

TRADUCTION/TRANSLATION



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

Citation: 2012 TMOB 87
Date of decision: 2012-04-30

IN THE MATTER OF AN OPPOSITION
by Sobeys Capital Incorporated to the
application for registration No. 1,340,966
for the trade-mark COMPLIMENTS in the
name of EDENRED, a *société anonyme*

[1] On March 27, 2007, ACCOR, a *société anonyme*, filed an application to register the trade-mark COMPLIMENTS (the Mark) on the basis of the use and registration of the Mark in France under No. 033252480 in association with certain wares and services:

[2] By means of an assignment on June 29, 2010, registered by the Registrar on February 24, 2011, this application was assigned by ACCOR to EDENRED, a *société anonyme*. I will refer indiscriminately to both corporations as the Applicant. The statement of the wares and services contemplated by the application currently on file (as amended on December 29, 2011), reads as follows:

[TRANSLATION]


Magnetic credit cards, electronic credit cards, memory payment cards, cards, namely electronic prepaid gift cards, electronic loyalty cards, excluding all such wares for the acquisition of food products, in store or online, and excluding all such wares for the purchase and payment of telephone communications packages; printed goods, namely: cards, tickets, coupons, excluding all such wares for the acquisition of food products, in store or online, and excluding all such wares for the purchase and payment of telephone communications packages.




Organization of business operations to engender client loyalty, namely, providing a program of coupons, discount cards and loyalty cards for hotel services, transportation services, vehicle rental services, leisure and entertainment services, excluding all such services provided in the food product and telephone communications industries; insurance services, management of payment cards and credit cards, excluding all such services for the acquisition of food products in store or online, and excluding all such services for the purchase and payment of telephone communications packages; issuing of travellers' cheques and vouchers, excluding all such services for the acquisition of food products in store or online, and excluding all such services for the purchase and payment of telephone communications packages; services related to issuance, distribution and redemption by all means of payment, namely: tickets, coupons, credit cards, cheques, exchange certificates, vouchers, excluding all such services for the acquisition of food products in store or online, and excluding all such services for the purchase and payment of telephone communications packages; financial and monetary services, namely: issuing traveller's cheques, vouchers, credit card and loyalty card services, services related to the issuance, distribution and redemption of all means of payment, namely: tickets, coupons, credit cards, cheques, exchange certificates, vouchers, excluding all such services for the acquisition of food products in store or online, and excluding all such services for the purchase and payment of telephone communications packages.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of May 21, 2008.

[4] Sobeys Capital Incorporated (the Opponent) filed a statement of opposition against this application on October 21, 2008. The grounds of opposition may be summarized as follows:

1. The application does not fulfill the requirements set out at s. 30(i) of the *Trade-marks Act*, RSC 1985, c T-13, (the Act) in that, at the filing date of the application in Canada, the Applicant could not have been satisfied that it was entitled to use the Mark in association with each of the wares and services alleged in the application, having regard to the Opponent's use in Canada of a family of trade-marks consisting of the word COMPLIMENTS used alone or in combination with other words or elements, which were the subject of the following registrations or applications for registration:

COMPLIMENTS	TMA675,272
	TMA675,493

INSPIRED BY COMPLIMENTS	TMA695,183
INSPIRÉ PAR COMPLIMENTS	TMA684,657
	Application No. 1,274,391
CENTRE CULINAIRE COMPLIMENTS	TMA684,027
COMPLIMENTS CULINARY CENTRE	TMA684,026
	Application No. 1,279,453
	TMA684,292

2. Having regard to the provisions of s. 38(2)(b) of the Act, the Mark is not registrable in that it is identical to one of the Opponent's registered marks identified above and is confusing with the Opponent's other COMPLIMENTS trade-marks that are the subject of the registrations and applications for registration identified above;
3. Having regard to the provisions of ss. 38(2)(c) and 16(3) of the Act, the Applicant is not the person entitled to the registration of the Mark in that, at the filing date of the application in Canada and at any other relevant date, the Mark was identical to one of the Opponent's registered marks identified above and was confusing with the Opponent's other COMPLIMENTS trade-marks identified above, which were previously used in Canada by the Opponent; and
4. Having regard to the provisions of s. 38(2)(d) of the Act, the Mark is not distinctive of the Applicant's wares and services in that, at the date of the statement of opposition, the

Mark was not (and still is not) adapted to distinguish and did not (and still does not) actually distinguish those wares and services from the Opponent's wares and services in association with which the COMPLIMENTS trade-marks set out above were used.

