

**IN THE MATTER OF AN OPPOSITION by
Unifeed Limited to application No. 1,014,855
for the trade-mark EQUI-SI
filed by MexAmeriCan Trading Corporation**

On May 10, 1999, the applicant, MexAmeriCan Trading Corporation, filed an application to register the trade-mark EQUI-SI. The application is based upon proposed use of the trade-mark in Canada in association with the following wares:

Bioavailable silicon for horses; bioavailable essential silicon for horses; silicon nutrients for horses; dietary equine silicon products, namely, additives, chemical compounds, concentrates, ingredients, and supplements; dietary zeolite for horses; dietary sodium zeolite A for horses; dietary sodium aluminosilicate for horses; dietary hydrated sodium aluminosilicate for horses; dietary synthetic sodium aluminosilicate for horses; dietary sodium silico aluminate for horses; and silicic acid, monosilicic acid, and orthosilicic acid additives, concentrates, ingredients, and supplements for horses.

The application was advertised for opposition purposes in the Trade-marks Journal of October 2, 2002. On November 8, 2002, Unifeed Limited, the opponent, filed a statement of opposition against the application. The applicant filed and served a counter statement.

As part of its rule 41 evidence, the opponent filed the affidavit of Johanna Coutts, a lawyer. It simultaneously requested a further extension of time for the purpose of filing an additional affidavit, based on what it categorized as “exceptional circumstances”, namely that “due to unanticipated courier delays and difficulties, we have not received the executed affidavit in time for today’s due date, but expect to receive it shortly.” Although the letter as originally typed

requested a one-month extension, someone has hand-written in that it should be a one-day extension. In any event, the next day the opponent filed the affidavit of John R. Dakers, the opponent's Director of Finance and Livestock Programs. The applicant objected to the granting of the extension on the basis that the initial extension provided that "no request for an extension will be considered unless the other party consents or exceptional circumstances are shown." In addition, it pointed out that the affidavit of Ms. Coutts had not been properly served on it, as it was received by regular mail.

On August 25, 2003, the applicant filed the affidavit of its President, Albert William Basile as rule 42 evidence.

On September 29, 2003, Board Member Myer Herzig granted the opponent a one-day extension of time for the filing of Mr. Dakers' affidavit and stated that no consequences would attach to the improper service of the Coutts affidavit because the failure to comply with rule 37 of the *Trade-marks Regulations* did not appear to have unduly prejudiced the applicant. On May 12, 2004, notice was given of the deadline for the parties to file written arguments.

Written arguments were filed by both parties. An oral hearing was not requested.

The applicant submits that it has been prejudiced by what it calls "the fact that we have been denied the right to file a reply to the late-filed affidavit evidence of John R. Dakers", the applicant being of the view that the Board ought to have automatically granted an extension to the applicant for the purpose of filing rebuttal evidence. However, I do not believe that the

applicant was so prejudiced because pursuant to rule 44, the applicant could have requested leave to file further evidence.

Grounds of Opposition

Five grounds of opposition have been pleaded:

1. the application does not comply with subsection 30(i) of the *Trade-marks Act* in that the applicant could not have been satisfied that it was entitled to use the applied-for mark because the applied-for mark is confusingly similar to the opponent's previously used and registered trade-mark EQUISINE;
2. the applied-for mark is not registrable pursuant to paragraph 12(1)(b) of the Act;
3. the applied-for mark is not registrable pursuant to paragraph 12(1)(d) of the Act because it is confusing with EQUISINE registered under No. TMA450,331;
4. the applicant is not the person entitled to register the mark under paragraph 16(3)(a) of the Act because the mark is confusing with the opponent's mark EQUISINE that has been previously used and made known by the opponent in Canada; and
5. the applied-for mark is not distinctive in that it is not adapted to distinguish the applicant's wares from the wares of others, including those of the opponent.

Onus

Although the applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act*, there is 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. [see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)]

Material Dates

The material dates with respect to the grounds of opposition are as follows: section 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469 at 475]; paragraph 12(1)(b) - the filing date of the application [see *Zorti Investments Inc. v. Party City Corporation* (2004), 36 C.P.R. (4th) 90 (T.M.O.B.); *Havana Club Holdings S.A. v. Bacardi & Company Limited* (2004), 35 C.P.R. (4th) 541 (T.M.O.B.); *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)]; paragraph 12(1)(d) - 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.)]; paragraph 16(3)(a) - the date of filing of the application; non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.) at 324].

