

IN THE MATTER OF AN OPPOSITION by Frank T. Ross & Sons (1962) Limited to application No. 718,017 for the trade-mark NATURE'S SUNSHINE filed by Nature's Sunshine Products, Inc.

On November 30, 1992, the applicant, Nature's Sunshine Products, Inc., filed an application to register the trade-mark NATURE'S SUNSHINE based upon use of the trade-mark in Canada since at least as early as 1982 in association with:

“Dietary food supplements, herbal, vitamin and mineral preparations and food supplements, namely, tablets, capsules, syrups, powders, lozenges, tonics, extracts, essences; herb extract liquids and powders; snack bars; liquid chlorophyll; vitamins; herbs; minerals; weight control beverages and beverage concentrates, namely syrups, powders, tonics; medicinal preparations, and homeopathic medicines, namely, creams, tablets, capsules, syrups, powders, lozenges, tonics, essences, ointment, salves, balms; skin discomfort cream; herbal cough syrup; breath freshening tablets, cosmetics and toilet preparations namely, creams, lotions, gels, oils, soaps conditioners for hair and body, ointments, salves, shampoos, toothpaste, facial and body cleansers, make-up solvents, astringents, toners, face and body moisturizers and lubricants, perfumes, colognes, body powders, antiperspirants and deodorants; general purpose cleaning concentrates; water filtration and purification units; aroma therapy products, namely, gels, soaps, conditioners; food and beverages containing real and herbal flavourings and light beverages, namely, juice, tea, herbal tea, aloe vera juice, mineral waters, snack bars, cookies, syrups, punches, powders.”

The present application was advertised for opposition purposes in the *Trade-marks Journal* of December 7, 1994 and the opponent, Frank T. Ross & Sons (1962) Limited, filed a statement of opposition on February 6, 1995, a copy of which was forwarded to the applicant on May 24, 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 NATURE'S SUNSHINE 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 of the trade-mark NATURE'S SUNSHINE in view of the prior use and registration of the trade-mark NATURE CLEAN;
- (d) The trade-mark NATURE'S SUNSHINE 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, who was cross-examined on his affidavit, the transcript of the cross-examination forming part of the opposition record. The applicant submitted as its evidence the affidavits of Brent Ashworth, Shirley McDonald, Valerie Tailleir and Gladys Tibbo Witt. Both parties filed a written argument and the applicant alone was represented at 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 evidential 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 evidential 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 NATURE'S SUNSHINE 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 Paragraph 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, 1982] while the material date for considering the non-

distinctiveness issue is the date of opposition [February 6, 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]. Further, during his cross-examination, Mr. Ross noted that the trade-mark NATURE CLEAN was chosen to describe the opponent's product, namely, a natural cleaning product. The applicant's trade-mark NATURE'S SUNSHINE possesses some measure of inherent distinctiveness when considered in its entirety even though the word NATURE'S 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 [October 20, 1995]. As pointed out by Mr. Ross in paragraph 9 of his affidavit and as confirmed during his cross-examination, 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 Brent F. Ashworth, General Counsel and Vice-President Legal of the applicant, in support of its application. The Ashworth affidavit establishes that the applicant is the registered owner in Canada of the trade-marks NATURE'S SUNSHINE & Design, registration Nos. 277,367 and 452,937, copies of which are annexed as exhibits to the Ashworth affidavit. 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. In my view, the existence of the applicant's registrations *per se* is of little relevance to the issues in this opposition. On the other hand, as noted below, the fact that the applicant has used its trade-marks NATURE'S SUNSHINE & Design is of relevance to the assessment of the likelihood of confusion between the trade-marks at issue, bearing in mind the absence of evidence of actual confusion between the applicant's mark and the opponent's NATURE'S SUNSHINE & Design trade-marks.

The Ashworth affidavit also establishes that the applicant has used the trade-mark NATURE'S SUNSHINE in Canada since 1977 and, from 1978 to May of 1996, sales of NATURE'S SUNSHINE products in Canada have exceeded \$70,000,000. According to Mr. Ashworth, the applicant's NATURE'S SUNSHINE products are distributed in Canada through a network of direct marketing distributors, there being over 10,000 distributors in Canada as of the date of Mr. Ashworth's affidavit [May 20, 1996]. Further, Mr. Ashworth states that the applicant does not advertise its NATURE'S SUNSHINE products by newspaper, television or in the supermarket, but rather distributes its promotional literature directly to Canadian purchasers through its network of direct distributors. Finally, Mr. Ashworth notes that the applicant's NATURE'S SUNSHINE products and those of the opponent associated with the trade-mark NATURE CLEAN have co-existed in the marketplace in the United States and in Canada without any evidence of confusion.

Having regard to the above, the extent to which the trade-marks at issue have become known weighs in the applicant's favour. On the other hand, the length of time the trade-marks have been in use favours the opponent to a limited extent in that the opponent's mark NATURE CLEAN appears to have been used in Canada since 1974 whereas the applicant's NATURE'S SUNSHINE trade-mark has been in use in Canada since 1977.

