



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 054

**Date of Decision:** 2023-03-28

## **IN THE MATTER OF AN OPPOSITION**

**Opponent:** A&W Trade Marks Limited Partnership

**Applicant:** Fromages La Chaudière Inc.

**Application:** 1,893,071 for MENOUM!

### **INTRODUCTION**

[1] A&W Trade Marks Limited Partnership (the Opponent) opposes the registration of the trademark MENOUM! (the Mark), the subject of application No. 1,893,071 by Fromages La Chaudière Inc. (the Applicant), in association with the following goods: [TRANSLATION] “Cheese”.

[2] The Opponent opposes the application on various grounds, including that the Mark creates confusion with the registered trademark MENOUM MENOUM, TMA277,465 (the Opponent’s Mark), used in Canada by the Opponent in association with the following services: “Restaurant services”.

[3] As my analysis will show, I find that the opposition ought to be rejected.

## **THE RECORD**

[4] The application for the Mark was filed on April 11, 2019, based on use in Canada since May 2013 and advertised in the *Trademarks Journal* for opposition purposes on January 1, 2020.

[5] The statement of opposition was filed on June 29, 2020, under section 38 of the *Trademarks Act*, RSC 1985, c. T-13 (the Act). I note that the Act was amended on June 17, 2019. As the application was advertised after that date, the Act applies as amended (see section 69.1 of the Act).

[6] The Opponent raises the grounds of opposition based on:

- non-registrability of the Mark under sections 38(2)(b) and 12(1)(d) of the Act;
- non-entitlement to registration of the Mark under sections 38(2)(c) and 16(1)(a) of the Act;
- non-distinctiveness of the Mark under sections 38(2)(d) and 2 of the Act;
- no use or intent to use the Mark under paragraph 38(2)(e);
- non-entitlement to use the Mark under section 38(2)(f) of the Act.

[7] The Applicant filed a counter statement denying the grounds of opposition.

[8] In support of its opposition, the Opponent filed an affidavit of Kelly Blankstein, sworn on January 6, 2021, with exhibits A to U.

[9] In support of its application, the Applicant filed a statutory declaration by Michel Choquette, sworn on June 4, 2021, with exhibits 1 to 5.

[10] Only the Opponent filed written representations. No hearing was held.

## **THE BURDEN**

[11] The Opponent has the initial burden of establishing the merits of its opposition. The Opponent must ensure that each of its grounds of opposition is properly pleaded and meet the initial burden of proof by establishing the facts on which it bases each one. Once the initial burden of proof is met, the burden is on the Applicant to establish,

on a balance of probabilities, that none of these grounds of opposition presents an obstacle to registering the Mark [*John Labatt Ltd v Molson Companies Ltd* (1990), 1990 CanLII 11059, 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 2002 FCA 29, 20 CPR (4th) 155].

## **ANALYSIS**

### ***Ground of opposition summarily dismissed: Section 38(2)(e)***

[12] In its statement of opposition, the Opponent submits that, on the filing date of the application, the Applicant had not used and did not plan to use the Mark in Canada. However, the Opponent did not file any evidence to support that ground of opposition. On the contrary, the Applicant's evidence, described below, shows that it offered cheese for sale in association with the Mark.

[13] Accordingly, the ground of opposition based on section 38(2)(e) is dismissed, as the Opponent has failed to meet its initial burden of proof.

### ***Non-registrability of the Mark under section 12(1)(d) of the Act***

[14] The Opponent argues that the Mark is not registrable, as it is confusing with the Opponent's mark.

[15] I have exercised the Registrar's discretion to consult the register and I confirm that the Opponent's registration is in good standing as of today's date, which is the material date for assessing a section 12(1)(d) ground of opposition [*Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 1991 CanLII 11769, 37 CPR (3d) 413 (FCA)].

[16] As the Opponent has met its burden of proof, the Applicant must now satisfy the Registrar, on a balance of probabilities, that there is no likelihood of confusion between the two marks.

### Test for confusion

[17] The test for confusion does not concern confusion of the trademarks themselves but confusion as to whether the goods and services associated with each party's trademark come from the same source. Where it is likely to be assumed that the applicant's goods or services either come from the opponent or are approved, licensed, or sponsored by the opponent, it follows that the trademarks are confusing [see *Glen-Warren Productions Ltd v Gertex Hosiery Ltd* (1990), 29 CPR (3d) 7 (FCTD)].

