

LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 156**

**Date of Decision: 2021-01-28**

**IN THE MATTER OF AN OPPOSITION**

**Precision Nutrition, Inc.**

**Opponent**

**and**

**Baxter International Inc.**

**Applicant**

**1,637,634 for PN Design**

**Application**

INTRODUCTION

[1] On July 31, 2013, Baxter International Inc. (the Applicant) filed application No. 1,637,634 (the Application) to register the trademark PN Design, depicted below (the Mark).



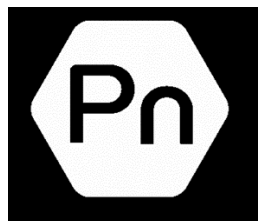
[2] The Application is in association with the following services:

Educational and training services in the field of parenteral nutrition; medical and healthcare services, namely, the provision of consultants and information on nutritional requirements and nutritional products; provision of clinical medical information; information and advice on patient nutritional requirements and products; assessment of hospitals and medical and health care facilities, namely, providing medical information for clinical medical treatment purposes and providing information and advice in the field of patient nutritional requirements.

[3] The Application is based on proposed use of the Mark in Canada and use and registration of the Mark in Australia. The Application claims priority to an application filed in Australia on July 10, 2013.

[4] The Application was advertised for opposition purposes in the *Trademarks Journal* on July 1, 2015. On December 1, 2015, Precision Nutrition, Inc. (the Opponent) filed a statement of opposition against the Application pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). I note that the Act was amended on June 17, 2019. All references in this decision are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act as it read before it was amended (see section 70 of the Act which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised prior to that date).

[5] The Opponent raises grounds of opposition based on non-entitlement under sections 16(2)(a) and 16(3)(a), non-distinctiveness under section 2, and non-compliance with sections 30(d), (e) and (i) of the Act. For the non-entitlement and non-distinctiveness grounds of opposition, the Opponent relies on its use in Canada of the trademark PN Logo, depicted below:



[6] In particular, the Opponent asserts that its PN Logo has been used in Canada by the Opponent and/or its licensees since at least as early as December 7, 2001 in association with the following services (the Opponent's Services):

Education services, namely, providing on-line lessons in the field of nutrition and fitness; Education services, namely, providing classes, seminars, and workshops in the field of nutrition and fitness; Educational services, namely, conducting classes, seminars, and workshops in the field of nutrition and fitness and distribution of educational materials in connection therewith; Educational services, namely, providing on-line instruction in the field of nutrition and fitness; Peer to peer coaching services in the field of nutrition and fitness; Personal coaching services in the field of nutrition and fitness; Professional coaching services in the field of nutrition and fitness; Providing group coaching in the field of nutrition and fitness

[7] The Applicant filed a counter statement on January 26, 2016 contesting the grounds of opposition. Both parties filed evidence. Only the Applicant filed written representations. A hearing was held at which both parties were represented.

[8] For the reasons set out below, the Application is refused in part.

#### EVIDENCE

[9] The evidence filed by the parties is summarized below and is also discussed in the analysis of the grounds of opposition.

#### **Opponent's Evidence**

[10] The Opponent filed the Affidavit of Robert Lombardi sworn December 23, 2016 (the Lombardi Affidavit). Mr. Lombardi was not cross-examined on his affidavit.

[11] Mr. Lombardi is the Chief Financial Officer of the Opponent. He describes the Opponent as one of the largest private nutrition coaching companies in the world. The Opponent is headquartered in Toronto.

[12] Mr. Lombardi indicates that the Opponent is the owner of the trademark PN Logo shown in paragraph 5, above. He states that the PN Logo has been used in Canada by the Opponent, its predecessors-in-title and/or its licensees since at least as early as December 7, 2001 in association with the Opponent's Services.

[13] Mr. Lombardi states that the Opponent is known for its nutrition, health and fitness coaching services for men and women offered through its online coaching platform and website located at *www.precisionnutrition.com* (the “PN website”). The Opponent’s clients sign up for a 12-month coaching process which is available online and via personal devices. Each day through the online coaching platform, coaching clients receive a lesson, a workout, and a habit to practice. The Opponent also offers certification courses for fitness professionals.

[14] Printouts from the PN website, displaying the PN Logo, are included as Exhibits “A” through “D”, as well as Exhibits “H” and “I”. In addition, printouts of archived pages from the PN website from 2009-2010, also displaying the PN Logo, are included as Exhibit “J”. Printouts of the Opponent’s social media pages displaying the PN Logo are included as Exhibit “K”.

