



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 191

Date of Decision: 2023-11-10

IN THE MATTER OF AN OPPOSITION

Opponent: BASF Agricultural Solutions Seed US LLC

Applicant: NewAgco Inc.

Application: 1869941 for VIGOR

INTRODUCTION

[1] BASF Agricultural Solutions Seed US LLC (the Opponent) opposes registration of the trademark VIGOR (the Mark) which is the subject of application No. 1869941 filed by NewAgco Inc. (the Applicant).

[2] The Mark is applied for in association with the following goods on the basis of proposed use in Canada (the Applicant's Goods):

CI 5 (1) A crop protection product, namely, herbicides.

[3] With the exception of the ground of bad faith, all grounds of opposition pleaded by the Opponent are rooted in an allegation of confusion with the Opponent's registered trademark No. TMA483211 for INVIGOR (the Opponent's

Trademark), which is registered in association with the Class 31 goods “Plants and reproductive material of plants, namely, seeds” (the Opponent’s Goods).

[4] For the reasons set out below, I refuse the application.

THE RECORD

[5] The application for the Mark was filed on November 27, 2017, and was advertised for opposition purposes on February 3, 2021.

[6] On March 29, 2021, the Opponent opposed the application by filing a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 as amended June 17, 2019 (the Act).

[7] The grounds of opposition are based on bad faith (section 38(2)(a.1)); non-registrability under section 12(1)(d); non-entitlement to registration under section 38(2)(c) and 16(1)(a); non-distinctiveness under section 2; and non-entitlement to use under section 38(2)(f) of the Act.

[8] The Applicant filed a counterstatement denying the grounds of opposition.

[9] In support of its opposition, the Opponent filed the affidavit of Blaine Woycheshin, sworn September 16, 2021 (the Woycheshin Affidavit).

[10] Mr. Woycheshin was cross-examined on his affidavit on February 11, 2022. Transcripts of the Woycheshin cross-examination were filed by the Opponent on March 15, 2022 (the Woycheshin Transcript).

[11] In support of its application, the Applicant filed the affidavits of Brian Rumberg, sworn September 28, 2022 (the Rumberg Affidavit) and Dorothy Dacres, sworn September 28, 2022 (the Dacres Affidavit).

[12] Both parties filed written representations and attended a hearing.

OVERVIEW OF THE OPPONENT'S EVIDENCE

The Woycheshin Affidavit

[13] Mr. Woycheshin is the Canadian InVigor Lead for BASF Canada Inc. (BASF Canada), a position he has held since 2011, initially for the predecessor-in-title to BASF Canada [para 1].

[14] Mr. Woycheshin attests to the following in his affidavit:

- both the Opponent and BASF Canada are wholly owned subsidiaries of BASF SE (the BASF Parent) [paras 5 and 6].
- the market share the BASF group of companies (which includes the Opponent, BASF Canada and BASF Agricultural Solutions Ontario Ltd. (BASF Ontario)) holds globally is the fourth largest market share in the agricultural solutions industry. Specifically in canola in Canada being 57.7% of the market share in 2018 [paras 6 and 7].
- in August 2018, BASF Parent acquired “a range of businesses and assets relating to crop protection, digital farming, seeds, non-selective herbicides and nematicide” including all rights in the Opponent’s Trademark with all associated goodwill attaching thereto along with the corresponding Canadian trademark registration [para 8].
- the BASF Parent assigned its rights in the Opponent’s Trademark to the Opponent in August 2018 [para 9]. The Opponent licensed the rights in the Opponent’s Trademark to BASF Ontario in August 2018. BASF Ontario and BASF Canada amalgamated in 2019 (collectively referred to as BASF Canada) [para 10]. As part of the licensing relationship between the Opponent and BASF Canada, the Opponent has “decisive control over the character and quality of goods manufactured and sold” in association with the Opponent’s Trademark as well as the specific manner in which the Opponent’s Trademark is used and displayed [para 12].
- BASF Canada is authorized, as a licensee, to “plant, grow, harvest, process, package and/or otherwise manufacture, market sell and distribute” seeds

associated with the Opponent's Trademark in Canada. Such sales are typically made to a network of distributors who then sell to growers [para 11].

- goods associated with the Opponent's Trademark were introduced to the Canadian market in 1996. The Opponent's Trademark has always been clearly displayed on the packaging of goods sold in Canada as well as in advertisements [para 13, Exhibits 4-A and 4-B].
- in 2001, the Opponent's predecessor-in-title had sales of close to \$1 million of the Opponent's Goods in Canada, representing the sale of over 6000 bags [para 14]. Since 2001, sales of the Opponent's Goods have continued to increase with sales in 2016, 2017 and 2018 of over one million bags sold over these years [para 15].
- invoices issued by BASF Canada (as well as BASF Ontario from prior to amalgamation) for sales of the Opponent's Goods in Canada between 2018 and 2020 representative of the manner in which the Opponent's Trademark is and was attached to invoices are attached as Exhibit 5. Invoices from prior to 2018 are not accessible as such sales occurred prior to the assignment to the BASF Parent [para 16].
- BASF Canada, as licensee, regularly performs Demonstration Strip Trial tests on the Opponent's Goods and provides growers with trial results to facilitate informed decisions with respect to the Opponent's Goods [para 18, Exhibit 6].
- samples of archived webpages from the Opponent's predecessor-in-title from June 2013 and June 2017 are attached as Exhibit 7 [para 21].
- as licensee, BASF Canada has continuously advertised and promoted the Opponent's Goods in Canada since August 2018 online, in print media, television or radio [para 22].
- since August 2018, BASF Canada has spent over \$1.7 million (CAD) advertising the Opponent's Goods in Canada, including printed media, out of home media, television and radio, and third-party websites [para 23].

