



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

**Citation: 2011 TMOB 56**  
**Date of Decision: 2011-03-28**

**IN THE MATTER OF AN OPPOSITION by  
Weetabix Limited to application  
No. 1,226,045 for the trade-mark ALPINA &  
Design in the name of Alpina Productos  
Alimenticios S.A.**

[1] On August 5, 2004, Alpina Productos Alimenticios S.A. (the Applicant) filed an application to register the trade-mark ALPINA & Design shown below (the Mark). The application includes the following colour claim:



The word ALPINA and the underline is white. The mountain is white with light blue shade. The background is light blue, and the bottom on each side of the mountain is dark blue.

[2] The application is based upon use of the Mark in Canada since at least as early as January 20, 2004 in association with the following wares:

Preserved, dried and cooked fruits and vegetables, jellies, jams, fruit sauces; eggs, milk, milk goods, namely long life milk, long life milk with flavours, milk drinks based with yogurt, milk drinks with fruits, milk drinks with cereals, Chicha (milk drink made with rice flour), oat milk, milk drinks with oats, cheese; jellies (confectionary), soy based food, namely soy-based beverages used as a milk substitute, soy-based yogurt, baby food, jams,

juices, nectars, and refreshments, namely non-alcoholic fruits drinks, fruit juices for babies, non-alcoholic cool drinks with fruit flavour, light non-alcoholic cool drinks with fruit flavours, fruits in syrup; edible oil and fats; mineral and aerated waters and other non-alcoholic drinks, namely carbonated fruit juices, coffee-based drinks and soy-based drinks; non-alcoholic fruit drinks and fruit juices; syrups and other preparations for making beverages, namely powders, carbonation and fruit flavours.

[3] The application is also based upon use and registration of the Mark in Colombia under No. 141717 in association with:

Preserved, dried and cooked fruits and vegetables, jellies, jams, fruit sauces; eggs, milk, milk goods, namely long life milk, long life milk with flavours, milk drinks based with yogurt, milk drinks with fruits, milk drinks with cereals, Chicha (milk drink made with rice flour), oat milk, milk drinks with oats, cheese; jellies (confectionary), soy based food, namely soy-based beverages used as a milk substitute, soy-based yogurt; fruits in syrup; edible oil and fats.

[4] The application was advertised for opposition purposes in the *Trade-marks Journal* of October 19, 2005.

[5] On September 19, 2006, Weetabix Limited (the Opponent) filed a statement of opposition claiming that the application does not conform to the requirements of s. 30(a), (b), (d), and (i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act). The statement of opposition also claims that the Mark is not registrable pursuant to s. 12(1)(d) of the Act, that it is non-distinctive of the Applicant pursuant to s. 2 and 38(2)(d) of the Act, and that the Applicant is not the person entitled to registration of the Mark pursuant to various grounds under s. 16 of the Act, in view of the fact that the Mark is confusing with the Opponent's trade-mark ALPEN covered by registration No. TMA191,383 and for which an application for registration bearing Serial No. 1,295,011 had been filed by the Opponent prior to the date of filing of the Applicant's application, which trade-mark has been used extensively since 1973 and continues to be so used in Canada.

[6] The Applicant filed and served a counter statement in which it denies the Opponent's allegations. The Applicant also requested that the Registrar render an interlocutory ruling with respect to some of the grounds raised in the statement of opposition.

[7] In response to the Applicant's request for an interlocutory ruling, the Opponent, on December 13, 2006, requested leave to amend its statement of opposition so as to clarify the ground of opposition raised pursuant to s. 2 of the Act and expand such ground of opposition as well as the s. 12(1)(d) ground so as to claim that the Mark is not registrable and non-distinctive in view of a third party trade-mark, namely Alpina Salami Inc' s ALPINA & Design trade-mark, which has been registered under No. TMA357,659 and used in Canada in association with salamis, hams, sausages, ham hocks, bacon, pepperettes, liver paste, paté, jellied pork, pork hocks, and cuts thereof since at least as early as 1960. Leave was granted by the Registrar on March 14, 2007 to so amend the statement of opposition.

[8] In support of its opposition, the Opponent filed the affidavit of Charles Marble, Executive Vice President of North America of Weetabix Company, Inc., a subsidiary of the Opponent, sworn July 11, 2007, as well as certified copies of registration Nos. TMA191,383 and TMA357,659 and application No. 1,295,011 which matured to registration on July 16, 2007 under No. TMA692,104. In support of its application, the Applicant filed the affidavits of Manon Goudreault, who describes herself as an employee of the law firm representing the Applicant in this proceeding, sworn February 11, 2008, and Thelma Thibodeau, a trade-mark agent in the employ of the same law firm, sworn February 14, 2008. The Opponent further filed, as evidence in reply, the affidavit of Shannon Young, a trade-mark agent in the employ of the law firm representing the Opponent in this proceeding, sworn July 15, 2008.

[9] Only the Opponent filed a written argument. Both parties attended at an oral hearing.

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[10] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidentiary burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); and *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

## Summary of the parties' evidence

### The Opponent's evidence

#### The Marble affidavit

[11] Mr. Marble first provides details regarding his position as Executive Vice President of North America of Weetabix Company, Inc. (Weetabix Company) and, in particular, that he is responsible for the three legal entities that make up Weetabix of North America: Weetabix of Canada, Ltd. (Weetabix Canada), The Weetabix Company Inc., and Barbara's Bakery. He also states that he is "responsible and accountable for all profit and loss of these three entities including Operations, Sales, Marketing and Finance". Mr. Marble further attests to the fact that he has knowledge of the relationship between Weetabix Company and its parent company, the Opponent.

