



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 021

Date of Decision: 2022-02-09

IN THE MATTER OF AN OPPOSITION

Made in Nature, LLC

Opponent

and

Pharmavite LLC

Applicant

1,617,374 for NATURE MADE

Applications

1,617,375 for NATURE MADE

1,617,376 for NATURE MADE

1,617,381 for NATURE MADE

INTRODUCTION

[1] Pharmavite LLC (the Applicant) has filed four applications to register the trademark NATURE MADE (the Mark) in association with a variety of goods. The goods listed in each application, as amended, are set out in Schedules A, B, C, and D to this decision. Each application was filed on March 8, 2013, claiming priority to a corresponding application in the United States filed on February 28, 2013. Each application is based on proposed use of the Mark in Canada.


[2] The applications were advertised for opposition purposes in the *Trademarks Journal* on July 8, 2015. On May 6, 2016, Made in Nature, LLC (the Opponent) filed a statement of opposition against each application pursuant to section 38 of the *Trademarks Act*,

RSC 1985, c T-13 (the Act). On December 4, 2019, the Registrar granted leave for the Opponent to file amended statements of opposition each dated November 20, 2019.

[3] Given that the parties, trademark, grounds of opposition, evidence and material dates in each of these four proceedings are identical, I have addressed the oppositions in a single decision. Where necessary in the decision to differentiate between the four applications, I have done so with reference to the final three digits of the application numbers (e.g. application No. 1,617,374 is the '374 Application, application No. 1,617,375 is the '375 Application, etc.).

[4] I note that the Act was amended on June 17, 2019, and pursuant to section 70 of the Act, the grounds of opposition in this case will be assessed based on the Act as it read prior to June 17, 2019.

[5] The Opponent raises grounds of opposition based on non-distinctiveness under section 2, non-entitlement under sections 16(3)(a), (b) and (c), non-registrability under section 12(1)(d), and non-compliance with section 30(e) and (i). For the grounds of opposition that are based on an alleged likelihood of confusion, the Opponent relies on the following trademarks for which it is the registered owner:

Reg. No.	Trademark	Goods
TMA423,398	MADE IN NATURE	Frozen and prepared organically grown or wild harvested vegetables; fresh organically grown or wild harvested fruits and vegetables.
TMA995,441	MADE IN NATURE	Fresh and frozen pizza; dried fruit; fresh fruit.
TMA995,439		Fresh and frozen pizza; dried fruit; fresh fruit.

[6] I note that the Opponent in its pleadings also relied on registration TMA555,833 for the trademark MADE IN NATURE CERTIFIED ORGANIC & DESIGN. However, that registration was expunged in 2017 and no evidence of use of that trademark was filed in this proceeding.

Consequently, no submissions regarding registration TMA555,833 were made by the Opponent at the hearing, and it will not be considered in the confusion analysis.

[7] The Applicant filed a counter statement denying the grounds of opposition.

[8] The Opponent filed as its evidence certified copies of registration Nos. TMA423,398 and TMA555,833. The Applicant filed as its evidence the affidavit of Peterson Eugenio sworn January 15, 2019, which is comprised of the particulars of the Applicant's Canadian registration Nos. TMA341,352 (NATURE MADE) and TMA482,642 (NATURE MADE BRAND SOMETIMES A NAME SAYS IT ALL).

[9] Both parties filed written representations and attended a hearing.

[10] For the reasons set out below, I reject the oppositions against all four applications.

ONUS

[11] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the Application complies with the requirements of the Act. 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 [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

GROUND OF OPPOSITION SUMMARILY REJECTED

Sections 30(e) and (i) Grounds of Opposition

[12] At the outset of the oral hearing, counsel for the Opponent indicated that the grounds of opposition under section 30(e) and (i) of the Act were being withdrawn. Indeed, there is no evidence of record to support these grounds of opposition with which the Opponent could meet its initial evidential burden. These grounds are therefore rejected.

Section 16(3)(a), Section 16(3)(c) and Section 2 Grounds of Opposition

[13] The Opponent did not file any evidence of use of its trademarks or trade name. Consequently, there is no evidence on which it can rely for the purposes of the section 16(3)(a), section 16(3)(c) and section 2 grounds of opposition. While the Opponent filed certified copies of two of its registrations (one of which was expunged), a certified copy alone does not permit the Registrar to assume anything more than *de minimis* use of an opponent's trademark [see *Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)] and is not sufficient to meet an opponent's evidential burden for a non-entitlement or non-distinctiveness ground of opposition [see *1772887 Ontario Ltd v Bell Canada*, 2012 TMOB 41]. Therefore, the grounds of opposition under sections 16(3)(a), 16(3)(c) and 2 are rejected as the Opponent has not met its initial evidential burden.

