

IN THE MATTER OF AN OPPOSITION
By Culinar Inc. To Application No. 855,601
Filed September 9,1997 by William Levene
Limited for registration of the trade-mark
CULINARE HOT CAFETIÈRE &Design

On September 9,1997, William Levene Limited (the «Applicant»)filed an Application to register the trade-mark CULINARE HOT CAFETIÈRE & Design (the «Application») as illustrated hereunder:



The Application was based on proposed use in association with the following wares:

« coffee pots and cafetières.»

The Applicant disclaimed the right to the exclusive use of the word CAFETIÈRE apart from the trade-mark as a whole.

The Application was advertised for opposition purposes in the November 11, 1998 issue of the Canadian Trade-marks Journal.

On December 11, 1998 Culinar Inc. (“the Opponent”) filed a Statement of Opposition to the application. The Statement of Opposition was forwarded to the Applicant on January 28, 1999.

The first ground of opposition contained in the Statement of Opposition is that the Application does not conform to the requirements of Section 30 (i) of the Trade-Marks Act R.C.S. c. T 13 (the «Act») because the Applicant could not have been satisfied at the time of the application that it was entitled to use the trade-mark CULINARE HOT CAFETIÈRE & Design in association with the abovementioned wares.

The second ground of opposition is that the trade-mark CULINARE HOT CAFETIÈRE & Design is not registrable, having regard to the provisions of Section 12(1)(d) of the Act in that it is confusing with the Opponent registered trade-marks: CULINAR registration no. 424 686, issued on March 4 1994; CULINAR & Design registration no. 237 739, issued on November 30 1979; CULINAR & Design registration no. 423 462, issued on February 25 1994 and CULINAR CANADA & Design registration no 495 031, issued May 21 1998.

The third ground of opposition is that pursuant to the provisions of Section 16(3)(a) of the Act, the Applicant is not entitled to register the trade-mark CULINARE HOT CAFETIÈRE & Design because it is confusing with the trade-marks CULINAR, CULINAR & Design, CULINAR & Design and CULINAR CANADA & Design previously used by the Opponent and its predecessor in title in association with its wares and services.

The fourth ground of opposition is that pursuant to the provisions of 16(3)(c) of the Act, the Applicant is not entitled to register the trade-mark CULINARE HOT CAFETIÈRE & Design because it is confusing with the trade-name CULINAR previously used by the Opponent and its predecessor in title in association with its wares and services.

The fifth ground of opposition is that the the trade-mark CULINARE HOT CAFETIÈRE& DESIGN is not distinctive within the meaning of Section 2 of the Act in that it does not distinguish nor is adapted to distinguish the wares of the Applicant from the wares and services of the Opponent.

Finally the Opponent alleges that it has not abandoned its trade-marks or trade-name.

The applicant filed and served a Counter Statement on March 17,1999 in which it essentially denied all of the opponent's grounds of opposition.

Each party advised the Opposition Board of their intention not to file any evidence. Only the Applicant filed written arguments. There was no oral hearing.

The material time for assessing the ground of opposition based on Section 12(1)(d) of the Act is the date of this decision [see: *Park Avenue Furniture Corp. v. Wickes/ Simmons Bedding Ltd.* (1991), *37 C.P.R. (3d) 413* (F.C.A.)]. The material time for assessing the non-entitlement ground of opposition is the filing date of the application, in this case, September 9,1997 [see Section 16 of the Act]. The material time for assessing the issue of distinctiveness is generally accepted to be the date of filing the opposition (in this case December 11,1998) [see *Andres Wines Ltd. and E&J Gallo Winery (1975)*, *25 C.P.R. (2d) 126 at 130* (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991)*, *37 C.P.R. (3d) 413 at 424* (F.C.A.)].

The burden of proof in Opposition proceedings can be generally described as follow: an opponent must raise enough evidence pertaining to any grounds of opposition upon which it relies to make it plain that facts exist to justify the ground of opposition. Once this initial burden is met, the burden shifts to the applicant who must prove that the particular ground of opposition should not prevent registration of the applied trade-mark (see *Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd. (1984)*, *3 C.P.R. (3d) 325*).

In *Dion Neckwear Ltd. v. Christian Dior, S.A. et al. (2002)*,*20 C.P.R. (4th) 155*, Mr Justice Décarie stated:

« The Registrar must therefore be reasonably satisfied that, on a balance of probabilities, the registration is unlikely to create confusion; he 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. At best, it is only where the probabilities are equal that a form of doubt may be said to arise, which is to be resolved in favor of the opponent. But the concept of doubt is a treacherous and confusing one in civil proceedings and a Registrar should avoid resorting to it.»

The Opponent's failure to file any evidence is fatal with respect to its first and fourth grounds of opposition.

