



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

Citation: 2016 TMOB 183
Date of Decision: 2016-11-30

IN THE MATTER OF AN OPPOSITION

Old Dutch Foods Limited	Opponent
and	
1904838 Ontario Inc.	Applicant
1,573,342 for the trade-mark DUTCH TRADITIONS & Design	Application

Background

[1] On April 16, 2012, the Applicant filed application No. 1,573,342 for the trade-mark DUTCH TRADITIONS & Design (the Mark, shown below) for proposed use in association with “Food articles of Dutch Origin, namely applesauce, cookies, licorice, soup, vegetables”.



[2] Colour is claimed as a feature of the trade-mark. The trademark contains colour as follows: -background is PANTONE Orange 151 C -Starburst is CMYK Orange 0.57.95.3 -The border, writing and windmill is CMYK Brown 30.95.95.70 -The top of the ribbon is CMYK Red 15.100.90.10 -The bottom of the ribbon is CMYK Blue 85.50.0.0

[3] The Opponent is the owner of a number of trade-mark registrations, including registration No. TMA104,697 for the trade-mark OLD DUTCH in association with the following goods:

- (1) Confections, namely, popcorn; potato chips; cheese flavored corn confection; caramel corn; fresh nut meats; salted peanuts; prepared, edible sunflower seeds; pretzels; and cheese crackers.
- (2) Corn snacks, onion, flavoured rings, tortilla chips, pork rinds, nuts,
- (3) Caramel corn and cheese curls.

[4] The application for the Mark was advertised for opposition purposes in the *Trade-marks Journal* of December 4, 2013 and on January 31, 2014 the Opponent opposed it under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition, as revised July 31, 2014, are based upon sections 12(1)(b), 12(1)(d), 16(3)(a), 30(i) and 38(2)(d)/2 (distinctiveness) of the Act. The two central issues in this proceeding are: 1) whether the Mark is clearly descriptive of the character and/or quality of the Applicant's goods, the conditions or the persons employed in their production or their place of origin; and 2) whether there is a reasonable likelihood of confusion between the Mark and any of the Opponent's marks.

[5] The Applicant filed a counterstatement on April 8, 2014, denying the allegations set out in the statement of opposition.

[6] As evidence in support of its opposition, the Opponent filed the affidavits of Brian Bambury, Brenda Anderson and Bonna Jean Bateman. None of these affiants were cross-examined.

[7] As evidence in support of its application, the Applicant filed the affidavit of Jeff Van Niekerk. Mr. Van Niekerk was not cross-examined.

[8] The Opponent did not file any evidence in reply.

[9] Both parties filed a written argument and attended a hearing.

Onus

[10] 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 [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (Fed TD) at 298].

Grounds of Opposition

Section 30(i) ground – non-compliance

[11] The Opponent has pleaded that the Applicant's application does not comply with section 30(i) of the Act because the Applicant could not have been satisfied that it was entitled to use the Mark in light of the prior use and registration of the Opponent's marks.

[12] Section 30(i) of the Act merely requires that an Applicant declare in its application that it is satisfied that it is entitled to registration of its trade-mark. Where an applicant has provided the requisite statement, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. Mere knowledge of the existence of the Opponent's trade-marks does not in and of itself support an allegation that the Applicant could not have been satisfied of its entitlement to use the Mark [see *Woot, Inc v WootRestaruants Inc Les Restaurants Woot Inc* 2012 TMOB 197 (CanLII)].

[13] As there is no evidence of bad faith in the present case, I am dismissing this ground of opposition.

Section 12(1)(b) ground – the Mark is non-registrable because it is clearly descriptive

[14] The Opponent's section 12(1)(b) ground of opposition can be divided into the following three prongs:

- DUTCH TRADITIONS & Design is clearly descriptive of the character and/or quality of the Applicant's goods;
- DUTCH TRADITIONS & Design is clearly descriptive of the conditions or the persons employed in the production of the Applicant's goods; and/or
- DUTCH TRADITIONS & Design is clearly descriptive of the places of origin of the applied for goods.

