



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 105

**Date of Decision:** 2023-06-21

## **IN THE MATTER OF OPPOSITIONS**

**Opponent:** Allmax Nutrition Inc.

**Applicant:** The DDrops Company Inc.

**Applications:** 1,905,376 for VITASTIX, and  
1,905,377 for DDROPS VITASTIX

## **INTRODUCTION**

[1] The DDrops Company Inc. (the Applicant) has applied to register the trademarks VITASTIX and DDROPS VITASTIX (collectively, the Marks), for use in association with “vitamins and nutritional supplements for general health and well-being” (the Applied-for Goods).

[2] Allmax Nutrition Inc. (the Opponent) opposes the registration of both Marks. The Opponent’s primary allegation is that both Marks are confusing with the Opponent’s trademark VITASTACK, which is registered and has been used in association with “dietary supplements containing vitamins and minerals for building body mass” (the Registered Goods).

[3] For the following reasons, the applications are refused.

### **THE RECORD**

[4] Both applications were filed on June 20, 2018, and were advertised for opposition purposes on May 15, 2019.

[5] Shortly thereafter, numerous amendments to the *Trademarks Act*, RSC 1985, c T-13 (the Act) came into force. Pursuant to section 70 of the Act as amended, the applications will be dealt with in accordance with the Act as it read immediately before June 17, 2019, with some exceptions (stated in section 70(1)(a) of the Act as amended). Unless stated otherwise, references to sections of the Act will be to the Act as it read immediately before June 17, 2019.

[6] On November 29, 2019 the Opponent filed statements of opposition in respect of both applications, pursuant to section 38 of the Act. Four grounds of opposition are raised in respect of each application. Three of the grounds are based on the assertion that the Marks are confusing with the Opponent's trademark VITASTACK. The fourth ground is based on the assertion that the applications were filed on the basis of proposed use in Canada, when in fact the Applicant was already using the Marks in Canada.

[7] The Applicant served and filed counterstatements on December 30, 2019, denying all the grounds of opposition raised and indicating that that it intends to defend the oppositions.

[8] In support of the oppositions, the Opponent submitted the affidavits of Michael Kichuk, President of the Opponent, and Paul Paik, a trademark assistant with the agents for the Opponent.

[9] Mr. Kichuk's affidavit provides details of the Opponent's use of the trademark VITASTACK (TMA770,362 – particulars of which are included under Exhibit A to his affidavit), including the following:

- images of the Opponent's products sold in association with the trademark VITASTACK (the Opponent's VITASTACK Products) [Exhibit B];
- a list of retailers that sell the Opponent's VITASTACK Products [Exhibit C];
- revenue generated from the sale of the Opponent's VITASTACK Products in Canada in the years 2015-2020 [para 6], and representative sample invoices [Exhibit D]; and
- advertising expenditures made by the Opponent in advertising the Opponent's VITASTACK Products [para 8], along with representative samples of online and print advertisements for the Opponent's VITASTACK Products [Exhibit E] and a list of publications in which these advertisements have appeared [Exhibit F].

[10] Mr. Paik's affidavit includes printouts from the websites of two of the retailers that sell VITASTACK goods [Exhibits A and B].

[11] In support of the applications, the Applicant submitted affidavits from the following people:

- Mary P. Noonan, a trademark searcher employed by the agents for the Applicant;
- Elizabeth Dingman, a reference librarian employed by the agents for the Applicant; and
- Jessica San Agustin, a private investigator.

[12] Ms. Noonan's affidavit provides the results of searches of the Canadian trademarks register for the following:

- all active registrations and applications owned by the Applicant, for trademarks that contain the elements "DDROPS" or "D DROPS" [Exhibit A];
- all active registrations and applications for trademarks containing the element "STACK", for goods in Class 5 of the Nice Classification [Exhibit B]; and

- all active registrations and applications for trademarks containing the element “VITA”, but excluding trademarks where “VITA” is part of an ordinary English word other than “vitamin”, for goods in Class 5 of the Nice Classification [Exhibit C].

[13] Ms. Dingman’s affidavit provides definitions from various dictionaries for the words “vitamin” [Exhibits 1-7], “stack” [Exhibits 8-14] and “stick” [Exhibits 15-21].

