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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 6

Date of Decision: 2020-01-27

IN THE MATTER OF AN OPPOSITION

Rex Inc.

Opponent

and

Saisha Enterprises Inc.

Applicant

1,742,334 for ORGANICTREE

Application

INTRODUCTION

[1] Rex Inc. (the Opponent) opposes registration of the trademark ORGANICTREE (the Mark), which is the subject of application No. 1,742,334 by Saisha Enterprises Inc. (the Applicant).

[2] The Mark is applied for in association with the following goods:

(1) Ashwagandha root powder, Brown flaxseed (whole), Brown flaxseed (milled), Cayenne pepper powder, Cinnamon powder, Coriander seed (whole), Garlic powder, Ginger powder, Onion powder, Psyllium husk powder, Psyllium husk whole, Tulsi leaf (Holy basil) powder, Turmeric powder.

(2) Andrographis powder, Ayurvedic teas, Black pepper (whole), Black pepper (ground), Cumin seed (whole), Cumin seed powder, Fennel seed (whole), Fennel seed powder, Fenugreek seed (whole), Fenugreek seed powder, Shatavari powder, Trikatu powder.

[3] The opposition is primarily based on an allegation that the Mark is confusing with the Opponent's trademark ORGANIC TREE and design [the Opponent's Mark], used in association with a variety of food goods.

[4] For the reasons that follow, the opposition is rejected.

THE RECORD

[5] The application for the Mark was filed on August 18, 2015 on the basis of use in Canada with respect to goods (1) and proposed use in Canada with respect to goods (2).

[6] The application was advertised for opposition purposes on February 15, 2017. Numerous amendments to the *Trademarks Act*, RSC 1985, c T-13 (the Act) came into force on June 17, 2019. As the application was advertised prior to such amendments, pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read immediately before June 17, 2019.

[7] Having been granted a retroactive extension of time to do so, the Opponent opposed the application on September 26, 2017, by filing a statement of opposition under section 38 of the Act. The grounds of opposition set out in the statement are based on sections 30(i), 12(1)(d), 16(1)(a), 16(3)(a) and 2 of the Act.

[8] The Applicant filed a counter statement on October 13, 2017, denying each of the grounds of opposition and requesting an interlocutory ruling on the sufficiency of the pleadings. An interlocutory ruling striking the 30(i) and 12(1)(d) grounds of opposition issued on January 22, 2018. The remaining grounds of opposition are addressed below.

[9] In support of its opposition, the Opponent filed the affidavit of one of its officers, Arash Missaghi, sworn February 13, 2018 in Toronto, Ontario [the Missaghi Affidavit]. Mr. Missaghi was not cross-examined on his affidavit.

[10] The Applicant did not file evidence, but both parties filed written representations. Neither party requested an oral hearing.

[11] Before assessing the remaining grounds of opposition, I will first provide an overview of the Opponent's evidence, the evidential burden on the Opponent, and the legal onus on the Applicant.

THE OPPONENT'S EVIDENCE

[12] The Missaghi Affidavit is brief and can be summarized as follows:

- The Opponent filed an application in Canada for the registration of the Opponent's Mark, ORGANIC TREE and design (under Application No. 1,799,197, a copy of which is attached to the affidavit) [para 4]. I note that the application was filed on September 7, 2016, after the filing date of the application for Mark; nevertheless, the Opponent's application claims use in Canada since December 31, 1999 in association with a variety of food products.
- The Opponent "has been using its trademark in the US" and has a USPTO registration for the Opponent's Mark (under registration No. 5,304,592, a copy of which is attached to the affidavit) [para 5]. I note that the registration indicates 1999 as the date of first use.
- Attached to the affidavit is "further evidence in the form of a poster showing a series of products in association with [the Opponent's Mark]" [para 6]. This poster appears to be an advertisement depicting a variety of "Organic Tree" products, such as jams, canned baked beans and preserved fruits. However, the advertisement is undated and neither the poster itself nor Mr. Missaghi give any indication as to distribution of the advertisement.

EVIDENTIAL BURDEN AND LEGAL ONUS

[13] Before considering the grounds of opposition, it is necessary to review the basic requirements with regard to (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[14] With respect to (i), in accordance with the usual rules of evidence, there is an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Ltd v Molson Companies Ltd*, 1990 CarswellNat 1053, 30 CPR (3d) 293

(FCTD) at para 11]. The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

[15] With respect to (ii), the legal onus is on the applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent in the statement of opposition (for those allegations for which the opponent has met its evidential burden). The presence of a legal onus on an applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, then the issue must be decided against the applicant.

