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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 60

Date of Decision: 2020-03-31

IN THE MATTER OF AN OPPOSITION

Northpaw Nutrition Inc.

Opponent

And

Corey Nutrition Company Inc.

Applicant

1,763,342 for NORTH PAW

Application

INTRODUCTION

[1] Northpaw Nutrition Inc. (the Opponent) opposes registration of the trademark NORTH PAW (the Mark), which is the subject of application No. 1,763,342 by Corey Nutrition Company Inc. (the Applicant).

[2] The application for the Mark is based on proposed use in Canada and is in association with the goods “pet food” (the Goods) and the services “wholesale and retail sale of pet food” (the Services).

[3] The grounds of opposition to be considered in this case include an allegation of non-entitlement to registration of the Mark based on the Opponent’s previous use of its trade names Northpaw, Northpaw Nutrition, and Northpaw Nutrition Inc., and an allegation of non-distinctiveness of the Mark, contrary to sections 16(3)(c) and 2, respectively, of the *Trademarks*

Act, RSC 1985, c T-13 (the Act). I note that the Act was amended on June 17, 2019. All references in this decision are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act before it was amended (see section 70 of the Act).

THE RECORD

[4] The application for the Mark was filed on January 14, 2016.

[5] The application was advertised for opposition purposes in the *Trademarks Journal* of August 3, 2016.

[1] On September 27, 2016, the Opponent filed a statement of opposition pleading grounds of opposition under sections 16(3)(c), 2, and 30(i) of the Act. The Applicant denied each of the grounds of opposition in a counter statement filed on November 25, 2016.

[2] In support of its opposition, the Opponent filed the affidavit of Jeff Friesen, the President of the Opponent. The Applicant did not file any evidence.

[3] Both parties filed a written argument and attended at a hearing.

LEGAL ONUS AND EVIDENTIAL BURDEN

[4] Before considering the grounds of opposition, it is necessary to review some of the technical 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.

[5] With respect to (i) above, there is, in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Limited v The Molson Companies Limited*, 1990 CanLII 11059 (FC), 30 CPR (3d) 293 at 298 (FCTD)]. The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, 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 an 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 is in, then the issue must be decided against an applicant.

PRELIMINARY REMARKS

[6] In reaching my decision I have considered all the evidence in the file. However, only those portions of the evidence that are directly relevant to my findings are discussed.

[7] Further, in considering the Opponent's evidence, namely the affidavit of Mr. Friesen, I have disregarded any assertions that I consider equivalent to an opinion on the questions of fact and law to be determined by the Registrar in this proceeding.

ANALYSIS OF THE GROUNDS OF OPPOSITION

Section 30(i) ground of opposition

[8] While a ground of opposition under section 30(i) of the Act was pleaded in the statement of opposition, the Opponent subsequently withdrew this ground of opposition in its written argument.

Section 16(3)(c) ground of opposition

[9] In its statement of opposition, the Opponent claims that it manufactures and distributes pet food, pet products including supplements and other related goods through the wholesale and retail sale of same, and that it carries on business under the trade names Northpaw, Northpaw Nutrition, and Northpaw Nutrition Inc. (collectively, the Trade Names).

[10] The Opponent pleads that contrary to sections 38(2)(c) and 16(3)(c) of the Act, the Applicant is not the person entitled to registration of the Mark as it is confusingly similar with the Opponent's Trade Names previously used in Canada.

[11] For this ground of opposition, there is an initial burden on the Opponent to show use of one or more of its Trade Names prior to January 14, 2016, the date of filing of the application,

and that it had not abandoned the(se) Trade Names as of August 3, 2016, the date of advertisement of the Applicant's application [section 16(5) of the Act].

