



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 64

Date of Decision: 2021-03-31

IN THE MATTER OF AN OPPOSITION

Premier Tech Ltée

Opponent

and

**753146 Alberta Ltd. operating as
Ultrasol Industries**

Applicant

1,698,647 for

Application

THE ORIGINAL RODENT REPELLENT

[1] Premier Tech Ltée (the Opponent) opposes application no. 1,698,647 (the Application) for registration of the trademark THE ORIGINAL RODENT REPELLENT (the Mark) filed by 753146 Alberta Ltd. operating as Ultrasol Industries (the Applicant).

[2] The opposition is based primarily on an allegation that the Mark deceptively misdescribes the Applicant's products as being original when in fact the Opponent and its predecessors in title had previously sold such products in Canada. In the alternative, the Opponent pleads that the Mark clearly describes the Applicant's products.

[3] For the reasons that follow, I reject the opposition.

THE RECORD

[4] The Application was filed on October 20, 2014, based on proposed use of the Mark in Canada in association with various commercial and domestic pest control products, including “rodent repellent”, and related retail, wholesale, marketing and consulting services therefor. The full list of goods and services covered by the Application (“Goods” and “Services”, respectively) is reproduced at Schedule A to my decision.

[5] The Application was advertised in the *Trademarks Journal* on April 26, 2017, and opposed when the Opponent filed a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on October 18, 2017 (the Opponent’s September 19, 2017 filing having been rejected for non-compliance with section 38(3)). Numerous amendments to the Act came into force on June 17, 2019. Pursuant to the transitional provisions in section 70 of the Act for applications advertised before that date, the grounds of opposition will be assessed based on the Act as it read immediately before amendment.

[6] The grounds of opposition are based on the Act’s sections 30(i) (application requirements), 12(1)(b) (registrability), and 2 (distinctiveness). The Applicant filed a counter statement on January 11, 2018, denying each of the grounds of opposition.

[7] The Opponent filed as its evidence the affidavit of Chantal Duchesneau, senior marketing and communications manager (“*Directrice principale marketing & communications*”) of its horticulture and agriculture group. Dated May 8, 2018, Ms. Duchesneau’s affidavit provides information on the Opponent’s weed and pest control product lines, as well as dictionary definitions for the words composing the Mark, and a printout she obtained of the Applicant’s corporate particulars.

[8] The Applicant filed as its evidence the affidavit of its director, Philippa Gaston-Kellock, dated September 10, 2018. Ms. Gaston-Kellock’s affidavit provides information on the Applicant’s DOCTOR DOOM product line, including THE ORIGINAL RODENT REPELLENT, THE ORIGINAL DEER REPELLENT, and the ORIGINAL ANIMAL REPELLENT, as well as dictionary definitions for the word “original”, and printouts of three trademark registrations resulting from her search of the Canadian Trademarks Database for

trademarks containing the word “ORIGINAL”. (The Applicant’s written argument claims 692 such trademarks are registered, and also references an “internet google search” using the words in the Mark, but such additional registrations and search results are not in evidence.) Ms. Gaston-Kellock also expresses opinions on questions of fact and law to be decided in this proceeding, but as she has not been qualified as an expert in trademarks or human behaviour and is not independent of the parties, her opinions in this respect have been disregarded.

[9] Neither Ms. Duchesneau nor Ms. Gaston-Kellock was cross-examined. Both parties filed written arguments; an oral hearing was not held.

EVIDENTIAL BURDEN AND LEGAL ONUS

[10] In opposition proceedings, the legal onus is on the applicant to show that its application complies with the provisions of the Act. However, for each ground of opposition, 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 that ground of opposition exist. For a ground of opposition to be considered at all, the opponent must meet its evidential burden [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD)].

[11] If the evidential burden is met, then the applicant must satisfy the Registrar, on a balance of probabilities, that the ground of opposition pleaded should not prevent the registration of the trademark at issue. The legal onus being on the applicant means that if a determinate conclusion cannot be reached after a consideration of all of the evidence, then the issue must be decided against the applicant. [*Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt, supra*].

