IN THE MATTER OF AN OPPOSITION
by Applica Consumer Products, Inc.
to application no. 1181704 for the trade-mark
LITTERMA TE filed
by InfraReady Products (1988) Ltd.

On June 30, 2003, InfraReady Products (1988) Ltd. ("InfraReady") filed an application to register the trade-mark LITTERMATE based on proposed use in Canada in association with

cat litter made from coarse waxy, hull-less barley meal.

The application disclaims the right to the exclusive use of the word LITTER apart from the mark as a whole.

The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated July 7,2004 and was opposed by HP Intellectual Corp. ("HPI") on December 7, 2004. The applicant responded by filing and serving a counter statement. The opponent's evidence consists of the affidavit of Michael R. Fretwell, an executive with the opponent company. The applicant's evidence consists of the affidavit of Mark D. Pickard, President of the applicant company. The opponent's evidence in reply consists of the affidavit of Mabe1 Hung, clerk.

The file record shows that the original opponent HPI merged with Applica Consumer Products, Inc. on January 17, 2006. The merged entity continued under the name Applica Consumer Products, Inc. ("Applica").

STATEMENT OF OPPOSITION

The grounds of opposition are pleaded succinctly and are shown in full below.

(a) The Opponent bases its opposition on the grounds provided by Section 38(2)(a), namely, the application does not comply with the requirements of Section 30(i) and should have been refused by the Registrar pursuant to the provisions of Section 37(1)(a). Specifically, the Applicant could not state it was satisfied it was entitled to use the trade-mark in Canada in ,association with the wares described in the application and wrongly stated that it intended to use the mark with the wares set out in the application.

(b) The Opponent further bases its opposition on the grounds provided by Section 38(2)(b), namely, that the trade-mark claimed in application no. 1,181,704 is not registrable having in mind the provisions of Section 12(1)(d). The trade-mark claimed in application 1,181,704 is confusing within the meaning of Section 6 with the trade-mark Registration number TMA528,457 owned by the Opponent for the mark **LITTER MAID** for use with *"electric self-cleaning cat litter box".* A copy of said registration is attached hereto and forms part of this Statement of Opposition.

(c) The Opponent further bases its opposition on the grounds provided by Section 38(2)(c) namely, that the Applicant is not the person entitled to registration of the trade-mark claimed in application number 1,181,704 in view of the provisions of Section 16(3). The trade-mark claimed in application number 1,181,704 is confusing with the Opponent's **LITTER MAID** trade-mark for use with electric self-cleaning cat litter boxes which has been used in Canada since at least as early as September 1997.

(d) Further, the Opponent bases its opposition on the grounds provided by Section 38(2)(d) in that the trade-mark **LitterMate** claimed in application 1,181,704 is not distinctive within the meaning of Section 2 in that such trade-mark is not adapted to distinguish the wares with which it is proposed to be used from those of others and in particular from those of the Opponent.

OPPONENT'S EVIDENCE

Mr. Fretwell's affidavit was sworn on September 6, 2005, that is, prior to the merger discussed above. His evidence may be summarized as follows. Applica and HPI are subsidiaries of Applica Incorporated. Applica produces and sells a wide variety of small electrical household products while HPI owns all the intellectual property of Applica. Mr. Fretwell testifies that Applica has been selling LITTER MAID automatic self-cleaning litter boxes since 1996 when it acquired proprietary rights to the product and brand name from Waters Research Company. Applica transferred ownership of the mark LITTER MAID to HPI on April 10, 2001 and thereafter used the mark under license from HPI. The opponent Applica, by itself and through predecessors in title, has been using the mark LITTER MAID since at least as early as September 1997. The litter boxes are used primarily by people who keep cats as pets. The box automatically cleans animal waste and clump litter by depositing it into a removable receptacle. The product is sold throughout North America including Canada. In Canada, LITTER MAID wares are sold through mass merchandisers such as Canadian Tire and Zellers as well as through

pet specialty stores. The applicant also sells LITTER MAID products over the Internet. Paragraphs 6 and 7 of Mr. Fretwell' s affidavit are shown below:

> 6. Attached as Exhibit C hereto is a page from Canadian Tire's 2004 Annual Catalog which shows a LITTER MAID self cleaning cat litter box. This page also shows cat litter from third party suppliers which is common since cat litter and cat litter boxes are complementary products. Canadian Tire's Annual Catalog is distributed to thousands of Canadian households across Canada.
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> 7. My company recently introduced LITTER MAID cat litter to the American and Canadian markets. Attached as Exhibit 0 hereto is a copy of page 15 from the Applica Incorporated 2004 Annual Report which shows LITTER MAID cat litter as well as a LITTER MAID cat litter box and other LITTER MAID products.