- samples of advertising of the Opponent's Goods include pages printed from BASF Canada's websites displaying information about the Opponent's Goods which are substantially similar or identical to the webpages that have been continuously available on the BASF Canada websites since August 2018 [para 24, Exhibit 8].
- between August 2018 and February 2019, approximately 30,000 Canadians viewed webpages on one of BASF Canada's websites related to the Opponent's Goods [para 25]. Promotional materials for the Opponent's Goods in Canada for the years 2016, 2017 and 2018 are attached as Exhibit 9 and examples of the social media presence of the Opponent and the Opponent's Goods are attached as Exhibits 10-A and 10-B [paras 25 and 26].
- the Opponent's Trademark "has acquired a preeminent reputation in the agriculture industry in Canada" and is of significant and increasing value to the Opponent and its Canadian licensee, BASF Canada [para 27].

OVERVIEW OF THE APPLICANT'S EVIDENCE

The Rumberg Affidavit

[15] Mr. Rumberg is the national sales manager for AgraCity Crop & Nutrition Ltd. (AgraCity), a licensee of the Applicant. Mr. Rumberg has over 20 years of experience in the agricultural business, primarily in the supply of crop protection products and related goods [Rumberg Affidavit, para 1].

[16] The Rumberg Affidavit contains, *inter alia*, the following statements and exhibits:

- AgraCity, the distributor of the Applicant's Goods in Canada, is licensed by the Applicant to use the Mark in Canada. The Applicant maintains control over the quality and character of the Applicant's Goods [para 4].
- The Mark was first used with the Applicant's Goods in Canada in 2018. The Applicant's Goods are sold directly to farmers and not through distributors,

which makes the channel of trade of the Opponent's Goods different from that of the Applicant [para 5].

- Neither AgraCity or the Applicant import, manufacture or sell seeds or any other plant products [para 6].
- In Mr. Rumberg's experience, farmers consider seeds and crop protection products such as herbicides to be very different. Many seed companies do not sell herbicides and, *vice versa*, many companies that sell crop protection goods do not sell seed. Many companies that sell both seed and crop protection products do so under different brands. Further, the decision to purchase seed and crop protection products are often made at different times of the year [para 7].
- A copy of a label used on the Applicant's Goods bearing the Mark is attached as Exhibit B [para 8]. A copy of a further regulatory label is attached as Exhibit C [para 9].
- AgraCity's sales revenue for the Applicant's Goods for annual periods from October 2017 to July 2022, ranged from over \$900,000 to over \$5 million [para 10].
- A copy of an excerpt from the AgraCity 2022 Agricultural Product Guide (the Guide) featuring the Mark is attached as Exhibit D. The Guide is available on the AgraCity website and is also circulated in paper form. Since 2008, over 20,000 Guides have been distributed by AgraCity in Canada [para 11].
- The Mark is used in advertising of the Applicant's Goods on the AgraCity website. A printout of this website advertising is attached as Exhibit E. Since December 2019, this webpage has had over 1200 unique pageviews [para 12].
- Sample invoices for the sale of the Applicant's Goods in 2019, 2020, 2021 and 2022 are attached as Exhibit G [para 13].
- A third party, NutriAg Ltd., uses the trademark VIGORMAX on seed treatment products in Canada [para 14].

The Dacres Affidavit

[17] Ms. Dacres is a legal assistant employed by the Applicant's agent [para 1].

[18] In September 2022, Ms. Dacres conducted searches of:

- the Clarivate Analytics database of Canadian trademark records for trademarks containing the word VIGOR in Classes 1, 5, and 44 [para 2]. A copy of these search results is attached as Exhibit A; and
- the Canadian Intellectual Property Office website to obtain details of the trademarks located in the Clarivate Analytics search described above [para 3]. A copy of these trademark details is attached as Exhibit B.

EVIDENTIAL BURDEN AND LEGAL ONUS

[19] 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 (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 admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist [*John Labatt*, at 298]. 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 [*Dion Neckwear Ltd v Christian Dior, SA*, 2002 FCA 29].

[20] For those allegations for which the Opponent has met its evidential burden, the legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. 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 it.

PRELIMINARY MATTER – ADMISSIBILITY OF THE OPPONENT’S EVIDENCE

[21] In its written arguments, the Applicant raised two issues regarding the Woycheshin Affidavit; first, that the affidavit contains inadmissible hearsay and, second, that the affidavit should be struck in its entirety due to Opponent’s counsel’s refusal to allow Mr. Woycheshin to respond to questions relating to third-party trademarks during cross-examination [Applicant’s written representations, paras 36 and 37].

[22] Specifically, the Applicant takes issue with paragraphs 7, 21 and 28 of the Woycheshin Affidavit for containing inadmissible hearsay given that Mr. Woycheshin:

- acknowledged on cross-examination that he did not have personal knowledge of the sales of third parties referenced in a report attached as Exhibit 1 (referenced in paragraph 7 of the Woycheshin Affidavit);
- admitted on cross-examination that the webpage printouts in Exhibit 7, as referenced in paragraph 21, were provided to him by his communications team; and
- the information relating to the number of views of the BASF Canada website were provided by an ad agency [Applicant’s written representations, para 36].

