



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 37

Date of Decision: 2024-02-29

IN THE MATTER OF AN OPPOSITION

Opponent: BioSyent Pharma Inc.

Applicant: Replete Nutraceuticals Inc.

Application: 1888495 for FERAPRO

INTRODUCTION

[1] BioSyent Pharma Inc. (the Opponent) opposes registration of the trademark FERAPRO (the Mark), which is the subject of application No. 1888495 by Replete Nutraceuticals Inc. (the Applicant).

[2] The Mark is applied for in association with the following goods (in Nice class 5): “Dietary and nutritional supplements consisting primarily of iron”.

[3] The opposition is primarily based on an allegation that the Mark is confusing with the Opponent’s trademark FERAMAX, previously registered and used in Canada in association with similar goods.

THE RECORD

[4] The application for the Mark was filed on March 16, 2018, on the basis of proposed use in Canada.

[5] The application was advertised for opposition purposes on September 4, 2019.

[6] On September 24, 2019, the Opponent opposed the application by filing a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act).

[7] The grounds of opposition are based on non-registrability pursuant to sections 38(2)(b) and 12(1)(d) of the Act; non-entitlement to registration pursuant to sections 38(2)(c) and 16 of the Act; non-distinctiveness pursuant to sections 38(2)(d) and 2 of the Act; that the Applicant was not using and did not propose to use the Mark pursuant to section 38(2)(e) of the Act; and non-entitlement to use pursuant to section 38(2)(f) of the Act.

[8] On November 21, 2019, the Applicant requested an interlocutory ruling to strike the grounds based on non-entitlement to registration and non-entitlement to use. However, the Applicant subsequently filed and served its counter statement on December 4, 2019, prior to the issuance of the requested ruling. Accordingly, and as explained in the Registrar's letter dated December 30, 2019, pursuant to section 38(6) of the Act and section II.2 of the practice notice, *Practice in opposition proceedings re: Interlocutory Rulings*, once the counter statement had been filed and served, issues concerning the sufficiency of the Opponent's pleadings would only be considered at the decision stage.

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

- Affidavit of Robert March, sworn April 24, 2020 in Toronto (the March Affidavit);
- Affidavit of Gail N. Wozny, affirmed May 19, 2022 in Ottawa (the Wozny Affidavit), filed as reply evidence; and

- Affidavit of Kerry Biggs, affirmed May 20, 2022 in Ottawa (the Biggs Affidavit), also filed as reply evidence.

[10] Ms. Wozny and Ms. Biggs were both cross-examined and the cross-examination transcripts were made of record.

[11] Mr. March was not cross-examined on his affidavit; however, as explained below, in part due to disruptions related to the Covid-19 pandemic at the time, the parties agreed that a substantively similar affidavit of a different principal of the Opponent from another proceeding (and subsequent cross-examination transcript and undertakings) would be made of record in this proceeding.

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

- Affidavit of Dawn Trach, sworn October 18, 2021 in Ottawa (the Trach Affidavit);
- Affidavit of Jennifer Nahorniak, sworn on October 14, 2021 in Toronto (the Nahorniak Affidavit); and
- Affidavit of Robert Youngson, sworn on October 18, 2021 in Toronto (the Youngson Affidavit).

[13] None of the Applicant's deponents were cross-examined.

[14] Both parties submitted written representations; as each party's request for a hearing was conditional on the other party requesting a hearing, a hearing was not held.

OVERVIEW OF THE OPPONENT'S EVIDENCE

[15] The Opponent is the owner of trademark registration No. TMA739115 for the trademark FERAMAX (the Opponent's Trademark), registered since April 29, 2009 in association with the following goods (the Opponent's Goods):

Pharmaceutical preparations, mineral supplements and herbal supplements namely iron preparations, hematinics and iron supplements for use as blood builders.