[14] Ms. San Agustin’s affidavit provides screen captures of various web pages that she was requested to obtain by the agents for the Applicant [para 3]. Ms. San Agustin obtained screen captures of pages from the following web sites:

- the Opponent’s website [Exhibits 1-9];
- the websites of various retailers that offer the Opponent’s VITASTACK Products [Exhibits 10-34];
- the websites of various magazines in which the Opponent’s VITASTACK Products have been advertised [Exhibits 35-51];
- the search engine *google.ca*, showing the results of searches for the terms “supplement stack”, “supplement stacking”, “bodybuilding stack” and “bodybuilding stacking” [Exhibits 52-55]; and
- websites included in the results of Ms. San Agustin’s Google searches [Exhibits 56-59].

[15] All of the affiants were cross-examined, and responses to undertakings and questions taken under advisement were provided by Mr. Kichuk and Ms. San Agustin. No other affiants provided undertakings or took questions under advisement.

[16] Both parties submitted written representations, and made representations at the hearing of this matter.

## **GROUND OF OPPOSITION, EVIDENTIAL BURDEN AND LEGAL ONUS**

[17] The Opponent relies on the following grounds of opposition in respect of both Marks:

- the Marks are not registrable pursuant to section 12(1)(d) of the Act, because the Marks are confusing with the Opponent's trademark VITASTACK, registered under number TMA770,362 (the Non-registrability Grounds);
- the Applicant is not the person entitled to register the Marks because, as of the filing dates of the applications, the Marks were confusing with the Opponent's trademark VITASTACK, which had been previously used in association with the Registered Goods, and which had not been abandoned as of the date of advertisement of the applications (the Non-entitlement Grounds);
- the Marks are not distinctive within the meaning of section 2 of the Act, because the Marks are confusing with the Opponent's trademark VITASTACK, and do not distinguish, nor are they adapted to distinguish, the Applied-for Goods from the Registered Goods (the Non-distinctiveness Grounds); and
- the applications do not comply with section 30(e) of the Act because, at the time the applications were filed on the basis of proposed use in Canada, the Applicant had already used the Marks in Canada, in association with the Applied-for Goods (the Section 30(e) Grounds);

[18] For each ground of opposition, the Opponent bears an initial burden to adduce evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition are true. If this initial burden is met, then the Applicant bears a legal onus of satisfying the Registrar that, on a balance of probabilities, the ground of opposition should not prevent registration of the Marks [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)].

## **THE NON-REGISTRABILITY GROUNDS**

[19] In support of these grounds of opposition, the Opponent relies on its registered trademark VITASTACK (TMA770,362). Since the registration of VITASTACK is in good standing on the register, the Opponent meets its initial burden for these grounds. Accordingly, the Applicant bears the legal onus of showing, on a balance of probabilities, that the Marks are not confusing with the Opponent's trademark VITASTACK. The material date for assessing confusion under this ground is the date of this decision [*Simmons Ltd v A to Z Comfort Beddings Ltd* (1991), 37 CPR (3d) 413 (FCA)].

### ***The Test for Confusion***

[20] The use of a trademark will cause 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 (as the case may be) by the same person [section 6(2) of the Act as amended]. This test is not about confusion of the trademarks themselves. Rather, it is about confusion as to the source of goods or services. In the present case, the relevant question is whether a consumer who sees the Applied-for Goods in association with the Marks, would think that those goods and the Registered Goods associated with the trademark VITASTACK come from the same person, or are licensed, approved, or sponsored by the same person.

[21] The test for confusion is a matter of first impression in the mind of a casual consumer somewhat in a hurry, who sees the applied-for trademark at a time when they have no more than an imperfect recollection of the opponent's trademark. This casual, hurried consumer does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the trademarks [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[22] Applying the test for confusion is an exercise in finding facts and drawing inferences [*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at para 102]. All

surrounding circumstances of the case must be considered, including those listed at section 6(5) of the Act, namely:

- the inherent distinctiveness of the trademarks and the extent to which they have become known;
- the length of time the trademarks have been in use;
- the nature of the goods, services or business;
- the nature of the trade; and
- the degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them.

[23] This list is not exhaustive; all relevant factors are to be considered, although they are not necessarily attributed equal weight [see *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 54; *Veuve Clicquot, supra* at para 21].

