

**IN THE MATTER OF AN OPPOSITION by
Multi-Marques Inc. and Boulangerie POM
Limitée to Application No. 891997 for the trade-
mark PIM POM filed by Gesfor
Aktiengesellschaft**

I The Pleadings

On September 29, 1998 Gesfor Aktiengesellschaft (the “Applicant”) filed an application to register the trade-mark PIM POM (the “Mark”), application number 891997, in association with a list of wares that was amended during the course of this opposition to cover only lollipops. (the “Wares”) The Applicant disclaimed the right to the exclusive use of the word POM apart from the trade-mark as a whole. The application is based on registration and use abroad and was advertised October 25, 2000 in the Trade-marks Journal for opposition purposes.

Multi-Marques Inc. (the “Opponent”) and Boulangerie Pom Limitée (the “Co-opponent”) (the Opponent and the Co-opponent collectively referred to as the “Opponents”) filed a statement of opposition on March 8, 2001 that was forwarded by the Registrar to the Applicant on June 15, 2001.

The grounds of opposition pleaded are:

1. The Application does not comply with the requirements of s. 30(d) of the *Trade-marks Act* R.C.S., 1985, c. T-13 (the “Act”);
2. The Application does not comply with the requirements of s. 30(i) of the Act as the Co-opponent has been using the trade-marks POM since 1930, “POM GOLD” (POM D’OR) since at least 1952, POM LITE since at least 1987 and POM & design since at least 1991 and as such the Applicant could not have made the statement required under s. 30(i) as it could not and still cannot be satisfied that it was entitled to use the Mark in Canada in association with the Wares as at the filing date of the application the Applicant was aware of the use of the Co-Opponent’s trade-marks;
3. The Mark is not registrable pursuant to the provisions of s. 38(2)(b) and 12(1)(d) of the Act in that the Mark is confusing with the following Co-Opponent’s registered trade-marks:

TMDA049765, POM;
UCA040516, “POM GOLD” (POM D’OR);

TMA335814, POM LITE
TMA469001POM & DESIGN as illustrated hereinafter:



4) The Applicant is not the person entitled to the registration of the Mark pursuant to the provisions of s. 38(2)(c) and 16(2)(a) of the Act as at the filing date of the application, the Mark was confusing with the Co-opponent's trade-marks previously used in Canada by the Co-opponent and the Opponent or their predecessor-in-title;

5) The Applicant is not the person entitled to the registration of the Mark pursuant to the provisions of s. 38(2)(c) and 16(2)(b) of the Act as at the filing date of the application, the Mark was confusing with the following Co-opponent's trade-mark applications previously filed in Canada by the Co-opponent:

- i) 0151507 for the trade-mark POM filed on May 3rd, 1930
- ii) 0213860 for the trade-mark POM GOLD (POM D'OR) filed on February 1, 1952;
- iii) 0572582 for the trade-mark POM LITE filed on November 10, 1986;
- iv) 0784074 for the trade-mark POM & Design filed on June 2, 1995;

6) Pursuant to s. 38(2)(d) and s. 2 of the Act, the Applicant's Mark is not distinctive, and is not capable of distinguishing or adapted to distinguish the Applicant's Wares from the Opponents' wares in view of the Co-opponent and Opponent's use of the trade-marks listed above;

The Applicant filed a counter statement on October 11, 2001 in which in essence it denies all grounds of opposition and pleaded that the Co-opponent's trade-marks are weak in view of the coexistence on the register or on the marketplace of trade-marks having the component POM.

The Opponents filed the affidavits of Jean-Pierre Galardo and Jennifer Petras. The Applicant filed the affidavit of Alan J. Booth. The latter was cross-examined and the transcript of his cross-examination was filed in the record.

Both parties submitted written arguments and were represented at an oral hearing.

II General principles applicable to all grounds of opposition

The legal burden is upon the Applicant to show that its application complies with the provisions of the Act, but there is however an initial evidential onus on the Opponents to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once this initial onus is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark. [See *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company*, [2005] F.C. 722]

III Conformity and entitlement based on s. 16(2)(b)

Without going into a detailed analysis of the evidence filed by both parties I can dispose at this stage of certain grounds of opposition.