March Affidavit

[16] Mr. March is the Vice President and Chief Financial Officer of the Opponent [para 1]. He explains that the Opponent sells iron pills and iron powder in association with the Mark through pharmacies and an online website. In this respect, the March Affidavit evidences the following:

- The Opponent's business and background, as an independent pharmaceutical company that is "focused on commercializing products that provide a distinguishable benefit to patients and their healthcare providers and is known for its ability to effectively and efficiently introduce new products to the Canadian market" [paras 4 and 5];
- The nature of the Opponent's FERAMAX products, namely iron pills (FERAMAX 150) and iron powder (FERAMAX Powder) [paras 7 to 9];
- Availability and sales of the Opponent's FERAMAX products in Canada, amounting to over \$90 million in gross sales since 2008 [paras 10 and 11, Exhibits B and C];
- Use of the Opponent's Trademark in packaging and displays [paras 12 and 13, Exhibits D and E];
- Availability of the Opponent's FERAMAX products online via the third-party website *pharmexdirect.com*, showing how the Opponent's products appear online in association with the Opponent's Trademark [para 14, Exhibit F];
- Use of the Opponent's Trademark in advertising and marketing the Opponent's FERAMAX products, including via: print and online advertising [paras 15 and 16, Exhibits G and H]; marketing materials used during events or distributed to the public [paras 17 and 18, Exhibits I and J]; conferences and continuing education events [para 19, Exhibit K]; the Opponent's website *feramax.com* [para 20, Exhibits L and M]; and social media [para 21]. Mr. March states that the

Opponent spends over \$2.5 million annually to promote its FERAMAX brand [para 23];

- Awards received by the Opponent, in particular that, in May 2019, the Opponent's FERAMAX brand "was named the Number 1 physician and pharmacist recommended over-the-counter, oral iron supplement brand in Canada for the fourth consecutive year in the Pharmacy Practice and Profession Santé Survey on the OTC Counselling and Recommendations" [paras 24 and 25, Exhibit N]; and
- The market share of the Opponent's FERAMAX products, compared to that of other iron supplements sold in the Canadian market between 2013 and 2019 [para 26, Exhibit O]. I note that, of the 38 products identified in the illustrative graph, over half of the products incorporate the element FER, such as "EURO-FER", "PROFERRIN" and "PALAFER".
- Printouts from the Applicant's website *ferapro.com* (as it appeared in June 2019), describing the Applicant's FERAPRO product [para 27, Exhibit P].
- Printout of a 2019 post from the Instagram page for "ferapro150", comparing the Applicant's FERAPRO product to the Opponent's FERAMAX product and that of a third party, which Mr. March characterizes as "misleading" [para 28, Exhibit Q].

[17] Relevant portions of the cross-examination of Mr. Goehrum, submitted by the Applicant as an exhibit to the Trach Affidavit, will be addressed below. Although nothing ultimately turns on the differences, I note that Exhibits P and Q and the related statements (or the like) are not present in the Goehrum Affidavit.

Wozny Affidavit

[18] Ms. Wozny identifies herself as a resident of Edmonton [para 1]. Her affidavit simply indicates that in May 2022, she attended a pharmacy in Edmonton, where she purchased a box of FERAPRO-branded iron supplements as well as a box of

FERAMAX-branded iron supplements, which were shelved in close proximity to each other [paras 2 to 4, Exhibits A and B].

Biggs Affidavit

[19] Ms. Biggs is a paralegal employed by the Opponent's agent [para 1]. She attests that, in May 2022, she conducted a search for online pharmacies selling iron supplements [para 2]. As a result, she attests that Coal Harbour Pharmacy, Amazon Canada, and the Association of Ontario Midwives all sell both FERAMAX brand and FERAPRO brand iron supplements [para 7]. Attached to her affidavit are printouts showing the iron supplements available for sale from each of the foregoing [paras 3 to 5, Exhibits B to D].