GROUND OF OPPOSITION BASED ON REGISTRABILITY UNDER SECTION 12(1)(B)

[12] The Opponent pleads that the Mark is not registrable pursuant to section 12(1)(b) of the Act because the Mark clearly describes or deceptively misdescribes, in the English language, the character or quality of the goods or services in association with which the Mark is proposed to be used. More specifically, the Opponent pleads that the Mark is deceptively misdescriptive in that the Applicant’s rodent repellent cannot be “the original”— meaning “present or existing from the

beginning; first; or earliest”— given that the Opponent or its predecessors in title were marketing anti-rodent products (“*produits anti-rongeurs*”) in Canada before the Applicant. Alternatively, if the Applicant is the first to market such products in Canada, then the Mark is clearly descriptive of the character of the goods or services in association with which the Mark is proposed to be used.

[13] The word “character” in section 12(1)(b) means “a feature, trait, or characteristic of the product” [*Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 at 23 (Ex Ct)]. It has been held that the character of a good includes its function, its purpose, and its effect when used as intended [*Thomson Research Associates Ltd v Canada (Registrar of Trade Marks)* (1982), 71 CPR (2d) 287 (FCA) aff’d 67 CPR (2d) 205 (FCTD)].

[14] For a trademark to be “deceptively” misdescriptive, it must mislead the public as to the character or quality of the associated goods or services [*Atlantic Promotions Inc v Registrar of Trade Marks* (1984), 2 CPR (3d) 183 (FCTD)]. For a trademark to be “clearly” descriptive, the meaning of the trademark must be “easy to understand, self-evident or plain” [*Drackett, supra*]. In either case, the descriptive character of the trademark must go to the material composition of the goods or services or refer to an obvious intrinsic quality or characteristic of the goods or services [*ITV Technologies Inc v WIC Television Ltd*, 2003 FC 1056; *Provenzano v Registrar of Trade-marks* (1977), 37 CPR (2d) 189 (FCTD), aff’d (1978) 40 CPR (2d) 288 (FCA)].

[15] The issue is to be decided by considering the trademark in its entirety as a matter of immediate impression in light of the associated goods or services [see *Canadian Parking Equipment v Canada (Registrar of Trade Marks)* (1990), 34 CPR (3d) 154 (FCTD); and *Ontario Teachers' Pension Plan Board v. Canada (Attorney General)*, 2012 FCA 60]. In this respect, the Registrar must not only consider the evidence but also apply common sense. [*Neptune S.A. v Attorney General of Canada* (2003), 29 CPR (4th) 497 (FCTD)]. The material date for the assessment is the application’s filing the [*Fiesta Barbeques Ltd v General Housewares Corp*, 2003 FC 1021].

[16] To support its allegations that the Mark is deceptively misdescriptive, the Opponent relies on the affidavit of Ms. Duchesneau. In her affidavit, Ms. Duchesneau explains that the Opponent develops, manufactures and distributes retail products in the home and garden sector in Canada,

including repellents for rodents (“*répulsifs pour les rongeurs*”), insecticides, and herbicides, which are sold under several trademarks, including WILSON, PREDATOR, and GREEN EARTH (para 5). She states that, according to the records to which she has access, the Opponent and its predecessors in title have distributed repellents for rodents continuously since the 1960s (para 6). She further states that, according to her search of Canadian business registries through the Quebec Bar Association, the Applicant was not incorporated until 1997 (para 12).

[17] Ms. Duchesneau attaches the following supporting exhibits to her affidavit:

- Printouts of the registration particulars for the Opponent’s WILSON, PREDATOR, and GREEN EARTH trademarks, registered for use in association with various pest control and gardening products (Exhibit B).
- An extract from the Opponent’s 2017 home & garden catalogue advertising various rodent control products, including WILSON units (co-branded with the PREDATOR and SONIC MAX or SONIC-REPEL trademarks) that “produc[e] ultrasonic sound waves to drive rodents out” and “repel mice and rats”; a GREEN EARTH pepper-based repellent against various animals, including groundhogs; and a SKOOT coating/spray repellent against various animals, including mice (Exhibit A).
- WILSON/WILSON’S price lists for 1966, 1978, 1984 and 1990, covering various pest and weed control products (Exhibit C).
- A printout of the Applicant’s corporate particulars from ESC Corporate Services Ltd., showing an incorporation date of September 3, 1997 (Exhibit I).
- Extracts from *The Canadian Oxford Dictionary* (1998) showing definitions of the words “original”, “rodent”, and “repellent”, as well as printouts of the first definitions for “original” from the *Cambridge* and *Collins* online dictionaries (Exhibits D to H).

