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**Citation: 2020 TMOB 22**

**Date of Decision: 2020-02-28**

**IN THE MATTER OF AN OPPOSITION**

**TMC Distributing Ltd**

**Opponent**

**and**

**Travel Health Group Holding B.V.**

**Applicant**

**1,734,052 for CARE PLUS (Stylized)**

**Application**

INTRODUCTION

[1] TMC Distributing Ltd. (the Opponent) opposes registration of the trademark CARE PLUS (Stylized) (the Mark), which is the subject of application No. 1,734,052 by Travel Health Group Holding B.V. (the Applicant). The Mark is shown below:

*care*  
**PLUS**

[2] Colour is claimed as a feature of the Mark, as follows: the word ‘CARE’ is green. The word ‘PLUS’ is Red.

[3] The Mark is applied for in association with the following goods:

(1) Pharmaceutical and sanitary preparations for the topical treatment of insect bites, insect bite prevention products, namely, insect repellent, mosquito nets, mosquito head nets, mosquito net sheets, impregnated socks and socks for preventing insect and animal bites and stings from animals and insects, trousers, jackets, shirts, caps, hats, caps with neck protection, shoes, boots for protection against insects and animals, mosquito nets, tick removal instruments, namely, tweezers, grabbers, cards, twisters, tick testing apparatus and instruments, namely, a tube containing liquid for testing for Borrelia bacteria, a wooden stick, a pipette, a test cassette, and an informational leaflet, insect bite relief products, namely, high voltage low amp shock meter, insect bite gel, venom extractor, insect bite relief spray, insect repellants.

(2) Pharmaceutical and sanitary preparations for the topical treatment of insect bites, insect bite prevention products, namely, insect repellent, mosquito nets, mosquito head nets, mosquito net sheets, impregnated socks and socks for preventing insect and animal bites and stings from animals and insects, tick removal instruments, namely, tweezers, grabbers, cards, twisters, tick testing apparatus and instruments, namely, a tube containing liquid for testing for Borrelia bacteria, a wooden stick, a pipette, a test cassette, and an informational leaflet, insect bite relief products, namely, high voltage low amp shock meter, insect bite gel, venom extractor, insect bite relief spray, insect repellants; mosquito nets.

(3) Trousers, jackets, shirts, caps, hats, caps with neck protection, shoes, boots for protection against insects and animals.

[4] The opposition is primarily based on an allegation that the Mark is confusing with the trademark CARE+ & Design [the Opponent's Trademark] previously used and/or registered in association with the following goods and services:

- meal replacement drinks, vitamins, minerals, herbal supplements, first aid tape, bandages, hand sanitizers, anti-diarrheal medicines, laxatives, allergy remedies, nasal decongestants, antacids, ibuprofen, acetaminophen and acetylsalicylic acid [the Opponent's Goods];
- provision of information in a written standard format to purchasers of prescription medicines and pharmaceuticals concerning the brand name and generic name of, and allergic reactions, potential drug interactions, health cautions, side effects and usage precautions associated with identified prescribed medicines and pharmaceuticals [the Opponent's Information Services];
- the promotion and operation of a pharmacy [the Opponent's Pharmacy Services].

[5] For the reasons that follow, the application is refused in part.

## THE RECORD

[6] The application for the Mark was filed on June 22, 2015, based on proposed use in Canada with respect to goods (1) and based on registration in the European Union and use in Netherlands with respect to goods (2) and (3).

[7] The application was advertised for opposition purposes on May 18, 2016. Numerous amendments to the *Trademarks Act*, RSC 1985, c T-13 (the Act) came into force on June 17, 2019. As the application was advertised prior to such amendments, pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read immediately before June 17, 2019, an exception being that, with respect to confusion, sections 6(2) to (4) of the Act as it currently reads will be applied.

[8] The Opponent opposed the application on July 7, 2016, by filing a statement of opposition under section 38 of the Act. The grounds of opposition are based on sections 30(d), 30(i), 12(1)(d), 16(2)(a), 16(3)(a) and 2 of the Act, discussed below.

[9] The Applicant filed a counter statement on November 10, 2016, denying each of the grounds of opposition.

