

Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 078

Date of Decision: 2023-05-10

IN THE MATTER OF AN OPPOSITION

Opponent: Biscuits Leclerc Ltée

Applicant: Hormel Foods Corporation

Application: 1,871,759 for HORMEL VITAL CUISINE

INTRODUCTION

[1] Biscuits Leclerc Ltée (the Opponent) opposes registration of the trademark HORMEL VITAL CUISINE (the Mark) which is the subject of application No. 1,871,759 by Hormel Foods Corporation (the Applicant).

[2] The Mark has been applied for registration in association with the goods listed below, together with the associated Nice classes (CI):

CI 5 (1) Nutritionally fortified beverages for general health and well-being; powdered protein supplement drink mix; dietary and nutritional supplements for general health and well-being

CI 30 (2) Cookies fortified with protein

[3] The opposition is based on allegations of confusion between the Mark and the Opponent's trademarks VITAL and VITAL Design in association with food products.

[4] The opposition originally raised with respect to all the applied-for goods is now restricted to "Cookies fortified with protein", as discussed below.

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

THE RECORD

[6] The application was filed on December 7, 2017 on the basis of proposed use of the Mark in Canada. It was advertised in the *Trademarks Journal* of July 10, 2019.

[7] The Opponent opposed the application on December 9, 2019, pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition raised by the Opponent are based on non-registrability under section 12(1)(d) of the Act, non-entitlement under section 16(1)(a) of the Act, and non-distinctiveness under section 2 of the Act.

[8] In support of its grounds of opposition, the Opponent alleges the likelihood of confusion between the Mark and its trademarks VITAL (Nos. TMA605,622 and TMA630,378) and VITAL Design (No. TMA982,184), depicted below, registered in association with various food products, which the Opponent also alleges having previously used in Canada.



[9] Unless otherwise indicated, I will refer collectively to the above trademarks as the "VITAL Marks".

[10] The Applicant filed a counter statement denying all of the allegations contained in the statement of opposition.

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

- a statutory declaration of Pierre Couvrette dated August 4, 2020 (Couvrette Declaration), and
- a statutory declaration of Marylène Gendron dated August 5, 2020 (Gendron Declaration).

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

- an affidavit of Swen Neufeldt dated May 6, 2021 (Neufeldt Affidavit),
- an affidavit of Gavin Phillips dated March 3, 2021, together with Exhibits GP-1 to GP-115 (Phillips Affidavit),
- an affidavit of Gay Owens dated May 6, 2021, together with Exhibits A and B (Owens Affidavit), and
- an affidavit of Louisa Chen dated May 5, 2021, together with Exhibits A to P (Chen Affidavit).

[13] Neither party conducted cross-examinations. Both parties filed written representations and were represented at a hearing.

[14] At the hearing, the Opponent withdrew its opposition with respect to goods (1), namely “Nutritionally fortified beverages for general health and well-being; powdered protein supplement drink mix; dietary and nutritional supplements for general health and well-being”. As a result, the present opposition is restricted to goods (2), namely “Cookies fortified with protein”.

OVERVIEW OF THE PARTIES’ EVIDENCE

[15] The following is a brief overview of the evidence. A more detailed review of the evidence will be presented where relevant in the analysis below.

Opponent’s evidence

Couvrette Declaration

[16] Mr. Couvrette is the Vice-president of Sales – National Marks for the Opponent. In his declaration, Mr. Couvrette describes the activities of the Opponent and its use of

the VITAL Marks in Canada, mainly in association with cookies and bars, since 2002 and 2004, respectively.

Gendron Declaration

[17] Ms. Gendron is an administrative assistant for the Opponent's agent firm. Further to searches she conducted on the United States Patent and Trademark Office trademark database as well as on the website located at www.hormelhealthlabs.com, Ms. Gendron provides in her declaration images purporting to show the manner in which the Applicant displays the Mark on its products.

[18] According to the Opponent's representations, it relies on the Gendron Declaration to show the manner in which the Mark will be used by the Applicant in Canada. There is no evidence in this case to conclude that the Applicant will display the Mark in Canada in the same manner as in the United States, and I refuse to make such an inference. Consequently, I am disregarding the Gendron Declaration and I will therefore not be discussing the Opponent's representations with respect to this evidence.