[12] With respect to assessing use of a trade name, the Act does not contain a definition of what constitutes such use. However, the topic was considered by the Federal Court in *Mr. Goodwrench Inc. v General Motors Corp* (1994) 55 CPR (3d) 508 (FCTD), with Simpson J. stating:

There are no provisions in the Act which define and describe the use of a trade name. However, in his decision in *Professional Publishing Associates Ltd. v. Toronto Parent Magazine Inc.* (1986), 9 C.P.R. (3d) 207 Mr. Justice Strayer considered the problem and held that the principles in ss. 2 and 4(1) of the Act apply to trade name use. In this regard, His Lordship said:

While there is no definition in the *Trade Marks Act* of "use" in relation to trade names, I am satisfied that consistent with the purposes of the Act such "use" would have to be in the normal course of trade and in relation to the class or classes of persons with whom such trade is to be conducted.

Accordingly, use in the normal course of trade will be the test applied in these reasons.

[13] I also refer to the decision of *Pharmx Rexall Drug Stores Inc v Vitabrin Investments Inc.*, (1995) 62 CPR (3d) 108, where Hearing Officer D. Martin stated:

However, the formation or registration of a company under a particular name does not, by itself, constitute use of that name as a trade mark or a trade name.

[14] With these principles in mind, I will now turn to a review of the Opponent's evidence, and an analysis of whether the Opponent has met its initial onus.

Affidavit of Jeff Friesen

[15] The Opponent's evidence is comprised of the affidavit of Jeff Friesen, sworn March 16, 2017. Mr. Friesen is a director and president of the Opponent, and has principal responsibility for and conducted a review of the books, records, files and correspondences maintained by the Opponent pertaining to its opposition of the application for the Mark by the Applicant (Friesen affidavit, paras 1, 2).

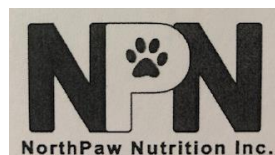
[16] Pertinent portions of the Friesen affidavit are summarized below. I note that at the hearing, the Applicant emphasized that there were several shortcomings in the Friesen affidavit,

most notably that most of the exhibits to the affidavit that are intended to show use of the Trade Names are undated, and are not stated by Mr. Friesen to be representative of the material date of January 14, 2016.

Business of the Opponent and presentation of the trade name “Northpaw Nutrition Inc.”

[17] In or around May 12, 2010, the Opponent was incorporated in Saskatchewan having the incorporated name Northpaw Nutrition Inc. (para 4, Exhibit A). In or around May, 2010, the Opponent commenced business under its current business names and the Trade Names, at which time the Opponent began to use its Trade Names in association with the Opponent’s business (para 6), as described below.

[18] Mr. Friesen states that the Opponent manufactures and distributes pet foods, pet products, including supplements, and other related goods through wholesale and retail sale throughout Canada. The Opponent’s business includes the manufacturing and distribution of: Satori Pet Food, Boka Pet Food, Aurora Pet Products, Element 5 Supplements and Vintage Pet Foods (the Opponent’s Products). Exhibit B is described as a copy of the Opponent’s marketing material and excerpts from the Opponent’s websites (para 5). I note that the following logo or composite mark consistently appears on these and other exhibits to the affidavit:



[19] In its written submissions, the Applicant takes the position that the Opponent’s use of this logo does not constitute use of any of the Trade Names, and that “Northpaw Nutrition Inc.” when used in the context of this logo is not a trade name within the meaning of the Act. The Applicant submits that the logo, even though it contains the alleged trade name “NorthPaw Nutrition Inc.”, constitutes use of a trademark.

[20] In my view, notwithstanding its inclusion in a mark or logo, I find that “NorthPaw Nutrition Inc.”, as it appears above, constitutes trade name use. I do not consider the fact that the name also forms part of a composite trademark or logo to constitute a bar to it simultaneously

being recognized as a trade name, nor am I aware of any case law that says they cannot [see *CEG License Inc v Joey Tomato's (Canada) Inc*, 2011 TMOB 221 (CanLII) at para 15. See also *Consumers Distributing Company Limited v Toy World Limited*, 1990 CarswellNat 1398 (TMOB) at para 14 and *Road Runner Trailer Manufacturing Ltd. v Road Runner Trailer Co.* (1984), 1 CPR (3d) 443 (CFTD) which discuss how trademark and trade name usages are not necessarily mutually exclusive]. When viewed by the average consumer, the words “NorthPaw Nutrition Inc.” within the logo would continue to signal or identify to consumers the name under which the Opponent’s company is carried on. Put another way, I do not find that the trade name as it has been incorporated into the logo has been rendered indistinguishable or incapable of signaling to the consumer the name under which the Opponent’s business is carried on.

