



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2016 TMOB 162
Date of Decision: 2016-09-30

A. Bosa & Co. Ltd. **Opponent**

and

A-27 S.p.A. **Applicant**

1,621,402 for BONTÀ DIVINA

Application

[1] On April 5, 2013, A-27 S.p.A. (the Applicant) filed an application to register the trade-mark BONTÀ DIVINA (the Mark). The application is based on the Applicant's use and registration in Italy in association with the following Goods and claims a priority filing date of February 12, 2013:

Preserved, frozen, dried and cooked fruits, jellies, jams, compotes; milk and milk products; bakery goods, namely cake mixes, cakes, cookie mixes, cookies, pies, and bakery desserts; dessert products, namely pastries, custards, ice cream, mousses, confectionery, namely almond confectionery, chocolate confectionery, frozen confectionery, fruit-based confectionery, peanut confectionery, sugar confectionery.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of December 3, 2014.

[3] On February 3, 2015, A. Bosa & Co. Ltd. (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- The application does not comply with section 30(a) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) because the application does not contain a statement in ordinary commercial terms of the goods described as “milk products”.
- The application is not registrable as it is confusing with the Opponent’s registration No. TMA535,095 for the trade-mark BONTA registered for use in association with baby clams, beans, rice, peppers, pimentos, artichokes, fish for food purposes, mackerels, sardines and anchovies.
- The Applicant is not the person entitled to register the Mark pursuant to section 16(2)(a) of the Act because at the date of filing the application, it was confusing with the Opponent’s trade-mark BONTA used in association with:
 - (1) Baby clams, beans, rice, peppers, pimentos, artichokes, fish for food purposes, mackerels, sardines and anchovies.
 - (2) Chick peas, cornmeal, spit green peas, mushrooms, quinoa, semolina, olive oils, olives, fish for food purposes namely, squid, tuna, octopus.
- The Applicant is not the person entitled to register the Mark pursuant to section 16(2)(b) of the Act because at the date of filing the application, it was confusing with the Opponent’s trade-mark BONTA previously filed under application No. 891,362 in association with baby clams, beans, rice, peppers, pimentos, artichokes, fish for food purposes, mackerels, sardines and anchovies.
- The Mark is not distinctive because it is not capable of distinguishing the Goods from those of others, particularly the goods provided by the Opponent under the trade-mark BONTA.

[4] The Applicant served and filed a counter statement. Neither party filed evidence. Both parties filed a written argument and I confirm that I have had regard to the Opponent’s submissions filed by facsimile on May 12, 2016 and the Applicant’s submissions filed on May 12, 2016 and those filed before the call for written arguments on February 12, 2016. A hearing was not held.

Onus and Material Dates

[5] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[6] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30(a) - the date of filing the application [see *Georgia-Pacific Corp. v Scott Paper Ltd.* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co. v Canadian Exhibition Management Inc.* (1990), 28 CPR (3d) 428 at 432 (TMOB)].
- sections 38(2)(b)/12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].
- sections 38(2)(c)/16(2) - the priority filing date of the application [see sections 16(2) of the Act and 34].
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v Stargate Connections Inc.* (2004), 34 CPR (4th) 317 (FC)].

Analysis of the Grounds of Opposition

Section 30(a) Ground of Opposition

[7] The section 30(a) ground of opposition alleges that the application does not conform to the Act insofar as the goods described as milk products are concerned since this term is not in ordinary commercial terms. The Opponent did not file any evidence in support of its allegation.

[8] The Trade-marks Office's Goods and Services Manual includes a representative list of acceptable goods and services [see *Johnson & Johnson v Integra Lifesciences Corp* (2011), 98 CPR (4th) 429 at para 29 (TMOB) which confirms that the Registrar may exercise her to discretion to check it].

[9] As the Goods and Services Manual includes this term and indicates that it was effective as of May 5, 2011, I find that in the absence of evidence, the Opponent's pleading alone fails to meet its evidential burden and this ground of opposition is rejected.

Section 12(1)(d) Ground of Opposition

[10] An opponent's initial evidential burden is met with respect to a section 12(1)(d) ground of opposition if the registration set out in the statement of opposition is in good standing as of the date of the decision. I have exercised the Registrar's discretion to check the register [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd.* (1986), 11 CPR (3d) 410 (TMOB)] and confirm that the Opponent's registration is valid. The particulars of this registration are set out below.

| Registration No. | Trade-mark | Goods |
|------------------|------------|--|
| TMA535,095 | BONTA | (1) Baby clams, beans, rice, peppers, pimentos, artichokes, fish for food purposes, mackerels, sardines and anchovies (Registered Goods (1)). (2) Chick peas, cornmeal, spit green peas, mushrooms, quinoa, semolina, olive oils, olives, fish for food purposes namely, squid, tuna, octopus (Registered Goods (2)). |

[11] In deciding this ground of opposition, however, I am only having regard to Registered Goods (1) set out above. I note that the registration was amended after the filing of the statement of opposition to include Registered Goods (2). Given that the statement of opposition identifies only Registered Goods (1) and leave to amend it to include Registered Goods (2) was not sought, I am not having regard to these goods in my assessment of the likelihood of confusion. If my decision on this point is incorrect, I note that having regard to Registered Goods (2) would not have impacted my findings or conclusion on the likelihood of confusion between the parties' trade-marks.

