

O P I C



C I P O

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 213

Date of Decision: 2021-09-28

IN THE MATTER OF AN OPPOSITION

**The Nutraceutical Medicine Company
Inc.**

Opponent

and

Akeso Health Sciences LLC

Applicant

1,807,496 for PURACOL

Application

INTRODUCTION

[1] The Nutraceutical Medicine Company Inc. (the Opponent) opposes registration of the trademark PURACOL (the Mark), which is the subject of application No. 1,807,496 (the Application) by Akeso Health Sciences LLP (the Applicant).

[2] The Application is in association with “dietary supplements containing feverfew” (the Goods).

[3] The opposition is primarily based on an allegation that the Mark is confusing with the Opponent’s prior use and registration of the trademark PURICA in association with goods including “health food supplements and nutraceuticals, namely vitamins, minerals, amino acids; health food supplements and nutraceuticals, namely herbal supplements, meal replacement supplements, and herbal extracts consisting of chia seeds, mushrooms and chicory root, for the promotion of health”.

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

THE RECORD

[5] The Application was filed on November 2, 2016, based on proposed use in Canada as well as use and registration in the United States. The Application was advertised for opposition purposes in the *Trademarks Journal* of May 30, 2018.

[6] On August 30, 2018, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition are based on registrability under section 12(1)(d), entitlement under section 16, and distinctiveness under section 2 of the Act, all of which turn on the issue of a likelihood of confusion between the applied for Mark and the Opponent's trademark or trade name. The Opponent has also raised grounds of opposition based on non-compliance with section 30 of the Act. As 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 (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 before this date).

[7] The Applicant denied all the grounds of opposition in a counter statement served on the Opponent on November 13, 2018.

[8] The Opponent elected not to file any evidence in support of its grounds of opposition. In support of its Application, the Applicant filed the affidavit of Alan Booth (sworn August 20, 2019), a trademark searcher instructed by Applicant's counsel to carry out a search of the Canadian Trademarks Office records to locate active trademarks incorporating the prefix PUR for trademarks containing goods in Class 5. Mr. Booth also attached copies of the particulars for the Applicant's PURACOL registration and the Opponent's PURICA registration from the United States Patent and Trademark Office (USPTO).

[9] Both parties filed written representations. No hearing was held.

ONUS AND MATERIAL DATES

[10] The Opponent has an initial evidential burden to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once that burden is met, the Applicant bears the legal onus of establishing, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155 (FCA)].

[11] The material dates that apply to the grounds of opposition pleaded are:

- Sections 38(2)(a) and 30 - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984) 3 CPR (3d) 469 (TMOB) at 475];
- Sections 38(2)(b) and 12(1)(d) - the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- Sections 38(2)(c) and 16 – the filing date of the application [sections 16(2) and (3) of the Act]
- Sections 38(2)(d) and 2 – the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

ANALYSIS OF THE GROUNDS OF OPPOSITION

Section 12(1)(d) ground of opposition

[12] The Opponent has pleaded that the Mark is not registrable because it confusing with the Opponent's registered trademark PURICA (TMA681,954). I have exercised my discretion to check the Register and confirm that this registration remains extant [*Quaker Oats Co Ltd of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Accordingly, the Opponent has met its initial burden with respect to this ground.

[13] The Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's trademark.

Test for confusion

[14] The test to determine the issue of 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 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. 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.

[15] 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]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, where the Supreme Court of Canada, at para 49, states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

Inherent distinctiveness of the trademarks and the extent to which they have become known

[16] The trademarks in issue are coined terms, which ordinarily hold a high degree of inherent distinctiveness. However, the prefix portion of both PURICA and PURACOL, namely “PUR”, holds meaning as a diminutive for the word “pure” in view of the parties’ respective supplements. Accordingly, I find the parties’ trademarks to be somewhat suggestive of the parties’ respective supplements being “pure” (i.e. supplements free of contamination or any harmful substances). This lessens the inherent distinctiveness of both of the parties’ marks.