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

- Affidavit of Kevin Krug, sworn March 7, 2017 [the Krug Affidavit]; and
- Certified copies of the Opponent's applications for its trademarks CARE+ and design (1,755,724) and CARE+ and design (1,755,725).

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

- Affidavit of Jennifer Leah Stecyk, sworn November 15, 2017 [the Stecyk Affidavit].

[12] Neither affiant was cross-examined on their affidavits. Both parties submitted written representations; an oral hearing was not held.

[13] Before assessing the grounds of opposition, I will first provide an overview of the parties' evidence, the evidential burden on the Opponent, and the legal onus on the Applicant. I will also address the recent change of ownership in the Opponent's Trademark.

#### OVERVIEW OF THE OPPONENT'S EVIDENCE

##### **The Krug Affidavit**

[14] The Krug Affidavit can be summarized as follows:

- Mr. Krug is a Director of Federated Co-operatives Limited (FCL), "a shareholder/owner and manager of the Opponent". In that capacity, Mr. Krug has been directly involved in the management of the Opponent's pharmacy-related trademarks, "including their development and implementation on private label product packaging and in association with services" [para 1].
- When the affidavit was sworn, the Opponent was the Owner of registration No. TMA498,996 for the trademark CARE + & DESIGN (the Opponent's Trademark), registered in association with the Opponent's Information Services [para 2]. The Opponent's Trademark is shown below:



- I note that, pursuant to a change of title registered on October 25, 2019, the registration is now owned by FCL. For ease of reference, I will continue to refer to this mark as the Opponent's Trademark and I will further address the change of ownership below.
- The Opponent's Trademark was acquired from Calgary Co-operative Association Limited (Calgary Co-op) and assigned to the Opponent on July 17, 2002. Since the assignment, the Opponent, through its licensees, has used the Opponent's Trademark in association with the Opponent's Information Services "and, more generally, with the promotion and operation of pharmacies" [paras 3 and 6].

- Prior to the assignment, Calgary Co-op had been using the Opponent's Trademark in association with pharmacy services [para 4]. In particular, Calgary Co-op used the Opponent's Trademark on booklets provided to customers [Exhibit A], prescription information reports [Exhibit B], patient/customer surveys relating to an osteoporosis clinic [Exhibit C], and posters promoting its pharmacy services [Exhibit D] between 1996 and 2001 [para 4].
- The Opponent licenses the right to use the Opponent's Trademark to 26 retail co-operatives owning and operating a collective total of 68 pharmacies located in western Canada, including Calgary Co-op. Pursuant to license agreements, the Opponent maintains control over the character and quality of the services performed or advertised by the licensees in association with the Opponent's Trademark [para 5].
- The Opponent's Trademark is displayed throughout the licensee's pharmacy locations using door stickers and various signs [para 7, Exhibits E and F] and on uniforms worn by pharmacists [para 8, Exhibit G].
- Mr. Krug attests that 181 private-label products bear the Opponent's Trademark, and that such products are typically shelved in the health and beauty sections of the licensees' pharmacy locations [para 9]. Exhibit H consists of images of thirteen such private label products, including acetylsalicylic acid tablets, antacid tablets and herbal supplements. The Opponent's Trademark appears on the labels. Invoices from contracted manufacturers of such products, dated from April to July 2016 are provided at Exhibit I.
- Exhibit J(a) consists of approximately two dozen representative invoices that Mr. Krug attests show sales of such private-label products from FCL to its licensees, dated between 2002 and 2009. Exhibit J(b) consists of four multi-page invoices showing such sales between April and June 2016 [para 10].
- Mr. Krug attests that the licensees offer the Opponent's Information Services and the Opponent's Pharmacy Services with customers' purchase of prescribed or controlled medication. The Opponent's Trademark is displayed on prescription labels, receipts and paper bags used by the licensees [para 12, Exhibits K and L].

