



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 217

Date of Decision: 2023-12-18

IN THE MATTER OF AN OPPOSITION

Opponent: Northpaw Nutrition Inc.

Applicant: 8372683 Canada Inc

Application: 1979016 for NORTH PAW & Design

INTRODUCTION

[1] This is an opposition brought by Northpaw Nutrition Inc. (the Opponent) in respect of application number 1979016 for the trademark NORTH PAW & Design (the Mark) filed by 8372683 Canada Inc (the Applicant) and depicted below:



[2] The application contains a variety of pet-related goods including toys, bedding, shampoo, apparel and accessories (the Goods), a full list of which is attached as Schedule A.

[3] The Opponent bases the opposition on non-entitlement to registration, non-distinctiveness, and non-entitlement to use.

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

THE RECORD

[5] The application for the Mark was filed on August 5, 2019 and was advertised for opposition on February 9, 2022.

[6] On April 6, 2022, the Opponent filed its statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T 13 as amended June 17, 2019 (the Act). The Opponent bases the opposition on sections 38(2)(c) (non-entitlement to registration), 38(2)(d) (non-distinctiveness), and 38(2)(f) (non-entitlement to use). All grounds of opposition are rooted in an allegation of confusion with the Opponent's trademark NORTHPAW (the Opponent's Trademark) and/or trade name NorthPaw Nutrition (the Opponent's Trade Name).

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

[8] Both parties filed evidence and written representations.

[9] Both parties requested and attended an oral hearing.

OVERVIEW OF THE EVIDENCE

Opponent's Evidence -The Friesen Affidavit

[10] Mr. Friesen is a director and president of the Opponent [para 1]. Mr. Friesen attests to the following in his affidavit:

- The Opponent was incorporated as Northpaw Nutrition Inc. in May 2010 [para 3].
- The Opponent has been using the Opponent's Trademark and Trade Name at common law in association with pet food and wholesale and retail store services for pet food since the date of incorporation [paras 4 and 5].

- The Opponent distributes pet foods, pet products, including supplements, and other related goods through wholesale and retail sale throughout Canada. The Opponent's business includes the manufacturing and distribution of Satori Pet Food, Boka Pet Food, Aura Pet Products, Element 5 Supplements and Vintage Pet Foods (the Opponent's Products) [para 7].
- The Opponent's Products have been and continue to be promoted to consumers through the Opponent's website and the websites for the Opponent's Products [para 8].
- The Opponent advertises on social media, such as Facebook and Instagram, at trade shows and by word of mouth. Attached as Exhibit G are examples of the Opponent's marketing materials [para 9].
- The Opponent attends trade shows and conferences to promote the Opponent's Products and business [para 10].
- The Opponent's Products are distributed to over 400 cities across Canada [para 11, Exhibit I].
- The Opponent has two primary online retailers, Costco and Critters Pet Health Store [para 12].
- Images of the Opponent's Products' packaging and the Opponent's product catalogue are attached as Exhibits K and L [paras 13 and 14].
- The Opponent estimates that more than 544,000 units of the Opponent's Products have been purchased since the Opponent was incorporated [para 15].
- Copies of invoices showing sales of the Opponent's Products from April 2011 to June 2022 are attached as Exhibit M [para 16].
- The Opponent has used the Opponent's Trademark and Trade Name continuously in the marketplace since 2010 [para 17].

Applicant's Evidence – The Corcoran Affidavit

[11] Mr. Corcoran has held the position of senior vice president and chief financial officer of the Applicant since September 2020 [para 1]. As part of his position,

Mr. Corcoran is responsible for overseeing the Applicant's brands and authorizes the use and protection of the Applicant's trademarks [para 2].