[12] Mr. Marble states that the Opponent is the leading British cereal manufacturer. He also states that Weetabix cereal products are exported to over 80 countries throughout the world with manufacturing facilities in the United Kingdom, Africa and Canada and that Weetabix Canada, operating under the full control of the Opponent, is responsible for the manufacture and distribution of the Opponent's cereal based snack food, cereal derived food bars (ready to eat), breakfast cereals, muesli and mixed cereals with fruits and nuts sold in Canada in association with the trade-mark ALPEN.

[13] Mr. Marble provides details regarding the relationship between Weetabix Canada and the Opponent, namely that Weetabix Canada is the exclusive Canadian licensed manufacturer and distributor of the Opponent and that it manufactures products bearing the ALPEN trade-mark in accordance with strict specifications as to character, composition and quality standards established and routinely revised by the Opponent. The trade-mark ALPEN is furthermore designated on product packaging as a registered trade-mark of the Opponent, used under license by Weetabix Canada (see samples of packaging of the Opponent's ALPEN Swiss style breakfast

cereals attached as Exhibit B).

[14] Mr. Marble also provides information regarding the channels of trade through which the Opponent's ALPEN branded products travel. In particular, he describes how Weetabix Canada manufactures and sells cereal and cereal products, identified by the trade-mark ALPEN, to Canadian grocery chains and other retail food stores and that the food retailers in turn sell the products bearing the ALPEN trade-mark to Canadian consumers. He attaches as Exhibit A a sampling of invoices and accompanying purchaser orders pertaining to the sale of "ALPEN products" in Canada from 1998 to 2007. Mr. Marble states that similar invoices would have been issued in association with the sale of ALPEN products in Canada in the years prior to 1998 but these are not easily accessed. While Mr. Marble states that the invoices pertain to the sale of "ALPEN products", they seem to pertain only to the Opponent's breakfast cereals or muesli and mixed cereals with fruits and nuts. They do not seem to pertain to the Opponent's cereal based snack food and cereal derived food bars (ready to eat).

[15] Mr. Marble states that since at least as early as 1973, Weetabix Canada, by virtue of its licensing arrangement with the Opponent, has continuously sold products bearing the ALPEN trade-mark in Canada and provides an estimate of the annual volume of products identified by the ALPEN trade-mark and sold in Canada for the years 1985 to 2006. The approximate total of these sales amounts to 31 million dollars. However, he does not provide a breakdown of annual sales for each of the Opponent's ALPEN products. These sale figures seem to pertain only to the Opponent's breakfast cereals or muesli and mixed cereals with fruits and nuts. They do not seem to pertain to the Opponent's cereal based snack food and cereal derived food bars (ready to eat).

[16] Turning to the promotion of the ALPEN products, Mr. Marble states that such is primarily executed via promotional contests and product "give-aways". He further states that the approximate total spent on Canadian advertising/promotional budgets for products bearing the ALPEN trade-mark over the years 1999-2007 is \$97,000. Mr. Marble states that the samples of packaging attached as Exhibit B show the manner in which the ALPEN trade-mark is used in Canada in association with cereal goods and also demonstrate some of the ways in which the ALPEN products are promoted via on-box contests, special offers, and promotional product

give-aways.

[17] Mr. Marble then turns to the Applicant's application. He states that he has never heard of specific products referred to as "milk goods, namely namely milk drinks with cereals, Chicha (milk drink made with rice flour), oat milk, milk drinks with oats". I will revert to this point later on in my decision when assessing the s. 30(a) ground of opposition.

[18] Mr. Marble concludes his affidavit by providing his opinion as to the likelihood of confusion between the Mark and the Opponent's ALPEN trade-mark. I am not prepared to accord weight to this statement of Mr. Marble, which constitutes inadmissible opinion evidence. The likelihood of confusion involves mixed questions of law and fact to be determined by the Registrar on the basis of the factual evidence of record.

#### The Young affidavit

[19] As indicated above, the Young affidavit has been filed as evidence in reply. According to Rule 43 of the *Trade-marks Regulations*, SOR/96-195, such evidence must be strictly confined to matters in reply. I am satisfied that it does.

[20] Ms. Young states in her affidavit that pursuant to instructions received from her employer, she conducted investigations of websites, and if necessary, further Internet searches pertaining to the trade-mark registrations contained in Exhibit TTH-3 of the affidavit of Thelma Thibodeau, submitted as part of the Applicant's evidence (discussed below). I will revert to Ms. Young's search results later on in my decision when assessing the surrounding circumstances under the s. 12(1)(d) ground of opposition.

#### The Applicant's evidence

#### The Goudreau affidavit

[21] Ms. Goudreau states in her affidavit that pursuant to instructions received from her

employer, she obtained copies of information pertaining to registrations or applications contained on the Canadian Intellectual Property Office (CIPO) trade-marks database. She attaches as Exhibit MG-1 copies of all the trade-mark registrations and pending trade-mark applications resulting from her search.

[22] As pointed out by the Opponent, Ms. Goudreau simply attaches print-outs based on instructions received from her employer without any explanation of how the search was carried out or what the instructions were. Her affidavit is also silent as to the factual inferences which ought to be drawn from the results which are annexed to her affidavit. However, at the oral hearing, the Applicant's agent did specifically identify verbally some of the trade-marks listed in Exhibit MG-1 as supporting the Applicant's contention that identical or similar trade-marks in the names of different entities in respect of a variety of food products coexist on CIPO register of trade-marks. I will revert to this point later on in my decision when assessing the surrounding circumstances under the s. 12(1)(d) ground of opposition.

#### The Thibodeau affidavit

[23] Ms. Thibodeau states in her affidavit that pursuant to instructions received from her employer, she conducted a search of CIPO trade-marks database so as to locate allowed or registered trade-marks containing the prefix "ALP" in association with food and/or beverage products and she attaches as Exhibits TTH-1 to TTH-4 the results of her searches. I will revert to this point later on in my decision when assessing the surrounding circumstances under the s. 12(1)(d) ground of opposition.

