



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

Citation: 2012 TMOB 160
Date of Decision: 2012-08-22

**IN THE MATTER OF AN OPPOSITION
by Les Aliments O'Sole Mio Inc. to
application No. 1,362,030 for the trade-
mark 'O SOLE MIO! in the name of
GENNARELLI BIDERI EDITORI
S.R.L.**

[1] On August 31, 2007, GENNARELLI BIDERI EDITORI S.R.L. (the Applicant) filed an application to register the trade-mark 'O SOLE MIO! (the Mark) based on proposed use in Canada in association with the wares “edible oils”(the Wares).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of March 4, 2009.

[3] On May 1, 2009, Les Aliments O'Sole Mio Inc. (the Opponent) filed a statement of opposition. The Opponent filed an amended statement of opposition dated December 14, 2009, leave for which was granted on April 20, 2010. The grounds of opposition can be summarized as follows:

- pursuant to sections 38(2)(a) and 30(e) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), the application does not comply with section 30(e) of the Act because at the time of filing the application for the Mark, the Applicant did not intend to use the Mark in association with the Wares.
- pursuant to sections 38(2)(a) and 30(i) of the Act, the application does not comply with section 30(i) because the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Wares in view of the fact that at the time of filing the application the Mark was confusing

with the Opponent's trade-mark O' SOLE MIO which was in use in Canada and of which the Applicant was or ought to have been aware.

- pursuant to sections 38(2)(c) and 16(3)(a) of the Act, the Applicant is not the person entitled to registration of the Mark because as of the date of filing the application for the Mark, the Mark was confusing with the Opponent's mark O' SOLE MIO which had been previously used in Canada in association with "pasta and pasta sauces, fish sauces, meat sauces, pesto, marinated vegetables with oil and oil based hot peppers".
- pursuant to sections 38(2)(c) and 16(3)(c) of the Act, the Applicant is not the person entitled to registration of the Mark because at the date of filing the application for the Mark, the Mark was confusing with the trade-name Les Aliments O'Sole Mio Inc. that had been previously used by the Opponent in Canada.
- pursuant to sections 38(2)(d) and 2 of the Act, the Mark is not distinctive having regard to the provisions of section 2 of the Act in that the Mark does not distinguish the Wares from the products of others, including those of the Opponent. Moreover the Mark is not adapted so as to distinguish the Applicant's products from those of others, including those of the Opponent.

[4] The Applicant served and filed a counter statement in which it denied the Opponent's allegations and put the Opponent to the strict proof thereof.

[5] In support of its opposition, the Opponent filed an affidavit of Alfred Napolitano, the Opponent's President, affirmed December 11, 2009 with Exhibits A – D.

[6] In support of its application, the Applicant filed the affidavit of Herbert McPhail, a trademark searcher employed by the Applicant's agent, sworn March 12, 2010 with Exhibit A. An order for the cross-examination of Mr. McPhail issued on May 27, 2010 but the cross-examination was not conducted.

[7] Both parties filed written arguments and were represented at an oral hearing.

Onus and Material Dates

[8] 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].

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

- sections 38(2)(a)/30(e) and (i) - 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)(c)/16(3)(a) and (c) - the date of filing the application [see section 16(3) of the Act].
- 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)].

Section 30 Grounds of Opposition

Non-compliance with section 30(e) of the Act

[10] Since the application contains a statement that the Applicant by itself or through a licensee intends to use the Mark in Canada, it formally complies with section 30(e) of the Act.

[11] The Opponent failed to include any allegations of fact in support of its allegation that the Applicant did not intend to use the Mark in Canada for the Wares. Further, there is no evidence of record to suggest a lack of intention to use the Mark on the part of the Applicant. As a result, I dismiss the ground of opposition based upon non-compliance with section 30(e) for having been insufficiently pleaded or alternatively for the Opponent having failed to meet its evidential burden.

Non-compliance with section 30(i) of the Act

[12] Where an applicant has provided the statement required by section 30(i), 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]. The Applicant has provided the necessary statement and this is not an exceptional case; the section 30(i) ground is accordingly dismissed.