- The Opponent’s licensees provide “CARE+ Reports” to customers upon the dispensing of a prescription [para 13, Exhibit M].
- Since 2002, the Opponent’s licensees have provided information pamphlets bearing the Opponent’s Trademark to customers [para 14, Exhibits N and O].
- The Opponent’s Trademark has been displayed in weekly printed flyers to advertise licensee’s pharmacy services since at least 2003 [para 15, Exhibit P].
- The private-label products bearing the Opponent’s Trademark have been advertised through various means, including in weekly printed and online flyers since at least March 2016. Such flyers are distributed online, at co-op pharmacies and to approximately 1.4 million households across Western Canada [paras 16 and 17, Exhibit Q].
- Since 2003, the Opponent’s annual wholesale sales through FCL to its licensees of non-prescription private-label products bearing the Opponent’s Trademark have increased annually, as follows (approximately): 2003: \$500,000; 2004: \$750,000; 2007: \$1,100,000; 2008: \$1,300,000; 2015: \$2,900,000; 2016: \$3,000,000 [para 18].
- Since the Opponent’s acquisition of the Opponent’s Trademark in 2002, the Opponent, through its licensees, has made “retail sales of prescription medicines and controlled products in the amount of hundreds of millions of dollars”. For example, in 2015, retail sales of such products was approximately \$178,000,000, with an estimated three million prescriptions filled [para 19].
- Mr. Krug is of the belief that by virtue of the long-standing and continued use of the Opponent’s Trademark through its licensees in the retail pharmacy services industry, “many pharmacy customers in Canada would associate the term CARE PLUS with the Opponent’s services and private label products bearing [the Opponent’s Trademark] offered through its licensees” and that use of the Mark in association with goods sold in pharmacies “would inevitably lead to confusion in the marketplace with [the Opponent’s Trademark]” [para 20].

## **Certified Copies**

[15] As reply evidence, the Opponent filed certified copies of the Opponent's applications for the trademarks CARE+ and design (No. 1,755,724) and CARE+ and design (No. 1,755,725), shown below, respectively:



[16] The applications were filed on November 16, 2015 by the Opponent in association with the Opponent's Goods, the Opponent's Information Services and the Opponent's Pharmacy Services based on proposed use in Canada. Pursuant to a change of title registered on October 25, 2019, both applications are now owned by FCL, the Opponent's successor-in-title. Both applications remain pending.

[17] At this point, I note that neither the statement of opposition nor the Krug Affidavit refers to these applied-for trademarks; as such, their existence has no impact on the ultimate disposition in this proceeding.

### OVERVIEW OF THE APPLICANT'S EVIDENCE

#### **Stecyk Affidavit**

[18] The Stecyk Affidavit largely consists of printouts relating to searches of CIPO's trademark database with respect to the terms CARE and PLUS. It can be summarized as follows:

- Ms. Stecyk is a trademark searcher employed by the Applicant's agent [para 1].
- On November 14, 2017, Ms. Stecyk conducted searches using the CDNameSearch software and database system provided by CDNameSearch Corp., which contains extracts of information maintained by CIPO in respect of pending applications and trademark registrations [para 2].

- The first search conducted was devised to locate active applications and registrations of trademarks which contained the element “CARE” combined with either the word “PLUS” or the element “+” and in association with goods “included in International Classes 3, 5, 10, 16, 35, 44 and Section 9”. Exhibit A is a copy of those search results [para 2]. Of the 38 search results included, I note that 24 appear to be for registered trademarks.
- The second search conducted was devised to locate active applications and registrations of trademarks that contained the element “CARE”, in association with goods “limited to [International] classes 5, 10 and Section 9”. Exhibit B is a copy of those search results [para 3]. Of the 1,313 search results included, I note that a significant number appear to be for registered trademarks.

#### EVIDENTIAL BURDEN AND LEGAL ONUS

[19] Before considering the grounds of opposition, it is necessary to review the basic requirements with regard to (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[20] With respect to (i), 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, 30 CPR (3d) 293 (FCTD) at para 11]. 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.

[21] With respect to (ii), the legal onus is on the applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent in the statement of opposition (for those allegations for which the opponent has met its evidential burden). The presence of a legal onus on an applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, then the issue must be decided against the applicant.



