

**IN THE MATTER OF AN OPPOSITION
by Parmalat Food Inc. to application no. 853,582
for the trade-mark BLACK DIAMOND filed
by Sun World International, Inc.**

On August 15, 1997, the applicant Sun World International, Inc. filed an application to register the trade-mark BLACK DIAMOND based on use in Canada since at least as early as July 6, 1990 in association with fresh fruits and vegetables. The Examination Section of the Trade-marks Office objected that the applied for mark was confusing with a number of registered trade-marks comprised, in whole or in part, of the term BLACK DIAMOND. The cited registrations were owned by Parmalat Food Inc. for use in association with cheese and related wares.

The applicant overcame the objections of the Examination Section by arguing, among other things, that the wares associated with the applied for mark were different from the wares covered by the cited registrations. The subject mark was subsequently advertised for opposition purposes in the *Trade-marks Journal* issue dated May 9, 2001 and was opposed by Parmalat Food Inc. on January 9, 2002.

On January 31, 2002, the applicant requested leave to amend the subject application to narrow the scope of the wares to "plums." The Registrar granted leave to the applicant on February 12, 2002, and notified the opponent that if it wished to do so it could request leave to amend its statement of opposition. As well, on February 12, 2002, the Registrar forwarded to the applicant a

copy of the statement of opposition dated January 9, 2002. The applicant responded by filing and serving a counter statement.

The first ground of opposition alleges that the application does not conform with Section 30(i) of the *Trade-marks Act* because, at the date of filing the application, the applicant was aware of the opponent's extensive use of confusingly similar marks set out in Schedule 1, below.

The second ground of opposition alleges that the application does not conform to Section 30(b) of the *Trade-marks Act* in that the applicant has not used the applied for mark since the date cited in the application, that is, July 6, 1990.

The third ground of opposition alleges that the applied for mark is not registrable, pursuant to Section 12(1)(d) of the *Act*, because it is confusing with the opponent's registered marks listed in Schedule 1, below.



The fourth ground of opposition alleges that the applicant is not entitled to register the applied for mark, pursuant to Section 16(1)(a) of the *Act*, because at the date of first use of the applied for mark, it was confusing with the opponent's marks set out in Schedule 1, below, which had been previously used in Canada by the opponent and its predecessors in title.




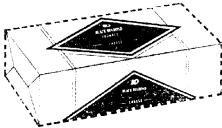
The fifth ground of opposition alleges that the applicant is not entitled to register the applied for mark, pursuant to Section 16(1)(c) of the *Act*, because at the date of first use of the





applied for mark, it was confusing with the opponent's trade-name Black Diamond Cheese Company previously used in Canada by the opponent and its predecessors in title.





The last ground of opposition alleges that the applied for mark is not distinctive of the applicant's wares in view of the opponent's use of its marks for cheese and related products.


Schedule 1 - Opponent's Registered Trade-marks

Mark and Registration no.	Wares
BLACK DIAMOND regn. no. 853582	cheese, dip, spread, fondue, mixes
BLACK DIAMOND 1% regn. no. 507570	cheese
 regn. no. 210879	processed cheese
 Black Diamond	cheese

<p>regn. no. 277603</p>	
<p>  Black Diamond </p> <p>regn. 277602</p>	<p>cheese</p>
<p>  </p> <p>regn. no 553386</p>	<p>cheese and promotional items, namely, T-shirts, sweatshirts and caps.</p>
<p>  Black Diamond </p> <p>regn. no. 264394</p>	<p>cheese</p>
<p>  </p>	<p>cheese</p>

regn. no. 413573	
 regn. no. 450124	cheese
 regn. no. 450171	cheese
 Black Diamond Burgerslice regn. no. 407385	cheese
 regn. no. 536002	cheese
	process skim milk cheese