In their written argument the Opponents did not make any representations with respect to the first ground of opposition. There is no evidence filed by the Opponents on this issue and as such they have not met their initial onus. Therefore this ground of opposition is dismissed.

As for the second ground of opposition, the fact that the Applicant might have been aware of the Co-opponent's registrations listed above does not prevent it from making the statement required under s. 30 (i) of the Act. This ground of opposition has a limited scope such as where the trademark applied for contravenes a statute; or in case of bad faith on the part of the Applicant; or where there is a breach to some contractual undertaking. [See for example *Sapodilla Co. Ltd. v. Bristol Myer Co.* (1974), 15 C.P.R. (2d) 152 and *Super Seer Corp. v. 546401 Ontario Ltd.* (2000), 6 C.P.R. (4th) 560] There is no such allegation in the statement of opposition or evidence in the file to that effect. Consequently the second ground of opposition described above is also dismissed.

As for the fifth ground of opposition, s. 16(4) of the Act stipulates that the applications listed against the registration of a trade-mark must be pending at the date of advertisement of the application opposed. (October 25, 2000) I used my discretionary power and reviewed the register. I confirm that none of the applications listed under the fifth ground of opposition were pending at such date. Therefore this ground of opposition is also dismissed.

IV Registrability

There remain three grounds of opposition: registrability under s. 12(1)(d), entitlement under s. 16(2)(a) and distinctiveness. All these grounds must be assessed at different dates but that variable will not have any influence on the key common issue under these grounds: is the Mark confusing with any of the Co-opponent's trade-marks? This question must be answered by applying the criteria listed under s. 6(5) of the Act, namely:

- (a) The inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;
- (b) The length of time the trade-marks or trade-names have been in use;
- (c) The nature of the wares, services, or business;
- (d) The nature of the trade;
- (e) The degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them.

Those criteria are not exhaustive and it is not necessary to give each one of them equal weight. [See *Clorox Co. v. Sears Canada Inc.* (1992), 41 C.P.R. (3d) 483 (F.C.T.D.), *Gainers Inc. v. Marchildon* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.) and *Mattel, Inc. v. 3894207 Canada Inc.*, (2006) 49 C.P.R. (4th) 321 (S.C.C.)]

The Opponents agents' firm has employed Ms. Petras. She filed a certified copy for each of the Co-opponent's registered trade-marks listed above. The certificates of registration filed reveal the following:

TMDA049765, for the trade-mark POM registered on June 20, 1930 in association with bread, cake and confectionary;

UCA040516, for the trade-mark “POM GOLD” (POM D’OR) registered on February 1st 1952 in association with bread;

TMA335814, for the trade-mark POM LITE registered on December 31, 1987 in association with bread;

TMA469001, for the trade-mark POM & DESIGN registered on January 17, 1997 in association with baked goods and pastries, namely bread, organic bread, rolls, donuts, buns, cakes, biscuits, galettes, pastries, pies, muffins, English muffins, croissants, pizza dough, tortillas, pita, bagels, breadsticks and Kaisers.

At the hearing there was a debate as to what should be considered as the list of wares covered by registration TMDA049765. According to the Opponents, the certificate of registration was amended subsequent to proceedings taken under s. 44 of the Act. The Opponents made a verbal request to introduce as additional evidence a certified copy of the certificate of registration as it now reads. The Applicant objected on the basis that the amendment to the registration occurred 2 or 3 years ago and as such the present request was made too late. Since the demand was presented at the last possible moment I gave each party one week to file written representations on this issue. The Opponents did file a copy of the certificate of registration as it now reads. As for the other documents annexed to the letter dated April 23, 2008, they are not introduced properly by way of affidavit and as such I will not consider them.

