



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 171

**Date of Decision:** 2023-10-05

## **IN THE MATTER OF AN OPPOSITION**

**Opponent:** Société des Produits Nestlé S.A.

**Applicant:** The Nutraceutical Medicine Company Inc.

**Application:** 1848386 for PURICA PET IMMUNE

### **INTRODUCTION**

[1] Société des Produits Nestlé S.A. (the Opponent) opposes registration of the trademark PURICA PET IMMUNE (the Mark), that is the subject of application No. 1,848,386 (the Application), filed by The Nutraceutical Medicine Company Inc. (the Applicant).

[2] The Application for the Mark was filed on July 19, 2017, for use in association with “nutritional supplements for pets, namely, an immune modulator”.

[3] The Application was advertised in the *Trademarks Journal* of February 14, 2018. On July 16, 2018, the Opponent filed a statement of opposition against the Application pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). Numerous amendments to the Act came into force on June 17, 2019. However, as the Application in this case was advertised prior to June 17, 2019, pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read on June 16, 2019.

[4] The Opponent raises grounds of opposition based on non-compliance with sections 30(e) and 30(i), non-entitlement under section 16(3)(a), non-registrability under section 12(1)(d), and non-distinctiveness under section 2 of the Act. With the exception of the section 30(e) ground, the grounds of opposition revolve around an allegation of confusion between the Mark and the Opponent's PURINA and PURINA composite registered trademarks, used in association with pet food, pet treats, pet litter, and pet related goods and services. Particulars of the Opponent's relied upon trademarks, which it refers to as a family of PURINA marks, are included under Schedule A to this decision (the Opponent's Marks).

[5] For the reasons that follow, I refuse the application.

### **THE RECORD**

[6] As previously indicated, the Opponent filed its statement of opposition on July 16, 2018.

[7] The Applicant filed and served its counter statement on September 25, 2018, denying the grounds of opposition.

[8] In support of its opposition, the Opponent filed the statutory declaration of Ms. Susan Molenda, sworn on January 23, 2019, together with Exhibits A to M.

[9] In support of its Application, the Applicant filed the affidavit of Mr. Trevor Watkin, sworn on May 24, 2019, together with Exhibits A through I (Watkin affidavit #1).

[10] On September 18, 2019, the Opponent requested and subsequently was granted leave to file additional evidence in the nature of the affidavit of Ms. Jennifer Allen, sworn September 17, 2019, together with Exhibits A to D.

[11] On January 29, 2020, the Applicant requested and subsequently was granted leave to file additional evidence in the nature of a second affidavit of Mr. Trevor Watkin, sworn on May 28, 2020, together with Exhibits A to E (Watkin affidavit #2). Mr. Watkin was cross-examined on his second affidavit, and the transcript forms part of the record.

[12] Both parties filed written representations, however, only the Opponent elected to attend a hearing in the matter.

## **OVERVIEW OF THE EVIDENCE**

### Opponent's Evidence

#### *Summary of the Molenda Declaration*

[13] Ms. Molenda is the Vice President of Marketing for Nestle Purina PetCare Canada (Purina), a division of Nestle Canada Inc., and a wholly owned subsidiary of Nestle S.A.

[14] Ms. Molenda states that the Opponent, an affiliate of Nestle Canada, is also a wholly owned subsidiary of Nestle S.A. She further states that the Opponent is also the owner, in Canada and around the world, of a significant number of trademarks, most of which are used under license, by Nestle S.A. and Nestle subsidiaries, such as Nestle Canada (including Purina, as a division of Nestle Canada).

[15] Ms. Molenda explains that Nestle S.A. through its subsidiary companies, manufactures, imports, and sells comprehensive product lines in almost every food and beverage and animal care category including baby foods, bottled water, cereals, chocolate and confectionery, coffee, culinary products, chilled and frozen food, dairy products, drinks, food service, healthcare nutrition, ice cream, pet health and pet nutrition.

[16] Ms. Molenda states that Nestle Canada supplies the Canadian market with goods and that through its Purina division, has offered and continues to offer pet food, treats, supplements, and litter to the Canadian pet market.

[17] Ms. Molenda states that Purina has used and continues to use the trademarks owned by the Opponent in Canada pursuant to a formal licensing arrangement in which the Opponent exercises and has consistently exercised control over the character and quality of the goods and services sold and/or performed in association with its trademarks, including all goods marketed by the Opponent's affiliates such as Purina in Canada. She elaborates on how the Opponent monitors compliance with quality standards (para 12 of the declaration).

[18] Ms. Molenda further states that the Opponent owns several trademark applications or registrations for trademarks that include the element PURINA in Canada (the PURINA Marks), which together form a family of marks (the PURINA Family of Marks). She attaches as Exhibit A, what she describes as copies of members of the PURINA Family of Marks. The marks referred to in this exhibit correspond to 12 of the 30 Opponent's Marks identified in the statement of opposition. She then highlights the following marks specifically (all associated with

pet food and related goods): TDMA021,062 (PURINA); TMA180,241 (PURINA); and TMA661,939 (PURINA & Design). She attests that the latter mark, which she refers to as the PURINA CHECKERBOARD Design, has been used as the “house mark” or “house brand” for most pet-related goods marketed and sold by Purina in Canada, since at least as early as 2002 (hereinafter referred to as the PURINA house mark).