[12] Mr. Corcoran attests to the following in his affidavit:

- The Applicant's core and active business involves developing, innovating, designing, manufacturing, marketing, selling and/or distributing various pet products, including pet apparel, pet walking gear, pet treats, pet food, veterinary health products, pet beds, as well as pet toys and accessories [para 5].
- The Applicant's use of the Mark dates back to the early 1980's through its predecessor company JC KID'S Apparel Inc brand (JC KIDS), a company owned by the parents of the existing shareholders of the Applicant [para 6]. JC KIDS actively used the Mark in Canada at least as early as 1985 [para 18].
- JC KIDS assigned all rights to the Mark to the Applicant in 2012 [para 7].
- The Applicant uses a number of brands to promote its products and services in Canada and has filed more than 35 Canadian trademark applications, many of which share the same classes as the application for the Mark [para 8]. A list of the Applicant's other trademark applications and registrations is attached as Exhibit B. Eight of these trademarks that are registered or subject to pending applications contain the word "PAW", including the Mark and versions of the trademark SILVER PAW [para 11]. The Applicant considers these eight "PAW" trademarks (the PAW Marks) to be a family of trademarks deserving of a broader scope of protection [para 13].
- The Applicant has actively used the PAW Marks in association with its goods and services since 2012 [para 19].
- The Applicant estimates it sells three million units associated with the Mark annually [para 21]. More specifically, the Applicant sells "various pet apparel and accessories, pet beds, pet cushions, pet toys, pet tents, pet pools, pet floatation devices and other pet products" using the Mark through various

retail channels, including trade shows and social media, and on its website [paras 22 and 25].

EVIDENTIAL BURDEN AND LEGAL ONUS

[13] 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 (FC)]. 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].

[14] 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 the 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 REMARKS

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

[16] Further, in considering the evidence, I have disregarded any assertions that I consider equivalent to an opinion on the question of fact and law to be determined by the Registrar in this proceeding.

PRELIMINARY MATTER – USE OF THE OPPONENT’S TRADEMARK

[17] The Opponent has based its opposition on grounds that rely on prior use of the Opponent’s Trademark and Trade Name. However, for the reasons set out below, I find that the Opponent has not provided evidence of use of the Opponent’s Trademark and, as such, it cannot be relied on for the purposes of this opposition.

[18] The Opponent's evidence, namely, the Friesen Affidavit, states that the Opponent commenced business in May 2010 and that, around this date, the Opponent commenced use of the Opponent's Trademark and Trade Name [paras 3 and 5]. However, the term "use" in respect of a trademark is clearly defined in sections 2 and 4 of the Act as follows:

use, in relation to a trademark, means any use that by section 4 is deemed to be a use in association with goods or services;

4 (1) A trademark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

[19] The Opponent submits that use of the Opponent's Trademark is found in the exhibits to the Friesen Affidavit, namely images of the Opponent's trade show displays and images of the Opponent's Products as packaged [Exhibits H and K].

[20] While the Opponent's trade show displays do contain the wording "Family Owned & Operated by NPN NorthPaw Nutrition Inc." on the various signage on display, I do not consider this to be evidence of use of the Opponent's Trademark. Specifically, it is not clear that the Opponent's Products were actually sold at the trade shows it attended (in fact, Mr. Friesen specifically notes that the Opponent attends trade shows and conferences to promote the Opponent's business and products but makes no reference to product sales) and, as such, this use fails to meet the requirements of the definition of "use" of a trademark with goods under section 4 of the Act [Friesen Affidavit, para 10].

[21] With respect to the packaging of the Opponent's Products, the images in evidence only depict the word "NorthPaw" on the lower back side of product as part of the Opponent's corporate name, NorthPaw Nutrition Inc., followed by an address and website [Friesen Affidavit, Exhibit K]. Accordingly, while the word NorthPaw is technically printed on the packaging of the Opponent's Products, I consider this to constitute use of the Opponent's Trade Name but not the Opponent's Trademark. I make this finding on the basis that an average consumer would identify the depiction of

the corporate name NorthPaw Nutrition Inc. followed by the company address and website as an indication of the name under which the Opponent carries on business, rather than the brand of the product.

