

IN THE MATTER OF AN OPPOSITION by Compagnie Gervais-Danone to application no. 618,588 for the trade-mark DAN SLOT
filed by MD Foods A.m.b.a.

On November 4, 1988, MD Foods A.m.b.a. filed an application for the mark DAN SLOT based on use in Canada since February 1983 in association with cheese. The mark was advertised for opposition purposes on April 26, 1989 and the opponent, Compagnie Gervais-Danone, filed a statement of opposition on August 24, 1989. The statement of opposition claimed that the mark was not registrable according to the provisions of section 12(1)(d) of the *Trade-marks Act* because the mark was confusingly similar to the opponent’s registrations for:

<u>Mark</u>	<u>Reg. No.</u>	<u>Wares</u>
DANNY-YO	251, 798	Yogurt
DANNY	251,768	Yogurt
DANO SHAKE	283,872	Cheese and Yogurt
DANINO	177,526	Cheese and Yogurt

The statement of opposition also claimed that the mark DAN SLOT was confusing with the opponent’s application for DANONE, appln. no. 474,245 filed for use in association with dairy products including yogurt, and the applicant was therefore not the person entitled to register the mark pursuant to the provisions of section 16(1)(b). The opponent also alleged that, due to the opponent’s use of the above-mentioned trade-marks, the mark was not distinctive of the applicant and, pursuant to the provisions of section 16(1)(a), the applicant was not the person entitled to register the mark. The applicant filed a counter statement denying these allegations.

Both parties subsequently requested extensions of time so that the opponent’s evidence was not filed until September 14, 1992 and it consisted of certified copies of the four trade-mark registrations and one application (which had since matured to registration under no. 370,508) referred to above. The applicant’s evidence was filed on June 9, 1993 and consisted of the affidavit of Niels U. Pedersen, President & C.E.O. of MD Foods Canada Ltd., a wholly owned subsidiary and Canadian distributor of MD Foods A.m.b.a.. His evidence sets out volume and dollar amounts of sales of the DAN SLOT cheese in Canada by his company from 1989 - 1993. He also provides invoices between his company and the parent company MD Foods dating back to 1983 which refer to the DAN SLOT cheese product. Unfortunately, three of the attachments to his affidavit have been misfiled in that Exhibit “A” referred to in his affidavit is actually to be found in the attachment labelled Exhibit “C”. Exhibit “B” can be found in the attachment

labelled Exhibit “A” and Exhibit “C” in Exhibit “B”. Although this initially made his affidavit somewhat confusing I will still allow the evidence as it is really just a technical error and does not call into question the validity of the evidence he has submitted. Mr. Pedersen’s affidavit also introduces certified copies of various trade-mark registrations owned by other parties which incorporate the prefix “Dan”, for use in association with cheese.

As a result of the fact that Mr. Pedersen’s affidavit indicated that there had been a predecessor-in-title to MD Foods A.m.b.a., namely DOFO A.m.b.a., the applicant filed an amended application on July 13, 1993 to include this claim in the application. The applicant’s written argument was filed on April 29, 1994, no written argument was filed by the opponent and neither party requested an oral hearing.

In an opposition there is an initial evidentiary burden on the opponent to provide evidence to support the allegations made in the statement of opposition. In the case of the third ground of opposition based on non-compliance with section 16(1)(a) of the *Act*, the opponent has an obligation to prove that there has been previous use or making known of a confusingly similar trade-mark prior to the date of first use by the applicant, which use or making known had not been abandoned at the date of advertisement of the applicant’s mark, as set out in sections 16(5) and 17(1) of the *Act*. In the case of the fourth ground of opposition based on non-distinctiveness, the opponent similarly must prove sufficient use of a confusingly similar trade-mark in order to support the claim that the applicant’s mark is incapable of distinguishing the applicant’s wares from those of the opponent. In this case, the only evidence filed by the opponent was the certified copies of its trade-mark registrations. This is not enough to support either the third or fourth grounds of opposition as it does not prove that the marks have been used or that such use was still in effect at the date the applicant’s mark was advertised. Therefore I must reject both these grounds of opposition.

With regard to the first ground of opposition, namely that the mark is confusingly similar to the opponent’s registered trade-marks, the opponent has met the initial evidentiary burden which it is under to prove that it does have valid trade-mark registrations. The onus therefore shifts to the applicant to prove that there is no reasonable likelihood of confusion between the marks and the material date for considering this matter is the date of my decision (see Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. et al, 37 C.P.R. (3d) 413 (F.C.A.)). In assessing whether there would be a reasonable likelihood of confusion according to section 6(2)

of the Act, the Registrar must have regard to all the surrounding circumstances including those set out in section 6(5) of the *Trade-marks Act*.