[19] Ms. Molenda states that since 2002, while different Purina products are known under different brands (such as ALPO, FRISKIES, TIDY CATS, PRO PLAN, etc), Purina has used the PURINA house mark on most goods and services offered for sale, marketed, and sold in Canada by Purina. She further states that as a dominant element of the PURINA house mark and a number of PURINA composite marks, the PURINA word or term appears on many if not most products sold by Purina in Canada. She states that members of the PURINA Family of Marks are and have been prominently and consistently displayed on the labels and packaging for most Purina products sold in Canada and on or in most promotional and advertising materials for Purina products and services circulated or made available in Canada. In support, she provides examples of representative packaging and labels and photos of Purina products as displayed on the shelves of various distributors of Purina products in Canada (Exhibits B-1 and B-2). The PURINA house mark is clearly visible on labels and packaging for pet food and specialty pet foods (formulations for specific pet nutritional/dietary needs), pet treats, and pet litter. Additional PURINA composite marks (e.g., PURINA Tidy Cats Design, PURINA ONE) are clearly visible on select products as well.

[20] In terms of sales channels, Ms. Molenda states that Purina sells goods bearing the PURINA Family of Marks in Canada (and has for decades) through retail stores (such as PetSmart Inc., Sobey’s Capital Inc., Loblaw Companies Limited, and Wal-Mart Canada Corp.), veterinary clinics, and specialty retail stores. She states that Purina also sells through online distributors and promotes the availability of its products through these retailers (e.g., PetSmart, Amazon, and Loblaws) by providing links to specific distributors on its website since at least May 2016.

[21] Ms. Molenda states that in addition to offering mainstream products, Purina offers and has sold specialty products since well before 2017, which are formulated to address common health issues in pets or to provide pets with enhanced nutrition. She provides descriptions and images of several of these specialty PURINA products at paragraphs 29, 31, 32 and 33 of her declaration, and sample packaging at Exhibits C-1 (PURINA PRO PLAN product), C-2 (PURINA

PRO PLAN VETERINARY DIETS product), and D-1 (PURINA PRO PLAN VETERINARY DIETS FORTIFLORA probiotic supplement for dogs and cats). She states that in addition to Purina's veterinary supplements for pets, some of Purina's other products also incorporate nutritional supplements as integral ingredients.

[22] In terms of sales of Purina products in association with PURINA Marks in Canada, Ms. Molenda provides significant sales figures for the years 2013 to 2018 (paragraph 37). Further to this, she provides as Exhibit E, a sampling of invoices for the sale of Purina products to customers in Canada. She states that products listed in the invoices display the PURINA house mark, and that all invoices include a reference to Nestle Purina PetCare – which is Purina (as a division of Nestle Canada Inc) and a list of Purina products ordered. She states that the invoices are representative of invoices for the sale of Purina products in association with the PURINA house mark and other PURINA-formative trademarks in Canada for at least the last decade.

[23] With respect to advertising of Purina products in association with PURINA Marks in Canada, Ms. Molenda provides numerous examples as follows:

- Exhibit F-1 – retailer branded brochures and flyers representative of those distributed and/or made available to consumers throughout Canada for the last several years;
- Exhibits F-2, F-3, and F-4 – magazine excerpts and artwork for magazine advertisements published between 2004 and 2012;
- Exhibit F-5 – sample print advertisements, catalogue advertisements, online banner advertisements, contest advertisements, flyers, and coupons, all of which feature the PURINA house mark in association with a variety of Purina products and which are similar to those used in Canada for at least the last decade;
- Exhibit G – a sampling of coupons made available to Canadian consumers. She states that all coupons for Purina products in Canada bear the PURINA house mark as well as any relevant PURINA-formative trademark specific to the product associated with the coupon. She estimates that at minimum, at least once a year, one Purina product has been featured in a PetSmart coupon;
- Exhibit H – examples of ads placed by Purina in Pet Valu's trade magazine, dated between 2010 and 2015. She states that distribution figures indicate that 2000 copies of each publication were distributed. Each ad includes the PURINA house mark;
- Exhibit I – an email pertaining to a direct mail contest from Purina that was run in the spring of 2018. She states that other direct mail communications with consumers include monthly newsletters which Purina has emailed to a significant database of pet consumers. All such communications have featured the PURINA house mark;
- Exhibit J – screenshots of various television spots featuring various Purina products between 2013 and 2018;
- Exhibit K – examples of point of purchase displays;

- Exhibits L-1, L-2, and L-3 – social media pages (Facebook, Twitter, and YouTube); and
- Exhibits M-1, M-2, and M-3 – excerpts from *Purina.ca*, archived excerpts, and excerpts from associated websites, with website traffic statistics.

[24] Lastly, Ms. Molenda provides significant promotion and advertising expenditures for Purina products associated with the PURINA house mark (paragraph 43), for the years 2010 to 2017.

### *Summary of Allen Affidavit*

[25] Ms. Allen is a law clerk employed by the Opponent.

[26] Ms. Allen states that on August 16, 2019, she conducted searches of the records maintained by CIPO for active trademarks consisting of or including the element PURI in combination with the letter “A”, including marks that contain one or more characters falling between the term PURI and the letter “A”. She attests that her search was not limited to any particular goods or services. She attaches the results of those searches conducted through CompuMark’s SAEGIS search system under Exhibits A and B, and the results of those same searches conducted through the Canadian Trademarks Database under Exhibits C and D to her affidavit.

### Applicant’s Evidence

#### *Summary of the Watkins Affidavit #1*

[27] Mr. Watkin, the Vice President of the Applicant, explains that the Applicant began as a family run business in 1999. He states that around early 2004, the Applicant coined the term “PURICA”, based on the Applicant’s reputation for producing “pure” and natural health remedies. He states that the Applicant then registered the domain name *www.purica.com* in 2004 (through its affiliated company Biomedica Laboratories Inc. (Biomedica)), and applied for the trademark PURICA, which was subsequently registered in 2007. He states that the PURICA brand is now widely recognized by consumers, customers, and distributors of the Applicant in association with a variety of nutraceutical goods, including nutraceuticals for animals.

[28] Mr. Watkin attaches as Exhibit C to his affidavit, a printout of the Applicant’s current, active trademarks, which he refers to as the Applicant’s “family” of trademarks. There are 33 such trademarks. I note however, that not all of the listed trademarks include the term PURICA.