Opponent's Evidence

The most pertinent information provided by Ms. Coutts consists of dictionary definitions of the words “equine” and “si”. “Equine” is defined as an adjective meaning “of, pertaining to, or resembling a horse”. “Si” is defined, *inter alia*, as the chemical symbol for silicon.

Mr. Dakers states that his company “has used the trade-mark EQUISINE continuously in association with horse feeds in Canada since 1995.” He provides a “sample feed bag”, a “sample product application guide” and “sample feed tags”. The latter two items bear the name of EQ Products, which Mr. Dakers has attested is the name of a division of the opponent. However, the feed bag bears only the name Manyan Inc. Mr. Dakers has made no mention of this company in his affidavit and I can only conclude that the appearance of its name on the actual bags that

contain the EQUISINE feed could result in consumers believing that Manyan Inc. is the source of the wares. This undermines the distinctiveness of the trade-mark EQUISINE in the hands of the opponent.

Mr. Dakers does state that “Unifeed retains control over the quality of feeds manufactured and sold under the mark EQUISINE by its EQ products division”, but that is insufficient for me to conclude that any use by Manyan Inc. accrues to the benefit of the opponent. If the opponent wished to rely on the use of the trade-mark EQUISINE by Manyan Inc., it had to establish that such use was under licence from it in accordance with the provisions of subsection 50(1) of the *Trade-marks Act*.

Applicant’s Evidence

Mr. Basile explains that he “created the trade-mark EQUI-SI because it is phonetically easy to pronounce in all three of the official languages that are used by the signatory countries to the *North American Free Trade Agreement*.” He points out that “si” means “yes” in French and Spanish and he provides various comments on Ms. Coutts’ evidence.

Subsection 30(i) Ground of Opposition

The first ground of opposition fails because it has not been sufficiently pleaded. The opponent has not claimed that the applicant was aware of the opponent’s alleged prior rights. Even if the applicant had been aware of the opponent’s trade-mark as of the relevant date, such a fact is not inconsistent with the statement that the applicant was satisfied that it was entitled to use the

applied-for trade-mark on the basis that its trade-mark was not confusing with the opponent's trade-mark.

Paragraph 12(1)(b) Ground of Opposition

The opponent pleads that EQUI is very similar to the word EQUINE, which means “of, relating to, or characteristic of a horse” and that SI is a standard abbreviation for the element silicon. However those allegations do not result in the mark EQUI-SI being clearly descriptive of the applicant's wares. “Clearly”, in paragraph 12(1)(b), means “easy to understand, self-evident or plain”. [*Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968), 55 C.P.R. 29 at 34] In determining whether a trade-mark is descriptive, the mark must not be dissected into its component elements and carefully analyzed, but rather must be considered in its entirety as a matter of immediate impression. “The decision that a mark is clearly descriptive is one of immediate impression; it must not be based on research into the meaning of words.” [*Wool Bureau of Canada Ltd. v. Registrar of Trade Marks* (1978), 40 C.P.R. (2d) 25 (F.C.T.D.) at 27]

The second ground of opposition therefore fails.

Paragraph 12(1)(d) Ground of Opposition

The third ground of opposition pleads that EQUI-SI is confusing with the opponent's registered trade-mark EQUISINE. The opponent has not provided evidence of its registration but the Registrar does have discretion to check the register in order to confirm the existence of the registration relied upon by the opponent [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)]. I have exercised

this discretion and confirm that EQUISINE is currently registered in the name of the opponent for use in association with “horse feeds” under No. TMA450331. I note that the registration was initially owned by United Grain Growers Limited, but was assigned to the opponent on September 9, 1999. This raises some doubt about Mr. Dakers’ statement that Unifeed Limited has used the mark continuously since 1995.

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in subsection 6(5) of the Act. Those factors specifically set out in subsection 6(5) are: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, 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. The weight to be given to each relevant factor may vary, depending on the circumstances [see *Clorox Co. v. Sears Canada Inc.* (1992), 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

I consider each of the marks to have the same degree of inherent distinctiveness, given that both begin with two syllables that are somewhat suggestive of horses. I conclude that neither mark has acquired distinctiveness in the hands of its owner; the applicant’s because it has not evidenced any use of its mark and the opponent’s because the use that it has evidenced appears to accrue to the benefit of another party.

I also do not consider the length of time that each mark has been used to favour either party. It is true that the opponent's registration refers to use as of 1995, but contrary to Mr. Dakers' statement, the registration refers to use by the opponent's predecessor, not the opponent. (I note that Mr. Dakers has been an employee of the opponent since several years before the assignment of the mark to it in 1999). Moreover, the opponent's evidence shows use of the mark by a party other than the opponent.

