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C I P O

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 036

Date of decision: 2022-02-28

[UNREVISED ENGLISH

CERTIFIED TRANSLATION]

IN THE MATTER OF AN OPPOSITION

Premier Horticulture Ltée.

Opponent

and

Les Sols R. Isabelle Inc.

Applicant

1,737,829 for BIOMIX

Application

[1] Premier Horticulture Ltée (the Opponent) opposes registration of the trademark BIOMIX (the Mark), which is the subject of registration No. 1,737,829 (the Application), filed by Les Sols R. Isabelle Inc. (the Applicant). The Application is based on the proposed use of the Mark in Canada in association with the following goods: [TRANSLATION] “Soil, top soil, fertilizers, manures, compost, lawn seed.”

[2] The grounds for opposition concern the likelihood of confusion, within the meaning of the *Trademarks Act*, RSC 1985, c. T-13 (the Act), between the Mark and the BIOMAX Design trademark shown below (the BIOMAX Mark), which consists of the word BIO in solid uppercase, followed by the word MAX in hatched uppercase italics, all underlined with a straight line, and which was used in Canada by the Opponent and registered by it as No. TMA407,386 in association with the following goods: [TRANSLATION] “manure and peat compost.”

BIOMAX

[3] As my analysis will show, I find that the application should be refused.

THE RECORD

[4] The Application was filed on July 17, 2015, and advertised in the *Trademarks Journal* for opposition purposes on April 3, 2016.

[5] The statement of opposition was filed on May 30, 2016, under section 38 of the Act and was then amended by the Opponent on December 20, 2016, in response to a motion for an interlocutory decision on the sufficiency of the grounds of opposition pleaded by the Applicant at the same time as its counter statement denying each of the grounds of opposition. The interlocutory decision, rendered on January 18, 2017, struck the ground of opposition based on the non-compliance of the Application with section 30(i) of the Act, having found that ground insufficiently pleaded.

[6] The remaining grounds of opposition allege that the Mark is not registrable under section 12(1)(d) of the Act, that the Applicant is not the entitled to registration of the mark under section 16(3)(a) of the Act, and that the Mark is not distinctive under section 2 of the Act, all due to the confusion created by the Mark with the BIOMAX Mark. A final ground of opposition, based on the non-compliance of the Application with section 30(e) of the Act, was abandoned by the Opponent at the hearing.

[7] Numerous amendments to the Act came into force on June 17, 2019. Pursuant to the transitional provisions in section 70 of the Act concerning applications advertised before June 17, 2019, the grounds of opposition in this case will be assessed based on the Act as it read immediately before those amendments, an exception being that the definition of confusion in sections 6(2) to 6(4) of the Act as it currently reads will be applied.

[8] In support of its opposition, the Opponent filed the following evidence:

- An affidavit by its Senior Director of Marketing and Communications, Chantal Duchesneau, dated March 1, 2017. Ms. Duchesneau has been employed by the

Opponent since 1999, first as marketing coordinator and then in several positions as Director of Marketing and Communications in various business units in the company. In her affidavit, she describes the Opponent's activities and the use of the BIOMAX Mark and discusses the Applicant's activities.

- As reply evidence, an affidavit by Béatrice Dubois, a paralegal employed by the firm representing the Opponent, dated July 25, 2017. Ms. Dubois attached to her affidavit as exhibits BD-1 to BD-3 the results of some searches that she carried out on July 25, 2017, using the Saegis search tool to identify active trademarks (registered or with outstanding applications) beginning with "BIOM" and ending in "X" in association with goods in class 1 of the Nice Classification (including chemical goods for industry, science and agriculture, including fertilizer and mulch).

[9] In support of its application, the Applicant filed the following evidence:

- An affidavit by Wendy Landrigan-Pant, a paralegal employed by Gestion Miltom S.E.N.C., a service provider for the firm representing the Applicant, dated July 3, 2017. Ms. Landrigan-Pant attached to her affidavit as exhibits WLP-1 to WLP-4 copies or printouts of pages from some dictionaries, including the *Nouveau Petit Robert*, the *Webster's Ninth New Collegiate Dictionary* (United States: 1987), the *Paperback Oxford Canadian Dictionary* (Second Edition) and the *Larousse* (online), containing definitions of the words "bio," "max" and "mix."
- Certified copies of various trademark registrations and applications generally associated with goods such as fertilizers, soil amendments, herbicides or pesticides and lawn seeds.

[10] Each of the parties filed written arguments and participated in the hearing that was held.

THE BURDEN INCUMBENT ON THE PARTIES

[11] It is initially up to the Opponent to establish that each of its grounds of opposition is well-founded: the Opponent must ensure that the ground is properly pleaded and establish the facts on which it is based. Once the Opponent has met this initial burden of proof for a ground of opposition, it is up to the Applicant to establish, on a balance of probabilities, that the ground of

opposition does not prevent the registration of its trademark. The fact that the ultimate burden rests on the Applicant means that, if a determinate conclusion cannot be reached after all the evidence is presented, the issue must be decided against the Applicant [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD), decision affirmed (1992), 42 CPR (3d) 495 (FCA)]; and *Dion Neckwear Ltd. v Christian Dior, SA et al* (2002), 2002 FCA 29 (CanLII), 20 CPR (4th) 155 (FCA)].

GROUND OF OPPOSITION BASED ON NON-REGISTRABILITY OF THE MARK UNDER SECTION 12(1)(D)

[12] The Opponent alleges that the Mark is not registrable under section 12(1)(d) of the Act because the Mark creates confusion with the BIOMAX Mark registered under No. TMA407,386 (the BIOMAX Registration).

[13] The relevant date for the analysis of this ground of opposition is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)]. An opponent has met its initial burden if the alleged registration remains in effect on that date and the Registrar has discretion to consult the Register to check it [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Having exercised my discretion, I confirm that the BIOMAX Registration is still in effect.

[14] The Applicant must now establish, on a balance of probabilities, that the Mark is not likely to cause confusion with the BIOMAX Mark.

The test for confusion

[15] The use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods associated with those trademarks are manufactured, sold, leased or hired by the same person, whether or not the goods are of the same general class or appear in the same class of the Nice Classification [section 6(2) of the Act].

[16] Thus, the issue of confusion is not related to the confusion of the marks themselves but confusion as to whether the goods associated with each mark are from the same source. The test

to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the applicant's trademark, 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 [see *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée*, 2006 SCC 23, at para 20]. The determination of the issue must reflect all the circumstances of the case, including the factors set out in sections 6(5)(a) to (e) of the Act, but that list is not exhaustive, and the weight given to each factor will vary based on context [see *Veuve Cliquot*, above; *Mattel Inc. v 3894207 Canada Inc.*, 2006 SCC 22; and *Masterpiece Inc. v Alavida Lifestyles Inc.*, 2011 SCC 27].