## MATERIAL DATES

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

- Sections 38(2)(a)/30 with respect to non-compliance with section 30 – the filing date of the application, namely June 22, 2015 [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Sections 38(2)(b)/12(1)(d) with respect to confusion with a registered trademark – the date of this decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd et al*, 1991 CarswellNat 1119, 37 CPR (3d) 413 (FCA) at para 18];
- sections 38(2)(c)/16 with respect to non-entitlement – the filing date of the application, namely June 22, 2015 [section 16 of the Act]; and
- sections 38(2)(d)/2 with respect to non-distinctiveness – the filing date of the opposition, namely, July 7, 2016 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317 at para 25].

## OWNERSHIP OF THE OPPONENT’S TRADEMARK

[23] As noted above, on October 25, 2019 – well after the parties had submitted their evidence and written representations – a change in title of the Opponent’s Trademark to FCL was registered by the Registrar.

[24] In my view, although FCL is not named as an opponent in this proceeding, this change in ownership does not affect the assessment of the grounds of opposition below.

[25] In this respect, for purposes of the section 16 non-entitlement grounds of opposition, since the material date is the filing date of the application for the Mark, the evidenced use of the Opponent’s Trademark was indeed by the Opponent and/or its licensees. Thus, the subsequent change in title does not materially affect the analysis. Similarly, since it occurred after the material dates for the section 30 and section 2 grounds of opposition, the change in title has no impact on those grounds either.

[26] Furthermore, for purposes of a section 12(1)(d) ground of opposition, an opponent is permitted to rely on the registration of another party [see *USV Pharmaceuticals of Canada Ltd v Sherman and Ulster Ltd* (1974), 15 CPR (2d) 79 (TMOB)]. Accordingly, in this case, the Opponent is permitted to rely on the registration of the Opponent's Trademark that, as of the date of this decision, is owned by FCL.

#### ANALYSIS OF THE GROUNDS OF OPPOSITION

##### **Section 30(d) ground – Contents of the Application**

[27] In its statement of opposition, the Opponent pleads, pursuant to section 38(2)(a) of the Act, that at the date of filing of the application, the Mark had not been used in the Netherlands in association with each of the goods listed in the application, contrary to the requirements of section 30(d) of the Act.

[28] As none of the evidence addresses this ground, I cannot find that the opponent has met its initial burden.

[29] Accordingly, the ground of opposition based on section 30(d) of the Act is rejected.

##### **Section 30(i) ground – Entitled to Use Statement**

[30] In its statement of opposition, the Opponent pleads, pursuant to section 38(2)(a) of the Act, that at the date of filing of the application, the applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the applied-for goods since the Mark was confusing with:

- the Opponent's Trademark, registered under No. TMA498,996 for use in association with the Opponent's Information Services; and
- the Opponent's Trademark previously used in Canada in association with the Opponent's Goods, the Opponent's Information Services and the Opponent's Pharmacy Services.

[31] Section 30(i) of the Act, as it then was, merely required that an applicant include a statement in its application that it is satisfied that it is entitled to use its trademark in Canada in

association with the goods or services described in the application. Where this statement has been provided, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co Ltd v Bristol Myers Co*, 1974 CarswellNat 476, 15 CPR (2d) 152 (TMOB) at paras 8-10]. Mere knowledge of the existence of an opponent's trademark does not in and of itself support an allegation that an applicant could not have been satisfied of its entitlement to use its trademark [*Woot, Inc v WootRestaurants Inc*, 2012 TMOB 197 at para 10].

[32] The application for the Mark contains the statement required under section 30(i) of the Act and there is no evidence that this is an exceptional case.

[33] Accordingly, the ground of opposition based on section 30(i) of the Act is rejected.

#### **Section 16 grounds – Non-entitlement re: Opponent's Trademark**

[34] In its statement of opposition, the Opponent pleads that, pursuant to sections 38(2)(c) and 16(2)(a) and 16(3)(a) of the Act, the Applicant is not the person entitled to registration of the Mark in that at the date of filing of the subject application, the Mark was confusing with the Opponent's Trademark that had previously been used in Canada in association with the Opponent's Goods, the Opponent's Information Services and the Opponent's Pharmacy Services by the Opponent and/or its predecessor-in-title.

[35] In order to meet its burden, the Opponent must evidence that it had used its trademark in Canada prior to the date of filing of the subject application, namely June 22, 2015. Furthermore, the Opponent must establish non-abandonment of its trademark as of the date of advertisement of the subject application for the Mark, namely May 18, 2016.