[15] Mr. Lombardi states that Exhibits “A” through “K” are representative of the manner in which the PN Logo has been used, advertised and promoted in Canada for many years, and continues to be used, advertised and promoted in Canada.

[16] Annual sales figures in Canada in association with the PN Logo from 2008 to 2015 are included in the Lombardi Affidavit, ranging from in excess of \$200,000 in 2008 to in excess of \$2,500,000 in 2015. Annual website traffic from Canada to the PN website is also included.

### **Applicant’s Evidence**

[17] The Applicant filed the Affidavit of Sultana (Tania) Marvaki sworn April 21, 2017 (the Marvaki Affidavit) and the Affidavit of Ellen Anastacio sworn April 27, 2017 (the Anastacio Affidavit). Both Ms. Marvaki and Ms. Anastacio were cross-examined on their respective affidavits, and the transcripts, exhibits and written answers to undertakings from those cross-examinations form part of the record.

#### The Marvaki Affidavit

[18] Ms. Marvaki is the Business Unit Manager, Nutrition of Baxter Corporation, which she describes as an affiliate of the Applicant. She states that the acronym “PN” in the Mark “stands for parenteral nutrition and is a common acronym used in the industry to refer to this type of intravenous feeding.”

[19] Exhibit “A” to the Marvaki Affidavit are the results of an online search for the term “parenteral nutrition”. The first search result is from Wikipedia and describes parenteral nutrition as follows:

Parenteral nutrition (PN) is the feeding of a person intravenously, bypassing the usual process of eating and digestion. The person receives nutritional formulae that contain nutrients such as glucose, salts, amino acids, lipids and added vitamins and dietary minerals.

[20] Ms. Marvaki indicates that the Applicant has continuously used the Mark in Canada since September 2013 in association with a parenteral nutrition program. She states that the Mark is used in Canada by Baxter Corporation under licence from the Applicant who maintains control over the character and quality of the services in association with the Mark.

[21] Exhibit “B” to the Marvaki Affidavit are documents described as “various promotional and information documents for the applicant’s parenteral nutrition program bearing the [Mark]”. The exhibit includes documents bearing the Mark that describe the Applicant’s parenteral nutrition products and services, as well as slides from a presentation relating to parenteral nutrition at the International Conference for Advancing Nutrition (ICAN) in March 2016 in Chicago. Certain slides bearing the Mark also promote another ICAN conference later in 2016 in Toronto.

[22] In nearly all instances where the Mark is displayed in the documents in Exhibit “B”, the Mark is displayed directly next to the tagline “Patient nutrition, evolved” (or in French “La nutrition des patients, repensée”). Within the bodies of the documents, the term parenteral nutrition is frequently abbreviated as “PN”.

[23] Ms. Marvaki describes that the materials in Exhibit “B” are “available on the mobile application Vablet, are distributed by print and email to consumers and/or are distributed and presented at industry conferences.” However, no data is provided in the Marvaki Affidavit regarding the extent of distribution in Canada of these materials. In written answers to undertakings from the cross-examination of Ms. Marvaki, the Applicant provided some figures titled “Printed QTY” for certain documents included in Exhibit “B”, though no specifics as to where or indeed whether these documents were distributed were provided. In its written answers,

the Applicant also provided comments regarding the display of the Mark at ICAN and other events; however, I have no details regarding these events, whether they took place in Canada, and many of the documents purportedly bearing the Mark and referenced in these answers were not provided and do not appear to be included in the Marvaki Affidavit.

[24] Ms. Marvaki states that the primary market for the Applicant's services in association with the Mark are hospitals and healthcare facilities, and that given the nature of parenteral nutrition (i.e. that it is an intravenous product) there is really no other applicable market for such services.

#### The Anastacio Affidavit

[25] Ms. Anastacio is a trademark searcher employed by the agent representing the Applicant. Her affidavit includes, as Exhibit "A", printouts from a search she conducted of the Opponent's website at *www.precisionnutrition.com* and, as Exhibit "B", printouts of archived pages from that website from December 1, 2015.