He also attaches, as Exhibits D and E respectively, printouts of the particulars of two registered trademarks, TMA681,954 (PURICA) and TMA867,382 (PURICA & Design) from the Canadian Trademarks Database. He states that these two trademarks are used prominently on labels for all of the Applicant's nutritional supplements.

[29] Mr. Watkin attests that around August 2016, the name PET IMMUNE/IMMUNE PET was adopted, prefaced with the word PURICA, and that a soft launch of PURICA IMMUNE PET was then conducted around June 2017. He attaches as Exhibit H (incorrectly identified as Exhibit F) to his affidavit, a copy of a press release posted June 5, 2017 to the *purica.com* website which states "PURICA EXPANDS PET PRODUCT LINE BY LAUNCHING IMMUNE PET FOR IMMUNITY SUPPORT FOR SMALL ANIMALS." He states that the Applicant is still testing the marketplace with respect to PURICA PET IMMUNE vs. PURICA IMMUNE PET, and that while there have not been any sales of goods bearing the Mark, there have been significant sales (currently estimated at over \$2 million per year) of nutraceuticals for animals which bear the PURICA and PURICA & Design trademarks. Illustrative of such products, he provides as Exhibit G to his affidavit, printouts from *purica.com* of pages that feature PURICA products available in Canada both online and through the Applicant's distributors.

[30] Mr. Watkins explains that the Applicant founded the Purica Foundation in 2016 as part of the Applicant's commitment to improving the health of others. He attaches as Exhibit F (incorrectly identified in his affidavit as Exhibit H), a press release dated October 2, 2018, which includes the subject title "PURICA FOUNDATION EXPANDS SCOPE TO SUPPORT CARE AND WELL-BEING THROUGHOUT FULL SPECTRUM OF LIFE." The press release discusses the Purica Foundation's support of PURICA as a natural supplements company that is committed to wellness and improving the quality of life of *people* of all ages, and philanthropy and community initiatives in this regard.

[31] Mr. Watkin then describes one of the co-founders of the PURICA brand and the Applicant, Jason Watkin, as being recognized as a top health and fitness influencer by a health and wellness magazine (*optimyz.com*) distributed across Canada. He provides an excerpt from an online posting of the magazine about Jason Watkin and the Applicant, which includes the following passage: "The company's products include supplements to aid in sleep, improve athletic performance and help with stress relief. The flagship product has been used by ballet dancers, arthritis sufferers, athletes, diabetics – and race horses. [...]".

[32] Lastly, Mr. Watkins attaches as Exhibit I to his affidavit, a printout of a press release titled “20<sup>th</sup> Anniversary Media Release”. The press release highlights Jason Watkin’s recognition on the OptiMYz Magazine top-100 influencer list, as well as the Applicant’s 20<sup>th</sup> anniversary in the “natural healthy industry”.

### *Summary of the Watkins Affidavit #2*

[33] In Mr. Watkin’s brief, second affidavit, he refers to the following attached exhibits:

- Exhibit A – what he describes as a current printout of a PURICA pet product supplement label “which is substantially the same as the label which has been in use on pet supplements since at least as early as 2006”;
- Exhibit B – a copy of a 2006 invoice for a purchase of PURICA pet product supplements by Agribrands Purina Canada Inc (the Canadian affiliate for the Opponent), which he attests shows that they knowingly purchased PURICA pet product supplements in the past and over a 14-year period up to 2019;
- Exhibit C – a 2019 invoice showing a purchase by Cargill Animal Nutrition, a division of Cargill Ltd, which he attests he understands was “changed” from Agribrands Purina Canada Inc.;
- Exhibit D – a Google printout for a search which asks the question whether “nestle is related to Cargill?”. Mr. Watkin attests that the first hit was located at *agripurina.ca*, which states “In 2001, Agribrands International agreed to acquisition by Cargill, Inc. which continued the Purina brand... Purina became the pet food brand of Nestle”; and
- Exhibit E – search results of the Canadian Trademark Database (through Saegis search system) for active, registered trademarks which contain the prefix PUR\* in class 5.

### *Cross-Examination of Mr. Watkin*

[34] Mr. Watkin was only cross-examined on his second affidavit.

[35] During the cross examination, Mr. Watkin was primarily asked about his knowledge of the claims made in his affidavit, that “Agribrands Purina Canada Inc. is the Canadian affiliate for the Opponent”, and that Cargill Animal Nutrition was changed from Agribrands Purica Inc. (*i.e.* a successor to). He answered that Agribrands Purina Canada Inc. had been a client of and



distributor for the Applicant and that the aforementioned claims were made based upon personal knowledge acquired through various Internet searches.

## **ANALYSIS**

### ***Section 12(1)(d) Ground of Opposition***

[36] The Opponent pleads that the Mark is not registrable, as it is and was, at all material times, confusing with the Opponent's Marks (per Schedule A to this decision).

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

[38] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition, if one or more of the registrations relied upon are in good standing. Furthermore, the Registrar has the discretion to check the register in order to confirm the existence of any registrations relied upon by an opponent [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 the Registrar's discretion, I confirm that the Opponent's registrations relied upon under this ground of opposition are in good standing as of the date of this decision.

[39] Furthermore, in considering the issue of confusion, I will primarily focus on the Opponent's PURINA house mark (TMA661,939), as I consider this trademark to represent the Opponent's best chance of success, in view of the prevalence of this trademark in the Opponent's evidence. If the Mark is not confusing with this trademark, it will not likely be confusing with any of the remaining trademarks relied upon by the Opponent.

### **The Test for Confusion**

[40] The test for confusion is assessed as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the applicant's mark, at a time when he or she has no more than an imperfect recollection of the opponent's trademark, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée*, 2006 SCC 23 at para 20].

