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

**Citation: 2018 TMOB 71**

**Date of Decision: 2018-07-11**

**IN THE MATTER OF AN OPPOSITION**

**7088990 Canada Inc.**

**Opponent**

**And**

**Café Cimo Inc.**

**Applicant**

**1,702,053 for ESPRESSO AZZURRO**

**Applications**

**1,702,054 for ESPRESSO AZZURRO**

**& Design**

INTRODUCTION

[1] On October 28, 2014 Café Cimo Inc. (the Applicant) applied for the marks ESPRESSO AZZURRO and ESPRESSO AZZURRO & Design (shown below) for use in association with the following goods and services:

Café, espresso, café italien moulu ou non et ce, pour toute sorte d'infusion, filtre, percolateur, espresso, machines distributrices de grains de café et de café moulu.

La distribution et la vente de café espresso et le rôtissage ainsi que la torréfaction, le mélange, l'emballage, la distribution et la vente en gros de café.



[2] Both applications claim use in Canada since November 29, 1999.

[3] The applications for ESPRESSO AZZURRO and ESPRESSO AZZURRO & Design were advertised for opposition purposes in the *Trade-marks Journal* of November 18, 2015 and June 15, 2016 respectively.

[4] On November 14, 2016, 7088990 Canada Inc. (the Opponent) opposed the applications. In its statement of opposition in each case, the Opponent provides the following background information:

The Opponent has been using both the trade-mark and trade-name ARA AZZURRO (the Opponent's trade-mark) in Ontario since at least as early as March of 2006 in association with similar and identical goods and services to the Applicant's goods and services. The Opponent adopted and developed the Opponent's trade-mark in good faith without knowledge of the Applicant's trade-mark and outside the Applicant's common law marketplace of Quebec.

As such, the Opponent and Applicant's respective trade-marks have co-existed in the Canadian marketplace as a whole since at least as early as March of 2006, developing their own common law trade-mark rights within their respective jurisdictions.

Furthermore, the respective parties did not become aware of one another until August of 2011, after five years of unfettered co-existence in their respective common law marketplaces.

To date there has been no judgment or ruling which prevents or bars the Opponent from using its trade-mark within its common law jurisdiction of Ontario and the respective parties continue to both lawfully operate in their respective jurisdictions and common law marketplaces.

[5] The only ground of opposition in each case is based on section 38(2)(d) of the *Trade-Marks Act*, RSC 1985, c T-13 (the Act). This ground is set out in each statement of opposition as follows:

The Applicant's applied for trade-mark is not distinctive.

The Opponent alleges and the fact is that the Applicant's applied for trade-mark neither distinguishes the goods and services described in the applied for trade-mark application from the goods and services of the Opponent, nor is the applied for trade-mark adapted so as to distinguish the goods and services of the Applicant from the goods and services of the Opponent. The Opponent has used and continues to lawfully use the Opponent's trade-mark in Canada in association with very similar and/or identical goods and services as set out in the applied for trade-mark application.

As a result of the bona fide adoption and lengthy use of the Opponent's trade-mark by the Opponent, the Opponent's trade-mark has become sufficiently known to negate the distinctiveness of the Applicant's trade-mark and that to allow the Applicant to secure exclusive use of the Applicant's trade-mark throughout Canada would be in conflict with the actual common law trade-mark rights of the parties.

[6] The Applicant filed and served a counter statement in each case, in which it denies the Opponent's allegations and provides additional background information about the parties.

[7] Neither the Opponent nor the Applicant filed any evidence nor written arguments. An oral hearing was not conducted.

SECTION 38(2)(D) GROUND OF OPPOSITION

[8] The material date that applies to the section 38(2)(d) ground of opposition is the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317, (FC), at 324]. In each case, this date is November 14, 2016.

[9] The evidential burden on the opponent is to prove the facts in its allegations pleaded in the statement of opposition [see *John Labatt Ltd v Molson Cos* (1990), 30 CPR (3d) 293, (Fed TD), at 298]. The presence of an evidential burden on an opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

[10] In both of these cases, the evidential burden on the Opponent with respect to the section 2 ground in particular was to demonstrate that its trade-mark or trade-name acquired a reputation in Canada that was sufficient to affect the distinctiveness of the Mark as of the date of filing the statement of opposition [see *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427, (FC) at para 34 which sets out what is required of an opponent to meet its burden with respect to distinctiveness].

[11] As the Opponent has not evidenced that its ARA AZZURRO trade-mark or trade-name was used or known in Canada as of the filing date of the statement of opposition, this ground of opposition is rejected in each case.

DISPOSITION

[12] 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.

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

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

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No Hearing Held

**AGENT(S) OF RECORD**

Andrews Robichaud

FOR THE OPPONENT

François W. Légaré

FOR THE APPLICANT

Ratelle, Ratelle & Associés