OVERVIEW OF THE APPLICANT'S EVIDENCE

Trach Affidavit

[20] Ms. Trach is a law clerk employed by the Applicant's agent [para 1]. In her affidavit, she explains that she requested and obtained from the Registrar copies of documents filed in the opposition proceeding against application No. 1821234 for the trademark FERACCRU [paras 2 to 4]. Accordingly, attached to the Trach Affidavit are the following documents from that proceeding:

- Exhibit A: the affidavit of Rene Goehrum sworn May 16, 2019, filed by the Opponent in the FERACCRU proceeding.
- Exhibit B: the transcript from the cross-examination of Mr. Goehrum, conducted on November 7, 2019.
- Exhibit C: the response to undertakings from the cross-examination of Mr. Goehrum, dated January 25, 2020.
- Exhibit D: the affidavit of Do Youn Kim, sworn August 20, 2020 (the Kim Affidavit), filed by the applicant in the FERACCRU proceeding.

[21] As Ms. Trach attests, due to issues related to the Covid-19 pandemic, this evidence was submitted in this manner in lieu of the Applicant conducting a cross-examination of Mr. March on his substantively-similar affidavit, and with the consent of the Opponent [para 7, Exhibit E].

Nahorniak Affidavit

[22] Ms. Nahorniak is a law clerk employed by the Applicant's agent [para 1]. In October 2021, she conducted various Internet, database and dictionary searches [paras 2 to 14]. Accordingly, the Nahorniak Affidavit evidences the following, all from October 2021:

- A printout of the “where to purchase” page from the Opponent’s website *feramax.com* [para 2, Exhibit A].
- Search results for active trademarks incorporating the element FER in Nice Class 5 (Pharmaceuticals and herbicides) from the Canadian Trademarks Database [para 3, Exhibit B].
- Particulars of 51 trademark registrations (all incorporating the element FER), as well as the particulars of the subject application for the Mark [paras 4 and 5, Exhibits C and D].
- Search results from Health Canada’s Natural Health Products database (NHP database) for all active products with brand names incorporating the element FER, and having “iron” or “ferric” as ingredients [paras 6 and 7, Exhibits E to G].
- Printouts of the particulars of 14 products from the NHP database [para 8, Exhibit H].
- Search results from Health Canada’s Drug Product Database (DPD) for “active” or “marketed” products, with product names incorporating the element FER and having “iron” or “ferric” as active ingredients [para 9, Exhibit I].

- Particulars of 9 products from the DPD, together with terminology explanations from Health Canada’s website, from which Ms. Nahorniak identifies four “approved” or “marketed” products from the Exhibit I search results that “were for use in humans” [paras 10 to 12, Exhibits J to L].
- Printouts of various dictionary definitions, including for the terms “iron”, “fer (French)”, “ferro- (combining form)”, “a- (prefix)”, “max”, and “pro / pro-” [paras 13 and 14, Exhibits M to AA].

Youngson Affidavit

[23] Mr. Youngson is an articling student employed by the Applicant’s agent [para 1]. In his affidavit, Mr. Youngson attests to attending several pharmacies in Toronto in October 2021, where he photographed various iron supplement products available for sale [paras 2 to 15, Exhibits A to Z]. Mr. Youngson also attests that he was informed by some of the pharmacists he spoke to of other products that were not in stock at the time, but normally would be in stock at those pharmacy locations [paras 7, 10 and 14].

[24] Mr. Youngson confirms that the products he photographed during his pharmacy visits are largely the same as the products referenced in the abovementioned Kim Affidavit, filed as evidence in the FERACCRU proceeding [para 15, Exhibit Z].

[25] The Youngson Affidavit also evidences screenshots from the third-party website *odanlab.com*, one of which references the product FERODAN Syrup & Infant Drops [paras 17 and 18, Exhibits AA and BB].