The wares of both parties consist of something that is fed to horses, but the opponent's registered wares are stated to be "horse feed", which distinguishes its wares somewhat from the applicant's additives, concentrates, ingredients, and supplements. However, Mr. Dakers attests that the opponent also sells supplements under its EQUISINE trade-mark.

It is possible that the applicant's wares are intended to be sold to companies that produce horse feed, as opposed to directly to horse owners, but given that there is no evidence of that, it seems fairer to assume that the parties' channels of trade overlap.

Although the first component of a mark is often considered more important for the purpose of distinction, when that portion is a suggestive word, the significance of the first component decreases [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.); *Phantom Industries Inc. v. Sara Lee Corp.* (2000), 8 C.P.R. (4th) 109 (T.M.O.B.)]. In the present case, this means that the significance of the common first portion EQUI is diminished because it is suggestive of horses through its suggestion of the word

“equine”. Although the applicant has pointed out that “equi” is a prefix defined as “a combining word meaning ‘equal’”, given the nature of both parties’ wares, it seems more likely that consumers would interpret EQUI in these marks as referring to horses.

There is a considerable degree of resemblance between EQUI-SI and EQUISINE when considered visually. However, the hyphen does serve to set the last syllable of the applicant’s mark, SI, apart from its first syllable, EQUI.

It is hard to know how the opponent’s invented mark would be pronounced. For example, I am uncertain if the last syllable would be pronounced so as to rhyme with “dine” or with “seen”. The opponent’s position is that its mark is pronounced “equi-sign”.

Regarding the applicant’s mark, if consumers see the last syllable as the French word “si”, it will be pronounced with a long “e” sound at the end. In the alternative, if, as the opponent submits, consumers associate the last syllable of the applicant’s mark with the chemical symbol for silicon, then I would think that they would pronounce the last syllable as either the individual letters, S, I, or possibly the actual word “silicon”, resulting in a pronunciation that is very different from either pronunciation of EQUISINE. (The opponent submits that the applicant’s mark would be pronounced “equi-sigh” but I do not understand how that accords with its argument that consumers understand the ending to refer to “silicon”, which to my knowledge is never referred to as “sigh”.)

In idea suggested, the applicant's mark either suggests that "yes, this is for horses" or, as argued by the opponent, that this is a silicon product for horses. The opponent has not provided any meaning for its mark but if consumers responded to it as a contraction of the words "equine" and "cuisine", this would result in the mark suggesting that this is food for horses.

A consideration of all the surrounding circumstances leads me to conclude that, on a balance of probabilities, there is not a reasonable likelihood of confusion between EQUISINE and EQUI-SI. Although the opponent's mark has been used longer than the applicant's mark, with similar wares, I am not satisfied that such use enures to the benefit of the owner. In these circumstances, I consider the differences between the two marks to be sufficient to make confusion unlikely.

As stated by the Federal Court of Appeal in *Pink Panther Beauty Corporation v. United Artists Corporation* (1998), 80 C.P.R. (3d) 247 at 269, "the test to be met is *likelihood* of confusion (not possibility of confusion)".

Paragraph 16(3)(a) Ground of Opposition

The opponent has not met its evidential burden with respect to this ground, i.e. it has not satisfied me that the opponent itself used EQUISINE prior to the filing date of May 10, 1999. I reach this conclusion for two reasons: 1) the registration indicates that the opponent was not the owner of the mark as of May 10, 1999 and 2) the evidence shows that a third party's name appears on the EQUISINE packaging. In any event, in order for this ground to succeed, I would have had to conclude that on a balance of probabilities, it was reasonably likely that there would be confusion between EQUI-SI and EQUISINE as of the material date and this ground would

have met the same fate as the third ground of opposition. In the circumstances of this case, nothing turns on the date at which the issue of confusion is determined. Moreover, I note that in the marketplace, EQUISINE is displayed in a manner that emphasizes the letters EQ (those letters being displayed in a larger font, in a different colour and inside a black box), which increases the differences between the marks in appearance, sound and even idea suggested.

Distinctiveness Ground of Opposition

I interpret the fifth ground of opposition as pleading that the applicant's mark is not adapted to distinguish the applicant's wares from the opponent's wares because the applicant's mark is confusing with the opponent's mark. Therefore this ground also fails for reasons similar to those set out with respect to the third ground of opposition.

Disposition

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

DATED AT TORONTO, ONTARIO, THIS 20th DAY OF MAY 2005.

**Jill W. Bradbury
Member
Trade-marks Opposition Board**