[22] In any event, even if I were to consider the placement of NorthPaw Nutrition Inc. to represent use of the trademark NORTHPAW, there is no indication in the Friesen Affidavit, either in the body of the affidavit or in the images of the Opponent's Products packaging that confirms that the images are representative of packaging used as of the material dates in this opposition.

[23] Based on the reasoning above, I find that the Opponent has not established use of the Opponent's Trademark in Canada.

PRELIMINARY MATTER – USE OF THE MARK

[24] The Applicant submits that it has used the Mark in Canada, by itself or its predecessor-in-title JC KIDS, since at least as early as 1985 [Corcoran Affidavit, para 18]. It claims that it acquired all rights in the Mark by virtue of an assignment from JC KIDS to the Applicant in 2012 [Corcoran Affidavit, para 7]. However, the Applicant has not provided any evidence that speaks to what goods or services the Mark was used in association with by JC KIDS, nor does it provide details as to what rights were assigned – the simple statement that “all rights” in the Mark were assigned to the Applicant without providing pertinent details on the nature and scope of the rights that were assigned cannot be relied upon as a blanket statement that means the Mark has been used continuously since 1985 with all of the Goods in the application for the Mark. It is also unclear whether the goodwill in the Mark was assigned.

[25] The Applicant has also failed to evidence use of the Mark with any Goods as defined in section 4 of the Act. The only statements in the Applicant's evidence with respect to use of the Mark are that the Applicant has actively used the Mark since 2012 and that an estimated three million “units” are sold annually, with no indication as to what the term “units” covers and no indication that the Mark has been in continuous use since the 2012 acquisition [Corcoran Affidavit, paras 19 and 21].

[26] Given the vague nature of the Applicant's evidence, I cannot conclude that use of the Mark by the Applicant's predecessor-in-title accrues to the benefit of the Applicant. Most importantly, it is not clear what rights JC KIDS had in the Mark (i.e. what goods or services it offered in association with the Mark) or whether any such use was continuous from 1985 onward.

[27] There is also a lack of clarity in the Applicant's evidence relating to the Applicant's use of the Mark since 2012. The statements in the Corcoran Affidavit relating to the Applicant's use of the Mark are as follows:

- Since 2012, the Applicant has actively used all of [the PAW Marks] in association with its goods and/or services, including the NORTH PAW trademark [para 19];
- The Applicant has more than 200 stock-keeping units for products branded under the NORTH PAW trademark [para 20];
- The Applicant's current inventory of North Paw product exceeds 600,000 units and estimates three million units sold annually [para 21]; and
- The Applicant sells various pet apparel and accessories... using the NORTH PAW trademark through various retail channels, including trade shows and social media [para 22].

[28] First, it must be noted that the Corcoran Affidavit does not define the Mark or refer specifically to use of the Mark, being NORTH PAW & Design. Reference is made only to the NORTH PAW trademark. Accordingly, it is not clear if any of the Applicant's evidence is in relation to the Mark *per se*.

[29] Second, there is no indication in the Corcoran Affidavit that the Mark (or any trademark containing NORTH PAW) was used in accordance with section 4 of the Act, namely, that the Mark was, at the time of transfer of the Applicant's Goods in the normal course of trade, the Mark was marked on the goods themselves, on the packaging in which they are distributed, or in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession of the goods is transferred. Mr. Corcoran only attests that the Applicant "has actively

used” the NORTH PAW trademark in association with “goods and/or services” since 2012 [Corcoran Affidavit, para 19]. Further, none of the exhibits to the Corcoran Affidavit depict the Mark on any of the Applicant’s Goods, on packaging of the Applicant’s Goods, or otherwise associated with the Applicant’s Goods in a manner that meets the requirements of section 4 of the Act. Accordingly, the Applicant’s evidence of use of the Mark in Canada is limited to mere assertions of use, rather than statements of fact demonstrating use.