[12] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[13] 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 trade-marks 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 trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc. v 3894207 Canada Inc.* (2006), 49 CPR (4th) 321 (SCC). and *Masterpiece Inc. v Alavida Lifestyles Inc.* (2011), 96 CPR (4th) 361 (SCC).]

Inherent Distinctiveness

[14] The Mark consists of the words “bontà” and “divina” and the Opponent’s trade-mark consists of the word “bonta”. According to the translation provided in the application for the Mark, “bontà divina” translates into “goodness gracious”. In its written submissions, the Opponent states that the word “bonta” is a foreign word (para 6.2.1). However, there is no evidence to suggest that purchasers of the parties’ goods would be aware of the translation of the Mark or the Opponent’s trade-mark BONTA or understand the Opponent’s trade-mark to be anything other than a fanciful word. Therefore, the marks of each party are inherently distinctive [*Thai Agri Foods Public Co v Choy Foong Int’l Trading Co Inc*, 2012 TMOB 61 at para 11].

Extent Known and Length of Time in Use

[15] This factor favours neither party. There is no evidence that the Applicant has used the Mark in Canada. While the Opponent's registration is based on use, this only entitles me to assume *de minimis* use [*Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB) at 430]. *De minimis* use does not support a conclusion that the trade-mark has become known to any significant extent, nor that the trade-mark has been used continuously.

Nature of Goods, Services or Business

[16] It is the Applicant's statement of goods as defined in its application versus the Opponent's registered goods that govern my determination of this factor [see *Esprit International v Alcohol Countermeasure Systems Corp.* (1997), 84 CPR (3d) 89 (TMOB)].

[17] The Applicant's fruit products, milk products, and desserts and confectionery products and the Opponent's beans, rice, vegetable products specifically peppers, pimentos, and artichokes and the types of fish covered in Registered Goods (1) fall within the general category of food products although the specific nature of the parties' food products differs. Neither of the parties has filed any evidence regarding the precise nature of its business or its normal course of trade. In view of the fact that the parties' goods are all food products, however, it is reasonable to conclude that their channels of trade would overlap since the goods of both parties might well be sold through the same supermarkets, grocery stores or the like, although not necessarily in the same section.

Degree of Resemblance

[18] In assessing the degree of resemblance between the parties' marks they must not be dissected and must be considered as a whole and as a matter of first impression by the average person [see *Masterpiece*, at para 83]. In the present case, the Opponent's trade-mark consists solely of the word BONTA, which is inherently distinctive. While the addition of the word DIVINA and the accent above the letter "a" in "bontà" in the Mark do result in some differences between the parties' trade-marks, overall, I find that as a matter of first impression, there is still a fair degree of resemblance between them.

Conclusion

[19] Having considered all of the surrounding circumstances and applying the test of confusion as a matter of first impression and imperfect recollection, I find that the Applicant has failed to establish on a balance of probabilities that there is not a reasonable likelihood of confusion between the Mark and the Opponent's trade-mark BONTA. I have reached this conclusion because the Applicant has incorporated the whole of the Opponent's inherently distinctive trade-mark into the Mark, which results in a fair degree of resemblance between the

parties' trade-marks. Further, the Opponent's Registered Goods (1) fall into multiple categories of food products and may be found throughout a grocery store (for example, the Opponent's trade-mark may be found where fresh vegetables, fish products, legumes, and rice are sold), and as such, a consumer seeing the Mark in association with fruits, dessert and confectionery products, and milk and milk products may well infer that these goods sold in association with the Mark have the same source as the Opponent's Registered Goods (1) sold in association with its BONTA trade-mark. As such, the Applicant fails to meet its legal onus of proving that there was no reasonable likelihood of confusion on a balance of probabilities and this ground of opposition is successful.

Opponent Does Not Meet Its Burden with Respect to Any of the Remaining Grounds of Opposition

[20] The Opponent has not met its initial burden with respect to the grounds of opposition based on sections 16(2)(a) and 2 of the Act. With respect to the section 16(2)(a) ground of opposition, there is an initial burden on the Opponent to evidence use of its trade-mark prior to the Applicant's priority filing date and that it had not abandoned its trade-mark as of the date of advertisement of the Applicant's application [section 16(5) of the Act]. With respect to the section 2 ground of opposition, the Opponent must demonstrate that its trade-mark acquired a reputation in Canada that was sufficient to affect the distinctiveness of the Mark as of the date of filing the statement of opposition [see *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 at para 34 (FC) which sets out what is required of an opponent to meet its burden with respect to distinctiveness]. As the Opponent has not evidenced that its BONTA trade-mark was used or known in Canada as of the applicable material dates, these grounds of opposition are rejected.

[21] With respect to the section 16(2)(b) ground of opposition, the Opponent alleges that the Applicant is not the person entitled to registration of the Mark as it is confusing with the Opponent's prior application No. 891,362 for BONTA for baby clams, beans, rice, peppers, pimentos, artichokes, fish for food purposes, mackerels, sardines and anchovies. As this application had matured to registration and was not pending as of the Applicant's advertisement date (i.e. December 3, 2014) as required by section 16(4) of the Act, this ground of opposition is invalid.

Disposition

[22] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

AGENTS OF RECORD

KLS TRADEMARK SERVICES

For the Opponent

FETHERSTONHAUGH & CO.

For the Applicant