



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 052

Date of Decision: 2023-03-17

IN THE MATTER OF AN OPPOSITION

Opponent: LRC Products Limited

Applicant: Church & Dwight Co., Inc.

Application: 1,744,868 for TROJAN VIBRATIONS (Stylized)

INTRODUCTION

[1] Church & Dwight Co., Inc. (the Applicant) applied to register the trademark TROJAN VIBRATIONS (Stylized) (the Mark) shown below on September 4, 2015.

TROJAN
VIBRATIONS

[2] The Applicant claims use of the Mark in Canada since at least as early as September 2011 in association with adult sexual stimulation aids, namely personal vibrators (the Goods). The application, which contains a disclaimer of the right to the exclusive use of the word VIBRATIONS apart from the Mark, was advertised on November 8, 2017.

[3] On April 9, 2018, LRC Products Limited (the Opponent), filed a statement of opposition against the Mark pursuant to section 38 of the *Trademarks Act*, RSC 1985, c. T-13 (the Act). The Act was amended on June 17, 2019. All references herein 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].

[4] In support of its opposition, the Opponent submitted a certified copy of registration No. TMA715,265 for VIBRATIONS and the affidavit of Mr. Cameron Weir, Senior Counsel of Reckitt Benckiser (Canada) Inc., an entity within a group of companies that distributed the Opponent's VIBRATIONS branded goods. Mr. Weir was cross-examined on his affidavit. The Opponent also submitted the affidavits of Mr. Aleksandar Vukovic, a searcher and Mr. Michael S. Duchesneau, a law clerk, both employed by the Opponent's firm.

[5] In support of its application, the Applicant submitted certified copies of the Applicant's registrations including TROJAN and the affidavits of Mr. Frayan Mama, Marketing Manager for Church & Dwight Canada Corp., the Applicant's Canadian subsidiary, and Ms. Ginger Dorval, a trademark agent employed by the Applicant's firm. Neither individual was cross-examined.

[6] The Applicant alone filed written representations and attended a hearing.

GROUND OF OPPOSITION

[7] The Registrar struck out one ground of opposition in response to an interlocutory ruling request from the Applicant during the course of the proceeding. The grounds of opposition at issue now are:

- The Mark is not registrable in view of section 12(1)(d) as it is confusing with the Opponent's registration for VIBRATIONS, registered under No. TMA715,265 and covering the goods, condoms; massage apparatus, instruments (sic) and appliances, namely, body massagers, massagers for intimate areas, massagers for sexual stimulation; battery-operated massage apparatus, instruments and appliances, namely body massagers, massagers

for intimate areas, massagers for sexual stimulation; personal massagers; vibrators for personal use; penis rings; rings for genital stimulation.

- Pursuant to section 16(1)(a) of the Act, the Applicant is not the person entitled to registration since at the date of first use in Canada, the Mark was confusing with the Opponent's VIBRATIONS trademark previously used and made known in Canada.
- Pursuant to section 2 of the Act, the Mark is not distinctive of the Applicant within the meaning of section 2 owing to the Opponent's prior adoption, use, advertisement and making known in Canada of the VIBRATIONS trademark.
- The application for the Mark does not comply with section 30(b) of the Act because the Applicant has not used the Mark in Canada in association with the Goods since at least as early as September 2011.
- The application for the Mark does not comply with section 30(i) of the Act because the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Goods because:
 - The Applicant knew or should have known that the use of the Mark in association with the Goods would be likely to have the effect of depreciating the value of the goodwill attaching to the Opponent's registered VIBRATIONS trademark contrary to section 22 of the Act, and
 - The Applicant knew or should have known that use of the Mark would constitute passing off contrary to sections 7(b) and (c) of the Act in view of the Opponent's prior use of the trademark VIBRATIONS.

