



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 26
Date of Decision: 2020-02-28

IN THE MATTER OF AN OPPOSITION

**Olive Me Inc., Isabelle Ortiz Martinez
(nee Fontaine), and a Partnership
between Isabelle Ortiz Martinez (nee
Fontaine) and Yosberti Ortiz Martinez** **Opponent**

and

1887150 Ontario Inc. **Applicant**

1,738,663 for Olive-Me & Co. **Application**

[1] 1887150 Ontario Inc. (the Applicant) has applied for the trademark Olive-Me & Co. (the Mark) for use in association with olive oils, flavoured vinegar, wine vinegar based on its use of the Mark in Canada since 2013.

[2] Isabelle Ortiz Martinez (nee Fontaine), her successor-in-title a Partnership between Isabelle Ortiz Martinez (nee Fontaine) and Yosberti Ortiz Martinez and their successor-in-title Olive Me Inc. (collectively referred to as the Opponent), have used the trademark OLIVE ME since 1999 in association with a processed olive business operating in Edmonton. The Opponent has primarily opposed this application on the basis that the trademark Olive-Me & Co. is confusing with its previous use of its trademark in association with processed olives.

[3] For the reasons that follow, I find that this application should be refused.

File Record

[4] The Applicant filed application No. 1,738,663 on July 23, 2015.

[5] The application was advertised in the March 30, 2016 issue of the *Trademarks Journal*.

[6] The statement of opposition was filed on August 25, 2016. Leave was granted for the filing of an amended statement of opposition on September 20, 2017. The amended statement of opposition raises five grounds of opposition under section 38 of the *Trademarks Act*, RCS 1985, c T-13 (the Act). This Act was amended on June 17, 2019. All references are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act as it read before it was amended (see section 70 of the Act which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised before this date).

[7] At the hearing, the Opponent's agent conceded that it had not met its evidential burden with respect to its section 30(b) and (i) grounds of opposition and advised that it was no longer pursuing those grounds. If the opponent had not conceded them, I would have rejected these grounds of opposition as the Opponent did not file any evidence pertaining to them. The remaining grounds of opposition can be summarized as follows:

1. The Applicant is not the person entitled to registration of the Mark in view of section 16(1)(a) of the Act since on the alleged date of first, namely 2013, the Mark was confusing with the trademark OLIVE ME previously used and made known in Canada by the opponents or one or more of them in association with processed olives since at least as early as 1999.
2. The Applicant is not the person entitled to registration of the Mark in view of section 16(1)(c) of the Act since on the alleged date of first, namely 2013, the Mark was confusing with the trade name OLIVE ME Inc., previously used by the opponents or one or more of them in association with processed olives since at least as early as 1999.

3. The Mark is not distinctive, within the meaning of Section 2 of the Act, of the goods of the Applicant and is not adapted to distinguish such goods because the Mark does not distinguish the Applicant's goods from the goods of the opponents or one or more of them in association with which the trademark OLIVE ME has been used and made known by the opponents or one or more of them. I note that this ground of opposition referred to the opponent's use of the Mark as opposed to its trademark OLIVE ME. In view of the fact that both parties at the oral hearing treated this ground of opposition as being based on the Opponent's use of its trademark OLIVE ME, I find the reference to use of the Applicant's Mark by the Opponent to be a typographical error.

[8] The Applicant filed and served a counter statement denying all of the grounds of opposition.

[9] In support of its opposition, the Opponent filed the affidavit of Isabelle Ortiz Martinez (sworn on March 22, 2017). On July 24, 2017, the Opponent requested leave to file an amended affidavit of Ms. Ortiz Martinez (sworn July 5, 2017) with minimal amendments. Upon receipt of the Opponent's request, the Registrar wrote the Applicant requesting its comments and advising, "should no comments be received it is likely that leave will be granted". No comments were received from the Applicant. On September 20, 2017, the Registrar updated the database to reflect that leave had been granted and sent a letter confirming the same. It appears, however, that the parties may not have received this letter. At the hearing, I confirmed the granting of leave for the filing of the second affidavit based on the minimal amendments and the fact that the Applicant had made no comments. Throughout this decision, I will refer only to the affidavit of Ms. Ortiz Martinez sworn on July 5, 2017. No cross-examination of Ms. Ortiz Martinez was conducted. Only the Opponent filed a written argument. Both parties attended the hearing.

