

IN THE MATTER OF AN OPPOSITION by Frank T. Ross & Sons (1962) Limited to application No. 738,424 for the trade-mark NATURES PRESCRIPTION & Design filed by London Drugs Limited

On October 4, 1993, the applicant, London Drugs Limited, filed an application to register the trade-mark NATURES PRESCRIPTION & Design, a representation of which appears below, based upon use of the trade-mark in Canada since at least as early as December, 1992 in association with:

“Vitamins and minerals; soap, namely toilet, deodorant, body, facial and liquid soaps.”

The applicant disclaimed the right to the exclusive use of the word PRESCRIPTION apart from its trade-mark.



The present application was advertised for opposition purposes in the *Trade-marks Journal* of February 1, 1995 and the opponent, Frank T. Ross & Sons (1962) Limited, filed a statement of opposition on March 24, 1995, a copy of which was forwarded to the applicant on June 9, 1995.

The opponent alleged the following grounds of opposition in its statement of opposition:

- (a) The present application does not comply with Section 30 of the *Trade-marks Act* in that the applicant does not have the genuine intention or ability to use its trade-mark on all of the wares set out in the application within the time that is likely to be allowed by the Trade-marks Office;
- (b) The trade-mark NATURES PRESCRIPTION & Design is not registrable in view of Paragraph 12(1)(d) of the *Trade-marks Act* in view of the opponent's prior use and registration of the trade-mark NATURE CLEAN, registration No. 198,880, covering shampoos, detergents, washing compounds and cosmetic products;
- (c) The applicant is not the person entitled to registration in view of the prior use and registration of the trade-mark NATURE CLEAN;
- (d) The trade-mark NATURES PRESCRIPTION & Design is not distinctive of the applicant's wares in view of the opponent's prior use and registration of the trade-mark NATURE CLEAN.

The opponent filed as its evidence the affidavit of Bernard F.J. Ross, President of the opponent, while the applicant submitted as its evidence the affidavits of Michael Godwin, Norman

Hoff, Jennifer C. Newcombe and Jehangir Choksi. Both parties filed a written argument and neither party requested an oral hearing.

As its first ground, the opponent alleged that the present application does not comply with Section 30 of the *Trade-marks Act* in that the applicant does not have the genuine intention or ability to use its trade-mark on all of the wares set out in the application within the time that is likely to be allowed by the Trade-marks Office. While the legal burden is upon the applicant to show that its application complies with Section 30 of the *Trade-marks Act*, there is an initial evidential burden on the opponent in respect of its Section 30 ground [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330]. To meet the evidentiary burden upon it in relation to a particular issue, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. As no evidence has been adduced by the opponent in respect of its Section 30 ground, the opponent has failed to meet the evidentiary burden upon it. I have therefore dismissed this ground of opposition.

The remaining grounds of opposition are based on allegations of confusion between the applicant's trade-mark NATURES PRESCRIPTION & Design and the opponent's trade-mark NATURE CLEAN. Accordingly, the determination of the issue of confusion will resolve all the remaining grounds in this proceeding. In assessing whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Subsection 6(5) of the *Trade-marks Act*. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the material date(s). With respect to the ground of opposition based on Section 12(1)(d) of the *Trade-marks Act*, the material date is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)]. Further, the material date in respect of the non-entitlement ground of opposition is the applicant's claimed date of first use [December 31, 1992] while the material date for considering the non-distinctiveness issue is the date of opposition [March 24, 1995].

Paragraph 6(5)(a) of the *Act* requires that the Registrar consider the inherent distinctiveness of the trade-marks at issue. In this regard, the opponent's trade-mark NATURE CLEAN possesses little inherent distinctiveness in that the word CLEAN is descriptive of the function of the opponent's wares while the word NATURE when combined with the word CLEAN might suggest to some consumers that the opponent's wares contain natural ingredients as opposed to artificial ingredients or ingredients which are harmful to the environment [see *Frank T. Ross & Sons (1962) Limited v. Belvedere International Inc.*, 74 C.P.R. (3d) 243, at p. 246]. The applicant's trade-mark NATURES PRESCRIPTION & Design possesses some measure of inherent distinctiveness when considered in its entirety although the word NATURES may suggest to some consumers that the applicant's wares are formulated from natural ingredients.

The Ross affidavit establishes that the mark NATURE CLEAN has become known in Canada in association with shampoo, and cleaning and personal care products with annual sales increasing from \$65,000 in 1974 to approximately \$400,000 as of the date of the Ross affidavit [April 19, 1996]. As pointed out by Mr. Ross in paragraph 9 of his affidavit, he is unable to provide detailed sales figures as the opponent sells many different products and “does not keep separate accounts giving separate figures in respect of NATURE CLEAN”.