Non-entitlement Grounds

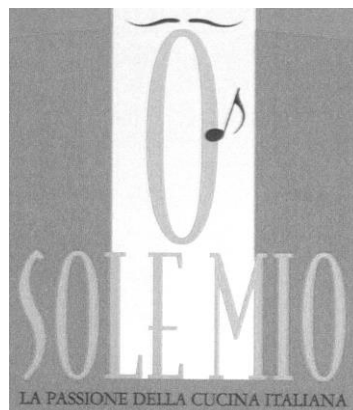
Section 16(3)(a) of the Act

[13] Despite the onus of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's O' SOLE MIO trade-mark, the Opponent has the initial onus of proving that its trade-mark alleged in support of its ground of opposition based on section 16(3)(a) of the Act was used in Canada prior to the date of filing the application for the Mark and had not been abandoned at the date of advertisement of the application for the Mark (March 4, 2009) [section 16(5) of the Act].

[14] In his affidavit Mr. Napolitano states that in the early 1990s the Opponent began marketing the O' SOLE MIO line of fresh pasta, sauces and "marinated vegetables with oil" for consumers to prepare meals at home (paragraph 4).

[15] Mr. Napolitano states that from the early 1990s the Opponent's products were marked with the O' SOLE MIO trade-mark (paragraph 11). In support of this statement, Mr. Napolitano attaches to his affidavit colour copies of labels featuring the O' SOLE MIO mark that he states were affixed to the Opponent's "pasta, pasta sauces, fish sauces, meat sauces, pesto sauce and oil based hot peppers" (Exhibit B). Mr. Napolitano states that the specific labels attached to his affidavit have been used since 2005 (paragraph 11).

[16] I note that on the sample labels and invoices, the Opponent's O' SOLE MIO trade-mark is displayed in the following design format:



[17] In its written argument, the Applicant essentially submits that the design mark as used by the Opponent does not constitute use of the word mark as alleged by the Opponent in its statement of opposition (at paragraph 30 of the Applicant's written argument: "With respect to the Opponent's alleged use of the trade-mark O' SOLE MIO, the Opponent's evidence does not show use of O' SOLE MIO *per se*. Rather, the evidence shows use of a design that would be unlikely to be seen by an average consumer as O' SOLE MIO.").

[18] This issue was not raised in reference to the Opponent's evidential burden, however, to accept the Applicant's submission that use of the design mark does not constitute use of the word mark would necessarily mean that the Opponent fails to meet its evidential burden. Accordingly, I must consider whether or not the design mark as used by the Opponent constitutes use of the word mark as pleaded.

[19] In its written argument the Applicant submits the following:

The top portion of the Opponent's design contains a large oval with a moustache on top and a musical note beside. The Opponent is apparently taking the position that this design would be read as O'. However, in view of the moustache and musical note, this design is likely to be seen by the average consumer as a depiction of a singing mouth, rather than O'

[20] I do not agree. I am satisfied that when the Opponent's mark is viewed as a whole, it is clear that the dominant word element is O SOLE MIO, largely because the elements O and SOLE MIO are featured in the same font.

[21] I find that the largest and most prominent element of the mark as used by the Opponent is the word element O' SOLE MIO as it is featured in larger and more distinctive font with the design elements functioning only as embellishments and the supplementary text ("La Passione Della Cucina Italiana") featured in much smaller font.

[22] A similar issue was raised in *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB) where the opponent in that case alleged use of the mark INTERLOC but the evidence showed use of a design mark featuring the word elements NIGHTINGALE INTERLOC in large font and Toronto Canada in smaller font. In that case the Hearing Officer

set out two basic principles regarding the question of what deviations in a trade-mark are permissible:

PRINCIPLE 1

Use of a mark in combination with additional material constitutes use of the mark per se as a trade mark if the public, as a matter of first impression, would perceive the mark as being used as a trade-mark. This is a question of fact dependent upon such factors as whether the mark stands out from the additional material, for example by the use of different lettering or sizing [...]