Evidential Burden and Legal Onus

[10] Before considering the grounds of opposition, it is necessary to review some of the requirements with regard to (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[11] With respect to (i) above, there is an evidential burden on an opponent to support the facts in its allegations pleaded in the statement of opposition: *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298. 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. With respect to (ii) above, the legal onus is on an applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent (for those allegations for which the opponent has met its evidential burden). A legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against an applicant.

Section 16(1)(a) Ground of Opposition

[12] The Opponent has an initial evidential burden of establishing use of its trademark OLIVE ME prior to December 31, 2013 (as the date of first use in the application is 2013, the date of first use is interpreted as December 31, 2013) [*Khan v Turban Brand Products Ltd* (1984), 1 CPR (3d) 388 (TMOB)] and that it had not abandoned this trademark as of March 30, 2016 [see sections 16(1)(a) and 16(5) of the Act].

The Opponent Does not have to prove a Certain Level of Use or Reputation

[13] At the hearing, the Applicant submitted that for an opponent to meet its evidential burden with respect to a section 16 ground based on prior use that there was a minimum threshold or *de minimis* amount of use which was required. Specifically, that in addition to establishing prior use that an opponent must also establish reputation under the relied upon mark [*British American*

Bank Note Co v Bank of America National Trust & Saving Assn (1983), 71 CPR (2d) 26 (FCTD)].

[14] The Registrar has previously found that the requirement to establish reputation is best viewed as a requirement to establish that an opponent's trademark has actually functioned as a trademark and has been used for the purpose of distinguishing an opponent's goods or services from those of others [*Domtar Inc v Ottawa Perma-Coating Ltd* (1985), 3 CPR (3d) 302 (TMOB) quoted with approval in *Merrill Lynch & Co v Bank of Montreal* (1996), 66 CPR (3d) 150 (FCTD) at para 35]. In the case of descriptive or laudatory trademarks, therefore, there is a requirement that there is some recognition of the mark as a trademark [*Monem v Lingle*, 2016 TMOB 49 at paras 35-37].

[15] Subject to the above requirement for descriptive and laudatory trademarks, there is no *de minimis* standard of use that an opponent must show to meet its burden under section 16. There is no requirement that the level of use meet a *de minimis* standard so long as the sales relied upon are in the normal course of trade [*JC Penney Co Inc v Gaberdine Clothing Co Inc*, 2001 FCT 1333 at paras 91-92] and an opponent demonstrates that its trademark has not been abandoned [section 16(5) of the Act]. If an opponent's evidence of use meets the requirements of section 4 and occurs at the material time, an opponent will have met its burden of demonstrating previous use for a section 16(1)(a) ground of opposition even if there is just one single sale or event [*7666705 Canada Inc v 9301-7671 Québec Inc*, 2015 TMOB 150].

The Opponent Meets its Burden

[16] At the hearing, the Applicant submitted that the Opponent failed to meet its burden because (i) the chain of title is not properly evidenced; and (ii) Ms. Ortiz Martinez's evidence is limited to bald statements concerning sales and no documentary proof of sales such as invoices is provided. The Applicant submitted that Ms. Ortiz Martinez's evidence is ambiguous with respect to both the chain of title and the evidence of sales and the ambiguities must be resolved against the affiant per *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA).

[17] In her affidavit, Ms. Ortiz Martinez explains that she is "responsible for all levels of operation of the business, from developing and implementing marketing strategies, to attending

trade shows, to generating sales and coordinating delivery to wholesalers, to operating a retail storefront and olive processing facility” (para 2).

[18] Ms. Ortiz Martinez sets out the following chain of title in her affidavit (para 1):

I founded a processed olive business in 1999 under the trade name and trademark OLIVE ME ... From 1999 to about 2014, I was the sole owner and user of the OLIVE ME trademark. From about 2014 to present, my husband Yosberti Ortiz Martinez and I formed a partnership that owned and used the mark OLIVE ME. From 2016 to present, I formed a corporation Olive Me Inc. to use the OLIVE ME trademark under license. [...]

[19] In the absence of cross-examination or contradictory evidence, I have no reason to doubt Ms. Ortiz Martinez’s sworn statements on the chain-of-title. Further, since both Ms. Ortiz Martinez and the partnership of Ms. Ortiz Martinez and Yosberti Ortiz Martinez are named as opponents, I do not find the fact that the precise dates the trademark OLIVE ME was assigned from Ms. Ortiz Martinez to the partnership of Ms. Ortiz Martinez and Mr. Ortiz Martinez to be problematic for this ground of opposition.