[30] In sum, the Applicant’s evidence falls short of establishing use of the Mark in Canada at any point, primarily due to the fact that there is no reference to the Mark at issue in this proceeding in the Corcoran Affidavit, namely, NORTH PAW & Design, and the statement that the Applicant has used the NORTH PAW trademark since 2012 in association with “goods and/or services” is a vague assertion and does not even specify that the “use” referred to was in Canada.

[31] Accordingly, for the purposes of this opposition, I find that the Applicant has not evidenced use of the Mark in Canada.

ASSESSMENT OF THE GROUNDS OF OPPOSITION

Sections 16(1)(a) - Non-entitlement to Registration – Prior Trademark Use

[32] The Opponent pleads the Applicant is not the person entitled to registration of the Mark having regard to section 16(1)(a) as the Mark is confusing with the Opponent’s Trademark which was previously used and made known in Canada by the Opponent since 2010.

[33] As I have found that there is no evidence of record of use of the Opponent’s Trademark, the Opponent has failed to meet its evidentiary burden for this ground. Accordingly, this ground is dismissed.

Sections 16(1)(c) - Non-entitlement to Registration-Prior Trade Name Use

[34] The Opponent pleads the Applicant is not the person entitled to registration of the Mark having regard to section 16(1)(c) as the Mark is confusing with the Opponent’s Trade Name which was previously used in Canada by the Opponent since 2010.

[35] The material date to assess an applicant's entitlement to registration is the earlier of the application's filing date and the date of first use. As I have already found the Applicant has failed to establish use of the Mark in Canada, the material date for this ground is the filing date of the application, August 5, 2019.

[36] For this ground of opposition, there is an initial burden on the Opponent to show use of the Opponent's Trade Name prior to August 5, 2019 and that it had not abandoned this trade name as of the date of advertisement of the application for the Mark, namely February 9, 2022 [the Act, section 16(3)].

[37] The evidence provided by the Opponent regarding use of its trade name essentially consists of various invoices for sales of the Opponent's Products in Canada for the years 2011 to 2022, and images of trade show displays from 2017 and 2019, all bearing the Opponent's Trade Name [Friesen Affidavit, Exhibits M and H]. I am therefore satisfied that the Opponent was using its trade name as of the filing date of the application for the Mark and that it had not abandoned the trade name as of the date of advertisement given that at least one invoice post-dates the February 9, 2022 date of advertisement.

[38] I also note that the Opponent has identified its trade name as NorthPaw Nutrition as opposed to the full corporate name NorthPaw Nutrition Inc. [Friesen Affidavit, para 5]. I consider the evidence of use of NorthPaw Nutrition Inc. to be sufficient to establish use of the trade name NorthPaw Nutrition as I consider the inclusion of "Inc." to be a minor deviation to the trade name such that it has not lost its identity and remains recognizable, though I do not find it sufficient to establish use of the trade name NorthPaw.

Test for Confusion

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

sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

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

Degree of Resemblance

[41] When considering the degree of resemblance, the trademarks must be considered in their entirety as a matter of first impression. They must not be carefully analyzed and dissected into their component parts [*Wool Bureau of Canada Ltd v Registrar of Trade Marks* (1978), 40 CPR (2d) 25 (FCTD)]. That being said, the preferable approach is to consider whether there is an aspect of each trademark that is particularly striking or unique. It is reasonable to conclude that such striking or unique elements are dominant in their respective trademarks [*Masterpiece*, para 64].

[42] The Opponent submits the Opponent's Trade Name is identical with respect to the primary element, being the words NORTHPAW / NORTH PAW, and also identical in sound, and ideas suggested [Opponent's written representations, pg 11]. The Opponent cites *Masterpiece* for the assertion that where the dominant feature of two trademarks (or in this case, a trade name and a trademark), it would "almost be certain to lead to

confusion” in the minds of consumers in Canada [Opponent’s written representations, pg 11].