[15] Each of these prongs is based on the premise that the Mark describes traditional food and snack products which are Dutch in origin. In this regard, the Opponent relies on the following statements made by the Applicant:

- The Applicant's proposed trade-mark will only be applied to those commodities originating in the Netherlands and accordingly will describe those commodities as Dutch in origin [counter statement, paragraph 4(b)];
- The commodities referred to in the Applicant's application will be located in ethnic stores in Canada, Dutch in origin and ethnic sections of Canadian retail stores, also Dutch in origin [counter statement, paragraph 4(d)];
- The Applicant's design has been applied to products originating from the Netherlands and sold in Ontario since 1998. It has been applied to cookies, candies, chocolates, licorice, dried vegetables and crackers. It has been sold in stores offering goods of Dutch origin and some retail chains in Ontario [Van Niekerk affidavit, paragraph 7].

[16] The Opponent also adds that the design and colour features of the proposed mark are intended to depict that the goods are of Dutch origin for the following reasons:

- the windmill is a symbol commonly associated with the Netherlands and the Dutch
- the red, white and blue ribbon design element of the proposed mark is representative of the Dutch flag; and
- the orange colour of the upper rectangular portion of the proposed mark is representative of the Dutch Royal Family, the House of Orange-Nassau, and symbolic of Dutch national pride.

[17] When conducting an analysis under section 12(1)(b) of the Act, a trade-mark must be considered as a matter of first impression, in its entirety and not dissected into its constituent

parts [*Wool Bureau of Canada Ltd v Canada (Registrar of Trade Marks)* (1978), 40 CPR (2d) 25 (Fed TD), at 27-8; *Atlantic Promotions Inc v Canada (Registrar of Trade Marks)* (1984), 2 CPR (3d) 183 (Fed TD), at 186]. The word "character" in section 12(1)(b) has been held to mean a feature, trait or characteristic of the product and the word "clearly" has been held to mean "easy to understand, self-evident or plain" [*Drackett Co. of Canada v. American Home Products Corp.* (1968), 55 CPR 29 at 34]. Finally, the material date for assessing the registrability of a trademark under section 12(1)(b) of the Act is the filing date of the application, which in this case is April 16, 2012 [*Shell Canada Ltd v P.T. Sari Incofood Corp* (2005), 41 CPR (4th) 250, (FC) and *Fiesta Barbeques Ltd v General Housewares Corp* (2003), 28 CPR (4th) 60 (FC)].

[18] Bearing in mind the relevant case law, I will now go on to consider the three prongs of the Opponent's section 12(1)(b) ground, but in the reverse order in which they were outlined above.

i) Is the Mark clearly descriptive of the place of origin of the applied for goods?

[19] In accordance with *MC Imports Inc v AFOD Ltd*, 2016 FCA 60, a trademark is clearly descriptive of the place of origin if the trademark, whether depicted, written or sounded, is a geographic name and the associated goods or services originate from the location of the geographic name. The recent Trade-marks Office Practice Notice on Geographic Names (entitled *Place of Origin – Paragraph 12(1)(b) of the Trade-marks Act*) states that a trade-mark will be determined to be a geographic name if the trade-mark either has no meaning other than as a geographical name or that despite having multiple meanings, its primary or predominant meaning is as a geographical name.

[20] In this case, the Opponent has not provided any evidence of its own in support of this ground of opposition. It is therefore not clear, in my view, whether the Opponent has met its burden under this ground.

[21] Having said that, the Court has held that in determining whether a trade-mark falls under the section 12(1)(b) exclusion, the Registrar must not only consider evidence at her disposal but also her common sense in the assessment of the facts [see *Neptune SA v Canada (Procureur General)*, 2003, 29 CPR (4th) 497 (FC) and *Ontario Teachers' Pension Plan Board v Canada*,

supra]. In addition to applying common sense, I also note that I may exercise my discretion to take into account dictionary definitions for the words that make up the Mark [see *Yahoo! Inc v audible.ca inc* (2009), 76 CPR (4th) 222 (TMOB)].

[22] The *Canadian Oxford Dictionary* defines “DUTCH” as follows:

Adjective

Relating to the Netherlands or its people or their language

Noun

1. The language of the Netherlands
2. The people of the Netherlands, collectively.

[23] It is clear from the above dictionary definition that “DUTCH” is not a geographic name, but rather a word used to describe people who live in the Netherlands or the language they speak. Further, while the Applicant’s goods relate to the Netherlands because they are Dutch in origin, the fact that the Mark includes the word TRADITIONS in my view removes it from this part of the prohibition in section 12(1)(b). Therefore, in view that DUTCH TRADITIONS & Design is not a geographic name, it cannot be found to be clearly descriptive of the place of origin of the Applicant’s goods.

