



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

Citation: 2015 TMOB 94
Date of Decision: 2015-05-28

**IN THE MATTER OF AN OPPOSITION
by A. Bosa & Co. Ltd. to application
No. 1,581,501 for the trade-mark Sole
Bontà in the name of Better for You
Foods LLC (a Florida limited liability
company)**

[1] On June 11, 2012, Better for You Foods LLC (a Florida limited liability company) (the Applicant) filed application no. 1,581,501 for the trade-mark Sole Bontà (the Mark).

[2] The application is based upon use in Canada since at least as early as April 20, 2012 in association with “jarred vegetables” and based upon proposed use in Canada in association with “marinated mushrooms, canned mushrooms, dried mushrooms, canned vegetables, mixed vegetables, pickled vegetables, vegetables, canned fruit, jarred fruits, dried fruit, fruit, frozen vegetables and frozen fruit”.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of May 29, 2013 and on July 29, 2013, A. Bosa & Co. Ltd. (the Opponent) opposed it under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[4] The grounds of opposition are based upon sections 30(a), 12(1)(d), 16(1)(a), 16(1)(b), 16(3)(a) and 2 (distinctiveness) of the Act.

[5] The Applicant denied each of the allegations set out in the statement of opposition in a counterstatement dated October 2, 2013.

[6] As evidence in support of its opposition, the Opponent filed the affidavit of Chris MacDonald, sworn February 3, 2014 (the MacDonald affidavit). Mr. MacDonald was not cross-examined.

[7] The Applicant did not file any evidence in support of its application.

[8] Only the Opponent filed a written argument and no hearing was held.

[9] For the reasons which follow, the opposition is successful.

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

Grounds of Opposition Summarily Dismissed

Non-compliance - Section 30(a)

[11] The Opponent has pleaded that the application for the Mark does not comply with section 30(a) of the Act as it does not contain a statement in ordinary commercial terms of the goods in association with which the Mark has been used or is proposed to be used. A ground of opposition based upon an allegation of non-compliance with section 30(a) of the Act that does not identify which goods are not defined in ordinary commercial terms is generally considered to be insufficiently pleaded [see *K-tel International Ltd v 1033064 Canada Inc* (1998), 86 CPR (3d) 122 (TMOB) and *Where Magazines International et al v Nystrom Division of Herff Jones, Inc* (2004) 42 CPR (4th) 271 (TMOB)]. In view of this and in view of the fact that the Opponent did not address this ground in any detail in its written submissions or file any evidence to support it, this ground of opposition is summarily dismissed.

Non-entitlement – Section 16(1)(b)

[12] The Opponent has pleaded that the Applicant is not entitled to registration of the Mark because on the date that it was first used, namely, April 20, 2012, it was confusing with the Opponent's trade-mark BONTA which is the subject of application No. 891362 (an extension application based upon registration No. TMA535,095).

[13] In order to meet its initial burden under this ground of opposition, the Opponent must show that its application had been filed prior to the Applicant's claimed date of first use of the Mark and had not been abandoned as of the date of advertisement.

[14] The filing date for application No. 891362 is June 25, 2013 and it therefore post-dates the April 20, 2012 claimed date of first use of the Mark. In view of this, the Opponent has not met its initial burden. This ground of opposition is therefore summarily dismissed.

Analysis of Remaining Grounds of Opposition

Non-Registrability - Section 12(1)(d)

[15] The Opponent has pleaded that the Mark is not registrable because it is confusing with its trade-mark BONTA, which is the subject of registration No. TMA535,095(1).

[16] 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)].

[17] The Opponent has filed a certified copy of its registration as part of its evidence and I have exercised my discretion and checked the register to confirm that it is 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.

[18] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-mark.

[19] 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.

[20] 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)].

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

[21] The Mark consists of the words “sole” and “bontà” and the Opponent’s trade-mark consists of the word “bonta”. According to the translation provided in the application for the Mark, “sole bontà” translates into “sunshine goodness”. However, there is no evidence to suggest that the average Canadian purchaser of the parties’ goods would be aware of this translation or attribute this meaning to the Mark. In the English language, “sole” is defined as “one and only” [MacDonald affidavit, para 10, Exhibit “E”]. However, due to the presence of “bonta” or “bontà”, in the parties’ trade-marks, in my view, they would both likely be perceived to be foreign or fanciful in nature. I therefore find that both parties’ trade-marks possess a fair degree of inherent distinctiveness.