#### Analysis of the grounds of opposition

[24] I will now assess the grounds of opposition in regard to the evidence of record, although not necessarily in the order they were raised in the statement of opposition.

Section 30(a) ground of opposition

[25] The Opponent has pleaded that the application does not comply with the requirements of s. 30(a) of the Act because the wares as described “do not constitute statements in ordinary commercial terms of the specific wares in association with which the [M]ark is said to have been used.” In its written argument and at the oral hearing, the Opponent has detailed further its pleading. More particularly, the Opponent submits that the following wares should be refused by the Registrar: “milk goods, namely milk drinks with cereals, Chicha (milk drink made with rice flour), oat milk, milk drinks with oats” as they are neither specific nor do they comprise terminology common to the food trade.

[26] The material date for considering the circumstances respecting the issue of non-compliance with s. 30(a) is the date of filing of the application [see *Delectable Publications Ltd. v. Famous Events Ltd.* (1989), 24 C.P.R. (3d) 274 (T.M.O.B.)].

[27] The facts relied upon by the Opponent so as to satisfy its initial evidentiary burden consist of Mr. Marble’s affidavit testimony that he has “never heard of specific products referred to as ‘milk goods, namely milk drinks with cereals, Chicha (milk drink made with rice flour), oat milk, milk drinks with oats’” and that he does “not believe the foregoing designations are specific nor do they comprise terminology common to the food trade”.

[28] The Applicant submits that the mere fact that Mr. Marble has never heard of products being referred to under such designations does not satisfy the Opponent’s initial evidentiary burden. I agree.

[29] As stressed by the Applicant, Mr. Marble states in his affidavit that he has held the position of Vice President of North America of Weetabix Company since April of 2006 only. While he states that he is “responsible and accountable for all profit and loss” of the three entities that make up Weetabix Company, no information is provided as to how knowledgeable he is about the marketplace. Mr. Marble has not been presented as, nor can he be qualified as an



expert with respect to the terminology used in the food trade for describing different kinds of “milk goods”. The fact that Mr. Marble has not been cross-examined on his affidavit does not cure the foregoing deficiencies.

[30] I further note that “Chicha” is defined in the *Grand dictionnaire terminologique* of the *Office québécois de la langue française* as follows: “Thickened flavoured beverage prepared from rice flour and dried skimmed milk (Venezuela)”, which definition is in line with the one provided in parentheses by the Applicant in its statement of wares. I also note that “oat milk” corresponds to one of the examples of cereal milks defined in the *Oxford Reference Online Book of Health Foods* under the subheading *Dairy products - Plant milks*. As for the wares described as “milk drinks with cereals” and “milk drinks with oats”, I note that the terminology used by the Applicant is in line with the one used to describe some of its other milk goods, namely “milk drinks with fruits” and “long life milk with flavours”, and that these latter descriptions of wares are not objected to by the Opponent. I further note that these wares fall under the category of “milk products”, which is listed as acceptable as such in CIPO’s *Trade-marks Wares and Services Manual*.

[31] Accordingly, the s. 30(a) ground of opposition is dismissed on the basis that the Opponent has not satisfied its evidentiary burden.

#### Section 30(b) and (d) grounds of opposition

[32] The Opponent has pleaded that the application does not comply with the requirements of s. 30(b) of the Act in that the Applicant has not used the Mark in Canada in association with all of the wares specified in the application since the claimed date of first use. Furthermore, the Applicant has not used the Mark continuously since the date of first use claimed in the application with all of the wares specified in the application.

[33] The Opponent has also pleaded that the application does not comply with the requirements of s. 30(d) of the Act in that at the date of filing of the application in Canada, neither the Applicant nor a predecessor-in-title had used the Mark in Columbia, or in any other

country of the world, in association with the wares designated in the Canadian application. Moreover, as of the filing date of the Canadian application, the country of origin of the Applicant referred to in the s. 16(2) claim was not Columbia. As a result, the Opponent alleges that the present application as filed was void *ab initio*.

[34] The material date for considering the circumstances respecting the issue of non-compliance with s. 30(b) and (d) is the date of filing of the application [see *Georgia-Pacific Corporation v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.); and *Austin Nichols & Co., Inc. v. Cinnabon, Inc.* (2000), 5 C.P.R. (4th) 565 (T.M.O.B.)].

[35] The facts relied upon by the Opponent so as to satisfy its initial evidentiary burden consist of Mr. Marble's affidavit testimony that he is "familiar with many products containing cereal components for sale in the Canadian marketplace yet [he is] unaware of Canadian sales of the Applicant's products in Canada" and that he has "also investigated whether the Applicant's products bearing the [Mark] are available in Canada and find no instances that these products are offered for sale in Canada. [He is] not aware of any use by the Applicant of the [Mark] in association with these products in Columbia as claimed in the [a]pplication".

[36] More particularly, the Opponent submits that some weight should be accorded to Mr. Marble's statements which have not been challenged by cross-examination. The Opponent further submits that the Applicant has not adduced any evidence of its own which contradicts Mr. Marble's statements or raises questions as to his credibility.

[37] The Applicant submits for its part that the mere fact that Mr. Marble is unaware of sales of the Applicant's products in Canada or Columbia does not satisfy the Opponent's initial evidentiary burden. I agree.