EVIDENTIAL BURDEN AND LEGAL ONUS

[26] In accordance with the usual rules of evidence, there is an evidential burden on the Opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Ltd v Molson Companies Ltd*, 1990 CarswellNat 1053 (FCTD)]. The presence of an evidential burden on the Opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient

evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

[27] For those allegations for which the Opponent has met its evidential burden, the legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. The presence of a legal onus on the Applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, then the issue must be decided against it.

CONFUSION WITH A REGISTERED TRADEMARK – SECTION 12(1)(D)

[28] Pursuant to sections 38(2)(b) and 12(1)(d) of the Act, the Opponent pleads that the Mark is not registrable because it is confusing with registration No. TMA739115 for the Opponent's Trademark, registered since April 29, 2009 and covering the Opponent's Goods.

[29] The material date with respect to confusion with a registered trademark is the date of this decision [*Simmons Ltd v A to Z Comfort Beddings Ltd*, 1991 CarswellNat 1119 (FCA)]. As the registration for the Opponent's Trademark is extant on the register, the Opponent meets its initial burden.

[30] Accordingly, the Applicant must establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark (FERAPRO) and the Opponent's Trademark (FERAMAX).

Test to determine confusion

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

[32] The test to be applied is a matter of first impression in the mind of a casual consumer “somewhat in a hurry” who sees the Mark in association with the applied-for goods at a time when they have no more than an imperfect recollection of the Opponent’s Trademark and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[33] In making such an assessment, all the relevant surrounding circumstances must be taken into consideration, including those listed in section 6(5) of the Act: 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 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.

[34] The criteria or factors in section 6(5) of the Act are not exhaustive and different weight will be given to each one in a context-specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 54]. In *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, the Supreme Court of Canada stated that section 6(5)(e), the resemblance between the trademarks, will often have the greatest effect on the confusion analysis [at para 49] and that, while the first word in the trademark may be the most important in some cases, the preferable approach is to consider whether there is an aspect of the trademark that is particularly “striking or unique” [at para 64].

Inherent Distinctiveness and the Extent Known

[35] In its written representations, the Opponent submits that the Opponent’s Trademark is inherently distinctive as “it is a coined, non-sequitur term when used in association with the Opponent’s Goods” [para 40]. Furthermore, the Opponent notes that the evidence shows that the Opponent’s Trademark has been used in association with the Opponent’s Goods since 2009, whereas the application was filed on the basis of proposed use in Canada [paras 42 and 43].

[36] For its part, in its written representations, the Applicant argues that the Opponent's Trademark has low inherent distinctiveness, submitting the following:

- "FER" is the French word for "iron" and is also a direct reference to iron in English, e.g. "ferric", "ferrous", and other associated words beginning with "fer" [paras 69 and 70].
- The FER element is highly suggestive, if not descriptive of the associated goods [para 69].
- The evidence shows numerous FER-formative trademarks and product names on the Canadian market [paras 71 and 72].
- In his cross-examination, Mr. Goehrum (the Opponent's affiant in the FERACCRU proceeding) acknowledged several FER-formative words that are used to describe or reference iron, and that there is common use of the "FER" element in the Canadian market in association with iron supplements [paras 73 to 76].
- The MAX element of the Opponent's Trademark is suggestive or laudatory, merely suggesting that the Opponent's products contain the maximum or highest dosage of iron [paras 76 to 78].

[37] The Applicant notes that the Registrar has previously found that the FER element is highly suggestive of iron [paras 80 and 81, referencing *Ferring, Inc v Apotex Technologies, Inc*, 2013 TMOB 225 at para 97; *Ferring Inc v Ddrops Company Inc*, 2016 TMOB 36 at para 76; and *BioSyent Pharma Inc v Shield TX (UK) Ltd*, 2022 TMOB 162 (*Feraccru*) at para 41].

[38] In summary, regarding the inherent distinctiveness of the Opponent's Trademark, the Applicant submits that the Opponent "has simply reached inside the common trade vocabulary for a term that is both descriptive and widely used and combined it with 'MAX', a laudatory term that is also descriptive and common", such that the Opponent's

Trademark should be attributed “an extremely low degree of inherent distinctiveness” [para 79].

