



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 147

Date of Decision: 2020-12-30

IN THE MATTER OF AN OPPOSITION

PROsnack Natural Foods Inc.

Opponent

and

Frank Ferragine

Applicant

1,794,557 and 2,043,870 for

Applications

Elevated Eats

INTRODUCTION

[1] Frank Ferragine (the Applicant) has applied for registration of the trademark Elevated Eats (the Mark), based on proposed use in Canada, in association with the following goods and services:

<p>Application No. 1,794,557 (hereinafter sometimes referred to as the original application)</p>	<p>Application No. 2,043,870 (hereinafter sometimes referred to as the divisional application)</p>
<p><u>Goods</u>: Garden hoes; gardening shears and scissors; gardening tools; gardening trowels. Garden hoses. Garden ornaments. Garden</p>	<p><u>Goods</u>: Fresh flowers, fresh vegetables and fresh fruits</p>

<p>furniture. Gardening gloves. Fresh garden herbs; seeds for fruit and vegetables</p> <p><u>Services:</u> Workshops and seminars in the field of gardening, food, nutrition, agriculture and farming. Providing a website in the field of gardening, agriculture, farming, food and nutrition</p>	
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[2] PROsnack Natural Foods Inc. (the Opponent) owns registrations for the following trademarks in association with nutritional health foods, mostly in the form of energy bars: ELEVATE (TMA867,428), ELEVATE ME (TMA712,170), ELEVATE ME PERK (TMA895,619) and ELEVATE ME PERK & Design (TMA895,613) (collectively, the Opponent’s Registered Trademarks, the particulars of which are set out in Schedule A) and has opposed the applications mainly on the basis that the Mark is confusing with its registrations for and use of these trademarks. The Opponent has further challenged the applications on the basis (i) that the goods/services covered are not in ordinary commercial terms and (ii) that the Applicant did not intend to use the Mark in Canada.

[3] For the reasons that follow, I find that application No. 2,043,870 should be refused for the goods “fresh vegetables and fresh fruits” and I reject the opposition with respect to the remaining Goods in application No. 2,043,870 and with respect to application No. 1,794,557.

BACKGROUND

[4] Application No. 1,794,557 was filed on August 5, 2016 and advertised for opposition purposes in the *Trademarks Journal* on May 3, 2017. On October 3, 2017, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). All references herein are to the Act as amended on June 17, 2019, with the exception of references to the grounds of opposition which refer to the Act before it was amended.

[5] The Opponent raises grounds of opposition based upon non-compliance with section 30; non-registrability under section 12; non-entitlement under section 16; and non-distinctiveness under section 2 of the Act, as summarized below:

- (a) The application does not comply with the requirements of section 30(a) of the Act because the goods described as “flowers” as well as the Services do not meet the requisite degree of specificity, nor are they described in ordinary commercial terms.
- (b) The application does not comply with the requirements of section 30(e) of the Act because the Applicant fails to state the date from which he has used the Mark in Canada in association with the Goods and Services and the application therefore contains an inaccurate statement.
- (c) The application does not comply with the requirements of section 30(i) of the Act because the Applicant could not have been satisfied he was entitled to use the Mark with the Goods and Services as he was aware of the Opponent’s prior use and registration of the Opponent’s Registered Trademarks.
- (d) The Mark is not registrable pursuant to section 12(1)(d) of the Act because it is confusing with the Opponent’s Registered Trademarks.
- (e) The Applicant is not the person entitled to register the Mark pursuant to section 16(3)(a) of the Act because the Mark was confusing with the Opponent’s Registered Trademarks which have been previously used by the Opponent in Canada.
- (f) The Mark is not distinctive pursuant to section 2 of the Act, as it does not actually distinguish and is not adapted to distinguish the Applicant’s Goods and Services from those of the Opponent having regard to the use and advertisement by the Opponent of the Opponent’s Registered Trademarks in Canada.

[6] The Applicant filed and served a counter statement denying the grounds of opposition pleaded in the statement of opposition.

[7] In support of its opposition, the Opponent filed the affidavit of Dulce Campos, a trademark researcher employed by the Opponent's trademark agents, sworn June 4, 2018 along with Exhibits 1-13 thereto (the Campos affidavit). Ms. Campos introduces into evidence the results of various online searches she conducted and provides some information regarding the Opponent's business, including the promotion and use of the Opponent's Registered Trademarks in Canada. Ms. Campos was not cross-examined on her affidavit.