[17] The strength of a trademark may be increased by it becoming known through promotion or use. However, there is no evidence that the Applicant’s Mark or the Opponent’s trademark has become known in Canada to any extent.

[18] Accordingly, I find that the overall consideration of the section 6(5)(a) factor, which involves a combination of the inherent and acquired distinctiveness of the parties' trademarks, favours neither party.

Length of time in use

[19] As noted above, the Applicant has not demonstrated any use of the Mark, which has been applied for registration based on proposed use in Canada as well as use and registration in the United States.

[20] With respect to the Opponent's trademark, a declaration of use was filed on January 31, 2007. However, the Opponent has filed no evidence of use of its trademark in association with the registered goods and services.

[21] Accordingly, this factor favours neither party.

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

[22] For ease of reference, the goods and services associated with the Opponent's registration are listed below:

Goods

- (1) Cosmetics, namely lip-gloss, bath crystals, bath grains, bath salts, body scrubs.
- (2) Health food supplements and nutraceuticals, namely vitamins, minerals, amino acids; Health foods supplements and nutraceuticals, namely herbal supplements, meal replacement supplements and herbal extracts consisting of chia seeds, mushrooms and chicory root, for the promotion of health.

Services

- (1) Retail store services offering the sale of cosmetics, skin care and hair care products, health food and health food supplements, light fixtures namely, full spectrum lights, household cleaning products, filters namely, air filters and water filters, home care products, home accessories, books.

[23] The Mark is associated with "dietary supplements containing feverfew".

[24] The Applicant in its written representations admits that there is an overlap in the nature of the Applicant's goods with those of the Opponent, and that there is potential for overlap in the

channels of trade. I agree that there is direct overlap in respect of the Opponent's supplements and the Applicant's Goods. In view of the absence of any evidence to the contrary, I am also prepared to conclude that there would likely also be overlap in the channels of trade associated with the parties' goods.

[25] Accordingly, these factors favour the Opponent.

Degree of resemblance

[26] As noted above, the degree of resemblance between the trademarks will often have the greatest effect on the confusion analysis. When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality. 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, supra*].

[27] When I consider the trademarks as a whole, I find the Mark has some similarity with the Opponent's trademark in appearance given both marks share the prefix PUR. However, the importance of this first component is diminished by its suggestive significance [*Sky Solar Holdings Co v Skypower Global*, 2014 TMOB 262]. Further, notwithstanding that both of the parties' suffixes contain the letter "C", I find that there are clear differences between the suffixes "ICA" and "ACOL".

[28] With respect to the degree of resemblance when sounded, the Opponent in its written representations submits that the Mark is essentially the phonetic equivalent of the Opponent's trademark considering that:

“...The trademarks share the same first 3 letters, followed by a vowel, which while different *produces the same sound*, followed by the same letter “C”, followed by a vowel which again *produces the same/similar sound*, the only difference is the remaining letter “L” of the Applicant's trademark which is so insignificant that it does not serve to render the trademark sufficiently different in sound from the Opponent's trademark PURICA...”.

[29] In turn, the Applicant submits that the average consumer would not consider the Mark to have a similar sound to the Opponent's trademark “due to the differences in the suffix “SOL [my

emphasis added] in the Applicant’s trademark PURACOL, which also increases the length of time required to pronounce the trademark”.

[30] However, as neither of the parties has provided any evidence to substantiate their assertions of how the marks would be sounded by the average consumer, I have not relied on these assertions in my analysis. With this in mind, I am of the view that there would be some degree of resemblance when sounded in that the marks share the prefix PUR, which importance is diminished given its suggestive significance. The parties also share a hard “C” sound in the suffixes of their respective marks. However, there are clear differences in the suffixes “ICA” and “ACOL” when sounded. The parties’ marks share some resemblance in the ideas suggested insofar as they share the same suggestive prefix.