Applicant's evidence

Neufeldt Affidavit

[19] Mr. Neufeldt is the President of Hormel Foods International Corporation as well as Group Vice President of the Applicant. In his affidavit, Mr. Neufeldt defines both entities collectively as "Hormel Foods" and provides evidence relating to Hormel Foods' use and advertising of the trademark HORMEL in association with a "variety of food and nutritional products" in Canada since 1980.

[20] Although Mr. Neufeldt does not identify the particular food and nutritional products to which he refers, his affidavit highlights the Applicant's trademark HORMEL (No. TMA246,054), registered in 1980, for use in association with meat, meat sausage luncheon meats, canned meats and corned meats.

Phillips Affidavit

[21] Mr. Phillips is a private investigator. In his affidavit, Mr. Phillips provides state of the marketplace evidence, together with related state of the register evidence, regarding VITAL-formative trademarks used in association with food-related products or services in Canada. He also provides French and English dictionary definitions for the word “vital”.

Owens Affidavit

[22] Ms. Owens is a trademark searcher employed by the Applicant’s agent firm. In her affidavit, Ms. Owens provides state of the register evidence regarding VITAL-formative trademarks registered or applied-for in Canada in association with “food-related goods, including foodstuffs, dietary products and vitamins”.

Chen Affidavit

[23] Ms. Chen is a law clerk employed by the Applicant’s agent firm. In her affidavit, Ms. Chen describes various searches for “Hormel” that she conducted on news websites, and she provides printouts of the results. She also provides a certified copy of Canadian registration No. TMA246,054 for the trademark HORMEL, referenced in the Neufeldt Affidavit.

ANALYSIS


[24] The Opponent has the 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 Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA*, 2002 FCA 29].

[25] I will now turn to each of the Opponent’s grounds of opposition.

Non-registrability of the Mark under section 12(1)(d) of the Act

[26] The Opponent pleads that the Mark is not registrable pursuant to section 12(1)(d) of the Act on the basis that it is confusing with its registered VITAL Marks. The material date for assessing this ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[27] I have exercised the Registrar's discretion to confirm that the Opponent's alleged registrations, the particulars of which I summarize below, are extant.

| Registration Number | Trademark | Registration Date | Goods [TRANSLATION] |
|----------------------------|---|--------------------------|---|
| TMA605,622 | VITAL | Mar. 18, 2004 | (1) Food products, namely: crunchy-cereal based bars. (2) Food products, namely: granola- and breakfast-cereal-based bars. |
| TMA630,378 | VITAL | Jan. 19, 2005 | (1) Food products, namely cookies, crackers, pretzels and snacks. |
| TMA982,184 |  | Oct. 4, 2017 | (1) Food products, namely cookies (2) Food products, namely chewy bars (3) Food products, namely cereal bars |

[28] Since the Opponent has satisfied its initial evidential burden for this ground of opposition, the issue becomes whether the Applicant has met its legal onus to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and any of the VITAL Marks.

[29] As registration of the VITAL word mark permits the Opponent to use the mark in any size and with any style lettering, colour or design [*Masterpiece, supra*, at paras 55-57], any evidence of use of the VITAL design mark also serve as evidence of use of the

word mark. Thus, I will focus my analysis on the likelihood of confusion between the Mark and the VITAL word mark (registration Nos. TMA605,622 and TMA630,378). If the Opponent is not successful based on its word mark, then it will not be successful based on its VITAL design mark (registration No. TMA982,184).

[30] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act provides that 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 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. Therefore, section 6(2) of the Act does not deal with confusion between the trademarks themselves, but with the likelihood that the goods or services from one source will be perceived as being from another source.

[31] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks, including in appearance or sound or in the ideas suggested by them.

[32] These criteria are not exhaustive and different weight will be given to each one in a context-specific assessment [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at paragraph 49, where the Supreme Court of Canada states that the section 6(5)(e) factor, the resemblance between the trademarks, will often have the greatest effect on the confusion analysis. I will therefore begin with the analysis of that factor.

