

**IN THE MATTER OF AN OPPOSITION
by Nit Pickers to application No. 1,154,524
for the trade-mark NITPICKERS filed by
The Lice Squad Inc.**

On October 2, 2002, The Lice Squad Inc. (the “Applicant”) filed an application to register the trade-mark NITPICKERS (the “Mark”) based upon use of the Mark in Canada in association with “head lice identification and removal services; education services in the field of head lice prevention, identification and removal” since at least as early as September 15, 2002.

The application was advertised for opposition purposes in the Trade-marks Journal of October 8, 2003. By letter of November 13, 2003, a trade-mark agent/law firm, acting on behalf of Nit Pickers, requested an extension of time to oppose the application. An extension of time was granted to March 8, 2004 and on that date a statement of opposition was filed. The Trade-marks Opposition Board served this statement of opposition on the Applicant on March 16, 2004.

Various materials were filed with the statement of opposition on March 8, 2004, but I have disregarded them, as they constitute evidence that has not been filed in the required form.

The Applicant filed and served a counter statement.

A single affidavit signed by both Jody Davis and Lynn Laking was filed pursuant to rule 41 of the *Trade-marks Regulations (1996)*.

An affidavit of the Applicant’s President, Dawn Mucci, was filed pursuant to rule 42.

Both parties filed a written argument. I have disregarded the Applicant’s written argument to the extent that it refers to matters that have not been properly introduced as evidence.

An oral hearing was not requested.

Preliminary Matter

Paragraph 2 of the Applicant's written argument reads as follows:

2. As a preliminary matter, the Applicant submits that the Opponent [Nit Pickers] is not an entity possessing standing to bring an opposition and to make submissions in its own name, since it is not an incorporated company, but rather an unincorporated business.

In addition, paragraph 1 of the Applicant's counter statement reads:

The Applicant states that the Opponent has not properly identified itself in that the Opponent has not indicated that Lynn Barbara Laking and Jody Lynn Davis should in fact personally be the opponents, since they are not incorporated, but merely, allegedly, operate as a general partnership under the business name "Nit Pickers". "Nit Pickers" is not an entity possessing standing to bring an opposition and to make submissions in its own name.

I have accordingly reviewed the file in order to determine if the Applicant's preliminary objection renders the addressing of the grounds of opposition moot. In this regard, I note that paragraph 3 of the Applicant's written argument states, "Assuming the issue set out in paragraph 2 above can be resolved in the Opponent's favour," before proceeding to address the grounds of opposition.

As set out earlier, at the request of a firm acting on behalf of Nit Pickers, an extension of time was granted for the purpose of opposing the present application. A statement of opposition was then filed directly by the would-be opponent. The letter that accompanied the statement of opposition identified Nit Pickers as the company name but was signed by Lynn White Laking and Jody Davis on behalf of Nit Pickers. The statement of opposition bears the heading, "In the Matter of an Opposition by Nit Pickers to application #1154524", but paragraph A thereof reads, in part, "We (Jody Davis and Lynn Laking) registered the trade name Nit Pickers with the Ontario Ministry of Consumer and Commercial Relations on October 6, 2000 and have carried on business in the form of a general partnership under this name from this date to present." The statement of opposition is signed:

OPPONENT

Nit Pickers

Per: Lynn Laking

Per: Jody Davis

The opponent has not addressed the Applicant's point concerning its standing, but we cannot of course tell whether this was done intentionally, or was done through oversight or ignorance. In any event, after carefully considering this matter, I have concluded that it was clear when the statement of opposition was filed that Nit Pickers is the trading style of the two individuals carrying on business in partnership. As such, it is an acceptable opponent. While it would have been preferable for Ms. Davis and Ms. Laking to respond to the Applicant's issue by amending those lines in the statement of opposition that refer to Nit Pickers *simpliciter*, I find that the manner in which the statement of opposition was signed, combined with the statements in the body of the statement of opposition setting out the facts, serve to override any references to Nit Picker *simpliciter*. In other words, although the opponent is referred to in some instances as Nit Pickers, it is clear from a reading of the document as a whole that the entity opposing the application is "Jody Davis and Lynn Laking, carrying on business as a partnership under the name Nit Pickers" [hereinafter the "Opponent"].