[18] The test is to be applied as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the applicant's trademark at a time when he or she has no more than an imperfect recollection of the opponent's trademark and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the trademarks [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23]. In applying the test, regard must be had to all the surrounding circumstances, including those set out in sections 6(5)(a) to (e) of the Act, but these criteria are not exhaustive and the weight given to each factor will vary in a context-specific analysis [*Mattel USA Inc v 3894207 Canada Inc*, 2006 SCC 22].

### *The inherent distinctiveness of the trademarks and the extent to which they have become known*

[19] According to the Opponent's position, the evidence does not establish that *menoum* is an English or French word. It therefore submits that the word has no particular meaning to consumers and is not descriptive of the services offered by the Opponent. The Opponent submits that the Opponent's Mark is inherently distinctive.

[20] Although the term *menoum* does not appear in the French-language *Larousse* or *Le Robert* dictionaries, or in the English-language *Canadian Oxford Dictionary*, it has a particular meaning at least for Francophones living in Quebec. Indeed, according to the site *lalanguefrancaise.com*, there are two definitions for the word *menoum*:

[TRANSLATION]

(Quebec) (Popular) Child-speak to refer to good food to a baby or very young child.

(Quebec) Expression expressing satisfaction from taste, or the expectation of tasting something good.

[21] Consequently, the trademarks in question are suggestive when considered in the context of the Applicant's food goods or the Opponent's restaurant services, at least for a Francophone living in Quebec. For the rest of the Canadian population, the marks are more unique given the lack of any particular meaning associated with the term *menoum* outside Quebec.

[22] The Mark and the Opponent's Mark therefore both have an equal degree of distinctiveness, albeit low when the marks are considered from the perspective of a Quebec consumer.

[23] The distinctiveness of a trademark may be increased by it becoming known through promotion or use.

[24] This leads me to consider the evidence from each party and the Opponent's representations on this point.

#### Opponent's Evidence

[25] Ms. Blankstein states the following in her affidavit concerning the Opponent's Mark:

- She is the "Chief Financial Officer" of A&W Food Services of Canada Inc. (A&W Food Services) and A&W Revenue Royalty Income Fund, two businesses that are part of the overall A&W businesses, of which the Opponent is also a part [para 1].
- She describes A&W as a fast-food chain with over 900 restaurants in Canada under the A&W banner [para 5] and adds that those restaurants are operated by franchisees or by A&W Food Services [para 6].

- Since at least January 2009, A&W Food Services has been licensed by the Opponent to use its trademarks, including the Opponent's Trademark. Franchisees operating restaurants under the A&W banner are also licensed to use the Opponent's Mark [para 14]. It should be noted that the deponent uses the term "A&W trademarks" but that expression is not defined anywhere in her affidavit. In fact, the only specific marks referred to by the deponent are A&W and MENOUM MENOUM.
- The Opponent and its predecessors in title have always controlled the characteristics or quality of the goods and services offered in association with the Opponent's Mark [para 16].
- A&W Food Services and the franchisees have considerable annual revenues in Canada, including over \$1 billion per year since 2015 [para 18].
- The Opponent's Mark has been used in Canada since at least 1981, through the distribution of coupons to potential customers in Quebec, and through television advertising broadcast in Quebec [paras 19 and 20].

[26] Ms. Blankstein also states the following in her affidavit concerning the Opponent's activities and related businesses associated with other trademarks:

- A&W Food Services uses various trademarks owned by the Opponent in association with soft drinks. All restaurants in the A&W chain sell packages of four bottles of root beer, except where that is not permitted [para 33]. I note that Ms. Blankstein does not identify these trademarks.
- The Opponent grants a licence to Coca-Cola Refreshments Canada Company (Coca-Cola Canada) to use its trademarks in association with canned and bottled soft drinks [para 34]. I note that Ms. Blankstein does not identify these trademarks. However, the documentary evidence described below (Exhibit R for example) illustrates the use of the A&W mark.
- The goods sold by Coca-Cola Canada are sold to various types of stores, including grocery stores, pharmacies and convenience stores [para 35]. Each year since 2008, over two million packages of soft drinks have been sold in Canada by Coca Cola Canada [para 37] in association with the A&W mark.

