



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2024 TMOB 110

**Date of Decision:** 2024-06-13

## **IN THE MATTER OF AN OPPOSITION**

**Opponent:** OrganiGram Inc.

**Applicant:** 11535706 CANADA INC.

**Application:** 2,000,205 for Organican

## **INTRODUCTION**

[1] OrganiGram Inc. (the Opponent) opposes registration of the trademark Organican (the Mark), which is the subject of application No. 2,000,205 (the Application) by 11535706 CANADA INC. (the Applicant).

[2] The Application is in association with the following goods, all of which fall in Class 34 of the Nice Classification: cannabis grinders; cannabis oil for electronic cigarettes; cannabis oil for oral vaporizers for smoking; dried cannabis (the Goods).

[3] The opposition is primarily based on an allegation that the Mark is confusing with the previous use and registration by the Opponent of its ORGANIGRAM trademarks.

[4] For the reasons that follow, the Application is refused as the Applicant has not met its burden to demonstrate that there is no likelihood of confusion between the parties' trademarks.

### **THE RECORD**

[5] The Application was filed on December 9, 2019, and was advertised for opposition purposes in the *Trademarks Journal* of February 2, 2022. On July 30, 2022, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition relate to registrability under section 12(1)(d), entitlement to register under sections 16(1)(a) and 16(1)(c), distinctiveness under section 2, and non-compliance with sections 38(2)(a) and 30(2)(d), 38(2)(e), and 38(2)(f) of the Act.

[6] The Applicant filed a counter statement denying the grounds of opposition. The Opponent filed as its evidence the affidavits of Helen Martin, sworn May 16, 2023, (the Martin affidavit) and Jayoung Kim, sworn May 15, 2023 (the Kim affidavit). These affidavits are discussed further below. The Applicant elected not to file any evidence.

[7] Only the Opponent filed written representations and no hearing was held.

### **LEGAL ONUS AND EVIDENTIAL BURDEN**

[8] The Opponent has the initial evidential burden to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once that burden is met, the Applicant bears the legal onus of establishing, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd* (1990), 1990 CanLII 11059 (FC), 30 CPR (3d) 293 (FCTD); *Dion Neckwear*

*Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155]. This means that if a determinate conclusion cannot be reached in favour of the Applicant after a consideration of all the evidence, then the issue must be decided against the Applicant.

## **OVERVIEW OF THE EVIDENCE**

### ***The Martin affidavit***

[9] Ms. Martin is the Chief Legal Officer of Organigram Holdings Inc, the parent company of the Opponent, and an employee of the Opponent. She has been employed by the Opponent since November 2018. Ms. Martin is responsible for overseeing aspects of the brand and product marketing, media and advertising, and intellectual property matters for the Opponent, including the ORGANIGRAM trademarks and trade name. Ms. Martin's affidavit provides information on the Opponent's business, trademarks, channels of trade, revenue, and advertising.

[10] Ms. Martin states that the Opponent was founded in 2013 in Canada, and that it is a licensed producer of cannabis, focused on providing indoor-grown cannabis, cannabis-derived products, and related cannabis services in Canada. The Opponent has headquarters in Toronto, Ontario, and runs facilities in three provinces - a primary cannabis growing facility in New Brunswick, a production and craft cultivation facility in Quebec, and a cannabis edibles and extract manufacturing facility in Manitoba.

[11] Ms. Martin states that the Opponent operates under the trade name Organigram, and also uses the trademarks ORGANIGRAM and ORGANIGRAM & Design (collectively, the ORGANIGRAM Trademarks) in association with its business. The Opponent owns registrations for the ORGANIGRAM Trademarks in association with a range of cannabis goods including cannabis and cannabis-derived products, such as dried cannabis flower, cannabis

extracts, edible cannabis, and cannabis oil (the Cannabis Products) and in association with services including the breeding, cultivation and processing, production, manufacturing and sale of cannabis (the Cannabis Services).

[12] Ms. Martin states that the Opponent has been using the ORGANIGRAM Trademarks and trade name in association with its Cannabis Products and Services since at least as early as 2014. In the normal course of trade, the ORGANIGRAM Trademarks and/or trade name is marked on the packages in which the Cannabis Products are sold. Exhibit B consists of a bundle of images of ORGANIGRAM branded Cannabis Products bearing the ORGANIGRAM Trademarks. These images are representative of how the ORGANIGRAM Trademarks have appeared on these products sold in Canada since at least as early as 2014 through to the present day.