The applicant submitted the affidavit of Norman Hoff, Vice-President, Finance of the applicant, in support of its application. The Hoff affidavit establishes that the applicant is the registered owner of the trade-mark NATURES PRESCRIPTION, registration No. 317,859, dated August 29, 1986, as applied to “vitamins” and the trade-mark NATURES PRESCRIPTION, registration No. 350,647, dated January 27, 1989, as applied to “shampoo, conditioner, skin care lotion, baby oil and baby shampoo”. However, as pointed out by the hearing officer in *Coronet-Werke Heinrich Schlerf GmbH v. Produits Menagers Coronet Inc.*, 4 C.P.R. (3d) 108, at p. 115, Section 19 of the *Trade-marks Act* does not give the owner of a registration the automatic right to obtain any further registrations no matter how closely they may be related to the original registration [see also *Groupe Lavo Inc. v. Proctor & Gamble Inc.*, 32 C.P.R. (3d) 533, at p. 538]. While the decision of the hearing officer was reversed on appeal [see *Produits Menagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH*, 10 C.P.R. (3d) 482], it was on the basis of new evidence

filed on appeal that the applicant had used its previously registered trade-mark in Canada. As a result, I do not consider that the existence of the applicant's registrations is of any relevance to the issues in this opposition.

In paragraphs 6 to 9 of his affidavit, Mr. Hoff sets out the annual volume and dollar value of sales in Canada of the applicant's NATURES PRESCRIPTION shampoo, baby oil, conditioner, lotion, bath foam, vitamins, minerals and soap from 1990 to 1996, the approximate total dollar value being in excess of \$9,000,000. Further, according to Mr. Hoff, he is unaware of any instances of confusion between the trade-marks of the parties. While the Hoff affidavit establishes that the applicant's trade-mark NATURES PRESCRIPTION has become fairly well known in British Columbia and Alberta, the Hoff affidavit is unclear as to the extent to which the design trade-mark sought to be registered has become known in Canada in association with the wares covered in the present application. I have concluded therefore that the extent to which the trade-marks at issue have become known must be considered as favouring the opponent. Furthermore, the length of time the trade-marks NATURES PRESCRIPTION & Design and NATURE CLEAN have been in use weighs in the opponent's favour in that it commenced use of its trade-mark NATURE CLEAN in 1974 whereas the applicant claims that it commenced use of its trade-mark NATURES PRESCRIPTION & Design in December of 1992.

Registration No. 198,880 for the trade-mark NATURE CLEAN covers *inter alia* shampoos and cosmetic products which differ specifically from the wares covered in the present application although shampoos and cosmetics and the applicant's toilet, deodorant, body, facial and liquid soaps are related to personal care. Further, I would expect that the channels of trade associated with the wares of the parties would or could overlap, bearing in mind that there is no restriction in the applicant's statements of wares which limit the distribution of its wares in any manner.

As to the degree of resemblance between the trade-marks of the parties, I consider there to be some similarity in appearance and in sounding between the applicant's trade-mark NATURES PRESCRIPTION & Design and the opponent's trade-mark NATURE CLEAN. Further, both trade-marks suggest the idea of nature or something which is natural.

As a further surrounding circumstance in respect of the issue of confusion, the applicant sought to rely upon evidence of the state of the register adduced by way of the Godwin affidavit. In particular, Mr. Godwin has annexed to his affidavit photocopies of more than forty registered trade-marks including the words NATURE, NATURE'S or NATURES covering hair care products including shampoos, skin care and other personal care products, and soaps. Given the number of trade-marks disclosed by the search, I am prepared to conclude that at least some of these trade-marks are in use in Canada.

The applicant also submitted marketplace evidence by way of the Newcombe and Choksi affidavits. These affidavits establish *inter alia* use of the following: CREME OF NATURE shampoo; NATURE MADE potassium tablets; NATURE PERFECT herbal and vitamin soap; NATURE'S FAMILY moisturizing lotion; NATURE'S GATE moisturizing lotion; LEMEI NATURE'S CARE moisturizing lotion; and NATURE PERFECT shampoo.

The applicant has submitted in its written argument that the absence of evidence of instances of actual confusion between the trade-marks at issue is a relevant surrounding circumstance in respect of the issue of confusion. In this regard, the applicant has evidenced in excess of \$9,000,000 in sales of NATURES PRESCRIPTION shampoo, baby oil, conditioner, lotion, bath foam, vitamins, minerals and soap from 1990 to 1996 in Canada, as well as advertising and promotion of its NATURES PRESCRIPTION personal care products. Further, the opponent has furnished evidence of use, advertising and promotion of its trade-mark NATURE CLEAN since 1974. It would appear, therefore, that the products of both parties bearing their respective trade-marks have been brought to the attention of Canadian consumers for at least six years without evidence of any confusion between the trade-marks at issue. However, bearing in mind that there does not appear to have been a direct overlap in the channels of trade of the parties, I have accorded only limited weight to this surrounding circumstance.