Section 6(5)(e): The degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them

[17] The degree of resemblance between trademarks will often have the greatest effect on the confusion analysis [see *Masterpiece*, above]. There is no need for side-by-side scrutiny to identify similarities and differences; each trademark must be considered as a whole and assessed based on its effect on the average consumer in a first impression [*Masterpiece*, above]. Considering a trademark as a whole does not necessarily mean that a dominant component should be ignored that would affect the overall impression on an average consumer. Because of this, the preferred approach is to begin by determining whether there is an aspect of each trademark that is “particularly striking or unique” [*Masterpiece*, above, at para 64].

[18] In this case, the parties' trademarks are both invented words, having a similar construction, consisting of the BIO element followed by the MIX or MAX element, as applicable. In each case, I find that no particular aspect of the trademark is particularly striking or unique.

[19] The first component of a trademark is often considered more important for the purpose of distinction [see *Conde Nast Publications Inc. v Union des éditions modernes* (1979), 46 CPR (2d) 183 (FCTD)]. However, the importance of the first element may diminish when it is a common descriptive or suggestive term [see *Merial LLC v Novartis Animal Health Canada Inc* (2001), 11 CPR (4th) 191 (FCTD)]. However, I accept the Applicant's claims that BIO is an

abbreviation for the French term “*biologique*” (organic in English), and that it is therefore descriptive of the nature of the parties’ goods. I also find that MAX is an abbreviation for “maximum” and that MIX refers to a “mix” (in both English and French, as discussed below). Thus, the second half of each mark is also descriptive, or at least suggestive—as praise in the case of MAX and a general indication of the composition of the good in the case of MIX. The design aspect of the BIOMAX Mark places emphasis on the MAX element (as the M hides the edge of the O in BIO), adorned with hatching, but the effect is subtle. In all, I find that, in both cases, on first impression, no element of the mark is prominent.

[20] Considering each trademark as a whole, I find that they resemble each other to a fair degree in appearance and sound. Apart from the graphic aspect of the BIOMAX Mark, the two invented words differ only by one letter, near the end of the word, that only has a minor effect on the sound of the syllable in question. The stylized design of the BIOMAX Mark is relatively simple and does not significantly diminish the visual resemblance between the marks.

[21] In terms of the ideas they suggest, the marks are both suggestive, both in English and French, of organic goods, i.e., goods based on materials from living things, as opposed to artificial or synthetic materials. Although the English term “organic” is common in this context, I find that the prefix “*bio*” would be viewed in essentially the same way, as it is an abbreviation of “biology” (*biologie*) and also refers to “life” (*vie*) and “living things” (*organismes vivants*) [see the definitions of “*bio*” and “*bio-*” in the *Concise Canadian Oxford Dictionary* (Toronto: Oxford University Press, 2005); and see *Tradall S.A. v Devil’s Martini Inc*, 2011 TMOB 65, concerning the Registrar’s discretion to take judicial notice of dictionary definitions.

[22] I also accept the Applicant’s claims that the BIOMAX Mark can be seen as an abridged form of the French description “*biologique au maximum*” (maximum organic) and the Mark as an abbreviated form of the French description “*mélange biologique*” (organic mix) [written argument, at paras 26 and 30; see also the dictionary excerpts attached to the affidavit by Ms. Landrigan-Pant, defining the terms “BIO” and “MAX” in French and the term “MIX” in English and French]. In this respect, the Applicant submits that MIX means the combination of various pieces of music in French, according to the definition of MIX in the *Larousse* online dictionary, but I also note that the following definition of the French term “*mixte*” in the same

dictionary, although it was not cited by either party: [TRANSLATION] “Made up of elements from a different source or different in nature”. In my view, given that (i) fertilizers and seeds are likely to consist of a mix of different ingredients, and (ii) in French, MIX is pronounced almost identical to the term “mixte”, the immediate impression created by the suffix MIX in this context would rather be simply that of a mixed good—i.e., made up of various elements.

[23] The Opponent submits that there is no evidence of the meaning of the combination of the words BIO and MAX but the fact remains that the meaning of the words used in a trademark has an impact on the ideas that the mark will suggest. That said, I find that the invented word BIOMAX remains somewhat ambiguous in association with goods such as fertilizers or seeds, in that the term could suggest a formulation with a maximum quantity of organic ingredients or an organic formulation with maximum effectiveness, i.e., that makes plants grow the most.

[24] In short, I find that, from the perspective of a unilingual Francophone, a unilingual Anglophone or someone who is bilingual, the idea suggested by the BIOMAX Mark in the context of the Opponent’s goods is that of a good that is “maximum organic” or “organic and maximum acting”, while the idea suggested by the Mark is that of an “organic mix”. In my view, although the meaning of the two expressions is not identical, the central idea suggested is essentially the same in both cases, i.e., that it is an organic formulation. I therefore find that there is also a high degree of resemblance conceptually.

[25] In concluding my analysis of this factor, I note that the Opponent cites several decisions in which trademarks with only one letter difference have been found to represent a likelihood of confusion. However, I agree with the Applicant that such decisions cannot be a determining factor concerning the issue of resemblance. Each case rests on its own facts. For example, the ideas suggested by the marks or the underlying design may be a differentiating factor and a single letter can make a big difference in that respect (see, for example, *Ikea Ltd/Ikea Ltée v Idea Design Ltd*, [1987] FCJ No 104). Moreover, the degree of resemblance is not the only factor that influences the likelihood of confusion.

[26] That said, the fact remains in my view that, in terms of first impression and imperfect recollection, slight differences between the ideas suggested by the marks in question is not enough to offset the strong resemblances between them in appearance and sound. Overall, I find

that the factor of resemblance between the trademarks in presentation, sound and the ideas suggested strongly favours the Opponent.

Section 6(5)(a): The inherent distinctiveness of the trademarks and the extent to which they have become known

[27] The applicant submits that the parties' trademarks have low inherent distinctiveness, as they are composed of common words in the French language, although the BIOMAX Mark has a marginally greater inherent nature, due solely to its [TRANSLATION] "semi-design" aspect [at para 22].