### ***Inherent Distinctiveness and Extent Known***

[24] The inherent distinctiveness of a trademark refers to its originality. Trademarks consisting of or including words that are descriptive of the goods to be sold have a low degree of inherent distinctiveness, and attract a more limited range of protection relative to an invented, unique, or non-descriptive word, or an original design [see *General Motors Corp v Bellows*, 1949 CanLII 47 (SCC), [1949] SCR 678; see also *Fairmount Properties Ltd v Fairmount Management LLP*, 2008 FC 876]. The distinctiveness of a trademark increases when the trademark becomes known to the consuming public, for example, through use or promotion of the trademark in the marketplace [see, e.g., *Mondo Foods Co Ltd v TorreMondo Industries Inc*, 2022 FC 926, at para 24].

### **VITASTACK**

[25] The inherent distinctiveness of the Opponent's trademark VITASTACK is low. While the trademark is a coined term that has no meaning in either English or French, the mark as a whole is obviously comprised of two elements, "VITA" and "STACK". The

parties agree that the element “VITA” suggests vitamins. As for the element “STACK”, the evidence shows several instances in which combinations of different types of supplements are described as a supplement “stack”. For example:

- an article from the website *livestrong.com* discusses the term “stack” in the context of nutritional supplements, and claims that “a bodybuilding stack is a group of supplements used to enhance performance” [San Agustin Affidavit, Exhibit 57, fourth search result];
- an article from the website *myokem.com* describes supplement stacking as “common in practice in the strength and bodybuilding community”, and asserts that it involves “strategically combining nutrients and ergogenic aids” [San Agustin Affidavit, Exhibit 57, first search result];
- an article from *muscleandperformance.com* provides tips on how to build one’s own “supplement stack” by mixing and matching supplements [San Agustin Affidavit, Exhibit 57, fifth search result];
- various online retailers refer to classes of supplement products as “supplement stacks” or simply “stacks” [San Agustin Affidavit, Exhibit 56]; and
- the Opponent’s VITASTACK Product has been described on product packaging as “nutrient stack packs” [Kichuk Affidavit, Exhibit E].

[26] In view of these and other examples in the evidence, coming from a multitude of sources, I am satisfied that the term “stack” is commonly used in the field of nutritional supplements to refer to a collection of different supplements taken together to produce a specific result. Accordingly, the Opponent’s trademark VITASTACK, while unique, is fairly suggestive of a “vitamin stack”, which would be understood as a collection of different vitamins taken together to produce a specific result. The Registered Goods could potentially include products meeting this description, and the evidence demonstrates that the Opponent’s VITASTACK Product does indeed fit this description [see Kichuk Cross-examination, questions 59-60]. I am therefore satisfied that the



Opponent's trademark VITASTACK is fairly suggestive of the Registered Goods, and its inherent distinctiveness is low.

[27] However, I am also satisfied that the trademark VITASTACK has become somewhat known to the consuming public, thereby increasing its distinctiveness to some degree. Mr. Kichuk states that the Opponent has used the trademark VITASTACK in association with the Registered Goods since at least 2010 [Kichuk Affidavit, para 3]. From 2015 until at least 2020, annual sales of the Opponent's VITASTACK Products have been in the several hundreds of thousands of dollars, and \$20,000 has been spent on advertising during the same period [Kichuk Affidavit, paras 6 and 8]. In view of the foregoing, I am satisfied that the Opponent's trademark VITASTACK has become known to some extent in the Canadian marketplace.

#### VITASTIX and DDROPS VITASTIX

[28] The trademark VITASTIX is also a coined term that has no meaning in either English or French. However, I am not prepared to find that it has greater inherent distinctiveness than VITASTACK, as urged by the Applicant.

[29] As stated above, the parties agree that the element "VITA" suggests vitamins. As for the element "STIX", it suggests the English word "sticks". The trademark VITASTIX is therefore fairly suggestive of the phrase "vitamin sticks". A "vitamin stick" could reasonably be understood to mean a long, thin piece of a vitamin supplement, since a "stick" of something is defined as a long, thin piece of it, such as a stick of celery or cinnamon [Dingman Affidavit, Exhibit 15, page 3/20]. Such a "vitamin stick" would fall within the scope of the Applied-for Goods. I am therefore not satisfied that VITASTIX has no suggestive meaning in connection with these goods.