Regarding the fact that the request for an extension of time was made on behalf of Nit Pickers *simpliciter*, I note that the wording of s. 47 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the "Act") does not indicate that only a "person" may be granted an extension of time, unlike s. 38 which allows only a "person" to file a statement of opposition.

Onus and Material Dates re Grounds of Opposition

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, the Opponent must first 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.).]

Although the statement of opposition is somewhat imprecise, both parties seem to agree in their written arguments that grounds of opposition have been pleaded pursuant to s. 16(1)(a), 16(1)(c) and 12(1)(b) of the Act. The material date for assessing each of the s. 16 grounds of opposition is the Applicant's date of first use. The material date for assessing the s. 12(1)(b) ground of

opposition is the Applicant's filing date [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.)].

Section 16(1)(a) Ground of Opposition

In order to satisfy its initial burden with respect to this ground of opposition, the Opponent must evidence that it used NITPICKERS as a trade-mark prior to September 15, 2002 and had not abandoned such use as of October 8, 2003 [See s. 16(5) and 17]. Once this is done, the s. 16(1)(a) ground of opposition will succeed if the Applicant does not meet its onus to establish that, as of September 15, 2002, its Mark was not confusing with the mark NITPICKERS as previously used by the Opponent.

Use of a trade-mark in accordance with services is defined in s. 4(2) of the Act as follows: "A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services."

The Opponent attests that it registered NIT PICKERS as a business name on October 6, 2000. However, registration of a business name is not use of a trade-mark. [See *Opus Building Corp. v. Opus Corp.* (1995), 60 C.P.R. (3d) 100 at 106.]

The Opponent also attests that it "advertised our business by flyers accompanied by covering letters. Attached hereto and marked as Exhibit 'C' are copies of our flyers and covering letter." Exhibit "C" contains one coloured flyer that displays at the top THE NIT PICKERS, followed by promotional text advertising nit removal services, with the names and telephone numbers of the two individuals who comprise the partnership appearing at the bottom. Exhibit "C" also includes copies of 3 letters clearly directed to those in charge of schools, promoting the Opponent's lice-related services. The Opponent offers to provide in-school head lice checks, as well as lice and nit removal services to individuals. The letters are dated February 6, 2001, Fall 2001, and September 2004. They each display NIT PICKERS at the top in large, bold letters, followed in smaller lettering by an address. In the bodies of the letters, the Opponent refers to Nit Pickers

being a service based company, and the letter is signed by the two members of the partnership, followed by the words Nit Pickers. Although I agree that references to NIT PICKERS in these materials sometimes appears to be business name use, rather than trade-mark use, I find that the manner in which NIT PICKERS is set out at the top of the letters results in it qualifying as trade-mark use. [See *Road Runner Trailer Mfg. Ltd. v. Road Runner Trailer Co. Ltd. et al.* (1984), 1 C.P.R. (3d) 443 (F.C.T.D)] I further find that use of NIT PICKERS qualifies as use of NITPICKERS. [See Principle 2, *Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535 at 538-9.]

As Exhibit “F”, the Opponent has provided invoices that relate to the services that it rendered. These bear dates ranging from October 20, 2000 to October 22, 2004. They are made out to various schools and bill for head lice checks/screening. They include an invoice dated October 20, 2000 to Terraview-Willowfield Public School and one dated December 7, 2000 to Ellesmere Statton P.S., both of which display NIT PICKERS at the top in a manner that I find is trade-mark use of NITPICKERS, for reasons similar to those discussed above.