[26] The Anastacio Affidavit appears to be directed at suggesting that not all pages of the Opponent's PN website bear the Opponent's trademark PN Logo. However, I did not find the Anastacio Affidavit of assistance on that factual point, given the limited number of pages of the PN website included in the Anastacio Affidavit, as compared to the extensive website evidence filed by the Opponent bearing the PN Logo, and given the doubts raised on cross-examination as to whether the printouts in Exhibits "A" and "B" of the Anastacio Affidavit constituted a complete representation of what would have been visible to a viewer of the webpage [for example, see Q19-Q30 of the transcript of the cross-examination of Ms. Anastacio]. As a consequence, I will not address this affidavit any further.

#### ONUS AND MATERIAL DATES

[27] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the Application complies with the requirements of the Act. This means that if a determinate conclusion cannot be reached in favour of the Applicant after a consideration of all of the evidence, then the issue must be decided against the Applicant. 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 CPR (3d) 293 (FCTD) at 298].

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

- Section 38(2)(a) / 30 of the Act – the filing date of the Application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Section 38(2)(c) / 16(2)(a) and 16(3)(a) of the Act – the priority filing date of the Application [*Earthrise Farms v Saretzky* (1997), 85 CPR (3d) 368 (TMOB); *Fisons Pharmaceuticals Ltd v Sales Affiliates Inc* (1973), 10 CPR (2d) 123 (TMOB)];
- Sections 38(2)(d) and 2 of the Act - the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317 (FC)].

#### SECTION 30 GROUNDS OF OPPOSITION

##### **Non-compliance with section 30(d) of the Act**

[29] The Opponent pleads that the Application does not comply with section 30(d) of the Act, because at the filing date of the Application, the Mark was not in use by the Applicant, or any named predecessor in title, in Australia in association with the services and/or the Applicant did not have a real and effective industrial or commercial establishment in Australia. The Opponent also pleads that the Applicant's priority claim is invalid.

[30] There is no evidence of record to support the section 30(d) ground of opposition. Specifically, there is no evidence from either party which speaks to the use (or absence of use) of the Mark by the Applicant in Australia, or indeed anything relating to the Applicant's activities in Australia. At the hearing, the Opponent argued that because the Marvaki Affidavit described the use of the Mark in Canada by Baxter Corporation as being under license from the Applicant, that suggested the same license arrangement was in place in Australia and that such licensed use would not be sufficient to support a claim to use and registration of the Mark abroad, pursuant to

*Molson Cos Ltd v Rola Weinbrennerei Und 21 Likorfabrick GmbH* (1988), 23 CPR (3d) 197 (TMOB). In my view, there is no basis in the evidentiary record on which I could assume that the circumstances of use of the Mark in Australia are the same as that in Canada, and so I reject the Opponent's argument on this point.

[31] At the hearing, the Opponent also sought to rely on *Allergan Inc v Lancôme Parfums & Beauté & Cie, general partnership* (2007), 64 CPR (4th) 147 at para 93 (TMOB) (*Allergan*), a case in which a section 30(d) ground of opposition succeeded in respect of an application based on use and registration in France. However, in *Allergan*, there was evidence from the opponent speaking to the absence of use of the trademark in France, such that the opponent was able to meet its initial evidential burden. As noted above, I have no comparable evidence relating to Australia in this case.

[32] Consequently, the Opponent has not met its initial evidential burden for the section 30(d) ground of opposition and that ground is dismissed.

#### **Non-compliance with section 30(e) of the Act**

[33] The Opponent pleads that the Application does not comply with the requirements of section 30(e) of the Act because the Applicant, either by itself or through a licensee, had no intention to use the Mark within the meaning of section 4 in association with the services listed in the Application. There is no evidence of record to support this ground of opposition and at the hearing the Opponent indicated that it was not pursuing this ground. I find that the Opponent has not met its initial evidential burden and the section 30(e) ground of opposition is dismissed.

#### **Non-compliance with Section 30(i) of the Act**

[34] The Opponent pleads that the Application does not comply with section 30(i) of the Act because the Applicant could not have been satisfied that it was entitled to use the Mark in Canada since it was confusing with the Opponent's trademark PN Logo, of which the Applicant was or ought to have been aware.

[35] Where an applicant has provided the statement required by section 30(i), a ground of opposition based on this section should only succeed in exceptional cases such as those involving



evidence of bad faith on the part of the applicant or the violation of a Federal statute [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155 and *Interprovincial Lottery Corp v Monetary Capital Corp* (2006), 51 CPR (4th) 447 (TMOB)]. Mere knowledge of the existence of an opponent's trademark does not in and of itself support an allegation that an applicant could not have been satisfied of its entitlement to use a trademark [see *Woot Inc v WootRestaurants Inc / Les Restaurants Woot Inc*, 2012 TMOB 197].