[20] I am satisfied that Ms. Ortiz Martinez’s evidence summarized below is sufficient to meet the Opponent’s evidential burden:

1. For retail sales, processed olives are packaged mostly in 8, 16, and 32 ounce containers which bear the trademark OLIVE ME as shown in the photo and labels attached as Exhibits C and D. This packaging has been used from 2006 onwards (para 7).
2. For wholesale sales, processed olives are mostly sold in 20 L buckets that each bear the trademark OLIVE ME. These olives are typically sold by the pound to customers in grocery stores.
3. Ms. Ortiz Martinez provides the following sales figures of olives sold between 2012-2015 (para 5).

2012	\$227,635
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2013	\$253,020.10
2014	\$356,424.70
2015	\$407,776.63

Ms. Ortiz Martinez explains that since 2011, wholesale sales have accounted for about 70 percent of sales volume.

[21] Ms. Ortiz Martinez’s evidence of representative packaging and labelling and sales of processed olives is sufficient to meet the Opponent’s evidential burden. At the hearing, the Applicant submitted that Ms. Ortiz Martinez’s evidence was insufficient because she simply made bald statements about sales without providing documentary proof such as invoices. The Applicant suggested that this renders Ms. Ortiz Martinez’s evidence ambiguous and this ambiguity should be resolved against the Opponent per *Plough (Canada) Ltd*. I do not agree with the Applicant’s submissions. Ms. Ortiz Martinez’s evidence does not consist of “bald statements”, nor do I find it, when viewed as a whole, ambiguous. Rather, Ms. Ortiz Martinez’s attested to sales are consistent with the evidence of use of the trademark OLIVE ME on business cards since 1999 (para 11, Exhibit G), storefront signage since 2006 (para 10, Exhibit F), photographs of sample packaging and labels used since 2006 (paras 7-8, Exhibits C-D) and on a menu since 2006 (para 12, Exhibit I).

The Applicant Fails to Meet Its Legal Onus

[22] As I am satisfied that the Opponent has met its evidential burden, I must now determine whether the Applicant has met its legal onus of proving that there is no reasonable likelihood of confusion on a balance of probabilities.

Test for Confusion

[23] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general or Nice class.

[24] 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 trademarks 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 trademarks 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); *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC).]

[25] In support of its application, the Applicant also raises several additional circumstances that it submitted weigh in favour of finding that there is not a likelihood of confusion. Below, I consider each of the circumstances enumerated in section 6(5) of the Act as well as the additional circumstances raised by the Applicant.

inherent distinctiveness, extent known, and length of time in use

[26] The overall consideration of the section 6(5)(a) factor, which involves a combination of inherent and acquired distinctiveness of the parties' trademarks, and the section 6(5)(b) factor, length of time in use, favours the Opponent. With respect to inherent distinctiveness, both parties' marks have some measure of inherent distinctiveness, owing to the play on words employed in both marks which sound like "all of me". The Opponent has shown that its trademark is known to some extent in Edmonton, Alberta as it has sold olives with the OLIVE ME trademark through its retail store in this city since 2002 (paras 5,7), at wholesale in large buckets with the trademark OLIVE ME to other grocery stores in the Edmonton and Calgary area (paras 8, 15) and at farmers markets around Edmonton (para 9). Further, Ms. Ortiz Martinez provides sales numbers of greater than \$75,000 for each of the years 2001-2015 of processed olives in association with the trademark OLIVE ME (para 5). In contrast, there is no evidence that the Applicant had commenced use of the Mark as of the material date.

degree of resemblance

[27] The Mark and the Opponent's trademark OLIVE ME are highly similar. The Applicant has taken the Opponent's mark in its entirety. The addition of & Co. does not effectively

diminish the resemblance as it is descriptive of the type of entity providing the goods (a company) [*Reno-Dépôt Inc v Homer TLC Inc* (2009), 84 CPR (4th) 58 (TMOB) at para 58].