[41] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at 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 the trademarks have 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. This list is not exhaustive; all relevant factors are to be considered and are not necessarily attributed equal weight [see *Mattel, Inc v 3894207 Canada Inc* 2006 SCC 22; *Veuve Clicquot, supra*; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27].

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

[42] The Opponent submits, and I agree, that as the Mark contains the descriptive terms PET and IMMUNE, the more distinctive component of the Mark is the term PURICA.

[43] Both the terms PURICA in the Mark, and PURINA in the Opponent's house mark, are coined terms, with no clear meaning in association with their respective goods and services. Consequently, these terms share a similar level of inherent distinctiveness. The design component in the Opponent's PURINA house mark, while integral to the mark, is not the dominant, most striking portion of the mark; in any event, unlike the descriptive terms in the Applicant's Mark, the checkerboard design adds to the overall inherent distinctiveness of the Opponent's relied upon mark.

[44] The strength of a trademark may be increased by means of it becoming known through promotion or use.

[45] The Applicant submits that it has adduced unrefuted evidence of use of the trademark PURICA on nutraceuticals for humans and animals since at least 2006, with 2 million dollars in sales for animal products alone (per the Watkin affidavit #1). The Applicant submits that while the Mark is based on proposed use, one cannot disregard that the Applicant has been using the PURICA trademark on nutraceuticals for humans and animals since at least 2006 and has become known as a reputable company to promote health for humans and animals.

[46] However, Mr. Watkin attests (in the Watkin affidavit #1) that estimated sales of PURICA branded nutraceuticals for animals are *currently* 2 million dollars per year, and there is no evidence of the extent or breadth of sales historically. Furthermore, there is no evidence of use

of the Mark itself, but rather, the PURICA & Design mark (TMA867,382), (per labels shown in Exhibit G to the Watkin affidavit #1 and in Exhibit A to Watkin affidavit #2). Consequently, while sales of PURICA-branded nutraceuticals for animals (as shown in Exhibit G to the Watkin affidavit #1) are currently 2 million dollars per year in Canada, it is not possible to ascertain the extent of any prior sales of such products to draw any meaningful conclusions as to the degree to which even the term PURICA would have become known to consumers in association with such products.

[47] On the other hand, the Opponent submits that its PURINA marks are famous and therefore should be afforded a broader scope of protection. I would agree that the Opponent has provided evidence of significant use of its PURINA house brand in Canada, in association with pet foods, pet treats, pet litter, and associated pet products. In this regard, the Molenda declaration clearly shows the PURINA house brand on labels and packaging for a multitude of such goods (Exhibits B-1, B-2, C-1, and C-2), significant sales figures for the years 2013 to 2018 (ranging from \$450 to \$550 million per year), representative invoices and advertisements (Exhibits E to M-3), and significant advertising figures for the years 2010 to 2017 (ranging from \$4 to \$11 million per year) for products bearing the PURINA house brand. Furthermore, Ms. Molenda attests that the specimens of labels and packaging (Exhibit B) are representative of the manner in which the PURINA house mark has appeared on such products as sold in Canada since 2002. Consequently, I find that the Opponent's PURINA house brand has become well known in Canada in association with pet foods, pet treats, pet litter, and associated pet products.

[48] Having regard to the aforementioned, I find that this first factor, which is a combination of inherent and acquired distinctiveness, favours the Opponent.

#### Section 6(5)(b) – the length of time in use

[49] While there is evidence that the Applicant has used various iterations of PURICA in association with nutraceuticals for animals since 2006 (per Watkin affidavit #2), there is no evidence that the Applicant has commenced use of the Mark itself.

[50] On the other hand, as discussed in the section 6(5)(a) analysis, the Opponent has shown use of its PURINA house brand for many years. While Ms. Molenda attests that such use has been since at least as early as 2002, supporting sales figures date back to 2013, and

supporting invoices are representative of invoices dating back to approximately 2006. In any event, such use pre-dates that of the Applicant.

[51] Consequently, this factor also favours the Opponent.

Sections 6(5)(c) and (d) – the nature of the goods, services, business, and trade

[52] It is the Applicant's statement of goods and services as defined in the Application versus the Opponent's registered goods and services that governs my determination of this factor [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA)].

[53] The Opponent submits that the parties, in the present case, sell identical goods or closely related goods such that the relationship between the parties' goods is even closer than that in *Société des Produits Nestlé SA v Pet Passion Comércio de Produtos para Animais Ltda*, 2014 COMC 290. In that case, overlap was considered to exist as both parties' trademarks were associated with animal food and hygiene. In the present case, the Opponent submits, the Molenda declaration shows that the Opponent's PURINA goods include specialized and nutritionally enhanced products, and supplements for pets and animals. Further to this, the Opponent submits that the Applicant's applied-for goods similarly covers "nutritional supplements for pets, [...]" and that the Applicant's affiant, Mr. Watkin, has explained that the Applicant is involved with the sale of nutraceuticals for animals.

[54] Additionally, the Opponent submits that the parties' channels of trade are also identical, as both parties' goods are sold online and through distributors. Moreover, the Opponent submits that, absent evidence to the contrary, and as there are no restrictions in the Applicant's application, no distinction between the parties' channels of trade has been established.

[55] The Applicant, on the other hand, submits that it is apparent from the Molenda declaration, that the ultimate consumer purchaser of the Opponent is of "pet food" or "pet treats", not nutritional supplements. The Applicant further submits that while the pet food may

contain supplements to enhance its nutritional value, the consumer is not ultimately purchasing PURINA nutritional supplements.

[56] While the goods are not identical, that is, the Applicant's goods are not "pet food", and the Opponent's goods are not strictly "nutritional supplements", there appears to be a fair degree of overlap. In this regard, both parties' goods include goods that are either pet food (including specialized pet food with added or enhanced nutritional ingredients) or are related to specialized nutrition for animals and are for consumption (nutritional supplements).

