



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

Citation: 2014 TMOB 148
Date of Decision: 2014-07-21

**IN THE MATTER OF OPPOSITIONS by
Dairy Farmers of Canada/Les Producteurs
Laitiers du Canada to application
Nos. 1,407,605 and 1,430,288 for the trade-
marks MONSTER MILK and MONSTER
MLK respectively, in the name of Cytosport,
Inc.**

[1] Dairy Farmers of Canada/Les Producteurs Laitiers du Canada (the Opponent) opposes registration of the trade-marks MONSTER MILK and MONSTER MLK (sometimes collectively referred to as the Marks) that are the subject of application Nos. 1,407,605 and 1,430,288 respectively.

[2] The applications were filed by Cytosport, Inc. (the Applicant) on August 18, 2008 and March 9, 2009 respectively, and are based upon proposed use of the Marks in Canada in association with the following wares, as revised:

Dietary and nutritional supplements for use in athletic training, namely for improving body strength and building muscle, excluding ready to drink beverages. (The Wares)

[3] The oppositions were brought by the Opponent under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The determinative issue in these proceedings is whether the Marks are deceptively misdescriptive of the character or quality of the Wares.

[4] For the reasons explained below, each opposition is rejected.

The Record

[5] The Opponent filed essentially identical statements of opposition against each application on October 5, 2011. The statements of opposition claimed that the applications do not conform to the requirements of section 30 of the Act for a number of reasons, and that the Marks are not registrable pursuant to section 12(1)(b) of the Act and that they are non-distinctive pursuant to section 2 of the Act since the average consumer is likely to believe that they are made of “real milk” or contain “real milk”.

[6] The Applicant filed and served a counter statement in each case in which it denied the Opponent’s allegations.

[7] As its evidence in each case, the Opponent filed an affidavit of Ian MacDonald, National Director, Marketing and Nutrition of the Opponent, sworn January 6, 2012. The MacDonald affidavit serves, among others, to introduce into evidence various definitions for the word “milk” as well as copies of the relevant sections of various provincial and federal legislations and regulations applicable to dairy products including milk. I shall indicate at this point of my decision that I will not refer to or place any weight on any statements which constitute the opinions of the affiant on issues that go to the merit of the oppositions [see *British Drug Houses Ltd v Battle Pharmaceuticals* (1944), 4 CPR 48 at 53 (Can Ex Ct)]

[8] As its evidence in each case, the Applicant filed the affidavits listed below:

- Ryan Steeves, an associate lawyer employed by the firm representing the Applicant, sworn September 24, 2012. The Steeves affidavit essentially serves to introduce into evidence various definitions for the word “milk”;
- Andrea Pitts, a law student employed by the same firm, sworn September 21, 2012. The Pitts affidavit essentially serves to introduce into evidence the results of marketplace searches for products containing the words “milk”, “butter” or “cream”;
- Gustavo Gil, an articling student employed by the same firm, sworn September 28, 2012. The Gil affidavit essentially serves to introduce into evidence the results of an Internet

search using the Google search engine for products and packaging using or displaying the word “milk”; and

- Karen E. Thompson, a trade-mark searcher employed by the same firm, sworn September 24, 2012. The Thomson affidavit essentially serves to introduce into evidence the results of various searches of the records maintained by the Canadian Intellectual Property Office through Onscope’s online trade-mark database for active trade-marks consisting of or including the words “milk”, “butter”, or “cream”;

[9] The Applicant also filed in each case, two affidavits of its Vice President, Legal and Regulatory Affairs, Roberta White. The first affidavits were sworn September 20, 2012. They were replaced in each case by a second affidavit sworn October 9, 2012. The second affidavits were meant to correct errors made at the time of filing the first affidavits. The White affidavit provides information on the Applicant’s business and discusses the MONSTER MILK and MONSTER MLK products, which are proposed to be part of the MONSTER series of products designed and specially formulated for the more serious athlete or bodybuilder seeking to build or maintain muscle mass.

[10] None of the witnesses was cross-examined on their affidavits.

[11] Both parties filed written arguments and were represented at a hearing during which the Opponent withdrew all the non-conformity grounds of opposition based on section 30 of the Act, except the one based on subsection 30(i). Accordingly, these grounds of opposition will not be discussed further.