[23] Hearsay evidence is *prima facie* inadmissible unless it satisfies the criteria of necessity and reliability [see *Labatt Brewing Co v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FC)].

[24] In respect of the first point of concern raised by the Applicant in respect of Exhibit 1, on cross-examination, Mr. Woycheshin confirmed that the report in Exhibit 1 of his affidavit was generated from an AGDATA BPI Canola Seed Report, August 29, 2018, confirmed that he had seen this underlying report before, had a copy of the underlying report in his files and advised that the “accuracy would be very high on this” referring to the information contained in Exhibit 1 [Woycheshin Transcript, Qs 55-57]. Based on these statements, I am satisfied that Mr. Woycheshin has personal knowledge of the information contained in Exhibit 1 and reject the hearsay objection.

[25] Regarding the second objection raised by the Applicant in respect of the Woycheshin Affidavit, regardless of who printed the web pages contained in Exhibit 7, they act only as evidence of the existence of those pages as of the day they were printed and are inadmissible hearsay evidence with respect to the information that appears on the webpages [see *TCG International Inc v Autosock AS*, 2006 CanLII 80379 (CA TMOB) citing *Envirodrive Inc v 836442 Alberta Inc*, 2005 ABQB 446 (CanLII)].

[26] With respect to the third objection regarding the information relating to the number of views of the Opponent's website provided by an advertising agency, I am satisfied from the response given by Mr. Woycheshin on cross-examination that the information was reliable and necessary [Woycheshin Transcript, Q69]. Mr. Woycheshin advised that the information regarding the number of views of the Opponent's website was provided by the Opponent's strategic partner and ad agency of record that tracked the metrics for the Opponent's website and that the information provided by this agency were standard metrics the Opponent reviewed every year [Woycheshin Transcript, Q 70]. As such, I consider this information to have been obtained as part of the standard business practices of the Opponent which Mr. Woycheshin was familiar with and find that it is reasonable that this evidence was submitted through the Woycheshin Affidavit.

[27] Lastly, with respect to the Applicant's request that the Woycheshin Affidavit be struck in its entirety due to the Opponent's counsel's refusal to allow Mr. Woycheshin answer questions relating to his knowledge of third-party trademarks, I am of the view that the appropriate remedy is to draw a negative inference against the Opponent in respect of the refusal and not to strike all or any part of the Woycheshin Affidavit.

PRELIMINARY MATTER – PREDECESSOR-IN-TITLE USE OF THE OPPONENT'S TRADEMARK

[28] As discussed in the evidence summary above, the Opponent acquired rights in the Opponent's Trademark on August 1, 2018 by virtue of an asset purchase agreement [Woycheshin Affidavit, para 8]. The immediate prior owner of the

Opponent's Trademark was Bayer Intellectual Property GmbH (Bayer IP), with which the Opponent entered an ancillary agreement with respect to the rights in the Opponent's Trademark [Woycheshin Affidavit, para 8].

[29] The Opponent's Goods were introduced into the Canadian market in 1996 and have been continuously sold since that time [Woycheshin Affidavit, para 13]. Further, as of that date and since, the Opponent's Trademark has always been clearly displayed on all packaging of the Opponent's Goods in Canada [Woycheshin Affidavit, para 13]. However, as the Opponent only acquired the Opponent's Trademark in August 2018, it was not able to provide invoices issued by the predecessors-in-title prior to this date [Woycheshin Affidavit, para 16].

[30] Nonetheless, the Opponent submits that prior to August 1, 2018, the Opponent's Trademark was "owned and used by other companies, all of which should be considered as predecessors-in-title of [the Opponent] in respect of the [Opponent's Trademark] and all rights and goodwill associated thereto" [Woycheshin Affidavit, para 8].

[31] For its part, the Applicant submits that "there is no evidence of any use of the [Opponent's Trademark] in Canada by Bayer IP or by any other company in such a manner that the requirements of section 50 of the *Trademarks Act* were met" [Applicant's written representations, para 15]. The Applicant further submits that the Opponent's own evidence demonstrates use of the Opponent's Trademark in Canada between 2015 and 2019 on canola seed packaging bearing the name Bayer Cropscience Inc. and that this packaging contains a copyright notice "indicating that Bayer Cropscience Inc. was the copyright owner, presumably in the artwork and text on the bags" while the then-owner of the Opponent's Trademark, Bayer IP, did not appear anywhere on the packaging [Applicant's written representations, paras 13 and 14]. The Applicant submits that there is "no evidence of any licence by Bayer IP to Bayer Cropscience Inc. or of any control of the character or quality of the goods sold in Canada by Bayer IP" and that it is impossible to determine the identity of the owner of the Opponent's Goods as there is no notice on the packaging of the Opponent's

Goods indicating that the Opponent's Trademark is being used under licence [Applicant's written representations, paras 16 and 17]. Accordingly, it is the Applicant's position that there is no basis upon which it can be concluded that any use of the Opponent's Trademark prior to August 1, 2018 was by, or was deemed to be by, the then owner, which was Bayer IP [Applicant's written representations, para 18].

[32] At the hearing, when addressing the issue of whether use of the Opponent's Trademark prior to August 1, 2018 was "use" under licence in accordance with section 50 of the Act that could enure to the Opponent, the Opponent submitted that the Woycheshin Affidavit "reveals hints of control by the predecessors-in-title" of the Opponent's Trademark.

