



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2017 TMOB 156

Date of Decision: 2017-11-22

IN THE MATTER OF AN OPPOSITION

This and That Canine Company Inc.

Opponent

and

2347539 Ontario Inc.

Applicant

1652243 for CHEW-THAT & Design

Application

INTRODUCTION

[1] This and That Canine Company Inc. (the Opponent) opposes registration of the trade-mark CHEW-THAT & Design, as illustrated below (the Mark), filed by 2347539 Ontario Inc. d.b.a. Chew-That (the Applicant):



[2] For the reasons that follow, I reject the opposition.

THE RECORD

[3] On November 15, 2013 the Applicant filed the application bearing serial No. 1,652,243.

[4] The application covers the following goods and services:

(1) Reusable canned pet food lids

(2) Pet training devices, namely clickers and leashes

(3) Pet leashes

(4) Promotional items, namely t-shirts, hooded sweat shirts, crew shirts, pens, coffee mugs, posters, flags, baseball hats and jackets

(collectively referred to as the Goods);

(1) Pet food and pet accessory retail stores (the Services).

[5] The application is based on use and proposed use as detailed hereinafter:

Used in Canada since at least as early as April 25, 2013 on goods (1);

Used in Canada since at least as early as April 26, 2013 on goods (2);

Used in Canada since at least as early as May 10, 2013 on goods (3);

Used in Canada since at least as early as April 2013 on Services;

Proposed use in Canada on goods (4).

[6] The application was published on August 26, 2015 in the *Trade-marks Journal* for the purposes of opposition.

[7] The Registrar received the Opponent's statement of opposition on September 8, 2015. The grounds of opposition pleaded are based on sections 30(b), (d), (h), and (i) (requirements), 12(1)(d) (registrability), 16(1) and (3) (entitlement) and 2 (distinctiveness) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[8] The Applicant filed a counter statement on November 10, 2015 in which it denied each ground of opposition pleaded by the Opponent.

[9] The Opponent filed as its evidence the affidavit of Mitchell Benjamin Burko sworn March 2, 2016, while the Applicant filed as its evidence the affidavits of Dominique Girard-Witts, sworn April 5, 2016 and Shannon Giust, sworn June 7, 2016.

[10] The Opponent filed as reply evidence a certified copy of registration No. TMA898,468 for the trade-mark THIS & THAT CANINE CO., registered in the name of the Opponent.

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

[12] Both parties filed written arguments and no hearing was held.

EVIDENTIARY BURDEN

[13] The legal onus is on the applicant to show that the application complies with the provisions 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. Once this initial burden is met, the applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd et al v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB), *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD), and *Wrangler Apparel Corp v The Timberland Company* [2005] FCJ No 899, (FC)].

MATERIAL DATES

[14] The material dates that apply to the grounds of opposition raised are as follows:

- sections 38(2)(a)/30 – the filing date of the application (November 15, 2013) [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- sections 38(2)(b)/12(1)(d) – the date of the Registrar’s decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 at 424 (FCA)];
- sections 38(2)(c)/16(1) – the various claimed date of first use;
- sections 38(2)(c)/16(3) – the filing date of the application (November 15, 2013); and
- sections 38(2)(d)/2 – the filing date of the statement of opposition (September 8, 2015) [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185].

PRELIMINARY REMARKS

[15] In reaching my decision I have considered all the evidence in the file. However, I shall refer only those portions of the evidence which are directly relevant to the issues discussed in the body of my decision.

THE OPPONENT'S EVIDENCE

[16] Mr. Burko has been the Opponent's Director of Operations since its incorporation, namely November 17, 2009. He states that the Opponent has been, since that date, in the business of manufacturing, distributing and selling pet products for use by pet owners. He states that "the products are sold to Canadian pet supply distributors who wholesale them to Canadian pet supply retailers, to third party independently owned pet specialty stores and third party franchised pet specialty stores and via the Opponent's online retail store."

[17] Mr. Burko affirms that the Opponent is the owner of the trade-mark CHEW THIS, which was registered on the Canadian Trade-marks register on May 7, 2013 under registration number No. TMA850,371. The registration covers dog chews; dog treats namely edible dog treats and dog toys (the Opponent's goods). A certified copy of that registration is annexed to Mr. Burko's affidavit as Exhibit 1.

[18] Mr. Burko provides the annual sales figures (in dollars and units sold) of the Opponent's products bearing its trade-mark CHEW THIS for the years 2013 to 2015 inclusive which vary from approximately 1.35 million dollars to over 1.6 million dollars representing a total of more than 550,000 units sold during that period.