[24] This prong of the Opponent’s argument under this ground is therefore unsuccessful. I will therefore now go on to consider the second prong of the Opponent's section 12(1)(b) ground of opposition.

2) Is the Mark clearly descriptive of the conditions or the persons employed in the production of the Applicant’s goods

[25] With respect to the Opponent’s second argument under this ground, I had the opportunity to consider the meaning of section 12(1)(b) as it relates to the persons employed in the production of goods in *Wal-Mart Stores, Inc v Tough Stuff Distributors, Inc* (1999), 1 CPR (4th) 271 (TMOB) at p. 278:

There is very little jurisprudence that interprets the meaning of s. 12(1)(b) as it relates to the persons employed in the production of wares or to the place of origin of the wares. Although I consider that the word CANADA clearly describes the place of origin of the clothing wares and sporting equipment (in this regard, see *Carling Breweries Ltd. v. Molson Companies Ltd.* (1984), 1 CPR (3d) 191(FCTD) at 195), I do not reach the same conclusion when I consider the mark CANADA PROUD in its entirety. I am also not able to conclude that the mark CANADA PROUD is clearly descriptive of the persons employed in the production of the proposed wares. In my view, it is not the intention of s. 12(1)(b) to prevent the registration of trade-marks that may describe the feelings or states of being of the persons employed in the production of the wares with which the trade-mark is to be used. Rather, in my view, this part of s. 12(1)(b) was designed to prevent the registration of trade-marks that clearly describe the character of persons employed in the production of the applied for wares, *eg.* the word POTTER would not be registrable for the ware "pottery" nor would the word BAKER be registrable for the ware "bread". I therefore conclude that this ground is unsuccessful.

[26] In this case, the issue is whether the mark DUTCH TRADITIONS & Design is clearly descriptive of the persons employed in the production of the proposed goods. The Applicant admits that its products originate from the Netherlands. While the word "DUTCH" alone may describe the character of the persons employed in the production of the proposed goods, I must consider the Mark in its entirety. In my view the Mark DUTCH TRADITIONS & Design does not clearly describe any character of persons employed in the production of the Applicant's consumable food products. The Opponent's second argument under this ground is therefore also unsuccessful.

3) Is the Mark clearly descriptive of the character and/or quality of the Applicant's goods

[27] The last argument of the Opponent for me to consider under this ground is whether the Mark is clearly descriptive of the character or quality of the applied for goods. The Opponent states in its written argument that "it is clear that the intention of the words DUTCH TRADITIONS is to convey that the associated food products are of Dutch origin and, therefore, clearly descriptive of a character or quality of the goods, the conditions used or the persons employed in the production thereof and the place of origin, as "traditional" food and snack products which are "Dutch in origin"" (Opponent's written argument, paragraph 38).

[28] Once again, I have exercised my discretion to find the dictionary definition for the word "traditions". The definition I found in the *Canadian Oxford Dictionary* is as follows:

Noun




The transmission of customs or beliefs from generation to generation or the fact of being passed on in this way.

[29] The Mark consists of two ordinary dictionary words DUTCH and TRADITIONS and also has a design component. I agree with the Opponent that the component “DUTCH”, as applied to the Applicant’s goods, is clearly descriptive of a character or quality of the goods. The question therefore becomes whether the addition of the word "TRADITIONS" and the windmill design and colour claims render the Mark as a whole not clearly descriptive.

[30] I find that the word "TRADITIONS", being a noun that, as defined, relates to the transmission of customs or beliefs, does not clearly describe the character or quality of the Applicant’s goods that are comprised of consumable food products. The Opponent itself in its written argument refers to the adjective “traditional” as opposed to the noun “TRADITIONS” which is the word used in the Mark. While the adjective “traditional” when used with the adjective “DUTCH”, may describe food products that typically come from or are used in customs in the Netherlands, the fact that the word TRADITIONS is a noun gives the Mark a different meaning that is not, in my view, clearly descriptive of a character or quality of the applied for food products. As a result, I find that the Mark as a whole is not clearly descriptive of the character or quality of the goods as a matter of immediate impression. The Opponent’s third argument under this ground is therefore also unsuccessful.