[43] I agree that the Mark and the Opponent’s Trade Name share the same distinctive element, namely NORTHPAW / NORTH PAW, as there is nothing particularly unique about the wording “Est. 1982” in the Mark. There is also nothing particularly striking or unique about the word “Nutrition” in the Opponent’s Trade Name. I also find the Opponent’s Trade Name and the Mark to be notably similar in sound, but somewhat different in idea suggested as the Opponent’s Trade Name is clearly suggestive of food or food supplements, a suggestion that is not present in the Mark.

[44] Nonetheless, given the shared distinctive element and resulting similarity in sound, this factor favours the Opponent.

Length of Time the Mark and Trade Name Have Been in Use

[45] As discussed above under Preliminary Matters, the Applicant’s evidence does not demonstrate use of the Mark in Canada.

[46] The uncontested evidence of the Opponent is that it has used the Opponent’s Trade Name since “around May 2010” [Friesen Affidavit, para 5]. The Opponent’s evidence also includes numerous invoices for sales in Canada in 2011 and 2013 to 2017, all of which predate the material date for this ground.

[47] This factor therefore favours the Opponent.

Inherent Distinctiveness and Extent Known

[48] Both the Mark and the Opponent’s Trade Name possess some level of inherent distinctiveness as, although the words NORTH and PAW are dictionary words, the combination of these words either as NORTHPAW or NORTH PAW, is somewhat unique as they are not common or well-known words or phrases. While the Mark also has a design element, namely the silhouette of a dog’s head profile, given that the word “paw” in the Mark is already associated with and suggestive of animals or dogs, I do not

consider this design element to materially increase the Mark's inherent distinctiveness. Accordingly, neither party is favoured in respect of inherent distinctiveness.

[49] With respect to extent known, I have already concluded that there is no evidence of use of the Mark in Canada. There is also no evidence that the Mark has been made known in any way in Canada.

[50] The Opponent's evidence contains the estimate that "more than 544,000 units of the Opponent's Products" since the Opponent's date of incorporation in May 2010 [Friesen Affidavit, para 15]. I do not find this estimate to be of much assistance to the Opponent given that it is not clear that all of these sales were to Canadian consumers. Further, while the Opponent's evidence contains numerous examples of advertising, particularly on social media, much of this evidence only references the Opponent's various product lines and do not feature the Opponent's Trade Name [Friesen Affidavit, Exhibit G]. I do, however, find that the Opponent has demonstrated use of the Opponent's Trade Name at trade shows in 2017 and 2019 and on invoices from April 2011 and 2013 to 2017 [Friesen Affidavit, Exhibits H and M].

[51] Overall, this factor slightly favours the Opponent.

Nature of the Goods and Business and Nature of the Trade

[52] When considering the nature of the goods and services, it is the statements of goods in the subject application and registrations (where applicable) that govern [*Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 (3d) 3 (FCA)]; *Miss Universe, Inc v Dale Bohna*, (FCA), [1995] 1 FCR 614]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful, particularly where there is an ambiguity as to the goods and services set out in the subject application or registrations [*McDonald's Corp v Coffee Hut Stores Ltd*, 1996 CanLII 3962 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[53] The Opponent submits that the goods of the parties are identical in that they both carry on business in the pet industry [Opponent's Written Representations, pg 10].

[54] More specifically, the Opponent describes itself as a manufacturer and distributor of pet food, pet products (including supplements), and other related goods through wholesale and retail sale throughout Canada [Friesen Affidavit, para 7]. The Opponent also promotes the Opponent's Products through social media, on websites and attends trade shows and conferences for this purpose [Friesen Affidavit, para 10].

[55] For its part, the Applicant describes its "core and active business" as involving developing, innovating, designing, manufacturing, marketing, selling and/or distributing various pet products including pet food [Corcoran Affidavit, para 6]. The Applicant sells the Goods through various retail channels, including trade shows and social media [Corcoran Affidavit, para 22].

