



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

**Citation: 2011 TMOB 216**  
**Date of Decision: 2011-11-04**

**IN THE MATTER OF AN OPPOSITION  
by Neuville Industries, Inc. to application  
No. 1,322,806 for the trade-mark  
WHERE MEDI MEETS PEDI in the  
name of KvG Group Inc.**

- [1] On November 3, 2006, KLTD International Inc. filed an application to register the trade-mark WHERE MEDI MEETS PEDI (the Mark).
- [2] The application was advertised for opposition purposes in the *Trade-marks Journal* of August 15, 2007.
- [3] On January 15, 2008, Neuville Industries, Inc. (the Opponent) filed a statement of opposition against the application.
- [4] On April 16, 2008, the application was assigned to KvG Group Inc. I shall use the term Applicant to refer to both KvG Group Inc. and KLTD International Inc. as the case may be.
- [5] The Applicant filed and served a counter statement in which it denied the Opponent's allegations.
- [6] In support of its opposition, the Opponent filed an affidavit of its President, Kathy Willis, plus certified copies of Canadian trade-mark registration Nos. TMDA55,715 and TMA704,942.

[7] On March 26, 2010, the Applicant amended its application to delete its proposed use wares, namely “clothing, namely t-shirts, sweatshirts, socks and caps”. This resulted in the application’s statement of wares and services being restricted to the following wares and services, for which the Applicant claims use in Canada since at least as early as October 13, 2006:

wares: footcare products, namely foot mousse, sprays and lotions;

services: educational services, namely providing courses, seminars and workshops relating to pedicure products; educational services, namely providing courses in the field of pedicuring.

It is noted that the Applicant has disclaimed the right to the exclusive use of the word PEDI apart from the Mark.

[8] In support of its application, the Applicant filed an affidavit of Katharin von Gavel, the President of KvG Group Inc.

[9] No cross-examinations were conducted.

[10] Only the Applicant filed a written argument. An oral hearing was not requested.

#### Grounds of Opposition

[11] One of the grounds of opposition relates solely to the Applicant’s proposed use clothing wares; as those wares are no longer in the application, that ground of opposition is now moot.

[12] The remaining grounds of opposition may be summarized as follows:

1. The Mark is not registrable pursuant to s. 12(1)(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), as it is confusing with the trade-mark PEDS registered by the Opponent under No. TMDA55,715 for “an article known as stocking foot or foot glove”.
2. The Applicant is not the person entitled to registration of the Mark pursuant to s. 16 of the Act as at the applicable material dates the Mark was confusing

with the trade-mark MEDIPEDS, in respect of which an application for registration had been previously filed in Canada by the Opponent.

3. The Mark is not distinctive within the meaning of s. 2 of the Act because it does not distinguish, nor is it adapted to distinguish, the Applicant's wares and services from the wares of the Opponent.

#### Onus and Material Dates

[13] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential 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* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

[14] The material dates with respect to the grounds of opposition are as follows:

- s. 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 C.P.R. (3d) 413 (F.C.A.)];
- s. 16(1)(b) - the date of first use alleged in the application;
- non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

[15] The Opponent has met its initial burden with respect to its s. 12(1)(d) ground of opposition because the pleaded registration is extant.

[16] In order to meet its initial burden with respect to the s. 16(1)(b) ground, the pleaded application must have been pending when the application was advertised (see s. 16(4)). Although the Opponent did not provide the serial number of the MEDIPEDS application in its statement of opposition, it did provide a registration number for its MEDIPEDS registration in Ms. Willis' affidavit and a certified copy of such registration. Registration No. TMA704,942 for MEDIPEDS issued to registration on January 17, 2008. Although it was listed as owned by International Legwear Group, Inc. at that point of time, an assignment effective December 19, 2007 was subsequently recorded in favour of the Opponent. I therefore find that the Opponent has met its initial burden with respect to the s. 16(1)(b) ground.

