

IN THE MATTER OF THE OPPOSITION

by Chocolaterie **Bernard Callebaut Ltd.** to
the application for registration no. 883450
for the trade-mark **PISTOLES** filed by
Barry Callebaut France, Société Anonyme.

On July 3, 1998, Barry Callebaut France, Société anonyme (the “Applicant”) filed an application for the registration of the trade-mark PISTOLES (the “Mark”) in association with:

[Translation] Cocoa, chocolate, sugar, rice, tapioca, sago; flours, bread, pastry and confectionary, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar; spices; ice. (the “Wares”).

The Applicant claimed the priority under section 34 of the *Trade-marks Act* (the “Act”) by virtue of an application for registration for the Mark filed on March 30, 1998, in France, the Applicant’s country of origin, and its use in that country. This application for registration was published on September 29, 1999, in the *Trade Marks Journal*.

On June 12, 2000, Chocolaterie Bernard Callebaut Ltd. filed a statement of opposition alleging the following grounds of opposition:

- (1) In consideration of the provisions of section 30 of the Act, the Applicant could not be satisfied that it was entitled to use the Mark because of the grounds of opposition hereinafter described. The Opponent further based this ground of opposition on the fact that the Applicant had not used and registered the Mark in France in association with the Wares.
- (2) In consideration of the provisions of section 30 of the Act, the statement of the Wares was not in the ordinary commercial terms.

(3) In consideration of the provisions of paragraph 12(1)(d) of the Act, the Mark is confusing with the following registered marks:

a) PISTOL & BURNS and design	TMA467236
b) PISTOL & BURNS	TMA467237
c) PISTOL & BURNS and design	TMA468913

(4) The Mark is not distinctive because of the facts described above and it is not capable of distinguishing the Wares in association with which it is alleged to be employed from the wares of third parties including those of the Opponent and the owners of the trade-marks referred to above. If the Mark has been used, it has not been used by the Applicant.

On June 30, 2000, the Applicant filed a counter-statement of opposition denying each and every one of the grounds of opposition.

The Opponent filed in evidence the affidavit of Lisa J. Reynolds. She was a student employed by the Opponent's agents. Her affidavit serves only for the filing of the trade-marks registration certificates referred to in paragraph 3 of the grounds of opposition listed above.

The Applicant filed no evidence, subject to what follows. None of the parties filed any written submissions. The Opponent availed itself of its right to request a hearing but subsequently abandoned this request. So there was no hearing.

Notwithstanding the fact that the Registrar may examine the state of the Register when analyzing a ground of opposition based on paragraph 12(1)(d) of the Act [see, in this regard, *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats Ltée. v. Manu Foods Ltd.*, 11 C.P.R. (3d) 410] the Applicant requested leave to file in evidence some certificates of authenticity of each of the trade-marks cited by the Opponent in its statement of opposition, in order to demonstrate that these marks were expunged on

March 22, 2002, because of the failure of the owner to demonstrate their use after the Registrar sent a notice under section 45 of the Act. On April 26, 2004, I allowed this request for filing of additional evidence.

The relevant date for the analysis of the different grounds of opposition varies according to the ground of opposition that is raised. So, with reference to grounds of opposition based on section 30 of the Act, the relevant date is the date of filing of the application (March 30, 1998, or the claimed date of priority) [see *Dic Dac Holdings (Canada) Ltd. v. Yao Tsai Co. (1999)*, 1 C.P.R. (4th) 263]. With reference to the ground of opposition based on paragraph 12(1)(d) of the Act, the relevant date is the date of my decision [see *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. (1991)*, 37 C.P.R. (3d) 413 (FCA)]. Finally, it is generally recognized that the date of filing of the opposition (June 12, 2000) is the relevant date for the analysis of the ground of opposition based on the Mark's lack of distinctiveness [see *Andres Wines Ltd. and E&J Gallo Winery (1975)*, 25 C.P.R. (2d) 126 (F.C.A.) at page 130 and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd., op. cit.*].

In proceedings involving an opposition to the registration of a trade-mark, the Opponent must present sufficient evidence concerning the grounds upon which it is relying to indicate that there are facts that support these grounds of opposition. If this task is accomplished, the burden of proof shifts to the Applicant, who will have to persuade the Registrar that the grounds of opposition should not preclude the registration of its trade-mark [see *Sunshine Biscuits Inc. v. Corporate Foods Ltd. (1982)*, 61 C.P.R. (2d) 53, *Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd. (1984)*, 3 C.P.R. (3d) 325 and *John Labatt Ltd. v. Molson Companies Limited, (1990)*, 30 C.P.R. (3d) 293].

From the evidence summarized above, it appears that the Opponent has not discharged its initial burden of proof relating to the grounds of opposition described above in paragraphs 1 and 2, and consequently they are rejected.

The certificates of registration for the trade-marks on which the Opponent relies in support of its third ground of opposition have all been expunged from the Register. Consequently, it is unnecessary to determine whether there is a risk of confusion between the Mark and these trade-marks at the date of my decision [see *Labatt Brewing Co. v. Molson Breweries, A Partnership* (1992), 42 C.P.R.(3d) 481]. The third ground of opposition is therefore rejected as well.

That leaves only the fourth ground of opposition. The Opponent has filed no proof of use of the trade-marks it cites in support of this ground of opposition. But if the Opponent is to have any chance of success in relation to this ground of opposition, it must demonstrate that its mark or the marks of third parties that it cites are sufficiently known to the public that the Mark is not distinguishable of the Wares from the wares of these third parties [see *Motel 6, Inc. v. No6 Motel Ltd.* (1981) 56 C.P.R. (2d) 44 and *Andreas Wines Ltd. v. E & J Gallo Winery* (1975) 25 C.P.R. (2d) 44]. Because the Opponent has failed to discharge this initial burden of proof, I have no option but to reject this ground of opposition as well.

In accordance with the powers delegated to me by the Registrar of Trade-marks under the provisions of subsection 63(3) of the Act, I therefore reject the opposition by the Opponent, under the provisions of subsection 38(8) of the Act.

DATED AT MONTRÉAL, QUEBEC, THE 18th DAY OF MAY 2004.

Jean Carrière

Member of the Trade-marks Opposition Board