Section 12(1)(d) ground – the Mark is not registrable because of a reasonable likelihood of confusion with one or more of the Opponent’s marks

[31] The Opponent pleads that the Mark is not registrable because it is confusing with one or more of its registrations as set out below:

Trade-mark	Registration No.
OLD DUTCH	TMA104697
	TMA154824
	TMA222319
Old Dutch	TMA222320
	TMA223333
DOUBLE DUTCH	TMA406712
DUTCH CRUNCH	TMA448550
DUTCH GOURMET	TMA820855

[32] The material date to assess a section 12(1)(d) ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[33] I have exercised my discretion to check the register to confirm that the Opponent's registrations are extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent has therefore met its initial burden with respect to this ground.

[34] Of the eight extant registrations, registration Nos. TMA104697 for the mark OLD DUTCH and TMA154824 for the WINDMILL Design mark present the Opponent's strongest case, both because I find these marks more similar to the Mark than the Opponent's other registered marks and because these are the oldest and longest used registrations of the Opponent (as will be discussed further below). I shall therefore focus my assessment of the likelihood of

confusion on these registered marks--if confusion is not likely between either of these marks of the Opponent and the Applicant's Mark, then confusion will not be likely between the Applicant's Mark and any of the Opponent's other registered marks.

[35] 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. This section does not concern the confusion of the trade-marks themselves, but confusion of goods or services from one source as being from another source.

[36] 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 [*Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)].

[37] I will now address each of these factors sequentially.

the inherent distinctiveness of the trade-marks and the extent to which they have become known

[38] The Opponent's OLD DUTCH word mark and WINDMILL design mark each suggest a geographic link to the Netherlands which impacts their inherent distinctiveness to some extent. The Mark does not possess much inherent distinctiveness either because it is suggestive of the applied for "food articles of Dutch origin".

[39] With respect to the acquired distinctiveness of the trade-marks, the Opponent has filed as its evidence an affidavit of Bonna Jean Bateman, Chief Financial Officer of the Opponent. Ms. Bateman's evidence is that:

- (a) The Opponent commenced distributing and selling seasoned potato chips under the OLD DUTCH word mark in Canada in 1954 (Bateman, para. 3);
- (b) Over time the Opponent's product line expanded to include other snack products such as potato sticks, corn chips, popcorn, puffed corn products, puffed bacon-flavoured products, nuts, sunflower seeds, pumpkin seeds, pretzels, crackers, dips, sauces, meat snacks and candy (the "OLD DUTCH products") (Bateman, para. 5);
- (c) Each bag, box or jar is referred to as a unit and each unit bears the trade-mark OLD DUTCH, typically in the script font illustrated in registration No. TMA222,320 and typically with one or more of the windmill designs (Bateman, para. 7);
- (d) In the five complete fiscal years from 2009 to 2013, the Opponent's annual sales revenues averaged in excess of \$340,000,000 for the OLD DUTCH products sold in Canada, all of which featured the OLD DUTCH word marks, one or more of the windmill design marks, and one or more of the Old Dutch product trade-marks including DUTCH CRUNCH and DUTCH GOURMET (Bateman, para. 27);
- (e) The Opponent's gross sales for the first three quarters of 2014 were approximately \$250,000,000 (Bateman, para. 35);
- (f) The Opponent carries out extensive national advertising programs of its products through all forms of media. These programs include mass distribution of flyers, radio and television commercials, Internet – Youtube videos, point of purchase promotions, magazine advertisements and coupons, contests and sponsorship of sporting events including sponsorship of National Hockey League games and the Canadian Hockey League Memorial Cup from 2008 through 2014 [Bateman, Exhibits H – M];
- (g) The Opponent also participates extensively in co-operative advertising with its retail customers which includes specific product promotions within a retail customer's general advertisement of its retail services [Bateman, para. 13];
- (h) In the four complete fiscal years from 2010 to 2013 the Opponent's annual advertising expenses averaged in excess of \$50,000,000 for advertisements and promotions in Canada, all of which featured the word marks, one or more of the Windmill Designs and, one or more of Old Dutch's product trade-marks, including DUTCH CRUNCH or DUTCH GOURMET [Bateman, para. 21];
- (i) Advertising expenses for the first three quarters of 2014 are on pace to exceed \$50,000,000 for fiscal year 2014 [Bateman, para. 21]; and
- (j) The Opponent's products are distributed and sold in every province in Canada through a network of employed route sales personnel and, at the date of Ms. Bateman's affidavit, 337 independent contractors. The Opponent's products

are sold to the general public through a variety of retail outlets, including bulk food stores, convenience stores, dollar value stores, drug stores, grocery stores, mass merchandisers, department stores, gas stations, sports facilities, schools and educational institutions, food services and concessions, and vending machines [Bateman, paras. 23-24].