The parties’ respective burden or onus

[12] The Opponent has the initial evidentiary burden to establish the facts alleged to support each ground of opposition. Once that burden is met, the legal burden or onus that each of the Marks is registrable remains on the Applicant, on a balance of probabilities [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

Analysis

The non-conformity ground of opposition based on section 30(i) of the Act

[13] The Opponent has pleaded that the applications for the Marks do not comply with section 30(i) of the Act because in each case, the Applicant's statement that it is satisfied of its entitlement to use each of the Marks in Canada was false in view of "the content of the present opposition[s] and in light of the content of several federal and provincial legislations".

[14] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional circumstances such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB)] or where there is a *prima facie* case of violation of a piece of federal legislation [see *Interprovincial Lottery Corp v Monetary Capital Corp* (2006), 51 CPR (4th) 447 (TMOB); and *Interactive Design Pty Ltd v Grafton-Fraser Inc* (1998), 87 CPR (3d) 537 (TMOB)]. The material date to assess this issue is the date of filing of the application for the mark [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)].

[15] In the present cases, the Opponent has not identified the specific pieces of legislation that would render the statements made by the Applicant under section 30(i) false. The Applicant contends that this contravenes section 38(3)(a) of the Act because the ground as pleaded is not set out in sufficient detail to enable it to reply thereto. However, according to *Novopharm Limited v AstraZeneca AB* (2002), 21 CPR (4th) 289 (FCA), I must assess the sufficiency of the pleadings in association with the evidence. As indicated above, the MacDonald affidavit includes excerpts from a selection of pieces of legislations and regulations. More particularly, Exhibit IM-4 includes excerpts from the following:

- *Food and Drugs Act, Consolidated Statutes of Canada* (RSC 1985, c. F-27);
- *Consumer Packaging and Labelling Act, Consolidated Statutes of Canada* (RSC 1985, c. C-38);
- *Dairy Products Regulations* (SOR/79-840); and

- *Food Products Act*, Revised Statutes of Quebec (RSQ, c. P-29).

[16] The MacDonald affidavit also includes under Exhibit IM-5 excerpts from the 2003 *Guide to Food Labelling and Advertising* of the *Canadian Food Inspection Agency*.

[17] I am prepared to infer that these are the federal and provincial legislations the Opponent was referring to in each of its statements of opposition.

[18] That said, the fact is that allegations of non-compliance with provincial statutes are not an appropriate basis for a section 30(i) ground of opposition [see *Interprovincial Lottery Corp*, *supra*; *Interactive Design Pty*, *supra*; and *Producteurs Laitiers du Canada/Dairy Farmers of Canada v Lander* 2013 TMOB 178 (CanLII) (*Land of Milk*), at para 14]. Thus, the *Food Products Act* cannot form the basis of a section 30(i) ground of opposition.

[19] Turning to the federal pieces of legislation, the Opponent refers me to section 5 of the *Food and Drugs Act*, which provides that: “No person shall label, package, treat, process, sell or advertise any food in a manner that is false, misleading or deceptive or is likely to create an erroneous impression regarding its character, value, quantity, composition, merit or safety”, and to section 7 of the *Consumer Packaging and Labelling Act*, which is essentially to the same effect. The Opponent also refers me to section 9.4.1 of the 2003 *Guide to Food Labelling and Advertising* which provides that: “Milk, unless otherwise designated, refers to cow’s milk [B.08.003]. The standards for fluid milks are set and enforced by municipal, provincial, and federal authorities. [...] Milk from an animal other than a cow must include the animal source of the milk.”

[20] The Applicant submits that the relevancy of the 2003 *Guide to Food Labelling and Advertising* is arguable as it is a guide only as opposed to a piece of legislation *per se* and as it is dated for the year 2003. However, I note that section 9.4.1 expressly refers to section B.08.003 of the *Food and Drug Regulations*.

[21] Still, the Applicant submits that it is not clear whether these pieces of legislation apply to dietary and nutritional supplements. Even if they do, the Applicant submits that there is no evidence in the present cases that the Wares will not conform to all relevant statutes and regulations in relation to their production and sale. To the contrary, Ms. White expressly states at

paragraph 5 of her affidavit that the Applicant's authorized distributor in Canada works with its international suppliers to ensure that imported products are compliant with relevant Canadian laws and regulations. The Applicant draws a parallel between the present cases and the *Land of Milk* decision wherein Board Member Flewelling wrote at para 26:

In his affidavit, Mr. Landry confirms that the wares will conform to all relevant statutes and regulations in relation to the production and sale of the products identified therein. As a result, I feel comfortable making the inference that the Dairy Wares are made of dairy-based milk or contain dairy-based milk and that the Non-Dairy Wares are not made of dairy-based milk or do not contain dairy-based milk.