[36] At the hearing, the Opponent indicated that it was not pursuing this ground. In any event, the Application contains the requisite statement and there is no evidence that this is an exceptional case involving bad faith or the violation of a Federal statute. Accordingly, the section 30(i) ground of opposition is dismissed.

#### GROUND OF OPPOSITION BASED ON ALLEGED CONFUSION

##### **Non-entitlement Ground of Opposition - Sections 16(2)(a) and 16(3)(a)**

[37] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark because, at the priority filing date of the Application (i.e. July 10, 2013), the Mark was confusing with the Opponent's PN Logo which had been previously used in Canada by the Opponent and/or its licensees since at least as early as December 7, 2001 in association with the Opponent's Services.

[38] The Opponent has demonstrated use of its trademark PN Logo in association with the Opponent's Services since prior to the material date, and there is no evidence to suggest that the Opponent had abandoned its trademark as of the date of advertisement of the Application. Thus, I am satisfied that the Opponent has met its initial evidential burden with respect to the non-entitlement ground of opposition. This ground then turns on the question of whether there is a likelihood of confusion between the Mark and the Opponent's trademark PN Logo.

##### ***Test for confusion***

[39] The test for confusion is set out in section 6(2) of the Act which provides 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 and services associated with those

trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods and services are of the same general class or appear in the same class of the Nice Classification. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them.

[40] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772 at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

[41] The test for confusion is assessed as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the applicant's mark, at a time when he or she has no more than an imperfect recollection of the opponent's trademark, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot, supra*, at para 20].

#### Degree of resemblance

[42] The degree of resemblance between the parties' trademarks is reasonably high. The striking element of both parties' marks is the acronym "PN", and in both parties' marks those letters are framed by a hexagonal shape. There are some differences in appearance between the marks; for example, with the Applicant's Mark, the hexagon is oriented differently and the Mark incorporates a droplet shape within the hexagon that is absent from the Opponent's trademark. The Opponent's trademark also appears to include a mixture of upper and lower case letters. However, overall, I do not consider the visual differences to be significant as a matter of first impression to an individual with an imperfect recollection of the Opponent's trademark. The marks are also identical when sounded.

[43] The Applicant argues that the ideas suggested by the trademarks are different, in part because the Opponent's PN Logo is typically displayed beside the name "Precision Nutrition", such that consumers would understand "PN" to refer to "Precision Nutrition", as compared to the "PN" in the Applicant's Mark which the Applicant indicates stands for "parenteral nutrition". However, I don't find this argument particularly persuasive in the present case, as in my view the evidence suggests that the Opponent's PN Logo would be perceived as a separate trademark in its own right apart from the name "Precision Nutrition" (in this regard there are multiple examples in the Opponent's evidence where the PN Logo is displayed on its own, separated from the name "Precision Nutrition" - for example, see Exhibits "B3" and "D1" to the Lombardi Affidavit). Also, based on the evidence of record, I am unable to conclude that the Applicant's Mark would necessarily be understood as a reference to "parenteral nutrition", given that many of the services listed in the Application are not restricted to parenteral nutrition.

[44] In view of the above, on balance, the degree of resemblance factor favours the Opponent.

#### Inherent distinctiveness of the trademarks and the extent they have become known

[45] Trademarks that are comprised solely of acronyms or abbreviations generally possess a low degree of inherent distinctiveness [see *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD) at 163-164; and *Gemological Institute of America Inc v Gemology Headquarter International LLC*, 2014 FC 1153, 127 CPR (4th) 163]. In the present case, both parties' trademarks are composite trademarks that include the letters "PN" in conjunction with a design component. I find that both parties' trademarks possess at least some inherent distinctiveness in view of the design elements; however, both parties' trademarks are still inherently weak and reside on the low end of the spectrum of inherent distinctiveness.

[46] With respect to the extent to which the parties' trademarks have become known, the Opponent's evidence demonstrates use of its trademark in Canada for many years, including annual sales figures in association with the PN Logo dating back to 2008. I am satisfied that the Opponent's trademark is known to a reasonable extent in Canada in association with the Opponent's Services.