In any event, as I pointed out at the hearing, I have the discretionary power to check the register where s. 12(1)(d) is argued as a ground of opposition and that there is no certificate of registration filed to support such ground. [See *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.*, 11 C.P.R. (3d) 410 (T.M.O.B.)] *A fortiori*, if a certificate of registration has been filed and a party argues that it has been amended since then, I fail to see why I could not use my discretion to verify the register to determine the scope of the modifications made since the relevant date to determine registrability under s. 12(1)(d) is the date of my decision. [See *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)]

I check the register and confirm that certificate of registration TMDA049765 was amended on February 20, 2004 and it now covers the following wares: Bread, cake and confectionery namely pastries, cookies, waffles and candies.

Ms. Petras also filed extracts of Webster's Ninth New Collegiate Dictionary, 1988 corresponding to the definitions of the words "confectionary", "lollipop", "candy" and "sweet".

In so far as the ground of opposition under s. 12(1)(d) is concerned, the Opponents have met their initial onus. I must therefore review the evidence in the context of the relevant factors to determine if the Mark is likely to cause confusion with any of the Co-opponent's registered trade-marks.

(a) Inherent distinctiveness of the marks and the extent to which they have become known;

In *Choice Hotels International Inc. v. Hotels Confortel Inc* (1996), 67 C.P.R. (3d) 340 Mr. Justice Rouleau made the following observations on the issue of inherent distinctiveness:

21 Now let us examine paragraph 6(5) (a) of the Act, which refers to the inherent distinctiveness of the trade-marks. The Registrar found, in relation to this paragraph, that neither of the disputed trade-marks has a strong inherent distinctiveness. Hughes has articulated the following principle concerning the inherent distinctiveness of a trade-mark, in his treatise on trade-marks:

A strong, inherently distinctive trade mark is one consisting of a striking inventive name or an original design, and as such, will be entitled to a wide scope of protection; on the other hand a trade mark lacking these qualities is inherently less distinctive and is considered to be a weaker mark; the ambit of protection afforded to a weak mark is much less than for a strong mark, and registration of other marks containing comparatively small differences may be permitted.[FN8]

Mr. Galardo has been, since 1991, the marketing Director for the Opponent and the Co-opponent. He states that the Co-Opponent is an affiliate of the Opponent. He alleges that the Co-opponent's founder created the trade-mark POM in 1930. It would be the acronym for "Pride Of Montreal/ Pain Orgueil de Montréal". On one hand the Applicant's agent is arguing that it should be considered as a weak mark for two reasons: it is an acronym and phonetically identical to the French word "pomme" which means "apple". On the other hand the Opponents' agent is arguing that it is a coined word and should have a wide ambit of protection.

The average Canadian consumer would not perceive the trade-mark POM as an acronym for Proud of Montreal when used in association with the wares listed above. POM is a coined word even though it may sound like the French word “pomme”. I am also of the opinion that the Mark is inherently distinctive.

The degree of distinctiveness of a trade-mark can be enhanced through its use. We have no evidence of use of the Mark in Canada in association with the Wares.

Mr. Galardo alleges that the Co-opponent has granted a license to the Opponent to use the trade-marks listed above. Mr. Galardo provides the total sales of products bearing the Co-Opponent’s trade-marks between 1999 and March 2002 which total more than \$150 million. However we do not have a breakdown of those figures per trade-mark and per product. I am inclined to consider any use of the trade-mark POM & Design as illustrated above as use of the trade-mark POM.

The Co-opponent’s trade-marks are advertised in printed media, on radio and television and other type of printed and visual media. He filed samples of such advertisements. The Opponents spent approximately more than \$2.5 million to promote the trade-marks listed above. The trade-mark POM is promoted during sporting events such as football games of the Montreal Alouettes. I will discuss later the argument raised by the Applicant concerning the absence of use of the trade-mark POM in association with confectionaries including candies and lollipops. Under these circumstances I conclude that the Co-opponent’s trade-mark POM is known in Canada. Therefore the first criterion favours the Opponents.

(b) The length of time the trade-marks or trade-names have been in use;

As appears from the facts described under the preceding criterion, this factor also favours the Opponents.

(c) and (d) The nature of the wares and the nature of the parties' respective businesses and trades;

I must compare the wares covered by the Co-opponent's registrations with the Wares. [See *Fonorola, Inc. v. Motorola, Inc.*, 78 C.P.R. (3d) 509] There is definitely an overlap between lollipops and candies.