[8] The material dates are the date of my decision with respect to the section 12(1)(d) ground; September 2011 with respect to the entitlement ground; the date of filing the application (September 4, 2015) with respect to the section 30 grounds; and the date of filing a statement of opposition (April 9, 2018) with respect to the

distinctiveness ground [see *American Retired Persons v Canadian Retired Persons* (1998), 84 CPR (3d) 198 at 206–209 (FCTD)].

THE PARTIES

[9] The Opponent, is a wholly owned subsidiary of Reckitt Benckiser Group plc, a British multinational consumer goods company that produces health, hygiene and home products. Pursuant to inter-company agreements, VIBRATIONS branded products have been manufactured under the direction of the Opponent and, prior to September 1, 2018, distributed by RB Canada Inc. another wholly-owned subsidiary of Reckitt Benckiser Group Plc (Weir affidavit, paras 2– 4; responses to undertakings 1 and 2). To the extent that any VIBRATIONS branded products were distributed in Canada after September 1, 2018, this was by a newly created entity, RB Health Canada, also a wholly-owned subsidiary of Reckitt Benckiser Group Plc. (Qn 61; responses to undertakings 1 and 2).

[10] The Applicant is a multi-national entity who, itself or through its predecessors in title, have been carrying on business in Canada since 1904. That business involves the sale of consumer goods in the nature of personal care products including condoms sold under its TROJAN brand. As part of its initiatives towards the development of adult and condom-related products, it introduced the TROJAN VIBRATIONS adult sexual stimulation line of products in Canada in 2011 (Mama affidavit, paras 1, 3, 4 and 6).

LEGAL ONUS AND EVIDENTIAL BURDEN

[11] An applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, an opponent must first adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

PRELIMINARY ISSUE: CROSS-EXAMINATION OF MR. WEIR

[12] The Applicant requested that Mr. Weir's affidavit be struck, or given little weight, as he was evasive during his cross-examination or lacked the relevant information to answer questions (for example, Qns 158, 159, 162–165, 172, 174, 176–180 and 200–202). I find that Mr. Weir's evidence is not credible and should be afforded little weight for the following reasons:

- (a) Mr. Weir only joined his company in February, 2017 and while he did have access to some business records and people who could provide information (Qns 31–44), he appeared to have little knowledge regarding sales (Qns 247 and 260–264).
- (b) Mr. Weir appeared to have no knowledge of who his company's competitors are (Qns 144–151).
- (c) Mr. Weir did not know whether the photographs provided in evidence were actual products or mock ups of product packaging or what period of time various products related to (Qns 88-91, 98-100). Furthermore, Mr. Weir could not identify or recognize the current iteration of the Opponent's packaging (Qns 111-113).
- (d) Mr. Weir wouldn't admit or acknowledge that some products, referenced as "vibrators for personal use" and found in Exhibit A, were "vibrators" (Qns 84-86). He could not answer the question of whether a "vibrator" product "vibrates" (Qns 156-157) or whether a product that vibrates creates "vibrations" (Qn 158). He indicated that he does not have any knowledge as to what "vibrators" are and whether they "vibrate", and does not know if his company puts the word "vibrating" on products that do not vibrate (Qns 159, 180, and 183). He would not acknowledge that a vibrator vibrates, or that the products in question vibrate, even though they say "vibrating ring" or "battery-powered vibrating ring" on product packaging (Qns 162-164, 172, 174, 176,-180, and 200-202).

ANALYSIS

Registrability Ground

[13] The Opponent pleads that the Mark is not registrable in that, pursuant to section 12(1)(d) of the Act, it is confusing with the Opponent's registered VIBRATIONS trademark. I have exercised my discretion to check the Register and confirm this registration remains extant [*Quaker Oats Co of Canada Ltd v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent has therefore met its initial evidential burden. The Applicant must therefore prove on a balance of probabilities that there is no reasonable likelihood of confusion between the Mark and the Opponent's trademark.

Are the Trademarks Confusing?