[28] I agree that the trademarks in question, although they are invented terms, are made up of ordinary dictionary words or elements of such words and thus have a low inherent distinctiveness [see the dictionary excerpts attached to the affidavit by Ms. Landrigan-Pant and the definitions from the *Larousse* online dictionary and the *Concise Canadian Oxford Dictionary* cited in the previous section]. With respect to the stylized font, I am of the view that it has no significant impact on the inherent distinctiveness of the BIOMAX Mark. It has been held that graphic features that are intrinsic to the letters and cannot be dissociated from the letters themselves add little to the inherent distinctiveness of a trademark [see *Canadian Jewish Review Ltd v The Registrar of Trade-marks* (1961), 37 CPR 89 (Ex Ct); and *John Labatt Ltd v Canada (Registrar of Trade Marks)* (1984), 79 CPR (2d) 110 (FCTD)].

[29] The distinctiveness of a trademark can be enhanced through its use and promotion in Canada [see *Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD); *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD)]. Only the Opponent submitted evidence in this respect, in the affidavit by Ms. Duchesneau.

Evidence of the use and promotion of the BIOMAX Mark submitted by the Opponent

[30] Ms. Duchesneau explains that the Opponent operates in the field of gardening and horticultural goods in Canada and has been selling a range of such goods since at least as early as March 1990 displaying the BIOMAX Mark [paras 4–5], i.e., the organic soil amendments and fertilizers identified in paragraph 16 of her affidavit, including images of packaging attached to it in exhibits CD-3 to CD-10, as follows:

- In a first packaging style: “PEAT•SEAWEED•MANURE COMPOST” [CD-3] and “PEAT•SHRIMP•MANURE COMPOST” [CD-4]
- In a second packaging style: “PEAT•SEAWEED COMPOST” [CD-6]; “PEAT•SHRIMP COMPOST” [CD-7]; and “3 in 1 GARDEN MIX” (with black earth, sphagnum peat moss and compost – manure free, according to the description on the packaging) [CD-5]
- In a third packaging style: “ULTRA Composted Cattle/Steer Manure” [CD-8]; “ULTRA Composted Manure” (from sheep, according to the image on the packaging) [CD-9]; and “ULTRA Composted Shrimp Mix” [CD-10]

[31] Ms. Duchesneau states that all these goods (BIOMAX Goods) fall into the “compost” category and are for retail gardening and horticulture markets [paras 16–18]. She also confirms that the BIOMAX Mark has been [TRANSLATION] “used” in Canada since at least as early as March 1990 in association with [TRANSLATION] “the goods listed in the registration”—with the logo evolving slightly but retaining the combination of the prefix BIO in full characters and the suffix MAX in hatched characters [paras 10–12].

[32] Ms. Duchesneau also explains that, in 2010, the Opponent granted a company with its head office at the same address, Premier Tech Home and Garden Inc. (the Licensee), a licence to develop, manufacture and distribute goods displaying the BIOMAX Mark, while the Opponent, under the terms of the license, regularly monitors [TRANSLATION] “the characteristics, quality, use, advertising or exposure” of the goods [paras 6–7, 9] Although that assertion could have been more specific, without cross-examination or evidence to the contrary, I accept that the Opponent controls the characteristics and quality of the goods under the license. Thus, it benefits from the presumption in section 50(1) of the Act that the use of a trademark by a licensee is deemed to be use by the owner of the mark.

[33] Ms. Duchesneau states that the Opponent and/or the Licensee sold, and continue to sell, BIOMAX Goods through distributors and resellers, particularly in Eastern Canada, in Canadian Tire, Home Depot, Home Hardware, Loblaws, Lowe’s, Rona and Walmart stores [para 19]. Ms. Duchesneau adds that the BIOMAX Mark is prominently displayed on promotional and advertising material distributed by the Opponent across Canada [para 22] and that the Licensee also presents goods with the BIOMAX Mark to Canadians on its website and on a microsite created for the goods in 2015, both sites being accessible to all Canadians [paras 23–24]. In support of her assertions, Ms. Duchesneau attached the following exhibits to her affidavit:

- Reproductions of the packaging of each of the BIOMAX Goods, showing that they all display the BIOMAX Mark [exhibits CD-3 to CD-10].
- An advertisement from 1999 showing organic composts and garden mix displaying the BIOMAX Mark, i.e., “PEAT•SEAWEED•MANURE COMPOST”, “PEAT•SHRIMP•MANURE COMPOST”, “PEAT•MANURE COMPOST”, and “3 IN 1 GARDEN MIX” [Exhibit CD-13]. I also note that the packages are of the “first” style shown in exhibits CD-3 and CD-4 and that the “3 in 1 GARDEN MIX” is similar to the 3 in 1 garden mix (the English name displayed on the packaging of both goods is the same: “GARDEN MIX 3 IN 1”).
- Two pages showing [TRANSLATION] “more recent” advertising material showing “outdoor growing media” displaying the BIOMAX Mark, i.e., Ultra Composted Cattle/Steer Manure, Ultra Composted Manure, Ultra Composted Shrimp Mix and 3 in 1 garden mix [Exhibit CD-14]. The packaging of these four goods evolved slightly from one advertisement to the other and I note that one of the advertisements refers to the two ultra manures as “*New*” goods and the composted shrimp mix as a “*New formula*” that includes black peat.
- Five promotional documents printed from the Licensee’s microsite and distributed by the Licensee in the ordinary course of its business, again illustrating the ultra composted cattle/steer manure and the ultra composted shrimp mix, all referred to as “*new*” and displaying the BIOMAX Mark on their packaging [Exhibit CD-15]. I note that two of the documents seem to represent the French and English sides of a coupon that can be exchanged at Canadian Tire from May 4, 2015, to August 1, 2015.
- A sales report since 2005/06 (presumably the fiscal year) for the BIOMAX Goods shows total sales per year of hundreds of thousands of dollars, exceeding \$1M since 2015/16. The data are broken down in the following five categories of goods:
 - “*BIOMAX CATTLE/STEER MANURE*” (sold beginning in 2014/15)
 - “*BMX MANURE COMPOST*”—in translating “MANURE” in the original French decision, I opted for the plural form, based on the packaging for the first style (sales stopped in 2005/06 and resumed in 2014/15)
 - “*BMX PEAT SHRIMP COMPOST*”

- “*BMX PEAT SEAWEED COMPOST*” (sales ended in 2014/15), and
- “*BMX 3 IN 1 GARDEN MIX*”
- Copies of three invoices issued by the Opponent (dated 2010 to 2012) and four issued by the Licensee (dated 2013 to 2016), showing sales of “BIOMAX 3 in 1 Garden Mix” (or “BIOMAX 3 en 1 Terreau Jardin”) to businesses in several provinces across Canada—the invoice dated in 2012 also includes a sale of “BIOMAX Peat-Seaweed Compost” [Exhibit CD-12].

