necessary to give each one of them equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); and *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC)]. In *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 92 CPR (4th) 361 (SCC), the Supreme Court of Canada clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks.

*section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known*

[15] The Mark is not inherently strong. In this regard, it is comprised of a common dictionary word which means the state of being lively or energetic. As such, it is suggestive of a character or quality of the Applicant's dog and pet treats and pet food, i.e. that they provide energy to pets.

[16] The Opponent's mark also suggests the character or quality of the goods, i.e. that the Opponent's dog food snacks are made from natural ingredients. However, in view that the Opponent's mark also includes the word VITALIFE which is a coined word, I consider it to be inherently stronger than the Mark.

[17] The Opponent's mark has acquired distinctiveness through promotion and use. The first affidavit of Mr. Sriskandarajah, Executive Vice-President of the Opponent, evidences significant use of the Opponent's mark in Canada since 2005. The Opponent's mark appears on the Opponent's products, on the shelves of retailers and on the Opponent's own branded cardboard purchase display [Exhibit J, K and L]. Between June 2005 and December 2013, total annual revenues for the Opponent's "VITALIFE products" were over \$41 million dollars [para 20]. Mr. Sriskandarajah does not clearly identify all of the products or trade-marks that comprise the VITALIFE products but I am prepared to infer that there have been considerable sales of goods in association with the Opponent's registered trade-mark from the exhibits that have been filed.

[18] Mr. Sriskandarajah further states that the Opponent's mark has been extensively advertised and promoted. In addition to having been displayed in magazine advertisements since 2012, the Opponent's mark has been featured in television advertisements since 2013, on the Opponent's website since 2005 and through various customer and trade-shows in the pet industry across Canada since 2008 where the Opponent's products were displayed at and sold from its own booth [Exhibits O, P, Q, R, S, T and U].

[19] From the evidence furnished, I am satisfied that the Opponent's mark has become known to a considerable extent in Canada. There being no evidence of use or making known of the Mark from the Applicant, I must conclude that the Mark has not become known at all in Canada.

[20] This factor therefore favours the Opponent.

*section 6(5)(b) - the length of time each trade-mark has been in use*

[21] As set out in more detail above, the Opponent has shown use of its mark in association with its registered goods since at least as early as 2005. The Applicant has not shown any use of the Mark but its claimed dates of first use are as follows: August 2005 (for its pet and dog treats), and June 30, 2008 (for its pet food and dog food). I therefore do not find that this factor significantly favours either party.

*sections 6(5)(c) and (d) - the nature of the goods, services or business; the nature of the trade*

[22] The Applicant's dog food and dog treats are virtually the same as the Opponent's dog food snacks and the Applicant's pet food and pet treats clearly overlap with the Opponent's goods. In the absence of evidence to the contrary, I think it is reasonable to assume that the parties' channels of trade would also overlap.

*section 6(5)(e) - the degree of resemblance between the marks in appearance, sound and ideas suggested*

[23] The law is clear that when assessing confusion marks must be considered in their entirety [*British Drug Houses Ltd v Battle Pharmaceuticals*, [1944] Ex CR 239, at 251, affirmed [1946] SCR 50 and *United States Polo Assn v Polo Ralph Lauren Corp* (2000), 9 CPR (4th) 51 at para 18, aff'd [2000] FCJ No 1472 (CA)]. It has also been held that the first portion of a trade-mark is usually considered more important for assessing the likelihood of confusion [*Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 at 188 (FCTD)].

[24] More recently, however, the Supreme Court advised in *Masterpiece* that when comparing marks one should begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique. In this regard, I refer to the following summary of my colleague Member dePaulsen who summarized the approach taken by the Supreme Court in *Masterpiece* in her decision in *Heather Ruth McDowell v Laverana GmbH & Co.* KG 2015 TMOB 56 at para. 17:

In *Masterpiece*, *supra*, the Supreme Court of Canada advises that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-

marks that is particularly striking or unique [para 64]. In that case, at issue was the trade-name used by Masterpiece, Inc, MASTERPIECE, and its trade-marks MASTERPIECE THE ART OF LIVING and MASTERPIECE THE ART OF RETIREMENT LIVING, versus Alavida's trade-mark - MASTERPIECE LIVING. Mr. Justice Rothstein reasoned that MASTERPIECE was the striking or unique aspect of each trade-name/trade-mark which led to a finding of confusion. It must be observed, however, that in these trade-marks there is no striking element other than MASTERPIECE; rather the remaining words are suggestive of retirement residences.

