

Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 179

Date of Decision: 2023-10-25

IN THE MATTER OF AN OPPOSITION

Opponent: Chocoladefabriken Lindt & Sprüngli AG

Applicant: GRC Food Services Ltd.

Application: 1840459 for MASTER CHOCOLAT PURE

INTRODUCTION

[1] Chocoladefabriken Lindt & Sprüngli AG (the Opponent) opposes registration of the trademark MASTER CHOCOLAT PURE (the Mark), that is subject of application No. 1,840,459 (the Application), filed by GRC Food Services Ltd. (the Applicant).

[2] The Application for the Mark was filed on June 1, 2017, for use in association with a variety of chocolate and chocolate-based products, associated gift packaging items and recipes/cookbooks, as well as services relating to the sale of such goods. A complete listing of the applied-for goods and services, together with their associated Nice classes (CI), and bases of filing, is attached under Schedule A to this decision.

[3] The opposition to the Mark is primarily based on an allegation of confusion with one or more of the Opponent's trademarks (registered or otherwise), which incorporate the words

MASTER and CHOCOLATE or CHOCOLATIER (or French language equivalents). A complete listing of the Opponent's relied-upon trademarks (collectively, the Opponent's Marks) is attached under Schedule B to this decision.

[4] For the reasons that follow, the Application is refused.

THE RECORD

[5] As previously indicated, the Application was filed on June 1, 2017. The Application was then advertised for opposition purposes in the *Trademarks Journal* of July 18, 2018.

[6] On July 2, 2019, the Opponent filed a statement of opposition against the Application 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, and pursuant to section 70 of the Act, the grounds of opposition in this proceeding will be assessed based on the Act as it read prior to June 17, 2019.

[7] The Opponent raises grounds of opposition based on non-registrability under section 12(1)(d), non-entitlement under sections 16(1)(a), 16(3)(a), 16(1)(b), and 16(3)(b), and non-distinctiveness under section 2 of the Act.

[8] The Applicant filed and served its counter statement on September 17, 2019, denying the grounds of opposition.

[9] In support of its opposition, the Opponent filed the affidavit of Kairen Wu, the Vice President of Marketing for Lindt & Sprüngli (Canada) Inc. (a wholly owned subsidiary and licensee of the Opponent). Ms. Wu's affidavit pertains to evidence concerning the Opponent's business and its relied upon trademarks. Ms. Wu was not cross examined on her affidavit

[10] In support of its Application, the Applicant filed:

- The affidavit of Jahaan Premji, an articling student employed by the agent for the Applicant. Ms. Premji's affidavit concerns use in Canada of the words CHOCOLATE MASTERS by a school for chocolate making, and the World Chocolate Masters competition;
- The affidavit of Bernard Callebaut, an award winning Master Chocolatier who has been employed by the Applicant since 2015. Mr. Callebaut's affidavit provides evidence concerning the Applicant's business and the Mark;

- The affidavits of Suzy Torres and Thomas James, research analysts with CompuMark, an intellectual property research firm. Ms. Torres' and Mr. James' affidavits provide the results of various searches related to the words MASTER or MASTERS; and
- The affidavit of Amanda Jamieson, a legal assistant employed by the agent for the Applicant. Ms. Jamieson's affidavit provides the results of various searches related to the term CHOCOLATIER.

[11] With the exception of Mr. Callebaut, all of the Applicant's affiants were cross examined on their affidavits, and the associated transcripts form part of the record.



[12] Both parties filed written representations and attended a hearing that was held in conjunction with a hearing for a related application (App. No. 1,749,988 for MASTER CHOCOLAT), a decision for which will be issued under separate cover.

ANALYSIS

Section 12(1)(d) Ground of Opposition

[13] The material date for the section 12(1)(d) ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[14] The Opponent pleads that the Mark is not registrable because it is confusing with the Opponent's following registered trademarks, namely:

Registration No.	Trademark	Goods
TMA377,673		(1) Chocolate and chocolate products namely chocolate cups, chocolate decorations, and chocolate shavings.
TMA837,071		(1) Chocolate and chocolate products, namely

		chocolate cups, chocolate decorations and chocolate shavings.
TMA993,318	LINDT MAÎTRE CHOCOLATIER	(1) chocolate
TMA993,319	LINDT MASTER CHOCOLATIER	(1) chocolate

[15] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition, if one or more of the registrations relied upon are in good standing. Furthermore, the Registrar has the discretion to check the register in order to confirm the existence of any registrations relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Having exercised the Registrar's discretion, I confirm that the Opponent's registrations relied upon under this ground are in good standing as of the date of this decision.

[16] Since the Opponent has satisfied its initial onus, the issue becomes whether the Applicant has met its legal burden to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and any of the Opponent's relied upon trademarks.

[17] In considering the issue of confusion, I will focus on the Opponent's registered trademarks TMA377,673 and TMA837,071 (the CHOCOLATE MASTERS Marks), as I consider these trademarks to represent the Opponent's best chance, given that they have the closest relationship to the Mark in terms of the degree of resemblance.

Meaning of Confusion between Trademarks

[18] Trademarks are confusing when there is a reasonable likelihood of confusion within the meaning of section 6(2) of the Act:

The 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 class or appear in the same class of the Nice Classification.

[19] Thus, section 6(2) does not concern mistaking one mark for the other, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether purchasers of the goods and services, sold under the Mark, would believe that those goods or services were produced or authorized or licensed by the Opponent who sells its goods and services under the CHOCOLATE MASTERS Marks.

Test for Confusion

[20] The test for confusion is 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 they have no more than an imperfect recollection of the opponent's trademark. This casual, hurried consumer 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 at para 20].

[21] Applying the test for confusion is an exercise in finding facts and drawing inferences [*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at para 102]. All surrounding circumstances of the case must be considered, including those listed at section 6(5) of the Act, namely: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods, services or business; the nature of the trade; and the degree of resemblance between the trademarks including in appearance or sound or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered, although they are not necessarily attributed equal weight [see *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 54; and *Veuve Clicquot, supra* at para 21].

Section 6(5)(a) – inherent distinctiveness and extent known

[22] The overall consideration of the section 6(5)(a) factor involves a combination of inherent and acquired distinctiveness of the parties' marks.

[23] The Applicant submits that both parties' trademarks have a low degree of inherent distinctiveness. In this regard, the Applicant submits that the word CHOCOLATE clearly indicates the nature of the Opponent's goods, and that the word MASTER, defined as "to

become skilled or proficient in the use of” (per Merriam-Webster Online Dictionary), indicates that the Opponent is “proficient in the use of” chocolate. The Applicant submits however, that its Mark is a unique combination of the English word MASTER and the French word CHOCOLAT, which adds distinctiveness to the Mark and does not offend section 12(1)(b) of the Act. Further to this, the Applicant submits that although the word PURE is suggestive that the Applicant’s products are free of impurities, the addition of this word in combination with MASTER CHOCOLAT adds distinctiveness to the Mark as a whole.