ANALYSIS – SECTION 16 GROUNDS – NON-ENTITLEMENT

[16] In its statement of opposition, the Opponent pleads that, pursuant to sections 38(2)(c), 16(1)(a) and 16(1)(3) of the Act, the Applicant is not the party entitled to registration of the Mark in that at the date of filing of the subject application (on the basis of use in Canada for goods (1) and proposed use in Canada for goods (2)), the Mark was confusing with the Opponent's Mark "which continues to be in use for a long time" [paras 4(d) and 4(e)].

[17] In order to meet its initial burden in support of these non-entitlement grounds, the Opponent was required to show that it had used or made known its trademark in Canada prior to the date of filing of the subject application for the Mark, namely August 18, 2015. Furthermore, the Opponent was required to establish non-abandonment of its trademark as of the date of advertisement of the subject application for the Mark, namely February 15, 2017.

[18] At this point, I would note that the Opponent's representations were brief and amount to a reiteration that the application for the Mark should not proceed to registration, "given the extent of the time period over which the Opponent's goods [have] been in the Canadian marketplace".

[19] For its part, in its written representations, the Applicant argues that the Opponent has not met its initial evidential burden to establish that it has used or made known the Opponent's Mark in Canada at any time [paras 9 to 16].

[20] Indeed, at the outset, I note that Mr. Missaghi does not even clearly attest to the Opponent having used or made known the Opponent's Mark in Canada. Rather, it appears that the exhibits accompanying the Missaghi Affidavit are left to speak for themselves.

[21] With respect to the Opponent's Canadian application, the claimed date of use in Canada (since December 31, 1999) does not constitute evidence of actual use or made known of the Opponent's Mark in Canada. As submitted by the Applicant in its representations, "the Registrar does not have the discretion to take cognizance that a party has been using the mark which is the subject of a trademark application on the basis of the claims in that application" [para 10]. As noted by the Registrar in *Dimo's Tool & Die Ltd v Quantum Electronics Inc* (2009), 72 CPR (4th) 209 (TMOB) at para 5, it is the responsibility of the opponent to establish that it has in fact used or made known its mark and to establish the time period of such use or making known [see also *Artic Jungle Media v HTC Corporation*, 2011 TMOB 47 at para 11].

[22] Similarly, the registration of the Opponent's Mark in the United States does not constitute evidence of use or making known in Canada. Furthermore, notwithstanding the claimed date of first use, the mere registration of the Opponent's Mark in the United States does not constitute evidence of use of that mark in the United States. As such, the Opponent has not met the requirements for "made known" as set out in section 5 of the Act, since the Opponent has not clearly evidenced that its trademark was used in a country of the Union other than Canada. In any event, there is no evidence that the Opponent's Mark was made known in Canada since to be considered "well known" under section 5, the trademark must be known in a substantial area of Canada [*Valle's Steak House v Tessier* (1980), 49 CPR (2d) 218 (FCTD)].

[23] Finally, with respect to the exhibited poster, absent any context, I cannot conclude that it constitutes use or making known of the Opponent's Mark in Canada at any time.

[24] In view of the foregoing, I cannot find that the Opponent has met its aforementioned initial burden with respect to these grounds. As the Opponent has failed to meet its burden, I reject the grounds of opposition based on non-entitlement.

ANALYSIS - SECTION 2 GROUND – NON-DISTINCTIVENESS

[25] In its statement of opposition, the Opponent pleads that, pursuant to sections 38(2)(d) and 2 of the Act, the Mark is not distinctive in that it does not distinguish, nor is it adapted to distinguish, the associated goods from the goods associated with the Opponent’s Mark, “which has become known in Canada” [para 4(f)].

[26] The material date for this ground of opposition is the filing date of the opposition, namely, September 26, 2017 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317 at para 25]. With respect to an opponent’s initial evidentiary burden for a ground of this nature, its trademark “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 FC 657 at para 34; see also *Sadhu Singh Hamdard Trust v Navsun Holdings Ltd*, 2019 FCA 10 at para 4].

[27] However, as described above, the Missaghi Affidavit does not establish that the Opponent’s Mark has been used or made known in Canada to any extent at any time.

[28] Accordingly, I cannot find that the Opponent has met its initial burden with respect to this ground. As the Opponent has not met its burden, I reject the ground of opposition based on non-distinctiveness.

DISPOSITION

[29] In view of all of the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: No hearing held

AGENTS OF RECORD

No agent appointed

For the Opponent

Aventum IP Law LLP

For the Applicant