



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 42

Date of Decision: 2024-03-06

IN THE MATTER OF AN OPPOSITION

Opponent: GlobalRidge LLC dba NutriBiotic

Applicant: Dairy Crest Limited

Application: 1,844,063 for NUTRABIOTIC

INTRODUCTION

[1] GlobalRidge LLC dba NutriBiotic (the Opponent) opposes registration of the trademark NUTRABIOTIC (the Mark), which is the subject of application No. 1,844,063 filed by Dairy Crest Limited (the Applicant).

[2] The opposition is based on the allegation that the Mark is confusing with the Opponent's previously registered and used trademark NUTRIBIOTIC.

[3] For the reasons that follow, the opposition succeeds.

FILE OVERVIEW

[4] The application for the Mark was filed on June 22, 2017, based on use and registration of the Mark in the European Union and on proposed use in Canada.

[5] The statement of goods, as last amended, is reproduced below together with the associated Nice class (CI):

CI 5 (1) Prebiotic meal replacements, prebiotic dietetic food and beverages, adapted for veterinary use; prebiotic preparations for veterinary use in the form of dilutable powder and in liquid form; enzyme and vitamin preparations for veterinary use.

[6] The application was advertised for opposition purposes in the *Trademarks Journal* on August 24, 2022 and on October 20, 2022, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act).

[7] The grounds of opposition alleged by the Opponent are that: the Mark is not registrable in view of section 12(1)(d) of the Act; the Applicant is not the person entitled to registration of the Mark in view of sections 16(1)(a) and 16(3) of the Act; and the Mark is not distinctive in view of section 2 of the Act. As indicated above, these grounds of opposition all turn on the alleged likelihood of confusion between the Mark and the Opponent's trademark NUTRIBIOTIC.

[8] On November 16, 2022, the Applicant filed a counter statement essentially denying the grounds of opposition.

[9] In support of its opposition, the Opponent filed the affidavits of Kenny Ridgeway and Scott Taylor, both sworn March 13, 2023 (respectively the Ridgeway Affidavit and the Taylor Affidavit); and Maxwell Guld sworn March 14, 2023 (the Guld Affidavit).

[10] In support of its application, the Applicant filed the declaration of Lucie Lasnier dated May 24, 2023 (the Lasnier Declaration).

[11] None of the deponents were cross-examined.

[12] Both parties filed written representations; no hearing was held.

EVIDENCE OVERVIEW

Opponent's evidence

Ridgeway Affidavit

[13] The Ridgeway Affidavit provides information regarding the Opponent's business, including the use and promotion of its NUTRIBIOTIC trademark in Canada.

[14] More specifically, Mr. Ridgeway is President of the Opponent and has been associated with the Opponent for over 30 years (paras 1-2).

[15] The Opponent has been manufacturing and selling nutritional supplements in the United States since around 1980. Its business gradually expanded to include the manufacturing and selling of other products including personal health care products. The Opponent has been selling nutritional supplements in Canada in association with its NUTRIBIOTIC trademark since as early as August 1991, and began selling various personal health care products in Canada shortly thereafter. (paras 3, 6 and 15; Exhibits C and K)

[16] The Opponent sells its NUTRIBIOTIC products to various authorized distributors across Canada, including to Ecotrend Ecologics Ltd. (Ecotrend). The Canadian distributors then sell NUTRIBIOTIC products to retailers across Canada, who in turn sell them directly to end customers. (para 7)

[17] Mr. Ridgeway states that sales volumes of NUTRIBIOTIC products by Canadian distributors between 2011-2022 have exceeded 460,800 units, which resulted in revenues for the Opponent of approximately USD \$2,951,000. He provides representative invoices of sales for distribution made to Ecotrend in Canada dated between 2015-2022 and displaying the NUTRIBIOTIC trademark. (paras 8-10; Exhibits E and F)

[18] Mr. Ridgeway states that, since 1991, the NUTRIBIOTIC trademark and associated products have been extensively advertised and promoted in Canada, the Opponent having spent on average approximately USD\$7,000 per year on marketing (para 12). Such advertising and promotion has taken different forms, including:

- On the Opponent's website at *nutribiotic.com* registered in August 1997 – Printouts from several pages of the website are included in Exhibit A of the Ridgeway Affidavit and Exhibit J shows that it has had over 100,000 Canadian visitors from May 6, 2017 to March 6, 2023. (paras 4 and 13-18; Exhibits A and H to J)
- On print catalogues – Stated to have been provided to Canadian distributors since 1991 (para 15; Exhibit K).
- At trade shows and conferences – Dedicated to natural, organic, health, and wellness products (paras 16-17, Exhibit L).
- On social media – Namely on Facebook (since 2015) and Twitter (since 2020) (para 18; Exhibit M).