[24] The Opponent, on the other hand, submits that its CHOCOLATE MASTERS Marks are “fairly distinctive”, in that the words CHOCOLATE MASTERS are a unique combination of words that are not clearly descriptive of the Opponent’s goods and services. The Opponent further submits that the evidence shows that no other trader in Canada uses the term “chocolate masters” in connection with such goods and services. The Opponent submits that the Mark, likewise, possesses some distinctiveness, as it too is not clearly descriptive of its associated goods and services. The Opponent submits however, that with respect to the marks’ inherent distinctiveness, this factor does not favour either party.

[25] I agree that both parties’ marks are not inherently strong, and that this consideration does not favour either party. As both parties’ have submitted, both parties’ marks are comprised of descriptive and suggestive terms. Furthermore, I do not consider that the combination of English and French terms, in the present case, nor the addition of the word PURE, adds any material degree of distinctiveness to the Mark.

[26] In any event, the strength of a trademark may be increased by means of its becoming known through promotion or use.

[27] The Application for the Mark is based upon proposed use in Canada in part, as well as use in Canada since March 31, 2017 in part (see Schedule A to this decision for complete particulars). The Applicant has filed evidence under the Callebaut affidavit regarding use of the Mark in Canada.

[28] In his affidavit, Mr. Callebaut explains the origin of the Mark. In this regard, he attests that during his years as a Master Chocolatier, he became well known for his luxury chocolates and, as a result, acquired the nickname “Papa Chocolat” from his customers and admirers. He states that the name Master Chocolat was chosen to connect his Master Chocolatier status to

his Papa Chocolat nickname, and that the word “Pure” was added to indicate that the products were sourced from quality ingredients.

[29] Mr. Callebaut then explains that the Applicant is known for its handmade luxury chocolates, which it sells through its factory and retail locations as well as online through its website and through wholesale clients. He states that the Applicant has been operating under the trade name and trademark Master Chocolat since November of 2015, with three Master Chocolat store locations in Calgary, Alberta. As evidence of use of the Mark, he provides the following:

- A depiction of the logo as shown below. He states that the Applicant has used a “Diamond logo” on its chocolate products, with different variations, but which always includes the words MASTER CHOCOLAT in large and distinctive font, which is different from the other fonts in the Diamond logo. He states that the Applicant began using this Diamond logo in March 2017 on chocolate products:



- Photographs of the Applicant’s storefronts in Calgary, Alberta (Exhibit D). The Mark clearly appears on signage for the store, as depicted in the Diamond logo above;
- Representative depictions and photographs of packaging for chocolate products displaying the Mark (Exhibit E), as depicted in the above Diamond logo;
- Copies of the Applicant’s Valentine’s Day and Easter product offerings 2021 product catalogue featuring chocolate products displaying the Mark on packaging, as depicted in the above Diamond logo (Exhibits H);
- Printouts from the Applicant’s website featuring chocolate products sold on the website captured on February 17, 2021 (Exhibit I). He states that the Applicant has been promoting the Mark on this site since 2017;

- Printouts from the Applicant's Facebook and Instagram pages which he states were created in 2015 and have been used to promote the Mark since 2017 (Exhibits J and K);
- An article title "Master Chocolat Sweet Success" which includes depictions of chocolate products displaying the Mark, as in the Diamond logo above, published in the December 2019 issue of Business in Calgary Magazine (Exhibit L);
- Proofs of ads featured in Avenue magazine, distributed in Calgary and Edmonton in 2015, 2017, 2018, and 2020 (Exhibit N). The 2017 and 2018 ads feature chocolate products displaying the Mark, as in the Diamond logo above. He states that he was told by this magazine that it prints 37,000 magazines per month with an average of 188,700 readers;
- A Master Chocolat corporate gift brochure for 2019 featuring the Mark, as in the Diamond logo above (Exhibits O); and
- A sampling of photos of the Applicant's booths at various trade shows and venues, wherein the Mark, as in the Diamond logo above, is displayed on signage (Exhibit P).

[30] Mr. Callebaut states that since first using the Mark in March of 2017 in Canada on chocolate products, the Mark has been used and promoted, and sales have significantly increased. He provides a chart of sales figures for the years 2015 to 2020 for all MASTER CHOCOLAT branded products which includes sales of products branded with the Mark between March 2017 and December 31, 2020. Sales range from \$762,678 in 2017 to \$1,845,158 in 2020.

[31] Lastly, Mr. Callebaut provides a breakdown of advertising expenditures for the Applicant's MASTER CHOCOLAT and MASTER CHOCOLAT PURE brands for the years 2015 to 2020. Advertising expenditures range from \$6,710 in 2017 to \$19,620 in 2020.

[32] In view of Mr. Callebaut's evidence, I accept that the Mark has become known to some extent in Calgary, Alberta.

[33] On the other hand, with respect to the Opponent's relied upon marks, the Applicant submits that the Opponent has not provided a single specimen showing use of its CHOCOLATE MASTERS Marks since the Opponent acquired these marks from Barry Callebaut in 2018. Furthermore, the Applicant submits that prior to the assignment to the Opponent, these marks

would have benefitted from the goodwill created from the World Chocolate Masters competitions in Canada (as evidenced in the Premji affidavit). The Applicant submits that given the lack of evidence of a single sale of chocolate products under these marks since May 13, 2014, it is likely that, if the relevant public in Canada recognizes the CHOCOLATE MASTERS Marks at all, they associate it with Barry Callebaut AG, and not the Opponent. In contrast, the Applicant submits that it has been selling luxury chocolates under the trademark Master Chocolat Pure since March of 2017, and as such, the Applicant's Mark is more well known than the Opponent's registered marks.

[34] The Opponent submits that the Wu affidavit shows that both the Opponent and its predecessor in title Barry Callebaut have used the CHOCOLATE MASTERS Marks in Canada. In this regard, in her affidavit, Ms. Wu attests that in 2018, Barry Callebaut AG assigned all of its rights, title and interest in and to these marks to the Opponent. According to the claims made in these registrations, Barry Callebaut AG and its predecessor-in-title, Barry Callebaut Decorations B.V. used the CHOCOLATE MASTERS Marks in Canada in association with chocolate and chocolate products since at least as early as December 2009.