[30] As for the trademark DDROPS VITASTIX, the Applicant argues that the additional element "DDROPS" has no particular meaning or connotation in connection with the Applied-for Goods, and that the element would suggest a connection to the Applicant in view of the Applicant's longstanding use of DDROPS as a brand. However, there is no evidence of the extent to which the Applicant has used DDROPS as a brand, making it impossible to determine the likelihood that consumers would associate the

element “DDROPS” with the Applicant. On the evidence before me, it is just as likely that “DDROPS” would be seen as the phonetic equivalent of the phrase “D drops” which, when considered in the context of vitamin supplements, is suggestive of vitamin D drops. Vitamin D in the form of drops would also fall within the scope of the Applied-for Goods, and so the element “DDROPS” is also potentially suggestive of those goods. That being said, the combination of the element “DDROPS” and the element “VITASTIX” would suggest a vitamin supplement in the form of both drops and sticks, which is contradictory. This contradictory combination appears to be somewhat original, and is therefore somewhat more inherently distinctive than VITASTIX and VITASTACK.

[31] With regard to the extent to which the Marks have become known, I cannot conclude that the Marks have become known in Canada to any extent, since there is no evidence that the Marks have ever been used in the Canadian marketplace. Accordingly, I cannot conclude that the low distinctiveness of the Marks has been increased to any extent.

#### Conclusion regarding inherent distinctiveness and extent known

[32] The evidence shows that the Opponent’s trademark VITASTACK is of low inherent distinctiveness, but has acquired some degree of distinctiveness by becoming known to consumers to some extent. As for the Marks, they are both of relatively low inherent distinctiveness, although the trademark DDROPS VITASTIX is somewhat more inherently distinctive than both VITASTIX and VIASTACK. However, there is no evidence that either Mark has acquired any additional distinctiveness by becoming known to consumers through use.

[33] Therefore, I find that this factor favours the Opponent to a limited degree, since the Opponent’s trademark VITASTACK has become known to some extent.

#### ***Length of Time in Use***

[34] As discussed above, Mr. Kichuk’s evidence establishes that the Opponent has used the trademark VITASTACK since at least 2015 [see Kichuk Affidavits, paras 6 and

8]. As for the Marks, there is no evidence that either of them have ever been used. Therefore, this factor favours the Opponent in respect of both Marks.

### ***Nature of the Goods, Services or Business***

[35] When considering this factor, it is the goods as listed in the applications that must be compared with the statement of goods in the Opponent's registration [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); see also *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 1987 CanLII 8953 (FCA), 19 CPR (3d) 3 (FCA)]. In this case, I must compare the Applied-for Goods ("vitamins and nutritional supplements for general health and well-being") with the Registered Goods ("dietary supplements containing vitamins and minerals for building body mass").

[36] In addition, the Applied-for Goods and the Registered Goods must be read with a view to determining the probable types of business or trade intended by the parties, rather than all possible businesses or trades that may be encompassed by the wording [*Movenpick Holding AG v Exxon Mobil Corporation*, 2013 FCA 6 at paras 6-7]. That being said, the Applied-for Goods and the Registered Goods must not be limited to the products currently sold by the parties. How the parties' trademarks are actually used (if at all) is not irrelevant, but it must not be considered to the exclusion of other uses falling within the scope of the Opponent's registration or the applications, as the case may be [*Masterpiece*, at para 59].

[37] Upon considering the Registered Goods and the Applied-for Goods as they are stated, it is apparent that this factor favours the Opponent. These goods are both supplements containing vitamins and minerals. The only stated difference between the goods is the intended health benefit to be obtained by using them. In terms of the particular compositions of the supplements, the evidence shows that supplements for building body mass, such as the Opponent's VITASTACK Product, are generally more potent and more inclusive than other multivitamins, containing a greater range of vitamins and nutrients [Kichuk Cross-examination, questions 230-232]. It therefore stands to reason that there is some degree of overlap between the Registered Goods

and the Applied-for Goods in terms of their composition, with the Registered Goods generally containing more vitamins and nutrients, at greater concentrations. Overall, I find that the Registered Goods and Applied-for Goods are more similar than they are different.

[38] The Applicant argues that this factor favours it, for several reasons:

- the evidence “demonstrates that the parties’ goods ... would not be offered to the same types of consumers ...” [Applicant’s written representations, para 137];
- the Registered Goods are suitable for, and marketed toward body builders and hard-training athletes [paras 140-146, citing Kichuk Cross-examination, questions 142-144, 150-151, 278-280, and Exhibit 1];
- the Applied-for Goods are “likely to be purchased by a consumer in the market for an “ordinary” vitamin or supplement product, such as a daily multivitamin”, and such consumers are “unlikely to be looking for a product that “builds body mass”” [para 134].