[47] The Applicant has not demonstrated that its Mark was used or had become known to any extent in Canada as of the material date for the non-entitlement ground of opposition (July 10, 2013), as the Applicant's evidence indicates that it commenced using the Mark in Canada in September 2013. In any event, regardless of the material date, the Applicant's evidence of the extent of its use of the Mark in Canada at any time is weak. The Marvaki Affidavit filed by the Applicant provides no sales or distribution figures in association with the Mark in Canada, and the additional information provided by the Applicant in its answers to undertakings, in my view, does not permit me to conclude that the Mark was known to any meaningful extent in Canada.

[48] Consequently, taking into account both the inherent distinctiveness of the parties' trademarks and the extent to which they have become known, this factor favours the Opponent.

#### Length of time the trademarks have been in use

[49] The Lombardi Affidavit indicates that the PN Logo has been used in Canada by the Opponent, its predecessors-in-title and/or its licensees, since at least as early as December 2001 in association with the Opponent's Services. The Lombardi Affidavit provides multiple examples of the use of the PN Logo, which are characterized as "representative" of the Opponent's use of its trademark, and none of this evidence was challenged on cross-examination. I note that the earliest example of the use of the Opponent's PN Logo in the Lombardi Affidavit dates from 2009 (see paragraph 26 and Exhibit "J" to the Lombardi Affidavit), and Exhibit "J" to the Lombardi Affidavit also includes what appear to be some archived versions of the PN website from 2005 which do not bear the Opponent's PN Logo.

[50] However, regardless of the precise date on which use of the Opponent's trademark PN Logo commenced, the Lombardi Affidavit demonstrates that the Opponent commenced using its trademark well prior to the material date for the non-entitlement ground of opposition, and well prior to the Applicant's first use of its Mark in Canada. Consequently, this factor also favours the Opponent.

Nature of the goods, services or business; and nature of the trade

[51] Given the other factors which weigh in the Opponent's favour in this case, the confusion analysis turns largely on the degree to which the nature of the parties' goods, services, and likely channels of trade overlap. In particular, has the Applicant demonstrated that its goods and services and the nature of its trade are sufficiently different from those of the Opponent to avoid a likelihood of confusion?

[52] It is the wording of an applicant's statement of services in the application that governs the confusion analysis. That statement must be read with a view to determining the probable type of business or trade intended by the applicant rather than all possible trades that might be encompassed by the description of services. In this regard, evidence of the actual trade of the applicant can be useful. [see *McDonald's Corporation v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA) at 169; *London Life Insurance Co v Nesbitt Thomson Inc* (1997), 75 CPR (3d) 114 (TMOB)].

[53] I will begin with the first service described in the Application, namely, "Educational and training services in the field of parenteral nutrition". The Applicant's evidence indicates that "parenteral nutrition" is the feeding of a person intravenously, bypassing the usual process of eating and digestion [Marvaki Affidavits para. 3 and Exhibit "A"]. During the hearing, I inquired whether the Opponent took issue with this definition of parenteral nutrition and my understanding is that the Opponent did not.

[54] The remainder of the Applicant's evidence suggests that parenteral nutrition services are carried out by medical professionals in a medical setting such as a hospital in order to treat undernourished patients for whom other means of food intake is compromised. Thus, the market for parenteral nutrition products and services appears likely to be medical professionals and institutions in the medical community.

[55] In my view, this first service listed in the Application is fundamentally different from the Opponent's Services. The evidence indicates that the Opponent's Services in association with the PN Logo are nutritional and fitness coaching for the general public seeking to lose weight and improve overall health and well-being. The Opponent offers its services to the general public via

its website. Ultimately, I consider it unlikely that an individual with a vague recollection of the Opponent's PN Logo in association with nutrition and fitness coaching would think that parenteral nutrition (i.e. intravenous feeding) services in association with the Mark were coming from the same source as the Opponent, or were otherwise licensed, sponsored or authorized by the Opponent. In my view, the nature of the services and the likely channels of trade are too dissimilar.