[33] I find the Opponent's evidence and submissions on the issue of use of the Opponent's Trademark prior to August 1, 2018 to be, at best, ambiguous. Even if it can be concluded that the Opponent's Trademark was in use in Canada by entities related to the immediate predecessor-in-title of the Opponent's Trademark prior to August 1, 2018, there is no evidence to conclude that such use met the requirement of section 50(1) of the Act. Indeed, it is trite law that a corporate relationship, on its own, is insufficient to satisfy the requirement of section 50 of the Act [see *MCI Communications Corp v MCI Multinet Communications Inc* (1995), 61 CPR (3d) 245 (TMOB); *Dynatech Automation Systems Inc v Dynatech Corp* (1995), 64 CPR (3d) 101 (TMOB)].

[34] As the evidence falls short of establishing that the Opponent's Trademark was used in Canada in accordance with sections 4 and 50 of the Act prior to August 1, 2018, I cannot consider any such use accrued to the benefit of the Opponent. I therefore consider the earliest date of first use of the Opponent's Trademark to be when the Opponent itself began use of the Opponent's Trademark, which necessarily can be no earlier than the August 1, 2018 date of acquisition.

[35] The Applicant also asserted that use of the Opponent's Trademark by multiple, apparently unlicensed, entities prior to its acquisition by the Opponent on August 1, 2018 negates any potential distinctiveness of the Opponent's Trademark [Applicant's written representations, para 33]. While I have determined the Opponent cannot rely on use of the Opponent's Trademark by the Opponent's predecessors-in-title, I am not prepared to conclude that use by the Opponent's predecessors-in-title negates the distinctiveness of the Opponent's Trademark. The Opponent has owned and used the Opponent's Trademark in Canada since August 1, 2018 by virtue of its license agreement with BASF Canada, meaning that the Opponent has been amassing acquired distinctiveness in the Opponent's Trademark since that date. I find that the over five years of consistent use of the Opponent's Trademark by the Opponent and/or its licensee BASF Canada is not significantly affected, and is certainly not negated, by the prior use by predecessors-in-title [see *Boston Pizza International Inc v Boston Chicken Inc*, 2005 CanLII 78252 (CA TMOB) for similar reasoning].

ANALYSIS OF THE GROUNDS OF OPPOSITION

Section 38(2)(a.1) Ground – Bad Faith

[36] The Opponent pleads that the application for the Mark was filed in bad faith as the Applicant is a competitor of the Opponent and promotes the herbicide associated with the Mark as being for use on the canola seeds sold in association with the Opponent's Trademark. The Opponent further pleads that the Applicant applied for registration of the Mark "intentionally misrepresenting sponsorship or affiliation between the parties' products, services and businesses, and knowingly tethering to the well-established and respected goodwill and reputation of the Opponent's [Trademark]".

[37] The material date for assessing this ground of opposition is the filing date of the application, November 27, 2017.

[38] It is well established that mere knowledge of another's trademark does not in and of itself support an allegation of bad faith [*Woot Inc v Woot Restaurants Inc / Les Restaurants Woot Inc*, 2012 TMOB 197]. Mere wilful blindness or a failure to inquire into a competitor's rights is also insufficient to constitute bad faith [*Blossman Gas Inc v Alliance Autopropane Inc*, 2022 FC 1794 (CanLII)]. While circumstances where an applicant is attempting to take advantage of the reputation of another can form a successful ground of opposition, this assertion must be supported by evidence [*Yiwu Thousand Shores E-Commerce Co Ltd v Lin*, 2021 FC 1040 (CanLII)].

[39] In the present case, there is no evidence of bad faith or, more specifically, no evidence to support the assertion that the Applicant was attempting to associate the Applicant's Goods with those of the Opponent in an attempt to take advantage of the goodwill and reputation of the Opponent's Trademark.

[40] Accordingly, this ground of opposition is rejected.

Section 38(2)(f) – Entitlement to Use

[41] The Opponent pleads that the Applicant was not entitled to use the Mark in Canada in association with the Applicant's Goods for the reasons summarized below, namely, that the Applicant:

- is a competitor of the Opponent;
- knew (or should be deemed to be aware) of the Opponent's rights in the Opponent's Trademark;
- filed the application for the Mark knowing it would create confusion with the Opponent's Trademark and infringe on the Opponent's rights contrary to section 20 of the Act; and
- knew that use of the Mark in association with the Applicant's Goods would be and is unlawful as such use is likely to have the effect of depreciating the goodwill in the Opponent's Trademark contrary to section 22 of the Act and would draw attention to the Applicant's Goods in a way that would cause

confusion between these goods and the Opponent and the Opponent's Goods contrary to paragraph 7(b) of the Act.

[42] The material date for this ground is the filing date of the Application for the Mark, namely, November 27, 2017.

[43] As discussed above under preliminary matters, I do not consider the Opponent's evidence of use of the Opponent's Trademark prior to the Opponent's August 1, 2018 acquisition date of the Opponent's Trademark to be attributable to the Opponent given that the evidence of use of the Opponent's Trademark by the predecessors-in-title was insufficient to support use of the Opponent's Trademark in accordance with section 50 of the Act.

[44] Since I have determined that the earliest use of the Opponent's Trademark post-dates the filing date of the application for the Mark, the Opponent has failed to meet its initial evidentiary burden for this ground of opposition.