[21] That said, while I consider the above to constitute trade name use, these printouts (at Exhibit B) are largely undated - the only date reference is a copyright notice dated 2017 on the Boka Pet Food and Satori Pet Food webpages. Further, Mr. Friesen does not identify these documents as being representative of the material date. As a result, I cannot assume that these materials are representative of the use of this trade name as of the material date of January 14, 2016.

[22] Mr. Friesen states that the Opponent markets and sells the Opponent’s Products through retailers and online dealers throughout Canada, including Costco Canada (para 7).

The Opponent’s websites

[23] Mr. Friesen states that the Opponent’s Products have been and continue to be promoted to the public on the Opponent’s websites, *www.northpawnutrition.com* (the Opponent’s website), *satoripetfood.com* and *bokapetfood.com*. Mr. Friesen states that the Opponent registered the Opponent’s website domain name in or around May 17, 2013, at which time its Trade Names began appearing on the website. The Opponent further registered the domain name *satoripetfood.com* in or around July 2011, and *bokapetfood.com* in or around February 2012 (para 8).

[24] Mr. Friesen asserts that these websites receive thousands of visits (para 8) and provides as Exhibit C printouts described as “excerpts from Google analytics showing site traffic for the

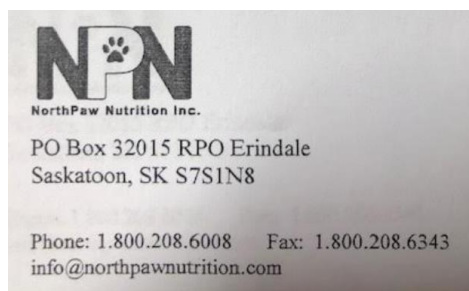
sites through March 1, 2011 through December 31, 2015 and March 2, 2011 through March 8, 2017”. However, without any evidence showing the use of the Trade Names on these websites during these periods (more specifically, as of the material date of January 14, 2016), this information is of little relevance. While copies of excerpts from the Opponent’s websites bearing the Opponent’s Trade Name “NorthPaw Nutrition Inc.” are attached as Exhibit D, they are undated but for a “© 2017 NORTHPAW NUTRITION. ALL RIGHTS RESERVED” on the Satori and Boka webpages.

Wholesale purchase agreement, retailer order sheet, catalogue listings

[25] Mr. Friesen states that the Opponent has used the Trade Names on a continuous basis since incorporation and up to the date of swearing this affidavit (para 13), and that the Opponent has been known as, and is often commonly referred to by customers and distributors by its Trade Names (para 14). Attached as Exhibit G are copies of documents described as the “Opponent’s wholesale purchase agreement and an example of the Opponent’s retailer order sheet and Catalog listings of the Opponent’s products in association with the Trade Names”. While these materials contain the trade name “NorthPaw Nutrition Inc.” and “NorthPaw” (for example on the Terms & Conditions page), I note that they are either undated or postdate the material date (the price catalogue is dated March 2017).

Invoices

[26] Mr. Friesen states that the Opponent has adopted and used the Trade Names in all matters of promoting the Opponent’s business, including but not limited to advertisement and billing (para 15). Exhibit H contains copies of six invoices, and “Northpaw Nutrition Inc.” appears in the top left corner of each invoice as follows:



[27] The Applicant, in its written argument, points out that the words “Northpaw Nutrition Inc.” are in a different font than the below listed business address on the invoices with the result that the words “Northpaw Nutrition Inc.” would be seen, along with the “NPN design”, as part of the logo as opposed to being a recitation of the Opponent’s business name.