[39] I accept that the Opponent’s VITASTACK Product is suitable for and marketed toward body builders and athletes. However, the Opponent is not limited to marketing its VITASTACK Product in this manner in the future. The Registered Goods as stated on the VITASTACK registration could be marketed toward anyone seeking to build body mass. There is no evidence to suggest that such goods are intended *only* for body builders and athletes.

[40] I also accept that an “ordinary” vitamin or supplement product, such as a daily multivitamin, would fall within the scope of the Applied-for Goods. However, the evidence shows that supplements for “general health and well-being” also include a variety of supplements having a range of intended health benefits. Some of the Applicant’s design trademarks that are registered for use in association with “vitamins and nutritional supplements for general health and well-being” contain language claiming a range of health benefits, including the treatment of colic, support for immune health, support for digestive health, support for bone health, and muscle formation

[Noonan Affidavit, Exhibit A, pages 2, 5, and 19]. Accordingly, I find that the Applied-for Goods encompass several types of supplement products designed to achieve a range of health benefits. Some such benefits may be of interest to those seeking to build body mass. Therefore, consumers in the market for the Registered Goods could potentially be in the market for the Applied-for Goods as well.

[41] Overall, the Registered Goods and the Applied-for Goods as stated are more similar than they are different. In view of the broad nature of the Applied-for Goods, the goods could potentially provide health benefits that are closely related, meaning that the same consumers would be in the market for both goods. Accordingly, this factor favours the Opponent.

### ***Nature of the Trade***

[42] The nature of the trade in which the goods move also favours the Opponent. In view of the substantially similar nature of the goods, I find it reasonable to infer that the goods will likely travel in substantially similar channels of trade.

[43] The evidence of record supports the inference that the goods will travel in similar channels of trade, at least some of the time. Some retailers have been shown to carry both the Opponent's VITASTACK Products and the Applicant's products [Paik Affidavit, Exhibits A and B]. These products of the Applicant, although not sold in association with the Marks, are sold in association with other trademarks of the Applicant that are registered for use in association with "vitamin and nutritional supplements for general health and well-being" [see registration No. TMA1054248, for the trademark Baby Ddrops Packaging Design, Noonan Affidavit, Exhibit A, page 54]. The evidence therefore demonstrates that products in the nature of the Registered Goods (such as the Opponent's VITASTACK Products) and products in the nature of the Applied-for Goods (such as the Applicant's Baby Ddrops supplements "for general health and well-being") are available through the same retailers, in at least some instances.

[44] The Applicant argues that, "as a matter of common sense, vitamins and nutritional supplements for general health and well being are ordinary consumer goods typically sold through grocery stores and pharmacies, rather than specialized

supplement or nutrition stores targeting bodybuilders and athletes” [Applicant’s written representations, para 149]. I agree that it is reasonable to expect the Applied-for Goods to be available in grocery stores and pharmacies. However, I am not prepared to accept that such goods are not also available in other locations where supplements such as the Registered Goods can be found, such as the online supplement retailers in the Paik Affidavit.

[45] Since the channels of trade in which the goods are available appear to overlap at least partially, I find that this factor favours the Opponent.

### ***Degree of Resemblance***

[46] The degree of resemblance between the trademarks often has the greatest effect on the confusion analysis [*Masterpiece* at para 49]. When considering the degree of resemblance, the trademarks must be considered in their entirety as a matter of first impression. They must not be carefully analyzed and dissected into their component parts [*Wool Bureau of Canada Ltd v Registrar of Trade Marks* (1978), 40 CPR (2d) 25 (FCTD)]. That being said, the preferable approach is to consider whether there is an aspect of each trademark that is particularly striking or unique [*Masterpiece* at para 64].

[47] With regard to the trademark VITASTIX, I agree with the Applicant’s assertion [at para 126 of the Applicant’s written representations] that no one part or syllable the trademark VITASTIX stands out from any other, and that accordingly, there is no one aspect of the mark that is striking or unique. I make a similar finding in respect of the Opponent’s trademark VITASTACK. Both trademarks consist of a single coined (albeit suggestive) word, with no obvious emphasis on any letter or syllable thereof.

[48] Considering each trademark as a whole, I find there to be a fair degree of resemblance between the marks in both appearance and sound. Indeed, the only differences between the trademarks, in both appearance and sound, appear in the final few letters and final syllable of the words. Overall, the trademarks are more similar than they are different. While the Applicant refers to *Ferring Inc v Ddrops Company Inc*, 2016 TMOB 36 in arguing that the latter letters of the trademarks are different enough to

distinguish them, I find that the trademarks in the present case are substantially more similar than those at issue in *Ferring* (namely, FERRING and FERIDROPS).