PRINCIPLE 2

A particular trade mark will be considered as being used if the trade mark actually used is not substantially different and the deviations are not such as to deceive or injure the public in any way [...]

[23] Based on the foregoing, and taking into account the two principles above, I am satisfied that the mark as used constitutes use of the word mark O' SOLE MIO as alleged in the statement of opposition. I will now assess the evidence to determine whether the Opponent has met its evidential burden of establishing use of the O' SOLE MIO trade-mark prior to the date of filing the application for the Mark which had not been abandoned as of the date of advertisement for the application for the Mark.

[24] Mr. Napolitano states that in the 1990s when it began producing the O' SOLE MIO products the Opponent operated out of the "Casa Napoli kitchen" and shipped its products to Provigo, Maxi and L'inter Marche (paragraph 4). Mr. Napolitano states that increasing demand for the Opponent's O' SOLE MIO products prompted the Opponent to move its operations to an 11,000 square foot manufacturing plant in Boisbriand, Quebec in 1998 (paragraph 5). Mr. Napolitano states that at the time of swearing his affidavit the plant employed over 100 people and had expanded to 48,000 square feet (paragraph 5). Mr. Napolitano states that the Opponent planned to further expand the plant to 160,000 square feet (paragraph 5).

[25] The Opponent provides approximate sales figures for its O' SOLE MIO "pasta, pasta sauces, fish sauces, meat sauces, pesto sauce and oil based hot peppers" since 2004 (paragraph 9). Mr. Napolitano states that sales ranged from approximately \$6 million in 2003/2004 to approximately \$9 million in 2008/2009 (paragraph 9).

[26] At the oral hearing, the Applicant pointed out that in his affidavit Mr. Napolitano had not specifically stated that the provided sales figures related exclusively to Canada (paragraph 9), as he had with respect to advertising expenditures (paragraph 12). The Applicant submitted that in light of Mr. Napolitano's later statements that the Opponent exports its products to retailers and distributors in the US, Mexico and Puerto Rico and is the owner of US registration No. 3021329 (paragraph 8), only a portion of the provided sales figures likely related to Canada. The Applicant then referred to the invoices provided by Mr. Napolitano which evidenced sales in Canada and came to the conclusion that the only sales figures which could be considered as specifically relating to Canada would be the sum of the invoices provided. Specifically, Mr. Napolitano provided sample invoices for sales of the Opponent's products sold under the O' SOLE MIO trade-mark from 2004-2009 (Exhibit A). The Applicant submitted that this amounted to a total of \$154,000 over the five years pre-dating the material date.

[27] I note that the Applicant chose not to cross-examine Mr. Napolitano on his affidavit. The Applicant submitted that cross-examination was not necessary and that the ambiguities in Mr. Napolitano's affidavit should be resolved against him. By contrast, the Opponent submitted that Mr. Napolitano's failure to include a clear statement that the sales figures provided related to Canada (as had been provided with respect to advertising expenditures) was merely a typographical error.

[28] Based on a review of the evidence as a whole, I am not prepared to accept the Applicant's restricted interpretation of the Opponent's sales figures. I am satisfied that Mr. Napolitano's failure to specify that the sales figures provided related exclusively to Canada was more likely an unintentional omission. In light of the substantial advertising expenditures in Canada over the years prior to the material date (over \$6 million with yearly figures ranging from approximately \$600,000 in 2004 to \$1.5 million in 2009 (Napolitano, paragraph 12)) I am satisfied that the evidence supports a finding that the sales figures provided by Mr. Napolitano must relate if not in whole, at least in large part, to the Canadian marketplace. Alternatively, given that the evidence establishes that the Opponent's wares are manufactured and marked with the Opponent's O' SOLE MIO trade-mark in Canada, sales for export could also qualify as evidence of use of the mark in Canada pursuant to section 4(3) of the Act.