[13] Ms. Martin states that in the normal course of trade of offering the Cannabis Services, the ORGANIGRAM Trademarks and/or trade name are displayed on the Opponent's advertising materials, including in-store displays, customer invoices, uniforms, and folios used for client communications. Exhibit C contains a bundle of images of ORGANIGRAM branded advertising materials featuring the ORGANIGRAM Trademarks and/or trade name, that are representative of how the ORGANIGRAM Trademarks and/or trade name have appeared in association with the Cannabis Services offered in Canada since at least as early as 2014 through to the present day.

[14] Ms. Martin explains that the Opponent sells its Cannabis Products across Canada through a variety of channels of trade, depending on the specific province/territory. These channels include government-run retail outlets (brick and mortar and online), such as the Ontario Cannabis Store (OCS) and Société Québécoise du Cannabis (SQDC), and third-party privately owned retailers such as Shopper's Drug Mart (for medical patients)

and Tokyo Smoke (for recreational consumers). The Cannabis Products all display the ORGANIGRAM Trademarks and/or trade name. The Opponent's ORGANIGRAM branded Cannabis Services are offered through both business to business and direct to consumer channels, depending on the nature of the service being offered.

[15] Ms. Martin states that since 2014 through to the present day (her affidavit being sworn on May 16, 2023), the Opponent's annual revenue generated by the sales of its Cannabis Products and Services in Canada, in association with the ORGANIGRAM Trademarks and/or trade name, has been "in the millions".

[16] Ms. Martin states that the Opponent's advertising expenditures for its Cannabis Products and Services in Canada has been significant, and as an example, cites expenditures of over \$1 million dollars to promote its medical ORGANIGRAM-branded Cannabis Products. The Martin affidavit includes representative examples of advertising for the Opponent's business, and its Cannabis Products and Services, including through its website at *organigram.ca*, on its various social media, brick and mortar signage, and through sponsorship and participation in trade show and industry events (Exhibits E-K).

[17] Ms. Martin states that the ORGANIGRAM Trademarks and trade name have appeared in third party articles in publications which she understands enjoy readership in Canada (Exhibit L). Ms. Martin also provides particulars of various recognitions awarded to the Opponent between 2017 and 2022.

### ***The Kim affidavit***

[18] Ms. Kim is employed as a Practice Group Assistant with the agent for the Opponent. Ms. Kim's affidavit mainly consists of printouts of screenshots

and online search results filed in support of the Opponent's allegations under sections 38(2)(a) and 38(2)(e) of the Act.

[19] Ms. Kim conducted a search for the Applicant, 11535706 Canada Inc, on the Corporations Canada database, which yielded no results (Exhibit A). Ms. Kim also provided a screenshot of the webpage at *www.organicaninc.com* as of May 15, 2023 as well as archived versions of this website using the Internet Archive Wayback Machine (Exhibit B, C). The screenshot from May 15, 2023, indicates that the website has expired, while the screenshots of archived versions of the website simply indicate it is a "private site". Ms. Kim also conducted a Google search and Google Map/Street View search of the listed address of the Applicant (Exhibits D, E). The results suggest that an entity by the name of "Paul Motor Leasing" operates at that address. A screenshot of a LinkedIn overview of Paul Motor Leasing is provided (Exhibit F).

[20] Ms. Kim also attaches the results of her searches for the terms "11535706 CANADA INC", "Organican" and "Organigram" from Health Canada's list of licensed cannabis cultivators, processors and sellers (Exhibit G). I note that only "Organigram" (the Opponent) appears as a license holder in these search results.

## **ANALYSIS OF THE GROUNDS OF OPPOSITION**

### ***Section 12(1)(d) ground of opposition***

[21] The Opponent has pleaded that the Mark is not registrable because, contrary to section 12(1)(d) of the Act, the Mark is confusing with the Opponent's registrations for the trademarks ORGANIGRAM and ORGANIGRAM & Design (TMA964,018 and TMA964,020).

[22] The material date for this ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 1991 CanLII 11769 (FCA), 37 CPR (3d) 413 (FCA)].