[49] As for the ideas suggested by the trademarks, I find the degree of resemblance to be somewhat lower. As discussed above, VITASTACK is suggestive of a “vitamin stack”, whereas VITASTIX is suggestive of “vitamin sticks”. Both concepts incorporate vitamins, but that appears to be the extent of the relationship, there being no obvious relationship between a “stack” and a “stick” in the context of vitamin supplements.

[50] Overall, I find that the degree of resemblance factor somewhat favours the Opponent in respect of the trademark VITASTIX. This finding is based on the fair degree of similarity between the trademarks in appearance and sound, which I find is sufficient to outweigh the differences between the ideas suggested by the trademarks.

[51] As for DDROPS VITASTIX, again I am of the view that no one part or syllable of this trademark stands out from any other. As discussed above, both words that make up this trademark are coined, although they are made up of components that are suggestive of the goods, such that their suggestive meaning is fairly obvious. There is no one aspect of this trademark that is striking or unique, any more so than any other aspect.

[52] The degree of resemblance between VITASTACK and DDROPS VITASTIX is clearly less than that in respect of VITASTIX, due to the addition of the word “DDROPS”. However, I am not satisfied that the trademarks are different enough such that this factor favours the Applicant. The trademark still contains the word “VITASTIX” in its entirety which, in my view, is fairly similar to VITASTACK in both appearance and sound. The addition of “DDROPS” does not alter or diminish the word “VITASTIX” in any way. Bearing in mind that the test for confusion is whether consumers will infer a common source, and not simply whether consumers will mistake one trademark for another, I am not satisfied that adding “DDROPS” to the already similar “VITASTIX” will prevent consumers from making an inference of common source.

[53] At the hearing of this matter, the Applicant argued that the addition of its “house mark” DDROPS is sufficient to differentiate the trademark DDROPS VITASTIX from the trademark VITASTACK. The Applicant cited *Smart Cloud Inc v International Business Machines Corporation*, 2021 FC 236, and *Outotec (Sweden) AB v NORAM Engineering and Constructors Ltd*, 2018 TMOB 123 in support of this proposition. However, both of these decisions are distinguishable.

[54] In the *Smart Cloud* decision, the owner of the trademark SMARTCLOUD unsuccessfully opposed registration of the trademark IBM SMARTCLOUD. In that case, the trademark applicant relied on evidence of the reputation of its trademark IBM, and the Opposition Board concluded that the reputation of IBM would assist consumers in distinguishing between SMARTCOULD and IBM SMARTCLOUD [*Smart Cloud* at paras 17, 25]. In this case, there is no evidence that the “house mark” DDROPS has become known in Canada to any extent.

[55] In the *Outotec* decision, the owner of the trademark SX unsuccessfully opposed registration of the trademark NORAM SX. In that case, there was evidence that “SX” had been used in a descriptive manner to describe a steel product having a particular designation [*Outotec* at para 48]. It was therefore open to the trademark applicant to apply its “house mark” NORAM to the descriptive term SX, thereby forming a new trademark. In the present case, although the trademark VITASTACK is suggestive the Registered Goods, the trademark is not descriptive *per se*. In addition, there is no evidence of any use of the trademark VITASTACK in a descriptive manner.

[56] Overall, I am not satisfied that the addition of “DDROPS” to “VITASTIX” sufficiently differentiates the trademark DDROPS VITASTIX from the trademark VITASTACK, such that the degree of resemblance factor favours the Applicant. The inclusion of VITASTIX in its entirety, in view of my finding of a fair degree of resemblance between VITASTIX and VITASTACK, gives rise to a fair degree of resemblance in respect of DDROPS VITASTIX. Since the Applicant bears the legal onus, and the Applicant has failed to satisfy me that the degree of resemblance favours it, I find that this factor somewhat favours the Opponent.



### ***State of the Register and Marketplace***

[57] The Applicant argues that there are numerous VITA-formative and STACK-formative trademarks, both on the register and in the Canadian marketplace. In particular, the Applicant asserts the following:

- there are roughly 150 VITA-formative trademarks and six STACK-formative trademarks registered for use in association with various types of vitamins and other nutritional or dietary supplements [Noonan Affidavit, Exhibits B and C]; and
- numerous STACK-formative trademarks have been used in the Canadian marketplace, in association with supplement products that are sold by online retailers that also sell the Opponent's VITASTACK products [San Agustin Affidavit, Exhibits 6-34].