[45] This ground of opposition is therefore rejected.

Section 12(1)(d) Ground - Registrability

[46] The determinative issue for decision raised by all remaining grounds of opposition is whether the Mark is confusing with the Opponent's Trademark. As such, I will first address the issue of likelihood of confusion under what I consider to be the Opponent's strongest ground, that being the section 12(1)(d) ground.

[47] The relevant date for this ground of opposition is date of my decision [*Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd*, (1991), 37 CPR (3d) 413 (FCA)].

[48] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if the registration(s) relied upon remain in good standing as of the date of the opposition decision. The Registrar has discretion to check the register and I have exercised this discretion to confirm the Opponent's Trademark remains extant [see

Quaker Oats Co of Canada Ltd/La Compagnie Quakers Oats du Canada Ltée v Menu Foods Ltd. (1986), 11 CPR (3d) 410 (TMOB)]. I therefore find that the Opponent has satisfied its evidential burden. I must now assess whether the Applicant has met its legal burden.

The Test for Confusion

[49] Section 6(2) of the Act stipulates that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely 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.

[50] Therefore, section 6(2) of the Act does not concern confusion of the trademarks themselves, but of the goods or services from one source as being from another. Essentially, the question here is whether an average consumer, with an imperfect recollection of the Opponent's Trademark, would think that the goods contained in the application for the Mark emanate from, are sponsored by, or approved by the Opponent.

[51] In applying the test for confusion, I must take into consideration all the relevant surrounding circumstances, including those listed 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 they have 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 criteria are not exhaustive and different weight will be given to each one in a context-specific assessment [*Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée*, 2006 SCC 23]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 where the Supreme Court of Canada states at para 49 that section 6(5)(e), the resemblance between the trademarks, will often have the greatest effect on the confusion analysis.

Degree of Resemblance

[52] The Supreme Court of Canada suggested in *Masterpiece* at paragraph 49, that a consideration of the resemblance between the marks is where most confusion analyses should start. If the marks do not resemble each other, it is unlikely that even a strong finding on other factors would lead to a finding that there was a likelihood of confusion.

[53] When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality. The appropriate test is not a side by side comparison but an imperfect recollection in the mind of a consumer of an opponent's trademark [*Veuve Clicquot*, at para 20]. The preferable approach when comparing trademarks is to begin by determining whether there is an aspect of a trademark that is particularly striking or unique [see *Masterpiece* at para 64].

[54] For its part, the Opponent submits that although the Opponent's Trademark is the word INVIGOR, the "predominant and striking element" of the parties' marks is the term VIGOR [Opponent's written representations, para 62]. I note that the Opponent also depicted the stylized version in its written representations which capitalizes the initial "I" and the letter "V" appearing as **InVigor** to support its argument that the distinctive element of the Opponent's Trademark is the word "vigor" [Opponent's written representations, para 62]. However, as it is the trademark as registered rather than as used that must be considered, this is not a relevant consideration for the purposes of this ground of opposition. In any event, the fact that the Opponent's Trademark is commonly used with a capitalized "I" and "V" would not significantly impact my findings with respect to degree of resemblance.

[55] The Applicant submits that the Opponent's Trademark is distinguishable from the Mark in sound in that the Opponent's Trademark is comprised of two syllables instead of one and that the "in" prefix of the Opponent's Trademark not only results in a different pronunciation of the marks but also a different appearance [Applicant's written representations, para 53]. The Applicant also submits that the marks at issue

convey different ideas in that INVIGOR would be connected with the same idea as the word “invigorate” which suggests the associated goods would “give life and energy to”, whereas the Mark, namely, VIGOR, conveys a different idea, being “active bodily or mental strength or force”, “active healthy well-balanced growth especially of plants” or “intensity of action or effect” [Applicant’s written representations, para 55]. Finally, the Applicant points out that both of the marks at issue are weak marks overall and that, accordingly, small differences in sound, appearance and idea suggested are acceptable to distinguish one mark from the other [Applicant’s written representations, para 56].

[56] I do not fully agree with either party on this issue. Despite the Opponent’s assertion that the marks at issue share the same distinctive element, namely, the word “vigor”, in my view it is not this dictionary word that is the most distinctive element of the Opponent’s Trademark. Rather, it is the Opponent’s Trademark as a whole that is distinctive given that it is technically not a dictionary word, although it is very close to, and highly suggestive of, the common dictionary word “invigorate”. The Mark itself is comprised exclusively of the common dictionary word “vigor” and really has no particularly striking or unique element.

[57] I also do not find the Applicant’s submissions on the degree of resemblance to be persuasive. Although the dictionary meanings of the words “vigor” and “invigorate” (the latter of which in my view would essentially be the initial thought an average consumer would have on first impression of the Opponent’s Trademark) do differ slightly in that the Mark is a noun and the Opponent’s Trademark is a verb, in my view, the general concept conveyed by the trademarks of both parties is essentially the same, i.e. that the goods associated with each trademark impart strength, resiliency, vitality and robustness.

[58] Overall, I am of the view that the trademarks at issue are very similar in appearance, sound and idea suggested. As a result, this factor favours the Opponent.

Length of Time the Trademarks Have Been in Use

[59] As discussed in detail above under preliminary matters, I have found that the earliest date of use that can be attributed to the Opponent's Trademark is August 1, 2018.