Taylor Affidavit

[19] Mr. Taylor is the Controller of Ecotrend, a wholesale distributor of ethical health and wellness products for humans and animals, including the Opponent's goods sold under its NUTRIBIOTIC trademark (paras 1-4). His affidavit supports that adduced by Mr. Ridgeway and provides information with respect to Ecotrend's business. It notably serves to support the Opponent's contention that the Applicant's goods could likely be sold to the same distributors through the same channels in direct competition with the Opponent. (paras 2-15, Exhibits A to H)

Guld Affidavit

[20] Mr. Guld is employed by the Opponent's trademark agents and introduces into evidence the results of his visit to a store (a pharmacy and natural health centre) in Vancouver, BC, namely photographs of various NUTRIBIOTIC-branded products as well as of several veterinary products and other health and wellness products for animal use under various third party trademarks, all available for sale on location (paras 1-4, Exhibits A and B). His affidavit mainly serves to support the Opponent's contention that it is likely that retailers in the health and wellness product market would offer for sale both parties' goods to their customers.

Applicant's evidence – Lasnier Declaration

[21] Ms. Lasnier is a paralegal employed with the Applicant's trademark agent and introduces state of the register evidence in the form of searches she performed of the Canadian Trademarks Database for all active trademarks containing either (i) the element NUTR or (ii) the element BIOTI, separately (paras 1-3, Exhibits LL-1 and 2).

PARTIES' RESPECTIVE ONUS AND BURDEN

[22] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD)].

GROUND OF OPPOSITION

Non-registrability (confusion with a registered trademark)

[23] With respect to the section 12(1)(d) ground of opposition, the Opponent alleges that the Mark is not registrable as it is confusing with its trademark NUTRIBIOTIC registered under No. TMA465,060 in association with various nutritional supplements and personal health care products.

[24] Having exercised the Registrar's discretion to check the register, I confirm that the relied upon registration is in good standing as of the date of this decision. The Applicant must now establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's registered trademark.

Test for confusion

[25] The test to determine the issue of confusion is set out in section 6(2) of the Act which stipulates that the use of a trademark causes confusion with another if the use of both trademarks in the same area would likely 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.

[26] Therefore, section 6(2) of the Act does not concern confusion of the trademarks themselves, but of the goods from one source as being from another. The question here is essentially whether a consumer, with an imperfect recollection of the Opponent's NUTRIBIOTIC trademark, who sees the Applicant's goods in association with the Mark, would think that they emanate from, are sponsored by, or approved by the Opponent.

[27] In applying the test for confusion, I must take into consideration all the relevant surrounding circumstances, including those listed in 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 they have been in use; the nature of the goods or business; the nature of the trade; and the degree of resemblance between the trademarks including in appearance or sound or in the ideas suggested by them. These are not exhaustive and different weight can be assigned to each factor in a context-specific assessment [*Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée*, 2006 SCC 23; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22].

[28] I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, where the Supreme Court of Canada states at para 49 that the resemblance between the marks will often have the greatest effect on the confusion analysis.

Degree of resemblance

[29] This factor strongly favours the Opponent here as the parties' trademarks are quasi-identical, differing only by one letter.

Inherent distinctiveness

[30] This factor does not meaningfully favour either party, given that the trademarks at hand, when taken as a whole, possess a similar degree of inherent distinctiveness. Both trademarks consist of an invented word without any particular meaning and neither can be found in commonly used dictionaries. Also, while I believe that they could both either suggest a coined word/brand or hint at ideas such as that the parties' goods are related

to nutritional supplements that contain pre or probiotics or such as (having) a healthy/nutritious mode of life, it is difficult to ascertain how the parties' trademarks would be perceived by consumers.