[8] The Applicant elected not to file any evidence. Only the Opponent filed a written argument and requested a hearing.

[9] On July 29, 2020, a few weeks before the scheduled hearing, the Applicant filed an amended application narrowing the description of the goods "vegetables, fruits and flowers" to "fresh flowers, fresh vegetables and fresh fruits". The Applicant further submitted a request to include these goods, as amended, in a divisional application under section 39(1) of the Act. The division was recorded on the register on August 5, 2020 and by way of official letter dated August 10, 2020, the Registrar accepted the amendment and confirmed the creation of the divisional application under No. 2,043,870.

[10] The scheduled hearing was subsequently cancelled when the Opponent withdrew its request.

APPLICATION NO. 1,794,557

[11] I will first consider the Opponent's opposition to application No. 1,794,557.

Material dates and onus

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

- Sections 38(2)(a) and 30 of the Act – the filing date of the application, namely, August 5, 2016 [*Delectable Publications Ltd v Famous Events Ltd*, (1989) 24 CPR (3d) 274 (TMOB); *Canadian National Railway Co v Schwauss* (1991), 35 CPR (3d) 90 (TMOB); *Tower Conference Management Co v Canadian Exhibition Management Inc*, (1990) 28 CPR (3d) 428 at 432-433 (TMOB)]. However, with respect

to the section 30(a) ground of opposition, it is the statement of goods and services as amended after the filing date which is assessed [*Eaton Williams (Millibank) Ltd v Nortec Air Conditioning Industries Ltd* (1982), 73 CPR (2d) 70 (TMOB)].

- Sections 38(2)(b) and 12(1)(d) of the Act – the date of my decision [*Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)];
- Sections 38(2)(c) and 16 of the Act – the filing date of the application, namely, August 5, 2016 [section 16(3) of the Act].
- Sections 38(2)(d) and 2 of the Act – the filing date of the opposition, namely, October 3, 2017 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185].

[13] 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 [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD)]. If this burden is met, the Applicant then bears the legal onus of establishing, on a balance of probabilities, that his application complies with the requirements of the Act.

[14] In applying these principles to the case at hand, the grounds of opposition below can be summarily rejected on the basis that the Opponent has failed to meet its evidential burden:

- Section 30(e) – Pleading that an application solely based on proposed use does not include the date from which the Applicant has used the Mark does not raise a proper ground of opposition pursuant to section 30(e). In any event, even were I to have considered that the Opponent had sufficiently raised a section 30(e) ground of opposition, it would still fail because the Opponent has not met its initial evidential burden. Section 30(e) of the Act requires that an applicant for a trademark based on proposed use include a statement in its application that, by itself and/or through a licensee, it intends to use said trademark in Canada. The application for the Mark contains the required statement and there is no evidence that such statement is untrue. I would add that the

absence of evidence of the Applicant's intention to use the Mark does not in the present circumstances suffice to discharge the Opponent's burden.

- Section 30(i) – This ground, as pleaded, also does not raise a proper ground of opposition. The Applicant's mere knowledge of the existence of the Opponent's Registered Trademarks does not in and of itself support the allegation that he could not have been satisfied of his entitlement to use the Mark [*Woot Inc v Woot Restaurants Inc/Les Restaurants Woot Inc*, 2012 TMOB 197]. Further, even were I to have considered that the Opponent had sufficiently raised a section 30(i) ground of opposition, it would still fail because the Opponent has not met its initial evidential burden. Section 30(i) of the Act requires that an applicant include a statement in its application that it is satisfied that it is entitled to registration of its trademark. Where this statement has been provided, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith [*Sapodilla Co Ltd v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. The application for the Mark contains the required statement and there is no evidence that this is an exceptional case.
- Sections 16(3)(a) and 2 – These grounds of opposition fail because the evidence adduced, as will be further discussed below, does not effectively demonstrate the use of the Opponent's Registered Trademarks in Canada at the filing date of the application nor that any of these trademarks had acquired a reputation in Canada that was sufficient to affect the Mark's distinctiveness at the date of filing the statement of opposition [see section 16(5) of the Act and *Bojangles' International LLC v Bojangles Café Ltd* (2006), 2006 FC 657, 48 CPR (4th) 427 at para 34 which sets out the Opponent's evidential burden].