[57] With respect to the channels of trade, there is no restriction in the Application for the Mark. Moreover, absent evidence to the contrary, a reasonable inference could be drawn from the evidence that the parties' goods could conceivably travel through the same channels of trade. In this regard, such specialized nutritional and pet health products, could both be sold through the same specialized channels, such as through veterinary offices, as are the Opponent's specialty formulated pet foods (Molenda declaration, para 35).

[58] Having regard to the aforementioned, I consider both of these factors to be in the Opponent's favour.

#### Section 6(5)(e) – the degree of resemblance

[59] It is well established that when considering the degree of resemblance between trademarks, the trademarks must be considered in their totality, and it is not the correct approach to lay them side by side and carefully compare and observe the similarities or differences among their elements.

[60] While it is generally accepted that the first component of a mark is often the most important for the purposes of distinguishing between the marks [*Conde Nast Publications Inc v Union des éditions modernes* (1979), 46 CPR (2d) 183 (FCTD)], the importance of this factor diminishes if the first component is descriptive. Indeed, when any portion of a trademark is a common descriptive or suggestive word, its importance diminishes [see *Merial LLC v Novartis Animal Health Canada Inc* (2001), 11 CPR (4th) 191 (FCTD)]. Furthermore, the Supreme Court of Canada in *Masterpiece, supra*, has advised that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trademark that is particularly striking or unique.

[61] The Opponent submits that the first and more striking portion of the Applicant's Mark is the word PURICA, which, the Opponent submits, is almost identical to its trademark PURINA (which is also the common element in its PURINA Family of Marks). The Opponent further submits that, as both PURICA and PURINA are coined words with no clear meaning in association with their respective goods, and only differ by one letter, the parties' marks bear unquestionable similarities in appearance, sound and ideas suggested. The Opponent submits that as per *Corby Distilleries v Wellington Country Brewery Ltd* (1993), 52 CPR (3d) 429 at 435 (TMOB), *aff'd* (1995), 59 CPR (3d) 356 (FCTD), it is not necessary that every part of a trademark be copied for a finding of confusion; it is sufficient that enough of that trademark is copied to have a tendency to confuse the public. The Opponent further notes cases where confusion was held where the marks at issue only differed by one letter [See *Premier Horticulture Ltée v Les Sols R Isabelle Inc*, 2022 TMOB 36 (BIOMIX vs BIOMAX); and *Teaja Holdings Ltd v Jana Beverages Ltd*, 2017 TMOB 64 (TEANA vs TEAJA)].

[62] The Applicant, on the other hand, submits that it is important to view the trademark as a whole. However, the Applicant submits that since there appears to be an attack on the Applicant's primary trademark "PURICA", it is important to consider the PURICA family of trademarks and use of PURICA since at least 2006. Furthermore, the Applicant submits that the first portion of both parties' marks is "PUR", which is very common on the register in the name of other owners. I will discuss the Applicant's evidence concerning its alleged PURICA family of trademarks as well as the state of the register under separate subsections below.

[63] With respect specifically to the component PURIKA, the Applicant submits that this component is derived from the word PURE and sounds like PURICKA (*i.e.*, sounded with a short vowel, ĭ). By contrast, the Applicant submits that PURINA sounds phonetically like PUREENA (*i.e.*, sounded with a long vowel, ē). Thus, the Applicant submits that the parties' marks do not look or sound the same, and that they have different meanings. The Applicant did not however, make any submissions as to what, if any idea, is suggested by the Opponent's mark.

[64] I agree with the Opponent that the most striking component of the Applicant's Mark is the word PURICA. Furthermore, while the checkerboard design is integral to the Opponent's PURINA house mark, the word PURINA, in my view, is the more dominant and striking component. That being said, I further agree with the Opponent that there is a high degree of similarity between the dominant, most striking portions of the parties' marks in appearance and

when sounded. Only one letter differs in this component, where a casual consumer in a hurry, may not even recall such a minor distinction, let alone pronounce this component of the parties' marks in the manner the Applicant suggests. With respect to ideas suggested however, the striking, most dominant portion of each parties' marks are coined words with no clear meaning in association with their respective goods. However, in considering the parties' marks as a whole, it is clear that the Applicant's Mark is associated with products that are for pets' immune health. Consequently, there is no readily apparent shared idea between the two parties' marks. In any event, the similarities between the most striking, dominant portions of the parties' marks in appearance and when sounded are so significant, that I find this factor strongly favours the Opponent.

### State of the Register

[65] Both parties have presented state of the register evidence.

[66] The Applicant's evidence in this regard includes search results of the Canadian Trademarks Database for "active, registered trademarks which include the prefix PUR\* in class 5" (Watkin affidavit #2, Exhibit E). The Applicant submits that where a term is common on the Trademarks Register, such as the prefix "PUR", which exists in the names of different owners, it is important to consider all surrounding circumstances and the likely response from the consumer [relying on *Lipton, Thomas J v Salada Foods Ltd* (No 3)(1979), 45 CPR (2d) 157 (FCTD) re: state of the register evidence].

[67] Upon review of the search results attached as Exhibit E to the Watkin affidavit #2 however, while the prefix "PUR" is a component of many of the trademarks (or is entirely absent from some of the trademarks), I do not find any of the trademarks to be relevant. In this regard, none of the trademarks of third parties captured in these results so closely resemble the Opponent's PURINA Mark in appearance or when sounded. Indeed, in many cases, the prefix "PUR" is simply a component of common and easily recognizable dictionary words in the English language such as "pure", "purple", "purpose", "purely", "purest", "purchase", and "purse" for example.

[68] The Opponent's state of the register evidence consists of the results of searches for active trademarks consisting of or including the element PURI in combination with the letter "A", including marks that contain one or more characters falling between the term PURI and the letter "A" (Allen affidavit). The Opponent submits that these search results show that the

Opponent and the Applicant are the only two entities with marks consisting of the element “PURI”, followed by one or multiple characters, and ending with a letter “A”, for goods related to pets and supplements.