[17] In order to meet its initial burden with respect to the distinctiveness ground, the Opponent's marks "must be known to some extent at least to negate the established distinctiveness of another mark, and its reputation in Canada should be substantial, significant or sufficient" [*Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.) at para. 34]. Ms. Willis' evidence, as discussed further below, satisfies this initial burden.

[18] Whether the Applicant has met its legal onus will be assessed in the paragraphs below.

### Likelihood of Confusion

[19] The issue underlying each of the grounds of opposition is the likelihood of confusion between the Applicant's Mark and one or more of the marks owned by the Opponent.

[20] 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. The test for confusion is one of first impression and imperfect recollection

[21] 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: (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 wares, 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. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.) and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.).]

[22] I will begin by discussing the ground of opposition that pleads that the Mark is not registrable because it is confusing with the Opponent's registered trade-mark PEDS.

*inherent distinctiveness of the marks, the extent to which each mark has become known, and the length of time the marks have been in use*

[23] Both marks have some inherent distinctiveness. However, neither PEDS nor WHERE MEDI MEETS PEDI is an inherently strong mark since, with regards to their associated wares/services, they both evoke an association with feet (ped- is defined in *Merriam–Webster Online* as a combining form for foot, with the variants pedi- or pedo- [Exhibit N, von Gavel affidavit]). Overall, I would say that WHERE MEDI MEETS PEDI is more inherently distinctive than is PEDS.

[24] There has been a licensee authorized to sell PEDS socks in Canada since July 1, 2000. Canadian sales of PEDS socks amounted to \$1,258,704 in 2006, \$3,586,006 in 2007 and \$1,959,216 in 2008, i.e. in excess of \$6,000,000 between 2006 and 2009.

[25] The Applicant has promoted its wares and services in association with the Mark in Canada since 2006 by distributing printed materials such as postcards, brochures, posters, presentation folders and flyers and by advertising in print media such as the magazines *Salon* and *Nails*. From 2006 to 2009 inclusive, the Opponent's advertising and marketing expenses were in excess of \$395,000, while its Canadian sales during that time period exceeded \$3,350,000.

[26] Based on the foregoing, I conclude that both PEDS and WHERE MEDI MEETS PEDI have become known to a fair extent in Canada.

*the nature of the wares, services, business and trade*

[27] When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark application and registration that govern in respect of the issue of confusion arising under s. 12(1)(d) [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe, Inc. v. Dale Bohna* (1984), 58 C.P.R. (3d) 381 (F.C.A.)].

[28] The wares and services currently listed in the application differ from the wares in the Opponent's registration. They are nevertheless related to some degree in that both relate to feet.

[29] Ms. Willis attests that the Opponent is a textile company located in North Carolina that specializes in designing, manufacturing, marketing, and selling socks, legwear, footwear and related products. She refers to various licenses granted to parties to sell the Opponent's wares. The Applicant has pointed out that there is no evidence that such licenses meet the requirements of s. 50(1) of the Act. However, as it appears that the licenses are merely licenses to sell, it seems to me that they are more in the nature of distributorship agreements, which do not require the invocation of s. 50(1). In this regard, I note that at least some of the Opponent's packaging indicates that the wares are being distributed by a "licensee" of the Opponent, identifies the Opponent's mark as a registered trade-mark of the Opponent, and states that the mark is being used under license. This message both confirms that the "licensee" is acting as a distributor and also invokes s. 50(2) of the Act. Accordingly, I reject the Applicant's argument that the use shown does not accrue to the benefit of the Opponent.

[30] Ms. Willis informs us that the Opponent's PEDS socks have been sold in Canada through mass market retail stores such as Walmart and Zeller's.

[31] Ms. von Gavel informs us that the Applicant has, since 2002, been in the business of manufacturing, distributing and selling non-medicated foot care products for cosmetic and esthetic purposes and for pedicure treatments, and in providing courses, workshops and tutorials on the application of pedicure products, and pedicure techniques to pedicurists, estheticians and trained footcare professionals of salons and spas offering pedicure services. The Applicant's primary brand name is FOOTLOGIX with the Mark being used as a tag line in association with the Applicant's FOOTLOGIX branded footcare products and educational services. The Applicant's footcare products are sold through distributors and also directly to salons and spas for their own in-house use in providing pedicure services and/or for resale to the direct customer for home care use.