[40] The exhibits attached to Ms. Bateman's affidavit show that a large portion of the Opponent's sales is attributable to the Opponent's main product, namely potato chips.

[41] In view of the above, I am able to conclude that the Opponent's OLD DUTCH word mark and WINDMILL design mark have become known to a significant extent in Canada.

[42] The application, on the other hand, is based on proposed use. While there is some evidence that the Mark has been used by a predecessor-in-title, the evidence is not sufficient for me to conclude that such use was to any meaningful extent.

[43] This factor therefore favours the Opponent.

the length of time the trade-marks have been in use

[44] As noted above, the Opponent's OLD DUTCH word mark and WINDMILL design mark have been in use since at least 1954 while the Applicant has not filed any meaningful evidence of use of its Mark in association with the applied for goods. This factor therefore also favours the Opponent.

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

[45] When considering the nature of the goods, services or business and the nature of the trade, I must compare the Applicant's statement of goods with the statement of goods in the registration relied upon by the Opponent [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266

(TMOB); and *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[46] In this case, the Opponent's OLD DUTCH word mark registration covers various snack foods including potato chips, popcorn, salted peanuts, and pretzels. The Opponent's WINDMILL design registration covers similar snack foods, and also men's and women's promotional apparel, backpacks and accessories and promotional items. The Applicant's Mark, on the other hand, covers applesauce, cookies, licorice, soup and vegetables. The parties' goods therefore, although not identical, do overlap to some extent.

[47] The Opponent submits that the parties' channels of trade also overlap. To support this assertion, the Opponent relies on the evidence of Ms. Bateman and Ms. Anderson, Applications Trainer employed by the Opponent.

[48] The evidence of Ms. Bateman purports to show that the Applicant's predecessor-in-title, Continental Imports Limited, operated a retail store in Barrie Ontario and promoted its business through a website located at www.dutchimports.ca (Bateman, Exhibits X,Y,Z). Attached as Exhibit A to the Anderson affidavit is an excerpt from the Dutch Imports Website, captured October 28, 2014, which comprises copies of webpages she downloaded and printed from the website. The Opponent submits that four of the stores listed on the website which retail or have retailed the Applicant's products also retail the Opponent's products.

[49] The Opponent further submits that the affidavit of Brian Bambury, Regional Sales Manager for Eastern Ontario for the Opponent, shows that in one of these locations, products bearing variations of the proposed mark were located on the same shelving as one of the Opponent's product, as well as across the aisle. In this regard, on July 30, 2014, he attended at the premises of one of the Opponent's customers, Bakker's General Store in Manotick, Ontario, and observed that a product labelled with the words DUTCH TRADITIONS and a windmill design was located on the shelf directly below the Opponent's OLD DUTCH popcorn twist product.

[50] I do not consider the Opponent's evidence to be of much relevance because the Applicant's evidence is that its predecessor-in-title Continental Imports Limited ceased

operations effective March 31, 2015, and it is not clear from the Applicant's evidence whether it carries on business in the same manner as its predecessor-in-title. Further, the products located by Mr. Bambury bearing variations of the proposed mark are not any of the applied for goods.

[51] Having said that, the Applicant itself has submitted evidence of what I assume to be former food products of the Applicant and the Opponent's products being sold in the same stores, and in close proximity to one another [Van Niekerk, paragraphs 4 and 5]. I therefore think it is reasonable to assume that the parties' food products would also travel through the same channels of trade.

the degree of resemblance between the trade-marks

[52] In *Masterpiece Inc v Alavida Lifestyles Inc*, *supra* at para 49, the Supreme Court of Canada indicates that the factor amongst those listed under section 6(5) of the Act with the greatest effect on the confusion analysis is the degree of resemblance between the parties' trade-marks.

[53] When considering the degree of resemblance between the marks, the trade-marks must be considered in their totality; it is not correct to lay the trade-marks side by side and compare and observe similarities or differences among the elements or components of the marks [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC) at para 20]. Further, while the first portion of a mark is often the most important for the purpose of distinguishing between marks, it has also been held that where when the first or dominant portion of a mark is a common descriptive word, its importance diminishes: see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 at 188 (Fed TD). In *Masterpiece*, the Supreme Court also advised that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique [see *Masterpiece*, *supra*, at para. 64].