The exhibit material referred to above substantiate Mr. Fretwell's testimony. Retail sales in Canada of LITTER MAID cat litter boxes and accessories averaged about $228,000 annually for the four year period 1998 - 2001, increasing to about $1.33 million annually for the three year period 2002 - 2004.

Mr. Fretwell's concerns are voiced at paragraph 11 of his affidavit, shown below:

> 11. Based on my experience I believe Canadian consumers and retailers are likely to confuse LitterMate when used with cat litter for the LITTER MAID trade-mark and are likely to believe that said cat litter is manufactured for use in LITTER MAID cat boxes so that the automatic features of such boxes function most effectively.

APPLICANT'S EVIDENCE

Mr. Pickard's evidence may be summarized as follows. Mr. Pickard is the inventor of the applicant's product, and has been President of the applicant company since 1994. The applicant produces and sells over 160 products, based on cereals, legumes or oilseeds, for food and industrial purposes. The applicant owns LitterMate Bio-Products Ltd. ("Bio-Products"), a company which is dedicated to enhance the liquid absorption attributes of waxy hull-less barley. The intellectual property developed by Bio-Products is owned by the applicant. The applicant's LITTERMA TE product is sold throughout western Canada in specialty pet stores. Packaging for the applicant's product prominently features the applied for mark. The applied for mark LITTERMA TE was derived from two cats which served as cat litter testers. They were from the same litter and were therefore "litter mates."

From my inspection of the exhibit material attached to Mr. Pickard's affidavit, I note that the packaging referred to above identifies Bio-Products, rather than the applicant InfraReady, as the person to contact in respect of the product. I note also that an invoice for the LITTERMA TE product, dated August 24,2005, refers to Bio-Products, rather than to the applicant, as the vendor of the cat litter.

REPLY EVIDENCE

Ms. Hung's affidavit merely serves to introduce into evidence corporate searches for the applicant InfraReady and for Bio-Products. The documents, copied from the Saskatchewan Corporations Branch, show that the applicant was incorporated in 1998 while Bio-Products was

incorporated in 2003. Both companies share the same office and mailing address, and Mr. Pickard is a director of each company. However, there is no indication in the documents of any ownership of Bio-Products by InfraReady.

GROUNDS OF OPPOSITION (A) AND (D)

With respect to the grounds of opposition denoted by (a) and (d) above, the opponent submits that the Pickard affidavit is ambiguous with respect to who, as between the applicant and Bio- Products, began to use the mark LITTERMA TB. The opponent also questions, among other things, how Mr. Pickard can claim to be President of the applicant since 1994 when the applicant was not incorporated until 1998.

The opponent's submissions in respect of whether the applicant can claim proprietary rights to the subject mark LITTERMA TE are set out at page 9 of its written argument, shown, in part, below:

> The Pickard Affidavit neither alleges nor establishes the existence of a license agreement between the two entities pursuant to which control of the character or quality of the wares manufactured and sold by LitterMate Sio-Products Ltd. would be exercised by the Applicant. The Applicant did not establish the relationship between the two companies or demonstrate that they are closely related or in a close corporate nexus. The Pickard Affidavit merely states that the Applicant, InfraReady Products (1998) Ltd., is "the owner" of LitterMate Sio-Products Ltd. However, this statement is contradicted by the Hung Affidavit which shows that InfraReady Products (1998) Ltd. is not listed as a director, officer or shareholder of LitterMate Sio-Products Ltd. On the other hand, the Hung Affidavit does establish that the Applicant and LitterMate Sio-Products Ltd. are two distinct legal entities and are in good standing.