[35] Ms. Wu attests that following the assignment of the CHOCOLATE MASTERS Marks in 2018, the Opponent has continued use of these marks in Canada with the associated chocolate products. In support, she provides under Exhibit E to her affidavit, what she describes as a bundle of representative mock-ups showing the Opponent's use, advertisement, and promotion of the CHOCOLATE MASTERS Marks in Canada, representative of the signage displayed at LINDT Chocolate Shops in Canada in 2019.

[36] Ms. Wu further attests that the Opponent's trademark agents have informed her that the Applicant's former trademark agents had commenced section 45 proceedings against the CHOCOLATE MASTERS Marks. She attests that the Opponent's predecessor-in-title, Barry Callebaut AG, filed evidence to maintain these registrations and attaches as Exhibit F (the affidavit of Jean-Jacques Berjot) to her affidavit, copies of that evidence. In addition, she attaches as Exhibit G to her affidavit, a copy of the section 45 decision issued by the Trademarks Opposition Board on August 28, 2018, maintaining the registrations of the CHOCOLATE MASTERS Marks.

[37] Notwithstanding admissibility considerations concerning the evidence filed in the aforementioned section 45 proceedings [see *Springwall Sleep Products Ltd v Ther-A-Pedic*

Associates, Inc (1983), 79 CPR (2d) 227 (TMOB) regarding factors to consider in determining what weight should be given to evidence filed in other proceedings], the evidence in that case was only deemed to show use of the CHOCOLATE MASTERS Marks at some point in the three year period preceding the date of the notice (April 13, 2016). There is no evidence to support continuous use of the Opponent's relied upon marks since this time period. Indeed, the Applicant points out that the evidence filed in the prior section 45 proceeding, includes as the most recent evidence of use, an invoice dated May 13, 2014. Furthermore, the evidence filed in the prior section 45 proceedings did not concern, nor can any inferences be made from such evidence regarding the extent to which the CHOCOLATE MASTERS Marks would have become known in Canada at that time.

[38] With respect to Ms. Wu's evidence of use of the CHOCOLATE MASTERS Marks by the Opponent since acquiring these marks in 2018 (Exhibit E mock ups), this evidence is only representative of signage displayed at LINDT Chocolate Shops in Canada in 2019. As submitted by the Applicant, the evidence does not provide details concerning the extent of such advertising (placement and number of stores). Moreover, I note that there is no evidence concerning the sale of the registered goods in association with the CHOCOLATE MASTERS Marks. Consequently, I am unable to conclude to what extent, if at all, the Opponent's CHOCOLATE MASTERS Marks have become known in Canada.

[39] Having regard to the aforementioned, while the inherent distinctiveness factor does not favour either party, the acquired distinctiveness factor favours the Applicant.

Section 6(5)(b) – the length of time of use

[40] The Applicant submits, as previously indicated, that the Opponent did not provide any evidence that the CHOCOLATE MASTERS Marks have been used in Canada on a chocolate product since acquiring the marks in 2018, and the last evidence of use was by a predecessor-in-title, found in the affidavit of Jean-Jacques Berjot, in the form of an invoice dated May 13, 2014. The Applicant submits that, on the other hand, it has been selling luxury chocolates under the Mark since March 2017.

[41] The Opponent relies on use of its CHOCOLATE MASTERS Marks by its predecessor-in-title since 2009, as per the claims made in the registrations. However, it has been held that the Registrar can only infer a *de minimis* use of a registered trademark from the certification of registration [see *Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427

(TMOB)]. Moreover, to the extent that any weight could be afforded to the Berjot affidavit (attached as Exhibit E to the Wu affidavit), that evidence (which includes invoices dated in 2013 and 2014) does not ultimately significantly favour the Opponent.

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

[42] When considering sections 6(5)(c) and (d) of the Act, it is the statements of goods as defined in the application for the Mark and 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)].

[43] The Applicant submits that the Opponent's products are intended for baking and are not a finished boxed chocolate product such as the Applicant's products. In support, it refers to paragraph 9 of the Berjot affidavit, which refers to the Opponent's normal course of trade being with customers described as "wholesale distributors servicing the bakery and pastry industries", "a supplier of food products and food ingredients for, *inter alia*, cakes and pastry" and "a wholesaler of baker products including gourmet chocolate".

[44] In light of the difference in the nature of the parties' goods, the Applicant submits that such goods would be sold in different areas of a grocery stores: with the Opponent's chocolate sprinkles, shaving, and decorations being sold in the baking section, whereas the Applicant's products are finished products meant to be eaten right away and sold in the candy section. The Applicant relies on the cases of *Van Melle Nederland BV v Principal Marques Inc* (1998), 87 CPR (3d) 368 (TMOB), *Clorox Co v Sears Canada Inc (TD)*, 1992 CanLII 14802 (FC), and *Loblaws Inc v 676166 Ontario Limited*, 1999 CanLII 19566, as examples where it was determined that the public would be able to distinguish between the parties' goods, particularly in association with weak trademarks, and where as here, it submits, such goods would not be sold in the same section of a grocery store.

[45] The Opponent, on the other hand, submits that the goods need not be identical, but only need to be similar enough [citing *Henkel Kommanditgesellschaft, supra Auf*, and *Clorox Co v El du Point de Nemours & Co* (1995), 64 CPR (3d) 79 at 85 (FCTD)]. In this regard, the Opponent submits, and I agree, that it is readily apparent that the parties' goods overlap – both deal in chocolate and various chocolate products in Canada. Furthermore, the Opponent submits that if the goods are the same or very similar, as in the present case, there is a logical inference that

the nature of the trade is also likely to be substantially the same, and confusion is more likely [citing *Opus Building Corp v Opus Corp* (1995), 60 CPR (3d) 100 at 104 (FCTD) and *Top Notch Construction Ltd v Top-Notch Oilfield Services Ltd*, 2001 FCT 642 at para 24].

[46] In reply to the Applicant's submission that the Opponent's goods are intended for baking and are not finished boxed chocolate products like the Applicant's goods, the Opponent submits that the goods in its registrations are not restricted to merely ingredients for final products, nor do the registrations have restrictions as to channels of trade. Furthermore, the Opponent submits that there is nothing in the evidence to suggest that such products would be found in different sections of grocery stores. Thus, the Opponent submits that the present case is distinguishable from *Van Melle* and *Loblaws*, *supra*, as in those cases, there was actual evidence that the parties' goods were sold in different sections of the same grocery store [and while *Van Melle*, *supra*, was overturned on appeal, findings on channels of trade were not disturbed]. In addition, the Opponent submits that the case of *Clorox*, *supra*, is also distinguishable, on the basis that the goods in question (e.g. – BBQ sauce and fruitcake) were as different as "chalk and cheese". Once again, I agree.