[27] In support of her affidavit, Ms. Blankstein the following exhibits relevant to the Opponent's Mark and other trademarks also owned by the Opponent:

- Copies of coupons distributed in Quebec by A&W Food Services in 1981 [Exhibit D], in 2012 [exhibits F and G] and in 2013 [exhibits I to K]. The Opponent's Mark is displayed on them.
- An animated story from an advertisement by A&W Food Services that appeared on television in at least two cities in Quebec in the spring of 1981. This animated story shows that the Opponent's Mark was part of the visual and audio content of that advertisement [Exhibit E].
- A television advertisement from A&W Food Services that aired in several cities in Quebec in 2012 [Exhibit H]. The Opponent's Mark appears in and is mentioned in that advertisement.
- A copy of an email distributed by A&W Food Services on June 2, 2020 to registered mobile subscribers in Quebec to promote A&W restaurant services [Exhibit L]. The Opponent's Mark is displayed in it.
- Screenshots from the websites of Canadian retailers on which goods from Coca-Cola are for sale, including the following goods: "A&W Root Beer® 355 ml Cans, 12 Pack", "A&W Caffeine Free Root Beer – 2L", "A&W Root Beer (Case)" [exhibits P to U]. The Opponent's Mark is displayed on those screenshots.
- Screenshots from various websites where root beer is offered for sale in association with the A&W mark [Exhibits P to U].

#### Applicant's evidence

[28] Mr. Choquette states the following in his statutory declaration:

- He is the President of the Applicant [para 1], a company that has manufactured cheese since 1979 [para 2].
- The Applicant's cheeses are all sold under humorous brands [para 3], such as SKOUIK SKOUIK!, Fou raide" and TIGIDOU! [para 4]. I would add that these marks are also from popular language in Quebec.

- The Applicant's cheeses are sold in the cheese section of grocery stores, in restaurants and in convenience stores [para 14].

[29] In support of his statutory declaration, Mr. Choquette attached the following relevant exhibit:

- A photograph of several cheeses in a display that seems to be refrigerated [Exhibit 4]. Mr. Choquette did not state where or when the photograph was taken. The Mark is displayed on some goods.

Conclusion on the use of the parties' marks

[30] The Opponent's revenues and franchisees' revenues are not broken down by trademark and the Opponent owns several trademarks. It is therefore hard to accurately determine the ones in which its marks became known, including its MENOUM MENOUM mark. However, given the number of restaurants operated as A&W franchises, the considerable annual revenues of those restaurants and the many exhibits showing that the Opponent's Mark is displayed in various advertising by the Applicant, which were distributed in Quebec, I am prepared to conclude that the Opponent's Mark became known to some extent in Canada, particularly in the province of Quebec.

[31] With respect to the Applicant's evidence, it is far too imprecise to conclude that the Mark has become known in such a way as to increase its inherent instinctiveness in Canada. Exhibit 4 shows at best that the Applicant offered cheese for sale with the Mark displayed on the packaging. That evidence is insufficient to determine the extent to which the Mark has become known in Canada.

[32] I find that, overall, this factor favours the Opponent.

*The degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them*

[33] The degree of resemblance between the trademarks is often the factor likely to have the greatest effect on the confusion analysis and thus is an appropriate starting



point [*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27]. In assessing resemblance between trademarks, each trademark must be considered as a whole. The proper approach is not to compare each characteristic of the marks to identify similarities and differences.

[34] The analysis of the resemblance between the marks must not be limited to only one of Canada's official languages. For instance, it is not sufficient to show that a unilingual Anglophone would not pronounce or understand the parties' marks in the same way. There must not be a resemblance from the standpoint of the three types of average Canadian consumer: the unilingual Anglophone, the unilingual Francophone, and the bilingual consumer. If there is a likelihood of confusion in either of Canada's official languages, a mark must not be registered [see *Pierre Fabre Médicament v SmithKline Beecham Corp.* 2001 FCA 13, at paras 12 to 15].

[35] The Opponent noted that the degree of resemblance between the two marks is very high and that the lack of repetition of the word MENOUM and the addition of the exclamation mark at the end of the Mark are not sufficient to distinguish the Mark from the Opponent's Mark.

[36] I agree. Although the two marks are not identical, they are nonetheless very similar, and the lack of repetition of the word *menoum* and the addition of the exclamation mark are not sufficient to differentiate them in the eyes of a consumer.

[37] Moreover, the word MENOUM, suggests the same ideas, whether for a consumer in Quebec or outside Quebec. Indeed, for Quebecers, the marks suggest good food in a childlike language and, for the rest of Canadians, the marks would have no particular meaning.