 <p>regn. no. 287087</p>	
 <p>regn. no. 287088</p>	process skim milk cheese
<p>BLACK DIAMOND LITES LEGER</p> <p>regn. no. 393704</p>	processed cheese slices
 <p>regn. no. 433272</p>	cheese
	cheese

regn. no. 416264	
	processed cheese
regn. no. 331343	

The opponent's evidence consists of the affidavits of Steve Trofimchuk, Director of Marketing for the Dairy Food Group Division for the opponent; Brian Hind, Vice-President Operations, Fluid and Beverages for the opponent; and Alexander Chan, articling student. Additionally, the opponent submitted certified copies of each of the trade-mark registrations relied on in the statement of opposition. The applicant's evidence consists of the affidavits of Jemiah Yen Chan, lawyer, and Elenita Anastacio, trade-mark searcher. Additionally, the applicant submitted a certified copy of the subject trade-mark application no. 853,582. Messrs. Trofimchuk, Hind and Chan were cross-examined on their affidavit testimony. The transcripts thereof and exhibits thereto form part of the evidence of record. Only the opponent submitted a written argument, however, both parties were ably represented at an oral hearing.

Mr. Trofimchuk's affidavit evidence may be summarized as follows. The opponent and its affiliate Parmalat Dairy and Bakery Inc. are producers of dairy products namely milk, yogurt, cheese and sour cream. One line of cheese products is sold under the trade-mark BLACK DIAMOND. The opponent acquired the BLACK DIAMOND cheese business in 1990 from predecessors in title dating back to 1933. Mr. Trofimchuk is not aware of any sales or advertising

records for BLACK DIAMOND cheese products prior to 1990.

The opponent sometimes carries on business as Black Diamond Cheese Company, as Black Diamond Cheese Co., and as Black Diamond. Since 1990, the opponent has sold a number of different cheese products in Canada under its BLACK DIAMOND marks including natural cheese, process cheese slices, snack cheese, Sarento shredded cheese and process cheese spread. Exhibit 3 of Mr. Trofimchuk's affidavit shows that the opponent's mark BLACK DIAMOND is prominently featured on product packaging. The BLACK DIAMOND line of cheese products have consistently been the second largest selling cheese brand in Canada. Sales in Canada amounted to about \$63 million yearly in 1995 and 1996 rising steadily to about \$147 million yearly in 2001 and 2002. The BLACK DIAMOND line of cheese products is available in nearly every major grocery store throughout Canada except for Quebec where the line is carried by some, but not all, major retailers. Marketing expenses for BLACK DIAMOND products have averaged in excess of \$3.6 million annually for the period 1990 - 1994 inclusive. Promotional campaigns include point of sales displays at retailers, coupon offers, newspaper and magazine advertising, and radio and television advertising. Exhibit material attached to Mr. Trofimchuk's affidavit shows that the opponent's mark BLACK DIAMOND is prominently featured in such advertising.

Further, the opponent's line of BLACK DIAMOND cheese is often advertised and promoted in produce areas of grocery stores because the opponent views its cheese products as a complement to produce: see Mr. Trofimchuk's transcript of cross-examination at Q34; Q44; Q64; and in particular Q296 on re-examination shown below:

Mr. Hind's evidence is that he has been employed in the dairy industry for about 29 years. During the period 1973 - 1980 when he was employed by a competitor of the opponent, BLACK DIAMOND process cheese was the second best selling brand in Canada while BLACK DIAMOND natural cheese was the second or third best selling brand.

It is apparent from Mr. Trofimchuk's transcript of cross-examination that many of the details provided in his affidavit are sourced from third parties and are inadmissible hearsay. However, Mr. Trofimchuk as well as Mr. Hind responded clearly, fully and informatively to questions put to them on cross-examination. Taking their evidence as a whole, and after discounting the inadmissible portions of Mr. Trofimchuk's affidavit, I am prepared to infer that the opponent's mark BLACK DIAMOND had at all material times acquired a significant reputation in Canada in association with cheese.

Mr. Chan's affidavit evidence indicates that (1) he located several references to BLACK DIAMOND cheese in books on the subject of cheese found at the Ottawa Public Library, and (2) references to or advertisements for BLACK DIAMOND cheese appear regularly in major Canadian newspapers.