[36] The Opponent's evidence in this case is largely undisputed. In its written representations, the Applicant concedes that "since at least as early as 2002, the Opponent through its licensees, has used [the Opponent's Trademark] in association with [the Opponent's Information Services] and, more generally, in association with the promotion and operation of pharmacies by several retail cooperatives" [page 6 to 7] as well as "in association with various private label products sold by licensed retail cooperatives" [page 7]. For its part, in its written representations, the Opponent essentially asserts that the Opponent's Trademark has been used in association with

the Opponent's Information Services since December 1996 and in association with the Opponent's Goods and the Opponent's Pharmacy Services since 2001 [page 5].

[37] In any event, as there is no evidence that the Opponent has abandoned the Opponent's Trademarks and in view of the extensive evidence of continuous use of the Opponent's Trademark as summarized above, the Opponent meets its initial burden.

*Test to determine confusion*

[38] 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.

[39] In making such an assessment, I must take into consideration all the relevant surrounding circumstances, 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, services 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.

[40] The criteria 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, 1 SCR 772 at para 54]. In *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 at para 49, the Supreme Court of Canada stated that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis [at para 49]. As discussed below, given the resemblance of the parties' trademarks, the disposition in this case turns largely on the nature of the subject goods, services and business as well as the channels of trade.

*Inherent Distinctiveness and the Extent Known*

[41] In its written representations, the Applicant submits that the parties' trademarks possess the same degree of inherent distinctiveness. I further note that there is no evidence that the Mark has become known in Canada whatsoever.

[42] In contrast, there is substantial evidence that the Opponent's Trademark has become known in Canada in association with the Opponent's Goods, the Opponent's Information Services and the Opponent's Pharmacy Services.

[43] Given the evidenced extent to which the Opponent's Trademark has become known, this factor favours the Opponent.

*Length of Time in Use*

[44] As noted above, the Mark is applied for on the bases of proposed use and registration abroad and there is no evidence of use of the Mark in Canada.

[45] Again, in contrast, the Opponent's Trademark has been used in Canada since at least as early as 2002 in association with the Opponent's Goods, the Opponent's Information Services and the Opponent's Pharmacy Services.

[46] Accordingly, this factor favours the Opponent.

*Nature of the Goods, Services or Business / Nature of the Trade*

[47] In its written representations, the Applicant submits that it is seeking registration of the Mark for use in association with "a range of goods providing protection [and] relief from insect bites, whereas the Opponent's registration "does not cover such goods, and the Opponent has not claimed any use of any trademark in association with any goods overlapping those covered by the Applicant's applications". Accordingly, the Applicant submits that the goods of the parties are sufficiently different to avoid any likelihood of confusion [page 10].

[48] For its part, the Opponent submits that the applied-for goods "include goods that are typically sold in pharmacies", identifying the following as such goods:

pharmaceutical and sanitary preparations for the topical treatment of insect bites, insect bite prevention products, namely, insect repellent, ... tick removal instruments, namely, tweezers, grabbers, cards, twisters, tick testing apparatus and instruments, namely, a tube containing liquid for testing for *Borrelia* bacteria, a wooden stick, a pipette, a test cassette, and an informational leaflet, insect bite relief products, namely high voltage low amp shock meter, insect bite gel, venom extractor, insect bite relief spray, insect repellants.

[49] For ease of reference, below I will refer to these goods as the Insect Bite Goods.

[50] The Opponent further notes that “there is no restriction on the channels of trade for [the Mark] that would avoid availability of the [Insect Bite Goods] in a pharmacy” [page 8].

[51] Indeed, in my view, the applied-for goods fall into two general categories. The first category is the Applicant’s Insect Bite Goods, which can be characterized as preparations and/or products for the treatment and relief of ailments (in particular, products for insect bite treatment or prevention). The second category is the remaining goods, which includes the clothing items in goods (3), but also “mosquito nets, mosquito head nets, ... [and] impregnated socks and socks for preventing insect and animal bites and stings from animals and insects” from goods (1) and (2). I also include “mosquito net sheets” in this category as a textile product that is not in the nature of a pharmaceutical preparation. For ease of reference, below I will refer to this second category of goods as the Clothing Goods.