[29] Mr. Napolitano states that the Opponent advertises its O' SOLE MIO products in a variety of ways including radio advertisements, billboards, flyers, brochures, television advertisements, trade shows, coupons and in-store demonstrations (paragraph 13). Mr. Napolitano attaches to his affidavit sample brochures that have been distributed at trade-shows and at point of sale in retail outlets in Canada (Exhibit C). I note that the sample brochures are not dated and that Mr. Napolitano has not provided any circulation figures for them.

[30] Mr. Napolitano states that the Opponent also advertises its O' SOLE MIO products on its website at *www.osolemio.ca* (Exhibit D). I note that Mr. Napolitano has not provided any information as to the number of Canadians who have accessed the Opponent's website.

[31] Despite the minor deficiencies in the Opponent's evidence, as pointed out above, I am satisfied that the Opponent has established use of its O' SOLE MIO trade-mark since well before the filing date of the application for the Mark and that it had not abandoned the mark as of the date of advertisement for the application for the Mark. I must now assess whether the Applicant has met its legal burden.

[32] 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 wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[33] 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 wares, 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).]

Section 6(5)(a) – inherent distinctiveness and the extent to which the marks have become known

[34] The Mark and the Opponent's mark share the word elements O SOLE MIO which the Applicant submits translate into English as "my sun". The words O SOLE MIO or my sun have no particular meaning with respect to the parties' wares. Based on the foregoing, I assess the inherent distinctiveness of the parties' marks as being essentially the same and as being relatively high. Furthermore, I note that at the oral hearing both parties submitted that the parties' marks are inherently distinctive.

[35] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. I will now turn to the extent to which the trade-marks have become known in Canada.

[36] The application for the Mark is based on proposed use and the Applicant has not filed any evidence regarding use of the Mark. Based on the foregoing, I can only conclude that the Mark has not become known to any extent in Canada.

[37] At the oral hearing the Applicant admitted that the Opponent had established prior use of its O' SOLE MIO trade-mark but submitted that the evidence was not sufficient to support a finding that it had established any significant reputation. I disagree. As set out in more detail above, the Opponent has established, by virtue of its Canadian sales and advertising, a significant reputation for its O' SOLE MIO trade-mark in Canada in association with food products, particularly in association with pasta and pasta sauces since at least 2004.

[38] Based on the foregoing, this factor favours the Opponent.

Section 6(5)(b) – the length of time each has been in use

[39] At the oral hearing, the Applicant conceded that the Opponent had established prior use of its O' SOLE MIO mark.

[40] As set out in more detail above in the analysis of the section 6(5)(a) factor, Mr. Napolitano makes sworn statements that the Opponent's O' SOLE MIO mark has been used since the early 1990s. However, he has only provided sales figures and supporting documentary

evidence back to 2004. Regardless of whether the Opponent has succeeded in establishing use of its O' SOLE MIO trade-mark since 1990 or 2004 it predates the Applicant who has not established any use of the Mark.

Section 6(5)(c) and (d) – the nature of wares, services or business and trade

[41] At the oral hearing, the Applicant submitted that the parties' wares differed as the Opponent's wares constitute "ready to serve products" (Napolitano, paragraph 2) whereas the Applicant's Wares are used as ingredients for cooking. The Applicant submitted that the target markets for the parties' wares would thus be different; with the Wares targeting people who cook and the Opponent's wares targeting those who do not cook. Firstly, I note that the Applicant did not provide any evidence regarding the nature of the target consumer for the Wares. Secondly, I note that there is no evidence to support a distinction between people who cook versus those who do not cook and the types of products each type of person would purchase.

[42] I am of the view that the parties' wares belong to the same general class, namely food products. I do acknowledge that there is no direct overlap in the specific nature of the parties' food products. Specifically, the Opponent does not offer "edible oils". In its evidence and written argument, the Opponent classifies one of its wares as "oil based hot peppers". The Applicant submits, and I agree, that the label for the hot peppers product does not make reference to the product in that way. Rather, the label describes the product as merely "Hot Peppers". The only reference to oil is in the ingredients which are listed in small print on the back of the label as "Hot Peppers, Canola Oil & Salt". The Opponent has not provided any invoices evidencing sales of these hot peppers products and the sample brochures provided make no reference to them either. At the oral hearing, the Opponent conceded that sales of hot peppers amount to only a small portion of the Opponent's products sold with the bulk of sales relating to pasta and pasta sauces.