[18] As noted above, the Opponent pleads that the Applicant’s rodent repellents cannot be “the original”, given that the Opponent or its predecessors in title were marketing anti-rodent products in Canada before the Applicant. Indeed, the first definitions of “original” given by each cited dictionary refer to the quality of existing from the beginning or of being the earliest form of something. The furnished dictionary definitions also support the Opponent’s written submission

that “rodent” is a category of mammal that includes rats and mice and that the term “repellent” refers to a substance that repulses, wards off, or drives back (“*repousse*”).

[19] However, even if I were to find that these individual definitions support the Opponent’s interpretation of the Mark as a whole, the Opponent’s evidence fails to show that the Opponent or a predecessor in title marketed rodent repellents prior to the Application’s filing date. The Opponent’s evidence thus fails to support a conclusion that the Mark misdescribed the Applicant’s goods and services as being the first or earliest rodent repellents at the material date.

[20] More particularly, none of the products in the exhibited price lists is identified as a product that repels rodents. The only explanation of the price lists offered by Ms. Duchesneau is that the 1966 list includes, in the “RAT & MOUSE KILLERS” category, products such as “WILSON’S MOUSE TREAT, WILSON PROLIN BACON & CHEESE, WILSON’S RAT & MOUSE CAFETERIA, etc.” (para 6). However, these products appear on their face to be ones that attract and kill rodents, rather than repelling them. In this respect, I note the following relevant definitions of “repellent” and “repel” in the extract from *The Canadian Oxford Dictionary* furnished by Ms. Duchesneau:

repellent: **1** a substance that repels, esp. a chemical that repels insects.

repel: **1** drive back; ward off; repulse. **2** refuse admission or approach or acceptance to (*repel an assailant*). **3** to be repulsive or distasteful to.

[21] If any of the products in the “RAT & MOUSE KILLERS” category not highlighted by Ms. Duchesneau, such as “WILSON’S PROLIN CONCENTRATE” or “WILSON’S WATER SOLUBLE WARFARIN”, also *repel* rodents, then this is not indicated in the evidence.

[22] The remaining products in the 1966 price list appear to be in the nature of baits, traps, and poisons, for various organisms, including insects, fungus and weeds. The only product identified as a repellent is the “REPELL (DOG REPELLENT)”; however, there is no indication of whether this product also repels rodents. If any of the poisons or any of the products with more generic descriptions—such as “WILSON’S GARDEN SPRAY” or “WILSON’S GRAIN PROTECTANT”—repel rodents, then this is not mentioned in Ms. Duchesneau’s affidavit. Similarly, although the 1978, 1984 and 1990 price lists include rodent control products, the products appear on their face to be in the nature of baits, traps, and poisons rather than repellents.

The pre-existence in the marketplace of other types of rodent control products, or of other types of repellents, would not prevent the Applicant's product from being the original "rodent repellent".

[23] The trademark registrations at Exhibit B to Ms. Duchesneau's affidavit do not assist the Opponent. The GREEN EARTH registration does not cover either repellents or rodent control products; the WILSON registration does not cover repellents (as opposed to attractants, traps, and poisons); and the nature of the "repellent" goods covered by the PREDATOR registration is unclear. In this last respect, the descriptions "repellent spray" and "essential oil repellent" in the PREDATOR registration do not specify the type of pest repelled and the description "ultrasonic repellent namely electric devices for attracting and killing rodents" is contradictory, suggesting that the purported "repellent" actually attracts and kills the rodents instead. In any event, the mere existence of trademark registrations containing claims or declarations of use cannot in itself satisfy an opponent's evidential burden to demonstrate use of its trademarks in association with the goods covered by the registrations [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (TMOB); and *Classical Remedia Ltd. v. 1404568 Ontario Ltd.* (2010), 81 CPR (4th) 317 (TMOB); see also *Tokai of Canada Ltd. v. Kingsford Products Company, LLC*, 2018 FC 951].