As a result, I am satisfied that the Opponent did use NITPICKERS as a trade-mark in Canada in association with services similar to those offered by the Applicant, prior to the Applicant’s claimed date of first use, and had not abandoned such use as of the date of advertisement of the present application. I must therefore now determine if the Applicant has met the onus on it to demonstrate that confusion was not reasonably likely as of September 15, 2002.

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. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: the inherent distinctiveness of the trade-marks or trade-names 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 or trade-names in appearance or sound or in the ideas suggested by them.

In *Polo Ralph Lauren Corp. v. United States Polo Association et al.* (2000), 9 C.P.R. (4th) 51 (F.C.A.) at 58-59, Malone J.A. summarized the guidelines to be applied when assessing the likelihood of confusion as follows:

A review of some of the leading cases also establishes some practical guidelines. For example, the Court is to put itself in the position of an average person who is familiar with the earlier mark but has an imperfect recollection of it; the question is whether the ordinary consumer will, on seeing the later mark, infer as a matter of first impression that the wares with which the second mark is used are in some way associated with the wares of the earlier. With respect to the degree of resemblance in appearance, sound or ideas under subparagraph 6(5)(e), the trade-marks at issue must be considered in their totality. As well, since it is the combination of elements that constitutes a trade-mark and gives distinctiveness to it, it is not correct to lay the trade-marks side by side and compare and observe similarities or differences among the elements or components of the marks when applying the test for confusion. In addition, trade-marks must not be considered in isolation but in association with the wares or services with which they are used. When dealing with famous or well-known marks, it may be more difficult to demonstrate that there is no likelihood of confusion, especially if the nature of the wares are similar. Lastly, the enumerated factors in subsection 6(5) need not be attributed equal weight. Each particular case of confusion might justify greater emphasis being given to one criterion than to others.

inherent distinctiveness of the trade-marks

A “nit” is the egg of a louse or similar insect, and a “nitpicker” would be clearly understood to be someone who “picks” or “removes” such eggs, when NITPICKER(S) appears in association with head lice removal services. The Applicant has pointed out that a “nitpicker” can also mean someone who pays too much attention to petty details, but in the context of the parties’ services, this meaning seems to be less likely to be the one that comes to the mind of a potential purchaser or user. [See *Mitel Corp. v Registrar of Trade-marks* (1984), 79 CPR (2d) 202 (FCTD) at 208.] As a result, I consider neither party’s mark to be inherently distinctive.

the extent to which each trade-mark has become known; the length of time each trade-mark has been in use

In view of the fact that the application only claims use as of the material date, these factors necessarily favour the Opponent.

the nature of the wares, services or business; the nature of the trade

In order to discuss this factor, I will summarize the Applicant's evidence. Ms. Mucci states that the Applicant began manufacturing, packaging and offering for sale a product bearing the trade-mark NITPICKER SECRET PREVENTION SPRAY in November 2000. However, I do not consider this fact to assist the Applicant in any way for a number of reasons: 1) the application covers services, not wares; 2) no exhibits have been provided showing how this trade-mark was associated with the wares; 3) Ms. Mucci states that this trade-mark was used under a verbal license from another company, which raises the question of whether the use of this mark accrued to the benefit of the Applicant or the licensor.

In any event, Ms. Mucci states that the product was so popular with clients "that its name became practically synonymous with my general services throughout the fall of 2000." She states that she therefore began using both THE LICE SQUAD and NITPICKERS in association with her services. However, there is no documentary evidence of such use as of that date, and the application itself of course only claims use since at least as early as September 15, 2002.