[52] With respect to the Applicant’s Insect Bite Goods, although the Opponent’s Goods and the products otherwise shown to be sold in the licensee’s pharmacies do not appear to include any Insect Bite Goods, given the evidence of use of the Opponent’s Trademark in association with a variety of private-label products (such as allergy relief products), I find that there is overlap with respect to the nature of the goods. As depicted in Exhibit H of the Krug affidavit, the Opponent’s Goods generally appear to be in the nature of tablets or capsules, but the packaging of such products includes descriptions such as “relieves and prevents...”, “rapid relief...”, and “relieves burning & discomfort”. While not for insect bites *per se*, there is still overlap in the sense that some of the Opponent’s Goods and the Applicant’s Insect Bite Goods are for the treatment and relief of ailments.

[53] Similarly, the Opponent’s evidence shows that, in addition to the Opponent’s Goods, various pharmaceutical preparations for the treatment of different ailments are sold in the

licensee's pharmacies. Noting that there is no restriction in the applied-for goods – indeed, some of the Applicant's Insect Bite Goods are described as “pharmaceutical ... preparations” – there would also be potential overlap in the parties' channels of trade.

[54] Accordingly, I find that these factors favour the Opponent with respect to the Insect Bite Goods.

[55] In contrast, with respect to the Clothing Goods, the distinction between such goods versus the Opponent's Goods and/or the pharmaceutical goods typically sold in pharmacies is greater. In this respect, while the evidenced flyers and store photographs show that a wide variety of goods are sold in pharmacies, this does not appear to include protective clothing or the like. While a “mosquito net” has a function of preventing insect bites, I would not characterize it as a “pharmaceutical preparation” akin to the Opponent's Goods or goods typically sold in pharmacies.

[56] Accordingly, I find that these factors favour the Applicant with respect to the remaining Clothing Goods.

#### *Degree of Resemblance*

[57] In its written representations, the Applicant submits that the parties' trademarks are sufficiently different in overall appearance to permit the marks to be readily distinguished [pages 10 to 11]. It emphasizes that, in assessing the likelihood of confusion between trademarks that share a common word element, where the shared word is a descriptive, common or suggestive word, the significance of that shared word is diminished – consumers will be likely to distinguish products sold in association with the shared element by reference to other words or indicia [citing *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD); *Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA); and *Phantom Industries Inc v Sara Lee Corp* (2000), 8 CPR (4th) 109 (TMOB)].

[58] Applied to this case, the Applicant submits that “since CARE is so commonly used by many parties in association with goods in the relevant field, the fact that the marks at issue both contain that element should not be given a great deal of weight in the overall assessment of whether confusion is likely” [page 11].

[59] However, I agree with the Opponent that the “+” element in the Opponent’s Trademark is equivalent to the word “plus”. At a minimum, it follows that the Marks are identical when sounded and in the idea suggested. I further agree that, while there are visual differences between the trademarks (the colour claim and font of the Mark; the oval background and font of the Opponent’s Trademark), the striking element in both is essentially the same – CARE PLUS versus CARE +.

[60] Accordingly, I find that this factor favours the Opponent.

*Additional Surrounding Circumstance: State of the Register*

[61] As noted above, the Stecyk Affidavit largely consists of printouts of search results from CIPO’s trademark register pertaining to i) active applications and registrations that include a combination of the elements “CARE” and “PLUS” or “+” and ii) active applications and registrations that include the element “CARE”.

[62] First, even if I were to accept the second set of search results as supporting the proposition that “CARE” is a very common element of trademarks registered and used in association with pharmaceuticals and the like that would normally be sold in pharmacies, the trademarks at issue are both variations of CARE PLUS.

[63] With respect to the first set of search results, I agree with the Opponent that many of the located trademarks appear to have additional distinguishing elements in the trademark (*e.g.* TMA541,833 for ALCARE PLUS), or have a different location of the “+” element (*e.g.* TMA765,608 for DOVE MEN+CARE).