[25] In the present case, the marks at issue are VITALITY and VITALIFE MADE WITH LOVE. NATURALLY. In my view, the most striking or unique aspect of the Opponent's mark is the word VITALIFE for three reasons: it is a coined word, it is in the dominant first position of the Opponent's mark and the remaining words of the Opponent's mark are the words MADE WITH LOVE. NATURALLY which are laudatory and are also suggestive of the character of the Opponent's dog food. Therefore, in view of the similarities between this most striking feature of the Opponent's Mark and the Applicant's Mark, I consider there to be a fair degree of resemblance between the marks in appearance and sound.

[26] I agree with the Applicant, however, that the marks are distinguishable in terms of ideas suggested. The Mark suggests health and energy while the Opponent's mark suggests that it has been created with love and care, and is from natural sources.

### *Surrounding Circumstances*

### *State of the Register Evidence*

[27] The Applicant filed as its evidence the affidavit of Ms. Palmer, an independent trade-mark searcher. Her affidavit attaches the results of a search she performed for active registered trade-marks including the letters VITA for use in association with food for animals and pets.

[28] 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); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); *Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)]. Ms. Palmer's search identified about 15 registered marks standing in the name

of 10 different owners which include the letters VITA for dog or pet food or treats. In my view, this evidence is sufficient to support the drawing of an inference that such marks are common in the marketplace in association with goods similar to the parties' goods in this proceeding.

*Manner in which the Opponent's mark has been used in the marketplace*

[29] As a further surrounding circumstance, I have considered how the Opponent's mark has been used to date in the marketplace. I reproduce below copies of some of the exhibits attached to Mr. Sriskandarajah's first affidavit showing an example of how the Opponent's products are displayed at the PetSmart pet store and also showing an example of the Opponent's packaging.





[30] Although it is difficult to view from the reproductions above, in both examples the Opponent's mark VITALIFE appears in large letters and in a different font above the words MADE WITH LOVE, NATURALLY. In my view, although the Opponent's mark as a whole incorporates several other words, it is the first portion of the mark, namely the word VITALIFE, which attracts a viewer's attention in the manner in which it is used in the marketplace. I also note that this is how the Opponent's mark is abbreviated on invoices. In addition, given the many additional non-distinctive words that form the remainder of the Opponent's mark, it would seem reasonable that consumers of the Opponent's goods would abbreviate the Opponent's mark naturally to VITALIFE. In my view, since the Opponent's mark as used in the marketplace emphasizes the word VITALIFE, it is not likely that consumers would consider the other portions of the Opponent's mark to distinguish it from the Mark.

*Conclusion re likelihood of confusion*

[31] As indicated above, section 6(2) of the Act is not concerned with the confusion of the marks themselves, but confusion of goods from one source as being from another source. The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees VITALITY on the Applicant's pet and dog food and treats, at a time when he or she has no more than an imperfect recollection of the Opponent's mark used in association with similar goods, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot, supra*, at para 20]. The question posed is whether this individual would be likely to conclude that the Applicant's goods are manufactured, sold, performed or otherwise authorized by the Opponent.

[32] While I acknowledge that the marks at issue are not identical, and that consumers may be accustomed to distinguishing between VITA prefixed marks for similar goods in the marketplace, in view that the Opponent's mark has acquired distinctiveness with respect to its goods, and the parties' goods and channels of trade are basically the same, I find that the balance of probabilities with respect to the issue of confusion weighs equally for both parties. As the legal onus is on the Applicant, I must decide against the Applicant and allow the ground of opposition based on section 12(1)(d).

[33] I would add that had the Applicant been able to evidence that the Mark had acquired distinctiveness since the claimed dates of first use, and that the parties' marks co-existed in the marketplace in similar geographic locations without instances of actual confusion, then the outcome of this ground may have been different.

Non-entitlement – Section 16(1)(a)

[34] In order to meet its evidentiary burden under this ground of opposition, the Opponent has to show that as of the alleged dates of first use of the Mark in Canada, the Opponent's trademark had been previously used in Canada and had not been abandoned as of the date of advertisement of the Applicant's application in the *Trade-marks Journal* [section 16(5) of the Act]. As per my review of the Sriskandarajah affidavit, the Opponent has met this burden.

[35] Many of my findings under the section 12(1)(d) ground of opposition are also applicable to this ground. There are, however, two significant differences between this ground and the section 12(1)(d) ground. In addition to the Opponent's mark having acquired less distinctiveness as of the earlier dates of August 2005 and June 2008, there is very little evidence regarding the manner of use of the Opponent's mark in the marketplace as of the earlier dates. These differences, in my view, are sufficient to tip the balance of probabilities in favour of the Applicant. I therefore find that under this ground of opposition the Applicant has discharged its burden of showing, on a balance of probabilities, that there would be no reasonable likelihood of confusion between the Mark and the Opponent's mark as of the earlier material dates. This ground of opposition is therefore dismissed.

Disposition

[36] Having regard to the above, and 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.

---

Cindy R. Folz  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office