



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 180

Date of Decision: 2025-09-08

INTERLOCUTORY RULING

Opponent: Nathan Harewood

Applicant: FIT Foods Ltd.

Application: 2,061,672 for DOMIN8

INTRODUCTION

[1] Nathan Harewood (the Opponent) has opposed registration of the trademark DOMIN8 (the Mark), which is the subject of application No. 2,061,672 in the name of Fit Foods Ltd. (the Applicant).

[2] On June 19, 2025, the Applicant requested an interlocutory ruling to strike the ground of opposition based upon section 38(2)(f) of the *Trademarks Act*, RSC 1985 c T-13 (the Act). The Applicant also sought an extension of time to submit and serve its counter statement.

[3] By way of Office letter of June 23, 2025, the Registrar invited the Opponent to make its submissions in respect of the Applicant's request. In response, on June 24, 2025, the Opponent requested leave to file an amended statement of opposition and made submissions regarding the Applicant's request.

[4] By way of Office letter of June 26, 2025, the Registrar invited the Applicant to advise if it had any objections to the statement of opposition being amended as proposed by the Opponent. On July 8, 2025, in order "to respond meaningfully", the Applicant requested clarification of the new ground of opposition pleaded in the proposed amended statement of opposition. On July 9, 2025, the Opponent requested leave to file a further amended statement of opposition addressing the Applicant's request.

[5] By way of Office letter of July 11, 2025, the Registrar invited the Applicant to advise if it had any objections to the statement of opposition being further amended as proposed by the Opponent. No response to the Office letter has been received from the Applicant.

LEAVE TO AMEND THE STATEMENT OF OPPOSITION

[6] I am satisfied that it is in the interests of justice to grant the Opponent leave to amend the statement of opposition as requested on July 9, 2025. Suffice it to say that the amendments sought are in direct response to the issues raised by the Applicant and that there is no appreciable prejudice to the Applicant in allowing them.

[7] Accordingly, and pursuant to section 48 of the *Trademarks Regulations*, SOR/2018-227, the Opponent's request for leave is granted, and the amended statement of opposition dated July 9, 2025 is made of record. The Applicant's request will therefore be considered in relation to this amended statement of opposition.

THE SCOPE OF INTERLOCUTORY RULINGS

[8] The sufficiency of a statement of opposition is governed by section 38 of the Act. Section 38(2) of the Act comprises an exhaustive list of the grounds upon which an opposition may be based. Section 38(3)(a) of the Act requires grounds of opposition to be set out in sufficient detail so as to

enable an applicant to reply. An insufficient ground of opposition would therefore be one that either alleges an improper ground of opposition or does not contain sufficient material facts to allow an applicant to reply.

[9] A proper pleading alleges the material facts but not the evidence which the party intends to adduce to establish those facts [see *Pepsico Inc and Pepsi-Cola Canada Ltd v Registrar of Trade-marks* (1975), 22 CPR (2d) 62 (FCTD)]. Further, it is not the purpose of an interlocutory ruling to determine whether a valid ground of opposition has a reasonable prospect of success, but rather whether it contains sufficient material facts.

[10] Section 38(6) confers upon the Registrar the ability to strike all or part of a statement of opposition.

RULING

[11] In summary, the Applicant requests that the ground of opposition raised under section 38(2)(f) of the Act be struck in its entirety because: (1) it is improperly pleaded and duplicative of the section 38(2)(c) ground of opposition; and (2) to the extent that it is not found to be duplicative or improperly framed, the pleading assumes findings of law and fails to disclose sufficient material facts for the applicant to respond thereto. The Applicant also submits that “the reference to ‘registered trademarks’ allegedly infringed, passed off or depreciated is vague and unspecified”.

[12] The ground of opposition as amended, identifying the registered trademarks relied upon by the Opponent, addresses the Applicant’s representations with respect to the vague and ambiguous reference to “registered trademarks” in the original ground of opposition.