[22] While these comments were made in the context of assessing a section 12(1)(b) ground of opposition rather than one based on section 30(i) of the Act, I agree with the Applicant that the fact remains that the statement was made by the affiant and the Registrar was prepared to rely on the statement made. I see no reason not to apply a similar reasoning in the present cases.

[23] Indeed, I see no reason not to assume that the Applicant will comply with packaging and labelling legislation in Canada [see also by analogy *Dairy Bureau of Canada v Popsicle Industries Ltd* (199), 30 CPR (3d) 115 (TMOB); and *Dairy Farmers of Canada v ThaiDesserts Inc* 2010 TMOB 46 (CanLII)]. Furthermore, there is no evidence in the present cases that the Wares would not be made of or contain dairy-based milk.

[24] In view of the foregoing, I am not satisfied that the Opponent has met its evidential burden with respect to the alleged pieces of legislation.

[25] Accordingly, the section 30(i) ground of opposition is dismissed in each case.

The non-registrability ground of opposition based on section 12(1)(b) of the Act

[26] The Opponent has pleaded that the Marks are not registrable since the Marks, whether depicted, written or sounded, are deceptively misdescriptive in the English language of the character or quality of the Wares in association with which they are proposed to be used. Indeed, when depicted, written or sounded, the average consumer is likely to believe that the Wares are made of "real milk" or contain "real milk".

[27] The issue as to whether a mark is clearly descriptive or deceptively misdescriptive must

be considered from the point of view of the average purchaser of the associated wares or services. Furthermore, the mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd v Registrar of Trade Marks* (1978), 40 CPR (2d) 25 (FCTD); and *Atlantic Promotions Inc v Registrar of Trade Marks* (1984), 2 CPR (3d) 183 (FCTD)]. Character means a feature, trait or characteristic of the product and “clearly” means “easy to understand, self evident or plain” [see *Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 (ExCt)]. The material date to assess this issue is the date of filing of the application for the mark [see *Fiesta Barbecues Ltd v General Housewares Corp* (2003), 28 CPR (4th) 60 (FCTD)].

[28] For a trade-mark to be considered clearly descriptive, the mark must not be merely suggestive. The purpose of the prohibition with respect to clearly descriptive trade-marks is to prevent any single trader from monopolizing a term that is clearly descriptive or common to the trade, thereby placing legitimate traders at a disadvantage [see *Canadian Parking Equipment Ltd v Canada (Registrar of Trade-marks)* (1990), 34 CPR (3d) 154 (FCTD)]. For a trade-mark to be considered deceptively misdescriptive, the mark must mislead the public as to the character or quality of the wares and services. The mark must be found to be descriptive so as to suggest the wares or services are or contain something that is not the case. The purpose of the prohibition with respect to deceptively misdescriptive trade-marks is to prevent the public being misled [see *Atlantic Promotions, supra*; and *Provenzano v Canada (Registrar of Trade-marks)* (1977), 37 CPR (2d) 189 (FCTD)].

[29] Also, as stated by Mr. Justice Martineau in *Neptune SA v Canada (Attorney General)* (2003), 29 CPR (4th) 497 (FCTD) at paragraph 11.

To determine whether a trade-mark falls under [the section 12(1)(b)] exclusion, the Registrar must not only consider the evidence at his disposal, but also apply his common sense in the assessment of the facts. The decision that the mark is either clearly descriptive or deceptively misdescriptive is based on his initial impression. He must consider it not in isolation but in light of the product or service in question.

[30] As noted by the Applicant, the Opponent has only pleaded that the Marks are *deceptively misdescriptive* of the character or quality of the Wares in association with which they are

proposed to be used; the Opponent has not pleaded that the Marks are *clearly descriptive* of the character or quality of such wares.

[31] The Applicant submits that the Opponent has not met its burden with respect to this ground as it has failed to adduce any evidence that the Applicant's Wares would not be made of or contain or could not be made of or contain "real cow's milk" or "real dairy based milk" as alleged in the statements of opposition. In fact, the Applicant submits that it is very arguable that the nutritional supplements of the type proposed to be sold by the Applicant could contain protein sources that are also found in cow's milk.