[33] Before proceeding, I note here that in respect of many of the factors listed under section 6(5) of the Act, the Applicant argues the “fame of the HORMEL brand” as well

as the widespread use of VITAL-formative marks by third parties. As indicated at the hearing, I consider this evidence to be relevant as part of the assessment of the additional surrounding circumstances of this case and will treat it as such in this decision.

The degree of resemblance between the trademarks in appearance, sound, or in the ideas suggested

[34] When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality. While it is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trademarks, it is nevertheless possible to focus on particular features that may have a determinative influence on the public's perception [*United Artists Corp v Pink Panther Beauty Corp* (1998), 80 CPR (3d) 247 at 263 (FCA)].

[35] While the first portion of a mark will in some cases be the most significant when assessing a likelihood of confusion [*Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 at 188 (FCTD)], resemblance must be assessed with a consideration of whether there is an aspect of the mark that is particularly striking or unique [*Masterpiece* at para 64].

[36] The Applicant argues that there is a very low degree of resemblance between the parties' marks when considered as a whole. In that regard, the Applicant submits that HORMEL is the most striking and unique element of the Mark whereas the word VITAL is the sole striking element of the Opponent's mark.

[37] In addition, the Applicant contends that VITAL in the context of the parties' goods is "apt for food-related products" and therefore is not highly distinctive. More particularly, relying on dictionary definitions provided in the Phillips Affidavit, the Applicant submits that when used for snack foods such the Opponent's cookies and bars, VITAL is likely to be interpreted as a laudatory term meaning "full of life and vigor". When VITAL is used as in the Mark for nutritional supplements and enriched foods, it is likely to be interpreted descriptively as meaning "concerned with or necessary to the maintenance of life".

[38] For its part, the Opponent argues that there is a high degree of resemblance between the parties' marks because the entirety of its VITAL mark is encompassed in the Mark. The Opponent further disputes the Applicant's contention with respect to the distinctiveness attaching to the word VITAL forming its mark. The Opponent submits that VITAL in association with cookies and bars is inherently distinctive as these goods are neither essential to life nor to health.

[39] I consider that HORMEL is the most striking element of the Mark. As a result, I agree with the Applicant that the resemblance between the parties' marks when viewed and sounded is significantly decreased by the presence of HORMEL as the first element of the Mark.

[40] I disagree with the Applicant's contention that VITAL is "apt to describe cookies and bars". For one thing, in my view the word VITAL within the meaning of the definition "full of life and vigor" does not express praise but rather a state of being. Therefore, the Applicant's contention that VITAL is a "laudatory" term is questionable. In any event, I find that "full of life and vigor" has no direct connotation to cookies and to bars.

[41] In my opinion, the ordinary meaning of the word VITAL primarily brings to mind the notion of something which is "absolutely necessary" or "essential to life; I find that neither of those meanings has a direct connection to cookies, whether or not they are fortified with protein, or to bars.

[42] I am not convinced by the Applicant's argument that the word VITAL in the Mark evokes a different idea than in the Opponent's VITAL mark. However, considering the Mark as a whole, I find that VITAL CUISINE would be viewed as a unitary expression; thus, the word VITAL would not be perceived on its own. In other words, although the Mark encompasses the entirety of the Opponent's mark, the term CUISINE in the Mark mitigates the resemblance in the ideas suggested by the marks.

[43] In the end, despite the shared element VITAL, I find that the degree of resemblance between the trademarks in appearance, sound, and in the ideas suggested is fairly low. Thus, the section 6(5)(e) factor favours the Applicant.

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

[44] The overall consideration of this factor involves a combination of inherent and acquired distinctiveness of the trademarks. The acquired distinctiveness of a trademark refers to the extent to which it has become known.

[45] As mentioned above, I am not persuaded by the Applicant's argument that the word VITAL is "apt to describe cookies and bars".

[46] Overall, I find that the trademarks of both parties are inherently distinctive, but that the inherent distinctiveness of the Mark is greater given the presence of the term HORMEL.

[47] As for the extent to which the marks have become known, the subject application is based on proposed use in Canada, and there is no evidence from which to conclude that the Mark has become known in Canada.