[23] I have exercised my discretion to check the Register and confirm that these registrations remain extant [*Quaker Oats Co Ltd of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent has therefore met its initial evidential burden with respect to this ground of opposition. As a result, the Applicant bears the legal burden of demonstrating on a balance of probabilities that there is no likelihood of confusion between the Mark and one, or both, of the Opponent's registered trademarks. A full listing of the goods and services associated with these registrations is set out in Schedule A to this decision.

[24] In considering the issue of confusion, I will focus on the Opponent's registration for the word mark ORGANIGRAM as, in my view, this represents the Opponent's best case. That said, I also consider the use of the Opponent's design trademark covered by registration No. TMA964,020 to constitute use of the word mark ORGANIGRAM, as it comprises the dominant element of this trademark [*Nightingale Interloc Ltd v Prodesign Ltd*, (1984), 2 CPR (3d) 535 (TMOB)].

#### Test for confusion

[25] In determining whether two trademarks are confusing, all the surrounding circumstances should be considered, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and 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 [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772 at para 54; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 (CanLII), 49 CPR (4th) 401]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

[26] The test for confusion is assessed as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the applicant's mark, at a time when they have no more than an imperfect recollection of the opponent's trademark, and do not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot, supra*, at para 20].

Inherent distinctiveness of the trademarks and the extent to which they have become known

[27] Both parties' trademarks are coined terms, which ordinarily hold a high degree of inherent distinctiveness. However, the prefix of both ORGANIGRAM and ORGANICAN, namely "ORGANI", may be considered suggestive in that it suggests the parties' cannabis products are organic (i.e., free of pesticides or other artificial agents). This lessens the inherent distinctiveness of both of the parties' marks.

[28] The strength of a trademark may be increased by means of it becoming known through promotion or use. The evidence of the Opponent provided through the Martin affidavit establishes that its ORGRANIGRAM trademark has been used continuously since at least 2014. While the Opponent has not provided precise sales figures, the approximate information provided (that annual sales of the Opponent's Cannabis Products and Services associated with ORGANIGRAM Trademarks and trade name



have been in the millions) along with examples of a variety of advertising and advertising expenditures establishes that the Opponent's ORGANIGRAM trademark has become known to at least some extent in Canada. In contrast, there is no evidence that the Applicant's Mark has been used or become known at all in Canada.

[29] On balance, I find that the first factor, which is a combination of inherent and acquired distinctiveness, favours the Opponent.

Length of time the trademarks have been in use

[30] The evidence indicates that the Opponent has used the ORGANIGRAM trademark in Canada since at least 2014. There is no evidence of use of the Applicant's Mark. Accordingly, this factor favours the Opponent.

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

[31] It is the Applicant's statement of goods as defined in the Application versus the statement of goods and services in the Opponent's registration that governs my determination of this factor.

[32] There is a direct overlap between the Opponent's "cannabis..." and "cannabis derivatives containing cannabinoids derived from the cannabis plant, namely foodstuffs, namely, sweets, butters, oils, namely edible oils, hashes, waxes for ingestion by smoking, vaporizing or eating..." and the Applicant's "cannabis oil for electronic cigarettes; cannabis oil for oral vaporizers for smoking; dried cannabis." There is also a connection or similarity between the "cannabis grinders" (an item to be used with cannabis) in the Application and the Opponent's Cannabis Products [see *Pax Labs, Inc and Phoena Inc*, 2023 TMOB 114 at paras 36, 37].

[33] Given the overlap or connection in the parties' goods, and in the absence of any evidence or argument to the contrary from the Applicant, I find that there is potential for overlap in the parties' channels of trade.

[34] Accordingly, these factors favour the Opponent.

#### Degree of resemblance

[35] As noted above, the degree of resemblance between the trademarks will often have the greatest effect on the confusion analysis. 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, supra*].

[36] On consideration of the trademarks in their entirety, I find the Mark shares some similarity in appearance, sound, and ideas suggested with the Opponent's ORGANIGRAM trademark since they share the prefix ORGANI. However, the importance of this first component is diminished by its suggestive significance [*Sky Solar Holdings Co v Skypower Global*, 2014 TMOB 262]. The suffixes of the parties' marks are different and are not similar in ideas suggested. However, I agree with the Opponent's submission that the parties' suffixes "share a musicality and rhythm that enhance their similarity" (Opponent's written representations at para 65).