[19] To substantiate the fact that the Opponent has been offering for sale, advertising and selling the Opponent's goods, Mr. Burko provides the following material:

- Splash pages from websites of the Opponent's clients which show these clients carrying and offering for sale the Opponent's goods in association with the trade-mark CHEW THIS (Exhibit 2);
- Invoices to representative clients for each of the years 2013, 2014 and 2015 for the sale of the Opponent's goods in association with its trade-mark CHEW THIS (Exhibit 3);
- Photographs showing the Opponent's packaged goods in retail stores in Canada bearing the trade-mark CHEW THIS (Exhibit 4);

- Splash pages of the Opponent’s website for the retail sale of the Opponent’s goods bearing the trade-mark CHEW THIS (Exhibit 5).

[20] Mr. Burko states that, within an approximate 25 kilometer radius of the Applicant’s retail store located at 665 Earl Armstrong Rd. in the Ottawa area, there are 45 pet specialty stores that sell the Opponent’s goods in association with the trade-mark CHEW THIS.

[21] Mr. Burko filed, as Exhibit 7, a Google map printout showing the Applicant’s retail store location and those 45 pet specialty stores together with a list of each one of those stores and their municipal street addresses in the Ottawa area.

[22] Mr. Burko states that the Opponent had a booth at various trade shows specializing in reaching the pet supply market and provides as Exhibit 8 a page from their websites. He further alleges that, during the Ottawa Pet Expo, both the Applicant and the Opponent had their booths in the same aisle.

THE APPLICANT’S EVIDENCE

Affidavit of Dominique Girard-Witts

[23] Ms. Witts has been a paralegal at the Applicant’s agent firm. She states that on March 29, 2016 she obtained dictionary definitions for the word “CHEW” from the online versions of *Merriam-Webster* and *Cambridge* dictionaries. Those definitions have been attached as Exhibits A and B to her affidavit.

[24] Ms. Witts, on the same day, performed advanced searches on the Canadian Intellectual Property (CIPO) website for active trade-mark applications and registrations including the word and wildcard (TM Lookup) “Chew” in association with dog, cat or animal or pet and she filed the results of such search as Exhibit C to her affidavit.

[25] Also on the same day, she visited and printed webpages advertising various products in Canada in association with the following trade-marks:

- CHEW TIME (Exhibit D)
- CHEWMASTERS (Exhibit E)
- CHEW-RIFIC (Exhibit F)

- CHEW-EEZ (Exhibit G)
- TRUE CHEWS (Exhibit H)
- CHEW-LOTTA (Exhibit I)
- CHEW’N CLEAN (Exhibit J)
- CHEWS (Exhibit K)
- BIG CHEW (Exhibit L)
- SUPER CHEW (Exhibit M)
- DENTAL CHEW (Exhibit N)
- CABIN CHEWS (Exhibit O)
- FLOSSY CHEWS (Exhibit P)
- BRUSHING CHEWS (Exhibit Q)
- TRIPLE CHEW (Exhibit R)
- NATURE’S CHEWS (Exhibit S)
- ORA-CHEW (Exhibit T)

[26] Then, on March 30, 2016, Ms. Witts purchased the abovementioned products from various retailers and she filed, as corresponding Exhibits D1 to T1 respectively, a photograph of each product purchased, together with a copy of the receipt for each one of them.

Affidavit of Shannon Giust

[27] Ms. Guist describes herself as the operator and owner of the Applicant which was incorporated on October 26, 2012 and registered the business name CHEW-THAT in Ontario on February 13, 2013.

[28] Ms. Guist states that the Applicant has been operating a pet food and pet accessory retail store at 665 Earl Armstrong Rd in Ottawa (the “retail store”) continuously since April 25, 2013.

[29] Ms. Guist affirms that the Mark has been continuously used in association with pet food and pet accessories retail store services from the store’s opening on April 25, 2013 and she filed as Exhibit B various images of the store and its storefront.

[30] Ms. Guist states that the Applicant has been operating a website at *www.chew-that.ca* since 2013 to promote the Services and she filed as Exhibit C a copy of its homepage. She also filed as Exhibit D sampling of posts from the Applicant’s Facebook page posted between 2013 and 2016 and as Exhibit E a copy of the Applicant’s Twitter page.

[31] Ms. Guist lists nine events, held in Canada between June 2013 and June 2016, during which the Applicant promoted its Services and states that a banner on which appeared the Mark was prominently displayed and she filed as Exhibit G various pictures of display booths, the events themselves, participant badges and advertisement material displaying the Mark.