*degree of resemblance between the marks*

[32] The resemblance between PEDS and WHERE MEDI MEETS PEDI stems solely from their common use of PED, a suggestive formative. When the marks are considered in their totalities, there is little resemblance between them in appearance, sound or ideas suggested.

*other surrounding circumstances*

[33] I do not consider the Opponent's use and registration of its mark abroad to be a significant circumstance.

*conclusion re s. 12(1)(d) ground*

[34] Having considered all of the surrounding circumstances, I find that the Applicant has established, on a balance of probabilities, that confusion is not likely between PEDS and WHERE MEDI MEETS PEDI. I reach this conclusion primarily based on the small degree of resemblance between the marks. The degree of resemblance between the trade-marks is the most crucial or dominant factor in determining the issue of confusion [see *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.) at 149, affirmed 60 C.P.R. (2d) 70].

[35] The s. 12(1)(d) ground of opposition therefore fails.

*Distinctiveness Ground of Opposition*

[36] To the extent that the distinctiveness ground of opposition is based on the Opponent's PEDS mark, it fails for reasons similar to those discussed with respect to the s. 12(1)(d) ground of opposition; nothing turns on the date at which the issue of confusion is determined.

[37] However, the distinctiveness ground of opposition also requires me to assess the likelihood of confusion between the Opponent's MEDIPEDS mark and the Mark.

[38] The Opponent's MEDIPEDS socks have been sold through channels similar to those used for its PEDS wares, but the MEDIPEDS socks have also been sold through the Internet. At some unspecified point of time, the Opponent has extended the use of its MEDIPEDS mark to shoes, foot creams, and foot care kits – all of which are available for sale to Canadians through the website *www.medipeds.com* (Ms. Willis' exhibits concerning this all postdate the material date).

[39] Use of the MEDIPEDS mark in Canada began in 2005 and sales figures have been provided for each of the years 2005-2008. Prior to 2008, Canadian retail sales exceeded \$1,600,000 US.

[40] Ms. von Gavel attests at paragraph 16 of her affidavit: “In the pedicure industry, the term ‘medi-pedi’ is commonly used to describe or refer to an enhanced pedicure. In the pedicure industry, the term ‘medi-pedi’ is used generically by various spas, salons, pedicurist and foot specialist [*sic*] as a commonly used term of the trade.” As Exhibit M, she provides various pages obtained from the Internet in April 2010 that show the use of “medi-pedi” by others as a generic term for a type of pedicure.

[41] The MEDIPEDS mark is more similar to WHERE MEDI MEETS PEDI than is PEDS. However, the ideas suggested by the marks differ: MEDIPEDS may suggest that the Opponent’s socks are as good for feet as is a “medi-pedi” pedicure, whereas WHERE MEDI MEETS PEDI is a more fanciful allusion to medi-pedi wares/services.

[42] Having carefully considered the above-mentioned surrounding circumstances as well as those applicable from my s. 12(1)(d) discussion, I am satisfied that the Applicant has met the legal burden on it. Given the differences between the marks, the generic meaning of medi-pedi, plus the differences between the wares/services for which the parties had obtained a reputation as of the material date, I find that confusion between MEDIPEDS and WHERE MEDI MEETS PEDI was not reasonably likely as of January 15, 2008.

[43] The distinctiveness ground therefore fails in its entirety.

*Section 16(1)(b) Ground of Opposition*

[44] Although the s. 16 material date is approximately three years earlier than the material date for distinctiveness, the different date for assessing the likelihood of confusion between MEDIPEDS and WHERE MEDI MEETS PEDI does not result in a different outcome.

[45] Therefore, for reasons similar to those set out in my discussion of the likelihood of confusion between MEDIPEDS and WHERE MEDI MEETS PEDI under the distinctiveness ground of opposition, the s. 16(1)(b) ground fails.



Disposition

[46] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

---

Jill W. Bradbury  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office