[39] With respect to the extent to which the Opponent’s Trademark has become known, the Applicant attempts to characterize the evidence of use and promotion of the Opponent’s Trademark as “ambiguous”, relating to composite trademarks, and “not supported” by specific information [paras 26 to 28 and 142 to 153]. However, I accept that the Opponent has evidenced use and marketing of the Opponent’s Trademark since 2009.

[40] Furthermore, aside from the existence of the Applicant’s website in June 2019, there is no clear evidence regarding the extent to which the Mark has become known in Canada. As such, even if I were to find that the Mark has a greater degree of inherent distinctiveness than the Opponent’s Trademark, overall this factor favours the Opponent.

Length of Time in Use

[41] The Opponent has evidenced use of the Opponent’s Trademark in association with the Opponent’s Goods since 2009. The application for the Mark was filed on the basis of proposed use in Canada, and there is no evidence of use of the Mark subsequent to the filing date.

[42] Accordingly, this factor favours the Opponent.

Nature of the Goods or Business / Nature of the Trade

[43] When considering the nature of the goods of the parties in respect of the issue of confusion, it is the statements of goods in the subject application and registration that govern [*Mr Submarine Ltd v Amandista Investments Ltd*, 1987 CarswellNat 749 (FCA); *Miss Universe Inc v Bohna*, 1994 CarswellNat 1443 (FCA)].

[44] In its representations, the Opponent submits that the parties' goods and businesses directly overlap, as they both sell iron-related pharmaceuticals and supplements in the Canadian market [paras 45 to 50].

[45] For its part, the Applicant notes that the evidence regarding the Opponent's FERAMAX products indicates that such products are "non-prescription, licensed natural health products" that are "kept behind the counter" at the pharmacy [para 140]. In contrast, the Applicant characterizes its goods as "dietary and nutritional supplements consisting primarily of iron" [para 138], suggesting that "the intermediary role of a health care professional in accessing the respective products" somehow differentiates the nature of the parties' goods. I note that, given the absence of evidence from the Applicant regarding the sale or marketing of its goods, this implied difference is not necessarily clear. In any event, the Applicant correctly acknowledges that "there is potential overlap" between the parties' goods, but otherwise generally emphasizes the importance of other factors in the confusion analysis [para 141].

[46] Indeed, I agree with the Opponent that there is clear overlap in the nature of the parties' goods and, at a minimum, there is the potential for overlap in the nature of the parties' businesses and trade.

[47] Accordingly, these factors favour the Opponent.

Degree of Resemblance

[48] In its written representations, the Opponent submits that, as both trademarks begin with the prefix FERA, they have a high degree of resemblance in their appearance and "starting" sound [para 53]. With respect to the ideas suggested, the Opponent submits that the trademarks suggest the same idea, in that "FERAMAX suggests achieving or reaching maximum level", while "FERAPRO suggests achieving the highest level, e.g., after being an amateur in sport, one becomes a 'pro', or where one starts as an apprentice in a job, they level up to become a professional" [para 55].

[49] In particular, the Opponent compares the trademarks at issue in this case to the trademarks that were the subject of the abovementioned *Feraccru* proceeding. In this respect the Opponent submits:

In the FERACCRU Opposition, the Board decided that there was a difference of idea between ‘maximum iron’ and ‘accruing’ or ‘increasing iron’. This is not the case here. The idea between ‘maximum iron’ and ‘highest level’ is directly overlapping and confusing. [*Feraccru* at para 52]

[50] The Applicant submits that the Opponent’s argument that the Mark, FERAPRO, evokes the idea of “achieving the highest level” is a “strained interpretation unsupported by the evidence of record” and inconsistent with prior jurisprudence that has dealt with a similar “PRO” element [paras 129 to 131]. Rather, the Applicant submits that the term PRO would be understood to be an abbreviated form of “professional”, suggesting professionalism or that the Applicant’s product is of a professional grade [para 128]. Alternatively, the Applicant submits that it could evoke ideas of being “favourable” or the like – in any event, it argues that there is nothing inherent in the term PRO that “would be considered suggestive of the dosage strength let alone suggestive of the maximum dose of a product” [para 128].