[64] In any event, 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 CarswellNat 1431, 41 CPR (3d) 432 (TMOB) at para 10; and *Welch Foods Inc v Del Monte Corp*, 1992 CarswellNat 178, 44 CPR (3d) 205 (FCTD) at paras 7-10]. Inferences about the state of the marketplace 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, 43 CPR (3d) 349 (FCA)].



[65] In the absence of evidence of third-party use, there are too few relevant registered trademarks to draw any inference regarding the state of the Canadian marketplace with respect to the goods and services at issue. As such, I do not find the state of the register to be a relevant surrounding circumstance assisting either party.

*Conclusion – Confusion with the previously used Opponent’s Trademark*

[66] 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].

[67] As mentioned above, the degree of resemblance between the parties’ marks is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion. This is particularly the case where the parties’ goods and the parties’ channels of trade are the same or overlapping, as in this case with respect to the applied-for Insect Bite Goods [see *Reynolds Consumer Products Inc v PRS Mediterranean Ltd*, 2013 FCA 119, 111 CPR (4th) 155 at paras 26-30].

[68] Having considered all of the surrounding circumstances, I find that the Applicant has not met its legal burden with respect to the applied-for Insect Bite Goods. At best for the Applicant, I find the balance of probabilities regarding the likelihood of confusion as to the source of the parties’ goods to be evenly balanced. I reach this conclusion due to the resemblance between the trademarks, especially in view of the overlap in the nature of the parties’ goods and the evidenced extent to which the Opponent’s Trademark has become known in association with the Opponent’s Goods and the Opponent’s Pharmacy Services.

[69] As the onus is on the Applicant to show, on a balance of probabilities, that there is no reasonable likelihood of confusion, I must find against the Applicant. Accordingly, the section 16 grounds of opposition based on confusion with the Opponent’s Trademark are successful with respect to the applied-for Insect Bite Goods.

[70] I come to a different conclusion with respect to the remaining applied-for Clothing Goods. In my view, the difference between the nature of the Clothing Goods and the Opponent's Goods and/or the pharmaceutical goods typically sold in pharmacies is sufficient to diminish the likelihood of confusion for such goods. Having considered all of the surrounding circumstances, I find that the Applicant has met its legal burden with respect to the applied-for Clothing Goods. I reach this conclusion due to the difference in the nature of the goods, notwithstanding the resemblance between the trademarks and the extent to which the Opponent's Trademark has become known or used in association with the Opponent's Goods and the Opponent's Pharmacy Services.

[71] Accordingly, the section 16 grounds of opposition based on confusion with the Opponent's Trademark are rejected with respect to the applied-for Clothing Goods.

#### **Section 12(1)(d) – Confusing with a Registered Trademark**

[72] In its statement of opposition, the Opponent pleads that, pursuant to sections 38(2)(b) and 12(1)(d) of the Act, the Mark is not registrable because it is confusing with the Opponent's Trademark, namely registration No. TMA498,996 (CARE+ & Design). As noted above, the material date with respect to confusion with a registered trademark is the date of this decision.

[73] I have exercised my discretion and have checked the register to confirm that the registration is extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[74] I note that the Opponent's Trademark was registered on August 24, 1998 based on a declaration of use filed July 31, 1998. Furthermore, the evidence shows that the Opponent used its mark since at least 2002 in association with the registered Opponent's Information Services. This evidence naturally overlaps to some degree with the evidence of use regarding the Opponent's Pharmacy Services – for example, in the exhibited flyers of the licensees.

[75] However, when considering the nature of the goods and services of the parties in respect of the issue of confusion, it is the statements of goods and services in the subject application and registration that govern [*Mr Submarine Ltd v Amandista Investments Ltd*, 1987 CarswellNat 749,

19 CPR (3d) 3 (FCA); *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA) at paras 24-25].

[76] In this case, the Opponent's Information Services as registered are rather narrow and particular. As such, first – and notwithstanding the later material date – with respect to the applied-for Clothing Goods, I come to the same conclusion as above regarding the test for confusion for essentially the same reasons. In particular, I find that the nature of the goods and services factor favours the Applicant more strongly.