[22] The distinctiveness of a trade-mark may be further increased through promotion or use.

[23] In this case, the application for the Mark is based upon use since at least as early as April 20, 2012 for some goods and based upon proposed use for others. However, the Applicant has not filed any evidence of promotion or use of the Mark.

[24] The Opponent's registration for its trade-mark claims a 1980 date of first use and the Opponent has filed the MacDonald affidavit, in which Mr. MacDonald states that since at least as early as 1999 and up until the present, the Opponent has sold a variety of food products bearing its trade-mark in Canada [MacDonald affidavit, para 7]. The only other information which Mr. MacDonald has provided regarding the Opponent's use of its trade-mark is found in paragraph 8 of his affidavit, in which Mr. MacDonald states the following:

8. Exhibit "D", attached to this my affidavit, are sample labels in respect of the following wares:
 - mushrooms
 - artichokes
 - peppers

The labels prominently display the BONTA trade-mark. I understand the labels have had minor revisions from time to time. However, similar labels have been used since at least 1999 to the present day, prominently displaying the BONTA trade-mark.

[25] I note that Exhibit "D" to Mr. MacDonald's affidavit simply consists of print-outs showing sample labels along with instructions and or specifications for their application. The labels are not shown on or in association with any products. While Mr. MacDonald has not explicitly stated that the labels appeared on products which were sold by the Opponent in his affidavit, it can arguably be inferred from the statement made in paragraph 7 of his affidavit.

[26] Mr. MacDonald has also not included any invoices, sales figures or advertising figures as part of his affidavit and he has not provided any indication as to how or if the Opponent's products are promoted or advertised in association with its trade-mark. There is also no information regarding the Opponent's normal course of trade.

[27] In view of the lack of detail which has been provided in Mr. MacDonald's affidavit, I am unable to draw any meaningful conclusions with respect to the extent to which the Opponent's trade-mark has been used or become known.

[28] I therefore do not find that this factor, which is a combination of the inherent distinctiveness of the marks and the extent to which they have become known, favours either party.

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

[29] The Applicant has not filed any evidence of use of the Mark. According to Mr. MacDonald, the Opponent has sold food products bearing its trade-mark since at least as early as 1999. However, in view of the lack of detail and supporting evidence which has been provided by Mr. MacDonald, I am not prepared to give his evidence much weight. Accordingly, I do not find that this factor significantly favors either party.

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

[30] When considering sections 6(5)(c) and (d) of the Act, it is the statement of goods in the application for the Mark and the statement of goods in the Opponent's registration that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [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)].

[31] The statement of goods in the Opponent's registration covers "baby clams, beans, rice, peppers, pimentos, artichokes, fish for food purposes, mackerels, sardines and anchovies".

[32] The statement of goods in the application for the Mark covers "jarred vegetables" and "marinated mushrooms, canned mushrooms, dried mushrooms, canned vegetables, mixed vegetables, pickled vegetables, vegetables, canned fruit, jarred fruits, dried fruit, fruit, frozen vegetables, frozen fruit".

[33] Thus, both parties' goods are food products and to the extent that some of the Opponent's food products may be said to fall within the scope of the broader categories of "fruit" and "vegetables" which are identified in the application for the Mark, there may even be some direct overlap.

[34] Neither of the parties has filed any evidence regarding the precise nature of its business or its normal course of trade. However, in view of the fact that the parties' goods overlap, it is reasonable to conclude that their channels of trade would also overlap.

[35] The sections 6(5)(c) and (d) factors therefore favour the Opponent.

Section 6(5)(e) – degree of resemblance between the trade-marks

[36] In *Masterpiece Inc v Alavida Lifestyles Inc et al* [supra], the Supreme Court of Canada clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the parties' trade-marks [see also *Beverley Bedding & Upholstery Co v Regal Bedding & Upholstering Ltd* (1980), 47 CPR (2d) 145 (FC), at 149, affirmed (1982), 60 CPR (2d) 70 (FCA)]. If the parties' trade-marks do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion.

[37] In *Masterpiece*, the Supreme Court observed that even though the first word of a trade-mark may be the most important, for the purpose of distinctiveness [see *Conde Nast Publications Inc v Union des éditions modernes* (1979), 46 CPR (2d) 183 (FCTD)], 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.