[14] The test for confusion is one of first impression and imperfect recollection. 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 trademarks 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 including in appearance or sound or in the ideas suggested by them. These enumerated factors need not be accorded equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 [*Mattel*], *Veuve Cliquot Ponsardin v Boutiques Cliquot Ltée* [*Veuve Cliquot*], 2006 SCC 23 and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 [*Masterpiece*]].

Inherent Distinctiveness

[15] Descriptive words possess a very limited degree of inherent distinctiveness [see *Molson Cos v John Labatt Ltd*, 1994 178 NR 20 at paras 5–8 (FCA), *Venngo Inc v Concierge Connection Inc* 2017 FCA 96 at para 46]. As such, the Opponent's trademark VIBRATIONS has a very low degree of inherent distinctiveness as it consists solely of a descriptive word suggesting the function or result of using the goods, specifically that the Opponent's registered goods vibrate or produce "a quivering or trembling motion" or "a continuous quick slight shaking movement" (Dorval affidavit, Exhibits A and D).

[16] These definitions are consistent with the Opponent's evidence of packaging for the VIBRATIONS brand product described as "1 vibrating ring and 1 latex condom" (Exhibit A). Mr. Weir confirmed that the goods sold by the Opponent comprised a vibrating ring plus condom or the ring alone (Qns 16-17 and 80). He also confirmed that other products include vibrators (Qns 86 and 87), even if during a later line of questioning, Mr. Weir was unsure about the meaning of terms like "vibrations" or "one vibrating ring" and seemed reluctant to admit the wording suggested the products vibrate (Qns 156–185).

[17] The Applicant's evidence also suggests that the terms vibration or vibrations are used descriptively in association with products of the sort associated with the trademarks of the parties (Dorval affidavit, Exhibits L, N and O). While the materials are hearsay and do not prove the products in question were sold in Canada, I consider this evidence to show that these terms are used descriptively in association with personal vibrator products [see *Candrug Health Solutions Inc v Thorkelson* (2007), 60 CPR (4th) 35 (FC); reversed on other grounds 64 CPR (4th) 431 (FCA) [*Candrug*] and *Effigi Inc v HBI Branded Apparel Limited, Inc* 2010 TMOB 160].

[18] I find the Mark to have a significantly higher degree of inherent distinctiveness than the Opponent's trademark. The Mark also contains the term VIBRATIONS, albeit with a disclaimer to the right to the exclusive use of this word. The evidence of Mr. Mama also supports the descriptiveness of the VIBRATIONS component since the Applicant's packaging with the Mark includes "couples vibrating ring", and "compact vibrating massager"(Exhibit G). Mr. Duchesneau's affidavit including printouts of the Opponent's website showing the Mark also includes descriptive text such as "Vibrators are easy to use ... The aspect of being able to share the vibration with your partner..." (Exhibit C). However, I consider the dominant portion of the Mark to be TROJAN which, having no significance when considered in association with the Goods, is inherently distinctive.

Acquired Distinctiveness and Length of Time in Use

[19] The distinctiveness of a trademark is enhanced through use and promotion in Canada [see *Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD); *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD)].

[20] While Mr. Weir states that the Opponent's trademark has been in use since at least 2005, (para 5) there is no evidence showing use prior to 2012. The Opponent's evidence includes a statement that annual unit sales of VIBRATIONS brand products were in excess of 300,000 for each of 2012, 2013 and 2014 (Weir affidavit, para 8). This figure was corrected to 200,000 under cross-examination (Qns 9-10). Mr. Weir also attests to unit sales of more than 575,000 in the period of September 2015 to August 2018 (para 8). No explanation was provided as to why annual figures were not provided for this three year period and indeed when questioned, Mr. Weir believed the figures provided to him were annual (Qn 70). As such, I can conclude only that there were sales at some point between September 2015 and August 2018, but I cannot conclude that there was use throughout the entire period.