[47] In addition to overlap or similarity between the goods, the Opponent submits that both parties sell through the same wholesale distribution points. In this regard, the Opponent submits both the Wu affidavit (at para 17) and the Callebaut affidavit (para 12) identify Loblaws, for example, as purchasers of their respective products. I note that both parties have also identified convenience stores and mass merchandisers, in addition to grocery stores and other retailers, as channels through which its products are sold (Wu affidavit, para 17, and Callebaut affidavit, para 12). Thus, not only are there no restrictions as to the parties' channels of trade (in the application for the Mark and in the Opponent's registrations), the evidence shows that there is actual overlap in channels in trade of their respective products.

[48] Having regard to the aforementioned, I find these factors favour the Opponent.

Section 6(5)(e) – the degree of resemblance

[49] The Applicant submits that there are several important differences between the Mark and the Opponent's CHOCOLATE MASTERS Marks. To begin with, the Applicant submits that there are differences in appearance and sound due to the reversed order of the words in the parties' marks, noting that the first word is different and when assessing confusion, the first word

or syllable in a trademark is generally the most important for the purpose of confusion. As a further point of distinction, the Applicant notes the addition of the word PURE in the Mark.

[50] With respect to ideas suggested, the Applicant submits that the word Master in its Mark is used as an adjective, while in the Opponent's CHOCOLATE MASTERS Marks, it is used as a noun. Further to this, the Applicant submits that the Opponent's CHOCOLATE MASTERS Marks, when used in connection with the Opponent's chocolate products, suggest that these products were created by a "Chocolate Master", or is to be used by bakers (i.e., "Chocolate Masters) to create a finished chocolate based product. The Applicant submits, on the other hand, the Mark suggests that the Applicant's associated products are produced by a person with the nickname "Master Chocolat", and the word PURE suggests that the products are made from quality ingredients, free from impurities.

[51] The Applicant submits that when two marks have a low degree of inherent distinctiveness, small differences, such as in the case at hand, are enough to distinguish them [citing *Provigo Distribution Inc v Max Mara Fashion Group SRT* (2006), 46 CPR (4th) 112 at para 31 (FCTD)].

[52] The Opponent submits that but for the inverted order of the words, the Anglicization of "CHOCOLATE", the pluralization of "MASTER", and the mere addition of the strongly suggestive term "PURE", the parties' marks are identical. Furthermore, the Opponent submits that as a word mark, the Mark may be rendered in any style or typeface, including in an italic, cursive font like that in which the Opponent's registered trademarks are rendered.

[53] The Opponent submits that the Mark essentially incorporates the Opponent's marks in their entirety, albeit with an inversion of two elements, and the mere addition of a strongly suggestive term. The Opponent notes that it has been held that such an inversion of words, is not likely to significantly diminish the degree of resemblance in appearance, when sounded, or in the idea suggested between the marks [citing *NetSuite Inc v Infor (US), Inc*, 2019 TMOB 130 at para 46, citing *The Clorox Company of Canada, Ltd v Escola de Nataç o E Ginastica Bioswin Ltda*, 2017 TMOB 173 at para 36].

[54] The Applicant submits that the *Netsuite* and *Clorox* cases relied upon by the Opponent are distinguishable, in that the surrounding circumstances in those cases, unlike the present case, may not have been enough to avoid confusion. Of course, each case must be decided on its own merits and, in doing so, I will have regard to all surrounding circumstances.

[55] Additionally, the Opponent submits that the idea conveyed by the parties' marks is similar; both parties' marks suggest a mastery of chocolate or of chocolate making. The Opponent further submits, that the parties' marks also possess a titular quality, as both marks sound like the title of one who is proficient (indeed, masterful) in chocolate-making. Thus, the Opponent submits that the parties' marks bear a strong resemblance in the ideas suggested by them, as both marks convey the general idea that the parties offer chocolate products of the highest quality.

[56] Although the parties' trademarks are not identical, when considered as a whole, they are highly similar in appearance, given that they both include the word MASTER, or its plural, and the word CHOCOLAT or its English equivalent. Furthermore, whether the word "master" in the parties' marks is a noun or an adjective, does not detract from the overall idea that the parties' chocolate products are produced with mastery. Lastly, I agree with the Opponent's submission that the word PURE does not enhance the inherent distinctiveness of the Mark as to prevent any reasonable likelihood of confusion. Moreover, as noted by the Opponent, it is open to the Applicant to use the Mark in any font, design or feature the owner chooses [*Masterpiece* at para 55; *Pizzaiolo Restaurants Inc v Les Restaurants La Pizzaiolle Inc*, 2016 FCA 265 at paras 26-33]. Indeed, in this case, notwithstanding the highly suggestive nature of the word PURE, the manner in which the Applicant has actually used and displayed the Mark, as shown in the evidence, gives greater prominence to the words MASTER CHOCOLAT.

[57] Consequently, I find that there is a strong degree of resemblance between the parties' marks in appearance, sound, and in ideas suggested.

Surrounding Circumstance – state of the register and marketplace

[58] The Applicant submits that, per the Premji affidavit, the words CHOCOLATE MASTERS appear to be commonly used to describe those adept at making chocolate creations. In particular, the Applicant submits that the Premji affidavit located websites displaying this term, including the Ecole Chocolat located in Vancouver, British Columbia, with a video series from this school on chocolate making called "Chocolate Masters", and the "World Chocolate Masters" competition, which has a Canadian preselection held at the Chocolate Academy in Montreal. Quebec.

[59] Further to this, the Applicant submits that the state of the register evidence under the Torres and James affidavits, shows that the word MASTER is commonly used in the food

industry, including 44 such trademarks that contain the word MASTER and specifically reference chocolate, desserts, baked goods, or pastries in the list of goods. The Applicant submits that the Canadian Common Law Library portion of the search also located 75 uses of the word MASTER in business names at common law in Canada in connection with food, with four specifically for chocolate (SWISS-MASTER CHOCOLATIER for groceries, CHOCOLATE MASTERS INC. for food products, LADERACH SWISS-MASTER CHCLTR for chocolate, and CHOCOLATIER SWISS-MASTER for chocolate). Lastly, the Applicant points to 43 webpages featuring the word MASTER in connection with food products in Canada located through the Web Common Law portion of the search.

[60] The Applicant submits that this evidenced and significant, commonplace use of the word MASTER, detracts from any resemblance between the parties' marks, and that it is valid to make inferences about the marketplace when large numbers or relevant registrations are located (as the Applicant notes was held in *Great Atlantic & Pacific Co. of Canada Ltd v Effem Foods Ltd* (1993) CarswellNat 2546, 49 CPR (3d) at 13 re: the word MASTERS in relation to food products].