[32] Ms. Guist affirms that the Applicant has appeared as an expert guest on the television program CTV Morning Live on several occasions, which she states is Ottawa's top morning show. Some of these appearances can still be viewed by Canadians at CTV News Ottawa's website and she filed as Exhibit H screenshots of webpages of that website.

[33] Ms. Guist states that the Applicant has advertised its services in local magazines and newspapers, on billboards, by using brochures distributed to residential area, and by sponsoring events. She filed as Exhibit I sample brochures, advertisements, photographs of billboards and documents illustrating the Applicant's promotional activities and sponsorship events. She provides the amount spent by the Applicant in advertising for the periods of 2014-2015 (over \$8,000) and 2015-2016 (approximately \$13,000).

[34] Ms. Guist states that there are over 4,000 customers registered with the Applicant and she provides the Applicant's sales figures associated with the Mark for the periods of 2013-2014, 2014-2015 and 2015-2016 that vary between an excess of \$300,000 to over \$630,000. She filed, as Exhibit L, the invoice of the first sale of can lid displaying the Mark and a picture of the product sold. She filed other invoices for each year from 2013 to May 2016 illustrating "sales under the Mark".

[35] Ms. Guist filed as Exhibit S1 a report generated by her "sales software, Smart Vendor" detailing all products' names containing the word CHEW sold by the Applicant since April 25, 2013. The report is 70 pages long. That list includes the Applicant's sales of Goods bearing the Mark as well as the sales of third parties' products.

[36] Ms. Guist provides a list of six suppliers selling over 25 "CHEW products" and she filed invoices or brochures of those suppliers.

[37] Ms. Guist affirms that on April 29, 2016 she purchased at Bulk Barn a product sold in association with the trade-mark ANTLER CHEWS and filed as exhibit Z a photograph of that product as well as a copy of the receipt.

[38] Finally, Ms. Guist states that she is not aware of a single instance of confusion between the Opponent's products sold in association with its trade-mark CHEW THIS and the Mark, and/or the Applicant's business, services and products.

THE OPPONENT'S REPLY EVIDENCE

[39] As reply evidence, the Opponent filed a certified copy of registration TMA898,468 for the trade-mark THIS & THAT CANINE CO. registered in the name of the Opponent.

[40] In its written argument the Applicant asserts that the Opponent's reply evidence is inadmissible as such trade-mark registration was not cited as a basis of a ground of opposition in the Opponent's statement of opposition. Moreover, the Applicant asserts it also does not constitute proper reply evidence as it was not strictly confined to matters in reply to the evidence contained in the Applicant's affidavits.

[41] I agree with the Applicant that proof of the existence of registration TMA898,468 does not constitute evidence of reply to any of the allegations contained in the Applicant's evidence. Moreover, the Opponent has not referred to such registration in its statement of opposition.

[42] Consequently, I am disregarding the Opponent's reply evidence. In any event, if I had not disregard such evidence, it would not have impacted my decision.

GROUND OF OPPOSITION SUMMARILY DISMISSED

Ground of opposition based on section 30(b)

[43] The Opponent pleads that the Mark was not in use on the respective claimed dates of first use. It has not filed any evidence that would support such ground of opposition. However, the Opponent may rely on the Applicant's evidence to meet its light evidential burden under this ground of opposition [see *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10

CPR (3d) 8 (TMOB) and *Labatt Brewing Company v Molson Breweries, Partnership* (1996), 68 CPR (3d) 216 (FCTD)].

[44] There is nothing in the Applicant's evidence that would put into issue the various claimed dates of first use of the Mark.

[45] However, the Opponent has pleaded that any use of the Mark in association with the Services "has been in relation to only a single retail store on that date and therefore not more than one retail store on that date as the statement of services states due to the use of the plural form of the word 'store' in the statement of services".

[46] By analogy I can refer to the *Interpretation Act*, R.C.S., 1985, c. I-21, and in particular to section 33(2) which reads:

Words in the singular include the plural, and words in the plural include the singular.

[47] Consequently the fact that 'stores' is written in plural has no consequence on the claimed date of first use of the Mark in association with the Services as the evidence shows that the Applicant has been operating a retail store in association with the Mark since the claimed date of first use mentioned in its application.

[48] In any event, the Opponent has not presented, in its written argument, any arguments that would substantiate such position.

[49] Consequently, this ground of opposition is dismissed.

Grounds of opposition based on sections 30(d) and (h) of the Act

[50] The Opponent pleads:

The Applicant's application does not conform to the requirements of Sections 30(d) and (h) in that the trademark allegedly used is not the applied-for trademark covered by the opposed application.