[38] The nature and extent of Mr. Marble's investigations are unknown. The mere fact that he is allegedly familiar with "many products containing cereal components" and yet is unaware of the Applicant's wares does not necessarily imply that the Applicant has not used the Mark as stated in its application. There is no evidence that the Mark has not been used by the Applicant in

Canada and Columbia as claimed in the application. The application further formally complies with the requirements of s. 30(b) and (d) as the Applicant has provided the required statements of use of the Mark in Canada and use and registration of the Mark in Columbia, which is described as the Applicant's country of origin. The Applicant has also described itself as a "Colombian Corporation" in its application. As rightly submitted by the Applicant, the Applicant was under no obligation to positively evidence use of the Mark with each of the general classes of wares described in its application.

[39] Accordingly, the s. 30(b) and (d) grounds of opposition are dismissed on the basis that the Opponent has not satisfied its evidentiary burden.

#### Section 30(i) ground of opposition

[40] The Opponent has pleaded that the application does not comply with the requirements of s. 30(i) of the Act in that, at the date of filing of the application in Canada, the Applicant could not have been satisfied and could not make the statement that it was so satisfied that it was entitled to use or register the Mark in Canada in association with the wares specified in the application. The Applicant must have been aware of the Opponent's earlier adoption and use in Canada of its ALPEN trade-mark as applied to cereal preparations for human consumption and foodstuffs, namely mixed cereals with fruits and nuts. The Applicant was also aware that the Mark could not distinguish the applied for wares from the goods, services or businesses of others, including those of the Opponent.

[41] The material date for considering the circumstances respecting the issue of non-compliance with s. 30(i) is the date of filing of the application [see *Tower Conference Management Co. v. Canadian Exhibition Management Inc.* (1990), 28 C.P.R. (3d) 428 (T.M.O.B.)].

[42] This ground, as pleaded, does not raise a proper ground of opposition. The mere fact that the Applicant may have been aware of the existence of the Opponent's trade-mark, or third parties' trade-marks does not preclude it from making the statement in its application required by

s. 30(i) of the Act. Even if the ground had been properly pleaded, where an applicant has provided the statement required by s. 30(i), as the Applicant has done in the present case, a s. 30(i) ground should only succeed in exceptional circumstances such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.)]. There is no such evidence in the present case.

[43] Accordingly, the s. 30(i) ground of opposition is dismissed.

Section 12(1)(d) ground of opposition

[44] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of s. 12(1)(d) of the Act in that it is confusing with i) the Opponent's trade-mark ALPEN, registered in 1973 under No. TMA191,383 in association with "foodstuffs, namely mixed cereals with fruit and nuts"; and ii) the trade-mark ALPINA & Design (reproduced below) owned by Alpina Salami Inc., registered in 1989 under No. TMA357,659 in association with "salamis, hams, sausages, ham hocks, bacon, pepperettes, liver paste, paté, jellied pork, pork, pork hocks, and cuts thereof":



[45] The material date to assess a ground of opposition based on s. 12(1)(d) is the date of my decision [see *Park Avenue Furniture Corp. v. Wickers/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

[46] The Opponent has provided certified copies of both registrations. I have exercised the Registrar's discretion to confirm that they are in good standing as of today's date.

[47] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and either one or both of the Opponent's ALPEN word mark and Alpina Salami Inc.'s ALPINA & Design trade-mark.

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

[49] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at s. 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time the trade-marks have been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered, and are not necessarily attributed equal weight [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401 (S.C.C.) for a thorough discussion of the general principles that govern the test for confusion].

[50] I will assess the likelihood of confusion between the Mark and the Opponent's ALPEN word mark first. I will thereafter assess the likelihood of confusion between the Mark and Alpina Salami Inc.'s ALPINA & Design trade-mark.

i) Analysis of the likelihood of confusion between the Mark and the Opponent's ALPEN word mark

(a) The inherent distinctiveness of the trade-marks and the extent to which they have become known

[51] The parties' marks are inherently distinctive, not describing any particular feature of their respective goods. As submitted by the Opponent, the word ALPEN refers to something which is "of or pertaining to the Alps", a trait which is not related to the Opponent's products except to suggest a wholesome or hearty product. I note in this regard that the Opponent describes its breakfast cereal product as follows: "Naturally Delicious Swiss Style Cereal" [see Exhibit B to the Marble affidavit]. The Opponent further submits that the word ALPINA has the same meaning in Italian, although it did not provide any dictionary definition to this effect.

[52] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. However, the Applicant has produced no evidence that any of its products have been sold in association with the Mark in Canada (or anywhere else in the world). Thus, the Applicant has not established that the Mark has become known to any extent in Canada. In contrast, the Opponent's evidence establishes extensive use of the ALPEN trade-mark by the Opponent in Canada in association with breakfast cereals or muesli and mixed cereals with fruit and nuts (hereinafter collectively referred to as "breakfast cereals") for a considerable length of time.

[53] As per my review above of the Marble affidavit, the Opponent has adduced evidence of use of the trade-mark ALPEN in Canada supported by documentary evidence in the nature of invoices, sales and advertising data, as well as sample packages. While the Opponent's evidence does not establish continuous use of the ALPEN trade-mark with the wares described in the Opponent's registration since the very first date of use claimed therein, the sales figures provided for the years 1985 to 2006, which amount to some 31 million dollars, together with the advertising and promotion of the ALPEN trade-mark by the Opponent in Canada in the same

years, lead me to conclude that the ALPEN trade-mark has deeper roots and has become known significantly in Canada in association with breakfast cereals.

(b) The length of time the trade-marks have been in use

[54] For the reasons given above, this factor also favours the Opponent.

(c) The nature of the wares, services or business; and (d) the nature of the trade

[55] When considering the nature of the wares and services and the nature of the trade, I must compare the Applicant's statement of wares with the statement of wares in the Opponent's registration [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); and *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.); *Procter & Gamble Inc. v. Hunter Packaging Ltd.* (1999), 2 C.P.R. (4th) 266 (T.M.O.B.); and *American Optional Corp. v. Alcon Pharmaceuticals Ltd.* (2000), 5 C.P.R. (4th) 110 (T.M.O.B.)].