[56] However, the remaining services in the Application are not as narrowly defined and are not inherently limited to the specific field of parenteral nutrition. Indeed, the remaining services in the Application could reasonably be understood to encompass general nutritional consulting and counselling, albeit in a medical environment. In my view, these remaining services as described in the Application are potentially closer in nature to the Opponent's Services, specifically the Opponent's Services related to nutritional consulting. In addition, the Applicant's evidence in this case does not shed light on what specific activities these remaining services in the Application might comprise, beyond the educational and training services in the field of parenteral nutrition. On this point, I note that at paragraph 86 of the Applicant's written representations, the Applicant states "Any education or training provided by the Applicant is limited to parenteral nutrition and would not be confused with the general fitness-focused services provided by the Opponent". However, the Application nevertheless includes a list of remaining services which are not expressly tied to parenteral nutrition and which I must consider as part of the confusion analysis. With these remaining services as described in the Application, in my view, there is potential for overlap with the Opponent's Services.

#### Additional surrounding circumstances

##### *Concurrent use*

[57] The Applicant argues that the co-existence of the parties' trademarks is a surrounding circumstance which weighs in its favour.

[58] Evidence of instances of actual confusion is not required in order to demonstrate a likelihood of confusion. However, concurrent use of two trademarks without such instances of actual confusion is a surrounding circumstance which can suggest an absence of a likelihood of

confusion, depending on the specific nature and duration of that concurrent use [see *Christian Dior SA v Dion Neckwear Ltd*, 2002 FCA 29, 20 CPR (4th) 155 at para 19].

[59] In the present case, while the Marvaki Affidavit indicates that the Applicant has used the Mark in Canada, I do not have sufficient evidence from the Applicant regarding the extent of that use to attribute any weight to the purported co-existence of the parties' trademarks. Moreover, the Marvaki Affidavit indicates that the Applicant's use of the Mark did not commence in Canada until after the material date for the non-entitlement ground of opposition, further reducing the significance of any coexistence.

[60] Thus, this factor does not assist the Applicant.

### ***Conclusion regarding confusion***

[61] Having considered all of the surrounding circumstances, the Applicant has satisfied its legal burden to show that there is no reasonable likelihood of confusion between the parties' trademarks with respect to the services "Educational and training services in the field of parenteral nutrition". I am satisfied that those services are sufficiently different from the Opponent's Services that confusion is unlikely.

[62] However, with respect to the remaining services in the Application, I find that at best for the Applicant, the probability of confusion is evenly balanced between a finding of confusion and no confusion. In my view, for those remaining services in the Application there is potential for overlap with the Opponent's Services. As the onus is on the Applicant to demonstrate on a balance of probabilities that there is no reasonable likelihood of confusion, I must therefore find against the Applicant with respect to the remaining services.

[63] In view of the above, the non-entitlement ground of opposition under sections 16(2)(a) and 16(3)(a) of the Act fails in respect of the services "Educational and training services in the field of parenteral nutrition", and the non-entitlement ground of opposition succeeds with respect to the remaining services in the Application.

## **Distinctiveness Ground of Opposition – Section 2**

[64] With this ground of opposition, the Opponent pleads that the Mark is not distinctive in view of the Opponent's prior use and advertisement in Canada of its PN Logo. The material date for this ground of opposition is the date of filing the statement of opposition, namely, December 1, 2015. As with the non-entitlement ground of opposition, this ground turns on the question of whether there is a likelihood of confusion between the two parties' trademarks.

[65] In order to meet its initial evidential burden with a distinctiveness ground of opposition, an opponent must show that its trademark had a substantial, significant or sufficient reputation in Canada in association with relevant services [see *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427 at para 34]. In this case, I am satisfied that the Opponent has met that initial evidential burden by virtue of its evidence of considerable use of the PN Logo in Canada in association with the Opponent's Services prior to December 1, 2015.

[66] The question then becomes whether the parties' trademarks are confusing as of the material date. In my view, the different material date for the distinctiveness ground of opposition (as compared to non-entitlement) has no impact on the outcome of the confusion analysis. Thus, for effectively identical reasons to those set out above for the non-entitlement ground of opposition, the non-distinctiveness ground of opposition under section 2 of the Act similarly fails in respect of the services "Educational and training services in the field of parenteral nutrition", but succeeds with respect to the remaining services in the Application.

### DISPOSITION

[67] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition with respect to the services "Educational and training services in the field of parenteral nutrition", and refuse the Application with respect to the remaining services, pursuant to section 38(12) of the Act.



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Timothy Stevenson  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

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

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**HEARING DATE** 2020-10-13

**APPEARANCES**

Alison Hayman	For the Opponent
Sanjukta Tole	For the Applicant

**AGENTS OF RECORD**

Cassels Brock & Blackwell LLP	For the Opponent
Marks & Clerk	For the Applicant