[24] As for the pages from the Opponent's 2017 catalogue at Exhibit A, they depict what appear to be ultrasonic devices and chemical formulations that repel rodents. However, since the catalogue is dated after the material date of October 20, 2014, this evidence is insufficient to meet the Opponent's evidential burden.

[25] I would note that, even if I were able to consider this catalogue, it does not appear to pre-date the Applicant's use of the Mark on "rodent repellents". In this respect, Ms. Gaston-Kellock's affidavit, furnished on behalf of the Applicant, contains at Exhibit L a table of sales figures for "Rodent Repellent 400G" from May 2015 to April 2016 and "DD Original Rodent Repellent 400 Gram" from June 2016 to August 2018. Ms. Gaston-Kellock provides these sales figures to illustrate the Applicant's customers "from across Canada" and confirms that the products were sold bearing the Mark in the normal course of trade (para 17).

[26] Indeed, the product code in the sales figures (“77204”) matches that on the representative product label (in the bar code), feature sheet advertisement, and distributor’s catalogue extract furnished by Ms. Gaston-Kellock to show the Applicant’s use and promotion of the Mark in Canada (paras 7, 9, 10, 16 and Exhibits C, E, K). The label, feature sheet, and catalogue entries display the Mark in association with a 400 gram spray can of “Repellent for Wild and Domestic Animals” that stops mice, rats, squirrels, voles, porcupines, and beavers, among other animals, from “Chewing, Nibbling, Licking, Gnawing, Eating or Biting”. Although the label, feature sheet, and catalogue entries are undated, they confirm the nature of the “Rodent Repellent” product referenced in the sales figures.

[27] In view of the foregoing, the ground of opposition based on deceptive misdescriptiveness is dismissed, as the Opponent has failed to meet its initial burden.

Is the Mark clearly descriptive?

[28] To support its allegations that the Mark is clearly descriptive, the Opponent relies on the dictionary definitions for the words “original”, “rodent”, and “repellent” furnished as Exhibits D to H of Ms. Duchesneau’s affidavit, discussed above.

The Opponent’s position

[29] In light of the furnished definitions, the Opponent submits that the Mark is composed of common words and, as a whole, gives a clear description of the character and quality of the Goods and Services. In particular, the Opponent submits that there is only one possible conclusion: the ordinary meaning of the expression THE ORIGINAL RODENT REPELLENT for consumers of repellent products is that this repellent for rodents is the original (“*ce répulsif pour rongeurs est l’original*”). The Opponent’s position appears to be that in using the Mark the Applicant would claim that it is the first to market repellents for rodents (“*prétendre avoir été la première (l’originale) à commercialiser des répulsifs pour rongeurs*”).

[30] The Opponent also makes two more specific submissions regarding the meaning of the Mark. One is that the average consumer, in seeing the phrase THE ORIGINAL RODENT REPELLENT, would react by thinking that the Goods constitute the original formula of a

repellent for rodents available on the market to the general public (“*disponible sur le marché grand public*”) and known under the generic name “rodent repellent”. In support of this argument, the Opponent seeks to draw an analogy between the present case and that in *Henkel Corporation v Pacer Technology*, 2011 TMOB 99, which found the trademark THE ORIGINAL SUPER GLUE to be deceptively misdescriptive on a similar basis.

[31] The other specific submission is that the expression “THE ORIGINAL” in the Mark creates a laudatory qualifier. In this regard, the Opponent submits that the Federal Court has held that words or prefixes having a laudatory connotation are *prima facie* descriptive and that trademarks comprising only a laudatory epithet qualifying a clearly descriptive term are unregistrable under section 12(1)(b) [citing *Mitel Corporation v Registrar of Trade Marks* (1984), 79 CPR (2d) 202 (FCTD) (re SUPERSET for subscriber telephone instruments); *Molson Companies Ltd v John Labatt Ltd* (1981), 58 CPR (2d) 157 (FCTD) (re LABATT EXTRA for brewed alcoholic beverages); *Imperial Tobacco Ltd v Benson & Hedges (Canada) Inc* (1983), 75 CPR (2d) 115 (FCTD) (re RIGHT for cigarettes); and *Café Supreme F et P Ltée v Registrar of Trade Marks* (1984), 4 CPR (3d) 529 (FCTD) (re CAFE SUPREME for sale on premises or take-out of coffee and pastries)].