[56] The Opponent's registration covers "foodstuffs, namely mixed cereals with fruit and nuts" whereas the Applicant's application covers, *inter alia*, "milk goods, namely namely milk drinks with cereals, Chicha (milk drink made with rice flour), oat milk, milk drinks with oats". While the Opponent maintains that the foregoing goods of the Applicant have not been sufficiently described, and the Applicant has adduced no evidence demonstrating the nature of such products, the Opponent submits that one can infer that these goods comprise products which contain cereals and oats.

[57] In view of the foregoing, and the fact that the Opponent has also used and applied for registration of the trade-mark ALPEN in association with "cereal preparations for human

consumption, namely cereal based snack food, cereal derived food bars (ready to eat), breakfast cereals, muesli” (re application Serial No. 1,295,011 filed on March 23, 2006, which matured to registration on July 16, 2007 under No. TMA692,104), the Opponent submits that it must be concluded that the wares of the parties are quite similar.

[58] The Opponent, relying on the decision in *Opus Building Corp. v. Opus Corp.* (1995), 60 C.P.R. (3d) 100 (FCTD), at p. 104, further submits that where the wares of the parties are similar, it might be assumed, in the absence of evidence to the contrary, that the nature of the trade will also be similar. In this regard, the Marble affidavit sets out the manner in which the Opponent’s goods bearing the ALPEN trade-mark are sold in Canada. The Opponent sells its products through its exclusive Canadian manufacturer and distributor to Canadian grocery stores and other retail food stores who, in turn, sell the ALPEN product to individual consumers. The Opponent submits that even though no evidence of the manner of use has been submitted by the Applicant, its products bearing the Mark should be considered as being sold through the same channels of trade as are the Opponent’s wares. The Opponent submits that the possibility that the products associated with the trade-marks at issue could be sold side by side further increases the potential for their being a likelihood of confusion between the trade-marks in issue.

[59] The Opponent further asks the Registrar to consider that food products are not expensive items and, as such, consumers will not deliberate extensively over such purchases, but rather may not be careful in their consideration relating to the purchase of these products. Thus, the Opponent submits that consumers are likely to purchase the Applicant’s wares associated with the Mark mistakenly believing they are purchasing a product made by the Opponent and containing the Opponent’s ALPEN branded cereals.

[60] The Applicant submits for its part that the use of the ALPEN trade-mark shown by the Opponent is with breakfast cereals only as opposed to the other categories of wares covered by the Opponent’s aforementioned application Serial No. 1,295,011, which include cereal based snack food and cereal derived food bars (ready to eat). The Applicant further submits that such application, which matured to registration on July 16, 2007, has not been alleged by the Opponent in support of its s. 12(1)(d) ground of opposition. Thus, the Applicant submits that the



Opponent's wares that consist of cereal based snack food and cereal derived food bars (ready to eat) are not pertinent.

[61] The Applicant further submits that there is no evidence that the products associated with the trade-marks at issue could be sold side by side. Also, the Opponent's evidence establishes that the Opponent is a cereal manufacturer. There is no evidence that it is also a manufacturer of milk products and other type of food products. The Applicant further submits that the mere fact that some of the milk drinks listed in the Applicant's application contain cereals does not render such goods similar to the Opponent's cereal products.

[62] The wares covered by the Applicant's application essentially fall within three main categories of wares, namely preserved, dried and cooked fruits and vegetables; dairy products; and non-alcoholic beverages. While such wares differ in nature from the wares covered by the Opponent's registration No. TMA191,383, I agree with the Opponent that there is some similarity or relationship between the Applicant's wares described as "milk drinks with cereals" and "milk drinks with oats" and the Opponent's wares, particularly in view of the fact that it may be that such "cereals" and "oats" are not contained in the milk drink but rather attached to it as a dry mix to be added at the time of serving. The Applicant elected not to file any evidence establishing either the differences or the lack of relationship between such particular wares.

[63] I further agree with the Opponent that, in the absence of any evidence to the contrary, there is a potential overlap in the trades of the parties. As per my review of the Marble affidavit, the Opponent's cereal products are sold through grocery stores and other retail food stores. Presumably, the Applicant's wares will, or could, be sold through the same types of outlets.

[64] In addition, even if I acknowledge that typically, the parties' wares would not be sold side by side or even remotely close to one another, it is to be remembered that s. 6(2) of the Act does not require the parties' wares to be sold side by side, nor does it require the wares to be of the same general class.

(e) The degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[65] The marks in issue share little resemblance when viewed or sounded. However, they share a relatively fair degree of resemblance in the ideas suggested. As indicated above, the Opponent's mark refers to something which is "of or pertaining to the Alps", which suggests in the context of the Opponent's cereal products, a wholesome or hearty product. While the word ALPINA has no known meaning in French or English, it possesses an Italian connotation that evokes something which is also "of or pertaining to the Alps" (re the French word "alpin"), especially when the Mark is viewed owing to the design portion of the Mark that prominently displays a white mountain surrounded by a dark blue mountain range.

Additional surrounding circumstances

State of the register evidence

[66] As indicated above, the Applicant submitted evidence of the state of the register by way of the Thibodeau affidavit. State of the register evidence is introduced to show the commonality or distinctiveness of a mark or portion of a mark in relation to the register as a whole. Evidence of the state of the register is only relevant insofar as inferences may be made on it concerning the state of the marketplace, and inferences about the state of the marketplace can only be drawn when a significant number of pertinent registrations are located [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Welch Foods Inc. v. Del Monte Corp.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); and *Maximum Nutrition Ltd. v. Kellogg Salada Canada Inc.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

[67] More particularly, Ms. Thibodeau summarily reproduces in paragraph 7 of her affidavit the details of the 43 trade-mark registrations located for the stem "ALP" as a component of a trade-mark associated with food and/or beverage products and she attaches as Exhibit TTH-3 the computerized details obtained from CIPO database for each one of these trade-marks. Among these 43 trade-mark registrations, Ms. Thibodeau further attaches as Exhibit TTH-4 a table

summarizing the details of the trade-marks located for the word ALPEN alone or ALPEN as a component of a trade-mark associated with food and/or beverage products.