[56] Through its evidence, the Applicant has identified the development, manufacture, distribution and sale of pet food as part of its core business [Corcoran Affidavit, para 5]. This means there is a direct overlap in the goods and business of the parties. Accordingly, even though pet food is not specifically listed in the statement of Goods in the application for the Mark, there is an obvious connection between the Opponent's Products and the Applicant's Goods as all of the parties' goods are specifically for pets and there is a direct overlap in the business of the parties given that both manufacture and distribute pet food.

[57] I also find that the evidence is clear that both parties promote and/or sell their respective goods through the same channels of trade, namely retail sales, at trade shows and through social media.

[58] As there is an obvious connection between the Opponent's Products and the Applicant's Goods, and the evidence demonstrates that both parties sell and promote their respective goods through the same channels of trade, these factors favour the Opponent.

Surrounding Circumstance – Applicant’s Family of Trademarks

[59] The Applicant submits that the Corcoran Affidavit establishes that the Applicant has developed a family of trademarks, namely the PAW Marks [Applicant’s Written Representations, para 28].

[60] The Applicant further submits that the Applicant has actively used all of the PAW Marks in association with its goods since 2012 and that, as such, the Applicant’s customers have come to expect that the word PAW combined with NORTH, SOUTH, SILVER and other words in association with the pet apparel industry to originate from the Applicant [Applicant’s Written Representations, paras 30 and 31].

[61] It is trite law that section 19 of the Act does not give the owner of a registration the automatic right to obtain any further registrations, no matter how closely they may be related to prior registrations [*Coronet-Werke Heinrich Schlerf GmbH v Produits Menagers Coronet Inc*, 4 CPR (3d) 108 (TMOB); *Groupe Lavo Inc v Proctor & Gamble Inc*, 32 CPR (3d) 533 (TMOB)].

[62] Further, there can be no presumption of the existence of a family of marks in opposition proceedings. A party seeking to establish a family of marks must establish that it is using more than one or two trade-marks within the alleged family [*Techniquip Ltd v Canadian Olympic Assn* (1998), 1998 CanLII 7573 (FC), 145 FTR 59 (FCTD), aff’d 250 NR 302 (FCA); *Now Communications Inc v CHUM Ltd* (2003), 32 CPR (4th) 168 (TMOB)].

[63] First, I note that the Applicant has not filed any evidence to support its assertion that its customers have come to associate the PAW Marks with the Applicant in the pet apparel industry. Second, the Applicant has not filed any evidence of use of the PAW Marks as required to successfully assert ownership of a family of trademarks.

[64] Accordingly, this is not a surrounding circumstance that assists the Applicant.

Conclusion Regarding Confusion

[65] Having regard to the forgoing, in particular the significant degree of resemblance between the applied for trademark NORTH PAW & Design and the Opponent's NorthPaw Nutrition trade name and the direct overlap in the parties' goods, business and channels of trade, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that as of the application filing date of August 5, 2019, there was no reasonable likelihood of confusion between the Mark and the Opponent's Trade Name.

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

Section 2 – Non-Distinctiveness

[67] The Opponent pleads that the Mark is not distinctive within the meaning of section 2 of the Act as the Mark is not distinctive of the Applicant and does not distinguish and is not adapted to distinguish the Applicant's Goods from the goods and services of others, including the Opponent.

[68] While not explicitly stated, reading the statement of opposition as a whole, it appears the Opponent is relying on both the Opponent's Trademark and Trade Name in support of this ground. As I have already found that the evidence does not support a finding of use of the Opponent's Trademark, this ground will be assessed solely based on the Opponent's Trade Name.

[69] The material date for this ground is the filing date of the opposition, namely April 6, 2022 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185].

[70] Section 2 of the Act defines "distinctive" in relation to trademarks as follows:

"distinctive" in relation to a trademark, describes a trademark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or that is adapted so to distinguish them.