[13] Section 38(2)(f) of the Act addresses an applicant’s lawful entitlement to use the applied-for trademark. The analogous provision under the Act, as

it read prior to June 17, 2019 (the Old Act), is section 30(i). As is often the case, the jurisprudence under section 30(i) of the Old Act is instructive in assessing the Opponent's pleading here.

[14] For the reasons set out below, the request to strike the ground of opposition is refused in part. More particularly, the request to strike the portion of the ground relating to sections 7 and 22 of the Act is refused, while the request to strike the portion of the ground relating to sections 19 and 20 of the Act is accepted.

Use contrary to sections 19 and 20 of the Act

[15] Under section 30(i) of the Old Act, grounds of opposition alleging use contrary to sections 19 and/or 20 were considered duplicative and improper [see *Standard Products Inc v TRUMPF GmbH + Co KG*, 2015 TMOB 199 at paras 10-11] and were regularly struck at the pleadings stage. The same reasoning applies to legal entitlement under section 38(2)(f) of the Act [*Industria de Diseño Textil, SA v Sara Ghassai*, 2024 TMOB 150 at para 38].

[16] In the present case, I find that the ground of opposition alleging use that contravened sections 19 and 20 is duplicative in that its success is premised on a finding of confusion required in respect of the registrability and entitlement grounds. The statement of opposition does not contain facts that might explain why the Opponent must rely on sections 19 and 20 of the Act in addition to the sections 12(1)(d) and 16(1)(a) grounds of opposition [*10859036 Canada Inc v Defiant Supply Inc.*, 2025 TMOB 24 at para 16].

[17] Accordingly, the term "infringement" and the reference to sections 19 and 20 in the ground of opposition, as amended, are hereby struck.

Use contrary to Section 7 of the Act

[18] Pleadings acceptable under this ground should comprise material facts, which, if proven, would establish the three elements described by the Federal Court in *Diageo Canada Inc v Heaven Hill Distilleries Inc*, 2017 FC 571, namely goodwill, public deception due to misrepresentation and actual or potential damage.

[19] I find the ground based on sections 38(2)(f) and 7 of the Act, when read in the context of the statement of opposition as a whole, is sufficiently particularized. Indeed, the Opponent has alleged goodwill associated with its trademarks and confusion which, if established, would fulfill the requisite misrepresentation element of the test [*Sadhu Singh Hamdard Trust v Navsun Holdings Ltd*, 2016 FCA 69 at para 21]. Finally, given these alleged facts, I consider that an allegation of actual or potential damage to the Opponent is implied, which if proven would meet the third requirement.

[20] Accordingly, I decline to strike the portion of the amended ground of opposition relating to section 7 of the Act.

Use contrary to Section 22 of the Act.

[21] Section 22 of the Act requires four elements [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23]. Use of the registered trademark is a requirement, as is the trademark being sufficiently known for significant goodwill to have attached. Additionally, there must exist a connection, linkage or mental association in the mind of the hypothetical consumer between an opponent's goodwill and the applicant's use. Finally, a likelihood of depreciation is necessary.

[22] The Opponent has alleged prior use of its registered trademarks. It has also alleged depreciation of the goodwill in its registered trademarks. Its

allegations of a likelihood of confusion may imply the possible existence of a connection, linkage or mental association in a consumer's mind.

[23] Appropriate evidence will, of course, ultimately be required to meet the Opponent's burden of establishing a *prima facie* case of contravention of section 22. However, for now, when the statement of opposition is read as a whole, I find the ground based on sections 38(2)(f) and 22 of the Act to plead the necessary material facts and be sufficiently particularized for the Applicant to respond thereto.

[24] Accordingly, I decline to strike the portion of the amended ground of opposition relating to section 22 of the Act.

APPLICANT'S DEADLINE TO FILE ITS COUNTER STATEMENT

[25] Finally, pursuant to its request, the Applicant is hereby granted one month from the date of this Interlocutory Ruling to submit and serve its counter statement.

Céline Tremblay
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Agents of Record

For the Opponent: MLT AIKINS LLP

For the Applicant: PALMER IP INC.