[51] As indicated in the Applicant's written arguments, section 30(d) of the Act has no application to this case as it relates to applications filed on the basis of use and registration abroad, which is not our situation.

[52] As for section 30(h), the only requirement specified therein is that for a design mark, the application must contain a drawing in the prescribed form of the mark applied-for. Again, there is no evidence in the record that the Applicant has not fulfilled such requirement.

[53] Finally, the evidence filed by the Applicant shows that it has used the Mark as applied for and consequently these grounds of opposition are dismissed.

Ground of opposition based on Section 30(i) of the Act

[54] An opponent may rely on section 30(i) in specific cases such as where bad faith on the part of the applicant is alleged [see *Sapodilla Co Ltd v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. There is no allegation to that effect in the statement of opposition or evidence of bad faith on the part of the Applicant in the record. Finally, the Opponent has not provided any arguments with respect to this ground of opposition.

[55] Consequently, this ground of opposition is also dismissed.

Ground of opposition based on sections 50 and 2 of the Act (distinctiveness)

[56] The Opponent pleads in its statement of opposition that the Mark is not distinctive having been used outside the scope of Section 50 of the Act.

[57] Again, there is no evidence in the record that would support such contention. Moreover, in its written argument the Opponent is silent on this issue.

[58] Again, this ground of opposition is dismissed.

ANALYSIS OF THE REMAINING GROUNDS OF OPPOSITION

Registrability of the Mark under section 12(1)(d) of the Act

[59] As mentioned previously, Mr. Burko filed, as Exhibit 1, a certified copy of registration TMA850,371 for the trade-mark CHEW THIS.

[60] I checked the register and it is extant. It covers the following goods: dog chews; dog treats namely edible dog treats and dog toys (the Opponent's goods).

[61] Therefore, the Opponent has met its initial burden with respect to this ground of opposition.

[62] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trade-marks are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks or trade names have been in use; the nature of the goods, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC), *Mattel Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 96 CPR (4th) 361 (SCC)].

[63] The test under section 6(2) of the Act does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether a consumer, with an imperfect recollection of the Opponent's trade-mark CHEW THIS, who sees the Applicant's Goods and Services in association with the Mark, would think they emanate from, or are sponsored by, or approved by the Opponent.

Inherent distinctiveness of the marks and the extent to which they have become known

[64] The Opponent's trade-mark is made up of two common English words. As pointed out by the Applicant the word CHEW is commonly used in association with dog chews and dog treats. I will elaborate on this point when I analyze the state of the register and of the marketplace evidence.

[65] In the *Merriam-Webster Dictionary* the word "chew" is defined as "to crush, grind or gnaw (as food) with or as if with teeth" and provides the following example "The dog chewed a hole in the rug". In the *Cambridge English Dictionary* the word "chew" is defined as "to crush food into smaller, softer pieces with the teeth so that it can be swallowed" and provides the

following examples: “The dog was chewing happily on the bone” and “His dog has chewed my slippers” [see Exhibits A and B to Ms. Witts’ affidavit].

[66] I used my discretion to consult dictionaries and consulted the *Canadian Oxford English Dictionary* [see *National Laser Products Ltd v Canada (Registrar of Trade Marks)* (1976), 28 CPR (2d) 59 (FCTD)] where it is mentioned that it is also used as a noun to refer to something that is intended to be chewed (for example, candy or tobacco).

[67] Therefore, the Opponent’s trade-mark CHEW THIS has a low degree of inherent distinctiveness when used in association with the Opponent’s goods, as it is highly suggestive of their character and quality, i.e. that they are intended to be chewed.

[68] As for the Mark, it is a composite mark comprising several words/phrase components, namely “PET FOOD”, “CHEW-THAT”, and “TOYS GALORE”, and a design component, namely a black head of a cat with whiskers, a bone overlaying a portion of the cat head, and the whiskers of the cat appearing on each side of the bone.

[69] The components “PET FOOD” and “TOYS GALORE” are descriptive and the design portion is suggestive. However, the design portion of the Mark makes the Mark as a whole more inherently distinctive than the Opponent’s word mark CHEW THIS.

[70] The degree of distinctiveness of a trade-mark can be enhanced through use and promotion in Canada. Despite the fact that the Opponent was incorporated in 2009, Mr. Burko provides evidence of use of the trade-mark CHEW THIS only for the years 2013, 2014 and 2015. There is no indication in Mr. Burko’s affidavit that the Opponent has used its trade-mark prior to 2013. The Opponent’s sales of goods in association with the trade-mark CHEW THIS have been in excess of 1.3 million dollars annually between 2013 and 2015 inclusive.