[60] The Applicant's evidence is also somewhat ambiguous as the Rumberg Affidavit indicates that the Applicant's Goods were "first introduced and sold in Canada in 2018" but does not provide further details as to when in 2018 use first occurred, other than to provide a sales figure for goods sold in association with the Mark for the period of October 1, 2017 to September 30, 2018, suggesting that there were notable sales at some point prior to September 30, 2018 [paras 8 and 10]. It is not clear when in the period between October 2017 and September 2018 the Applicant's Goods were sold, although based on Mr. Rumberg's sworn statement, sales did not occur until 2018. I cannot give the Applicant the benefit of nearly a year of sales that may or may not have occurred prior to September 2018. As such, I consider the earliest use to be the latest date in the prescribed period, being September 2018.

[61] Given the lack of clarity in the evidence presented by both parties regarding use of their respective marks, I cannot find that either party is favoured by this factor. In any event, the evidence of both parties suggests that use of their respective marks commenced at some point in August/September 2018. Accordingly, even if the evidence clearly established use of either the Mark or the Opponent's Trademark as first in time, the amount of prior use would be limited to a few months at best, which is unlikely to significantly favour the party with the earlier use.

[62] Accordingly, neither party is favoured by this factor.

Inherent and Acquired Distinctiveness

[63] The Opponent submits that as the Mark is a common dictionary word, it has a low level of inherent distinctiveness and that, in contrast, the Opponent's Trademark is not a common dictionary word (although the Opponent does submit that the

Opponent's Trademark may suggest a connection with the verb "invigorate") and thus possesses a "fair degree" of inherent distinctiveness [Opponent's written representations, paras 31 and 32].

[64] While the Opponent's assertions regarding its trademark are factually accurate, in my view, an average consumer would, on first impression, recognize the Opponent's Trademark essentially as a common dictionary word given its close resemblance to the words "invigorate" and "vigor". Accordingly, while the Opponent's Trademark could be considered to have a higher level of inherent distinctiveness than the Mark, in my view it is insufficient to be materially relevant in this case.

[65] The acquired distinctiveness of a trademark refers to the extent to which it has become known in Canada through use and promotion. In the present case, the Opponent has submitted evidence relating to the advertising and sales of the Opponent's Goods, however, most of this evidence pre-dates the Opponent's August 1, 2018 acquisition date of the Opponent's Trademark. As discussed under preliminary matters above, it is not clear that this prior use was in compliance with sections 4 and 50 of the Act. Accordingly, I cannot conclude that use of the Opponent's Trademark by the predecessors in title actually contributed to the acquired distinctiveness of the mark.

[66] The Opponent's evidence of use of its trademark after its acquisition on August 1, 2018 is limited to the statement that over 1 million bags of the Opponent's Goods were sold in 2018 (but does not specify the portion of these sales that occurred after August 1, 2018) and invoices for sales in 2019 and 2020 [Woycheshin Affidavit, paras 15 and 16, Exhibit 5]. The Opponent has also spent over \$1.7 million CAD advertising the Opponent's Trademark on its websites, third-party websites, print media, television or radio in Canada since August 1, 2018 [Woycheshin Affidavit, paras 22 and 23].

[67] The Applicant submitted evidence of sales of the Applicant's Goods back to 2018, although no specific date of first use in 2018 was provided and the earliest

sample invoice provided by the Applicant is dated November 13, 2019 [Rumberg Affidavit, paras 3, 5 and 10]. The Applicant's sales revenue figures do show close to one million CAD for the period of October 1, 2017 to September 30, 2018 which indicates the sales of the Applicant's Goods commenced at some point prior to September 30, 2018 [Rumberg Affidavit, para 10].

[68] With respect to advertising, the Applicant provided details in respect of advertising on the AgraCity website that has had over 1200 unique pageviews, being views by unique users, since December 2019 [Rumberg Affidavit, para 12]. However, I note that it is not clear how many of these unique views were by Canadians and this is not addressed in the Applicant's evidence [Rumberg Affidavit, para 12].

[69] The evidence on record demonstrates that the parties commenced use of their respective trademarks around the same time in 2018. The Applicant has provided annual sales revenues, but no evidence relating to advertising expenditures or any advertising other than on its website (which may or may not relate to views by Canadians) and the distribution of product guides, while the Opponent has provided details on advertising expenditures and the nature of its advertising activities but no sales figures for the relevant time period (which commenced on August 1, 2018).

[70] I note that it is not clear why the Opponent failed to provide evidence of annual sales for the years it has owned the Opponent's Trademark, or why the Applicant failed to provide advertising expenditures, but either of these pieces of information would have been needed to possibly conclude that one party has developed superior acquired distinctiveness.

[71] As a result of the deficiencies in the evidence on record, it cannot be said that either party is favoured in respect of acquired distinctiveness.

[72] Accordingly, overall, this factor favours neither party.

Nature of the Goods and Business

[73] When considering this factor in the assessment of confusion, it is the statement of goods as defined in the registration relied upon by the Opponent and the statement of goods in the opposed application that govern the assessment of the likelihood of confusion [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[74] Both parties made submissions regarding their respective goods and the nature of the businesses associated with their respective trademarks as well as the description of the average consumer of the goods associated with those trademarks.

[75] For its part, the Opponent submits that although the respective goods of the parties do not belong to the same general class, there is a clear connection between the Opponent's Goods (being seeds) and the Applicant's Goods (being herbicides) [Opponent's written representations, para 46].