[54] In this case, both the Mark and the Opponent's word mark share the word DUTCH. Although this word may be the first component of the Mark, in view that it is somewhat descriptive of the Applicant's goods, I consider the word TRADITIONS to be the dominant portion of the Applicant's Mark. As the word DUTCH is the dominant component of the

Opponent's word mark, I do not find there to be much resemblance between the Mark and the Opponent's word mark in appearance or sound.

[55] The Mark and the Opponent's design mark both have a windmill design. However, again, given the descriptive connotation of this design in association with the Applicant's goods, I do not find much resemblance between the parties' marks in appearance or sound because I consider the dominant component of the Mark to be the word TRADITIONS.

[56] With respect to the ideas suggested by marks, all of the marks, in my view, suggest a geographic link to the Netherlands because of the word "DUTCH", the WINDMILL design, or both. The ideas suggested by the marks differ in that the Mark in its entirety is suggestive of the transmission of customs or beliefs of Dutch origin while the Opponent's OLD DUTCH mark in its entirety refers to something long standing or from the past relating to the Netherlands.

surrounding circumstance - state of the Register

[57] The Applicant has submitted that the significance of any resemblance between the marks is mitigated by the state of the register evidence introduced by means of the Van Niekerk affidavit. 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 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (Fed TD)]. Inferences about the state of the marketplace can only be drawn from state of the register evidence where a large number of relevant registrations have been located [*Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

[58] Included as Exhibit D to the affidavit of Mr. Van Niekerk is "research conducted with regard to our application". The first page of Exhibit D, states 5 points, the first two of which are as follows:

- (i) 41 trade-marks listed from the CIPO website using the word "Dutch" where the goods applied to the trade-marks are food consumables. See "i".

(ii) 24 trade-marks listed from the CIPO website using the Vienna Code 7.1.13 Windmills and water mills where the goods applied to the trade-mark are food consumables and are of similar design to the Applicant and the Opponent. See “ii”.

[59] Attached as Exhibits “i” and “ii” to his affidavit are the particulars of 41 active registered trade-marks which contain the word DUTCH in association with food consumables, and 23 active registered trade-marks which include the design of a windmill or water mill in association with food consumables, both from from CIPO’s database, and both dated June 4, 2015 (which is the day before Mr. Van Niekerk swore his affidavit). While some of these results include the Opponent’s trade-marks, there were still at least 30 registered third party marks with the word DUTCH and about 15 registered third party marks with windmill designs, all in association with food consumables.

[60] The Opponent submits that this evidence provides no particulars relating to the parameters or even the identity of the individual conducting the search and makes references to hearsay evidence. As such, the Opponent argues that these materials provide no information of probative value.

[61] While search results performed by those other than the person swearing the affidavit have been excluded on the basis of hearsay in the past see, [for example, *Royal Bank of Canada v Manufacturers Life Insurance Company*, 2002 CanLII 61430 (TMOB)], in this case it is not clear that Mr. Van Niekerk did not perform the search himself. The Opponent did have the opportunity to cross-examine Mr. Van Niekerk on his affidavit but it chose not to do so. While the absence of cross-examination does not prevent me from assessing the value or weight of his evidence [see *London Drugs Ltd v Purpharm Inc.* (2006), 54 CPR (4th) 87 at 92-93 (TMOB)], in view of his evidence as a whole, I have little reason to question the reliability of the search results. I am therefore prepared to give some weight to them.

[62] I therefore accept that Mr. Van Niekerk has evidenced a sufficient number of registrations to show that the use of the word DUTCH or a windmill design are common to the trade [see *Old Spaghetti Factory Canada Ltd v Spaghetti House Restaurants Ltd* (1999), 2 CPR (4th) 398 at 407 (TMOB)]. That is, given the number of relevant registrations, the presumption

is that consumers are accustomed to commonly seeing these elements used in the trade for these types of goods.

family of trade-marks

[63] The Opponent has claimed that it has a family of trade-marks.

[64] In order to rely on a family of trade-marks an opponent must prove use of each mark of the alleged family [*McDonald's Corp v Alberto-Culver Co* (1995), 61 CPR (3d) 382 (TMOB); *McDonald's Corp v Yogi Yogurt Ltd* (1982), 66 CPR (2d) 101 (Fed TD)]. In addition, the presumption of the existence of a family is rebutted where there is evidence that the alleged family's common feature is registered or used by others [*Thomas J Lipton Inc v Fletcher's Fine Foods Ltd* (1992), 44 CPR (3d) 279 (TMOB) at 286-7; *Techniquip Ltd v Canadian Olympic Assn* (1999), 3 CPR (4th) 298 (FCA)].