[48] I now turn to the evidence introduced by Mr. Couvrette with respect to the use and promotion of the Opponent's VITAL mark in Canada in association with cookies and bars.

[49] Mr. Couvrette asserts that the Opponent has been selling its cookies and bars in Canada in association with the VITAL mark since at least as early as 2002 and 2004, respectively [para 7].

[50] Mr. Couvrette provides within his declaration two images of representative packaging for VITAL-branded cookies and five images of representative packaging for VITAL-branded bars [para 8]. I reproduce below one example of the packaging for cookies and one example of the packaging for bars:



[51] According to the sales figures provided by Mr. Couvrette, between 2010 and 2019, the aggregated gross sales figures for VITAL-branded cookies and bars ranged between \$3.4 million and \$7.6 million per year, totaling over \$50 million over that period [para 10]. On a fair reading of the Couvrette Declaration, I conclude that those figures mainly represent sales in the province of Quebec and, to a lesser extent, in the other Canadian provinces. I note that the sales figures have not been broken down by product. However, considering the Couvrette Declaration as a whole, I find it reasonable to infer that both VITAL-branded cookies and bars have been the subject of significant sales.

[52] With respect to advertising, Mr. Couvrette asserts that the Opponent typically spends between \$500,000 and \$1.5 million each year for the promotion of its cookies and bars, notably through point of sale advertisements, marketing contests and social media advertising [para 9]. Mr. Couvrette does not provide information on the volume of point of sale advertisements, marketing contests and social media advertising. He also does not provide examples of promotional materials. Accordingly, the evidence concerning the promotion of the Opponent's VITAL-branded cookies and bars is not without deficiencies. However, this is not necessarily detrimental to the Opponent's case.

[53] Indeed, in my view the Opponent's evidence allows me to conclude that the Mark has become significantly known at least in the province of Quebec, and to some extent in other provinces, as a result of extensive sales of its associated cookies and bars.

[54] In the end, I am of the opinion that the overall assessment of the inherent distinctiveness of the parties' trademarks and the extent to which they have become known does not weigh significantly in either party's favour since I consider that the extent to which the Opponent's VITAL mark has become known counterbalances the greater inherent distinctiveness of the Mark.

Length of time the trademarks have been in use

[55] As indicated above, the application for registration of the Mark is based on proposed use in Canada. There is no evidence that the Mark has been used in Canada.

[56] The VITAL mark was registered under No. TMA605,622 in association with crunchy-cereal based bars based on use since February 18, 2002; and in association with granola- and breakfast-cereal based bars further to a declaration of use filed on February 18, 2004. Likewise, the VITAL mark was registered under No. TMA630,378 in association with cookies, crackers, pretzels and snacks, based on use in Canada since at least as early as February 16, 2004. As per my review above of the Couvrette Declaration, the evidence supports the continuous use of the VITAL mark since those dates.

[57] Accordingly, the section 6(5)(b) factor favours the Opponent.

The nature of the goods, business and trade

[58] When considering the nature of the goods and the nature of the trade, I must compare the opposed statement of goods in the application with the statement of goods in the registrations relied upon by the Opponent [see *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, 1987 CanLII 8953 (FCA)].

[59] The Applicant argues that its applied-for protein-fortified cookies are not merely cookies directed to ordinary snack food consumers, but rather a health food product directed to health food consumers. According to the Applicant, the applied-for goods fall "within the realm of edible nutritional supplements" and it would be reasonable to expect

ordinary health food consumers, who are more likely to be interested in nutritional content, to exercise an even greater degree of care and attention when purchasing such products.

[60] I am not persuaded by the Applicant's argument. Rather, I agree with the Opponent's submissions that the applied-for goods are cookies, and whether they are healthy versions of cookies or not, to find otherwise would require an overly granular approach to assessing the nature of the goods.

[61] I therefore conclude that the Applicant's applied-for cookies and the Opponent's cookies and bars are highly similar, if not identical.