[68] The registrations located by Ms. Thidodeau include the Opponent's registration Nos. TMA191,383 and TMA692,104 for the ALPEN mark and Alpina Salami Inc.'s registration No. TMA357,659 for the ALPINA & Design mark.

[69] A number of the registrations located are held by five distinct entities. These registrations (that I have grouped by owner for the ease of review) are:

- ALPENDORF (TMA633,650) and ALPENGUT (TMA631,960) for meat products, ready-to-serve meals, dairy products, etc.;
- ALPENHORN and ALPENHORN & Design (TMA183,164 and TMA180,765) for dairy products;
- ALPENWEISS (TMA235,777) and ALPENWEISS SPARKLING & DESIGN (TMA300,231) for wines;
- ALPINE (UCA10970); ALPINE & Design (TMA233,652); ALPINE & Design (TMA262,136); ALPINE & Design (TMA324,680); ALPINE & Design (TMA690,245); ALPINE & Design (TMA470,884); ALPINE GENUINE COLD FILTERED (TMA417,378); ALPINE GENUINE COLD FILTERED & Design (TMA414,046); ALPINE LAGER (TMA386,450); ALPINE LAGER BEER & Design (TMA146,228); ALPINE LIGHT (TMA387,125); and ALPINE LIGHT & Design (TMA696,935) for beer or alcoholic beverages; and
- ALPINE ASTER (TMA657,645); ALPINE BELL Design (TMA695,952); and ALPINE ROSE (TMA661,539) for dairy products.

[70] The following registrations (that I have grouped by category of wares for the ease of review) are each owned by distinct entities:

- ALPEN SPRINGS (TMA446,319); ALPIAN (TMA382,353); ALPINE (TMA435,451); ALPENROCK HOUSE (TMA526,769); and ALPINE-SUBTERRANEAN INTERNATIONAL GUIDING SERVICES INC. (TMA537,394) for water or other beverages and preparations for making beverages;
- ALPENBERGER (TMA696,591); ALPENFRESH (TMA339,530); ALPENJOY (TMA245,521); and ALPI (TMA337,617) for various dairy products;
- ALPINE LACE (TMA530,010) for cheeses and meat;
- ALPENKRAFT (TMA406,520) for herbal remedies and herbal candies;

- ALPINE (TMA565,425) for medicated and non-medicated lozenges, throat drops, candy and chewing gum;
- ALPENICE (TMA425,631) for candies;
- ALPINE (TMA139,149) for frozen bakery products;
- ALPIA (TMA534,480); and ALPROSE (TMA519,837) for chocolates and confectionary;
- ALPREZ (TMA511,791) for vegetables; and
- TRANS ALPINE & Design (TMA323,331) for snail, capers; canned and marinated vegetables; (...) pâté de foie, oil, soya sauce, vinegar, table syrup.

[71] The Opponent submits that none of the above registrations covers goods which are as closely related to the Applicant's wares as those covered by the Opponent's ALPEN mark, namely products containing or comprising cereals. The Opponent submits that the state of the register evidence does not permit the conclusion that a significant degree of coexistence exists with respect to marks beginning with ALP and used in association with cereal products.

[72] While it is true that none of the above registrations covers cereal products such as the ones marketed by the Opponent under the ALPEN mark, they do cover a variety of food products including dairy products and non-alcoholic beverages, which clearly overlap with the wares covered by the Applicant's application. I consider the number of registered marks located by Ms. Thibodeau sufficient to conclude that it is common in the food industry to adopt trade-marks made up of the word "ALPEN" or "ALPINE" in association with a variety of food products, especially dairy products and beverages. Accordingly, consumers are presumably adept at distinguishing between one such mark and another.

[73] This brings me to consider the Young affidavit. As indicated above, Ms. Young conducted investigations of websites, and if necessary, further Internet searches pertaining to the trade-mark registrations contained in Exhibit TTH-3 of the Thibodeau affidavit. Ms. Young states that she was asked to locate websites pertaining to the owners of the trade-marks contained in Exhibit TTH-3 of the Thibodeau affidavit and to review these websites in order to determine (a) whether the relevant trade-mark was present, and (b) whether the goods sold by the owner in association with the relevant trade-mark appeared to be available in Canada. In instances where she was unable to locate a website for the owner, she conducted general Internet searches using the search engine at *www.google.ca* in an attempt to locate information pertaining to the owner

and its use of the relevant mark or marks.

[74] The Opponent submits that Exhibits A and B to the Young affidavit “arguably point to use in Canada of the trade-marks ALPENWEISS as applied to wine, ALPINE as applied to milk and milk powder, ALPIA chocolate bars, ALPINA salami, ALPINE LAGER and ALPINE LIGHT as applied to lager and beer, ALPINE chewing gum (discontinued 2005), ALPINE BELL, ALPINE ASTER and APLINE ROSE all as applied to cheese, ALPINE LACE as applied to cheese and ALPROSRE as applied to chocolate”. However, the Opponent submits that “[g]iven the limited number of marks which appear to be in use in Canada, and excluding those marks as applied to alcoholic beverages, chewing gum, chocolate and chocolate bars, salami and cheese”, the state of the register evidence furnished by the Applicant should be accorded little, if any, weight in this opposition”. I disagree.