[21] For the purposes of this case, I accept that any use of the VIBRATIONS trademark enured to the Opponent pursuant to section 50(1) of the Act as Mr. Weir states that the products were manufactured under the direction of the Opponent and distributed by Reckitt Benckiser (Canada) Inc. (para 3). When requested to do so, Mr. Weir produced various license and distribution agreements confirming the requisite control (responses to undertaking nos. 1 and 2).

[22] However, the evidence does not allow me to determine the extent to which the trademark was known or the precise length of time in use of the VIBRATIONS trademark as it does not allow me to find that the VIBRATIONS trademark appeared on packaging of the products for which Mr. Weir provides sales information as:

- a. The Opponent has not evidenced marketing or promotion of its products in Canada that might have led to increased distinctiveness (Qns 265–275). Rather, Mr. Weir simply states that the Opponent and its licensee “communicated availability” of the products (para 9).

- b. The two labels bearing the Opponent's trademark VIBRATIONS in evidence are said to be representative of those displayed on its products (para 7, Exhibit A). However, when questioned it was clear that Mr. Weir did not know how the trademark was used on packaging associated with sales of the product, as he answered "correct" to the question "And we don't know exactly how the vibrations trademark might have appeared on the packaging of product that comprised those sales, right?" (Qns 238 –247). This results in some uncertainty regarding whether the sales figures correspond to items bearing the Opponent's trademark.
- c. Mr. Weir initially stated that the Opponent sold approximately 300,000 units of its VIBRATION branded sexual well-being products in the years 2012, 2013 and 2014 (para 8). Mr. Weir then corrected this number to 200,000 units (Qns 9 –10). It is unclear whether the figure of 200,000 is intended to refer to the period of 2012 to 2014 or each of those years. However, I find that either interpretation results in the same outcome.
- d. Mr. Weir stated in his affidavit that the number of units sold from September 2015 until August 2018 amounted to 575,000 (para 8). However, the vibration sexual well-being products were discontinued in 2018 (Qns 116 –123). Therefore at best the Opponent's evidence suggests use of the mark from 2012 to 2018 in association with several hundreds of thousands of units. While the Applicant argued that the Nielsen data relied upon by Mr. Weir was unreliable as it had not been verified (Qns 66-75; Written Submissions para 12), in other cases Nielsen data has been found admissible as a business record made in the usual and ordinary course of business [*Les Marques Metro / Metro Brands S.E.N.C. v 1161396 Ontario Inc*, 2017 FC 806]. Indeed, Mr. Weir stated that this is third-party information that every consumer product goods company relies on for valid sales data (Qn 76).
- e. While use since 2005 was claimed (para 5), Mr. Weir was unable to confirm that the products were sold continuously in Canada since that time (Cross-examination, Qn 215).

[23] In contrast, Mr. Mama's evidence, which he was not cross-examined on, shows that the Mark has been used to a significant extent from September 2011 onwards. In particular:

- a. Mr. Mama provides annual sales figures of 1.3-2.9 million in sales of products bearing the Mark between 2011 and August 2020 (para 18).
- b. Mr. Mama also evidences advertising and promotion of products through a variety of means. These include advertising including flyers, shelf-talkers and product inserts (paras 16; Exhibit G). Mr. Mama's evidence, however, is silent on the circulation of the advertisements or number of stores the point of sale material appeared in (para 14).
- c. The Applicant also used website advertising (Mama affidavit, para 8, 11, 14, 17; Exhibit H) and Mr. Mama provides the number of visits to the TROJAN VIBRATIONS branded products webpage between 2017–2019 (para 11). Since the website appears to be specific to Canada, I am prepared to infer that a portion of those visits were by Canadians and that the presence of the Mark resulted in an added measure of distinctiveness acquired through advertising and promotion.

[24] As a result of the deficiencies in Mr. Weir's evidence and the greater sales volume of the Applicant's products from September 2011 onwards, this factor favours the Applicant.