[38] In the present case, the Opponent's trade-mark consists solely of the word BONTA, which I have already found to possess a fair degree of inherent distinctiveness. While the addition of the word SOLE and the accent above the letter "a" in "bontà" in the Mark do result in some differences between the parties' trade-marks, overall, I find that as a matter of first impression, there is still a fair degree of resemblance between them.

Conclusion on the Likelihood of Confusion

[39] Having considered all of the surrounding circumstances and applying the test of confusion as a matter of first impression and imperfect recollection, I have come to the conclusion that there is a likelihood of confusion between the parties' trade-marks. I have reached this conclusion because the Applicant has incorporated the whole of the Opponent's

relatively inherently distinctive trade-mark into the Mark, which results in a fair degree of resemblance between the parties' trade-marks. In addition, the Applicant has not filed any evidence to establish any use or reputation in association with its Mark and proposes to use it in association with goods which either directly overlap with or are closely related to those of the Opponent. In addition, such goods would likely be sold through the same channels of trade. The legal burden is on the Applicant to establish, on a balance of probabilities, that its Mark is not confusing with the Opponent's trade-mark BONTA and, in my view, it has failed to do so.

[40] Accordingly, the section 12(1)(d) ground of opposition is successful.

Non-entitlement - Sections 16(1)(a) and 16(3)(a)

[41] The Opponent has pleaded that the Applicant is not entitled to registration of the Mark, in view of its use of its BONTA trade-mark prior to the filing date [(16)(3)(a)] and claimed date of first use [(16)(1)(a)] of the Mark.

[42] The word "use" is a legal term which is specifically defined in section 4 of the Act and one must look at the evidence filed in order to determine if in fact there has been use of a trade-mark in association with goods within the meaning of section 4. I have reproduced the wording of section 4 of the Act below:

4. (1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

[43] As mentioned previously, as Exhibit "D" to his affidavit, Mr. MacDonald has provided printed sheets showing labels and instructions and specifications for their application. However, he has not provided any photographs showing the labels affixed to actual products and he has not explicitly stated that the labels attached as Exhibit "D" are representative of those which were affixed to products which were actually sold to consumers. While this can arguably be inferred from the contents of Mr. MacDonald's affidavit as a whole, even if I were to make such an inference, in my view the evidence still falls short of what is required in order for the Opponent to meet its initial burden under these grounds of opposition.

[44] It has been held that in order for there to be use of a trade-mark within the meaning of section 4 of the Act, that use must be continuous and in the ordinary course of trade [*Redsand Inc v Dylex Ltd* (1997), 74 CPR (3d) 373 (FCTD)]. As previously indicated, Mr. MacDonald has not provided any detailed information regarding the nature of the Opponent's trade and he has not provided any sales figures, any information about how many products were sold during each year or any invoices.

[45] In view of this, even if I were to accept that the sample labels which were attached as Exhibit "D" to Mr. MacDonald's affidavit appeared on products, the evidence furnished is still insufficient to show that there was continuous use of the Mark in the ordinary course of trade or that the use pre-dated the filing date or the claimed date of first use in the application for the Mark. I therefore cannot conclude that the Opponent has met its burden.

[46] Accordingly, the sections 16(1)(a) and 16(3)(a) grounds of opposition are unsuccessful.

Non-distinctiveness – Section 2

[47] The Opponent has pleaded that the Mark is not distinctive as it does not distinguish the goods of the Applicant from those of the Opponent, in association with which it previously used its trade-mark BONTA.

[48] The material date for assessing this ground is the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[49] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its goods from those of others throughout Canada, there is an initial evidential burden on the Opponent to establish the facts relied upon in support of its non-distinctiveness ground [*Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[50] In the present case, the Opponent is under an obligation to show that, as of the filing date of the statement of opposition, namely, July 29, 2013, its trade-mark BONTA had become known sufficiently in Canada to negate the distinctiveness of the Mark. The reputation of the

Opponent's trade-mark should be substantial, significant or sufficient [*Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FC)].

[51] In the absence of any information pertaining to the advertising and promotion of the Opponent's goods in association with its trade-mark, any sales or advertising figures and any information pertaining to the scope of the Opponent's business operations, I cannot conclude that the Opponent has met its burden.

[52] Accordingly, this ground of opposition is unsuccessful.

Disposition

[53] In view of the foregoing, 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.

Lisa Reynolds
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office