The Applicant’s position

[32] The Applicant submits that the Opponent has failed to meet its evidential burden, because it is not enough to quote dictionary meanings and leave it to the Applicant to determine how the trademark is clearly descriptive; the Opponent must explain the reasons why.

[33] In particular, the Applicant submits that the Opponent’s interpretation of the Mark is based on a single of several possible connotations for the word “original”, whereas the Mark is not restricted to that connotation, and there is no reason to prefer one of the furnished definitions for the word “original” over the others. In the Applicant’s submission, the average purchaser would primarily deduce that the product sold under the Mark is “new, unusual, unfamiliar, unconventional, unorthodox, different, innovative, inventive, avant-garde, futuristic, groundbreaking, revolutionary, unique, unprecedented, uncommon, and out of the ordinary” rather than “present or existing from the beginning” as contemplated by the Opponent. The Applicant

submits that, since several possible interpretations exist, the Mark is “intrinsically ambiguous” and cannot be said to provide an easy to understand, self-evident, or plain description.

[34] In addition, the Applicant submits that the Mark consists of several words that are not generally recognized by the public in the pest control industry. In this respect, the Applicant seeks to draw an analogy with the decision in *Triple-C-Imports Ltd v Del Monte Corp* (1991), 36 CPR (3d) 562 (TMOB), regarding the trademark ORCHARD BLENDS for use in association with fruit juices. In that case, the Opposition Board commented that there was nothing in evidence to establish that the average user or purchaser of fruit juices associated the word ORCHARD with any particular types of fruit trees or that “orchard” was a recognized and identifiable class of fruits. As the average consumer would thus make only a vague association between a grouping of unspecified fruit trees and fruit juices, the trademark ORCHARD BLENDS was found to be merely suggestive. The Applicant emphasizes that section 12(1)(b) of the Act does not prohibit the registration of trademarks that are merely suggestive of the associated goods or services or that merely have some descriptive connotations [citing *Home Juice Company v Orange Maison Limitée* (1968), 36 Fox PC 179 (Ex. Ct.); *Provenzano, supra*; *Thomas J Lipton v Salada Foods Ltd (No. 3)* (1979), 45 CPR (2d) 157 at 160 (FCTD); *G House of Selective Researchers Inc v Schachter* 14 CPR (3d) 567].

[35] Furthermore, the Applicant emphasizes that, to be objectionable under section 12(1)(b), the trademark’s descriptive character must go to the material composition of the goods or services or refer to an intrinsic quality of the goods or services [citing *Unitel Communications Inc v Bell Canada* (1995), 61 CPR (3d) 12 (FCTD); and *Provenzano, supra*]. In this respect, the trademark must clearly describe a character or quality of the goods or services themselves and not just a collateral characteristic or feature [citing *Molson Companies Ltd v Carling O’Keefe Breweries* (1981), 55 CPR (2d) 15 (FCTD)]. In particular, the Applicant submits that, for the word “original” to be objectionable, its meaning would have to relate to an intrinsic quality or character of or be material to the composition of the Goods and Services, or describe a feature, trait, or characteristic, or function or result of, the Goods or Services. The Applicant submits that the Mark is not in any way descriptive of the inherent character or quality of the goods or services in association with which it is proposed to be used.

Conclusion with respect to clear descriptiveness

[36] The dictionary definitions furnished by the Opponent support its position that the Mark may be interpreted as describing the “earliest” rodent repellent. However, even if I were to accept that interpretation, I would find that the Opponent’s evidence falls short of showing how this description might be material to the composition of rodent repellents or refer to an intrinsic quality or characteristic of such repellents.