The opponent in its statement of opposition, as well as in its evidence, pointed out that it has opposed twenty-one trade-mark applications for registration of trade-marks including the word NATURE or NATURE'S and that the opponent was successful in its oppositions to registration of

the trade-marks: NATURE FRESH, application No. 451,725; NATURE'S WISDOM, application No. 675,341; and NATURE'S FRIEND, application No. 652,868 while the remaining oppositions resulted in the applications being abandoned, withdrawn or amended or are yet pending before the Registrar of Trade-marks..

In *Frank T. Ross & Sons (1962) Ltd. v. Nature Fresh Products Ltd.*, 1 C.P.R. (3d) 180], the Board refused an application for registration of the trade-mark NATURE FRESH, the Hearing Officer concluding that the applicant had failed to discharge the legal burden upon it in respect of the issue of confusion in view of the opponent's registration for the trade-mark NATURE CLEAN in that the words FRESH and CLEAN conveyed the same meaning. Likewise, in *Frank T. Ross & Sons (1962) Ltd. v. Hello Cosmetics Inc.*, 53 C.P.R. (3d) 124, and *Frank T. Ross & Sons (1962) Ltd. v. Luxo Laboratories Inc.*, 61 C.P.R. (3d) 410, the Board refused applications to register the trade-marks NATURE'S WISDOM and NATURE'S PROMISE in view of the opponent's registered trade-mark NATURE CLEAN, the Board Member concluding in each instance that the applicant had failed to discharge the legal burden upon it in respect of the Section 12(1)(d) ground of opposition.

On the other hand, in *Frank T. Ross & Sons (1962) Ltd. v. London Drugs Ltd.*, 57 C.P.R. (3d) 438, the Board rendered a split decision, concluding in part that the applicant had met the legal burden upon it in respect of the issue of confusion between its trade-mark NATURE'S FRIEND as applied *inter alia* to hair conditioners, bath products and soap and the opponent's registered trade-mark NATURE CLEAN. In that case, the applicant adduced evidence of the state of the register and state of the marketplace from which Board Member Martin concluded as follows:

Ms. Côté conducted a computerized search of the trade-marks register with a view to locating trade-marks which include the word "nature." The search results appended to her affidavit do not provide complete particulars of the entries located and they must therefore be given diminished weight. Nevertheless, from a review of those results, I am able to conclude that, as of the material time, there were over thirty registrations on the register for trade-marks incorporating the word "nature" and covering wares related to those at issue in the present case. However, most of those registrations cover shampoo or similar wares. Thus, I am able to conclude that, as of the material time, at least some of those registrations were in active use and that consumers would therefore have been accustomed to seeing trade-marks incorporating the word "nature", at least for shampoo or related wares.

The applicant also sought to rely on state of the marketplace evidence by way of the Fitzpatrick and Doxsee affidavits. Both Ms. Fitzpatrick and Ms. Doxsee effected purchases in October of 1992 of products bearing trade-marks incorporating

the word "nature", Ms. Fitzpatrick's purchases having been made in Vancouver and Ms. Doxsee's in Toronto. Most of the products purchased are not relevant to the wares at issue in the present case although some of the products were shampoo, conditioner or bath products. Such evidence suggests that, in October of 1992, it was not uncommon for traders to use trade-marks incorporating the word "nature" for wares such as shampoo, conditioner and bath products. To a much lesser extent, I can also infer that such evidence reflects the state of the marketplace as of the material time. At the very least, such evidence corroborates the conclusion which follows from the applicant's state of the register evidence.

More recently, however, in *Frank T. Ross & Sons (1962) Limited v. Belvedere International Inc.*, referred to above, I rejected an opposition by the present opponent to registration of the trade-mark NATURES BASICS covering various hair care products. At page 250 of the reported decision, I commented as follows:

Having regard to the above and, in particular, to the applicant's evidence which establishes that it is common in the hair care and skin care product trade to adopt and use trade-marks including the words NATURE or NATURE'S, I have concluded that the applicant has met the legal burden upon it in respect of the issue of confusion in this proceeding. I have therefore rejected the remaining grounds of opposition relied upon by the opponent pursuant to Subsection 38(8) of the *Trade-marks Act*.

In the present case, the wares of the parties do differ and the applicant's evidence points to there being other trade-marks in the marketplace including the word NATURE or NATURE'S as applied to shampoo, skin lotions, and other personal care products. Furthermore, the absence of evidence of instances of actual confusion does at least support the conclusion that there would be no reasonable likelihood of confusion between the trade-marks at issue. I have concluded, therefore, that the applicant has met the legal burden upon it in respect of the issue of confusion and have therefore rejected the remaining grounds of opposition.

Having been delegated by the Registrar of Trade-marks by virtue of Subsection 63(3) of the *Trade-marks Act*, I reject the opponent's opposition pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC THIS 12th DAY OF FEBRUARY, 1998.

G.W.Partington,
Chairperson,
Trade-marks Opposition Board.