I agree with the opponent's submissions that lacunae in Mr. Pickard's testimony raise ambiguities as to who began to use the subject mark, what proprietary rights the applicant may claim to the subject mark LITTERMATE and whether such rights, if any, reside in Bio-Products. As such ambiguities must be resolved against the applicant (see *Conde Nast Publications Inc.* v. *Union des Editions Modernes* (1979) 46 C.P.R.(2d) 183 at 186 (F.C.T.D.)), I find that the opponent succeeds under the grounds of opposition denoted by (a) and (d) above. I would add that even if Bio-Products was a wholly owned subsidiary of the applicant, that fact, by itself, would be insufficient to establish a trade-mark license agreement between InffaReady and Bio Products conforming to Section 50 of the *Trade-marks Act:* see *MCI Communications Corp.* v. *MCI Mu/tinet Communications Inc.* (1995),61 C.P.R. (3d) 245 at 254 (TMOB).

GROUNDS OF OPPOSITION (B) AND (C)

I will next consider the grounds of opposition raised by grounds (b) and (c), above, assuming that the applicant InffaReady does have full proprietary rights to the applied for mark. Grounds (b) and (c) turn on the issue of confusion between the applied for mark LITTERMA TE and the opponent's mark LITTER MAID. The material dates to assess the issue of confusion are the date of filing the application, that is, June 30,2003, with respect to ground (c) alleging non entitlement, and the date of decision with respect to ground (b) alleging non-registrability: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons* v. *Canadian Retired Persons* (1998),84 C.P.R.(3d) 198 at 206 - 209 (F.C.T.D.).

LEGAL ONUS AND TEST FOR CONFUSION

The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2) of the *Trade-marks Act,* between the applied for mark LITTERMATE and the opponent's mark LITTER MAID. The presence of an onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd.* v. *Mo/son Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.). The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in Section 6(5) of the *Trade-marks Act:* the inherent distinctiveness of the 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; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc.* v. *Tammy L. Marchildon and The Registrar of Trade-marks* (1996),66 C.P.R.(3d) 308 (F.C.T.D).

CONSIDERATION OF SECTION 6(5) FACTORS

The applied for mark LITTERMATE possesses a relatively low degree of inherent distinctiveness since the mark suggests a connection with the wares cat litter. Similarly, the opponent's mark LITTER MAID also possesses a relatively low degree of inherent distinctiveness. The applicant's evidence is insufficient for any conclusions to be made in respect

of whether the applied for mark acquired distinctiveness at the later material date. In this regard, the applicant has not presented any evidence quantifying the extent of use or advertising of the applied for mark. I am, however, able to conclude from the opponent's evidence that its mark LITTER MAID had acquired some reputation in Canada at the material dates through sales under its mark. The length of time that the marks in issue have been in use in Canada favours the opponent as the opponent's use of its mark LITTER MAID predates the applicant's use of its mark LITTERMA TE by at least five years. The nature of the parties' wares are different in that the opponent's registered mark LITTER MAID covers a mechanical device while the applicant's product is the material that would be used in conjunction with the device. However, the parties' wares are complementary products and, as conceded by the applicant in its written argument, the parties' wares" may well be sold in the same channels of trade and to the same class of purchasers." Further, the opponent's evidence confirms that cat litter products are a natural expansion of the opponent's business. Lastly, the marks LITTERMATE and LITTER MAID in their entireties resemble each other to a fair extent in all respects, that is, visually, in sounding, and in the ideas they suggest. In regard to the latter, both marks suggest the idea of a "litter helper."

In *Borden, Inc.* v. *Ogilvie Flour Mills Co. Ltd. (No. i)* (1978),44 C.P.R.(2d) 263, this Board considered whether the applied for mark MIRA-MEAL for pet food was confusing with the opponent's mark MIRRA-COAT for a nutritional food supplement for household pets. The Board refused the application based, in part, on the reasoning below, at p. 267:

> A pet owner it seems to me shopping for pet food and familiar with opponent's MIRRA-COAT product but perhaps having an imperfect

> recollection of it would I am satisfied be inclined to assume on seeing applicant's wares that they were the wares of the opponent. He could not in my view avoid concluding that a party who manufactures a pet food supplement would also manufacture pet foods.

The opponent submits that, in the instant case, the same reasoning applies and that the average cat owner shopping for cat litter would assume that the applicant's wares sold under the mark LITTERMATE were the wares of the opponent sold under the mark LITTER MAID.

Considering all of the above, I find that the applicant has not met the onus on it to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the marks in issue at the material dates. The opponent therefore succeeds on the grounds of opposition denoted by (b) and (c) above.

In view of the foregoing, the subject application is refused.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 13th DAY OF NOVEMBER, 2007.

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Myer Herzig,
Member,
Trade-marks Opposition Boar