[37] Specifically, on its face, the term “THE ORIGINAL” as defined by the Opponent describes the *timing* of the product’s discovery, invention or launch, rather than describing the *character* of the product, such as its composition, function or effect. Thus the quality or characteristic of being first would not appear to be intrinsic to the product itself, but instead dependent on the timing of the product’s arrival or introduction to consumers. In this sense, I consider the description THE ORIGINAL somewhat analogous to the description KOOL ONE, which, in *Provenzano*, was found not to describe an *intrinsic* quality or characteristic of beer, but rather a quality that could be imparted at will by servers of the product.

[38] To the extent that the decision in *Henkel* is applicable when the inquiry concerns clear descriptiveness rather than deceptive misdescriptiveness, I find that case to be distinguishable.

[39] In *Henkel*, there was evidence that cyanoacrylates are a class of glue products with strong adhesive properties that are commonly marketed as and referred to as “super glue”. On this basis, it was found that the average consumer would react to the phrase THE ORIGINAL SUPER GLUE by thinking that the product was the original formulation of the high strength glue generically known as “super glue” (without necessarily knowing that such glue is a “cyanoacrylate”). By contrast, in the present case, the Opponent has not provided any evidence that the term “rodent repellent” commonly refers to a class of products with a particular chemical composition or that the average consumer might react to the phrase THE ORIGINAL RODENT REPELLENT by thinking that it represents the original formulation within that class. Indeed, the Goods also include “non-chemical repellent”, which would be broad enough to cover mechanical or ultrasonic repellents. Unlike in *Henkel*, there is no evidence of the alleged generic term being used in marketing or on packaging, by the Applicant, by the Opponent, or otherwise.

[40] I appreciate that the issues under section 12(1)(b) of the Act may be addressed by applying common sense to the meaning of ordinary words and phrases and that, in some cases, dictionary definitions may be useful to discover the current sense of a particular word [*Neptune, supra*]. However, the Federal Court of Appeal has cautioned against drawing inferences without any evidence about what consumers would or would not understand from phrases with no known meaning. Specifically, in *Candrug Health Solutions Inc v Thorkelson*, 2008 FCA 100, rev'g 2007 FC 411, a finding of deceptive misdescriptiveness was overturned when the Federal Court of Appeal found that there was no evidence to support the trial judge's finding that consumers would understand from the mark CANADA DRUG, used in association with a "drugstore, dispensary and pharmacy", that the drugs originate or are dispensed in Canada.

[41] Therefore, in the absence of evidence either of a known meaning for the term "RODENT REPELLENT" or of consumers' likely reaction to the phrase, I am not prepared to infer that consumers would necessarily react to the phrase as denoting the *specific* type of product in association with which the Mark is encountered, as opposed to denoting products that repel rodents in general. Although I accept that repelling rodents would be a purpose or function of the goods and thus represent an aspect of their character, the Mark is not merely "RODENT REPELLENT" but "THE ORIGINAL RODENT REPELLENT". In the absence of evidence, I am not prepared to infer that consumers might react to the Mark as a whole by understanding that the Goods represent the first available means of repelling rodents—predating brooms, cats, and other natural repellents—rather than perceiving the phrase as suggesting an element of originality, unconventionality, or inventiveness, or as mere puffery designed to attract attention.

[42] Thus, although the Opponent has provided dictionary definitions of the individual words composing the Mark and suggested a plausible interpretation, the Opponent has not provided the type of further evidence that in *Henkel* may have led to the conclusion that the descriptive character of the mark goes to the material composition of the goods or to an obvious intrinsic quality or characteristic thereof. I would also note that, in *Henkel*, whether the descriptive character of the mark goes to the material composition of the goods or to an obvious intrinsic quality or characteristic thereof did not appear to be at issue.

[43] In addition, I find the cases in respect of laudatory trademarks cited by the Opponent to be distinguishable. In each of those cited cases, the laudatory word directly denotes excellence or superior quality. By contrast, in the present case, the words THE ORIGINAL do not in themselves denote excellence or quality. Furthermore, there is no evidence of a link between the originality or earliness of a rodent repellent and its level of quality. In the circumstances, the Mark can at best be considered indirectly suggestive of quality or a form of marketing puffery.