Remaining grounds of opposition

Section 30(a)

[15] The Opponent alleges that the Goods are not in ordinary commercial terms since the wording "flowers" requires further specification. While these goods have been deleted from the original application, for the sake of efficiency, I note that in view of the amendments made to the

application on July 29, 2020 and accepted by the Registrar on August 10, 2020, the first prong of this ground of opposition has become moot and is hereby rejected.

[16] The Opponent further alleges that the Services are not in ordinary commercial terms, in particular that educational services and the provision of a website relating to “food” and “agriculture” are too broad and too vague and therefore require further specification. In its written argument, the Opponent submits that listings of acceptable services descriptions relating to “food” and “agriculture” found in CIPO’s *Goods and Services Manual* include the following more specific examples: “educational demonstrations in the field of growing organic food”, “vocational education in the field of food services” and “training in the use and operation of agricultural equipment”.

[17] The *Goods and Services Manual* is not exhaustive. It includes a representative list of acceptable goods and services descriptions. With respect to goods or services not listed in the *Goods and Services Manual*, acceptable listings can be used to indicate, by analogy, the kinds of statements that would also be acceptable to describe similar goods or services. A statement of goods or services is acceptable if it is as specific as, or more specific than, a related or similar listing. [*Trademarks Examination Manual*, section 2.4.5]

[18] Having exercised my discretion to check the *Goods and Services Manual* [*Johnson & Johnson v Integra Lifesciences Corp* (2011), 98 CPR (4th) 429 (TMOB)], I note that it lists the following amongst the examples of acceptable descriptions for services in the fields of “food” or “agriculture”: “retail sale of food”, “food and nutrition consultation services”, “pest control services for agriculture” and “vermin exterminating for agriculture”. Accordingly, I am satisfied that the statement of Services, when read as whole, is sufficiently specific and reject this ground of opposition.

Section 12(1)(d)

[19] An opponent meets its initial onus with respect to a section 12(1)(d) ground of opposition if the registration relied upon is in good standing. In this regard, the Registrar has the discretion to check the register in order to confirm the existence of the registration relied upon by an opponent [*Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu*

foods Ltd (1986), 11 CPR (3d) 410 (TMOB)]. Having exercised my discretion, I confirm that registration Nos. TMA867,428, TMA712,170, TMA895,619 and TMA895,613 are in good standing.

[20] I will focus my analysis on the registration for the trademark ELEVATE (TMA867,428) as I consider it to represent the Opponent's strongest case. In other words, if confusion is not likely between the Mark and this trademark, then it would not be likely between the Mark and any other of the Opponent's Registered Trademarks.

Test for confusion

[21] The test to determine the issue of confusion is set out in section 6(2) of the Act which stipulates that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification. Therefore, section 6(2) of the Act does not concern confusion of the trademarks themselves, but confusion of the goods or services from one source as being from another.

[22] In applying the test for confusion, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time they have been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks including in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and different weight will be given to each one in a context-specific assessment [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 54].

Inherent distinctiveness and extent known

[23] The trademarks at hand have a similarly low degree of inherent distinctiveness. Both are composed of ordinary dictionary words and both have somewhat of a laudatory connotation as a result of their respective inclusion of the terms “elevate” and “elevated” suggesting that the goods and services are of a quality above the normal level. Further, the Mark also includes the term “eats”, which adds a suggestive connotation to the Mark in relation to food.

[24] The strength of a trademark may be increased by it becoming known through promotion or use.

[25] As mentioned above, the Applicant has not presented any evidence that his Mark has been used or become known to any extent in Canada. Similarly, I am not satisfied that the Opponent’s evidence demonstrates that its marks are known to any significant extent in Canada or were actually used within the meaning of section 4 of the Act.