[28] For the same reasons as discussed above in paragraph 20 and notwithstanding that the Opponent’s business address is displayed below in different font, I find that the invoices show use of the trade name “Northpaw Nutrition Inc”. Even though there is a visual separation between the trade name as it appears in the logo and the business address of the Opponent, I find that nonetheless, it continues to signal to consumer the identity of the Opponent.

[29] The particulars of the invoices at Exhibit H are briefly summarized as follows:

Invoice No.	Date of Invoice	Invoice To	Ship To	Description of Items
1237	31/03/2017	NorthPaw Nutrition Inc.	Blank	States “Invoice Template”
146	17/08/2011	Redacted	Partially redacted to read “Burnaby, BC, Canada”	Lists Satori pet food items. Invoice totals (with HST (BC)@12.0%) \$40,078.08.
776	06/05/2015	Redacted	Redacted	Lists Satori pet food items
267	19/06/2012	Redacted	Redacted	Lists Boka & Satori pet food items. The invoice total is redacted. The un-redacted tax summary refers to HST (BC)@12.0%.
506	08/11/2013	Redacted	Redacted	Redacted. The un-redacted tax summary, refers to GST only.
696	26/11/2014	Redacted	Partially redacted to read “Canada”	States “Shipment Nov 2014”.

[30] At the hearing, the Applicant submitted that invoice No. 1237 cannot be used to demonstrate use of “Northpaw Nutrition Inc.” in association with the Opponent’s manufacturing and distribution of pet food, because it is identified as a template. Further, it post-dates the material date and there is no indication that this invoice is representative of those that would have been issued at the material date. The Applicant submitted that of the remaining invoices,

that only invoice Nos. 146 and 696 are identified as shipping to Canada, and of these, only invoice No. 146 has a description of the goods being purchased (as invoice No. 696 simply refers to a shipment from November 2014).

[31] The Applicant submits that to the extent that invoice No. 146 shows use with the services of manufacturing and distributing pet food, that it is, at most, mere “token use” given that it is limited to a single invoice. I find that invoice No. 146 is not simply token use but is instead sufficient to show evidence of trade name use [by analogy, see *JC Penney Co v Gaberdine Clothing Co* (2001), 2001 FCT 1333 (CanLII), 16 CPR (4th) 151 (FCTD) at 178 in which it was held that only a single sale or instance of use is needed for an opponent to meet its burden so long as the mark functions as a trademark]. I am also prepared to infer that invoice No. 267 also shows use of the trade name in Canada in association with the Opponent’s business since the invoice refers to British Columbia provincial sales tax (BC HST), though if I am wrong in doing so, it does not affect my conclusion.

[32] As I understand it, the Applicant’s submissions suggest that the issue of whether there is “use” of the Opponent’s Trade Names is to be assessed just as one would approach an assessment of trademark use within the meaning of the Act – for example, requiring notice of association of the Trade Names at the time of transfer of the Opponent’s goods.

[33] In A. Kelly Gill, *Fox on Canadian Law of Trade-Marks and Unfair Competition*, 4th ed, (Toronto: Thomson Reuters Canada, 2002), ch 14.2(a) (WL Can), the following is noted with respect to trade names:

Trade names are terms or symbols used to distinguish and identify corporations, partnerships, businesses or individuals and the accompanying good-will. Trade names do not identify nor distinguish goods or services. The *Trade-marks Act* defines a “trade name” as “the name under which any business is carried on, whether or not it is the name of a corporation, a partnership or an individual.” Trade names so defined cannot be registered under the *Trade-marks Act*. [emphasis added]

[34] The difference between the use of a trademark and that of a trade name can also be observed in section 6(3) of the Act, which states “the use of a trademark causes confusion with a trade name if the use of both the trademark and the trade name in the same area would be likely to lead to the inference that the goods and services associated with the trademark and those

associated with the business carried on under the trade name business carried on under the trade name are manufactured, sold, leased, hired or performed by the same person...” [emphasis added]

[35] As such, the requirement for a notice of association to be made between a trademark and a good at the time of transfer does not appear to be applicable in the context of a trade name. Following the approach of the court in *Mr. Goodwrench*, supra, I will assess whether the Opponent carries on a business that manufactures and distributes pet food and pet products under one or more of the Trade Names such that it identifies the business in the normal course of trade, and in relation to the class/classes of persons which whom such trade is to be conducted.