[51] I tend to agree with the Applicant that the Opponent’s attempt to identify the trademarks as suggesting the same idea is somewhat strained. With respect to the Opponent’s examples of “achieving the highest level” – an apprentice at a job or an amateur in a sport – even if these can readily be extrapolated from “PRO”, they are not obviously evoked by the Opponent’s Trademark. Dots need to be connected, explanations made. While the logic of the journey can be appreciated and the journey is perhaps not as far as that argued in *Feraccru*, it is nonetheless a journey. In any event, to the extent it is necessary to consider the idea suggested beyond the word itself in a word mark, given the nature of the goods in this case – iron supplements and preparations – I do not consider the idea of higher or highest levels of iron to be particularly distinctive for purposes of this analysis.

[52] Furthermore, I consider the differences in appearance and when sounded to be more important than the shared element FER which, in association with the relevant

goods, the evidence demonstrates is at least suggestive of iron. As noted by the Applicant, when the first portion of a trademark is a common descriptive word, its importance diminishes [paras 120 to 125].

[53] Thus, I agree with the Applicant that, given the element FER has a suggestive if not descriptive meaning in relation to the relevant goods and is common to the trade, there are sufficiently significant differences between the trademarks in appearance, in sound, and in the ideas suggested by them.

[54] Accordingly, this factor favours the Applicant.

Additional Surrounding Circumstances – States of the Register and Marketplace

[55] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [*Ports International Ltd v Dunlop Ltd*, 1992 CarswellNat 1431 (TMOB); and *Welch Foods Inc v Del Monte Corp*, 1992 CarswellNat 178 (FCTD)]. Such inferences can only be drawn from state of the register evidence where large numbers of relevant registrations are located [*Maximum Nutrition Ltd v Kellogg Salada Canada Inc*, 1992 CarswellNat 124 (FCA)].

[56] In its representations, the Applicant submits that the Opponent's Trademark should be afforded only narrow protection, as the state of the register and marketplace evidence indicates that FER-formative trademarks are commonly adopted and freely coexist in the pharmaceutical field [para 84]. In this respect, it references and details both parties' evidence [paras 84 to 103], noting in particular that Mr. Goehrum had admitted in his cross-examination that the FER element is "a common generic description" [para 94, referencing the Trach Affidavit at Exhibit B, Q444-447]. The Applicant further submits that the evidence of record is consistent with past and recent findings of the Registrar in cases concerning FER-formative trademarks used in association with similar iron products, including the *Feraccru* proceeding [paras 108 to 117].

[57] In its written representations, the Opponent notes that it “is not arguing that it owns the use of them FER in association with iron-related goods [para 63]. Rather, the Opponent argues that the prefix “FERA” is of importance in this case, noting only one other registered trademark with the prefix FERA in the state of the register evidence set out in the Nahorniak Affidavit [paras 63 and 64]. Otherwise, it disputes the relevance of several of the FER-formative trademarks on the register, submitting that the Nahorniak Affidavit “provides limited evidence showing the use of FERA-formative marks are currently active or in use in the Canadian marketplace in association with iron-related goods, or even FER-formative trademarks with FER as the prefix” [para 67].