[71] Mr. Burko has not provided much detail on the scope of promotion and marketing of goods sold in association with the mark CHEW THIS. There is reference to the Opponent’s website but there is no information on the number of visitors of such website. There is also reference to an eNewsletter sent to clients and friends but we do not know the extent of such distribution. Finally, Mr. Burko has mentioned that the Opponent has attended trade shows in Ottawa, Toronto, and Calgary and in British Columbia.

[72] Accordingly, I conclude that the Opponent's trade-mark CHEW THIS has acquired some distinctiveness through its use and promotion at trade shows in Canada.

[73] As for the Mark, Ms. Giust provided the annual revenues from the Applicant's services in association with the Mark which vary from over \$300,000 in 2013-2014 to over \$630,000 in 2015-2016. Those revenues are inferior to those of the Opponent during approximately the same period of time. Ms. Guist also provided information on how the Applicant has been advertising the Mark, including appearances on television programs, distribution of brochures in residential area, advertisements in local newspapers, on billboards, attendance at trade shows and through event sponsorships. She provided the amounts spent by the Applicant to promote the Mark, which totalled over \$20,000 from 2014 to 2016. However, we have no information on the number of potential viewers of those television programs; the participation to trade shows and events seems to be limited to the Ottawa region; we have no information on the extent of the distribution of brochures at those various events; and finally, we have no information on the location of the billboards.

[74] In all, I conclude that the Mark is also known in Canada but in the Ottawa area only.

[75] Overall, this first factor favours slightly the Applicant as the Mark is more inherently distinctive than the Opponent's trade-mark CHEW THIS and, despite the fact that such mark has acquired some distinctiveness because of the sales figures of the Opponent's goods, such slight advantage in the sales figures is not sufficient to overcome the combination of the inherent distinctiveness of the Mark and its acquired distinctiveness through its use and promotion during the same period of time.

Length of time the trade-marks have been in use

[76] The Opponent argues that it has been using its trade-mark CHEW THIS since 2009. Registration TMA850,371 has been issued on the basis of use of that mark since 2009. There is no evidence of use of the trade-mark CHEW THIS between 2009 and 2012 inclusive. It has been determined that a registration alone entitles me to assume only *de minimis* use [*Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB) at 430]. Such *de minimis* use is not sufficient to create a clear advantage to the Opponent.

[77] Given that there is evidence of use by both parties of their respective marks since 2013, this factor does not favour either of the parties.

The nature of the goods and services

[78] When considering the nature of the parties' goods and business, I must compare the goods and services as described in the application with the goods covered by the Opponent's registration [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 at 10-11 (FCA); *Henkel Kommanditgesellschaft v Super Dragon* (1986), 12 CPR (3d) 110 at 112 (FCA); *Miss Universe Inc v Dale Bohna* (1994), 58 CPR (3d) 381 at 390-392 (FCA)]. However, those statements must be read with a view to determine 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 [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[79] The Applicant argues that the Opponent's registration does not cover any services. Moreover, it argues that the Opponent does not sell its goods directly to customers from a physical retail store. It sells its goods to pet supply distributors who wholesale their products to Canadian pet supply retailers, as well as via its website.

[80] Moreover, the Applicant contends that the parties' goods are different. It takes the position that its goods are promotional items ancillary to the Applicant's Services, namely, reusable canned pet food lids (goods (1)), pet training devices, namely clickers and leashes (goods (2)), pet leashes (goods (3)), as well as what has been described as promotional items, namely t-shirts, hooded sweat shirts, crew shirts, pens, coffee mugs, posters, flags, baseball hats and jackets (goods (4)).

[81] Except for goods (4), I do not see the other goods described above as promotional items. The Applicant has specifically enumerated what it considers to be promotional items and excluded goods (1), (2) and (3) from such category.

[82] Except for goods (4), I agree with the Opponent that the Goods overlap the Opponent's goods as they fall in the general category of pet products for use by pet owners that will ultimately be sold in pet stores.

[83] Concerning the goods (4), even though, from their description, they appear to be different than any of the Opponent's goods, they are ancillary to the Applicant's Services.

[84] As for the Services, their description speaks for itself: pet food and pet accessory retail stores. There is a close connection between them and the Opponent's goods. In fact, the evidence shows that the Opponent's goods are sold in retail stores selling pet food.

[85] Despite differences between the Applicant's Services and the Opponent's goods, I am of the opinion that there is some connection between them given their respective nature.