Ms. Anastacio's affidavit, filed on behalf of the applicant, serves to introduce into evidence searches of the trade-marks register for marks containing (1) the components BLACK and DIAMOND, or the design of a diamond, which search located 68 active and inactive marks, (2)

the components BLACK or DIAMOND (or a figure of a diamond similar to the diamond design feature in the opponent's marks shown in Schedule 1, above) for marks covering food products, which search located 234 active marks. Full particulars were then provided for 102 of the 234 marks. Among the marks located were, for example, BLACK PEARL & Design for fish products, BLACK RHINO COFFEE for coffee and tea products, BLACK RIVER for fruit juice, DIAMOND & Design for nuts, DIAMOND for canned foods, DIAMOND & Design for apples, pears and cherries.

A further search was conducted for marks "containing the same word or words that exist for different ownership for both fruit and cheese." The marks located were COTTAGE COUNTRY & Design for fruit and other wares; COUNTRY KITCHEN for cheese and other wares; and COUNTRY ACRES for blueberries and strawberries.

Jeliah Chan's affidavit, also filed on behalf of the applicant, serves to introduce into evidence a search of the *Toronto Star* newspaper for the phrase BLACK DIAMOND for the years 1945 to 2000. The search located BLACK DIAMOND used as a trade-mark for grapefruit and oranges (prior to 1950); baseball fielder's gloves (prior to 1992); footwear; television programming; a musical band; a motorcycle club; a musical album; a spinning reel for fishing rods (prior to 1983); jewelry (prior to 1965); and mink furs (mostly prior to 1990).

The first ground of opposition does not stand independently but depends on a finding of confusion raised in subsequent grounds.

The second ground of opposition, based on Section 30(b) of the *Trade-marks Act*, requires the application to contain the date from which the applicant has used its mark. As always, the legal onus is on the applicant to show that its application complies with Section 30(b). That is, the applicant must show that the date of first use alleged is factually correct. The application may contain a date of first use later than the actual date of first use, but may not contain a date earlier than the actual date of first use. There is also, in accordance with the usual rules of evidence, an evidential burden on the opponent to establish the facts inherent in its allegation that the applicant's date of first use is incorrect. The presence of an evidential burden on a party with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. The evidential burden on the opponent with respect to the date of first use of the applied for mark is relatively light because the facts pertaining to first use are usually known to the applicant but not easily available to the opponent: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R.(3d) 293 at pp. 298-300 (F.C.T.D.).

In the instant case the applicant has not submitted any evidence of use of its mark, however, the absence of such evidence is not, by itself, sufficient to put the second ground of opposition into issue. On cross-examination, counsel for the applicant questioned Mr. Trofimchuk as well as Mr. Hind on whether they had ever encountered the applicant's trade-mark BLACK DIAMOND used in association with plums. Both answered in the negative. Although the opponent did not explicitly establish that either Mr. Trofimchuk or Mr. Hind had knowledge

regarding trade-marks used in association with fruits, it is apparent from Mr. Trofimchuk's testimony on cross-examination that he was very familiar with the marketing of fruit in major grocery stores. Thus, there is at least some credible evidence indicating that the applied for mark was not used by the applicant. I note further that the applicant had every opportunity to dispel any doubts concerning its use of the mark BLACK DIAMOND by evidencing its use. It would have been a simple and prudent matter for the applicant to do so particularly in opposition proceedings where the applicant files its evidence after cross-examining the opponent's witnesses. Thus, as the evidence of record raises at least some doubt as to whether the applicant has in fact used its mark, I find that the opponent has met the light evidential onus on it to put the second ground of opposition into issue. I also find that the applicant has done nothing to meet the legal onus on it to overcome the evidence of record which indicates that the applicant did not in fact use its mark. Accordingly, the opponent succeeds on the second ground of opposition. In the event that I am in error in so finding, I will consider the remaining grounds of opposition.