Distribution of the Opponent's Products

[36] Mr. Friesen states that the Opponent, since incorporation, has distributed the Opponent's Products to 408 municipalities across Canada and from British Columbia, the Yukon territory and to Newfoundland and Labrador (para 16). Attached as Exhibit I is a document described as “a list of the municipalities the Opponent's Products have shipped to and from March, 2011 to February, 2017.

Product Packaging

[37] Mr. Friesen states that the Trade Names are actively displayed and marked on the Opponent's Products and attaches as Exhibit J photographs of “the Opponent's Products with the Trade Names printed on their respective packaging” (para 17). I confirm that the trade name Northpaw Nutrition Inc. is clearly displayed on the product packaging. However, all the product packaging is undated. Moreover, there is no indication from Mr. Friesen if the packaging shown is representative of product packaging as of the material date.

Sales information

[38] Mr. Friesen states that since incorporation, the sales of the Opponent from the operation of its business and the sale of the Opponent's Products has exceeded \$8,453,167.23 (whether in US or CAD is not indicated) (para 18, Exhibit K). While sales figures are not provided on an

annual basis, Mr. Friesen does attest that the Opponent estimates that more than 30,387 units of the Opponent's Products have been purchased each year since incorporation (para 19).

Other Promotional Activities

[39] Mr. Friesen states that the Opponent promotes its business in publications and by participation in conferences and events in the pet retailer field. He states that the Opponent registers and lists itself under the Trade Names at conferences and events, and that the Trade Names are used in all promotional material distributed in Canada (para 20). Attached as Exhibit L are copies of advertising and promotional items, including a "product coupon" with an expiry date of July 31, 2012.

[40] I find that this coupon shows use of the trade name Northpaw Nutrition Inc. for the following reasons:

- the trade name Northpaw Nutrition Inc. appears on the coupon (in substantively the same format discussed in paragraphs 18-20 of this decision) advertising the Opponent's Products;
- The coupon includes the date July 31, 2012, which is prior to the material date of January 2016;
- While there is some ambiguity as to how this coupon was distributed (for example, by mail or in newspapers), I disagree with the Applicant's submissions that there is no evidence that the coupon was distributed in Canada. I find that based on a fair reading of paragraph 20 of the Friesen affidavit, the coupon was distributed in Canada.

Advertising expenditures

[41] Mr. Friesen states that the Opponent estimates that since 2010, more than \$318,184.83 has been spent annually to promote its business and the sale of the Opponent's Products (para 22).

Conclusion – the Opponent meets its onus for the ground of opposition under section 16(3)(c)

[42] At the hearing, counsel for the Opponent acknowledged that some of the evidence might be undated or post-date the material date, but argued that when viewed as a whole, the evidence was nonetheless sufficient to meet the Opponent's initial burden. The Opponent pointed out that

the Applicant chose not to cross-examine Mr. Friesen on his affidavit, and further noted that the Applicant itself had submitted no contradictory evidence. In response, the Applicant submitted that it was not the Applicant's job to fill the gaps in the Opponent's evidence.

[43] While I do not know, nor do I consider appropriate to speculate, why the Applicant did not cross-examine Mr. Friesen, it seems to me that the Applicant's submission on this point is not without merit. In any event, I consider that the lack of cross-examination does not prevent me from assessing the value or weight of the evidence introduced by the affiant [see *H-D Michigan Inc v MPH Group Inc*, 2004 CanLII 71788, 40 CPR (4th) 245, and *GA Modefine SA v Di Gio' SRL*, 2006 CanLII 80390, 51 CPR (4th) 102, where analogous arguments have been addressed by the Registrar].