[34] The BIOMAX Mark as presented on the packaging and advertisements varies from the registered form. In the advertisement from 1999 and the packaging shown in it—which seems to correspond to those of the peat•seaweed•manure and peat•shrimp•manure composts shown in exhibits CD-3 and CD-4—the BIOMAX Mark is presented without underlining (Old BIOMAX Mark). In the more recent advertisements and on the packaging of the goods shown in exhibits CD-5 to CD-10, only MAX is underlined, using an arc (which conceals the bottom of the letters), now in the background (the start of the M is hidden by the O) and in sans serif font (Evolved BIOMAX Mark). In both cases, I find that it is the nonetheless use of the BIOMAX Mark, as its prominent characteristics are retained so it remains recognizable as such and does not lose any of its identity [according to the principles set out in *Canada (Registrar of Trademarks) v Cie Internationale pour l’informatique CII Honeywell Bull, SA* (1985) 4 CPR (3d) 532 (FCA); and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

[35] I also find no consequences in the fact that the BIOMAX Mark is often presented over the logo PREMIER, as the BIOMAX Mark stands out and nothing prevents the use of two or more trademarks simultaneously [see *Allen Ltd. v. Warner-Lambert Canada Inc.* (1985), 6 CPR (3d) 270 (FCTD)]. I do not agree with the Applicant’s arguments that that secondary mark as presented would necessarily be suggestive of the nature of the goods.

Relevance of the evidence of the use and promotion of the BIOMAX Mark in light of the description of the Opponent’s goods

[36] The Applicant submits that the Opponent’s evidence does not support a conclusion that the BIOMAX Mark has become known in Canada to an extent that offsets its low inherent

distinctiveness. In particular, the Applicant submits that only the evidence concerning the composts containing manure *and* peat is relevant, while the sales report and copies of invoices produced by Ms. Duchesneau do not differentiate composts containing those two ingredients together from other the BIOMAX Goods. The Applicant also cites the decision in *Dollarama LP v JE Mondou Ltée*, 2015 TMOB 63, in which the opponent’s trademark was deemed to be relatively weak despite millions of sales per year (not broken down by category of goods) reinforcing its distinctiveness.

[37] The opponent, on the other hand, submits that its undisputed evidence establishing sales of peat and manure compost since 1990 cannot be ignored. According to the Opponent, the expression [TRANSLATION] “manure and peat compost” in the BIOMAX Registration and in its statement of opposition not only includes compost containing both ingredients but also compost containing either one, making the evidence as a whole relevant. The Opponent claims that *Dollarama* is not comparable, for example, because it was a retailer’s mark, making overlap in the channels of trade unlikely.

[38] First, I would note that I do not find the *Dollarama* decision cited by the Applicant to be particularly relevant, especially since the verbal aspect of the opponent’s mark in that case consisted of an everyday term—i.e., “*PetStore*”. Although it was a design mark, the design was unexceptional and highly suggestive of the opponent’s goods, i.e., various goods and accessories for animals. In this case, however, the BIOMAX Mark consists of an invented word that combines two separate ideas: that of an organic formulation and that of an upper limit. As such, the BIOMAX Mark, although suggestive, is not “essentially devoid of intrinsic distinctiveness”, as the PETSTORE & Design mark was deemed to be in the decision cited [see *Dollarama*, at para 22].

[39] I find the Applicant’s arguments concerning the nature of the goods sold in this case to be more relevant. In that respect, I agree with the Applicant that it is not clear whether the sales figures provided by Ms. Duchesneau include compost containing manure and peat together. If such a good is in fact included in the sales report, either in one of the categories of peat composts or the category of manure composts, Ms. Duchesneau did not specify it. I therefore cannot

conclude that the BIOMAX Mark was used in recent years in association with the goods specified in its registration.

[40] With respect to the peat compost categories, only the advertisement from 1999 promoted peat composts containing manure, and the packing for those goods—two of which are also shown in exhibits CD-3 and CD-4—all display the Old BIOMAX Mark. I therefore find that the possibility cannot be excluded that BIOMAX peat composts have no longer contained manure since at least the adoption of the Evolved BIOMAX Mark. However, the date on which the Evolved BIOMAX Mark was adopted is not specified.

[41] With respect to the category of manure compost, it is not clear whether it corresponds (i) to the peat•manure compost that is only listed in the advertisement from 1999, (ii) to the ultra composted manure (*a priori* sheep) that is listed in the “recent” advertisements, or (iii) the peat•manure compost up to 2005/06 and the ultra composted manure starting in 2014/15. Given that the peat•manure compost is only shown displaying the Old BIOMAX Mark and is not included in the description of the BIOMAX Goods provided by Ms. Duchesneau in paragraph 16 of her affidavit, I am not prepared to conclude that this good has been sold in more recent years. Even if I were prepared to accept that the peat•seaweed•manure and peat•shrimp•manure composts fall into the same category, I would not be prepared to conclude that they were sold or promoted in more recent years either, as they are only shown displaying the Old BIOMAX Mark.

[42] Moreover, as the “ULTRA Composted Cattle/Steer Manure” and the “ULTRA Composted Manure” (the latter apparently being sheep) appear to be related new goods, the fact that sales of the “composted cattle/steer manure” category began in 2014/15 suggests that the resumption of sales of the “composted manure” category in 2014/15 may refer to the start of sales of the “ULTRA Composted Manure” category. However, although Ms. Duchesneau states that all goods for which packaging is reproduced in her affidavit are included in the “compost” category [paras 16–17], I am not satisfied that the Opponent promoted composted manure as being “manure compost”. Composted manure is described as “manure” in the coupon in Exhibit CD-15 and promoted (without the BIOMAX Mark) under “organic soils and manure” in the 1999 advertisement. The peat•manure, peat•seaweed•manure and peat•shrimp•manure

composts are promoted under “organic composts and garden mix” in that advertisement. If the Opponent did not market its ultra composted manures as “compost”, it is uncertain whether the average consumer would see them in that way.

[43] Moreover, the seven invoices from 2010 to 2016 attached to Exhibit CD-12 of Ms. Duchesneau’s affidavit do not help the Opponent demonstrate sales of “manure and peat compost.” Those invoices only show sales of 3 in 1 garden mix (which the evidence shows does not contain manure) and a single sale of peat shrimp compost (*a priori* the “peat•shrimp compost” good shown in Exhibit CD-7, not the “peat•shrimp•manure compost” shown in Exhibit CD-4). The lack of invoices showing more relevant sales—such as sales of compost with manure or more sales of compost with peat—is not explained.