As for the wares and channels of trades of the parties, it is the applicant's statement of wares

and the statement of wares covered in the opponent's registration for the trade-mark NATURE CLEAN which must be considered in assessing the likelihood of confusion in relation to the Paragraph 12(1)(d) ground [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.*, 19 C.P.R.(3d) 3, at pp. 10-11 (F.C.A.); *Henkel Kommanditgesellschaft v. Super Dragon*, 12 C.P.R.(3d) 110, at p. 112 (F.C.A.); and *Miss Universe, Inc. v. Dale Bohna*, 58 C.P.R.(3d) 38,1 at pp. 390-392 (F.C.A.)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful [see *McDonald's Corporation v. Coffee Hut Stores Ltd.*, 68 C.P.R.(3d) 168, at p. 169 (F.C.A.)].

In the present case, registration No. 198,880 for the trade-mark NATURE CLEAN covers "Shampoos, detergents, washing compounds, cosmetic products" which overlap the applicant's wares which include *inter alia* "cosmetics and toilet preparations namely, creams, lotions, gels, oils, soaps conditioners for hair and body, ointments, salves, shampoos, toothpaste, facial and body cleansers, make-up solvents, astringents, toners, face and body moisturizers and lubricants, perfumes, colognes, body powders, antiperspirants and deodorants; general purpose cleaning concentrates; water filtration and purification units; aroma therapy products, namely, gels, soaps, conditioners". Further, for the purposes of assessing the Paragraph 12(1)(d) ground, the channels of trade associated with the wares of the parties must be considered as potentially overlapping, bearing in mind that there is no restriction in the applicant's statement 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 NATURE'S SUNSHINE 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 Witt affidavit. In particular, Ms. Witt has annexed to her 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 Tailleur affidavit which establishes *inter alia* use of the following: NATURE'S GATE shampoo; NATURE MADE garlic oil capsules; and NATURE'S GATE lip balm.

The applicant has submitted 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 proceeding. In this regard, the applicant has evidenced in excess of \$70,000,000 in sales of NATURE'S SUNSHINE products from 1977 to 1996 in Canada through its network of direct distributors. 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 almost twenty years without evidence of any confusion between the trade-marks at issue. While there does not appear to have been a direct overlap in the respective channels of trade of the parties, the fact that there has been relatively significant concurrent use of the trade-marks at issue over such a long period of time justifies my according at least some 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 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.

In addition to the above decisions, the present opponent was successful in part in *Frank T. Ross & Sons (1962) Limited v. De Leeuw*, 77 C.P.R. (3d) 51, the Hearing Officer rendering a split decision in an opposition to registration of the trade-mark NATURE PERFECT & Design. In that case, Hearing Officer Groom commented as follows at pages 57-58 of the reported decision with respect to the applicant's argument that the word "nature" is a common word in the English language and should not be monopolized by anyone:

"... the fact that a word may or may not be commonly used in the English language is not enough to convince me to restrict the opponent's rights. Once a mark is registered it gives the owner the exclusive right to use it in association with the designated wares and services (Section 19 of the Act). The only question which the applicant can raise in its defence in a trade-mark opposition is whether the word has come to be commonly used by others in association with similar wares, which is shown by evidence of the state of the register or the state of the marketplace. If the applicant can show that it is so commonly used, then the presumption is that people are used to seeing marks of this sort for wares of this sort and therefore small differences between the marks will serve to distinguish them. In this case, the applicant has presented no evidence of the state of the register or the state of the market place therefore it is not open for me to speculate that the word might be commonly used and the opponent's rights will not be diminished."

Also, 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 marketplace evidence 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.

In a number of more recent decisions, the Opposition Board rejected the opponent's oppositions which were based on allegations of confusion involving its trade-mark NATURE CLEAN. In *Frank T. Ross & Sons (1962) Limited v. Belvedere International Inc.*, 74 C.P.R. (3d) 243, the applicant met the legal burden upon it in respect of the issue of confusion between its trade-mark NATURES BASICS covering various hair care products and the opponent's trade-mark NATURE CLEAN by establishing 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. Also, in *Frank T. Ross & Sons (1962) Limited v. Dep Corporation*, (application No. 772,075, yet unreported decision dated December 29, 1997), I rejected the opponent's opposition to registration of the trade-mark NATURES FAMILY based upon proposed use of the trade-mark in Canada in association with: "Skin scrubs, skin oils, shower and bath gels, thigh creams, facial cleansers, soaps, liquid soaps, toners, skin creams, skin gels, moisturizing foam baths, facial moisturizers, foam baths and skin lotions; skin lotions, skin creams, skin gels, moisturizing foam baths and facial moisturizers all containing aloe vera and vitamin E; milk foam baths; extra strength skin lotions and skin creams" and concluded as follows:

"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."

Finally, in *Frank T. Ross & Sons (1962) Limited v. London Drugs Ltd.*, (application No. 738,424, yet unreported decision dated February 12, 1998), the opponent's opposition to registration of the trade-mark NATURES PRESCRIPTION & Design as applied to "Vitamins and minerals; soap, namely toilet, deodorant, body, facial and liquid soaps" was rejected in that the wares of the parties were found to differ and the applicant's evidence pointed 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, in that case, the absence of evidence of instances of actual confusion supported the conclusion that there would be no reasonable likelihood of confusion between the trade-marks at issue.

In the present case, the applicant's state of the register evidence and marketplace evidence point 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 supports 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 16th DAY OF JUNE, 1998.

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