[69] The Applicant submits that as Jennifer Allen is employed by the agent for the Opponent, and as it is well known that it is inappropriate for an employee of the representative to submit evidence of search results, the entire affidavit of Ms. Allen should be disregarded. However, the Allen affidavit does not contain information that comprises contentious opinion evidence [see *Cross-Canada Auto Body Supply (Windsor) Ltd v Hyundai Auto Canada* (2006), 53 CPR (4th) 286 (FCA)], but rather search results of the Canadian Trademarks Database wherein she clearly sets out the associated search parameters. Consequently, I find this evidence admissible and as with the Applicant’s state of the register evidence, shows that none of the trademarks of third parties captured in these results so closely resemble the Opponent’s PURINA Mark in appearance or when sounded.

#### Family of Trademarks

[70] Where there is a family of trademarks, there may be a greater likelihood that the public would consider a trademark that is similar to be another trademark in the family and consequently, assume that the product or service that is associated with that trademark is manufactured or performed by the same person.

[71] The Applicant alleges it has a “family of trademarks” (Watkin affidavit #1, Exhibit C), and what the Applicant argues is “unrefuted evidence” of use of its PURICA house brand (TMA867,382 – for PURICA & Design) since 2004 (Watkin affidavit #1).

[72] The Opponent submits however, and I agree, that many of the printouts of the Applicant’s alleged family of trademarks are irrelevant, as for example, they do not contain the PURICA element, and/or cover products unrelated to pets. After eliminating such irrelevant trademarks, which also includes those marks that are formalized or opposed and still pending, the remaining marks are not clearly indicated to be for goods and services for, or related to, animals. Indeed, many have descriptions of goods and services that would indicate otherwise.

[73] In any event, there is no presumption of the existence of a family of trademarks within an alleged family, and a party seeking to establish a family of marks must show that it is using more than one or two trademarks within the alleged family [*Techniquip Ltd v Canadian Olympic*



*Assn* (1998), 145 FTR 59 (FCTD), *aff'd* (1999), 3 CPR (4th) 298 (FCA); *Now Communications Inc v CHUM Ltd* (2003), 32 CPR (4th) 168 (TMOB) at para 35].

[74] The Applicant's evidence shows use of one of its trademarks, PURICA & Design (TMA867,382), since 2006 (see analysis under 6(5)(a) and (b)). Even if this also qualifies as use of the word mark PURICA, this would be insufficient to establish a family of marks.

[75] In support of its opposition, the Opponent submits that it has a family of PURINA trademarks. The Opponent's evidence in this regard can be found in the Molenda declaration. Ms. Molenda attaches copies of members of the PURINA Family of Marks under Exhibit A to her declaration, which I have already noted correspond to 12 of the 30 trademarks identified in the Opponent's statement of opposition. She specifically highlights the following marks (all associated with pet food and related goods): TDMA021,062 (PURINA); TMA180,241 (PURINA); and TMA661,939 (PURINA & Design – the Opponent's PURINA house mark). I have already accepted that the Molenda declaration shows extensive use of the PURINA house mark, with representative invoices dating back to 2006. Further to this however, the Molenda declaration also shows use of other members of the Opponent's alleged family of marks, including, PURINA TIDY CATS (TMA889,992), PURINA ONE (TMA651,593), PURINA DOG CHOW & Design (TMA995,596), PURINA PUPPY CHOW & Design (TMA995,598), and PURINA VETERINARY DIETS & Design (TMA702,737). These marks appear on representative packaging and labels (Exhibits B-1, B-2, and C-2), and there is evidence of sales of such products (Exhibit E). As such, I am satisfied that the evidence is sufficient to demonstrate a family of PURINA marks, such that there is an increased likelihood of confusion.

### Coexistence

[76] The Applicant submits that on a balance of probabilities, considering the long-term use and co-existence without any instances of confusion, it is unlikely that the parties' trademarks will be confused with one another. Further to this, the Applicant submits that if the Opponent (or a licensee or a related PURINA entity) was not confused when knowingly purchasing PURICA products of the Applicant, it is highly unlikely the average consumer would be confused. These submissions are in reference to the Watkin affidavit #2; specifically, the Exhibit B invoice to Agribrands Purina Canada Inc. (which Mr. Watkin attests is a Canadian affiliate of the Opponent), and an invoice to a division of Cargill Ltd., which he attests was previously Agribrands Purina Canada Inc. (Exhibit C), as well as a Google printout which he indicates shows that Cargill acquired Agribrands (Exhibit D). Additionally, the Applicant submits that "it is

not without merit that the Trademark Office has never cited the Opponent's trademarks when examining the PURICA trademarks", and "for more than 18 years, the Opponent has not opposed the PURICA trademarks."

[77] The Opponent notes that on cross-examination, Mr. Watkin stated that, at the time that Agribrands Purina Canada Inc. was one of the Applicant's distributors, Agribrands Purina Canada Inc. had nothing to do with Nestlé. Further to this, the Opponent also notes from the Watkin cross-examination, that Mr. Watkin explained that his allegation that Agribrands Purina Canada Inc. is an affiliate of the Opponent is based "on common knowledge from internet search". However, reliability aside, Mr. Watkin's evidence is deficient for additional reasons. The Exhibit B invoice does not show that products bearing the PURICA mark were purchased or that such products were supplements for pets, and in any event, one or two invoices, dated more than 13 years apart, do not present a pattern of co-existence.