[62] As for the parties' business and their channels of trade, the evidence before me is that both parties are in the food business. The Opponent's products are primarily sold in grocery stores in Quebec; they are also available in retail stores where food products are sold, such as Walmart, in Quebec and in other Canadian provinces [Couvrette Declaration, para 3]. Similarly, the Applicant's HORMEL-branded food products are sold through retailers that sell food products to consumers, such as grocery stores [Neufeldt Affidavit, para 4].

[63] In view of the above, I find that the parties' business and channels of trade are also highly similar, if not identical.

[64] Accordingly, the section 6(5)(c) and (d) factors favour the Opponent.

Additional surrounding circumstance –The HORMEL brand

[65] As previously mentioned, the Applicant argues that its mark HORMEL – registered and used in Canada since 1980 – is famous and, therefore, that the Mark “clearly signals” to consumers that the applied-for goods originate from the Applicant. In other words, it argues that the presence of the prefix HORMEL in the Mark dispels any likelihood of confusion as to source because consumers would associate food products bearing the Mark with the Applicant.

[66] In support of its position, the Applicant points to the Registrar's decision in *Smart Cloud Inc v International Business Machines Corporation*, 2019 TMOB 78, aff'd 2021 FC 236. In that case, the Registrar concluded that, given the reputation of the prefix IBM, the applied-for trademark IBM SMARTCLOUD would "clearly signal" to consumers that IBM is the source of the goods and services [at para 120]. In coming to that conclusion, the Registrar considered that the IBM trademark was "fairly well-known" in Canada in association with technology, including computer hardware, software, and applications.

[67] It is trite law that each case must be decided based upon its own merit. It remains to be decided whether the Applicant's evidence shows that its trademark HORMEL is "fairly well-known" or otherwise establishes the reputation of that trademark in Canada in association with relevant goods.

[68] I will first address the news coverage of the HORMEL brand, evidenced in the Chen Affidavit. This affidavit attaches results from searches for "Hormel" that Ms. Chen conducted on April 20, 2021 on the National Post, Globe and Mail, and Google News websites. The exhibited results include printouts showing short previews of articles identified in her search [Exhibits A, F and K], as well as the full text of some of the articles [Exhibits B to E, G to J, and L to O].

[69] The articles are dated between 2018 and 2021, and they pertain to the Applicant, its business and philanthropic activities. In fact, based on my review of the exhibits, it would appear that references to "Hormel" mainly designate the Applicant, rather than any particular products (e.g., "Spam-maker Hormel Foods Corp is...", "the proposed class-action lawsuit included Hormel, based in Austin, Minnesota, and eight other companies...", "Minnesota-based Hormel..."). Where products are referenced, they are mainly meat products and, to a smaller extent, nuts.

[70] In terms of sales and advertising evidence, the Applicant relies on the Neufeldt Affidavit, which provides approximate annual sales figures (2010-2020) and yearly advertising expenditures (2016-2020) for "HORMEL branded products" in Canada. The

sales figures ranged between US\$5 million in 2010 and US\$18 million in 2020, and the average annual advertising expenditures was US\$354,000 [paras 5 and 7].

[71] It is noteworthy that the Applicant provided no specific evidence showing products bearing the trademark HORMEL. When I raised this at the hearing, the Applicant was only able to identify one such instance, namely a thumbnail image depicting cans of “Spam” meat product next to a preview of a news article in Seeking Alpha [Chen Affidavit, Exhibit K page 80]. Although that image is blurry, the trademark HORMEL appears to be displayed on the cans.

[72] As indicated by the Supreme Court of Canada, whether one's trademark aura extends beyond the goods with which it is normally associated is a matter not of assertion, but of evidence [*Veuve Clicquot, supra*, at para 26].

[73] The Opponent submits that Mr. Neufeldt's references to “HORMEL branded products” are ambiguous and that there is nothing in the Applicant's evidence to suggest the trademark HORMEL has become known in association with anything other than meat products. I agree.

[74] Indeed, even if I was to accept that the HORMEL brand has some degree of renown in Canada in association with meat products, I am not persuaded that there is sufficient evidence to conclude that any such reputation transcends into the market of cookies. In any event, given my subsequent conclusion on the likelihood of confusion, my finding with respect to this additional surrounding circumstance does not affect the outcome of this case.