[44] In closing, I accept the possibility that, in using the expression “manure and peat compost” in its application for registration and in the statement of opposition, the Opponent may have intended to use an omission to refer to two types of compost, i.e., “manure [compost] and peat compost.” However, since a reference to more than one type of compost would be expected to have the word “compost” in the plural—i.e., “manure and peat composts”—I am of the view that the expression used by the Opponent does not refer to manure compost that could be without peat and/or to peat compost that could be without manure. However, the ground of opposition based on the non-registrability of the Mark is limited to [TRANSLATION] “goods described as ‘manure and peat compost’”, or goods that meet the definition of a compost containing both ingredients.

[45] The Registrar must stick to the grounds cited in the statement of opposition. Failure to adequately cite a specific ground, or to amend the statement to do so, precludes consideration of that ground [*Carling Breweries Ltd v Molson Companies Ltd* (1984), 1 CPR (3d) 191 (FCTD)]. Once the evidence is filed, the Registrar must consider it when interpreting the grounds of opposition [according to *Novopharm Ltd v AstraZeneca AB*, 2002 FCA 387]. However, I am not satisfied that this is a case in which an ambiguous ground is clarified by the evidence. On the contrary, the fact that all composts promoted in the advertisement in 1999 contain manure and peat together suggests that, in fact, the application filed in 1990 that led to the BIOMAX Registration was only for compost containing both ingredients together.

[46] As a result, with respect to the factor set out in section 6(5)(a) of the Act concerning the extent to which the Opponent's mark has become known, I agree with the Applicant that the analysis must be limited to an examination of the Opponent's composts that contain both specified ingredients. However, for the reasons explained above, I am not satisfied that the BIOMAX Mark would be known to a significant extent in association with such goods today. In closing, I would add on this latter point that, even if I had included peat composts without manure and manure composts without peat in my analysis of the factors set out in section 6(5), that would not have affected my ultimate conclusion concerning this ground of opposition.

Conclusion on the distinctiveness of the marks

[47] In view of all the above, I find that the analysis of the factor set out in section 6(5)(a) of the Act does not significantly favour either party.

[48] That said, I do not agree with the Applicant that the evidence of use of the BIOMAX Mark in association with goods other than "manure and peat" compost is entirely irrelevant. In my view, such evidence can nonetheless be cited as an additional circumstance in the case [for similar conclusions, see e.g., *Mondo Foods Co Ltd v Saverio Coppola*, 2011 TMOB 228; and *Canadian Broadcasting Corporation/Société Radio-Canada v Big Mountain Coffee House and Roasters Ltd*, 2014 TMOB 240]. I will come back to this circumstance later.

Section 6(5)(b): The length of time the trademarks have been in use

[49] For the reasons set out in the previous section, I am of the view that the analysis of the factor set out in section 6(5)(b) of the Act concerning the length of time the trademarks have been in use must also be limited to a review of the Opponent's composts that contain manure and peat together.

[50] The opponent submits that its evidence demonstrates the use of the BIOMAX Mark since at least as early as 1990, as Ms. Duchesneau states in her affidavit that the BIOMAX Mark [TRANSLATION] "has been used uninterrupted in Canada since at least as early as march 1990 with the goods listed in the registration" and that the Opponent [TRANSLATION] "has sold since at least as early as March 1990, and continues to sell uninterrupted, a wide range of goods

displaying the BIOMAX trademark” [pages 11 and 16, emphasis added]. The Opponent notes that these statements were not challenged.

[51] However, the issue of whether there was “use” as specifically defined in section 4 of the Act is a question of law that must be decided by the Registrar in light of the evidence. It is up to the parties to present evidence showing how they have used their trademarks so the Registrar can determine whether the facts confirm that there has been use within the meaning of section 4.

[52] In this case, Ms. Duchesneau’s simple assertion that the BIOMAX Mark has been “used” since 1990 is not sufficient for me to conclude that there has been use within the meaning of section 4 in association with “manure and peat compost” or otherwise. Unable to analyze the means and context surrounding the alleged use of the BIOMAX Mark in 1990, I am not prepared to conclude that the use referred to by Ms. Duchesneau is in fact “use” within the meaning of section 4 of the Act. In this respect, it must be noted that the advertisement from 1999 cannot be used as proof of use of the BIOMAX Mark on the packaging of the goods shown in it without proof of sales of those goods. Furthermore, Ms. Duchesneau’s assertion that the Opponent has sold since 1990, and continues to sell uninterrupted, [TRANSLATION] “a wide range” of goods displaying the BIOMAX Mark does not support a conclusion of uninterrupted sales since 1990 of “manure and peat compost” in particular.

[53] At best, the sales figures provided by Ms. Duchesneau support a conclusion of use of the BIOMAX Mark in association with composts containing either manure or peat since 2005/06. Moreover, for the reasons cited above, I am not prepared to conclude that there has been the sale of composts containing both these ingredients together after 2005/06.

[54] As I am unable to conclude that the Opponent has established continuous use of the BIOMAX Mark in association with the goods listed in its registration, and given the lack of any evidence of use of the Applicant’s Mark, this factor does not favour either party.

Sections 6(5)(c) and (d): The nature of the goods, business or trade

[55] When considering a ground of opposition based on non-registrability, the parties’ goods, business and trade are analyzed by comparing the statement of goods included in the Applicant’s application to the statement of goods included in the Opponent’s application, with respect to the

channels of trade that would normally be associated with such goods [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr. Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[56] The Applicant submits that the BIOMAX Registration is related to manure and peat compost, while the Application is related to other goods, in addition to compost. I do not find that argument to be persuasive. In this case, with one exception, the goods covered by the Application overlap with those covered by the BIOMAX Mark in that soil, top soil, fertilizers and compost (whether or not peat and/or manure) are all forms of fertilizer or soil containing fertilizer. Moreover, there is complementarity between the remaining good, i.e., lawn seed, and compost in that these goods are both applied to lawns to make them denser. In this respect, I note that the packaging of the BIOMAX peat•seaweed compost shown in Exhibit CD-6 attached to Ms. Duchesneau’s affidavit describes the good as being “Ideal for Lawn Care” and that it “Helps Fortify Plant Stems”, while the packaging of the BIOMAX peat•seaweed•manure compost shown in Exhibit CD-3 also says that it “Helps fortify stems.”