[78] With respect to the Applicant's submissions that the Opponent's trademarks have never been cited by the Registrar in the course of prosecution of PURICA trademarks applications, nor have any of the Applicant's PURICA trademarks previously been opposed by the Opponent, this does not give rise to an automatic right to obtain further registrations [*Coronet-Werke Heinrich Schlerf GmbH v Produits Menagers Coronet Inc*, 4 CPR (3d) 108 (TMOB); *Groupe Lavo Inc v Proctor & Gamble Inc*, 32 CPR (3d) 533 (TMOB)]. In any event, I note that of the PURICA trademarks listed in Exhibit C to the Watkin affidavit #1, none of the registered or allowed trademarks that include the word PURICA are associated with goods or services indicated to be for animals/pets.

### Conclusion

[79] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all the surrounding circumstances, I conclude that the Applicant has not satisfied its legal onus to show that there is no likelihood of confusion between the Mark and the Opponent's PURINA house mark. I reach this conclusion due to the high degree of resemblance between the parties' marks, the extensive use and acquired distinctiveness of the Opponent's mark, the overlap in the parties' goods and channels of trade, and having regard to the Opponent's PURINA family of marks.

[80] Consequently, the ground of opposition based on section 12(1)(d) is successful. As such, I need not consider the remaining relied upon trademarks of the Opponent.

### **Section 16(3)(a) Ground of Opposition**

[81] The Opponent pleads that the Applicant is not the person entitled to register the Mark in Canada since as of the filing date of the Application, the Mark was confusing with the Opponent's Marks, previously used in Canada by the Opponent.

[82] With respect to a section 16(3)(a) ground, the Opponent has an initial burden of establishing that one or more of its trademarks alleged in support of this ground of opposition was used or made known prior to the filing of the application, namely, July 19, 2017, and was not abandoned at the date of advertisement of the Application (in this case, February 14, 2018) [section 16(5) of the Act].

[83] As previously discussed in the analysis under the section 12(1)(d) ground of opposition, I am satisfied that the Opponent has evidenced use of its PURINA house mark in Canada in association with pet foods and related products prior to July 19, 2017, and had not abandoned its mark as of February 14, 2018. Furthermore, the assessment of each of the section 6(5) factors as of July 19, 2017, rather than as of today's date does not significantly impact my previous analysis. That is, the difference in material date under this ground of opposition does not affect my ultimate conclusion regarding confusion between the parties' marks. As such, my findings under the ground of opposition based on section 12(1)(d) of the Act are equally applicable.

[84] Accordingly, the ground of opposition under section 16(3)(a) is also successful with respect to the Opponent's PURINA house mark.

### **Section 2 Ground of Opposition**

[85] The Opponent pleads that the Mark is not distinctive of the Applicant's goods and/or is not adapted to distinguish the Applicant's goods from the goods and services of the Opponent.

[86] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its goods from those of others throughout Canada, there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[87] In order to meet its initial burden in support of the non-distinctiveness ground of opposition, the Opponent must show that as of the date of filing of its statement of opposition, namely, July 16, 2018, one or more of the Opponent's Marks was known to some extent at least and its reputation in Canada was substantial, significant or sufficient [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd*, 48 CPR (4th) 427].

[88] In the present case, I am satisfied that the Opponent has met its evidential burden under this ground. As discussed in the section 12(1)(d) ground of opposition, I accept that the Opponent has evidenced extensive use and promotion of its PURINA house mark in Canada since at least 2006. Furthermore, there is also ample evidence of use in Canada of other members of the Opponent's PURINA Family of Marks.

[89] As the difference in the material date has no impact on my analysis of this ground of opposition, my findings under the ground of opposition based on section 12(1)(d) are equally applicable. Thus, I find that the Applicant has not met its burden to show that the Mark is adapted to distinguish or actually distinguishes its goods from those of others, including the Opponent's goods, throughout Canada.

[90] Consequently, the ground of opposition based on section 2 of the Act is also successful.

***Remaining Grounds of Opposition - Sections 30(e) and 30(i) Grounds of Opposition***

[91] As I have already decided in favour of the Opponent under three separate grounds of opposition, I will not address the remaining grounds of opposition.




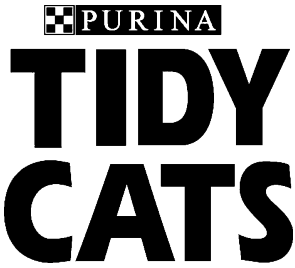
**DISPOSITION**





[92] Having regard to the aforementioned, 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.


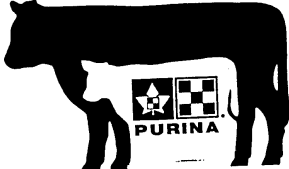
---

Kathryn Barnett  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

**SCHEDULE A**


<u>Trademark</u>	<u>Application or Registration Number</u>	<u>Status</u>	<u>Goods and Services</u>
PURINA PUPPY CHOW & DESIGN 	TMA995,598 Registered: April 30, 2018	Registered	(1) Food for animals namely, pet food.
PURINA DOG CHOW & DESIGN Nyno 	TMA995,596 Registered: April 30, 2018	Registered	(1) Food for animals namely, pet food.
PURINA NATIONAL & DESIGN  <i>The Purina National</i>	TMA891,717 Registered: December 5, 2014	Registered	(1) Sponsorship of dog shows.
9-square checkerboard device PURINA TIDY CATS 	TMA889,992 Registered: November 14, 2014	Registered	(1) Sanitary cat boxes, cat box filler, cat box deodorizer, cat box liners.