As for the second and third grounds of opposition, they deal with the issue of confusion and the Opponent did allege the existence of certificates of registration. As mentioned above, the Opponent didn't file a certified copy of any of the certificates of registration listed in support of those grounds of opposition. The Registrar does have some discretion, in view of the public interest to maintain the purity of the Register, to check the Register. While the general position of the Registrar is that he will not, in opposition proceedings, have regard to anything appearing on the Register that is not properly submitted as evidence, in view of the public interest in having a ground of opposition relying on Section 12(1)(d) of the Act properly disposed of, I consider it appropriate to exercise the Registrar's discretion to check the Register in the present circumstances. In support of this position, see, for example, *Quaker Oats of Canada Ltd. v. Menu Foods Ltd. (1986)*, 11 C.P.R. (3d) 410. Accordingly, having been delegated the powers of the Registrar pursuant to 63(3) of the Act, I have determined that those registrations are currently in good standing and extend to food products and the services of the preparation of food products.

In assessing whether there is a reasonable likelihood of confusion between the trademarks in issue within the scope of Section 6(2) of the Act, consideration should be given to all the surrounding circumstances including those, which are specifically enumerated in Subsection 6(5) of the Act. The factors enumerated in Section 6(5) of the Act are: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time the marks have been in use; the nature of the wares, services or

business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. It is, however, axiomatic that the list of surrounding circumstances referred to above is not exhaustive and that it is not necessary to give each factor equal weight [see, for example, *Clorox Co .v. Sears Canada Inc.* (1992), 41C.P.R.(3d) 483 (F.C.T.D.) and *Gainers Inc. vMarchildon* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.)]. Further, as noted by Mr. Justice Cattanach in *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd* (1980), 47 C.P.R. (2d) 145, aff'd 60 C.P.R. (2d) 70:

“Realistically appraised it is the degree of resemblance between the trade-marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a subservient role in the over-all surrounding circumstances.”

The trade-mark registrations cited by the Opponent in its Statement of Opposition are inherently distinctive. Moreover, the design feature of trade-marks Registration nos. 237,739 and 423,762, which is the same in both instances namely a square in which appears a cloud or rising steam as illustrated hereunder





is also a distinctive feature of these trade-marks. There has been however, no evidence of use of any of the cited trade-marks and, as such, no conclusion can be drawn as to their extent of use.

The Applicant's trade-mark consist of the components CULINARE,HOT,CAFETIÈRE and a design. Therefore, when viewed as a whole, such trade-mark is also inherently distinctive despite the fact that it contains the word «CAFETIÈRE» which is descriptive of the nature of the wares to be associated with the trade-mark in issue. The design components of the Applicant' trade-mark are distinctive and bear no similarity with the design features associated with the Opponent's trade-marks.

The criteria of the length of time the trade-marks have been in use doesn't favor either party as the Opponent failed to file any evidence of use while the Application is based on proposed use.

The Opponent's wares and services are food products and the preparation of food products respectively while the wares listed in the Application are coffee pots and cafetières, which can be classified as kitchen's appliances. As such, the wares and services of the Opponent are different from those of the Applicant.

There exists no evidence on the nature of the trade of each party and therefore such criterion doesn't favor either party.

The only resemblance between the Opponent's trade-marks and the trade-mark of the Applicant is the word CULINAR versus CULINARE, which is suggestive of «culinary» thus relating to food or the kitchen in general. Mr. Justice Décarie in *Dion Neckwear Ltd*, hereinabove cited mentioned:

« While I appreciate that the first portion of a trade-mark is the most relevant for purposes of distinction (see *Pernod Ricard v. Molson Breweries* (1992), 56 F.T.R. 53, 44 C.P.R. (3d) 359 (T.D.) *per* Denault J. at 60), marks are nevertheless to be considered in their totality and the effect or idea of the whole is to be compared even when words in the marks are disclaimed. (See *Standard Coil Products (Canada) Ltd. v. Standard Radio Corp.* (1971), 1 C.P.R. (2d) 155 (F.C.T.D.), affirmed (1976), 26 C.P.R. (2d) 288n (F.C.A.); *Sealy Sleep Products Ltd. v. Simpson's-Sears Ltd.* (1960), 33 C.P.R. 129 (Ex. Ct.), approved by the Supreme Court of Canada in *Ultravite Laboratories Ltd. v. Whitehall Laboratories Ltd.* (1965), 44 C.P.R. 189.)»(My underlines)

The Applicant's trade-mark is made of three words which, when viewed in their totality, are different in sound and ideas suggested, from any of the Opponent's trade-marks. The design components of the Applicant's trade-mark are also different from the Opponent design features of certificate of registrations 237739 and 423762 as illustrated above.

I am of the opinion that a consideration of all the surrounding circumstances leads to the conclusion that there is no likelihood of confusion between the Applicant's trade-mark and the Opponent's trade-marks and therefore, the second and third grounds of opposition should be rejected as well.

In view of my conclusions with respect to the issue of confusion, I conclude that the Applicant's trade-mark is registrable, that the Applicant is the person entitled to registration and that the Applicant's trade-mark is distinctive.

For the foregoing reasons, having been delegated authority by the Registrar of Trade-marks by virtue of Section 63(3) of the Act, I reject the Opponent's opposition pursuant to Subsection 38(8) of the Trade-marks Act.

DATED, IN MONTREAL, QUEBEC, THIS 4th DAY OF JULY 2003.

Jean Carrière
Hearing Officer
Trade-marks Opposition Board