[86] Therefore, the factor described in section 6(5)(c) of the Act favours the Opponent.

Nature of Business and Trade

[87] The Applicant's business is the operation of pet retail stores and the sale of pet products while the Opponent is in the business of selling pet food and toys to be offered for sale in pet stores. The Opponent sells its pet products to pet supply distributors, to third party independently owned pet specialty stores, to third party franchised pet specialty stores and to consumers directly through its website, while the Applicant does business with consumers from a physical location. There is no indication that the Applicant sells the Goods via the Internet. As a result, there is a difference in the nature of the parties' trade.

[88] Even though the parties' goods will eventually reach the end consumer, the nature of the parties' businesses is different. This factor favours the Applicant.

Degree of resemblance

[89] As indicated by the Supreme Court of Canada in *Masterpiece*, in most instances, the degree of resemblance between the marks in issue is the most important relevant factor. One must consider the degree of resemblance between the marks in issue from the perspective of appearance, sound and in the ideas suggested by them. Moreover, it stated that the preferable

approach when comparing trade-marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique. It is not the proper approach to set the marks side by side and to critically analyze them to find similarities and differences.

[90] As described in the Opponent's written submissions, the Mark is comprised of the words "CHEW-THAT", a fanciful design element consisting of the head of a cat, a bone with whiskers, as well as the additional word elements "pet food" and "toys galore", in smaller font, above and below the design portion of the Mark.

[91] The Opponent's contention is while both marks comprise the first word CHEW, the Opponent's mark also comprises the word element THIS while the Applicant's Mark comprises the word THAT. The Opponent argues that the expression "this and that" has a dictionary definition which means "various things". It adds that it is an expression where the two words go together much like the phrases "eat this-eat that", "drink this-drink that", or "pick this-pick that". Consequently, the Opponent submits that, notwithstanding the design portion of the Mark, there is a cohesive similarity between the Opponent's trade-mark CHEW THIS and the Applicant's trade-mark CHEW-THAT & Design.

[92] I wish to point out that there is no evidence of dictionary definition for the expression "this and that". However, I used my discretion and consulted the *Canadian Oxford Dictionary* and the expression "this and that" is defined as "various unspecified things".

[93] The dominant feature of the Mark is the word portion CHEW THAT written inside a bone design and a silhouette of a cat. There is also the presence of other descriptive expressions: "pet food" and "toys galore".

[94] As for the ideas suggested by the parties' marks, the Mark as a whole suggests that pet food could be found in its pet retail stores while the expression "toys galore" suggests that the one can find in the Applicant's retail pet stores a lot of toys.

[95] Despite the presence of the common element CHEW and perhaps the cohesive similarity between THIS and THAT, overall the parties' marks differ in sound, visually and in the ideas suggested by them.

[96] The Applicant argues that when trade-marks contains a common element which is also contained in a number of other trade-marks, purchasers pay more attention to the other features of the marks, and distinguish them by those features. I will discuss such argument in the context of the state of the register and marketplace evidence.

[97] Overall, this factor favours the Applicant.

State of the register and of the marketplace

[98] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [see *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)]. Inferences about the state of the marketplace can only be drawn from state of the register evidence where a large number of relevant registrations have been located [see *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

[99] Ms. Witts has located at least 15 trade-marks on the register that include the word CHEW or derivatives for dog chews, dog toys, dog treats and retail sales of pet products, including: CHEW TIME, PET CHEWZ, TRUE CHEWS, TOP CHEWS, POWER CHEW, CHEW-EEZ, CHEWY BITS, CHEW-RIFIC, SMART CHEW, CABIN CHEWS, CHEWMASTERS, ULTIMATE CHEW, STEAKCHEW, CHEW-A-TREAT and CHEW-LOTTA [see Witts affidavit, Exhibit C].

[100] Moreover, the Applicant's evidence includes purchases from third parties selling pet toys, dog chews, and dog treats in Canada using the term CHEW or derivatives thereof, including CHEW TIME, CHEWMASTERS, CHEW-RIFIC, CHEW-EEZ, TRUE CHEWS, CHEW-LOTTA, CHEW'N CLEAN, CHEWS, BIG CHEW, SUPER CHEW, DURA CHEW, DENTAL CHEW, CABIN CHEWS, FLOSSY CHEWS, BRUSHING CHEWS, TRIPLE CHEW, NATURE'S CHEWS, ORA-CHEW AND ANTLER CHEWS [see Witts affidavit, paragraphs 4 and 5, Exhibits D to T1 and Guist affidavit, Exhibit Z].