[61] The Opponent submits however, that the Premji affidavit only discloses two traders who allegedly use the term "chocolate masters" [Ecole Chocolat and the organizer of the World Chocolate Masters chocolate-making competition]. The Opponent submits that neither of traders uses the term in Canada in association with chocolate confectionery products, or the manufacture or sale of chocolate confectionery products. Thus, the Opponent submits, it is alone in its use of the trademark CHOCOLATE MASTERS in Canada in association with such goods. In any event, the Opponent submits, the mere fact that two other traders located throughout the world may be using CHOCOLATE MASTERS is not sufficient to demonstrate that the term is "commonly used" in the Canadian marketplace.

[62] Furthermore, with respect to the state of the register evidence, the Opponent directs attention to *Anheuser-Busch LLC v Molson Canada 2005*, 2016 TMOB 176, in which the opponent's evidence in that case, as here, focused on one component of the applicant's trademark as opposed to the mark in its entirety. More specifically, evidence of 16 third-party marks in Canada that included one component of the applicant's trademark, was not deemed to be enough to show that the words that made up the mark as a whole were commonly used in the trade. The Opponent submits that ultimately, the Applicant has only proffered seven

websites and one registration as evidence, and that this is insufficient [per *Kellogg Salada Canada Inc v Canada (Registrar of Trademarks)*, 43 CPR (3d) 349 (FCA)].

[63] State of the register evidence favours an applicant when it can be shown that the presence of a common element in marks would cause consumers to pay more attention to the other features of the marks, and to distinguish between them by those other features [*McDowell v Laverana GmbH & Co KG*, 2017 FC 327 at para 42]. Inferences regarding the state of the marketplace may be drawn from such evidence in two situations: a large number of relevant registrations are located; and/or there is evidence of common use in the marketplace of relevant third party marks [*Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA); *McDowell, supra* at paras 41-46]. Relevant trademarks include those that are (i) registered; (ii) are for similar goods and services as the marks at issue, and (iii) include the component at issue in a material way [*Sobeys West Inc v Schwan's IP, LLC*, 2015 TMOB 197].

[64] In the present case, I agree with the Opponent that nearly all of the trademarks identified in the search results attached to the Torres and James affidavits are not relevant. Many are for very different goods and/or services, and many are quite distinct from the Mark as a whole, owing to other components. It is true that the element “master(s)” is common in the marketplace, and as such, consumers would pay more attention to other features of the marks. However, in the present case, the *only* other feature of both parties’ marks is the word CHOCOLAT(E). As such, I agree with the Opponent that any relevant trademarks identified in the Applicant’s state of the register evidence, are trademarks that incorporate both MASTER(S) and CHOCOLAT(E). When doing so and considering only those marks that are registered and are for similar or related goods and services, there are simply not enough relevant trademarks to conclude that consumers are accustomed to distinguishing such highly similar marks. Consequently, I do not find this is a circumstance that favours the Applicant.

Surrounding Circumstance – no instances of actual confusion

[65] The Applicant submits that it is not aware of any instances of actual confusion in the marketplace. The Applicant notes that the absence of evidence of actual confusion over a relevant period of time, despite an overlap in the parties’ goods, services, and channels of trade, may entitle the Registrar to draw a negative inference about the likelihood of confusion.

[66] The Opponent submits that evidence of actual confusion is not necessary to establish a likelihood of confusion. In any event, the Opponent submits that the Applicant “has failed to

establish that any such incidents [of actual confusion] would have come to the attention of the [A]pplicant or that there was any procedure in place for the reporting of such incidents”.

Furthermore, the Opponent submits that Mr. Callebaut has made bald claims in this regard, and as these statements are made on personal opinion and belief, they carry little or no weight in evidence.

[67] In the present case, I am not prepared to draw a negative inference from the lack of evidence of actual confusion. The Applicant’s evidence predominantly demonstrates that it has used its Mark in Calgary, Alberta. The Opponent’s evidence on the other hand, is sparse with respect to use of its relied upon trademark. Thus, I am unable to determine whether the parties’ trademarks truly coexisted in the same marketplace over a sufficient period of time, in order to draw any meaningful conclusions regarding coexistence without confusion.

Conclusion

[68] Having considered all of the surrounding circumstances, I find the likelihood of confusion is, at best for the Applicant, evenly balanced. I reach this conclusion in view of the strong degree of resemblance between the trademarks MASTER CHOCOLAT PURE and CHOCOLATE MASTERS, the fact that the parties’ goods are similar and overlapping, and that the parties’ channels of trade overlap.

[69] Although the inherent distinctiveness of the parties’ marks is low, and as the Applicant submits, small differences are sufficient to distinguish between trademarks of low distinctiveness, the differences between the trademarks at issue, in my view, are not large enough to make it likely that consumers will be able to distinguish between them. Indeed, the addition of the highly suggestive, if not descriptive, word PURE, does not mitigate this finding. Moreover, as previously discussed, the manner in which the Applicant has actually used and displayed the Mark, as shown in the evidence, gives greater prominence to the words MASTER CHOCOLAT. Lastly, while the Opponent has not demonstrated that its relied upon marks have acquired distinctiveness, the Applicant has not shown that the particular combination of the words CHOCOLAT(E) MASTER(S) is commonly used in the marketplace.

[70] As I have concluded that a likelihood of confusion exists between the Mark and the Opponent’s CHOCOLATE MASTERS Marks, I will not consider the Opponent’s remaining relied upon trademarks under this ground of opposition.

Sections 16(1)(b) and 16(3)(b) Grounds of Opposition

[71] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark pursuant to sections 16(1)(b) and 16(3)(b) of the Act because, at the filing date of the Application, it was confusing with the Opponent's trademarks MASTER CHOCOLATIER and MAÎTRE CHOCOLATIER (App. Nos. 1,773,029 and 1,773,030 respectively), in respect of which applications for registration had been previously filed in Canada.

[72] With respect to these grounds, the Opponent has an initial burden of establishing that one or more of its relied-upon applications was filed prior to the filing date of the Application (*i.e.*, February 14, 2018), and was not abandoned at the date of advertisement of the Application for the Mark (April 14, 2021) [section 16(4) of the Act]. The Registrar has the discretion to check the Register in order to confirm the existence of the applications relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[73] The Opponent has met its evidential burden with respect to both of its relied upon trademarks under this ground of opposition, as both trademarks were previously applied for on [March 18, 2016]. While application No. 1,773,029 (MASTER CHOCOLATIER) has subsequently been abandoned, it was pending as of the advertisement date of the Application for the Mark. The abandonment, however, is not a factor to be considered in assessing the likelihood of confusion under this ground, as it occurred after the material date [see *ConAgra Inc v McCain Foods Ltd* (2001, 14 CPR (4th) 288 (FCTD); *Corporativo de Marcas GJB v Bacardi & Company Limited*, 2015 TMOB 51; *Starbucks (HK) Limited v Rogers Broadcasting Limited*, 2013 TMOB 114; and *Jarrow Formulas, Inc v Canada Bread Company, Limited*, 2015 TMOB 67].