[44] When the evidence is viewed as a whole, and notwithstanding the shortcomings in the Friesen affidavit, I am satisfied that the Opponent has carried on business under the trade name "NorthPaw Nutrition Inc." in association with the manufacture and distribution of pet food and pet products in Canada prior to January 14, 2016. I also find that there is nothing in the evidence to suggest that the Opponent had abandoned this trade name as of the date of advertisement.

[45] I would also add that I consider the evidence showing use of the trade name "Northpaw Nutrition Inc." to be sufficient to establish use of the trade name "Northpaw Nutrition" as I consider the addition of "Inc." to be a minor deviation to the trade name such that it has not lost its identity and remains recognizable, though I do not find it sufficient to establish use of the trade name "Northpaw".

[46] As I am satisfied that the Opponent has met its evidential burden under this ground of opposition, I must now determine whether the Applicant has met its onus of proving no reasonable likelihood of confusion on a balance of probabilities.

Test to determine confusion

[47] The test for confusion is one of first impression and imperfect recollection. Section 6(3) of the Act indicates that use of a trademark causes confusion with a trade name if the use of both the trademark and trade name in the same area would be likely to lead to the inference that the goods or services associated with the trademark and those associated with the business carried on

under the trade name 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.

[48] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trademark and trade name(s) and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks or trade names in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 (CanLII), 49 CPR (4th) 321 (SCC); *Masterpiece v Alavida Lifestyles Inc*, 2011 SCC 27 (CanLII), 92 CPR (4th) 361 (SCC) (*Masterpiece*)]. However, as noted by the Supreme Court of Canada in *Masterpiece*, although the degree of resemblance is the last factor cited in section 6(5) of the Act, it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion (*Masterpiece*, para 49).

Inherent distinctiveness of the trademark and trade names and the extent to which they have become known

[49] The applied for trademark consists of the ordinary dictionary words NORTH and PAW. While the word “paw” is somewhat suggestive of the character of the goods and services in that they relate to animals, I find that the Mark, when considered overall, possesses a fair degree of inherent distinctiveness. Similarly, I find the Opponent’s trade names “Northpaw Nutrition Inc.” and “Northpaw Nutrition” to possess a similar degree of inherent distinctiveness given that the additional elements “nutrition” and “Inc.” are descriptive in nature therefore do not increase the overall inherent distinctiveness of the Opponent’s trade names.

[50] The strength of a trademark (and trade name) may be increased by means of it becoming known through promotion or use. While the Opponent has provided evidence of use of its trade names, I am unable to make a determination as to the extent to which they have become known prior to January 14, 2016, given that much of the evidence is undated, or cannot be said to be representative of use in this period. The Applicant’s Mark is based on proposed use and the

Applicant has filed no evidence showing use or promotion of the Mark subsequent to the date of filing of the application (or at any other time).

[51] In the end, the overall consideration of the section 6(5)(a) factor favours neither party.

Length of time the trademark and trade names have been in use

[52] Since the Applicant's application for the Mark is based on proposed use with the Goods and Services, the length of time the Mark has been used by the Applicant is necessarily of little significance [*Hayabusa Fightwear Inc v Suzuki Motor Corporation*, 2014 FC 784 at para 34].

[53] As discussed above, the Opponent has shown some evidence of use of its trade names prior to January 14, 2016, though I am unable to determine the extent to which they may have become known through use or promotion as of the material date.

[54] Accordingly, this factor does not significantly favour either party.

Nature of the goods, services, or business, and trade

[55] The goods and services associated with the Mark are "pet food" and the "wholesale and retail sale of pet food", respectively. The services associated with the Opponent's business carried on under the trade names "Northpaw Nutrition Inc." and "Northpaw Nutrition" include the manufacture and distribution of pet food products through wholesale and retail channels.

[56] The parties' goods, services and businesses are of the same nature and there is direct overlap. Absent evidence to contrary, it reasonable to assume that their channels of trade (wholesale and retail) would also overlap.