[77] Second, with respect to the Insect Bite Goods, the nature of the registered Opponent's Information Services substantially effects the confusion analysis. Accordingly, while the Opponent has evidenced use of its mark in association with the registered Opponent's Information Services since at least 2002, in my view, such services are of a sufficiently distinguishable nature from the applied-for Insect Bite Goods as well.

[78] Having considered all the surrounding circumstances, I find that the Applicant has met its legal burden for the ground of opposition based on the 12(1)(d) of the Act with respect to all of the applied-for goods. I reach this conclusion due to the difference in the nature of the goods and services, notwithstanding the resemblance between the trademarks and the extent to which the Opponent's Trademark has become known in association with the Opponent's Information Services.

[79] Accordingly, the 12(1)(d) ground of opposition is rejected.

## **Section 2 – Non-Distinctiveness**

[80] In its statement of opposition, pursuant to sections 38(2)(d) and 2 of the Act, the Opponent pleads that the Mark is not distinctive because it does not distinguish and is not adapted to distinguish the applicant's goods from those of others, particularly the goods and services of the Opponent and/or its predecessors-in-title, since the Mark is confusing with the Opponent's Trademark.

[81] As noted above, the material date for this ground of opposition is the filing date of the opposition, namely, July 7, 2016 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317 at para 25].

[82] With respect to an opponent's initial evidentiary burden for this ground, the relied-upon trademark "must be known to some extent at least to negate the established distinctiveness of another mark, and its reputation in Canada should be substantial, significant or sufficient" [*Bojangles International LLC v Bojangles Café Ltd*, 2006 FC 657 at para 34; see also *Sadhu Singh Hamdard Trust v Navsun Holdings Ltd*, 2019 FCA 10 at para 4].

[83] In view of the significant evidence of use and reputation in Canada of the Opponent's Trademark with respect to the Opponent's Goods and the Opponent's Pharmacy Services described above, I find that the Opponent has met its initial burden.

[84] Furthermore, as this ground also turns on the issue of confusion as between the Mark and Opponent's Trademark, I come to the same conclusion for essentially the same reasons above with respect to the grounds based on entitlement.

[85] In other words, I find that the ground of opposition based on non-distinctiveness of the Mark succeeds with respect to the applied-for Insect Bite Goods, but I reject this ground of opposition with respect to the applied-for Clothing Goods.

#### DISPOSITION

[86] In view of all of the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to the goods set out in strikethrough below, and reject the opposition with respect to the remainder of the goods, all pursuant to section 38(12) of the Act:

(1) ~~Pharmaceutical and sanitary preparations for the topical treatment of insect bites, insect bite prevention products, namely, insect repellent, mosquito nets, mosquito head nets, mosquito net sheets, impregnated socks and socks for preventing insect and animal bites and stings from animals and insects, trousers, jackets, shirts, caps, hats, caps with neck protection, shoes, boots for protection against insects and animals, mosquito nets, tick removal instruments, namely, tweezers, grabbers, cards, twistors, tick testing apparatus and instruments, namely, a tube containing liquid for testing for Borrelia~~

~~bacteria, a wooden stick, a pipette, a test cassette, and an informational leaflet, insect bite relief products, namely, high voltage low amp shock meter, insect bite gel, venom extractor, insect bite relief spray, insect repellants.~~

(2) ~~Pharmaceutical and sanitary preparations for the topical treatment of insect bites, insect bite prevention products, namely, insect repellent, mosquito nets, mosquito head nets, mosquito net sheets, impregnated socks and socks for preventing insect and animal bites and stings from animals and insects, tick removal instruments, namely, tweezers, grabbers, cards, twisters, tick testing apparatus and instruments, namely, a tube containing liquid for testing for Borrelia bacteria, a wooden stick, a pipette, a test cassette, and an informational leaflet, insect bite relief products, namely, high voltage low amp shock meter, insect bite gel, venom extractor, insect bite relief spray, insect repellants; mosquito nets.~~

(3) Trousers, jackets, shirts, caps, hats, caps with neck protection, shoes, boots for protection against insects and animals.

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Andrew Bene  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE:** No Hearing Held

**AGENTS OF RECORD**

Cassan MacLean IP Agency Inc.

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Osler, Hoskin & Harcourt LLP

For the Applicant