There is no evidence of the channels of trade used or to be used by the Applicant. I therefore have to rely on the list of wares in the application to determine if those wares would be sold through the same channels of trade used by the Opponents. Mr. Galardo states that the Opponents' wares are sold to consumers in convenient stores and supermarkets, as well as in restaurants, bars, fast food counters, cafeteria, hospitals, nurseries, schools and others. There is a potential overlap in the channels of trade.

I conclude that these factors also favour the Opponents.

(e) The degree of resemblance between the marks

It has often been said that the degree of resemblance is the most important factor when assessing the likelihood of confusion between two trade-marks. Mr. Justice Cattnach in *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145 at par. 28 defined the issue in the following terms:

Realistically appraised it is the degree of resemblance between trade marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a subservient role in the over-all surrounding circumstances.

He also described the test of confusion in the following words in *Canadian Schenley Distilleries Ltd. v. Canada's Manitoba Distillery Ltd.* (1975), 25 C.P.R. (2d) 1 at par. 14:

«To determine whether two trade marks are confusing one with the other it is the persons who are likely to buy the wares who are to be considered, that is those persons who normally comprise the market, the ultimate consumer. That does not mean a rash,

careless or unobservant purchaser on the one hand, nor on the other does it mean a person of higher education, one possessed of expert qualifications. It is the probability of the average person endowed with average intelligence acting with ordinary caution being deceived that is the criterion and to measure that probability of confusion the Registrar of Trade Marks or the Judge must assess the normal attitudes and reactions of such persons.

In considering the similarity of trade marks it has been held repeatedly that it is not the proper approach to set the marks side by side and to critically analyze them for points of similarities and differences, but rather to determine the matter in a general way as a question of first impression. I therefore propose to examine the two marks here in dispute not for the purpose of determining similarities and differences but rather to assess the attitude of the average reasonable purchaser of the wares as a matter of first impression.»

As stated by Mr. Justice Denault of the Federal Court in *Pernod Ricard v. Molson Breweries* (1992), 44 C.P.R. (3d) 359, the first portion of a trade-mark is the most relevant for purposes of distinction.

The marks POM and PIM POM have the common component POM and as such there is some resemblance both in appearance and in sound. On the other hand there is a difference in the ideas suggested as the combination of the terms PIM and POM has no particular meaning while the term POM alone sounds like the French word “pomme”. Therefore in the latter case there could be an association with the fruit apple. Also, on the basis of an imperfect recollection, the average Canadian consumer who speaks French could possibly remember the Mark by association with the French word “pomme”.

(f) Additional surrounding circumstances

The Applicant argued that there is no evidence of use of the trade-mark POM in association with candies and as such it should be taken into consideration as mentioned in *Park Avenue* cited above. In that case Madam Justice Desjardins stated:

In contrast, some time prior to October 13, 1983, the appellant was using the trade mark POSTURE-BEAUTY extensively as its "house" trade mark, on all stationery, cheques, bills of lading, promotional material, etc. The use of that trade mark and the length of that use, together with the non-use of the mark BABYBEAUTY, were circumstances that had to be taken into consideration on the issue of confusion.

I reviewed the evidence attached to Mr. Galardo's affidavit and we have evidence of use of the Co-opponent's trade-marks POM, POM & Design (reference to packaging exhibits JPG-2 and advertising samples exhibit JPG-7), all in association with bread. On the invoices filed as exhibit JPG-3 there is no reference to candies. In fact at the end of the invoices there is one of the following statements:

« total PETIT PAIN PAIN »

« Total Pain et PATIS. »

« Total PAIN ET PATISSERIE »

« Total PATISSERIE »

The absence of evidence of use of the Co-opponent's registered trade-mark in association with candies is not fatal to the Opponents under the ground of opposition based on s. 12(1)(d) of the Act. The *Park Avenue* case is distinguishable. In that case there was no evidence of use of the registered trade-mark with any of the wares covered by the registration. Moreover there was evidence that the applicant had used the mark applied for.