As Exhibit "B", Ms. Mucci provides a copy of an article entitled "NITPICKERS" that appeared in the April 2002 edition of the magazine *Today's Parent*. She states that this shows the association that had grown between her company's services and the trade-mark NITPICKERS, but I disagree. Although NITPICKERS is the title of the article, this is because the article discusses what one can do about lice; it uses NITPICKERS as an eye-catching descriptive term, not as the trade-mark of the Applicant. It is true that there is a complimentary reference to the Applicant on the third page of the article, but again the word "nitpicker" is only associated with the Applicant in a descriptive sense. In particular, that section of the article reads:

If picking out nits and lice by hand sounds like too much work – it can easily take an hour or more every day – some parents now have the option of hiring someone to do the job. The two most prominent Canadian nitpickers are Karen Tilley and Dawn Mucci. Tilley began by treating a friend and before long was helping three or more families a week. Mucci has now taken over the in-home part of the business, called the LiceSquad.. ...

Ms. Mucci provides copies of ads that she says promote her company's services in association with the Mark. The first of these (Exhibit "C") does not display the Mark, but Exhibits "D" and "E", which Ms. Mucci says were used in September 2002, do display NIT PICKERS TM.

As Exhibit "N", Ms. Mucci has provided a brochure that she attests has been distributed "throughout Ontario, since early 2001, through pharmacies, schools, health departments, community centres, doctors' offices, camps, daycares, Children's Aid societies and private distribution." She says that the brochure "features the Applied-for Mark in association with my company's services." I agree that NITPICKERS does appear on the brochure in at least three different locations: 1) "The LiceSquad Inc. ® & Nitpickers knows how to conquer head lice, safely and quickly."; 2) "Our highly skilled team of hairdressers and nurses form a collective group called The LiceSquad Inc. & Nitpickers."; and 3) "The LiceSquad Inc. ® & Nitpickers Head Lice Removal Services".

I will not discuss the remainder of Ms. Mucci's exhibits, because they all postdate the material date.

It is clear that the parties are engaged in the same type of business, *i.e.* the removal or control of head lice and nits. In fact, they both target schools among their clientele. Accordingly, a consideration of the nature of the wares, services, business and trade favours the Opponent.

the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

The marks are identical, with the result that they have the highest possible degree of resemblance in all respects.

conclusion re likelihood of confusion

The legal onus is on the Applicant to show that there is not a reasonable likelihood of confusion between the marks. Given that the marks are identical and the associated services are very similar if not identical, I find that the Applicant has not met its onus.

The s. 16(1)(a) ground of opposition therefore succeeds.

Section 16(1)(c) Ground of Opposition

In order to satisfy its initial burden with respect to this ground of opposition, the Opponent must evidence that it used Nitpickers as a trade-name prior to September 15, 2002 and had not abandoned such use as of October 8, 2003 [See s. 16(5) and 17]. Once this is done, the s. 16(1)(c) ground of opposition will succeed if the Applicant does not meet its onus to establish that, as of September 15, 2002, its Mark was not confusing with the trade-name Nitpickers as previously used by the Opponent.

I am satisfied that the Opponent did use Nitpickers as a trade-name in Canada prior to the Applicant's claimed date of first use, and had not abandoned such use as of the date of advertisement of the present application. In addition to the materials already discussed, the various banking materials that were provided as exhibits to the Opponent's evidence show trade-name use of Nitpickers prior to the Applicant's claimed date of first use and after October 8, 2003.

For reasons similar to those set out in my discussion of the s. 16(1)(a) ground of opposition, the s. 16(1)(c) ground also succeeds.

Remaining Ground of Opposition

Although the parties seem to agree that the final ground of opposition is non-registrability pursuant to s. 12(1)(b) of the Act, the ground as pleaded is a cross between a distinctiveness ground of opposition and a s. 12(1)(d) ground of opposition. This blurring is somewhat understandable given that the basis for the Mark not being distinctive is that it is descriptive or generic of the services. In any event, I will not address the remaining ground of opposition as the opposition has already succeeded on two grounds.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, pursuant to s. 38(8) I refuse the application.

DATED AT TORONTO, ONTARIO, THIS 27th DAY OF OCTOBER 2006.

Jill W. Bradbury
Member
Trade-marks Opposition Board