[74] As the Opponent has satisfied its initial burden, the Applicant must therefore establish, on a balance of probabilities, that as of the date of filing of the Application, namely, June 1, 2017, there was not a reasonable likelihood of confusion between the Mark and either of the Opponent's relied upon trademarks, MASTER CHOCOLATIER or its French language equivalent, MAÎTRE CHOCOLATIER.

Section 6(5)(a) – inherent distinctiveness and extent known

[75] The Applicant submits that both parties' trademarks have a low degree of inherent distinctiveness. The Opponent submits that, with respect to the marks' inherent distinctiveness, this consideration favours neither party.

[76] I agree that both parties' marks have a low degree of inherent distinctiveness, in view of their descriptive and suggestive terms. I would add however, that the Opponent's MASTER CHOCOLATIER mark and its French language equivalent, in my view, have an even lesser degree of inherent distinctiveness. The term MASTER CHOCOLATIER, and its French language equivalent, as the Applicant has noted from the Opponent's own evidence (product label descriptions), appears to be an industry term used to describe one who has mastered or perfected skills as a chocolatier. This also follows from the following definitions as found in *The Canadian Oxford Dictionary* (2 ed) online:

Master: a person skilled in a particular trade and able to teach others. A person highly accomplished in a particular skill, activity, etc.

Chocolatier: a maker or seller of chocolate, esp. of fine quality.

[77] In any event, the strength of a trademark can be increased by making it known through promotion and use. As previously indicated, the Application for the Mark is based upon proposed use in Canada, in part, as well as use in Canada with respect to certain goods and services (for application particulars, see Schedule B to this decision). With respect to the used in Canada claims, the claimed date of first use of the Mark is approximately two months prior to the filing date of the applications.

[78] The Applicant's evidence of use of its Mark was previously detailed under the section 12(1)(d) ground of opposition. Suffice it to say that as the Applicant's use of the Mark only began very shortly before the Application was filed, the Mark would not have acquired much distinctiveness as of the filing date of the Application.

[79] With respect to the Opponent's relied upon trademarks, evidence pertaining to use and promotion of the MASTER CHOCOLATIER and MAÎTRE CHOCOLATIER marks is found in the Wu affidavit. In her affidavit, Ms. Wu attests that the Opponent has extensively used, advertised, and promoted these marks in Canada in association with chocolate products since 1999. She states that since this time, the Opponent has prominently displayed these marks on product

packaging, as well as on its dedicated Lindt Chocolate Shops. In support, she provides the following:

- Exhibit C - representative mock-ups of packaging. The packaging includes phrases such as “Our Master Chocolatiers have showcased our smooth melting Lindor in a beautiful gold tray [...]”, “LINDOR, created by Lindt’s Master Chocolatiers”, and “Behind each numbered door there is a delicious Lindt chocolate hand crafted by the Lindt Maitre Chocolatiers”. The only other reference to MASTER CHOCOLATIER or MAÎTRE CHOCOLATIER that appears in various colours on the packaging, is as follows (the Lindt logos):



- Exhibit D - representative photographs of various LINDT Chocolate Shops in Canada, which she attests is representative of the manner in which all 57 such shops in Canada prominently display the MAITRE CHOCOLATIER trademark. The store signage displays the first Lindt logo as identified above on the Exhibit C packaging;
- Substantial sales figures for all of the chocolate confectionary products sold through LINDT Chocolate Shops in Canada between 2006 and 2018, and substantial wholesale sales figures for the years 2010 to 2018, of all of the chocolate confectionery products sold through “wholesale distribution points” (including gas stations and convenience stores, drugstores, grocery stores, mass merchandisers such as Loblaws and Walmart, and warehouse club stores such as Costco). Ms. Wu attests that to her knowledge, almost all of the chocolate confectionery products sold in Canada since 2006 prominently displayed the MASTER CHOCOLATIER Marks on their packaging, or were otherwise associated with the MASTER CHOCOLATIER Marks at the point of sale (Wu affidavit, paras 16 to 19);

- Substantial advertising figures for confectionery products bearing the MASTER CHOCOLATIER Marks in Canada (Wu affidavit, para 20);
- Exhibits H to K - representative samples of advertising and promotion of the MASTER CHOCOLATIER Marks in Canada at high-profile events such as Stars on Ice, the Rogers Cup, and the Toronto International Film Festival, dating between 2011 and 2019. The advertising and promotion samples display the first Lindt logo as identified above on the Exhibit C packaging, with the exception of one instance at a sampling booth at the Rogers Cup in 2011 that displays the following:



; and

- Exhibit L – images of packaging of confectionary products shown in a Powerpoint presentation regarding the Opponent's sponsorship of professional sports teams in Canada, including the Montreal Canadiens, the Toronto Maple Leafs, and the Vancouver Canucks. Such products were produced in partnership with these sports teams, and advertised and sold at these teams' arenas, as well as at Lindt Chocolate Shops since 2011. Once again, the packaging displays the first Lindt logo, as identified on the Exhibit C packaging.

[80] The Applicant submits that Ms. Wu's evidence does not constitute trademark use of the MASTER CHOCOLATIER and MAÎTRE CHOCOLATIER marks. To begin with, the Applicant submits that although the words MAÎTRE CHOCOLATIER appear on the Lindt logos (as identified above from Exhibit C to the Wu affidavit), these words never appear on their own. I agree with the Applicant that the words MAÎTRE CHOCOLATIER are always accompanied by the words "SUISSE DEPUIS 1845" or "DEPUIS 1845", and that the term Lindt & Lindt & Sprungli are the dominant words in the logos.

[81] The Applicant further submits that the phrases that include reference to "Lindt's Master Chocolatiers", do not constitute trademark use, as they are purely informational, namely, that the chocolates are crafted by Master/Maitre Chocolatiers.

[82] I agree with the Applicant, that the way the Opponent's marks appear throughout the Wu affidavit, raises questions as to whether the public would perceive these marks as being used

per se [re *Nightingale Interloc Limited v ProDesign Limited* (1984), 2 CPR (3d) 535 (TMOB)]. Indeed, there is only one instance in the Wu affidavit, wherein the terms Lindt Maître Chocolatier appear on their own, with Lindt appearing in a different size and style of font as the words “Maître Chocolatier” (Wu affidavit, Exhibit I). Consequently, it is not clear the extent to which consumers would recognize the MASTER CHOCOLATIER and MAÎTRE CHOCOLATIER marks *per se*, and the degree with which they were made known in Canada as of the material date.