Surrounding circumstance – family of trademarks

[31] The Opponent submits that its position in this case is strengthened by a family of trademarks comprised of the Opponent’s trademark PURICA and a list of additional PURICA trademarks owned by the Opponent and disclosed in the Applicant’s search of the state of the register (in Exhibit A to the Booth affidavit).

[32] In order to benefit from the wider scope of protection that may be afforded to a family of trademarks, an opponent must prove use of each of the marks in the alleged family [*McDonald’s Corp v Alberto-Culver Co* (1995), 61 CPR (3d) 382 (TMOB)]. The Opponent in this case has not done so. Accordingly, this is not a relevant surrounding circumstance assisting the Opponent.

Surrounding circumstance – state of the register

[33] State of the register evidence favours an applicant when it can be shown that the presence of a common element in marks would cause consumers to pay more attention to the other features of the marks, and to distinguish between them by those other features [*McDowell v Laverana GmbH & Co. KG*, 2017 FC 327 at para 42]. Inferences regarding the state of the marketplace may be drawn from such evidence in two situations: a large number of relevant registrations are located; and/or there is evidence of common use in the marketplace of relevant third party marks [*Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43

CPR (3d) 349 (FCA); *McDowell v Laverana GmbH & Co KG*, 2017 FC 327 at paras 41-46]. Relevant trademarks include those that (i) are registered; (ii) are for similar goods and services as the marks at issue, and (iii) include the component at issue in a material way [*Sobeys West Inc v Schwan's IP, LLC*, 2015 TMOB 197].

[34] The Booth affidavit provides the result of a search conducted for “active trademarks incorporating the prefix PUR for marks containing class 5 goods” (Booth affidavit, Exhibit A). However, in reviewing the results, I note that many of the third party registrations are in association with dissimilar goods. Secondly, some of the third party registrations include “PURE” as a standalone element in a mark, or else feature other material differences. Finally, I have not considered those marks which are still pending, or that belong to the Opponent. With this in mind, in my view, the following marks located by Mr. Booth are the most relevant to the present case in that they are registered trademarks that incorporate the element PUR as a prefix and are listed for use in association with supplements. It is noteworthy that no evidence of use in the marketplace in Canada of these (or any other) third party marks has been provided:

PURAPHARM (TMA530,131); PURAGOLD (TMA631,343); PURVELOURS (TMA763,680); PURATOX (TMA 799,675); PURKRILL (TMA819,542); PURECURE LOGO (TMA912,878); PURTIER DESIGN (TMA930,128); PUREA (TMA984,112).

[35] Following the decision in *McDowell, supra*, however, I am not sure that evidence of the above registrations without any evidence of use of these marks in the marketplace is sufficient to draw a meaningful inference about the state of the marketplace. I also refer to the decision in *McDowell v The Body Shop International PLC*, 2017 FC 581, where the Court found that the lack of evidence that the mark was used in relation to goods that were similar to those of the parties was enough to conclude that the Board had erred in drawing a negative inference merely from the state of the register.

[36] Based on the foregoing, I do not consider this to be a relevant surrounding circumstance assisting the Applicant.

Surrounding circumstance – co-existence in other jurisdictions

[37] The Applicant notes that the Mark has been co-existing without confusion with the Opponent's trademark PURICA in the United States (US) since at least the US registration date, namely August 26, 2008 (Exhibits B and C, Booth affidavit). The Applicant submits that while there are some differences in the marketplace in the US compared to Canada, those differences are not that significant. However, the mere co-existence of marks on foreign registers is not relevant to the likelihood of confusion in Canada [*Vivat Holdings Ltd v Levi Strauss & Co* (2005), 41 CPR (4th) 8 (FC) at para 65]. Accordingly, I do not consider this to be a relevant surrounding circumstance assisting the Applicant.