Nature of the Goods and the Channels of Trade

[25] The Opponent's registered goods and the Applicant's Goods are identical and target the same consumer (adults seeking devices for sexual stimulation). Not surprisingly given the similarity in the goods, they appear to be sold through the same channels of trade (Weir affidavit, para 6 and Mama affidavit, para 19). For this reason, these factors also favour the Opponent.

Similarity in Appearance, Sound or Idea Suggested

[26] The resemblance between the trademarks is often the statutory factor likely to have the greatest influence on the confusion analysis [*Masterpiece* at 49].

[27] When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality. It is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trademarks. Nevertheless, the first component of a mark is often most important for the purpose of distinction [*Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD) [*Conde Nast*] and *Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd*, 1991 CanLII 11769 (FCA)].

[28] There is a degree of similarity in the appearance, sound and idea suggested by the parties' marks given that the entirety of the Opponent's trademark has been incorporated into the Applicant's mark. However, the Applicant's mark also contains the term TROJAN which appears first and in larger font. VIBRATIONS, owing to its descriptive nature, smaller size and positioning beneath TROJAN, is less striking and subordinate to the dominant component TROJAN. TROJAN is therefore the most important component of the Mark for the purposes of distinction [*Conde Nast* and *Masterpiece* at 63]. Confusion is unlikely in situations such as this where trademarks share common features but also possess dominant differences, such that the differences are a sufficient signal to the public that the products associated with each mark have different sources [*Foodcorp Ltd v Chalet Bar B Q (Canada) Inc* (1982), 66 CPR (2d) 56 (FCA) at 73]. Here the dominant component TROJAN in the trademark is such a signal. I therefore, find that this factor favours the Applicant.

Additional Surrounding Circumstance – No Evidence of Actual Confusion

[29] In some cases, the absence of evidence of actual confusion between the parties' marks, despite an overlap of sales of goods and the channels of trade, may lead to a negative inference about the strength of an opponent's case [*Christian Dior, SA v Dion Neckwear Ltd*, 2002 FCA 29, at 19; *Mattel* at 55; *Mr. Submarine* at para 29]. While Mr. Weir has confirmed there have been no instances of confusion that he is aware of

(Qns 133 and 152) as the evidence suggests that the Opponent's use of the VIBRATIONS trademark might not have been continuous and given the uncertainty regarding the manner of use of the Opponent's trademark on its packaging, I do not consider this circumstance to favour the Applicant.

Additional Surrounding Circumstance – Extensive Use of TROJAN with Condoms

[30] The TROJAN trademark which comprises the dominant first portion of the Mark, has been used and promoted extensively in Canada. More than half the condoms sold in Canada are TROJAN branded and this brand has been the #1 condom brand in Canada for years (Mama affidavit, paras 6 and 8). Between 2011 and 2018, the Applicant spent over \$22 million CAD in advertising of its TROJAN branded condoms and related products in Canada (Mama affidavit, para 13).

[31] Acquired distinctiveness through extensive use of a house mark by an applicant for similar goods has been found to be a relevant surrounding circumstance that may be considered as part of the confusion analysis [*Smart Cloud Inc v International Business Machines Corporation* 2021 FC 236 at para 77]. The established reputation of the Applicant's TROJAN trademark which forms the first and dominant portion of the Mark would assist consumers in distinguishing the trademarks as a matter of first impression. This is particularly so because the Opponent's trademark is weak [*Sealy Canada Ltd v Simmons Canada Inc*, 2012 TMOB 63 at para 26].

Additional Surrounding Circumstance – Jurisprudence Concerning Weak Trademarks

[32] When a word is a common, descriptive word, it is entitled to a narrower range of protection than an invented or unique word [*Laurentide Chemicals Inc v Les Marchands Deco Inc* (1985), 7 CPR (3d) 357 (FCTD) at 365].