Degree of resemblance

[57] There is a significant degree of resemblance between the parties' trademarks and trade names in appearance, sound, and ideas suggested. The Mark is comprised of the words NORTH and PAW, and the combination of these same words comprise the striking or unique element of the Opponent's trade names "Northpaw Nutrition Inc." and "Northpaw Nutrition". I do not consider the difference in spacing between the elements "North" and "Paw", or the additional

words “Nutrition” and “Inc.” in the Opponent’s trade names to diminish the degree of resemblance between the parties’ trademark and trade names given their suggestive nature.

[58] Accordingly, this factor strongly favours the Opponent.

Evidence of actual confusion

[59] As Exhibit M to the Friesen affidavit, the Opponent attaches what are described as “emails received by the Opponent confirming confusion between the Applicant’s product promoting the Mark and the [Opponent’s] Trade Names” (Friesen affidavit, para 26). The Applicant takes the position that these emails are hearsay or double hearsay and thus inadmissible. Notwithstanding the issue of their admissibility, given that all of these emails post-date the material date for this ground of opposition, I cannot consider this as a relevant surrounding circumstance supporting the Opponent’s case [*Servicemaster Co v 385229 Ontario Ltd* 2015 FCA 114 (CanLII) at paras 21- 22].

Conclusion

[60] Having regard to the foregoing, in particular the significant degree of resemblance between the applied for trademark NORTH PAW and the Opponent’s trade names “Northpaw Nutrition Inc.” and “Northpaw Nutrition”, and the direct overlap in the parties’ goods, services, and business, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that as of January 14, 2016, there was no reasonable likelihood of confusion between the Mark and the Opponent’s trade names “Northpaw Nutrition” and “Northpaw Nutrition Inc.”.

[61] Accordingly, this ground of opposition is successful.

Section 2 ground of opposition

[62] The Opponent has pleaded that the Mark is not distinctive, as “it does not distinguish the Applicant’s wares from the wares associated with the Opponent’s Trade Names whether considered at the filing date of the application or the date of filing this statement of opposition”.

[63] The material date with respect to distinctiveness is the filing date of the opposition, namely September 27, 2016 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 2004 FC 1185 (CanLII), 34 CPR (4th) 317 (FC)].

[64] With respect to an opponent's initial evidential burden for this ground, the test is not merely whether the opponent's trade names were used, but rather that the trade names "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].

[65] While the Opponent has shown some use in Canada of its trade names "Northpaw Nutrition" and "Northpaw Nutrition Inc.", it has failed to establish that either of these trade names has a substantial, significant or sufficient reputation in Canada. In this regard, I am of the view that there is insufficient evidence quantifying how many Canadians have been exposed to the Opponent's trade names as of the material date. As discussed earlier, shortcomings in the Friesen affidavit put into question the manner in which the Opponent's trade names have been used and marketed and the extent of such use and promotion in association with its business prior to the material date. Many of the advertising and promotional materials provided by the Opponent are undated with no indication of their relevance to the material date, and it is not clear from the evidence what the extent of distribution would have been for these materials. While the Opponent indicates that it has participated in conferences and events in the pet retailer field, reference is made to only one event (Superzoo 2016) without any further particulars, such as the specific date(s) the conference was held, whether this event was held in Canada, and/or the number of Canadian attendees. I have not had regard to the web traffic information provided by the Opponent since there is no evidence of how (if at all) the Opponent's Trade Names appeared on the Opponent's Web Site as of the material date. Further, while the Opponent has provided a list of the municipalities that the Opponent's Products have been shipped too and from between March, 2011 and February, 2017, there is no information on the extent of these transactions in terms of volume or duration nor a breakdown of such activities by region, thus limiting the relevance of this information. When Mr. Friesen's affidavit is viewed in its entirety, I am unable to determine whether any of the Opponent's Trade Names has acquired a substantial, significant

or sufficient reputation in Canada as required by *Bojangles*. Accordingly, the Opponent has not met its initial evidential burden, and this ground of opposition is rejected.

DISPOSITION

[66] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse this application pursuant to section 38(12) of the Act.

Jennifer Galeano
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2019-11-07

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FOR THE OPPONENT

McInnes Cooper

FOR THE APPLICANT