The other factor argued by the parties is the state of the register evidence. Mr. Booth, a trade-mark searcher, annexed to his affidavit extracts of the register and certified copies of registrations in respect of six (6) citations appearing on the extracts of the register filed as exhibit A to his affidavit. The Opponents argue that Mr. Booth admitted during his cross-examination that he did not verify the marketplace to determine if the marks appearing on extracts were used in Canada.

State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [*Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432; *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.)]. Inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located [*Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)]. Therefore I must identify the relevant citations and then determine if there are enough entries to infer that consumers are accustomed to

see the term POM as part of trade-marks in association with relevant wares such that they make the distinction between them.

Exhibit A to Mr. Booth's affidavit consists of 39 extracts of the register. However fourteen (14) of them have been expunged. The remainder are trade-marks comprising the term POM either as a prefix, a suffix or in the core of the trade-mark, or trade-marks with the term PIM as a prefix. I do not consider the other citations to be relevant as either phonetically or visually they are too remote. [See for example PÂMANTES] The wares associated with these trade-marks fall in the general categories of food and drinks. Those categories are too broad considering that the Applicant is seeking the registration of the Mark in association with lollipops. As appears from the various definitions in dictionaries filed by both parties, the more appropriate category would be "candy". From exhibit A, I only retain two citations, namely:

PIM'KO, certificate of registration TMA410572 in association with candy; and
PIMS, certificate of registration TMA388386 in association with candies.

The second set of extracts of the register, (exhibit B to Mr. Booth's affidavit) is the result of a search for "...marks similar to marks PIM POM and POM for food products, candy, beverages..." Most of the citations are entries having the term POMME as part of the trade-mark. There is some duplication with citations included as part of exhibit A. Most of these citations relate to trade-marks in association with apple ("pomme" in French) or potato ("pomme de terre" in French) It is therefore not surprising that an additional 33 citations form part of exhibit B to Mr. Booth's affidavit. However none of these citations cover candy.

Consequently the number of relevant citations is insufficient to make the inference described above.

The numbers of factors favouring one party should not dictate the outcome of my decision, but rather the weight to be given to the different factors. The weight of the factors favouring the Opponents tips the balance in their favour. The only factor favouring the Applicant is that there is some difference between the marks in issue, namely the addition of the term PIM as the first

component of the Mark. All the other factors favour the Opponents. I may add that the presence of the Co-opponents' trade-mark as a component of the Mark creates some resemblance both phonetically and visually when the Mark is compared to the trade-mark POM.

Consequently I conclude that the Applicant has not discharged its burden to prove on a balance of probabilities that the Mark is not confusing with the Co-opponents' registered trade-mark POM, certificate of registration TMDA049765. Accordingly I maintain the third ground of opposition.

V Entitlement under s. 16(2)(a) and distinctiveness

As for the grounds of opposition of entitlement under s. 16(2)(a) and distinctiveness they are dismissed for the following reasons. The evidence described above shows use of the trade-marks POM and POM & design, a different design than the trade-mark illustrated above. Nevertheless there are three bakers on the design with the word POM. There is also evidence of use of an unregistered trade-mark POM & design, consisting of the word POM written inside an ellipse in which there is a sheaf of wheat. I consider the use of the latter to be use of the trade-mark POM. [See *Canada (Registrar of Trade-marks) v. Cie. Internationale pour l'informatique CII Honeywell Bull, S.A.* (1985), C.P.R. (3d) 523] Such evidence of use is sufficient to conclude that the Opponents have met their initial onus with respect to these last two grounds of opposition. However the evidence of use of these trade-marks is limited to bread. There is no evidence of use of these marks in association with candies. Therefore I come to the conclusion that there would not be a likelihood of confusion between the Mark and any of these trade-marks. The difference in the nature of wares (bread vs. candies) combined with the addition of the prefix PIM is sufficient to conclude in favour of the Applicant. Therefore I dismiss the fourth and sixth grounds of opposition.

VI Conclusion

Having been delegated authority by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the Applicant's application, the whole pursuant to s. 38(8) of the Act.

DATED IN BOUCHERVILLE, QUEBEC, THIS DAY 13th DAY OF MAY 2008.

Jean Carrière
Member,
Trade-marks Opposition Board