[32] As indicated above, there is no evidence in the present cases that the Wares would not be made of or contain dairy-based milk. According to the White affidavit, the MONSTER MILK and MONSTER MLK products have been specifically designed to enhance or promote muscle size and strength. The formulation for the MONSTER MILK and MONSTER MLK products includes a greater concentration of lean protein, including protein that are digested more slowly, in order to supply muscle fibers with amino acids for an extended period of time.

[33] The Applicant further submits that the word "milk" has a number of meanings other than "cow's milk".

[34] As pointed out by the Applicant, the Opponent's own evidence introduced through the MacDonald affidavit provides a number of definitions for the word "milk" that are unrelated to "cow's milk" (or "real milk") or to milk products that originate from the dairy industry. For instance, the Oxford Dictionary [Exhibit IM-1] includes the following:

1. an opaque white fluid secreted by the female mammals for the nourishment of their young;
2. the milk of cows, goats, or sheep as food;
3. the milk-like juice of plants, e.g. in the coconut;
4. a milk-like preparation of herbs, drugs, etc.;
5. draw milk from (a cow, ewe, goat, etc.);
6. exploit (a person) esp. financially;

7. get all possible advantage from (a situation);
8. extract esp. venom, etc. from;
9. etc.

[See also to the same effect, the other dictionary definitions introduced through the Steeves affidavit and Exhibits “A” to “J” attached thereto.]

[35] The Applicant submits that these definitions make it clear that the word “milk” could mean many different things and would not, in the mind of an average consumer, necessarily refer to cow’s milk.

[36] The Applicant submits in this regard that the words “milk”, “butter” and/or “cream” are frequently used in the Canadian marketplace in reference to food products and other products that do not contain cow’s milk (or any dairy product). More particularly, the Applicant relies on the visits Ms. Pitts made to various grocery stores and convenience stores in Ottawa in June 2012, where she purchased numerous products, none of the ingredients of which includes any dairy product. For the purpose of my analysis, I will only list the products bearing a description that contain the word “milk”:

1. Organic Edensoy Vanilla Soy Milk [Exhibit “D”];
2. Thai Kitchen Coconut Milk [Exhibit “F”];
3. CELEBRATION Herbals, Caffeine Free Milk Thistle Seed Herbal Tea [Exhibit “G”];
4. NOW Silymarin Milk Thistle Extract, 120 tablets/capsules [Exhibit “I”];
5. Oatmeal Goat Milk & Honey Pure & Natural Soap [Exhibit “L”];
6. SO DELICIOUS Coconut Milk lactose free frozen desert [Exhibit “N”];
7. EXACT Milk of Magnesia USP [Exhibit “O”];
8. Original MILK-BONE Brand dog biscuits [Exhibit “Q”];
9. Nourishing Coconut Milk (Shampoo) [Exhibit “R”];
10. Jamieson Milk Thistle caplets [Exhibit “S”]; and

11. DELICIOUS Dairy Free Coconut Milk for Coffee [Exhibit V’].

[37] While Ms. Pitts’ purchases were made after the material date, I agree with the Applicant that the products so purchased by Ms. Pitts essentially illustrate some of the dictionary definitions outlined above.

[38] The Applicant submits that the Gil affidavit also provides numerous examples of online references to non-dairy products that include the word “milk” as part of their name. The Applicant points out that many of these products specifically exclude milk or dairy or are completely unrelated to cow’s milk or dairy. Examples include references similar to those contained in the dictionary definitions outlined above, namely human breast milk, soy milk, sheep milk, almond milk, milk thistle, milk of magnesia, etc. As for Ms. Pitts, the fact that Mr. Gil may have conducted these searches after the material date is less relevant since most if not all of these references are products that essentially illustrate the dictionary definitions referred to in the MacDonald and Steeves affidavits.

[39] To sum up, I find it fair to agree with the Applicant that consumers are accustomed to encountering the word “milk” in association with foods or the like that do not necessarily contain cow’s milk (or any dairy product). However, this is not equivalent to saying that the word “milk” by itself could not be found deceptively misdescriptive of non-dairy wares. I will return to this point later.

[40] The Applicant further submits that the Thompson affidavit makes reference to over 300 active trade-marks that consist of or include the element MILK, many of which cover goods and/or services that are unrelated to “cow’s milk” or any product of the dairy industry. More particularly, the Applicant refers to Exhibit “B” attached to the Thompson affidavit, which includes a summary of the search results. The Applicant submits that clearly the Registrar has considered these “MILK in combination marks” to be registrable and has taken the position that “MILK in combination marks” are not clearly descriptive or deceptively misdescriptive of the wares or services covered by these marks, where the wares or services covered by the marks in question are non-dairy products. The Applicant further makes the same argument for other trade-marks that include the words “butter” or “cream”. However, the fact that these trade-marks were registered has no bearing on the registrability of the Marks at issue. Suffice it to say that each

case must be decided on its own merits.