[57] Ms. Duchesneau states that all of the Opponent’s goods are intended for retail gardening and horticulture markets [paras 16–18] and the invoices she provides in Exhibit CD-12 appear *a priori* to be consistent with her statements. The Applicant did not provide evidence of the type of business it operates or its channels of trade. However, in the absence of evidence to the contrary, there is no reason to conclude based on all the goods involved that they would not travel through the same channels of trade and that they would not be intended for the same type of clientele.

[58] I note that Ms. Duchesneau attached to her affidavit as Exhibit CD-2 excerpts from the Applicant’s website, which offers a range of gardening and horticultural goods [para 14]. The Mark is not presented in the excerpt but the goods advertised include various types of fertilizer, composts and soils. However, I do not believe that the information from that website is needed to conclude that the parties’ goods overlap. Similarly, since the goods are sold to the general public for common use, Ms. Duchesneau’s opinion is not required to conclude that the goods are likely to travel in the same markets and be intended for the same type of clientele.

[59] In light of all the above, the factors set out in sections 6(5)(c) and (d) of the Act favour the Opponent.

Additional circumstances

[60] The parties raise several additional circumstances to be considered, as follows:

Scope of protection afforded to trademarks containing descriptive terms

[61] The Applicant submits that, in the case of trademarks that have little or no inherent distinctiveness, small differences are sufficient to avoid a likelihood of confusion. In support of this, the Applicant cites several past decisions in which small differences between marks were found to be sufficient to avoid any likelihood of confusion.

[62] Indeed, it has been consistently held that trademarks comprising descriptive or suggestive words are only entitled to a narrow ambit of protection. A greater degree of discrimination may fairly be expected from the public where a trademark consists wholly or in part of words describing the articles to be sold, such that relatively minor differences may suffice to avert confusion [*General Motors Corp v Bellows*, [1949] SCR 678, citing *Office Cleaning Services Ltd v Westminster Window & General Cleaners, Ltd* (1946), 63 RPC 39 at 41 (HL)].

[63] That said, I note that each case must be decided on its own facts. Only a few of the trademarks in question in the decisions cited by the Applicant consisted of an invented word that, taken as a whole, referred directly to the nature of the goods associated with it, without any fanciful elements.

[64] It must also be reiterated that the degree of resemblance is not the only factor that influences the likelihood of confusion. For example, the likelihood of confusion between trademarks that only differ slightly would usually be lower when the goods associated with each mark are not the same in nature or are not distributed in the same channels. Similarly, a conclusion of no likelihood of confusion can be supported by a lack of evidence of confusion despite the coexistence of the parties' marks in the same market over several years. The inherent distinctiveness of an opponent's trademark can be an important consideration but is not a determining factor in itself.

[65] The Applicant submits in his written argument that an [TRANSLATION] “ordinary consumer somewhat in a hurry” is not entirely without intelligence or recollection and is not entirely unaware or uninformed of what his happening around him or her [at para 19]. However, the fact remains that this mythical consumer has only an imperfect recollection of an opponent’s trademark and does not stop to closely examine the applicant’s trademark and reflect at length on the issue.

[66] In short, I am of the view that the BIOMAX Mark should be afforded more limited protection than would be afforded to a purely fanciful coined word that is in no way descriptive or suggestive in the context of the goods associated with it. This does not mean that any difference will be automatically sufficient to eliminate any likelihood of confusion. In other words, although the Opponent’s trademark is not one that would usually benefit from broad protection, limited protection does not equate to no protection.

State of the register

[67] The Applicant submits that the BIOMAX Mark should only be afforded limited protection because the BIO and MAX elements are elements adapted by several retailers in Canada in the parties’ field of trade. In support of this, the Applicant filed as evidence certified copies of excerpts from the register related to trademarks with the word BIO or MAX as elements, usually related to goods of the same nature as fertilizers, soil amendments, herbicides or pesticides, or lawn seed. That evidence includes the following entries:

- Four registrations and an application that include the element **BIO**: BIO MAL, BIOMER, BIOMARINE, BIOWAY (application) and ALPINE BIOMATE.
- Two registrations (held by the saw owner) and an application that include the element **MAX**: BUDMAX, BORONMAX and BLACKMAX (application).

[68] As reply evidence, the Opponent submits the search results attached to the affidavit by Béatrice Dubois, showing the presence of eight trademarks in the register (owned by five different owners) that include a word beginning with BIOM and ending in X, in class 1 of the Nice Classification (which covers the relevant goods in this case and other chemical goods). The Opponent notes that, of the marks identified, only the parties’ marks are associated with compost, manure or soil. However, I note that there is also a registration of the trademark

BIOMAX in the name of a third party for use in association with resins and synthetic fibres, including “*agricultural mulch cover and mulch made from synthetic fibres*”. In areas unrelated to horticulture, there is another BIOMAX mark, a BIOMAXX mark, the design marks GENEА BIOMEDX and GENEА BIOMEDX GEMS, and three variations of the mark BIOMÉRIEUX.

[69] It is trite law that the common use of a common element in trademarks tends to cause buyers to pay more attention to the other elements or characteristics of the trademark and to distinguish between them by means of those other characteristics. However, unless evidence of the state of the register includes a large number of relevant marks, their use must be established. Where a large number of trademarks is identified, the Registrar can infer that the element they all share is common in the marketplace, such that consumers are able to distinguish the marks by their additional characteristics. However, when the number of trademarks identified is low, evidence of their use must be provided [see *Maximum Nutrition, Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA); *McDowell v Laverana GmbH & Co KG*, 2017 FC 327; and *Canada Bread Company, Limited v Dr Smood APS*, 2019 FC 306].

[70] In this case, the low number of trademarks identified for each allegedly common element does not allow for any inference about the state of the market. I therefore cannot conclude that the word BIO or words resembling MAX or MIX are commonly adopted as elements of trademarks in the field of gardening and horticulture to the extent that Canadian consumers would be accustomed to seeing marks that include such elements in the marketplace.

[71] With respect to the Opponent’s reply evidence, the Applicant submits that the dissection of the BIOM combination and the letter X is improper, particularly as neither BIOM or the ending IX or AX has any meaning. According to the Applicant, it must be remembered that the marks in question consist of a juxtaposition of two elements that each have some meaning, such that no relevant conclusion can be drawn from the lack of trademarks containing combinations of letters that are void of meaning—such as adding M to the prefix BIO and including an X outside of a semantic element such as MIX or MAX.

[72] It is true that the juxtaposition of two semantic elements is a characteristic shared by the two marks in question. However, it is also true that their resemblance goes beyond the fact that they begin with the prefix “BIO” or end with a word like “MAX” or “MIX”. In fact, the two

marks in question also share the formula “BIO_X” and the Opponent has shown that there is only one other mark that follows that model in the register for use in what appears to be the same market.