The main issue in respect of the remaining grounds of opposition is whether the applied for mark BLACK DIAMOND used in association with plums is confusing with the opponent's mark BLACK DIAMOND used in association with cheese. In this regard, the opponent employs the term BLACK DIAMOND as a trade-mark *per se* and also as a component of various design marks as shown in Schedule 1, above. In the majority of the opponent's design marks the term BLACK DIAMOND would be perceived as a mark *per se* in combination with other marks, such as a stylised diamond design: see *Nightingale Interloc v. Prodesign Ltd.* (1984), 2 C.P.R.(3d) 535 at 538 (TMOB), under the heading Principle 1.

The material times to assess the issue of confusion are (i) the date of decision with respect to the third ground of opposition alleging non-registrability: see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A.), (ii) the date of first use of the applied for mark, in this case July 6, 1990, with respect to the fourth and fifth grounds of opposition alleging non-entitlement: see Section 16(1) of the *Trade-marks Act*, (iii) the date of opposition, in this case January 9, 2002, in respect of the last ground of opposition alleging non-distinctiveness: see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and *Clarco Communications Ltd. v. Sassy Publishers Inc.* (1994), 54 C.P.R.(3d) 418 (F.C.T.D.). However, in the circumstances of this case, I do not believe that anything turns on whether the issue of confusion is determined at any particular material date.

The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2), between the applied for mark BLACK DIAMOND for plums and the opponent's mark BLACK DIAMOND for cheese. The presence of an onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.). The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in Section 6(5) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time

each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

The opponent's mark possesses a fairly high degree of inherent distinctiveness because the term "black diamond" is an unusual juxtaposition, that is, the adjective "black" does not normally describe the noun "diamond." Further, the term BLACK DIAMOND is not related to or descriptive of cheese. Although the opponent's evidence is not immune to criticism for incompleteness, it is nevertheless sufficient to establish that its mark BLACK DIAMOND had acquired a significant reputation for cheese in Canada at all material times. The applied for mark also possesses a fairly high degree of inherent distinctiveness, however, there is no evidence that it acquired any reputation at any material time. In this regard, the applicant has not put forward any evidence of sales or advertising under its mark. The length of time that the marks in issue have been in use favours the opponent, as its mark was first used in 1933 while the applied for mark claims a date of first use in 1990. The parties' wares belong to the broad general category of food products, however, cheese is of course intrinsically different from fruit. Nevertheless, the channels of trade for the parties' wares may be expected to overlap and, according to Mr. Trofimchuk, cheese and fruit are two products which the consumer would eat together. Further, the opponent has a marketing strategy for advertising its cheese products in the produce areas of supermarkets.

As for the resemblance between the marks in issue, they are of course identical.

The Chan and Anastacio affidavits, filed on behalf of the applicant, do little to further the applicant's case. In this respect, the state of the trade-marks register search located many marks where the components BLACK and DIAMOND appeared singly or in conjunction with other components, but the search did not locate any occurrence for BLACK DIAMOND *per se* used in association with food products (with the possible exception of regn. no. 52227 for rum). Thus, the applicant's state of the register evidence does not significantly diminish the inherent distinctiveness of the opponent's mark BLACK DIAMOND. Further, the applicant's evidence of advertising under the mark BLACK DIAMOND by third parties for wares other than cheese is insufficient to significantly diminish the acquired distinctiveness of the opponent's mark BLACK DIAMOND.

Having regard to the above, and considering in particular the inherent and acquired distinctiveness of the opponent's mark BLACK DIAMOND, the length of time it has been in use in the marketplace, the overlap in the parties' channels of trade, and the connection between fruit and cheese as evidenced by the opponent, I find that the applicant has not shown, on a balance of probabilities, that there is no reasonable likelihood of confusion between the marks in issue. Accordingly, the opponent succeeds on the grounds of opposition alleging non-registrability, non-

entitlement, and non-distinctiveness.

In view of the above, the subject application is refused.

DATED AT GATINEAU, QUEBEC, THIS 28th DAY OF MARCH, 2006.

Myer Herzig,
Member,
Trade-marks Opposition Board