[83] Consequently, this factor does not favour either party.

Section 6(5)(b) – the length of time of use

[84] For the reasons discussed under the section 6(5)(a) analysis, this factor does not materially favour either party.

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

[85] The analysis of this factor remains the same as that under the section 12(1)(d) ground of opposition. Accordingly, these factors favour the Opponent.

Section 6(5)(e) – the degree of resemblance

[86] The Applicant submits that the parties’ marks are different in sound, appearance, and ideas suggested. The Applicant submits that the only word in common in the parties’ marks is the word MASTER (or its French language equivalent), and the remaining component of the parties’ marks, “chocolat” and “chocolatier” respectively, are different words, with different meanings. That is, “chocolat” is French for chocolate and is a food product, while a “chocolatier” is the profession of a person who creates chocolate.

[87] In addition, the Applicant submits that the parties’ marks, as a whole, have different meanings. In this regard, the Applicant submits that the Mark is suggestive of a nickname (i.e. – “Papa Chocolat” who is a Master Chocolatier). However, with respect to the Opponent’s MASTER CHOCOLATIER and MAÎTRE CHOCOLATIER marks, the Applicant submits that these terms clearly describe to the consumer, that the chocolate products are produced by Master/Maitre Chocolatiers (Maitre being the French word for “master”). In support, the Applicant refers to definitions of the word chocolatier (from *dictionary.com* and Merriam-Webster online) as well as an entry from Wikipedia describing the Master Chocolatier designation

[Jamieson affidavit, Exhibits K, L, and M). As such, the Applicant submits, these words cannot be claimed by any one trader who produces chocolate, and these words by themselves are not registrable per section 12(1)(b) of the Act (i.e. - clearly descriptive of “persons employed”).

[88] The Opponent, on the other hand, submits that the parties’ marks are very similar when read, and when sounded, and that save for the suffix IER, are practically identical. The Opponent further submits that the ideas are the same, being that of a mastery of chocolate making. Moreover, the Opponent submits that the Mark sounds like the title of someone who is a master of chocolate making.

[89] While the parties’ marks do have similarities, I agree with the Applicant that the marks, as a whole, are sufficiently different. Aside from visual and phonetic differences (chocolat vs chocolatier), the ideas suggested by the parties’ marks, although both related to chocolate, are distinct. As a matter of first impression, the Mark conveys the idea of mastery of a chocolate product, while the term MASTER CHOCOLATIER (and its French language equivalent) identifies a person, as it is the title designated to someone who has acquired a high level of skill in making chocolate.

[90] Consequently, I find this factor favours the Applicant.

Surrounding Circumstance – state of the register

[91] The Applicant submits that the state of the register evidence filed under the Jamieson affidavit shows that the word CHOCOLATIER is commonly used in the chocolate industry. The Applicant correctly notes that of the 37 marks located by Mr. Jamieson’s search, 29 are registered in association with chocolate products. Thus, I agree with the Applicant that it is reasonable to infer from the evidence that the term “Chocolatier” is commonly used in Canada in association with chocolate.

Surrounding Circumstance – no instances of actual confusion

[92] The Applicant submits that it is not aware of any instances of actual confusion in the marketplace. However, as per my reasoning under the section 12(1)(d) ground, I am not prepared to draw any negative inferences from the lack of evidence of actual confusion.

Conclusion

[93] Considering all of the surrounding circumstances, I conclude that the Applicant has satisfied its burden to prove, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's MASTER CHOCOLATIER and MAÎTRE CHOCOLATIER marks. I reach this conclusion despite the overlap in the parties' goods and channels of trade, as I find the parties' marks are sufficiently different in appearance, sound and ideas suggested.

[94] The inherent distinctiveness of the parties' marks is low, and as the Applicant submits, small differences are sufficient to distinguish between trademarks of low distinctiveness. The differences between the trademarks at issue under these grounds, unlike the CHOCOLATE MASTERS Marks, are large enough, in my view, to make it likely that consumers will be able to distinguish between them. Most particularly, the term "MASTER CHOCOLATIER", as previously discussed, is a term used to describe a person who has mastered or perfected skills as a chocolatier, a maker and seller of chocolate. Furthermore, the term "chocolatier" is commonly used in Canada by makers of chocolate. This idea is sufficiently different from that of the Mark, which conveys the idea of mastery over a chocolate product. Indeed, as the element "master" is common in the marketplace, consumers would pay more attention to the other features of the marks, which in the present situation, sufficiently distinguish the parties' marks.

[95] Having regard to the foregoing, the section 16(3)(a) ground is rejected with respect to the MASTER CHOCOLATIER and MAÎTRE CHOCOLATIER marks.

Section 16(1)(a) and 16(3)(a) Grounds of Opposition

[96] The Opponent alleges that pursuant to sections 16(1)(a) and 16(3)(a), the Applicant is not the person entitled to registration of the Mark, because at the date of filing of the application, the Mark was confusing with the Opponent's Marks, which had been previously and extensively used and made known in Canada by the Opponent or its predecessors in title prior to the date of filing of the Application in Canada.

[97] An opponent meets its evidential burden under section 16(1)(a) of the Act if it shows that as of the applicant's claimed date of use of its trademark in Canada, the opponent's trademark had been previously used or made known in Canada and had not been abandoned as of the date of advertisement of the applicant's application [Section 16(5) of the Act].

[98] With respect to the section 16(3)(a) ground, the Opponent has an initial burden of establishing that one or more of its trademarks alleged in support of this ground of opposition was used or made known prior to the filing date of the Application (namely, June 1, 2017), and was not abandoned at the date of advertisement of the Application for the Mark (in this case, July 18, 2018) [section 16(5) of the Act].

[99] I have already concluded that the Mark is not confusing with the Opponent's trademarks MASTER CHOCOLATIER and MAÎTRE CHOCOLATIER under the sections 16(1)(b) and 16(3)(b) grounds. Notwithstanding whether the Opponent has met its burden under these grounds, the same analyses concerning the likelihood of confusion would be applicable here, and extends to the Opponent's trademarks LINDT MASTER CHOCOLATIER and LINDT MAÎTRE CHOCOLATIER (which are even less likely to be confusing owing to the "Lindt" component). Thus, these grounds are rejected with respect to the Opponent's MASTER CHOCOLATIER Marks. Consequently, my analysis will focus solely on the Opponent's CHOCOLATE MASTERS trademarks.