Additional surrounding circumstance – state of the register and state of the marketplace

[75] The Applicant relies on the state of the register and the state of the marketplace evidence introduced through the Owens and Phillips affidavits to argue that the Opponent's trademark VITAL can only be accorded a narrow scope of protection because consumers have become accustomed to distinguishing between VITAL-formative marks based on small differences. For its part, the Opponent submits that the

evidence is insufficient to support a conclusion of common adoption of VITAL-formative marks, particularly in association with cookies and bars.

[76] In view of my conclusion on the likelihood of confusion, I find it is not necessary to consider this additional circumstance to find in favour of the Applicant.

Conclusion on the likelihood of confusion

[77] As indicated above, section 6(2) of the Act is not concerned with confusion between the trademarks themselves, but rather confusion as to the source of the goods. Further, as the Supreme Court of Canada explains in *Mattel, supra*, at para 57, the ordinary consumer is owed a certain amount of credit:

... I fully agree with Linden J.A. in *Pink Panther* that in assessing the likelihood of confusion in the marketplace “we owe the average consumer a certain amount of credit” (para. 54). A similar idea was expressed in *Michelin & Cie v. Astro Tire & Rubber Co. of Canada Ltd.* (1982), 69 CPR (2d) 260 (FCTD), at 263:

. . . one must not proceed on the assumption that the prospective customers or members of the public generally are completely devoid of intelligence or of normal powers of recollection or are totally unaware or uninformed as to what goes on around them.

[78] Having considered the surrounding circumstances of this case and applying the test of confusion as a matter of first impression and imperfect recollection, I find that the Applicant has met its legal onus to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent’s trademark VITAL of registration Nos. TMA605,622 and TMA630,378.

[79] Indeed, despite the length of time the Opponent’s VITAL mark has been in use, and the similar nature of the parties’ goods and channels of trade, I find that the overall differences between the parties’ trademarks are sufficient to shift the balance of probabilities regarding confusion in favour of the Applicant.

[80] Accordingly, the section 12(1)(d) ground of opposition is rejected.

Non-entitlement of the Applicant to registration of the Mark under section 16(1)(a) of the Act

[81] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark pursuant to section 16(1)(a) of the Act in view of confusion with the VITAL Marks, previously used in Canada by the Opponent.

[82] In view of the evidence discussed above, I am satisfied that the Opponent has met its initial burden of establishing use of its VITAL word mark in association with cookies and bars prior to the filing date of the application (December 7, 2017), and non-abandonment of this mark at the date of advertisement of the application for the Mark (July 10, 2019).

[83] The difference in the material date for this ground of opposition and the section 12(1)(d) ground of opposition has no significant impact on my analysis of the circumstances of this case.

[84] For similar reasons to those set out above, I find that the Applicant has met its legal onus to show, on a balance of probabilities, that there was no reasonable likelihood of confusion between the Mark and the Opponent's VITAL mark as of December 7, 2017.

[85] Accordingly, the section 16(1)(a) ground of opposition is rejected.

Non-distinctiveness of the Mark under section 2 of the Act

[86] The material date for assessing the ground of opposition alleging that the Mark is not distinctive under section 2 of the Act is the filing date of the statement of opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185].

[87] I am satisfied that the Opponent has met its initial evidential burden to establish that its VITAL word mark had become sufficiently known in Canada as of December 9, 2019, *i.e.* that its reputation was "substantial, significant or sufficient", to negate the distinctiveness of the Mark [*Motel 6 Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657].

[88] Once again, the difference in the material date under this ground of opposition does not materially affect my prior findings that there is no reasonable likelihood of confusion as to the source of the parties' respective goods. I am therefore of the view that the Applicant has met its legal onus to show that the Mark was distinctive at the material date.

[89] Accordingly, the non-distinctiveness ground of opposition is rejected.

DISPOSITION

[90] 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.

Céline Tremblay
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-02-08

APPEARANCES

For the Opponent: Isabelle Jomphe

For the Applicant: Laura Easton

AGENTS OF RECORD

For the Opponent: Lavery, De Billy, LLP

For the Applicant: Smart & Biggar LLP