[41] Lastly, but not less importantly, the Applicant submits that the Opponent has not provided any evidence to support the conclusion that, when considering each of the Marks in their entirety, consumers would believe that MONSTER MILK and MONSTER MLK deceptively misdescribe a character or quality of the Applicant's Wares, in a manner that would deceive or mislead consumers into believing that the products contain cow's milk or dairy based milk.

[42] Rather, and considering the slang meaning of MONSTER provided in the White affidavit - which states that MONSTER is suggestive of a person that has large muscles - the Applicant submits that each of the Marks could suggest several other meanings or ideas. For example, even if MLK were interpreted to mean "milk", the Marks could suggest:

- a) A product that is nutritious, nourishing, or beneficial for the development or maintenance of larger muscles - where the element MILK is understood metaphorically to mean beneficial and nourishing "food" for muscles;
- b) A product that is nutritious and beneficial for a person who engages in athletic training designed to improve or increase muscle mass;
- c) Metaphorically MONSTER MILK could also be understood as the best, most basic, or most healthy substance to "feed" muscles to promote healthy growth as would, for example, a mother's milk - which is often said to promote health and growth in babies.

[43] I agree with the Applicant.

[44] The Marks at issue are composed of two words: MONSTER and MILK or MLK. Concerning more particularly the MLK portion of the Applicant's trade-mark MONSTER MLK, it is possible that such portion would not be pronounced by the average consumer as "milk". Rather, it is possible that such portion would be viewed by consumers as an acronym involving the initials M-L-K. In fact, there is no evidence to suggest that the average consumer for the Wares would assume that MLK means "milk".

[45] Even if a consumer were to interpret MLK to mean “milk”, it would not be clear to a consumer what meaning of “milk” would be applicable here.

[46] The word MILK (or MLK) is only one word in a composite mark. The combination of the word MONSTER with the word MILK (or MLK) is unusual. Aside from the word MILK (or MLK) that may suggest the character of the dietary and nutritional supplements, there remains the distinctive portion MONSTER. The word MILK (or MLK) is no more dominant than the word MONSTER. The combination of MONSTER and MILK (or MLK) does not create a trade-mark that can be viewed as a whole as descriptive of the character or quality of the dietary and nutritional supplements. As the first portion of the test is not met, the Marks cannot be found misdescriptive. [See by analogy, *ThaiDesserts Inc, supra*, at para 15, where the trade-mark DairyLogic in association with frozen desserts and puddings was found not to be descriptive of the character or quality of the wares].

[47] In view of the foregoing, the non-registrability ground of opposition is dismissed in each case.

The non-distinctiveness ground of opposition

[48] The Opponent has pleaded that:

[...] the [Marks are] not distinctive of the wares of the Applicant, since the [Marks do] not actually distinguish the wares in association with which [they are] proposed to be used by the Applicant, nor [are they] adapted to so distinguish them.

[49] As noted by the Applicant, the individual paragraph that pleads the non-distinctiveness ground of opposition does not itself set out sufficiently specific reasons for which the Marks are not distinctive. However, when that paragraph is read as part of the whole statements of opposition and in conjunction with the evidence of record, it is apparent that the non-distinctiveness ground of opposition should be understood to encompass the pleading that the Marks are not distinctive by reason of the fact that they are deceptively misdescriptive of the character or quality of the wares in association with which they are intended to be used (re the non-registrability ground discussed above) [see *Novopharm, supra*]. A trade-mark that is deceptively misdescriptive of its associated wares is *prima facie* not distinctive.

[50] The material date to assess this ground of opposition is the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004) 34 CPR (4th) 317 (FC)].

[51] Having regard to my earlier finding under the non-registrability ground of opposition, the difference in material date having no effect on this issue, I conclude that each of the Marks was adapted to distinguish the Wares of the Applicant from those of others within the meaning of section 2 of the Act as of the filing date of the statements of opposition. Accordingly, the non-distinctiveness ground of opposition is dismissed in each case.

Disposition

[52] In view of the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I reject the oppositions pursuant to section 38(8) of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office