[58] The Opponent also characterizes the Applicant’s state of the marketplace evidence as “weak” [paras 69 to 73]. In this respect, it notes the limited search results and relevancy of the two Health Canada database searches evidenced in the Nahorniak Affidavit [paras 70 and 71]. With respect to Mr. Youngson’s visits to various pharmacies in Toronto, the Opponent submits that, of the products shown:

None of the trademarks have the prefix of FERA, in sound or appearance. Only two ... start with the prefix FER. Eleven ... trademarks on iron products from the Canadian marketplace is not significant enough to contribute to meaningful inferences about the state of the marketplace at the material time. [para 72]

[59] While I agree with the Opponent that, on their own, the Health Canada database search results are of limited value, none of the evidence should be considered in isolation. As noted by the Applicant, “there is no single type of evidence, or a specific combination of the types of evidence, that is required for a party to establish common adoption of a term in a particular trade at a given time” [at para 104, citing *Vital Source Inc v Vital Life Pharmaceutical Inc*, 2020 TMOB 21 at para 87; and *Feraccru* at para 65].

[60] While the Opponent submits that the relevant consideration is the “FERA” prefix (rather than just the FER element), I agree with the Applicant that such an approach improperly dissects the trademarks and disregards visually and phonetically-similar trademarks, such as those with “FERRI” or “FERRO” formative elements [Applicant’s written representations at para 113, citing *Feraccru* at para 66].

[61] In view of the evidence as a whole, I agree with the Applicant that FER appears to be a common element in trademarks associated with iron supplements and the like, such that it is reasonable to infer that customers have had significant exposure to FER-formative marks in association with iron supplements or pharmaceuticals [para 112].

[62] In view of the foregoing, considered in their totality, these factors strongly favour the Applicant.

Conclusion – Confusion with the Opponent’s Trademark

[63] Having considered all of the surrounding circumstances, I find that Applicant has met its legal burden on a balance of probabilities regarding the likelihood of confusion as to the source of the parties’ goods. I reach this conclusion due to the low degree of resemblance between the parties’ trademarks and given the state of the relevant marketplace with respect to FER-formative trademarks, and notwithstanding the evidence of use of the Opponent’s Trademark and the likely overlap in the nature of the parties’ goods, business, and channels of trade.

[64] Accordingly, the section 12(1)(d) ground of opposition based on confusion with the Opponent’s Trademark is rejected.

NON-ENTITLEMENT TO REGISTRATION – SECTION 16

[65] Pursuant to sections 38(2)(c) and 16(1)(b) of the Act, the Opponent pleads that the Applicant is not the person entitled to registration of the Mark in that as of the filing date of the application, the Mark was confusing with the Opponent’s Trademark in respect of which an application for registration has previously been filed.

[66] An opponent meets its evidentiary burden under a section 16(1)(b) ground if it shows that an application for registration in respect of its relied-upon trademark had been previously filed in Canada, and that such previous application was pending as of the date of advertisement of the opposed trademark [section 16(2) of the Act].

[67] In its written representations, the Opponent appears to reference section 16(3) of the Act, reiterating its position that there is a reasonable likelihood of confusion between the parties' trademarks and submitting that, therefore, "the Applicant could not have been satisfied that it was or is entitled to registration of [the Mark]" [para 74].

[68] However, if the Opponent wished to rely on a ground of opposition based on section 16(3) of the Act (which deals with "previous use or making known" of a trademark), then it was obligated to plead such or amend its pleading accordingly. As pointed out by the Applicant in its written representations (and echoing its abovementioned request for an interlocutory ruling), there was no pending application for the Opponent's Trademark as of the relevant advertisement date – the Opponent's FERAMAX trademark was registered in April 2009, well before the September 4, 2019 advertisement of the application for the Mark [paras 158 to 161]. Furthermore, there is no indication of any other pending applications for the Opponent's Trademark at that time.

[69] In view of the foregoing, the pleading is insufficient and not cured by the evidence of record.

[70] In any event, even if the Opponent had somehow met its initial burden under this ground (or a ground based on section 16(3) of the Act), I would not find my conclusions above with respect to the confusion analysis to substantially differ, notwithstanding any earlier material date.