<p>THE PURINA NATIONAL &amp; Design</p> 	<p>TMA742,249 Registered: June 18, 2009</p>	<p>Registered</p>	<p>(1) Sponsorship of dog shows.</p>
<p>PURINA VETERINARY DIAGNOSTICS</p>	<p>TMA758,290 Registered: January 28, 2010</p>	<p>Registered</p>	<p>(1) Diagnostic preparations namely reagents for veterinary clinical and diagnostic use.</p>
<p>PURINA PETCARE LEGACY</p>	<p>TMA744,712 Registered: August 5, 2009</p>	<p>Registered</p>	<p>(1) Educational services and entertainment services, namely providing educational exhibits involving pet care, pet health, pet behaviour and other pet related information; hosting parties, shows, festivals and competitions, all related to pets and pet ownership.</p>
<p>PURINA &amp; 9-square checkerboard</p> 	<p>TMA720,636 Registered: August 12, 2008</p>	<p>Registered</p>	<p>(1) Insurance underwriting in the field of health insurance for animals and pets.</p>
<p>PURINA</p>	<p>TMA720,624 Registered: August 12, 2008</p>	<p>Registered</p>	<p>(1) Insurance underwriting in the field of health insurance for animals and pets.</p>
<p>PURINA VETERINARY DIETS &amp; design</p> 	<p>TMA702,737 Registered: December 10, 2007</p>	<p>Registered</p>	<p>(1) Pet food.</p>
<p>PURINACARE</p>	<p>TMA691,382 Registered: July 5, 2007</p>	<p>Registered</p>	<p>(1) Health insurance for pets.</p>
<p>PURINA &amp; Design</p> 	<p>TMA661,939 Registered: March 31, 2006</p>	<p>Registered</p>	<p>(1) Pet food.</p>

PURINA ONE	TMA651,593 Registered: October 26, 2005	Registered	(1) Pet food.
PURINA ADVANCING LIFE	TMA612,910 Registered: June 16, 2004	Registered	(1) Pet food and cat-box filler. (1) Breeder and veterinarian related services.
FORMULES VÉTÉRINAIRES PURINA	TMA613,149 Registered: June 18, 2004	Registered	(1) Pet food.
PURINA VETERINARY DIETS	TMA601,738 Registered: February 10, 2004	Registered	(1) Pet food.
PURINA DRY	TMA521,978 Registered: January 21, 2000	Registered	(1) Ruminant mineral supplement.
PURINA DRY AND DESIGN 	TMA520,954 Registered: January 4, 2000	Registered	(1) Ruminant mineral supplement.
SILHOUETTE OF COW AND CALF DESIGN 	TMA426,435 Registered: April 22, 1994	Registered	(1) Cattle feed and cattle feed supplements.
PURINA	TMA395,616 Registered: March 13, 1992	Registered	(1) Pet food bowls, water dishes and self feeders.
PURINA O-N-E	TMA390,276 Registered: November 15, 1991	Registered	(1) Pet food.
PURINA	TMA377,619	Registered	(1) Toy trucks, clocks, sports bags, tuques, work pants, blue jeans,

	Registered: December 21, 1990		denim jeans, sweaters, shirts, belts, buckles, key rings, gloves, plastic bags, notebooks, desk folders, stuffed animals, calf meter sticks, suspenders, decorative bounties, pennants, lapel pins, crests, plaques, trophies, scarves, pails, catalogs, jackets, shop coats, parkas, vests, shirts, neck ties, caps, tennis visors, boxer shorts, coveralls, sweatshirts, t-shirts, pens, pen and pencil sets, calculators, telephone indexes, flags, cloth material, table cloths, blankets, cups, serviettes, cocktail glasses, aprons, oven mitts, bibs, sample bags, sanitary boots, briefcases, golfballs, playing cards, balloons, matches, canes, umbrellas, knives, tape measures, thermometers, measuring tapes for livestock, pig castrators, milk scales, and dog bowls.
PURINA	TMA330,702 Registered: July 31, 1987	Registered	(1) Pet litter.
PURINA PRO CLUB	TMA321,002 Registered: November 28, 1986	Registered	(1) Pet food.
PURINA BIO-4	TMA224,783	Registered	(1) Animal feed.



	Registered: December 9, 1977		
PURINA	TMA180,241 Registered: December 24, 1971	Registered	<p>(1) Germicides, insecticides, rodenticides, vermifuges.</p> <p>(2) Detergents and cleaners namely all-purpose cleaner, wax stripper, concentrated cleaner for fast cleaning, glass and bowl cleaner, hand cleaner, carpet cleaner, acid cleaner, liquid detergent, caustic cleaner, dairy pipeline cleaner, chlorinated cleaner, powdered cleaner and sanitizer, silver cleaner, dishwasher soap, egg cleaner, general cleaner, liquid caustic cleaning compound.</p> <p>(3) Wound protectors, vitamin mineral feed supplements and veterinary medicines.</p> <p>(4) Electric sprayers.</p> <p>(5) Pet food.</p> <p>(6) Animal bedding.</p> <p>(1) Swine breeding, care, feeding, sales and leasing services and brokerage of live hogs.</p>
PURINA & DESIGN 	TMA140,711 Registered: June 11, 1965	Registered	(1) Animal foods.
PURINA	TMDA52,600 Registered: June 26, 1931	Registered	(1) Worm capsules, dog soap, insect powder, disinfectants and liquid insect destroyer.

PURINA	TMDA21,062 Registered: September 2, 1915	Registered	<p>(1) Feed for livestock, namely stock feed, cattle feed, horse feed, dairy feed, poultry feed, scratch feed, chick feed, pigeon feed, molasses feed, sweet feed and fattening feed.</p> <p>(2) Edible soy protein used as an ingredient in human foods.</p> <p>(3) Wild bird seed.</p>
PURINA	NFLD2249 Registered: August 21, 1937	Registered	<p>(1) Poultry and stock feed, and human food products, including cereal food products, such as flour.</p>

**APPEARANCES AND AGENTS OF RECORD**

**HEARING DATE:** July 19, 2023

**APPEARANCES**

**For the Opponent:** Kathleen Lemieux

**For the Applicant:** N/A

**AGENTS OF RECORD**

**For the Opponent:** Bordner Ladner Gervais LLP

**For the Applicant:** KLS Trademark Services