



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 020

Date of Decision: 2023-02-06

IN THE MATTER OF AN OPPOSITION

Opponent: LEC Custom Products, Inc.

Applicant: Noxell Corporation

Application: 1,878,487 for EVERYDAY DEFENSE

INTRODUCTION

[1] LEC Custom Products, Inc. (the Opponent) opposes registration of the trademark EVERYDAY DEFENSE (the Mark), which is the subject of application No. 1,878,487 (the Application) by Noxell Corporation (the Applicant).

[2] The Application is based on proposed use in association with “cosmetics” (the Goods) in Class 3 of the Nice Classification.

[3] For the reasons that follow, the opposition is rejected.

THE RECORD

[4] The Application was filed on January 19, 2018, claiming a priority filing date of November 9, 2017, based on a United States application filed in association with the

same kind of goods. The Application was advertised for opposition purposes in the *Trademarks Journal* of December 5, 2018, and a statement of opposition was filed by the Opponent's predecessor in title, Evergreen Consumer Brands Inc. (Evergreen), under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on January 3, 2020.

[5] The Act was amended on June 17, 2019, and pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read prior to June 17, 2019. As last amended, the statement of opposition raises grounds of opposition based on non-compliance with sections 30(e) and 30(i) of the Act.

[6] The Applicant filed a counter statement denying the grounds of opposition.

[7] Both parties filed evidence, which is briefly summarized below. Only the Applicant filed written representations and neither party attended a hearing.

OVERVIEW OF THE EVIDENCE

[8] The Opponent filed the affidavit of Marcela Ferro (sworn July 13, 2020), a trademark clerk employed by the agent for the Opponent. Ms. Ferro attaches a copy of an assignment that she filed for various registrations and applications, including for the trademarks DAILY DEFENSE and DAILY DEFENSE & Design, from Evergreen to the Opponent (Exhibit A). Exhibit B contains printouts of the particulars of these registrations and pending applications, namely: DAILY DEFENSE (TMA537,647); DAILY DEFENSE & Design (TMA537,576); DAILY DEFENSE (App. No. 1,957,146) and DAILY DEFENSE & Design (App. No. 1,957,148). Both of the registrations are in association with hair care products, while both of the pending applications are in association with "cosmetics including body wash".

[9] The Applicant filed the affidavit of Biserka Horvat (sworn November 12, 2020), a law clerk employed by the agent for the Applicant. On October 28, 2020, Ms. Horvat conducted a search of the Canadian trademarks register for active trademarks containing the word DEFENSE in association with hair care preparations and body wash goods falling in Class 3 of the Nice Classification; the search yielded 83

trademarks (Exhibit 3). Further, between October 23 and November 12, 2020, Ms. Horvat visited a number of .ca websites and/or websites available to Canadian consumers and printed out pages displaying hair and skin care products branded under marks incorporating the words DAILY, DEFENSE/CE, or a combination thereof (Exhibits 4-47). Lastly, Ms. Horvat visited the United States Patent and Trademark Office Database website and printed copies of the status results for the Applicant's and Opponent's trademark registrations for EVERYDAY DEFENSE (No. 5,814,249) and DAILY DEFENSE (No. 2,226,528), respectively (Exhibits 48, 49). Both of these US registrations are active.

[10] As reply evidence, the Opponent filed the affidavit of Julianne Ball (sworn September 14, 2021), a trademark clerk employed by the agent for the Opponent. On June 8, 2021, Ms. Ball conducted a search of the Canadian trademarks register for all active trademarks containing the words "Daily Defense" and associated with goods belonging in Class 3 of the Nice Classification. The results yielded ten (10) trademarks, seven of which were applications and/or registrations for DAILY DEFENSE (or variations thereof) owned by the Opponent (Exhibit 1). Ms. Ball also searched the register for active marks containing the words "Everyday Defense" and associated with goods belonging in Class 3 of the Nice Classification. The search yielded one mark, namely the subject Application (Exhibit 2).

LEGAL ONUS AND EVIDENTIAL BURDEN

[11] 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 must satisfy the Registrar, on a balance of probabilities, that the grounds of opposition pleaded should not prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

ANALYSIS OF THE GROUNDS OF OPPOSITION

[12] Both of the grounds of opposition advanced by the Opponent are based on section 30 of the Act. As discussed below, these grounds can be summarily rejected on the basis that the Opponent has failed to meet its initial evidentiary burden.

[13] The material date for a ground of opposition under section 30 of the Act is the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd*, 3 CPR (3d) 469 at 475].

Section 30(e) ground of opposition

[14] The Opponent has pleaded that contrary to section 30(e) of the Act, the Applicant “did not intend to use the Mark as a trademark as defined by section 2 of the Act with the goods described in the Application, namely ‘cosmetics’ in International Class 3”.

[15] However, the evidence filed by the Opponent does not support this ground of opposition, nor is there any evidence from the Applicant that suggests that the Applicant did not intend to use the Mark as a trademark in association with the Goods. Moreover, the Opponent did not make any arguments to support this ground of opposition. Accordingly, the Opponent has not met its initial evidential burden and this ground of opposition is rejected.

Section 30(i) ground of opposition

[16] Under this ground of opposition, the Opponent has pleaded that the Applicant could not have been satisfied that it was entitled to use EVERYDAY DEFENSE as a trademark in Canada with the Goods because, at the relevant date, the Applicant was “aware of the iconic DAILY DEFENSE brand and registered DAILY DEFENSE and DAILY DEFENSE & Design trademarks, and that use of EVERDAY DEFENSE as a trademark with the Goods would be likely to have the effect of depreciating the value of the goodwill attaching to the registered DAILY DEFENSE and DAILY DEFENSE & Design trademarks contrary to section 22 of the Act.”

[17] Section 30(i) of the Act requires an applicant to include a statement in the application that the applicant is satisfied that it is entitled to use the trademark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant's statement untrue, such as evidence of bad faith or non-compliance with a Federal statute [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155; and *McDonald's Corporation and McDonald's Restaurants of Canada Limited v Hi-Star Franchise Systems, Inc*, 2020 TMOB 111, 178 CPR (4th) 179 at para 27].

[18] With respect to the first part of this ground of opposition, mere awareness or knowledge by the Applicant of the existence of the DAILY DEFENSE brand and registered DAILY DEFENSE and DAILY DEFENSE & Design trademarks, which has not even been established in this case, does not preclude the Applicant from truthfully making the statement required by section 30(i) of the Act [*Woot Inc v WootRestaurants Inc*, 2012 TMOB 197]. Moreover, there is nothing to suggest that this is a case involving bad faith. Accordingly, this part of the ground of opposition is rejected.

[19] With respect to the second part of the section 30(i) ground, in *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401 at para 46, the Supreme Court of Canada identified the following four elements required to demonstrate a likelihood of depreciation of goodwill under section 22: (1) use of the trademark, (2) sufficient goodwill in the trademark, (3) likely connection or linkage in the consumer's mind, and (4) likelihood of depreciation. As noted by the Applicant in its written representations, the Opponent has not filed evidence related to any of these elements of this test for the trademarks DAILY DEFENSE, DAILY DEFENSE & Design or any other trademark. Indeed, the Opponent's characterization of DAILY DEFENSE as an "iconic" brand is unsubstantiated. Accordingly, the second part of the section 30(i) ground of opposition is also rejected.

DISPOSITION

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

Jennifer Galeano
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Opponent: Borden Ladner Gervais LLP

For the Applicant: C. Michelle Nelles (Torys LLP)