[71] In view of all of the foregoing, the ground of opposition based on section 16 of the Act is rejected.

NON-DISTINCTIVENESS – SECTION 2

[72] Pursuant to section 38(2)(d) and 2 of the Act, the Opponent pleads that the Mark is not distinctive in Canada of the Applicant's goods in that the Mark does not distinguish, nor is adapted to distinguish, the Applicant's goods from those of the Opponent.

[73] The material date for this ground is the filing date of the opposition, namely September 24, 2019.

[74] Section 2 of the Act defines “distinctive” as follows:

“distinctive” in relation to a trademark, describes a trademark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or that is adapted so to distinguish them.

[75] A trademark “actually distinguishes” by acquiring distinctiveness through use, resulting in distinctiveness in fact. On the other hand, a trademark that is “adapted so to distinguish” is one that does not depend upon use for its distinctiveness because it is inherently distinctive [see *Astrazeneca AB v Novopharm Ltd*, 2003 FCA 57 at para 16].

[76] Under a non-distinctiveness ground such as this, the initial burden is on the Opponent to evidence that, as of the material date, its trademark i) was known to some extent in Canada in association with the relevant goods and ii) had a reputation in Canada that was “substantial, significant or sufficient” so as to negate the distinctiveness of the Mark [see *Bojangles’ International, LLC v Bojangles Café Ltd*, 2006 FC 657 at paras 33 and 34; and *Canadian Dental Association v Ontario Dental Assistants Association*, 2013 FC 266 at para 42, aff’d 2013 FCA 279]. In *Auld Phillips Ltd v Suzanne’s Inc*, 2005 FCA 429, albeit in the context of an expungement proceeding under section 57 of the Act, the Federal Court of Appeal stated that “Obviously, it will be a rare occurrence when one party is in a position to cause a mark to lose its distinctiveness, but nothing in principle prevents this result” [at para 7].

[77] In this case, as noted above, I accept that the Mark has some inherent distinctiveness in association with the applied-for goods. Although the Opponent’s Trademark was known to some extent in Canada in association with the Opponent’s Goods since 2009, it cannot be said that there is evidence that the reputation of the Opponent’s Trademark was substantial, significant or sufficient so as to *negate* such inherent distinctiveness of the Mark. In this respect, noting in part that the application is based on proposed use, there is simply no evidence of negation.

[78] Accordingly, as the Opponent fails to meet its initial burden, the section 2 ground of opposition is rejected.

[79] In any event, to the extent this ground in part ultimately turns on the issue of confusion, I would come to the same conclusion as above with respect to the section 12(1)(d) ground, notwithstanding the differing material date.

NOT USING AND DID NOT PROPOSE TO USE - SECTION 38(2)(E)

[80] Pursuant to section 38(2)(e) of the Act, the Opponent pleads that, at the filing date of the application in Canada, the Applicant was not using and did not propose to use the Mark in association with the goods specified in the application.

[81] I note that the Opponent does not specifically address this ground in its written representations. In any event, I agree with the Applicant that the Opponent has filed no evidence in support of this ground [paras 170 to 172]. Indeed, this ground is insufficiently plead and is not cured by the evidence of record.

[82] Accordingly, the ground of opposition based on section 38(2)(e) of the Act is rejected.

NON-ENTITLEMENT TO USE – SECTION 38(2)(F)

[83] Pursuant to section 38(2)(f) of the Act, the Opponent pleads that at the filing date of the application in Canada, the Applicant was not entitled to use the Mark in Canada in association with the applied-for goods.

[84] Again, the Opponent does not specifically address this ground in its written representations, the ground is insufficiently plead, and there is no evidence to cure the pleading or to otherwise support this ground.

[85] Accordingly, the ground of opposition based on section 38(2)(f) of the Act is rejected.

DISPOSITION

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

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Opponent: Smart & Biggar LP

For the Applicant: Ardeshir Darabi