[100] With respect to evidence of prior use or making known of the CHOCOLATE MASTERS Marks, as previously indicated, the Opponent relies on the Wu affidavit. Specifically, the Opponent relies on claims made in the registrations (particulars attached under Exhibit B to the Wu Affidavit), and evidence concerning use by the Opponent's predecessors-in-title as per previous section 45 proceedings [Exhibit F – copies of evidence filed by the Opponent's predecessor-in-title in section 45 proceedings, and Exhibit G – a copy of the section 45 decision issued by the Trademarks Opposition Board on August 28, 2018, maintaining the registrations of the CHOCOLATE MASTERS Marks].

[101] Concerning the claims made in these registrations, namely, that Barry Callebaut AG and its predecessor-in-title, Barry Callebaut Decorations B.V. used the CHOCOLATE MASTERS Marks in Canada in association with chocolate and chocolate products since at least as early as December 2009, such claims in registrations are not sufficient. Indeed, the Federal Court has cautioned against giving even *de minimis* weight to the dates of use claimed in a registration certificate (a certified copy of the registration was not filed in this case) [see *Tokai of Canada v Kingsford Products Company, LLC*, 2018 FC 951; and *Rooxs, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB)].

[102] Concerning evidence filed in other proceedings, the Registrar has previously accepted copies of affidavits filed in other proceedings where the circumstances justify such a course of action [see *Beachcombers Restaurant Ltd v Vita-Park Citrus Products Co* (1976), 26 CPR (2d) 282 (TMOB) and *Barbara's Bakery Inc v Sparkles Photo Ltd*, 2011 TMOB 28, 91 CPR (4th) 457]. The Registrar has also pointed to factors that have been considered in doing so, including (a) whether or not the parties to the proceedings are the same; (b) whether or not the trademark applied for is the same in both proceedings; (c) the availability of the affiant for cross-examination; and (d) whether or not all, or most, of the issues in both proceedings are the same [see *Springwall*, *supra*].

[103] In the present case, I am not prepared to place any weight on the affidavit of Mr. Berjot (Exhibit F to the Wu affidavit). While the parties to this proceeding involve the successor-in-title to the registered owner and the Opponent in that case and involve the issue of whether those specific trademarks of the Opponent were in use during the relevant period (such time period including a period of time predating the date of filing of the Application), Mr. Berjot is not available for cross-examination.

[104] Furthermore, I note that any findings the Registrar made in the section 45 proceeding are not evidence of use in the subject opposition. Each opposition decision before the Registrar must be decided on its own merits having regard to the evidence submitted in the particular case, which may differ from the evidence adduced in a prior case involving the same parties [see *Purafil Canada Ltd v Purafil, Inc*, 2012 TMOB 105 at para 20; and *Sunny Crunch Foods Ltd v Robin Hood Multifoods Inc* (1982) 70 CPR (2d) 244 (TMOB) at 249.]

[105] Having regard to the foregoing, I conclude that the Opponent has not met its initial burden, and therefore, this ground of opposition is also rejected with respect to the CHOCOLATE MASTERS Marks.

Section 2 Ground of Opposition

[106] The Opponent pleads that the Mark is not distinctive, since it does not actually distinguish nor is it adapted to so distinguish the goods and services of the Applicant from those of the Opponent, in view of the extensive use, promotion, advertising, and making known in Canada of the Opponent's Marks.

[107] There is an initial burden on the Opponent to establish that as of the filing of the opposition (in this case, July 2, 2019), one or more of the Opponent's Marks was known to a sufficient extent that could negate the distinctiveness of the applied-for-Mark [*Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427]. To do so, the Opponent must establish that one or more of its trademarks was either known to some extent in Canada or are well known in a specific area of Canada [*Bojangles, supra* at paras 33-34].

[108] I am not satisfied that the Opponent has met its initial burden. As per the discussion and analysis under the sections 12(1)(d) and 16 grounds, the Opponent's evidence of use of the CHOCOLATE MASTERS Marks is sparse and does not speak to the extent of use of these marks, and the evidence pertaining to the MASTER CHOCOLATIER Marks, does not demonstrate extensive use of these marks *per se*. Consequently, I am unable to conclude that any of the Opponent's Marks were known to a sufficient extent as of the material date.

[109] Having regard to the foregoing, this ground of opposition is rejected.

DISPOSITION

[110] Having regard to the aforementioned, 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.

Kathryn Barnett
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Application No. 1,840,459 for MASTER CHOCOLAT PURE:

Goods

- (1) Tins
- (2) Gift boxes and gift packaging, namely gift wrap, paper gift tags, gift cards, paper gift bags, paper gift wrap bows, and ribbons
- (3) Chocolate recipe cards and cookbooks
- (4) Chocolates, chocolate confectionary, cookies, and related items, namely, chocolate sauces, and chocolate-based spreads
- (5) Candy, ice cream, and cakes

Services



- (1) Operation of a business dealing in the sale of chocolates, chocolate confectionary, cookies, and related items, namely, chocolate sauces, chocolate-based spreads, gift boxes and gift packaging, namely, gift wrap, paper gift tags, gift cards, paper gift bags, paper gift wrap bows, and ribbons
- (2) Operation of a business dealing in the sale of candy, ice cream, cakes, and related items, namely, tins and chocolate recipe cards and cookbooks

Claims

- Used in CANADA since at least as early as March 2017 on goods (2), (4) and on services (1)
- Proposed Use in CANADA on goods (1), (3), (5) and on services (2)

SCHEDULE B

The Opponent's Marks:

The "MASTER CHOCOLATIER Marks":		
<u>Trademark</u>	<u>Application/ Registration No.</u>	<u>Goods/services</u>
MAÎTRE CHOCOLATIER	1,773,030	(1) chocolate
MASTER CHOCOLATIER	1,773,029	(1) chocolate
LINDT MAÎTRE CHOCOLATIER	TMA993,318	(1) chocolate
LINDT MASTER CHOCOLATIER	TMA993,319	(1) chocolate
The "CHOCOLATE MASTERS Marks":		
<u>Trademark</u>	<u>Application/ Registration No.</u>	<u>Goods/services</u>
	TMA377,673	(1) Chocolate and chocolate products namely chocolate cups, chocolate decorations, and chocolate shavings.
	TMA837,071	(1) Chocolate and chocolate products, namely chocolate cups, chocolate decorations and chocolate shavings.

Appearances and Agents of Record

HEARING DATE: 2023-06-08

APPEARANCES

For the Opponent: Graham Hood

For the Applicant: Carolyn Walters

AGENTS OF RECORD

For the Opponent: Smart & Biggar LLP

For the Applicant: Lawson Lundell LLP