[75] The mere fact that Ms. Young could not locate any reference to some of the marks listed in Exhibits TTH-3 and TTH-4 using the parameters described in her affidavit does not necessarily lead to the inference that such marks are not used in the Canadian marketplace. As stressed by the Applicant, one cannot conclude to the absence of a mark in the marketplace simply because a trade-mark does not appear on a website. As such, Ms. Young’s searches cannot be qualified as exhaustive. They can also hardly be qualified as objective because of the lack of objectivity of Ms. Young as an employee of the firm representing the Opponent in this proceeding [see *Cross-Canada Auto Body Supply v. Hyundai* (2006), 53 C.P.R. (4th) 286 (F.C.A.)]. Furthermore, the few results obtained by Ms. Young for the dozen of marks mentioned above arguably support the finding made above that it is common in the food industry to adopt trade-marks made up of the word “ALPEN” or “ALPINE” in association with a variety of food products.

[76] This brings me to comment on the Goudreau affidavit. As indicated above, the Goudreau affidavit was introduced to support the Applicant’s contention that identical or similar trade-marks in the names of different entities in respect of a variety of food products coexist on CIPO register of trade-marks, like for instance:

- BARON BRAND (TMA685,805) for “ham”; BARON BURGER and BURGER BARON (TMA488,523 and TMA495,236) for “hamburgers”; LE BARON (TMA665,228) for “pain de jambon cuit); BARON (TMA491,460) for “beurre de sucre, choucroute, compote de pommes, fèves au lard, fruits frais, fruits en conserve, [etc.]”; BARON DE LUZE (TMA287,064) for “vins, à l’exclusion des vins mousseux”; LE BARON (TMA247,789) for “tomates, jus de tomates, maïs en grains et en crème, petits pois, fèves jaunes et vertes, carottes, macédoine de légumes”; LE BARON (TMA301,646) for “fromages”; LE GRAND BARON (TMA297,043) for “wine”; RED BARON (TMA320,125) for “pizza”; and RED BARON (TMA351,199) for “beer”;
- THE BEEFEATER (TMA376,046) for “meat, poultry, fish, frozen meats” and BEEFEATER (TMA250,814) for “hydrolyzed vegetable protein”; BEEFEATER (TMA271,275 and TMA667,125) for “frozen French fries potatoes” and “appetizers and snack foods, namely frozen potato snacks, battered vegetables, onion rings, [etc.]” respectively; and BEEFEATER (TMA120,981) for “gin”;
- BIG RED (TMA224,704) for “meat products, namely wieners”; WRIGLEY’S BIG RED CHEWING GUM (TMA202,538) for “chewing gum”; BIG RED (TMA403,953) for “beer, ale and porter; mineral and aerated waters”; and BIG RED’S (TMA255,606) for “sandwiches and pizzas”; and
- BLUE RIBBON (TMA373,191) for “prepared meats, namely bologna”; BLUE RIBBON & Design (TMA339,911) for “food products, namely spices, dessert decorations and flavour extracts; coffee; tea; baking powder”; and BLUE RIBBON GOLDEN (TMA391,445) for “rice”.

[77] Even if I agree with the Applicant that the Goudreau affidavit supports to some extent the Applicant’s contention that identical or similar marks may well coexist on the register of trade-marks in respect of a variety of food products, it remains that each case must be decided on its own merits. Thus, the mere fact that various trade-marks coexist on the register in respect of a variety of food products is not binding upon the Registrar.

Conclusion regarding the likelihood of confusion between the Mark and the Opponent’s ALPEN word mark

[78] As indicated above, the issue is whether a consumer who has a general and not precise recollection of the Opponent’s mark, will, upon seeing the Mark be likely to believe that their associated wares share a common source.

[79] While the parties’ wares both belong to the general category of food products and are likely to travel through the same type of grocery stores, and other food retail stores, I find that,

except for the wares described as “milk drinks with cereals” and “milk drinks with oats” discussed below, there is little similarity in the exact nature of the parties’ wares. Furthermore, while I acknowledge that the Opponent’s ALPEN mark as associated with its breakfast cereal products has achieved a significant reputation in Canada, I find that the differences existing between the parties’ marks in appearance and sound outweigh the similarities existing in the ideas suggested by same, especially in view of the common adoption in the food industry of trade-marks that are made up of the words “ALPEN” or “ALPINE” in association with a variety of food products.

[80] In view of the foregoing, I conclude that, except for the wares described as “milk drinks with cereals” and “milk drinks with oats”, the Applicant has satisfied its burden to show that there is not a reasonable likelihood of confusion between the marks in issue.

[81] As for the wares described as “milk drinks with cereals” and “milk drinks with oats”, I find that the balance of probabilities is evenly balanced between finding that (i) there is no reasonable likelihood of confusion as to the source of the parties’ wares in view of the differences existing between the parties’ marks in appearance and sound and (ii) there is a reasonable likelihood of confusion as to the source of the parties’ wares in view of the similarities existing between both the ideas suggested by the parties’ marks and these particular wares of the Applicant and the Opponent’s cereal products, the fact that the Applicant has not evidenced any possible distinctions between such particular wares, and the fact that the state of the register evidence does not permit the conclusion that a significant degree of coexistence exists with respect to marks beginning with ALP and used in association with cereal products. As the onus is on the Applicant to show, on a balance of probabilities, that there is no reasonable likelihood of confusion, I must find against the Applicant.

[82] Accordingly, the s. 12(1)(d) ground of opposition based upon the likelihood of confusion between the Opponent’s mark and the Mark succeeds partially.

ii) Analysis of the likelihood of confusion between the Mark and Alpina Salami Inc.'s ALPINA & Design mark

[83] While the Opponent has pleaded that the Mark is not registrable having regard to the provisions of s. 12(1)(d) of the Act in that it is confusing with Alpina Salami Inc.'s registered trade-mark ALPINA & Design described above, the Opponent made no representations with respect to such pleading either in its written argument or at the oral hearing.