[43] Based on the foregoing, and in the absence of evidence regarding the exact nature of the Applicant's Wares I am satisfied that there is some overlap in the nature of the parties' wares by virtue of the fact that they all belong to the general class of food products.

[44] Mr. Napolitano states that the Opponent ships its O' SOLE MIO products directly from its plant in Boisbriand, QC to large retailers like Metro, Sobeys, Provigo/Loblaws and IGA as well as to several independent retailers throughout Canada (paragraph 6). Mr. Napolitano states that the Opponent also sells its products to distributors like Boivin and Distrago in Quebec and Dorgel in Toronto, Ontario (paragraph 7). Mr. Napolitano states that these distributors then sell the products to their retail clients (paragraph 7).

[45] The Applicant has not provided any evidence regarding where the Wares would be sold. However, by virtue of the fact that the Wares are food products and in the absence of evidence on this point, I am willing to infer that the Wares could be sold in the same retail outlets as the Opponent's wares.

Section 6(5)(e) – the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them

[46] The parties' word marks are essentially identical. The only difference is the placement of the apostrophe (before the letter "O" for the Mark and after the letter "O" for the Opponent's mark) and the presence of an exclamation point after the words in the Mark.

Additional Surrounding Circumstance – Use of Opponent's Mark in Design Form

[47] As mentioned previously, the evidence establishes that the Opponent uses its mark as part of a design mark with what appears to be a moustache above the letter O and a musical note replacing the apostrophe as well as additional smaller text in Italian.

[48] At the oral hearing, the Opponent submitted that, based on *Masterpiece*, the confusion analysis should include a consideration of all possible uses of the Mark. The Opponent submits that it would be open to the Applicant to use the Mark with the "O" above the "SOLE MIO" elements, thereby increasing the resemblance between the ways in which the parties use their marks.

[49] The Applicant did not agree with the Opponent's interpretation of *Masterpiece* and submitted that when a party is asserting common law rights in a distinctive design mark their rights are limited to the mark as used. The Applicant submitted that it would be improper for the

Opponent to take the position that the Applicant should be prevented from obtaining registration for a word mark based merely on the possibility that the Applicant may later wish to use the Mark in the design format used by the Opponent.

[50] I have considered both parties' submissions but note that the ground of opposition based on section 16(3)(a) of the Act as pleaded is based solely on the Opponent's word mark O' SOLE MIO. As discussed further above, I am satisfied that display of the design mark on the Opponent's labels and promotional materials qualifies as use of the word mark. As a result, these submissions are not relevant to a determination of the ground of opposition based on section 16(3)(a) of the Act.

[51] Even if I were to consider the parties submissions on this point, I remain of the view that the dominant element of the Opponent's mark as used is the word element O' SOLE MIO. As a result, while the additional design elements do create some distinctions between the parties' marks in terms of appearance, they do not serve to create any differences between the parties' marks in terms of sound or ideas suggested. The end result being that the parties' marks share a significant degree of similarity in the ways in which they are used by virtue of the fact that they both feature the identical word element O SOLE MIO.

Additional Surrounding Circumstance – State of the Register Evidence

[52] The Applicant filed state of the register evidence in the form of the McPhail affidavit. Specifically, Mr. McPhail attached to his affidavit particulars of trade-mark registrations as set out in a table contained in his affidavit (Exhibit A). The list of trade-marks features pairs of marks which are identical or almost identical where one mark includes "oil" or "oils" in the statement of wares and the other does not.

[53] When analyzing the relevance of state of the register evidence, it must be noted that such evidence will only be relevant insofar as one can make inferences from it about the state of the marketplace. Inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432; *Del Monte Corporation v Welch Foods Inc* (1992), 44 CPR (3d) 205 (FCTD); *Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)].