Conclusion

[38] Having regard to the foregoing, and in particular, taking into account that there is no evidence the Opponent's mark has become known to any extent in Canada, and that the diminished importance of the shared prefix PUR tends to mitigate the degree of resemblance between the parties' marks, I find that the balance of probabilities between finding that there is no reasonable likelihood of confusion, and that there is a reasonable likelihood of confusion weighs slightly in favour of the Applicant. Accordingly, the section 12(1)(d) ground of opposition is rejected.

[39] As an aside, I note that had the Opponent provided some evidence establishing that its trademark had become known to some extent in Canada so as to benefit from acquired distinctiveness, I may have reached a different conclusion on this ground of opposition.

Section 16(2)(a) and 16(3)(a) grounds of opposition

[40] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark having regard to sections 16(2)(a) and 16(3)(a) of the Act in that at the date of filing of the Application, the Mark was confusing with the Opponent's trademark PURICA which had been previously used and made known in Canada by the Opponent.

[41] The Opponent has provided no evidence of the use or making known of its trademark in Canada. Therefore, it has not met its initial evidential burden and these grounds of opposition are rejected.

Section 16(2)(c) and 16(3)(c) grounds of opposition

[42] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark having regard to sections 16(2)(c) and 16(3)(c) of the Act in that at the date of filing of the Application, the Mark was confusing with the Opponent's trade name PURICA which had been previously used in Canada by the Opponent.

[43] The Opponent has provided no evidence of use of its trade name in Canada. Therefore, it has not met its initial evidential burden and these grounds of opposition are rejected.

Section 2 ground of opposition

[44] The Opponent has pleaded that the Mark is not distinctive, because it is not capable of distinguishing the Applicant's Goods from those of others, particularly the goods and services sold by the Opponent under the trademark PURICA, nor is it adapted to so distinguish them.

[45] In order to meet its initial evidential burden under this ground of opposition, an opponent must show that its trademark had a substantial, significant or sufficient reputation in Canada in association with the relevant goods and/or services so as to negate the distinctiveness of the applied for trademark [*Motel 6, Inc v No 6 Motel Ltd*, (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427].

[46] In this case, the Opponent has provided no evidence of the use or making known of its trademark in Canada. Therefore, the Opponent has not met its initial evidential burden and this ground of opposition is rejected.

Section 30(a) ground of opposition

[47] The Opponent has pleaded that the Application does not comply with section 30(a) of the Act because it does not contain a statement in ordinary commercial terms of the specific goods and services in association with which the Mark has been or is proposed to be used.

[48] An opponent's evidential burden under section 30(a) is a lighter one and may be met through argument [*McDonald's Corp v MA Comacho-Saldana International Trading Ltd* (1984), 1 CPR (3d) 101 at 104 (TMOB)], which has been done in this case. Specifically, the Opponent submits that the Goods "dietary supplements containing feverfew" are not sufficiently described in accordance with Section 2.4.5.12 of the *Trademarks Examination Manual* which states that:

"goods that are described as ... "supplements" for "pharmaceutical", "veterinary", or "medicinal" use are not considered specific pursuant to paragraph 30(2)(a) of the Act and section 29 of the Regulations. The Registrar requires such goods to be specified in greater detail by either:

- naming the disease; or
- specifying the disease group or type of disease, disorder or condition to be treated; or
- by indicating the specific type of medication.

[49] In its written representations, the Applicant submits that the Goods have been described in ordinary commercial terms as its description for its supplement goods clearly states that the condition to be treated is "dietary", and the specific type of medication is "feverfew". The Applicant further submits that the Goods as described in the Application are consistent with the acceptable listings for "dietary supplements" published in the *Goods and Services Manual*, such as "beta carotene supplements, flaxseed dietary supplements, linseed dietary supplements, mugwort dietary supplements, propolis dietary supplements, wheat germ dietary supplements, and yeast dietary supplements".

[50] The *Goods and Services Manual* is not exhaustive. Rather, it includes a representative list of acceptable goods and services descriptions. For those 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 as specific as, or more specific than, a related or similar listing. [*Trademarks Examination Manual*, section 2.4.5].