[33] The jurisprudence on weak trademarks favours the Applicant. It is well accepted that comparatively small differences will suffice to distinguish between weak trademarks [*Boston Pizza International Inc v Boston Chicken Inc* (2001), 15 CPR (4th) 345 (FCTD) at para 66]. As explained in *Provigo Distribution Inc v Max Mara Fashion Group SRL* 2005 FC 1550 at para 31:

The two marks being inherently weak, it is fair to say that even small differences will be sufficient to distinguish among them. Were it otherwise, first user of words in common use would be unfairly allowed to monopolize these words. A further justification given by courts in coming to this conclusion is that the public is expected to be more on its guard when such weak trade names are used ...

[34] A party adopting a weak trademark has been held to accept some risk of confusion [*General Motors v Bellows* (1949), 10 CPR 101 at 115–116 (SCC)]. While it is possible for the degree of distinctiveness attributed to a weak trademark to be enhanced through extensive use [*Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD) at para 6], that is not the situation here. While evidence of sales in the form of Nielsen data exists, Mr. Weir could not confirm the manner of use of the trademark (para 8 and Qns 74, 75, 89-98, 108, 109, 112, 239-245). When asked about the sales figures he provided in his affidavit, and how the trademark appeared on the products sold, Mr. Weir stated he did not know (Qn. 247). Compounding this deficiency is the fact that the term “vibrations” has a descriptive meaning when considered in association with the goods. Absent better evidence showing the manner of use, I cannot conclude that VIBRATIONS would have acquired significant distinctiveness through the Opponent’s use.

Conclusion – Confusion Analysis

[35] Having considered all of the surrounding circumstances and applying the test of confusion as a matter of first impression and imperfect recollection, I conclude that, on a balance of probabilities, the Applicant has met its legal burden of proving that there is no reasonable likelihood of confusion. I reach this conclusion despite the overlap in the nature of the goods and trade of the parties, on the basis of the lack of inherent distinctiveness of the Opponent’s trademark, the differences between the parties trademarks in appearance, sound and idea suggested and the significance of the TROJAN component in the Mark.

Non-Entitlement and Distinctiveness Grounds

[36] While I have some doubt as to whether the Opponent meets its initial evidential burden, given the deficiencies in Mr. Weir’s evidence, to the extent that it

does for the entitlement and distinctiveness grounds of opposition, my conclusions respecting the section 12(1)(d) ground of opposition also apply. Thus, I find that the Applicant has met, at the material date of September 30, 2011 (the date of first use claimed) and April 9, 2018 (the date of filing the statement of opposition), the legal onus on it to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's VIBRATIONS trademark. While I acknowledge that the acquired distinctiveness and length of use of the Mark would be non-existent as of September 2011, and less at the material date for distinctiveness, I nonetheless find that the Applicant has met its legal onus as consumers would be able to distinguish between the Mark and the Opponent's weak trademark by virtue of the differences in the parties' trademarks in appearance, sound and idea suggested and the significance of the TROJAN component in the Mark.

Section 30(i) Ground of Opposition

[37] The Opponent pleads, pursuant to 30(i) of the Act, that the Applicant could not have been satisfied that it was entitled to use the Mark because to do so would depreciate the value of the goodwill attaching to the Opponent's trademark contrary to section 22 and that it constitutes passing off pursuant to sections 7(b) and (c) of the Act.

[38] Section 30(i) of the Act requires an applicant to declare in the application that it 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 in exceptional circumstances, such as where there is bad faith or non-compliance with a federal statute [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155; *Interactiv Design Pty Ltd v Grafton-Fraser Inc* (1998), 87 CPR (3d) 537 (TMOB) at 542-543].