[44] Thus, in the particular circumstances of the present case, since the Opponent has failed to show how the description “THE ORIGINAL RODENT REPELLENT” might be material to the composition of the Goods or Services or refer to an obvious intrinsic quality or characteristic thereof, I find the Opponent’s evidence and argument insufficient for a conclusion that the facts required to support a ground of opposition based on clear descriptiveness exist. Therefore, the section 12(1)(b) ground of opposition based on clear descriptiveness is dismissed as well, as the Opponent has failed to meet its initial burden.

GROUND OF OPPOSITION BASED ON NON-COMPLIANCE WITH SECTION 30(i)

[45] The Opponent pleads that the Application does not conform to the requirements of section 30(i) of the Act because the Applicant could not be satisfied that it was entitled to use the Mark in Canada in association with the goods and services covered by the Application, for the following reasons:

- i. at the time of filing the Application, the Applicant must have been aware that the Opponent and its predecessors in title had already been in the pesticide and anti-parasite product market for several decades; and
- ii. in light of the Opponent and others having similar products in the marketplace, the Applicant could not that assert its rodent repellents are “the first” or “original”.

[46] The requirement under section 30(i) of the Act is to include, in the application, a statement that the applicant is satisfied that it is entitled to use the mark in Canada in association with the goods and services described in the application. Where, as here, the required statement is provided, an opponent may only rely on section 30(i) in specific cases, such as where bad faith or fraud on the part of the applicant is alleged or where federal legislation arguably prevents the

registration of the mark [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB); and *Interprovincial Lottery Corp v Western Gaming Systems Inc* (2002), 25 CPR (4th) 572 (TMOB)]. In the present case, there are no allegations of that nature in the statement of opposition and there is no evidence in the record to that effect. As discussed above, the evidence does not show the Opponent or others marketing “rodent repellents” in Canada on or before the material date. Even if the evidence shows marketing of pest control products other than rodent repellents, such marketing would not preclude an applicant from being satisfied that its products are the first “rodent repellents”. Consequently, the ground of opposition based on section 30(i) of the Act is dismissed, as the Opponent has failed to meet its initial burden.

GROUND OF OPPOSITION BASED ON DISTINCTIVENESS OF THE MARK UNDER SECTION 2

[47] The Opponent also pleads that the Mark is not and cannot be distinctive within the meaning of section 2 of the Act, because the Mark does not distinguish the goods and services with which it is proposed to be used by the Applicant from the goods and services of others, including those of the Opponent, having regard to what is alleged in the statement of opposition (“*eu égard à ce qu’aux présents mentionné*”).

[48] In the absence of further particulars, I interpret the pleading to be that the Mark is not distinctive because it is clearly descriptive or deceptively misdescriptive in the manners alleged under the section 12(1)(b) ground of opposition. Indeed, in its written argument, the Opponent’s only submission with respect to the non-distinctiveness ground is that a finding of deceptive misdescriptiveness according to the “aforementioned” criteria (“*critères susmentionnés*”)—which would be those discussed under the section 12(1)(b) ground—also supports a conclusion that the Mark is not distinctive of the Goods and Services under section 2.

[49] The material date to analyze a ground of opposition based on non-distinctiveness is generally considered to be the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* 2004 FC 1185, 34 CPR (4th) 317].

[50] The Applicant submits that, to meet its evidential burden, the Opponent must show that its trademarks were known sufficiently to negate the distinctiveness of the Mark and that the issue of distinctiveness turns on the likelihood of confusion. However, when a ground of

opposition is based on an allegation that a trademark is clearly descriptive or deceptively misdescriptive, it is not necessary for an opponent to rely on confusion with one of its own trademarks. It is sufficient for an opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support the non-distinctiveness ground of opposition exist.

[51] I have already found that the Opponent has failed to meet its evidential burden to support its allegations of clear descriptiveness and deceptive misdescriptiveness when assessed at the filing date of the Application, and there is no reason for me to conclude otherwise as of the date the statement of opposition was filed, namely October 18, 2017. Even if the Opponent's 2017 catalogue (Exhibit A) was published sufficiently early in the year to be considered under this ground, the evidence would be insufficient to meet the Opponent's evidential burden, for the reasons discussed above.