[101] Finally, the Applicant itself sells products at its store, originating from various suppliers, in association with product names which incorporate the word CHEW including:

- Pet Science Ltd.: ANTLERCHEWZ
- Freedom Pet Supplies: CHEWMASTER, DUCK CHEWS, CHEWZZIES CHEWY TREATS, DEER CHEWS, RABBIT CHEWS, CHICKEN CHEWS, CHEW N CLEAN, CRISPY CHEWS, CHILLY CHEWS, PERFECT CHEW, KAYTEE CHEWS, PRO ACTION DENTAL CHEW, DURA CHEW, DURA CHEW PLUS, FLEXIBLE CHEWS, CHEW GUARD, Z-BONE® DENTAL CHEWS, SUPER CHEW, CHEWBIES and CHEWY'S
- Kane Pet Supplies: JONES NATURAL CHEWS, HIMALAYAN CHEWS, MARROWCHEWS
- MJM Unique Pet Supplies Ltd: TIBETAN DOG CHEW

[102] In view of the state of the register and the state of the marketplace evidence, I conclude that Canadian consumers are accustomed to see marks with the component CHEW in association with pet products. Therefore, they pay more attention to the other features of the marks and distinguish them by those features [see *Maximum Nutrition Ltd, op cit*]. In our case, those additional features of the Mark described above enable the consumer to distinguish the parties' marks.

[103] Therefore the state of the register and of the marketplace evidence is a relevant factor favouring the Applicant.

No instances of confusion

[104] Mr. Burko filed, as Exhibit 7, a Google map printout showing the Applicant's retail store location as well as the location of 45 pet specialty stores that sell the Opponent's aforesaid goods located within an approximate 25 kilometers radius of the Applicant's retail store.

[105] Despite such proximity of stores selling the Opponent's products, Ms. Guist affirms that she has no personal knowledge of a single instance of confusion between the Opponent's goods sold in association with the trade-mark CHEW THIS and the Applicant's business, services and products sold in association with the Mark.

[106] The Supreme Court of Canada in *Mattel, op cit*, has stated that the absence of actual confusion in the marketplace may be a relevant or even significant surrounding circumstance to consider when deciding if there is a likelihood of confusion between the marks.

[107] In our situation, the absence of evidence of actual confusion, despite the proximity of the Applicant's retail store to other pet stores that sell the Opponent's CHEW THIS products and the concurrent use of the parties' marks over a period of more than three years, confirms my conclusion that there is no likelihood of confusion between the marks in issue.

Conclusion

[108] From this analysis of all the relevant criteria, I conclude that the Applicant has satisfied its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's registered trade-mark CHEW THIS.

[109] I reach this conclusion despite the fact that the parties' goods and services overlap or are connected and that the marks in issue have a common component, namely, CHEW, and the cohesive similarity between the words THIS and THAT, as overall there are differences in the marks in sound, in the ideas suggested and visually. Moreover, the common component CHEW is also common to many trade-marks on the register and a component of many names of related products sold in Canada.

[110] Finally, the absence of evidence of actual confusion between the marks, despite their concurrent use in relative close proximity in the Ottawa region, supports my finding that, on the basis of balance of probabilities, there is no likelihood of confusion between the parties' marks.

[111] Accordingly, I dismiss this ground of opposition.

Entitlement Grounds of opposition (Sections 16(1) and (3) of the Act)

[112] As mentioned above, these grounds of opposition must be assessed at the various claimed dates of first use (section 16(1)) or at the filing date of the application (section 16(3)). Those dates vary from April 25, 2013 to November 13, 2013. The difference in the various dates will

not have an impact on the following analysis. I will review the evidence as of April 25, 2013, namely the earliest relevant date.

[113] In order to succeed under these grounds of opposition, the Opponent had to establish that it had used its trade-mark CHEW THIS prior to April 25, 2013 and that it had not abandoned such use at the advertisement date of the present application (August 25, 2015) [see section 16(5) of the Act].

[114] The mere filing of a certificate of registration does not establish use of an opponent's trade-mark [see *Rooxs Inc v Edit-SRL* (2002, 23 CPR (4th) 265 (TMOB)]. Yet, Mr. Burko filed invoices as Exhibit 3 to support his allegation that the Opponent's sold goods in association with its trade-mark CHEW THIS. The earliest invoice filed is dated March 6, 2013. There is also an invoice dated December 11, 2015.

[115] As such, the Opponent has met its initial burden. Therefore, the burden shifts on the Applicant to prove, on a balance of probabilities, that there was no reasonable likelihood of confusion between the Mark and the Opponent's trade-mark CHEW THIS on April 25, 2013.