[26] The Campos affidavit includes:

- A printout from the WHOIS Lookup database at *www.webnames.ca* for *prosnack.com* [para 7, Exhibit 4]. I note that the Opponent is not listed as the registrant in the particulars for this domain name registration.
- Printouts dated June 1, 2018 from the website *www.prosnack.com* [para 8, Exhibit 5].
- Archived versions of this website, including some of the pages referenced in Exhibit 5 obtained from the Internet archive Wayback Machine [para 9, Exhibit 6].
- Printouts from social media pages featuring some of the Opponent’s Registered Trademarks [paras 10-11, Exhibits 7-8].
- An announcement taken from the electronic records of the Opponent’s trademark agents “regarding the acquisition of [the Opponent] by Naturally Splendid Enterprises Ltd.” [para 12, Exhibit 9].

- An Internet article published on October 19, 2017 by Private Capital News Wire titled “Naturally Splendid closes Prosnack acquisition and \$334K final tranche of private placement” [para 13, Exhibit 10].
- A copy of the “Investor Information [documentation] for Naturally Splendid” for 2017 found on the website *www.naturallysplendid.com* [para 14, Exhibit 11].
- Printouts dated June 4, 2018 from the website *www.glutenfreeexpo.ca* providing details of an event which Ms. Campos states she personally attended in January 2016 in Vancouver [para 15, Exhibit 12].
- Promotional materials displaying the trademark ELEVATE ME that Ms. Campos collected on this occasion from the Opponent’s exhibition booth [para 16, Exhibit 13].

[27] Considering that Ms. Campos is employed by the Opponent’s trademark agents, her evidence is inadmissible to the extent that the results of her searches and her attendance to the promotional event held in Vancouver in 2016 pertain to a contentious issue in this proceeding, namely, the use and promotion of the Opponent’s Registered Trademarks [*Cross Canada Auto Body Supply (Windsor) Limited et al v Hyundai Auto Canada*, 2006 FCA 133]. In any event, even if I were to find her evidence admissible, it would not be of much assistance to the Opponent as it contains little, if any, relevant or reliable information as to whether the Opponent’s Registered Trademarks had been used or were known to Canadians. The various website and social media excerpts Ms. Campos provides do not speak to the truth of their contents. There is also no evidence to establish that any of the pages were accessed or followed by consumers in Canada, nor to what extent if they were. Further, the materials that Ms. Campos collected while visiting a promotional event in no way allow me to assess to what extent the trademark they display is known, nor the length of time it was in use. All in all, the filing of evidence of an employee of the Opponent’s agents, of visits to websites and attendance at a promotional event on a specific day, does not allow me to determine whether the relied upon trademarks in the instant case were actually used by the Opponent or were known to any significant extent.

[28] Consequently, I find that the overall consideration of the section 6(5)(a) factor, which involves a combination of inherent and acquired distinctiveness of the parties' trademarks, does not significantly favour either party.

Length of time in use

[29] As mentioned above, the application is based on proposed use and the Applicant has not adduced any evidence that use of the Mark commenced since its filing.

[30] The Opponent's registration for the trademark ELEVATE shows that a declaration of use was filed on October 21, 2013. Without evidence clearly establishing use pursuant to section 4 of the Act, and in the absence of a certified copy of the registration, I am disinclined to even infer *de minimis* use of this trademark in Canada [*Tokai of Canada v Kingsford Products Company, LLC*, 2018 FC 951 at para 37]. Besides, an inference of *de minimis* use would not support the finding that the Opponent's trademark was known to any significant extent, or that it has necessarily been continuously used since the date declared [*Krauss-Maffei Wegmann GmbH & Co KG v Rheinmetall Defence Electronics GmbH*, 2017 TMOB 50 at para 20].

[31] Consequently, the section 6(5)(b) factor also does not significantly favour either party.

Goods, services or business and nature of the trade

[32] When considering the nature of the goods and services and the nature of the trade, I must compare the Applicant's statement of goods and services with those contained in the registrations relied upon by the Opponent [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. However, these 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. Evidence of the parties' actual trades is useful in this respect [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[33] With this in mind, I find that while there is some overlap or at least a connection between the parties' goods and services as far as fresh garden herbs and Services in fields of food and nutrition are concerned, the precise nature of the parties' goods and services is different (energy bars versus equipment for gardening and workshops, seminars and providing a website). In the absence of evidence or submissions regarding the consumers targeted by the Applicant's goods and services or the nature of his trade, I have no reason to conclude that the parties' channels of trade could not potentially overlap.