[51] Having exercised my discretion to check the *Goods and Services Manual* [*Johnson & Johnson v Integra Lifesciences Corp* (2011), 98 CPR (4th) 429 (TMOB)], and having noted the above-referenced examples of acceptable descriptions for dietary supplements, I am satisfied that the statement of Goods, when read as whole, is sufficiently specific. Accordingly, this ground of opposition is rejected.

Section 30(d) ground of opposition

[52] The Opponent has pleaded that the Application does not comply with section 30(d) of the Act because “the Applicant’s alleged trademark has not been used by the Applicant in the United States of America in association with all of the goods covered by trademark application No. 1,807,496”.

[53] In support of this ground of opposition, the Opponent submits that the Applicant’s claim of use and registration of the Mark in the US should be “at least minimally supported by some showing of use in the United States”. The Opponent further submits that the Applicant’s evidence merely shows a copy of the status page from the USPTO, that the status page alone is insufficient to show use and registration in the US, and that the Applicant has not adduced any evidence to support its claim.

[54] Based on the foregoing, I understand this ground of opposition to be limited to an allegation that the Applicant has not *used* the Mark in the US with the Goods. However, the Opponent did not file any evidence that calls the Applicant’s claim of use in the US into question. Moreover, the Applicant is not obliged to submit any evidence to substantiate its claim of use in the US unless the Opponent has met its initial evidential burden, which is not the case here.

[55] Accordingly, this ground of opposition is rejected.

Section 30(e) ground of opposition

[56] The Opponent has pleaded that the Application does not comply with section 30(e) of the Act because at the date of filing of the Application, the Applicant never intended by itself, nor through a licensee, to use the Mark in Canada in association with the Goods.

[57] In support of this ground of opposition, the Opponent notes that the owner of the US registration No. 2,902,023 for PURACOL (Booth affidavit, Exhibit B) is not the Applicant, and that the evidence fails to make the correlation between the two owners. In reply, the Applicant submits that the US registration details provided at Exhibit B of the Booth affidavit do not appear to be updated to reflect corporate name changes. The Applicant further notes that the certified copy of its US registration No. 2,902,023, dated December 19, 2017, and which was filed with the Canadian Registrar of Trademarks on January 2, 2018 clearly indicates that the owner of such registration is the Applicant.

[58] Section 30(e) of the Act requires an applicant to make a statement that it, either by itself or through a licensee intends to use the applied-for trademark in Canada. In this case, the Application contains this statement and therefore formally complies with section 30(e) of the Act. The question then becomes whether the Applicant has substantively complied with section 30(e) of the Act; that is, did the Applicant have a *bona fide* intention to use the applied for trademark in Canada at the time of filing of the application?

[59] To meet its evidential burden, the Opponent has relied on the Applicant's printout of the status page for US registration No. 2,903,023 for PURACOL from the USPTO (Booth affidavit, Exhibit B), citing "Akeso, LLC Limited Liability Company California" as the last listed owner instead of the Applicant. I note that this Exhibit is simply a copy of the status page from the USPTO rather than a comprehensive printout of all of the documents in the file history.

[60] Leaving aside the question of whether the status page accurately reflects the ownership of the US registration, even if I were to accept that the Applicant was not the owner of the US registration at the filing date of the Application, I am of the view that this would not necessarily preclude the Applicant from having a *bona fide* intention to use the Mark in Canada. Put another way, the fact that the Applicant might not hold ownership of a registration for the Mark at the

material date in the US does not necessarily lead to the conclusion that the Applicant does not have a *bona fide* intent to use the Mark in Canada. Thus, I find that the Opponent has failed to meet its initial evidential burden.

[61] Accordingly, this ground of opposition is rejected.

DISPOSITION

[62] In view of all the foregoing, 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.

Jennifer Galeano
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

No Hearing Held

Agents of Record (All of the Agents at)

KLS Trademark Services

For the Opponent

DB Business Law/TM Central

For the Applicant