[71] Under this ground, an opponent's initial burden is not merely to evidence that its trade name had been used, but rather that as of the material date, its trade name: i) was known to some extent in Canada in association with the relevant goods; and ii) had a

reputation in Canada that was “substantial, significant or sufficient” so as to negate the distinctiveness of the applied-for trademark [see *Bojangles’ International LLC v Bojangles Café Ltd*, 2006 FC 657 at paras 33 and 34; and *Canadian Dental Association v Ontario Dental Assistants Association*, 2013 FC 266 at para 42, aff’d 2013 FCA 279]. In *Auld Phillips Ltd v Suzanne’s Inc*, 2005 FCA 429, the Federal Court of Appeal stated that “obviously, it will be a rare occurrence when one party is in a position to cause a mark to lose its distinctiveness, but nothing in principle prevents this result” [at para 7].

[72] As discussed in detail above, there is some evidence of record demonstrating use of the Opponent’s Trade Name prior to the April 2022 material date for this ground, most notably pictures of trade show exhibits from a show in each of 2017 and 2019 and a collection of invoices on invoices from 2011 and 2013 to 2017, all bearing the Opponent’s Trade Name [Friesen Affidavit, Exhibits H and M].

[73] In my view, the small sample of use of the Opponent’s Trade Name in evidence is insufficient to establish that the trade name has a substantial, significant or sufficient reputation in Canada. In this regard, the evidence fails to quantify how many Canadians may have been exposed to the Opponent’s Trade Name as of the material date. While the Applicant did provide a social media reach report for 2022, it is not clear when in 2022 this was prepared, who prepared it, whether the report reflects Canadian followers exclusively or, if not, what number or percentage of followers represent consumers in Canada. Further, while the Opponent has provided a list of provinces and cities to which the Opponent’s Products are shipped, there is no indication as to the extent of these transactions in terms of volume or duration [Friesen Affidavit, Exhibit I]. In any event, the list of provinces and cities provided in the Friesen Affidavit appears to contain information that post-dates the material date for this ground given that the stated date of import of the information is in August 2022.

[74] Overall, when viewed in its entirety, I am unable to determine that the Opponent’s Trade Name has acquired a substantial, significant or sufficient reputation in Canada. Accordingly, the Opponent has not met its initial evidential burden and this ground of opposition is rejected.

Section 38(2)(f) – Non-Entitlement to Use

[75] The Opponent pleads that, as of the filing date of the application for the Mark, the Applicant was not entitled to use the Mark in Canada with the Applicant's Goods as, if the Mark is used in Canada with the Applicant's Goods it would likely cause confusion in the marketplace with the Opponent's Trademark.

[76] In order to meet its evidential burden under this ground, the Opponent must first provide evidence of its own use and/or reputation of its mark. As I have concluded that there is no evidence of use of the Opponent's Trademark of record, the Opponent has failed to meet its initial evidential burden for this ground. Accordingly, this ground of opposition is rejected.

DISPOSITION

[77] 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

SCHEDULE A

The Applicant's Goods

- CI 3 (1) Pet shampoos, pet soaps.

- CI 18 (2) Pet apparel and accessories, namely pet clothing, pet jackets, pet vests, pet parkas, pet raincoats, pet rain ponchos, pet shoes, pet boots, pet hats, pet collars, pet leashes, pet umbrellas, pet carriers.

- CI 20 (3) Pet beds, pet cushions, pet baskets.

- CI 24 (4) Pet blankets.

- CI 28 (5) Pet toys used for play, training or competitions, pet tents, pet pools, pet flotation devices, namely dog vest swimming floats, pet float mattresses and pet pool floats

Appearances and Agents of Record

HEARING DATE: 2023-11-09

APPEARANCES

For the Opponent: Lorraine Pinsent

For the Applicant: Ronald Toledano

AGENTS OF RECORD

For the Opponent: MLT AIKINS LLP

For the Applicant: SPIEGEL SOHMER INC.