Extent known and length of time in use

[31] These factors favour the Opponent. The Opponent's evidence shows that the Opponent's trademark NUTRIBIOTIC was used for over 30 years in association with nutritional supplements and personal health care products and has become known to some extent in Canada in association with such products (mainly through sales, advertising and promotion as outlined above). The application for the Mark, on the other hand, is based on proposed use and the Applicant concedes in its written representations that the Mark is not yet used in Canada.

Nature of the goods or business and nature of the trade

[32] When considering the nature of the goods and the nature of the trade, I must compare the Applicant's statement of goods with the statement of goods in the registration relied upon by the Opponent [*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. 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)], although caution should be exerted not to restrict the protective scope of a registered mark based on its actual use [*Absolute Software Corporation v Valt.X Technologies Inc*, 2015 FC 1203].

[33] The Opponent's relied-upon trademark is registered in association with the following goods:

- (1) Nutritional supplements, namely rice protein, vitamins, grapefruit liquid extract, nutritional supplements made from botanicals; first-aid skin sprays; first-aid skin ointments; skin cleansers; dental gels; bubble baths; shower gels; nasal sprays; ear drops; foot powders; and personal hygiene deodorants.

(2) Nutritional supplements, namely minerals, vitamin and mineral combinations, nutritional drink powders, vitamin powders, herbal extracts, botanical extracts, herbal tablets, algae tablets; and mouth rinses.

(3) Anti-septic liquid.

[34] As indicated above, the statement of goods for the Mark now essentially covers prebiotic preparations, meal replacements and dietetic food and beverages as well as enzyme and vitamin preparations, all for veterinary use.

[35] The Applicant briefly submits that all of its goods are specified for veterinary use, and that veterinarians are professional purchasers who will pay more attention purchasing items for veterinary use than a consumer member of the general public purchasing items for regular consumption. Relying on *Borden Inc v Robin Hood Multifood Ltd* (1979), 49 CPR (2d) 133 (TMOB) and with reference to food items versus supplements for animals, the Applicant also submits that identical trademarks can very well coexist on the register if they cover goods that sufficiently differ.

[36] The Applicant indeed amended the application for the Mark to specify that all of its goods are for veterinary use. However, first, there is no indication in the relied-upon registration that the Opponent's goods are limited with respect to their use or consumption. Second, in the absence of any evidence on this point, I do not find that this restriction necessarily solely points to the Applicant's goods being exclusively destined for use by veterinarians, as suggested in its written representations. In my view, such language can also arguably be construed as simply referring to goods for animals or more specifically, for animal consumption.

[37] In other words, I find that the Applicant's goods—as described—can just as likely be perceived as including various dietary and nutritional supplements for animals, while the goods listed in the Opponent's registration include nutritional supplements as well as personal health care products.

[38] With this in mind, I tend to agree with the Opponent's submissions that the channels of trade for the parties' goods could overlap. More specifically, Mr. Ridgeway's evidence is that the Opponent's nutritional supplements have been sold through Canadian distributors, including Ecotrend and Mr. Taylor's evidence is that Ecotrend

indeed purchases such supplements for distribution to Canadian retailers. Mr. Taylor's evidence is also that Ecotrend purchases health and wellness products—including nutritional supplements—for consumption and use by both humans and animals from other vendors for distribution to Canadian retailers. Finally, Mr. Guld's evidence supports that this type of good can be found in the same retail stores. Therefore, ultimately, distributors and retailers in the health and wellness product market could potentially offer for sale both parties' supplements to end consumers.

[39] Lastly, with respect to the *Robin Hood Multifood Ltd* decision, I find that its circumstances can be distinguished from those I am considering here, notably in that the Opponent here has established use of its relied-upon trademark whereas in the cited case the evidence of the opponent only showed very limited use by a third party that was nowhere accounted for and whose activities were not explained. In any event, I don't find this case helpful to the Applicant, as the goods that it discussed were actually quite different—food items such as spaghetti for example vs an animal feed supplement. In the present case, the goods of both parties' include nutritional supplements.