REMAINING GROUNDS OF OPPOSITION

Section 12(1)(d) Ground of Opposition

[14] The material date for the section 12(1)(d) ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[15] The Opponent asserts that the Mark is not registrable because it is confusing with the Opponent's registered trademarks MADE IN NATURE (TMA423,398 and TMA995,441), and MADE IN NATURE ORGANIC & DESIGN (TMA995,439), identified in paragraph 5 of this decision, above. I have exercised my discretion to check the Register and confirm that these three registrations remain extant [see *Quaker Oats Co Ltd of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent has therefore met its initial evidential burden with respect to the section 12(1)(d) ground of opposition. As noted above, the Opponent's registration TMA555,833 has been expunged and so will not be considered in the analysis. The section 12(1)(d) ground of opposition based on registration TMA555,833 is rejected.

[16] In considering the issue of confusion, I will focus my analysis on the Opponent's registered word trademark MADE IN NATURE (TMA423,398 and TMA995,441) as in my view

this represents the Opponent's best chance of success. If there is no confusion between the Applicant's Mark and the Opponent's word trademark MADE IN NATURE, then there will be no confusion with the Opponent's other trademark MADE IN NATURE ORGANIC & DESIGN (TMA995,439), since that latter trademark contains additional word and design elements that reduce its resemblance to the Applicant's Mark.

Test for confusion

[17] 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.

[18] 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 Clicquot 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.

[19] 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].

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

[20] The Opponent's trademark MADE IN NATURE has a low degree of inherent distinctiveness in association with the food products with which it is registered. The phrase that comprises the trademark is highly suggestive, if not descriptive, of food products or ingredients sourced from nature.

[21] The Applicant's trademark NATURE MADE also has a low degree of inherent distinctiveness for the same reasons.

[22] Neither party filed evidence of use or reputation of their respective trademarks, and consequently there is no evidence to suggest that either party's trademark has become known to any extent.

[23] In view of the above, this factor does not favour either party.

The length of time the trademarks have been in use

[24] Neither party filed evidence of use of their trademarks. I do not consider the certified copies of registrations filed by the Opponent to speak in any meaningful way to the duration of use of its trademark [see *1772887 Ontario Ltd v Bell Canada*, 2012 TMOB 41 at para 22]. Therefore, this factor does not favour either party.

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

[25] As set out in paragraph 5 of this decision, above, the goods listed in the Opponent's registrations are "Frozen and prepared organically grown or wild harvested vegetables; fresh organically grown or wild harvested fruits and vegetables." and "Fresh and frozen pizza; dried fruit; fresh fruit."

[26] Most of the goods in the Applicant's applications fall within the general category of food and beverages products. However, I agree with the Applicant that degree of similarity with the Opponent's goods, alone, is not necessarily dispositive, given the breadth of the food and beverage category [for a similar analysis, see *Clorox Co v Sears Canada Inc* (1992), 41 CPR (3d) 483 (FC) at para 19, and *Tritap Food Broker v Billy Bob's Jerky Inc*, 2012 TMOB 40, 100

CPR (4th) 244 at paras 20-22]. I agree with the Applicant that in this case there is a difference in the nature of the parties' goods.

[27] For the vast majority of the goods listed in the Applicant's four applications, in my view, there is no direct overlap with the Opponent's goods. For example, I do not consider the "Herbal tea beverages" in the '374 Application or the various "Cereal bars" and "grain-based food bars" in the '375 Application to overlap or be similar in nature to any of the Opponent's goods. Nor do I consider the "nutritional supplements, namely, vitamin and mineral supplements in the form of capsules, tablets, caplets, [...]" in the '381 Application to overlap or be similar to the Opponent's goods. Further, I do not consider any of the goods in the Applicant's applications to be similar to the "Fresh and frozen pizza" listed in the Opponent's registrations.

[28] Where the connection between the parties' goods potentially gets closer is with the goods in the Applicant's applications that presumably include as ingredients some of the Opponent's goods (such as vegetables, fresh fruit or dried fruit). For example, the '374 Application includes the goods "Beauty beverages, namely, fruit juices and energy drinks containing nutritional supplements; [...] smoothies; beverages, namely, fruit beverages", the '376 Application includes the goods "fruit-based meal replacement bars; vegetable-based food bars", and the '381 Application includes the goods "nutritional and dietary supplements formed and packaged as bars, namely, energy bars and fruit bars". However, even with respect to these goods, in my view, the descriptions of the Applicant's goods suggests that they are manufactured and pre-packaged products that are different from the Opponent's fresh fruits and vegetables and dried fruit. In addition, even if some of the above-referenced goods of the Applicant were sold in the same type of store as the Opponent's goods (such as a grocery store or convenience store), they would likely be sold in different sections of that store.