[84] In the absence of evidence supporting use of Alpina Salami Inc.'s mark, the mere existence of a registration can establish no more than *de minimis* use and cannot give rise to an inference of significant or continuing use of the mark [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1992), 40 C.P.R. (3d) 427 (T.M.O.B.)]. Accordingly, while I appreciate the similarities existing between the marks in issue owing to the fact that their word portions both consist of the word "ALPINA", I agree with the Applicant that the differences existing between the marks when viewed, combined with the differences in the exact nature of their respective wares are sufficient, in the circumstances, to preclude a likelihood of confusion.

[85] Accordingly, the s. 12(1)(d) ground of opposition based upon the likelihood of confusion between this third party's registration and the Mark is dismissed. I wish to add that to the extent that my conclusion on this particular ground of opposition is based on the evidence of record, the present proceeding is distinguishable from my decision of even date in the co-pending opposition proceeding by Alpina Salami Inc.

Section 16 grounds of opposition

[86] The Opponent has pleaded various grounds of opposition pursuant to s. 16 of the Act. Two of these grounds are that the Applicant is not the person entitled to registration of the Mark having regard to the provisions of s. 16(1)(b) and (2)(b) of the Act in that at the claimed date of first use of the Mark and the date of filing of the Applicant's application respectively, the Mark



was confusing with the Opponent's ALPEN trade-mark applied for under application Serial No. 1,295,011 and used since at least as early as May 18, 1973.

[87] An opponent meets its evidentiary burden with respect to a s. 16(1)(b) or (2)(b) ground if it shows that its application for registration was filed previously to the applicant's application and that such application was pending at the date of advertisement of the applicant's application [s. 16(4) of the Act]. As the Opponent's application Serial No. 1,295,011 was filed subsequently to the Applicant's application, it cannot form the basis of a s. 16(1)(b) or (2)(b) ground of opposition. Accordingly, the s. 16(1)(b) and (2)(b) grounds of opposition are dismissed on the basis that the Opponent has not satisfied its evidentiary burden.

[88] The Opponent has also pleaded that the Applicant is not the person entitled to registration of the Mark having regard to the provisions of s. 16(1)(a) and (2)(a) of the Act in that at the claimed date of first use of the Mark and the date of filing of the Applicant's application respectively, the Mark was confusing with the Opponent's registered trade-mark ALPEN covered by registration No. TMA191,383, and was also confusing with the Opponent's ALPEN trade-mark applied for under application Serial No. 1,295,011, both of which have been extensively used since 1973 and which continue to be used extensively in Canada today.

[89] An opponent meets its evidentiary burden with respect to a s. 16(1)(a) or (2)(a) ground if it shows that as of the date of first use claimed in the Applicant's application or the date of filing of the Applicant's application respectively, its trade-mark had been previously used in Canada and had not been abandoned as of the date of advertisement of the Applicant's application [s. 16(5) of the Act]. As per my review of the Marble affidavit, the Opponent has met its evidentiary burden with respect to use of the ALPEN mark in association with breakfast cereals or muesli and mixed cereals with fruits and nuts. It has not with respect to the Opponent's cereal based snack food and cereal derived food bars (ready to eat).

[90] Because the difference in relevant dates does not substantially affect my analysis above under the s. 12(1)(d) ground of opposition, I find that the s. 16(1)(a) and (2)(a) grounds of

opposition succeed with respect to the wares described as “milk drinks with cereals” and “milk drinks with oats”.

[91] I wish in this regard to address the argument made by the Opponent at the oral hearing that both the Thibodeau and Goudreau affidavits ought not to be considered in my analysis of the non-entitlement and non-distinctiveness grounds of opposition as they are dated after each of the material dates that apply to these grounds. While it is true that technically speaking both affidavits are dated after the material dates to be considered under such grounds of opposition, the vast majority of the registrations listed in the Thibodeau and Goudreau affidavits were issued prior to either one or both of the material dates in issue. That being so, my findings made above concerning the state of the register evidence remain for the most part applicable to the non-entitlement and non-distinctiveness grounds of opposition.

#### Non-distinctiveness ground of opposition

[92] The Opponent has pleaded that the Mark does not distinguish the Applicant’s wares from the wares, services and businesses of i) Alpina Salami Inc. which has registered and used the trade-mark ALPINA & Design as indicated above; and ii) the Opponent which has previously registered, applied for and used the trade-mark ALPEN as indicated above.

[93] An opponent meets its evidentiary burden with respect to a non-distinctiveness ground if it shows that as of the filing of the opposition its trade-mark had become known to some extent at least to negate the distinctiveness of the applied-for mark [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D)]. As per my review of the Marble affidavit, the Opponent has met its evidentiary burden with respect to use of the ALPEN mark in association with breakfast cereals or muesli and mixed cereals with fruits and nuts. It has not with respect to the Opponent’s cereal based snack food and cereal derived food bars (ready to eat) and Alpina Salami Inc.’s trade-mark ALPINA & Design.

[94] Because the difference in relevant dates does not substantially affect my analysis above under the s. 12(1)(d) ground of opposition, I find that the non-distinctiveness ground of

opposition succeeds with respect to the wares described as “milk drinks with cereals” and “milk drinks with oats”.

Disposition

[95] In view of the foregoing and pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application in respect of the wares described as “milk drinks with cereals” and “milk drinks with oats”, and I reject the opposition with respect to the remainder of the wares pursuant to s. 38(8) of the Act [see *Produits Menagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 C.P.R. (3d) 492 (F.C.T.D.) as authority for a split decision].

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Annie Robitaille  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office