nature of goods, business and trade

[28] This factor favours the Opponent as I find that the goods are of similar nature all being food stuffs and olive oils being made from olives. Further, the evidence is that the goods are sold in the same channels of trade, namely, specialty retail stores. The applied-for goods and the Opponent's goods may also be sold in grocery stores. Ms. Ortiz Martinez attaches to her affidavit screenshots from the Applicant's Facebook page showing that the Applicant also sells olives (Exhibit K). Although the Opponent's evidence set out in Ms. Ortiz Martinez's affidavit postdates the material date for this ground of opposition, the Registrar may take into account such evidence insofar as it may indicate a situation existing at the material date [see, for example, *George Weston Ltd v Corporate Foods Ltd* (1988), 19 CPR (3d) 566 (TMOB)], in this case the overlap in the nature of goods, business and trade.

no evidence of actual confusion

[29] The Applicant submitted at the hearing that the fact that there was no evidence of confusion favours it. An adverse inference concerning the likelihood of confusion may be drawn when concurrent use on the evidence is extensive and no evidence of confusion has been given by an opponent [*Christian Dior SA v Dion Neckwear Ltd* (2002), 20 CPR (4th) 155 (FCA)]. However, in the present case, I cannot draw an inference because there is no evidence of extensive concurrent use at the material date, or at any other date.

difference in geographic areas

[30] The Applicant submitted that the Applicant and Opponent operate in different geographic areas and this eliminates any likelihood of confusion. The Applicant's submission is incorrect. The Supreme Court of Canada in *Masterpiece, supra*, at paras 28-33 holds that the likelihood of confusion test applied under section 16 is hypothetical in nature and any differences in where the trademarks are used does not play a role in this hypothetical test.

conclusion

[31] Having considered all of the surrounding circumstances and applying the test of confusion as a matter of first impression and imperfect recollection, I conclude that, on a balance of probabilities, that there is a reasonable likelihood of confusion between the trademark OLIVE ME and the Mark for use in association with the applied-for goods. I conclude this based on the degree of resemblance between these trademarks and the overlap in the nature of the goods and trade. Accordingly, this ground of opposition is successful. I acknowledge that suggestive trademarks are more likely to be able to co-exist; with a party adopting a weak trademark being held to accept some risk of confusion [*General Motors Corp v Bellows* (1949), 10 CPR 101 (SCC) at 115-116; *Mövenpick Holding AG v Exxon Mobil Corp*, 2010 TMOB 126, 2011 FC 1397, *aff'd* 2013 FCA 6; *Culinar Inc v National Importers* (2004), 42 CPR (4th) 180 (TMOB)]. While the Opponent's trademark is not the sort of mark that is typically afforded a broad scope of protection, a narrow scope of protection is not the same as having no protection at all.

[32] Accordingly, this ground of opposition succeeds.

Section 16(1)(c) Ground of Opposition

[33] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark as it is confusingly similar with the Opponent's trade name OLIVE ME. In order to meet its initial burden with respect to its section 16(1)(c) ground of opposition, the Opponent must show that it has used its trade name OLIVE ME prior to December 31, 2013 and had not abandoned such use as of March 30, 2016 (see section 16(5) of the Act). The Opponent's evidence is insufficient to meet this burden as its evidence does not show that it was using the trade name on its processed olives as of December 31, 2013. In particular, I find that the use of OLIVE ME on the labels attached to Ms. Ortiz Martinez's affidavit is use of a trademark as opposed to a trade name. As such, this ground of opposition is rejected. If I am incorrect in so finding, I would have found this ground of opposition successful for the reasons set out with respect to the section 16(1)(a) ground of opposition.

Distinctiveness Ground of Opposition

[34] In order to meet its evidential burden, the Opponent must show that as of the filing of the statement of opposition the Opponent's trademark OLIVE ME had become sufficiently known to negate the distinctiveness of the Mark [*Bojangles' International, LLC v Bojangles Café Ltd* 2006 FC 657 at paras 33-34]. When an opponent's reputation is restricted to a specific area of Canada, an opponent's evidential burden may be satisfied if its trademark is well known in that area [*Bojangles, supra*]. The evidence before me, however, does not allow me to conclude that the Opponent's trademark was well known in a specific area of Canada. In the absence of more specific information regarding how many consumers are aware of the Opponent's trademark OLIVE ME whether through purchase of the Opponent's olives branded with the trademark OLIVE ME, attendance at the Opponent's store front location, advertising or otherwise, I cannot conclude that the Opponent's trademark is well known in a specific area of Canada. As such, this ground of opposition is rejected.

Disposition

[35] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

Hearing Date: 2019-10-28

Appearances

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For the Opponent

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