[52] I acknowledge that the mere fact that a trademark has not been found to be either clearly descriptive or deceptively misdescriptive under section 12(1)(b) of the Act does not necessarily mean that it is therefore distinctive [see *Canadian Council of Professional Engineers v APA - The Engineered Wood Assn* (2000), 7 CPR (4th) 239 (FCTD)]. For example, although the prohibition under section 12(1)(b) of the Act requires that a trademark's descriptive character go to the material composition of the goods or services or refer to an obvious intrinsic quality or characteristic of the goods or services, there may not be such a requirement for a finding of non-distinctiveness under section 2 of the Act [see *Philip Morris Products SA v Imperial Tobacco Canada Limited*, 2014 FC 1237].

[53] Nevertheless, the Registrar has no jurisdiction to deal with a ground not found in the statement of opposition. In this respect, it is an elementary condition of fairness that each party be adequately informed of the case it has to meet [*Carling Breweries Ltd v Molson Companies Ltd.* (1984), 1 CPR (3d) 191 (FCTD)]. In the present case, the Opponent has specifically pleaded that the Mark is not distinctive having regard to what is alleged in the statement of opposition (“*eu égard à ce qu’aux présents mentionné*”). On a fair reading of the statement of opposition as a whole, the allegations it contains are that the Mark either clearly describes or deceptively misdescribes the character or quality of the Goods or Services as required under a

section 12(1)(b) ground (I find no other relevant allegations in the section 30(i) ground). Moreover, the Opponent filed no evidence or submissions to suggest that it was treating the non-distinctiveness ground of opposition as a broader or self-standing ground, or that the non-distinctiveness ground contemplated the Mark being incapable of distinguishing the Applicant's goods or services for reasons other than those already pleaded.

[54] Since the ground based on non-distinctiveness is phrased in general terms and is clearly derivative of the other grounds of opposition, and in the absence of any submissions from the Opponent as to whether or how the analysis under the non-distinctiveness ground of opposition should differ from that under the section 12(1)(b) ground, I find that the Opponent's evidential burden for the non-distinctiveness ground of opposition remains the same as for the section 12(1)(b) ground [for a discussion of the difference between a derivative ground and a self-standing ground, see *Philip Morris, supra*].

[55] Accordingly, the ground of opposition based on non-distinctiveness is rejected as well, as the Opponent has failed to meet its initial burden.

DISPOSITION:

[56] In view of all 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.

Oksana Osadchuk
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Trademark:

THE ORIGINAL RODENT REPELLENT

Goods:

- (1) Pesticides repellent for commercial and domestic use; Pesticides repellent sprayers and applicators.
- (2) Pest control products for commercial and domestic use, namely, sprayers, applicators, and dispensers for pesticides repellent, and odour control.
- (3) Pest control agents and formulations, namely, non-chemical repellent, chemical repellent, pest repellent, rodent repellent, animal repellent for commercial and domestic use.

Services :

- (1) Operation retail and wholesale sales business for commercial and domestic use products, namely, pesticides repellent and pest control products, namely, non-chemical repellent, chemical repellent, pest repellent, rodent repellent, and animal repellent for commercial and domestic use.
- (2) Marketing of commercial and domestic use products for others, namely, retail and wholesale sales of pesticides repellent and pest control products, namely, non-chemical repellent, chemical repellent, pest repellent, rodent repellent, and animal repellent for commercial and domestic use
- (3) Consultation services, namely, providing assistance and recommend pesticides repellent and pest control products, namely, non-chemical repellent, chemical repellent, pest repellent, rodent repellent, and animal repellent for commercial and domestic use.
- (4) Online retail store services featuring commercial and domestic use products, namely, pesticides repellent and pest control products, namely, non-chemical repellent, chemical repellent, pest repellent, rodent repellent, and animal repellent for commercial and domestic use.

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

No Hearing Held

AGENTS OF RECORD

Norton Rose Fulbright Canada LLP/S.E.N.C.R.L., S.R.L.	For the Opponent
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Flansberry, Menard & Associates/Associés	For the Applicant
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