[76] I note that the Opponent also included a table of Canadian trademark registrations and applications that cover both seeds as well as treatments such as herbicides, pesticides and fertilizers in its submissions as evidence of the state of the Canadian Trademarks Register [Opponent's written representations, para 48]. Although the chart was generated based on companies referenced in the Rumberg Affidavit, I agree with the Applicant that this chart is new evidence that cannot be submitted for the first time in written arguments. I have therefore given no weight to this chart and the related submissions made by the Opponent [Opponent's written representations, paras 48 and 49].

[77] The Applicant submits that although its goods and the Opponent's Goods may be somewhat related in that they are both used in the agriculture industry, the Rumberg Affidavit contains unchallenged evidence that "in the mind of the consumer, in this case farmers, brands of seeds are not typically associated with brands of herbicide" [Applicant's written representations, para 69].

[78] I do not consider the vague statements in the Rumberg Affidavit to be conclusive or persuasive. Mr. Rumberg's statements that "many seed companies do not sell herbicides or other crop protection products", "many crop protection companies do not sell seed" and "some companies that sell both seeds and herbicides use different brands" do not meaningfully detract from the clear connection between the Opponent's seeds and the Applicant's herbicides. Further, as the Opponent points out, the Applicant's Goods are intended to be used on the Opponent's Goods [Opponent's written representations, para 46, referring to the Rumberg Affidavit, para 6].

[79] Based on the evidence of record, I consider this factor favours the Opponent.

Nature of the Trade

[80] The Applicant submits that the channels of trade of the parties differ significantly as AgraCity sells the Applicant's Goods to farmers while the Opponent's Goods are sold to distributors [Applicant's written representations, para 71]. The Applicant also submits that the decision to purchase seed (such as the Opponent's Goods) and crop protection (such as the Applicant's Goods) "are often made at different times of year, especially for canola farmers" as seed purchases typically occur between August and November while herbicides are typically purchased in winter or early spring [Applicant's written representations, para 27].

[81] As noted above, the proper approach to take when assessing likelihood of confusion under section 12(1)(d) is to consider the statement of goods in the application and registration at issue, rather than actual use in the marketplace [*Henkel, Mr. Submarine*]. It is not necessary to prove that the parties' goods are actually sold in the same channels of trade, as long as the parties are entitled to do so [*Eminence, SA v Registrar of Trade Marks* (1977) 39 CPR (2d) 40 (FC) at para 43].

[82] I therefore do not find the Applicant's submissions regarding the initial consumers of the Opponent's Goods and the Applicant's Goods, or the times of year

such goods are sold (which in any event appear to overlap to some extent in early winter) to be of assistance to the Applicant. No restrictions on the channels of trade exist in either the Opponent's registration or the application at issue. Further, as the Opponent notes, farmers are the ultimate consumers of both parties' goods [Opponent's written representations, para 57].

[83] As there appears to be at least a potential, if not actual, overlap in the channels of trade associated with the goods of the parties, this factor favours the Opponent.

Surrounding Circumstance – State of the Register/State of the Marketplace

[84] The Applicant submits that the Dacres Affidavit shows evidence of at least 18 trademark applications and registrations on the Canadian trademarks register owned by 11 different persons that incorporate the word VIGOR and are associated with goods and services in classes 1, 5, and 22 [Applicant's written representations, para 79]. The Applicant specifically highlights the VIGOR TRIGGER registration, which it states, without evidence, is owned by a direct competitor of the Opponent in the field of seed treatment products [Applicant's written representations, para 79]. Finally, the Applicant points to the Rumberg Affidavit as evidence that the trademark VIGORMAX is used by the third-party company NutriAg Ltd. on seed treatment products in Canada [Rumberg Affidavit, para 14].

[85] State of the register evidence is relevant to the extent that inferences may be drawn from it concerning the state of the marketplace in Canada; such inferences can only be drawn when a large number of relevant trademark registrations are located [*McDowell v Laverana GmbH & Co KG*, 2017 FC 327 at para 42; see also *Caterpillar Inc v Puma SE*, 2021 FC 974 at paras 91-94]. Relevant trademarks include those that are registered for similar goods and services as the marks at issue and incorporate the component at issue in a material way [*Sobeys West Inc v Schwan's IP, LLC*, 2015 TMOB 197 at para 38].

[86] First, I note that the registration for the VIGOR TRIGGER referenced by the Applicant was expunged on November 2020 and is therefore not relevant to this proceeding.

[87] With respect to the remaining 17 registrations identified by the Applicant from the searches contained in the Dacres Affidavit, the Opponent points out that eight of these registrations are owned by the same owner (Home Depot International, Inc.) and of these registrations all are for trademarks that are comprised of or contain the word VIGORO, which is arguably materially different from the words VIGOR and INVIGOR given that it is suggestive of the word FIGARO at least as much as it is to the trademarks at issue [Opponent's written representations, para 68]. Of the remaining registrations identified by the Applicant through the Dacres Affidavit, two are Official Marks and only three are for registered trademarks that contain the word VIGOR in some form (VIGORTONE, VIGORMAX and TURFVIGOR) and are also associated with agricultural-related products.