[65] In this case, while the Opponent has evidenced use of at least several of its registered marks, the presumption of the existence of a family is rebutted in view of the Applicant's evidence that the family's common feature (i.e. the word DUTCH) is registered by many others in association with similar goods.

[66] I therefore do not consider this to be a relevant surrounding circumstance in this case.

conclusion

[67] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the DUTCH TRADITIONS & Design trade-mark on the Applicant's food products at a time when he or she has no more than an imperfect recollection of the Opponent's OLD DUTCH word and WINDMILL design trade-marks, and does not pause to give the matter any detailed consideration or scrutiny [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée, supra*].

[68] Having considered all of the surrounding circumstances, despite the acquired distinctiveness of the Opponent's marks, the length of time for which they have been in use, the clear overlap in the parties' goods and the potential for overlap in their channels of trade, I am of

the view that the overall lack of similarity between the marks, combined with the Applicant's state of the register evidence, are significant enough to shift the balance of probabilities in favour of the Applicant.

[69] While the Opponent has shown that its marks have acquired distinctiveness through long and extensive use and are therefore worthy of a significant amount of protection, the Applicant's evidence of a number of third-party registrations that include the word "DUTCH" or a windmill design in the food industry limits the scope of the protection that can be afforded to the Opponent's marks. I consider this to be a highly relevant factor in determining the likelihood of confusion between the parties' marks, especially since the only resemblance between the text portions of the parties' marks is the common use of the word DUTCH, and the only resemblance between the Mark and the Opponent's design mark is the windmill design.

[70] In dealing with a similar issue in *United States Polo Assn v Polo Ralph Lauren Corp*, (2000), 9 CPR (4th) 51, Malone J. stated the following at para. 25:

[25] The presence of a common element in trade-marks (*i.e.* the horse and polo mallet in this case) has been held in other cases to have an important effect on the issue of confusion. As stated by the Comptroller General in *Re Harrods Ltd.'s Application [In the Matter of an Application by . . . to Register a Trade Mark* (1934), 52 R.P.C. 65 at 70]:

"Now it is a well-recognised principle, that has been taken into account in considering the possibility of confusion arising between any two trademarks, that, where those two marks contain a common element [*i.e.* Boston] which is also contained in a number of other marks in use in the same market, such a common occurrence in the market tends to cause purchasers to pay more attention to the other features of the respective marks and to distinguish between them by those other features."

[71] In this case, the evidence of the Applicant, as I have already indicated, shows a sufficient number of third party registrations both for the word DUTCH and for windmill designs within the food industry. I must therefore conclude that Canadian consumers would pay more attention to the other elements of a trade-mark as a means of distinguishing the source of consumable food products. In other words, Canadian consumers would look not to the word "DUTCH", but to the word "TRADITIONS" and would therefore distinguish the trade-marks on that basis.

[72] Consequently, the Applicant has discharged its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the **Mark** and any of the registered trade-marks relied up on by the Opponent in the present proceeding.

[73] In view of the foregoing, I reject the section 12(1)(d) ground of opposition.

Section 16(3)(a) and Section 38(2)(d)/2 - Non-entitlement and Non-Distinctiveness

[74] The remaining grounds of opposition also turn on a determination of the issue of the likelihood of confusion between the Mark and the Opponent's marks. The material dates for assessing the likelihood of confusion in respect of the non-entitlement and non-distinctiveness grounds are, respectively, the Applicant's filing date and the date of opposition.

[75] The main difference between these grounds and the section 12(1)(d) ground, in my view, is that the Applicant's state of the register evidence was dated after both of the material dates for these grounds. However, my review of the state of the register evidence attached to Mr. Van Niekerk's affidavit shows that all of the relevant and registered third party marks relied upon by the Applicant had been registered by the earliest of these two dates. Therefore, the differences in material dates do not have any significant impact on the determination of the issue of confusion between the trade-marks of the parties. Thus, my finding above that the trade-marks are not likely to be confused applies to these grounds of opposition which are also unsuccessful.

Disposition

[76] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Cindy Folz
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

Hearing Date: November 7, 2016

Appearances

Robert Watchman For the Opponent

Jeff Van Niekerk For the Applicant

Agents of Record

Pitblado LLP For the Opponent

No agent appointed For the Applicant