[39] Section 7(b) is a codification of the common law tort of passing off. While the Registrar has previously considered such a ground to be valid [*Bojangles* at 561–562], to succeed the Opponent would have to show (i) the existence of goodwill; (ii) deception of the public due to a misrepresentation; and (iii) actual or potential damage [see *Ciba-*

Geigy Canada Ltd v Apotex Inc, [1992] 3 SCR 120 at para 33]. The evidence relied upon by the Opponent does not support the three elements required to show a violation.

[40] Section 7(c) is a codification of the common law tort of passing off through substitution. To succeed the Opponent would essentially have to prove that the Applicant supplied its own goods in response to an order for those of the Opponent. Again, there is no evidence to support this ground.

[41] To demonstrate a depreciation of goodwill under section 22 four elements are necessary. First, use of the registered trademark. Second, that the registered trademark is sufficiently known to have significant goodwill attached. Third, a likely connection or linkage in the mind of the hypothetical consumer between the trademarks. Fourth, the likely effect of use would be to depreciate the registered owner's goodwill [*Veuve Clicquot* at para 46]. Here, the evidence is insufficient to meet the Opponent's initial evidential burden. Even if I found that the Opponent's trademark had sufficient goodwill, the Opponent has not evidenced linkage of the trademarks in the mind of consumers. Indeed, given the presence of the dominant well known component TROJAN, it is difficult to see how the trademarks could be linked. Furthermore, there is no evidence that the likely effect of use of the Mark would be to depreciate the Opponent's goodwill.

[42] Consequently, I reject the section 30(i) grounds of opposition in view of the Opponent's failure to meet its initial evidential burden.

Applicant's Use of the Mark Since the Date Claimed

[43] The Opponent pleads that the application does not comply with section 30(b) of the Act because the Applicant has not used the Mark in Canada in association with adult sexual stimulation aids, namely personal vibrators, since at least as early as September 2011.

[44] While no written representations were made on this point, the Opponent's evidence includes:

- a Newswire article titled “Canadians Get Their Hearts Racing with the Launch of TROJAN® VIBRATIONS” dated February 2, 2012 (Duchesneau affidavit, para 5 and Exhibit E); and
- internet archival information from Wayback Machine showing 22 URL captures for the domain name *trojanvibrations.ca*. The earliest of these is dated March 2, 2012 [paras 6 -7 and Exhibits F, G and H]. Evidence produced by the Wayback Machine indicating the state of websites in the past has been found to be generally reliable [see *Candrug* at para 21].

[45] Taken together, this evidence does not meet the Opponent’s initial evidential burden. First, I do not find that the launch article results in the inference that the products were only available on or after the article’s publication. Further, I do not infer that the absence of a website means the Mark was not in use as of the date claimed because to do so would require the assumption that the Applicant’s first use was through a website [see *Divert, Inc v Resource Recovery Fund Board Inc*, 2022 FC 1650 at para 29 [*Divert*] where the Federal Court endorsed the Registrar’s refusal to make this type of assumption]. In this case, the Applicant’s products are sold through retail drug store and grocery chains (Mama Affidavit, para 19) as opposed to online.

[46] While an applicant is under no obligation to evidence its claimed date of first use, if an opponent has not met its initial evidential burden [*Divert*, at para 19], Mr. Mama has stated that the Applicant sold products branded with the Mark since at least as early as September 2011 (para 10). Further, the information regarding units sold annually suggests a very respectable level of sales in 2011 relative to other years (para 18). The Applicant’s sales data supports its claim of having used the Mark since September 2011. Additionally, if the Opponent wished further clarity or precision regarding sales data, it was at liberty to cross-examine Mr. Mama. It did not do so.

[47] As the Opponent has failed to meet its initial evidential burden, this ground of opposition is rejected.

DISPOSITION

[48] For the reasons provided above and 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.

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-01-17

APPEARANCES

For the Opponent: No one appearing

For the Applicant: Stephanie N. Vaccari

AGENTS OF RECORD

For the Opponent: Smart & Biggar LP

For the Applicant: Baker & McKenzie LLP