[116] The difference in the relevant dates with the previous ground of opposition (date of my decision) would have an impact in my analysis of the following relevant criteria: the extent to which the Mark was known at such dates, the state of the register and of the marketplace evidence, and the absence of evidence of actual instances of confusion. I shall therefore only review those criteria, since for the others, my analysis made previously is applicable *mutatis mutandis*.

The extent to which the marks were known as of the relevant date

[117] Mr. Burko does not provide any sales figures of the Opponent's goods bearing the trade-mark CHEW THIS prior to April 25, 2013. Those provided are for the entire year 2013. However, there are three invoices filed as part of Exhibit 3 that are dated prior to the relevant date. They totalled approximately \$40,000 and represent sales made in Alberta and Ontario.

[118] There is no evidence of use of the Mark by the Applicant prior to April 25, 2013.

[119] Consequently the Opponent's trade-mark CHEW THIS was known to a limited extent at the relevant date. However, whatever advantage it confers on the Opponent, it would not be sufficient, in view of its limited exposure at such date, to be a determinative factor in my analysis of the relevant factors under section 6(5) of the Act.

State of the register and of the marketplace evidence

[120] As for the state of the register evidence, it was conducted after the relevant date. However, there were registrations that were on the register as of April 25, 2013 and therefore, those citations can be taken into consideration. They include the following marks: PET CHEWZ, TRUE CHEWS, POWER CHEW, CHEW-EEZ, CHEWY BITS, CHEW-RIFIC, SMART CHEW, CHEWMASTERS, ULTIMATE CHEW, STEAKCHEW, CHEW-A-TREAT and CHEW-LOTTA [see Witts affidavit, Exhibit C]. Twelve registrations is sufficient to make inferences about the state of the marketplace [see *Maximum Nutrition Ltd*, *supra*].

[121] Despite the fact that I cannot take into consideration the evidence of the state of the marketplace described above, as it postdates the relevant date, the state of the register evidence is still sufficient to draw an inference about the state of the marketplace.

No instances of confusion

[122] As for the absence of evidence of instances of actual confusion, such factor is not applicable at this earlier material date.

Conclusion

[123] Notwithstanding the absence of the state of the marketplace evidence and the absence of evidence of instances of actual confusion at any of the material dates, I still conclude that the Applicant has met its burden to prove, on a balance of probabilities, that the Mark was not likely to cause confusion with the Opponent's trade-mark CHEW THIS, at any of the material dates applicable under these grounds of opposition, for similar reasons set forth under the previous ground of opposition, namely that the differences in the parties' marks are more important than their similarities, and the state of the register evidence establishes that CHEW was a common

element of many trade-marks registered in association with similar goods and/or services such that small differences are sufficient to allow a consumer to distinguish them.

[124] Consequently, the grounds of opposition based on sections 16(1) and (3) of the Act are also dismissed.

Distinctiveness ground of opposition

[125] Under this ground of opposition, the Opponent must show that as of August 26, 2015, the filing date of the statement of opposition, its trade-mark CHEW THIS had become sufficiently known to negate the distinctiveness of the Applicant's Mark. In other words, its trade-mark had to be either well known in at least one part of Canada or widely known in Canada [*Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FCTD)].

[126] I am satisfied that, through the content of Mr. Burko's affidavit, the Opponent has met such requirement. Consequently, the burden shifted on the Applicant who had to show, despite the fact that the Opponent's trade-mark CHEW THIS was known in Canada, the Mark could still serve to distinguish the Goods and Services from the Opponent's goods. The same factors listed in section 6(5) of the Act are used to determine such issue.

[127] The difference in the material dates between the grounds of entitlement under section 16 of the Act and the one applicable to this ground of opposition (August 26, 2015) does not materially alter the analysis I made under the entitlement grounds of opposition.

[128] To the Applicant's advantage, I would have to take into consideration the evidence of use of the Mark between April 2013 and the material date, as well as the fact that there had been no evidence of actual confusion between the marks in issue over a period of concurrent use of more than two years in the same area.

[129] The end result is the same namely, that the Applicant has met its burden to show that the Mark was distinctive at the relevant date and was apt to distinguish the Applicant's Goods and Services from the Opponent's goods sold in association with the trade-mark CHEW THIS.

[130] Accordingly, this ground of opposition is also dismissed.

DISPOSITION

[131] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

AGENT(S) OF RECORD

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FOR THE OPPONENT

MBM Intellectual Property Law LLP

FOR THE APPLICANT