[88] I do not consider the number of trademarks identified by the Applicant through the Dacres Affidavit to represent a sufficient number of registrations to draw the inference that the word VIGOR is commonly used in the marketplace with agricultural-related goods or services in Canada. The possible use of a few (in this case, three separate third-party marks and a group of 8 VIGORO registrations in the name of a single owner), does not, in my view, have any measurable impact on the determination of whether a person might reasonably be likely to mistake the Mark for the Opponent's Trademark [see *Canadian Olympic Association v SmithKline Beecham Biologicals SA*, 2001 CanLII 38020 (CA TMOB)].

[89] Accordingly, this factor does not assist the Applicant.

Conclusion

[90] Having considered all of the surrounding circumstances, particularly the significant degree of resemblance between the parties' respective trademarks, the close connection between the goods of the parties, and the similar, if not overlapping,

channels of trade, I find that the Applicant has failed to meet its burden of establishing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's Trademark.

[91] Thus, the ground of opposition based on section 12(d) of the Act is successful.

Section 16(1)(a) Ground – Entitlement to Registration

[92] The Opponent has pleaded that the Applicant is not entitled to registration of the Mark as, as of the filing date of the application, the Mark was confusing with the Opponent's Trademark that had been previously used in Canada by the Opponent or its predecessors-in-title.

[93] As I have previously concluded that the earliest possible date of first use of the Opponent's Trademark that can be relied on is August 1, 2018, which post-dates the November 27, 2017 filing date of the application for the Mark, the Opponent has failed to meet its initial burden for this ground.

[94] This ground of opposition is therefore dismissed.

Section 2 Ground – Non-Distinctiveness

[95] The Opponent has pleaded that the Mark is not distinctive of the Applicant's Goods as:

- The Mark does not actually distinguish the goods in association with which the Mark is used or proposed to be used from the Opponent's Goods; and/or
- The Mark is used outside the scope of the licensed use provided for by section 50 of the Act, including by Agracity.

[96] The relevant date for this ground is the filing date of the opposition, namely, March 29, 2021 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185].

[97] In order to meet its burden in respect of this ground, the Opponent must show that the reputation of its trademark prevents the Mark from being distinctive and the required level of use must be "substantial, significant" or "sufficient reputation" in association with the relevant goods and services as of the material date [*Hilton Worldwide Holding LLP v Solterra (Hastings) Limited Partnership*, 2019 TMOB 133 citing *Bojangles' International, LLC v Bojangles Café Ltd* 2006 FC 657].

[98] As I have previously determined that the earliest date of first use that the Opponent can rely on for the Opponent's Trademark is its date of acquisition of the trademark, the evidence must establish that the Opponent's Trademark had a significant, substantial reputation associated with the Opponent's Goods from August 1, 2018 to the material date of March 29, 2021.

[99] The Woycheshin Affidavit provides the following evidence for the relevant period of consideration for this ground:

- At the end of 2019, the BASF Parent (being the parent of the Opponent) held the fourth largest global market share of the agricultural solutions industry [para 6];
- Invoices for the Opponent's Goods sold between 2018 and 2020 [para 16, Exhibit 5];
- Since August 1, 2018, BASF Canada has been continuously advertising and promoting the Opponent's Goods in Canada online on its own websites as well as third-party websites, in print media, on television or radio [para 22];
- Since August 1, 2018, BASF Canada has spent over 1.7 million CAD advertising the Opponent's Goods [para 23]. A list of the media on which the Opponent's Goods were advertised from August 2018 to April 2019 includes various print media, billboards, television channels, radio stations and third-party websites is provided [para 23];
- Printouts from the BASF Canada websites displaying the Opponent's Trademark which are identical or substantially similar to those that have been continuously available since August 2018 [para 24, Exhibit 8]. Between

August 1, 2018 and February 16, 2019, approximately 30,000 Canadian users viewed webpages from the website *agriculture.basf.ca* related to the Opponent's Goods [para 24]; and

- For the past few years, BASF Canada has been increasing its social media presence by publishing content on platforms such as YouTube and Twitter [para 26, Exhibits 10-A and 10-B].

[100] I am satisfied that the Opponent has provided sufficient evidence of use of the Opponent's Trademark to meet its evidentiary burden for this ground of opposition.

[101] The determination of the first aspect of this ground rests upon the assessment of likelihood of confusion between the trademarks at issue [*Hilton*]. As I do not consider the different material date for this ground to significantly affect my assessment of confusion as set out above in respect of the section 12(1)(d) ground, I find that the Opponent succeeds on the section 2 ground as far as it is based on likelihood of confusion.

[102] With respect to the second aspect of this ground raised by the Opponent, namely that the Mark is used outside of the licensed use, including but not limited to use by the Applicant's licensee Agracity, the Rumberg Affidavit provides details on the licence between the Applicant and Agracity, namely that the Applicant has licensed Agracity to use the Mark, with the Applicant having control over the quality and character of the Applicant's Goods and over use of the Mark. As Mr. Rumberg was not cross-examined on his affidavit, these statements, which contain the required elements set out in section 50 of the Act, are uncontested. I therefore find that the Applicant has met its legal onus for this aspect of the section 2 ground.

[103] Nonetheless, as the Opponent has succeeded in respect of the first aspect of this ground, the application for the Mark is also refused under section 2 of the Act.

DISPOSITION

[104] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.

Leigh Walters
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-08-10

APPEARANCES

For the Opponent: Barry Gamache

For the Applicant: David Reive

AGENTS OF RECORD

For the Opponent: Robic, LLP

For the Applicant: Miller Thompson LLP