[58] In the Applicant's view, this evidence establishes that consumers have had significant exposure to both VITA-formative trademarks and STACK-formative trademarks used in association with dietary and nutritional supplements, and are therefore able to make relatively fine distinctions between products and trademarks in this field [Applicant's written representations, para 110].

[59] At the hearing of these matters, the Opponent argued that the existence of other VITA-formative and STACK-formative trademarks on the register and in the marketplace is not of assistance to the Applicant, because the trademarks must be considered as a whole, and must not be dissected into component parts. In this regard, the Opponent noted that there are no third party trademarks combining both VITA and STACK, and that none of the third party trademarks in evidence are more similar to VITASTACK than the Marks.

[60] I agree with the Opponent in that the state of the register and the state of the marketplace evidence are not of assistance to the Applicant. None of the third party VITA-formative or STACK-formative trademarks in evidence are, in my view, as similar to the Opponent's trademark VITASTACK as the Marks. Accordingly, this evidence

does not establish that consumers are accustomed to making sufficiently fine distinctions that would enable them to distinguish between VITASTACK and the Marks.

### ***Conclusion regarding Confusion***

[61] Having considered all of the surrounding circumstances, I find the likelihood of confusion is, at best for the Applicant, evenly balanced. I reach this conclusion particularly in view of the fair degree of resemblance between the trademarks VITASTACK and VITASTIX (which is present in both Marks), the fact that the Applied-for Goods and the Registered Goods are more similar than different, and the fact that the relevant channels of trade at least partially overlap.

[62] While the inherent distinctiveness of the Opponent's trademark is low, so too is the inherent distinctiveness of the Marks. Generally speaking, small differences are sufficient to distinguish between trademarks of low distinctiveness, but in my view, the differences between the trademarks at issue are not large enough to make it likely that consumers will be able to distinguish between them.

[63] Since the Applicant bears the burden of demonstrating, on a balance of probabilities, that the Marks are not confusing with the Opponent's trademark VITASTACK, and since I find the likelihood of confusion to be evenly balanced, the Applicant has failed to meet its legal onus in respect of the Non-registrability Grounds. These grounds are therefore successful.

### **THE NON-ENTITLEMENT GROUNDS**

[64] In support of these grounds of opposition, the Opponent relies on its use of the trademark VITASTACK in Canada prior to the filing dates of the applications (namely, June 20, 2018), and the fact that this trademark was not abandoned as of the dates of advertisement of the applications (namely, May 15, 2019). The Opponent has met its initial burden by virtue of its evidence of use of the trademark VITASTACK since at least 2015. Further, there is no evidence to suggest that the Opponent had abandoned its trademark as of the advertisement dates of the applications. The evidence actually suggests that the trademark has not been abandoned as of the advertisement dates,

since the Opponent's sales and advertising in association with the trademark VITASTACK extended into at least 2020.

[65] The Opponent having met its initial burden, the Applicant bears the onus of demonstrating that the Marks were not confusing with the Opponent's prior-used trademark VITASTACK. The material dates for assessing confusion under these grounds of opposition are the filing dates of the applications [section 16(3)(a) of the Act].

[66] In this case, the analysis of the likelihood of confusion under these grounds is substantially similar to that in respect of the Non-registrability Grounds. In my view, the exclusion of evidence post-dating the material dates for the Non-entitlement Grounds does not substantially affect my findings in respect of confusion. Accordingly, the Non-entitlement Grounds of opposition are also successful.

#### **REMAINING GROUNDS OF OPPOSITION**

[67] Since the Opponent has succeeded in respect of both the Non-registrability Grounds and the Non-entitlement Grounds, I do not consider it necessary to address the remaining grounds of opposition.

#### **DISPOSITION**

[68] For the foregoing reasons, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the applications pursuant to section 38(12) of the Act.

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Jaimie Bordman  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

# Appearances and Agents of Record

**HEARING DATE:** 2023-05-15

## **APPEARANCES**

**For the Opponent:** Christopher Dejardin

**For the Applicant:** James Green

## **AGENTS OF RECORD**

**For the Opponent:** Cassan Maclean IP Agency Inc.

**For the Applicant:** Gowling WLG (Canada) LLP