Degree of resemblance

[34] When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality and not dissected into their component parts. The appropriate test is not a side-by-side comparison but an imperfect recollection in the mind of a consumer of an opponent's trademark [*Veuve Clicquot* at para 20].

[35] When considered as a whole, I find that the parties' trademarks are more different than alike. The marks resemble each other to the extent that the first component of the Mark comprises the entirety of the Opponent's trademark ELEVATE. That said, the marks are not similarly structured and are visually and aurally different. The ideas they suggest also differ. In my view, the Mark connotes higher quality foods, provisions or crops whereas the trademark ELEVATE suggests that whoever consumes the Opponent's energy bars will somehow become better or raise to a superior level. Taking this into account, and considering that the terms "elevate" and "elevated" are not particularly distinctive as they are laudatory, I find that the differences between the trademarks in appearance and sound and particularly the differences in the ideas they suggest as a whole outweigh their similarities. Consequently, this factor favours the Applicant.

Conclusion regarding likelihood of confusion

[36] Taking all of the above into consideration, I find that the Applicant has met its onus to establish, on a balance of probabilities, that the Mark is not likely to cause confusion with the trademark ELEVATE relied upon by the Opponent. I reach this conclusion as I find that the lack of resemblance between the trademarks at hand in terms of appearance, sound and suggested

ideas, outweighs the overlap with respect to some of the parties' goods and the potential for overlap in their channels of trade.

[37] I would add that my conclusion regarding the likelihood of confusion would remain unchanged even were I to have considered any other of the Opponent's Registered Trademarks in my assessment of this ground of opposition as they are even more different than the Mark.

[38] Accordingly, the section 12(1)(d) ground of opposition is rejected.

APPLICATION NO. 2,043,870

[39] Section 40 of the Regulations provides that any action taken in respect of the original application, on or before the day on which the divisional application is filed, is deemed to be an action in respect of the divisional application, which includes the submission of a statement of opposition as well as any steps taken in an opposition proceeding such as the submitting of evidence, written argument or attendance at a hearing. In the case at hand, as the division was requested just a few weeks prior to the initially scheduled hearing, it follows that the issues, material dates, evidence and submissions regarding application No. 2,043,870 are identical to those discussed with respect to application No. 1,794,557.

[40] Consequently, my findings above regarding the grounds of opposition based upon non-compliance with section 30, non-entitlement and non-distinctiveness apply *mutatis mutandis*. The same goes for my analysis of the relevant factors done under the ground of opposition based upon non-registrability, with a distinction only with respect to the section 6(5)(c) factor as I have to consider the Applicant's Goods covered by application No. 2,043,870. In fact, while differences admittedly exist between energy bars and fresh fruits and vegetables, the latter are also food items which can arguably serve as nutritious snack food consumed on the go directly following their purchase. In my view, these similarities tip the balance of probabilities in favour of the Opponent. As a result, I find that the probability of confusion between the marks at hand is evenly balanced between a finding of confusion and of no confusion. As the onus is on the Applicant to show, on a balance of probabilities, that there is no reasonable likelihood of confusion, I must find against the Applicant. Consequently, the section 12(1)(d) ground of opposition succeeds, except for the goods described as fresh flowers.


DISPOSITION

[41] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition with respect to application No. 1,794,557 for all of the Goods and Services and with respect to application No. 2,043,870 for all of the Goods except “fresh vegetables and fresh fruits”.

Iana Alexova
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

The Opponent's Registered Trademarks

Trademark	Registration Number	Goods	Claims
ELEVATE	TMA867,428	Nutritional health foods, namely, energy bars in the nature of protein based nutrient-dense snack bars.	Declaration of use filed October 21, 2013
ELEVATE ME	TMA712,170	Nutritional health foods namely energy bars and energy cookies.	Declaration of use filed March 27, 2008
ELEVATE ME PERK	TMA895,619	Nutritional health foods, namely, energy bars in the nature of fruit and nut based nutrient-dense snack bars.	Declaration of use filed February 2, 2015
	TMA895,613	Nutritional health foods, namely, energy bars in the nature of fruit and nut based nutrient-dense snack bars.	Declaration of use filed February 2, 2015

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

No Hearing Held

AGENTS OF RECORD

ACCUPRO TRADEMARK SERVICES LLP

For the Opponent

JACK SMUGLER

For the Applicant