[73] Ultimately, the degree of resemblance in this case is also attributable to the fact that each of the marks is an invented word that consists of the particular combination of the two syllables noted above and that primarily communicate the idea of an organic formulation. However, none of the trademarks identified by the Applicant consist of a single invented word, made up solely of the word BIO followed by a word that follows the M-vowel-X model and that communicates the main idea noted above. Under the circumstances, even evidence of use of the trademarks identified by the Applicant would not demonstrate that the common elements in the parties’ marks are common on the market.

[74] Accordingly, the state of the register and marketplace is not a significant circumstance in this case.

Registrations of the Applicant’s trademarks that include the MIX element

[75] The Applicant also filed as evidence certified copies of excerpts from the register showing four registered trademarks that include the word MIX as an element, related to goods similar to those covered by the Application: NUMIX, MIRACLE MIX BY/D’ISABELLE & Design, MIRACLE MIX & Design and MIX 3 & Design. The Applicant notes that it is the owner of the last three registrations. According to the Applicant, this explains why the MIX element is included in the Mark.

[76] However, those registrations cannot help the Applicant demonstrate that there is no likelihood of confusion. The Applicant did not file any evidence to support the conclusion that its use of the MIX element has become known in the market. Moreover, it is well established that the Act does not give the owner of a registration the automatic right to obtain another registration, regardless how closely the trademarks covered by them may be related [see *American Cyanamid Co v Stanley Pharmaceuticals Ltd* (1996), 74 CPR (3d) 571 (TMOB); *Ralston Purina Canada Inc v HJ Heinz Co of Canada* (2000), 6 CPR (4th) 394 (TMOB); *Groupe*

Lavo Inc v Procter & Gamble Inc (1990), 32 CPR (3d) 533 (TMOB)]. Accordingly, the past registrations in the Applicant’s name are not a relevant circumstance in this case.

Scope of protection afforded to design marks

[77] The Applicant also submits that the protection afforded to a design mark—such as the BIOMAX Mark—is not the same as is afforded to a word mark. At the hearing, the Applicant cited *Dollarama*, above, as an example of a decision in which this consideration was retained.

[78] It is true that, in the case cited, it was noted and deemed important that the opponent’s registered mark consisted not of a word mark, “PETSTORE”, but of a mixed mark made up of that expression combined with a design of an animal footprint. However, that only led to consideration, as an additional circumstance, of the argument that the expression cannot be monopolized, as it is clearly descriptive and used by other retailers. I am therefore not satisfied that this is a separate principle from the principle that use of a descriptive or common term in a trademark leads buyers to pay more attention to other characteristics of the mark to distinguish it from other marks on the market—including any graphic aspects.

[79] I am therefore not satisfied that this is a significant circumstance in this case.

Use of the Opponent’s mark in association with goods other than “manure and peat compost” as such

[80] As noted above, although the statement of opposition and the BIOMAX Registration only cite the use of the BIOMAX Mark in association with composts containing peat and manure together, evidence of its use in association with related goods—e.g., peat composts that do not necessarily contain manure, or manure composts that do not necessarily contain peat—may be relevant as an additional circumstance in this case.

[81] In that respect, as described above, the sales report attached as Exhibit CD-11 to Ms. Duchesneau’s affidavit shows sales of peat•seaweed compost from 2005/06 to 2014/15 and peat•shrimp compost from 2005/06 to 2016/17. I am prepared to accept that the BIOMAX Mark was displayed on the packaging of goods in these two categories at least until 2014/15 in the manner shown on the packaging of the peat•seaweed and peat•shrimp composts shown in

exhibits CD-6 and CD-7. With respect to the use of the BIOMAX Mark starting in 2014/15, I am prepared to accept that it was shown in the manner noted above or in the manner shown on the packaging of the ultra shrimp compost mix shown in Exhibit CD-10. In this respect, I note that the sales of the other two goods packaged in the latter style—the ultra cattle/steer manure and the ultra composted manure shown in exhibits CD-8 and CD-9, respectively—also seem to have begun in 2014/15 (if we assume the resumption of the manure compost category for this ultra composted manure). In addition, the advertisements in Exhibit CD-14 indicate that the ultra shrimp compost mix is formulated with black peat humus to retain water. Finally, I accept the presentation of the BIOMAX Mark in association with 3 in 1 garden mixes—in which peat and compost are two of the three elements—in the manners shown in the images of its packaging in exhibits CD-5, CD-13 and CD-14.

[82] In light of the above, I find that the Opponent has demonstrated use of the BIOMAX Mark since at least as early as 2005 in association with (i) peat compost and (ii) garden soil that contains compost and peat. I also find that the Opponent has shown use of the BIOMAX Mark since at least as early as 2015 in association with composted manure.

[83] In my view, the BIOMAX Mark as pleaded would benefit from the reputation acquired in association with these three types of goods. The evidence shows that the BIOMAX Mark has become known, at least to some extent, in association with peat compost and, although they may or may not include manure, the mere fact that a “manure and peat compost” contains manure does not mean that it stops being a peat compost. The evidence also shows that the BIOMAX Mark has become known at least to some extent in association with a 3 in 1 mix containing compost and peat (and black earth). Compost is one of the 3 “goods” in this mix and it also includes peat. Finally, the evidence shows that, in recent years, the BIOMAX Mark has become known at least to some extent in association with composted manure, a type of good that at least resembles one of the elements in “manure and peat compost.”

[84] In my view, such a reputation acquired by the BIOMAX Mark would reasonably suggest that a “manure and peat” compost displaying that mark is from the same source as the other peat composts and/or composted manure goods displaying that mark, since at least as early as 2005. The reputation of the BIOMAX Mark in association with these related goods would thus offset

to some extent its low inherent distinctiveness. I therefore find that this is a relevant additional circumstance that favours the Opponent.

Conclusion on the likelihood of confusion

[85] As I noted previously, the Applicant bears the legal onus of establishing, on a balance of probabilities, that the Application complies with the requirements of the Act. The presence of a legal onus on the applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, then the issue must be decided against the applicant.