[38] In light of all the above, this factor favours the Opponent.

#### *Length of time the trademarks have been in use*

[39] The Opponent has demonstrated the use the Opponent's Mark since 1981.

[40] For its part, the Applicant did not submit any evidence of use of the Mark within the meaning of section 4(1) of the Act, as noted above.

[41] This factor therefore favours the Opponent.

*Nature of the parties' goods, businesses, and trades*

[42] The Opponent submits that the Applicant and the Opponent both operate in the food and beverage industry. It adds that the Opponent's goods are sold in the same businesses or types of businesses as those of the Applicant. It also notes that the trademarks are both used primarily in Quebec.

[43] When considering the nature of the goods, businesses, and trades under the ground of opposition based on the registrability of the Mark, it is the statement of goods in the Applicant's application and in the Opponent's registration that must be assessed, having regard to the channels of trade that would normally be associated with such goods [*Mr. Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export* (1986), 12 CPR (3d) 110 (FCA)]. Each statement must be read with a view to determining the probable type of business or trade intended rather than all possible trades that might be encompassed by the wording; evidence of the parties' actual trades is useful in this respect [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 1996 CanLII 3963, 68 CPR (3d) 168 (FCA)].

[44] In this case, Mr. Choquette alleges that the Applicant's goods are sold primarily in grocery stores, restaurants and convenience stores.

[45] With respect to the Opponent's Mark, it is registered in association with restaurant services. Those services are offered directly in the Opponent's restaurants or those of its franchisees operated under the A&W banner.

[46] The evidence establishes that, through franchisees, the Opponent sells soft drinks in association with its A&W trademark in several businesses, including its own

restaurants. There is no evidence that the Opponent sells or markets goods in association with its MENOUM mark.

[47] Given the significant difference in the parties' goods and services, this factor favours the Applicant.

#### Conclusion concerning the likelihood of confusion

[48] As indicated in *Dion Neckwear*, above, at page 163, the Registrar "need not be satisfied beyond doubt that confusion is unlikely. Should the 'beyond doubt' standard be applied, applicants would, in most cases, face an insurmountable burden because certainty in matters of likelihood of confusion is a rare commodity."

[49] In light of the analysis above, I find that the Applicant has met its burden of demonstrating, on a balance of probabilities, that a consumer with an imperfect recollection of the Opponent's Mark would not be likely to conclude that the Applicant's goods listed in the application were from the same source or otherwise linked to or associated with the Opponent's services, primarily given the significant difference in the nature of the Applicant's goods and the nature of the Opponent's services.

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

#### ***Ground of opposition summarily dismissed: Section 38(2)(f)***

[51] In its statement of opposition, the Opponent submits that, at the filing date of the application, the Applicant was not entitled to register the mark, as it was confusing with the Opponent's Mark. It adds that the Opponent's Mark is protected by an exclusive right of use under sections 19 and 20 of the Act.

[52] Even assuming that the ground of opposition as worded is a valid ground, I find that the Opponent has not met its initial burden concerning the ground under section 38(2)(f) of the Act for the following reasons:

- Section 19 requires the use of an identical trademark, which is not the case here.

- For section 20 to apply, confusion between the marks must be found; however, I found previously that there is no likelihood of confusion between the Mark and the Opponent's Mark.

[53] Consequently, the section 38(2)(f) ground of opposition is rejected.

***Other grounds of opposition***

[54] The grounds of opposition cited under sections 2 and 16(1)(a) of the Act are based, in whole or in part, on an allegation that there is a likelihood of confusion between the Mark and the Opponent's Mark.

[55] The Opponent's best argument concerning the issue of confusion was the ground of opposition under section 12(1)(d), as the ground of opposition had a material date that allowed for consideration of all the Opponent's evidence concerning its reputation. The grounds of opposition based on section 2 (June 29, 2020) and 16(1)(a) (May 2013 or April 11, 2018) have earlier material dates.

[56] In the circumstances, given that the Opponent was not successful in its ground of opposition under section 12(1)(d), for the same reasons as set out above for that ground, the grounds of opposition based on sections 2 and 16(1)(a) of the Act are also rejected.

**DISPOSITION:**

[57] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

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Jean Carrière  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

# Appearances and Agents of Record

**HEARING DATE:** No hearing held

## **AGENTS OF RECORD**

**For the Opponent:** GOWLING WLG (CANADA) LLP

**For the Applicant:** No agent appointed

The English is WCAG compliant.