Other surrounding circumstance – state of the register

[40] State of the register evidence is introduced to show the commonality or lack of distinctiveness of a trademark or of a portion of a trademark. It is established that where trademarks contain a common element that is also contained in a number of other trademarks in the same market, this tends to cause consumers to pay more attention to the marks' other non-common features to distinguish them [*K-Tel International Ltd v Interwood Marketing Ltd* (1997), 77 CPR (3d) 523 (FCTD)].

[41] That said, such evidence is relevant only insofar as it allows for inferences concerning the state of the marketplace, which can only be drawn when a significant number of relevant trademarks are located [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)]. Relevant trademarks include those that (i) are registered or are allowed and based on use; (ii) are for similar goods and services as the marks at issue, and

(iii) include the component at issue in a material way [*Sobeys West Inc v Schwan's IP, LLC*, 2015 TMOB 197 at para 38, aff'd 2017 FC 38].

[42] As indicated above, Ms. Lasnier has searched the Canadian Trademarks Database for active marks comprising the element NUTR and attaches in bulk to her declaration printouts listing the 1904 entries yielded through this search [Exhibit LL-1]. Ms. Lasnier has also searched this database for active marks comprising the element BIOTI and attaches in bulk to her declaration printouts listing the 161 entries yielded through this search [Exhibit LL-2].

[43] The parties did not address this evidence in great detail in their written representations.

[44] The Opponent rightly submits that there is no evidence of use of any trademarks in Canada for nutritional supplements, other than the Opponent's trademark NUTRIBIOTIC, which include the *combination* of the prefix NUTR and suffix BIOTIC.

[45] The Applicant simply mentions that the Opponent's trademark is composed of elements highly diluted on the register and common on the market. In this regard, I first note that the Applicant has not adduced any actual evidence of marketplace use. I also note that Ms. Lasnier has not restricted her searches to allowed or registered trademarks and so her evidence also includes many irrelevant results notably in the form of marks that are formalized, searched, in default, advertised and even opposed. She also has not restricted her searches to any specific goods. It is therefore unclear if the Applicant's position is that her evidence would be helpful regardless of whether the type of goods covered by the yielded results are similar or not. In any event, Ms. Lasnier's evidence is further deficient as she does not provide full particulars for any of the yielded trademarks. I would add on this point that it is not for the Registrar to fill in any gaps in the Applicant's state of the register evidence [see *SOS Tutorat Inc / SOS Tutoring Inc v SOSPROF Inc*, 2022 TMOB 52 at para 65 for a similar conclusion on such deficiencies in state of the register evidence].

[46] In view of the above, I do not consider Ms. Lasnier's evidence to be of any assistance to the Applicant.

Conclusion on likelihood of confusion

[47] Having considered all of the surrounding circumstances and applying the test of confusion as a matter of first impression and imperfect recollection, I find that the Applicant has not satisfied its onus to show that there is no reasonable likelihood of confusion between the parties' trademarks. I reach this conclusion in view of the very high degree of resemblance between the trademarks, the use and extent known of the Opponent's trademark, the close connection between the parties' goods and potential for overlap in their channels of trade. The section 12(1)(d) ground of opposition therefore succeeds.

Non-entitlement (prior trademark use)

[48] While the material date differs, the section 16(1)(a) ground of opposition also turns on the issue of confusion with the Opponent's trademark NUTRIBIOTIC and the Opponent's evidence of use outlined above is sufficient to meet the Opponent's corresponding burden. As my conclusions under the section 12(1)(d) ground, for the most part, also apply to this ground of opposition, I reach the same result respecting it and the section 16 ground, too, therefore succeeds.

Remaining ground of opposition (non-distinctiveness)

[49] As I have already refused the application under two grounds, I will refrain from considering the remaining ground of opposition under section 2 of the Act.

[50] I will however note that, notwithstanding the differences in the material date, to the extent that this ground turns on the issue of confusion between the parties' trademarks, I would likely have reached the same conclusion above regarding the likelihood of confusion for reasons similar to those discussed under the section 12(1)(d) ground of opposition.

DISPOSITION

[51] 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.

Iana Alexova
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

No hearing held

AGENTS OF RECORD

For the Opponent: Oyen Wiggs Green & Mutala LLP

For the Applicant: Simon Lemay