Degree of resemblance

[29] One must consider the degree of resemblance from the perspectives of appearance, sound, and ideas suggested. The preferable approach is to begin by determining whether there is an aspect of each trademark that is "particularly striking or unique" [*Masterpiece, supra*, at paragraph 64].

[30] With the Opponent’s trademark, in my view, the striking aspect is the phrase “MADE IN NATURE” as a whole. I do not consider any of the individual words in the phrase to be more striking than the other, and it is apparent that the trademark is intended to be read as a unitary phrase. Similarly, with the Applicant’s Mark, I consider the striking aspect to be “NATURE MADE” as a whole.

[31] The trademarks are not identical in view of the reverse ordering of the words “MADE” and “NATURE”, and the presence in the Opponent’s trademark of the preposition “IN”. However, when considered as a whole, it is nevertheless apparent that there is a meaningful resemblance between the trademarks in appearance and sound, given that they both include the words “MADE” and “NATURE”, and they both convey a similar idea of products being derived from nature.

Surrounding circumstance – jurisprudence concerning weak trademarks

[32] As discussed above, the Opponent’s trademark MADE IN NATURE has a low degree of inherent distinctiveness and the Opponent has not filed any evidence to suggest that the trademark has acquired distinctiveness through use or promotion. In these circumstances, the Opponent’s trademark must be considered a weak trademark.

[33] It is well established that weak trademarks are entitled to a narrow scope of protection and that relatively small differences between such marks will be sufficient to avoid a finding of confusion. The jurisprudence regarding weak trademarks was summarized as follows in *Fiber-Shield (Toronto) Ltd v Henkel Corporation*, 2020 TMOB 137 at para 18:

It is well accepted that comparatively small differences will suffice to distinguish between weak trademarks [*Boston Pizza International Inc v Boston Chicken Inc* (2001), 15 CPR (4th) 345 (FCTD) at para 66]. As explained in *Provigo Distribution Inc c Max Mara Fashion Group SRL* (2006), 46 CPR (4th) 112 (FC) at para 31:

The two marks being inherently weak, it is fair to say that even small differences will be sufficient to distinguish among them. Were it otherwise, first user of words in common use would be unfairly allowed to monopolize these words. A further justification given by courts in coming to this conclusion is that the public is expected to be more on its guard when such weak trade names are used ...

A party adopting a weak trademark has been held to accept some risk of confusion [*General Motors Corp v Bellows* (1949), 10 CPR 101 (SCC) at 115-116]. While it is possible for the degree of distinctiveness attributed to a weak trademark to be enhanced through extensive use [*Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD) at para 6], there is no evidence that this is the case here.

[34] Given that the Opponent’s trademark is a weak mark, I agree with the Applicant that small differences between the parties’ trademarks and/or the goods with which they are associated may be sufficient to avoid a finding of confusion. The jurisprudence concerning weak trademarks is a factor which weighs in the Applicant’s favour in this case.

Surrounding circumstance – Applicant’s existing registered trademarks

[35] The Applicant already owns the following two registered trademarks which include or are comprised of the term “NATURE MADE”, and submits that this weighs in its favour when considering whether there is a likelihood of confusion:

Reg. No.	Trademark	Goods
TMA341,352	NATURE MADE	Vitamins; minerals; and food supplements, namely lectithin [<i>sic</i>]; brewer's yeast; bran.
TMA482,642	NATURE MADE BRAND SOMETIMES A NAME SAYS IT ALL	Vitamins, minerals and food supplements.

[36] However, for the following reasons, I do not consider the existence of these two registrations to assist the Applicant in this case. First, it is well established that section 19 of the Act does not give the owner of a registration an automatic right to obtain any further registrations, no matter how closely they may be related to the original registration [see *Groupe Lavo Inc v Proctor & Gamble Inc* (1990), 32 CPR (3d) 533 (TMOB) at para 15; see also *Highland Feather Inc v American Textile Co*, 2011 TMOB 16 at para 20]. Second, the trademark which is the subject of TMA482,642 contains additional word matter which noticeably reduces its degree of resemblance with the Opponent’s trademark, making it less relevant. Third, I consider registration TMA341,352 to be of limited relevance given that its list of goods is much narrower than those of the four applications in issue in this proceeding (even taking into account that some of the goods in the ’381 Application might be considered an extension of those in TMA341,352; see *Caesarstone Sdot-Yam Ltd v Ceramiche Caesar SPA*, 2016 FC 895, 142 CPR (4th) 444 at paras 50-57). Finally, contrary to the Applicant’s argument in its written

representations, the existence of these two trademarks on the register does not demonstrate coexistence of the parties' trademarks in the Canadian marketplace. I have no evidence in this case of use of either party's trademarks.