With regard to the inherent distinctiveness of the marks I find all the marks to be inherently distinctive of cheese and dairy products. At most, the prefix DAN is mildly suggestive of the fact that the wares may come from Denmark. The applicant has introduced some state of the register evidence in an attempt to prove that the prefix DAN is commonly used in trade-marks for cheese. However, only six registrations have been listed and no evidence of use of any of the marks has been provided. Therefore I can only give limited weight to this evidence. With regard to the extent to which the marks have become known, the applicant's evidence points to rather small use since 1983 with sales figures falling from over \$141,000 in 1989/90 to \$34,000 in 1992/93. The opponent has not provided any evidence of use but I can infer some minimal use from the existence of the trade-mark registration for DANINO as a declaration of use was filed in that application in 1971 (the others were based on foreign registrations therefore there may have been no use in Canada). I find that this factor favours the applicant since their use, although it has not been carried on for as long as the opponent's, is more than minimal and has gone on for a sufficient length of time for the mark to acquire some degree of notoriety.

With regard to the length of time the trade-marks have been in use, the applicant's mark has been used since 1983. As stated above, I am prepared to assume minimal use by the opponent of its trade-mark DANINO since the declaration of use was filed in 1971. Therefore this factor favours the opponent.

The applicant's wares are cheese and the opponent's wares comprise dairy products including yogurt and/or cheese, depending on the registration. Therefore, I find that the wares are very similar and I also believe that the channels of trade must be largely the same as all the wares are dairy products which would be sold in the refrigerated section of a grocery or specialty food store. These two factors therefore favour the opponent.

With regard to the degree of resemblance between the marks the only similarity between the marks is the DAN component. This forms the first three letters of all the marks so it occupies a fairly dominant position in the marks. However, in none of the opponent's marks does it appear alone as it does in the applicant's, which makes the marks sound quite different. Also, each mark is combined with enough additional distinguishing matter so that when one compares the marks in their entireties there is really little similarity in sound, appearance or in the ideas suggested by

the marks. This factor therefore favours the applicant.

I note that the opponent, in its statement of opposition, made reference to the fact that it has a family of DAN marks and has from time to time adopted other marks with the prefix DAN including the mark DAN'UP , appln. no. 540,914. No certified copy of this application was ever filed, presumably because it did not predate the applicant's date of first use, yet since the material date for determining this ground of opposition is the date of my decision the opponent should have filed a certified copy of the application as evidence to help support its claim that it has a family of marks. Although the Registrar does have the discretion to check the register in certain cases (see Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltee v. Menu Foods Ltd. 11 C.P.R. (3d) 410) this discretion will not be exercised when it would merely assist the opponent's claim and is not determinative of whether or not a ground of opposition can be considered at all. Therefore I will not attach any weight to the application for DAN'UP. However, the opponent has provided certified copies of other registrations as well as the application for DANONE which leads me to acknowledge that they do have more than one DAN mark. However, I do not think that the fact that the opponent has five marks that include the letters DAN in various combinations is enough to establish a true family of marks, especially not one which is sufficient to permit them to monopolize the prefix DAN. Therefore this fact does not really help the opponent.

As a final surrounding circumstance I am taking into consideration the fact that no evidence of confusion was cited by the opponent despite the fact that the marks have co-existed for thirteen years.

Therefore, given the fact that there is no significant similarity between the marks in appearance, sound or in the ideas suggested by them, the fact that the applicant's mark has a high degree of inherent distinctiveness, and given the fact that the applicant has been using its mark for thirteen years, with no evidence of confusion, I find that the applicant has met the burden upon it to prove that the marks are not confusing. This ground of opposition is therefore dismissed.

With regard to the remaining ground of opposition, namely that based on section 16(1)(b) the material date for determining this matter is the date of first use which is August 1983. The opponent has an evidential burden to show that it had a valid trade-mark application that was not abandoned at the date of advertisement of the applicant's mark. It has met this burden by filing

the certified copy of the application for DANONE which became registered on July 13, 1990 so was obviously pending in 1989 when the applicant's mark was advertised. The onus then shifts to the applicant to prove that the marks are not confusing and this will be determined based on a consideration of all the circumstances, including those enumerated in section 6(5). However, the only factual differences between this issue and the one based on registrability are the difference in the material date, which does not really help the opponent as neither party had any significant use at the date the applicant first commenced use of its mark, and the difference in the opponent's mark (DANONE), which also does not assist the opponent as it is no more similar to DAN SLOT than were any of the opponent's registrations. I must therefore reject this ground of opposition for substantially the same reasons that I rejected the former ground, namely that the applicant's mark is inherently distinctive and the marks are not similar enough, when considered as a whole, to lead to the inference that the wares are manufactured or sold by the same person. The opposition is therefore rejected and the application will be allowed.