[86] In light of my analysis above, I find that at best for the Applicant, the balance of probabilities is equal between (i) the absence of a likelihood of confusion, given the inherent distinctiveness of the BIOMAX Mark, and (ii) the likelihood of confusion, given the high resemblance between the parties' marks, the identity or the possibility of overlap between the goods covered by the Application and those identified in the BIOMAX Registration, the likelihood of overlap of the parties' commercial networks, and the evidence of use of the BIOMAX Mark for about 10 years as opposed to the absence of any evidence of use of the Mark. I therefore find that the Applicant has not met its legal onus of establishing, on a balance of probabilities, that there is no risk of confusion between the Mark and the Opponent's BIOMAX Mark.

[87] If it had been shown that the Mark had in fact become known in Canada as a result of sales over a significant period in the same markets as the Opponent, my conclusion may have been different.

[88] In light of the above, the ground of opposition based on section 12(1)(d) of the Act is successful.

GROUND OF OPPOSITION BASED ON NON-ENTITLEMENT TO REGISTRATION WITHIN THE MEANING OF SECTION 16(3)(A)

[89] The Opponent also alleges that the Applicant is not the person entitled to registration of the Mark under the provisions of section 16(3)(a) of the Act because, on the filing date of the application for the registration, the Mark was confusing with the BIOMAX Mark, which had

been used previously and continued to be used in Canada [TRANSLATION] “since at least as early as March 1990 in association with goods described as: ‘manure and peat compost’”.

[90] To meet the initial evidential burden concerning the ground based on non-entitlement to registration, the Opponent must show that it had previously used the BIOMAX Mark in Canada at the filing date of the Application [under section 16(3)(a)] and that it had not abandoned the BIOMAX Mark at the date of advertisement of the Application, on April 3, 2016 [under section 16(5)].

[91] For the reasons set out above, the use of the BIOMAX Mark can only be cited in relation to the goods expressly listed in the statement of opposition. Moreover, the fact that all the composts promoted in the advertisement from 1999 contain manure and peat together suggests that, in fact, the goods in association with which the BIOMAX Mark was used as early as March 1990, as pleaded, are those that contain both ingredients together.

[92] However, I find that the evidence on record does not allow me to conclude that the BIOMAX Mark was not abandoned in association with that type of compost on the date of advertisement of the Application.

[93] Although abandonment requires both an absence of use and an intention to abandon use, a mere intention to preserve the mark is insufficient to avoid a finding of abandonment [*Labatt Brewing Co v Formosa Spring Brewery Ltd* (1992), 42 CPR (3d) 481 (FCTD); *Marineland Inc v Marine Wonderland and Animal Park Ltd* (1974), 16 CPR (2d) 97 (FCTD)]. Moreover, in the absence of other evidence, an intention to abandon can be inferred from a lengthy absence of use [*Marineland*, above; *Hortilux Schreder BV v Iwasaki Electric Co Ltd*, 2012 FCA 321, affirming 2011 FC 967 (*Hortilux*)]. While it is clear that a party may oppose such an assumption by showing even minimal use of the mark, the evidence in this case would allow for a conclusion, at best for the Applicant, of use of the BIOMAX Mark in association with “manure and peat compost” before 2006/07, about 10 years before the date of advertisement of the Application.

[94] I therefore find that the Opponent has not met its initial evidential burden with respect to the ground of opposition based on non-entitlement and it is therefore dismissed.

GROUND OF OPPOSITION BASED ON NON-DISTINCTIVENESS WITHIN THE MEANING OF SECTION 2

[95] The Opponent also alleges that the Mark is not distinctive within the meaning of section 2 of the Act because it does not distinguish and is not adapted to distinguish [TRANSLATION] “the Applicant’s goods from those of the Opponent”.

[96] To meet the initial evidentiary burden concerning the ground based on non-distinctiveness, the Opponent’s evidence must show that, on the date of filing of the statement of opposition, the BIOMAX Mark was known in Canada “to some point at least”, with a reputation that that is “substantial, significant or sufficient enough to negate the distinctiveness of the [M]ark”, or was “well known in a specific area of Canada” [*Bojangles’ International, LLC v Bojangles Café Ltd*, 2006 FC 657, at paras 33 and 36].

[97] Contrary to the wording of the two previous grounds of opposition, the ground based on non-distinctiveness is not limited to the BIOMAX Mark in association with the [TRANSLATION] “goods described as: ‘manure and peat compost’”. It should also be noted that, in seeking an interlocutory decision on the sufficiency of this ground, the Applicant did not seek any clarifications concerning the Opponent’s goods (as opposed to the goods of [TRANSLATION] “other owners” who had been mentioned in the original statement of opposition) and the interlocutory decision itself does not contain any limitation in this respect.

[98] The Registrar must therefore assess this ground of opposition in light of the evidence filed [according to *Novopharm*, above]. The evidence in this respect shows that, at the relevant date, the Opponent had sold a few hundred thousand dollars of peat composts per year since at least 2005/06, as well as hundreds of thousands of dollars of 3 in 1 garden mix in most of those years. The evidence also shows that, in 2014/15, the Opponent began selling composted manure and had sold a few hundred thousand dollars before the end of 2015/16. Ms. Duchesneau asserts that the BIOMAX Goods were and continue to be sold in major retail chains such as Canadian Tire, Home Depot, Home Hardware, Loblaws, Lowe’s, Rona and Walmart. I therefore accept that the BIOMAX Mark had become known to consumers. In short, I am satisfied that, at the date of filing of the statement of opposition, on May 30, 2016, the BIOMAX Mark had become known to consumers to some point at least, having sufficient reputation in association with gardening and compost, soil and fertilizer goods to negate the distinctiveness of the Mark.

[99] As the Opponent has met its initial evidentiary burden, the Applicant must now show, on a balance of probabilities, that at the date of filing of the statement of opposition, there was no risk of confusion between the Mark and the Opponent's mark [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[100] In this case, the difference between the relevant date for analyzing the ground based on non-registrability under section 12(1)(d) of the Act and the date for analyzing the ground based on non-distinctiveness under section 2 has no significant impact on the analysis. The Applicant's position is no stronger; on the contrary, the Opponent's position was somewhat strengthened by the fact that maintaining the use and promotion of the BIOMAX Mark in association with goods other than "manure and peat compost" has a direct impact on the analysis of the factors related to the distinctiveness of the trademarks and the period in which they were used, and that expanded range of goods identify in the ground of opposition leads to a broader overlap when considering the nature of the parties' goods.

[101] Accordingly, having previously concluded that there is a likelihood of confusion under the ground of opposition based on section 12(1)(d) of the Act, the ground of opposition based on non-distinctiveness within the meaning of section 2 of the Act succeeds.

DISPOSITION

[102] In view of all of the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.

Oksana Osadchuk
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Certified translation
Gerald Woodard

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

HEARING DATE: 2021-04-12

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