Conclusion regarding the Section 12(1)(d) ground

[37] Taking into account all of the surrounding circumstances, I conclude that the Applicant has satisfied its legal burden to show that there is no reasonable likelihood of confusion between the parties' trademarks. The Opponent's trademark MADE IN NATURE is an inherently weak mark and the Opponent has not filed any evidence to suggest that it has acquired distinctiveness through use or promotion. Consequently, the Opponent's trademark must be afforded a narrow scope of protection. Against this backdrop, the Applicant has satisfied me that the differences between the parties' trademarks themselves, in conjunction with the differences in the parties' goods, is sufficient to render confusion unlikely.

[38] In view of the above, I reject the section 12(1)(d) ground of opposition based on registration Nos. TMA423,398 and TMA995,441 in respect of each of the Applicant's four applications.

[39] I also reject the section 12(1)(d) ground of opposition based on registration No. TMA995,439 for essentially the same reasons, taking into account that there is a lower degree of resemblance between the parties' trademarks when considering TMA995,439.

Section 16(3)(b) Ground of Opposition

[40] With this ground of opposition, the Opponent relies on its application Nos. 1,575,409 and 1,575,416. These are the two applications which later matured to registration Nos. TMA995,441 and TMA995,439, respectively, considered in the section 12(1)(d) analysis, above. Since the two applications were still pending at the date of advertisement of the Applicant's application, the Opponent also relies on them as a basis for a ground of opposition under section 16(3)(b). The material date for this ground of opposition is the priority filing date of the Applicant's applications, namely, February 28, 2013 [*Earthrise Farms v Saretzky* (1997), 85 CPR (3d) 368 (TMOB)].

[41] Regardless of the earlier material date for the section 16(3)(b) ground, in my view, the confusion analysis for the section 16(3)(b) ground is essentially identical to that for the section 12(1)(d) ground of opposition, conducted above. In short, I am satisfied that the Applicant has met its legal burden to demonstrate on a balance of the probabilities that there is no likelihood of confusion between the Mark and the Opponent's trademarks.

[42] Consequently, I reject the section 16(3)(b) ground of opposition in respect of each of the Applicant's four applications.

DISPOSITION

[43] With respect to each of to application nos. 1,617,374, 1,617,375, 1,617,376 and 1,617,381, 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.

Timothy Stevenson
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Application No. 1,617,374 for NATURE MADE

Goods:

- (1) Beauty beverages, namely, fruit juices and energy drinks containing nutritional supplements; non-alcoholic beverages with tea flavor; drinking water with vitamins; bottled water; drinking waters; carbonated water; flavored waters; essences for making flavored waters; smoothies; beverages, namely, fruit beverages
- (2) Herbal tea beverages

SCHEDULE B

Application No. 1,617,375 for NATURE MADE

Goods:

(1) Cereal bars; cereal based energy bars; grain-based food bars; granola-based snack bars; chocolate based meal replacement bars; high-protein cereal bars; tea; tea-based beverages, namely, beverages made of tea; chewing gums; chewing gums with vitamins; candy; caramels; chocolate; chocolate confections; mints; candy sprinkles; salad dressings

(2) Edible oils

SCHEDULE C

Application No. 1,617,376 for NATURE MADE

Goods:

- (1) Soy-based food bars; soy-based snack foods; fruit-based meal replacement bars; vegetable-based food bars; nut and seed based snack bars; yogurts; yogurt-based beverages
- (2) Nutritionally fortified food products, namely, candies, and energy bars
- (3) Soy-based beverages, namely, non-dairy soy beverages

SCHEDULE D

Application No. 1,617,381 for NATURE MADE

Goods:

(1) Nutritional supplement energy bars; dietary supplemental drinks, namely, vitamin and mineral beverages; dietary supplement drink mixes, namely, mixes which when added to water forms dietary supplements for general health and well-being; nutritional and dietary supplements formed and packaged as bars, namely, energy bars and fruit bars; protein supplements, namely, protein shakes, protein-enriched-milk and textured vegetable protein; herbal products, namely, herbal supplements for general health and well-being, herbal supplements for the promotion of healthy liver function and herbal supplements for the treatment of arthritis; nutritional supplements, namely, vitamin and mineral supplements in the form of capsules, tablets, caplets, powder, syrups, chews, gums, gummies, gels, oral sprays and dissolvable strips; medicated antiseptic mouthwash.

(2) Protein-enhanced shakes

(3) Herbal teas; herbal products, namely, herbal tea beverages

(4) Protein-enhanced smoothies; vitamin- enriched water; mineral, vitamin and-nutritionally enhanced water

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

HEARING DATE 2021-10-05

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