[54] At the oral hearing, the Applicant submitted that the McPhail affidavit was adduced for two reasons. Firstly, the Applicant submits that the McPhail affidavit was adduced to show 49 trade-mark registrations for 19 different trade-marks owned by third parties where one covers oil and one covers another product sold in grocery stores. The Applicant submits that the affidavit demonstrates that on 49 separate occasions the Registrar determined that a trade-mark for oil can coexist with the same (or similar) trade-mark for another grocery store product. Secondly, the Applicant submits that given the large number of marks adduced in the McPhail affidavit it is reasonable to assume that the Canadian public has been exposed to cases where the same trade-mark is applied to oil and to another product sold in a grocery store by different parties.

[55] I do not agree with the Applicant's interpretation of the state of the register evidence. Rather, I find that the fact that third party marks are able to coexist on the Register with other third-party marks where one covers "oil(s)" and one does not is not relevant to a determination of the likelihood of confusion between the Mark and the Opponent's O' SOLE MIO mark. Each case must be determined based on the facts of the particular case. This is not a case where the state of the register evidence could enable me to infer whether a particular word is common to the trade. Based on the foregoing, I am not placing any weight on this state of the register evidence.

[56] Based on the foregoing, this does not form a relevant surrounding circumstance supporting the Applicant's position.

Conclusion

[57] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, in particular the extent to which the Opponent's mark has become known, the similarity in the nature of the parties' wares and the fact that the parties' word marks are essentially identical, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's O' SOLE MIO mark.

[58] Having regard to the foregoing, the ground of opposition based on section 16(3)(a) of the Act is successful.

Section 16(3)(c) of the Act

[59] Despite the onus of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-name Les Aliments O'Sole Mio Inc., the Opponent has the initial onus of proving that its trade-name alleged in support of its ground of opposition based on section 16(3)(c) of the Act was used in Canada prior to the date of filing the application for the Mark and had not been abandoned at the date of advertisement of the application for the Mark (March 4, 2009) [section 16(5) of the Act].

[60] The sample invoices (Exhibit A), labels (Exhibit B) and brochures (Exhibit C) attached to the Napolitano affidavit all display the Les Aliments O'Sole Mio Inc. trade-name. I am thus satisfied that the Opponent has met its evidential burden. I must now assess whether the Applicant has met its legal burden.

[61] The factors for the confusion analysis as between the Mark and the Opponent's trade-name are essentially the same as those with respect to the Opponent's trade-mark. The only differences being with respect to the section 6(5)(e) factor as the Opponent's trade-name includes the additional words "Les Aliments" and "Inc.". These additional words are descriptive and thus lacking in inherent distinctiveness. As a result my findings under the ground of opposition based on section 16(3)(a) of the Act are equally applicable here. As a result, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-name. Having regard to the foregoing, I allow the ground of opposition based on section 16(3)(c) of the Act.

Non-distinctiveness Ground – section 38(2)(d) of the Act

[62] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its Wares from those of others throughout Canada [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)],

there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness.

[63] Pursuant to its evidential burden, the Opponent is under an obligation to show that, as of the filing of the statement of opposition, one or more of its O' SOLE MIO trade-mark and Les Aliments O'Sole Mio Inc. trade-name had become known sufficiently to negate the distinctiveness of the Mark [see *Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FC)].

[64] As discussed more fully in the analysis of the non-entitlement grounds of opposition, the Opponent was successful in establishing that the Opponent's trade-mark and trade-name had become known to some extent as of the date of filing the statement of opposition and as a result the Opponent has met its evidential burden.

[65] The difference in material dates is not significant and as a result my findings under the grounds of opposition based on section 16(3)(a) and (c) of the Act are equally applicable here. As a result, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there was no reasonable likelihood of confusion between the Mark and the Opponent's O' SOLE MIO trade-mark and Les Aliments O'Sole Mio Inc. trade-name as of the filing of the opposition and thus, the non-distinctiveness ground is also successful.

Disposition

[66] 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.

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office