[37] Overall, this factor favours the Opponent.

#### Conclusion on the section 12(1)(d) ground

[38] Having considered all the surrounding circumstances, and in particular given the acquired distinctiveness and length of time in use of the Opponent's ORGANIGRAM trademark, the direct overlap and/or similarity between the applied-for Goods and the Opponent's registered Cannabis

Goods and the corresponding potential overlap in the nature and channels of trade, as well as the degree of resemblance between the trademarks, the Applicant has not satisfied its legal burden of demonstrating no likelihood of confusion. As a result, the section 12(1)(d) ground of opposition is successful.

***Section 16(1)(a) ground of opposition***

[39] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark because, as of the filing date of the Application, namely December 9, 2019, and at all material times, the Mark was confusing with the Opponent's ORGANIGRAM Trademarks, namely the word mark ORGANIGRAM and the ORGANIGRAM & Design trademark cited above, previously used by the Opponent in Canada in association with the cannabis goods and services listed in Schedule A.

[40] The Opponent has met its initial evidential burden by way of its evidence showing use of its ORGANIGRAM Trademarks since prior to the material date for this ground of opposition, namely December 9, 2019 (the filing date of the Application).

[41] In my view, the earlier material date for this ground of opposition does not alter to any meaningful degree the confusion analysis for the section 12(1)(d) ground of opposition set out above. Accordingly, the Applicant has not met its legal burden to demonstrate no likelihood of confusion as of the material date for this non-entitlement ground, and the section 16(1)(a) ground of opposition is also successful.

***Remaining grounds of opposition***

[42] As the Opponent has already succeeded under two grounds of opposition, it is not necessary to address the remaining grounds of opposition.

**DISPOSITION**


[43] In view of the above, 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.

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Jennifer Galeano  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

## **SCHEDULE A**

List of goods and services associated with the Opponent's registrations for ORGANIGRAM and ORGANIGRAM & Design

Trademark	Goods/Services
<b>ORGANIGRAM</b>  TMA964,018	Goods: (1) Cannabis, namely, medical marijuana for use in the treatment of pain and discomfort resulting from physical, psychological and cognitive ailments, and for mood enhancement and to provide an improved sense of well-being.  (2) Cannabis derivatives containing cannabinoids derived from the cannabis plant, namely, foodstuffs, namely, sweets, butters, oils, namely, edible oils, hashes, waxes for ingestion by smoking, vaporizing or eating, tinctures for oral consumption and adding to food and drink, tonics for oral consumption by drinking, teas, balms for topical application to one's skin, salves for topical application to one's skin, lotions for topical application to one's skin, sprays, namely, mouth sprays and sprays for topical application to one's skin, and ointments for topical application to one's skin.  Services: (1) The breeding, growing and processing of cannabis; Production and sale of medical marijuana; Growing marijuana and cannabis for others; Referral of patients seeking medical marijuana to medical practitioners; and Consulting services in the medical marijuana field.
  TMA964,020	Goods: (1) Cannabis, namely, medical marijuana for use in the treatment of pain and discomfort resulting from physical, psychological and cognitive ailments, and for mood enhancement and to provide an improved sense of well-being.  (2) Cannabis derivatives containing cannabinoids

	<p>derived from the cannabis plant, namely, foodstuffs, namely, sweets, butters, oils, namely, edible oils, hashes, waxes for ingestion by smoking, vaporizing or eating, tinctures for oral consumption and adding to food and drink, tonics for oral consumption by drinking, teas, balms for topical application to one's skin, salves for topical application to one's skin, lotions for topical application to one's skin, sprays, namely, mouth sprays and sprays for topical application to one's skin, and ointments for topical application to one's skin.</p> <p>Services:</p> <p>(1) The breeding, growing and processing of cannabis; Production and sale of medical marijuana; Growing marijuana and cannabis for others; Referral of patients seeking medical marijuana to medical practitioners; and Consulting services in the medical marijuana field.</p>
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# Appearances and Agents of Record

**HEARING DATE:** No hearing held

## **AGENTS OF RECORD**

**For the Opponent:** BERESKIN & PARR LLP/S.E.N.C.R.L., s.r.l.

**For the Applicant:** LEI ZHOU (WITMART INC.)