[5] The Applicant filed a counter statement denying each and every one of the grounds of opposition.

[6] In support of its opposition, the Opponent filed an affidavit by Karin McCaskill, Senior Vice President, General Counsel and Secretary of the Opponent, sworn on June 19, 2009. In support of its application, the Applicant filed a certificate of authenticity for registration TMA507,227, held by the Applicant for the trade-mark COMPLIMENT, and certificates of authenticity for each of the following elements relating to the Opponent's trade-mark COMPLIMENTS(TMA675,272): that is, (i) the amended application dated July 13, 2005; (ii) the Examiner's Report dated April 19, 2005; and (iii) the July 13, 2005, reply to the Examiner's Report dated April 19, 2005.

[7] Each of the parties filed a written argument. Only the Opponent participated in an oral hearing.

Analysis

[8] The onus is on the Applicant to show that its application meets the requirements of the Act. However, it is up to the Opponent to ensure that each of its grounds of opposition is duly argued and to meet its initial evidentiary burden by establishing the facts used to support its grounds of opposition. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that none of these grounds of opposition prevents the registration of the Mark [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FC); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

[9] Applying those principles to this case, the ground of opposition based on s. 30(i) of the Act may be summarily rejected. The mere fact that the Applicant may have been aware that the Opponent's "COMPLIMENTS" family of trade-marks existed when it filed its application for

registration is not inconsistent with its statement that it was satisfied that it was entitled to use the Mark on the basis that, among other things, it is not confusing with the Opponent's marks "COMPLIMENTS". Where an applicant has filed the statement required by s. 30(i), such a ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the Applicant's part [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. There is no evidence of bad faith on the Applicant's part in this case.

[10] The three other grounds of opposition all hinge essentially on the likelihood of confusion between the Mark and one or several of the Opponent's COMPLIMENTS trade-marks. Unless otherwise specified, I will focus my analysis on the likelihood of confusion between the Mark and the Opponent's word mark COMPLIMENTS (TMA675,272), which I consider to be the most relevant. I will begin my analysis of the likelihood of confusion between the Mark and this one of the Opponent's marks with regard to the ground of opposition based on the non-registrability of the Mark.

Ground of opposition based on non-registrability of the Mark

[11] Although I will focus my analysis on the likelihood of confusion between the Mark and the Opponent's word mark COMPLIMENTS, it should be noted at this stage of my analysis that the Opponent's reference to pending applications for registration in support of its ground of opposition based on the non-registrability of the Mark is not a valid ground of opposition. Therefore, this ground of opposition is rejected with regard to those applications.

[12] By means of Ms. McCaskill's affidavit, the Opponent provided a copy of the extract from the Canadian Intellectual Property Office's Canadian Trade-marks Database showing the particulars of each of the registrations relied on in support of its ground of opposition based on the non-registrability of the Mark, including registration TMA675,272 for the mark COMPLIMENTS.

[13] The material date for the ground of opposition based on the non-registrability of a trade-mark as regards its being confusing with a registered trade-mark is the date of my decision

[see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)]. I have exercised my discretion and checked that the Opponent's registration TMA675,272 still appears as valid in the Register of Trade-marks. That being so, the Opponent has met its initial burden of proof. The Applicant must now show, on a balance of probabilities, that there is no likelihood of confusion between its Mark and this mark of the Opponent's.

[14] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that the 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.

[15] In deciding whether trade-marks are confusing, the Registrar must have regard to all of the surrounding circumstances, including those specifically 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 is not an exhaustive list, and different weight may be given to the various factors depending on the context [see *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée et al* (2006), 49 CPR (4th) 401, (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 92 CPR (4th) 361 (SCC)].

(a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[16] The parties' marks are identical and both possess an equivalent degree of inherent distinctiveness in the context of the wares and services associated with them. The marks both call to mind the polite phrase "with the compliments of" / "avec les compliments de". In that respect, I am of the opinion that their inherent distinctiveness is relatively moderate.

[17] The strength of a trade-mark may be increased by making it known through promotion and use. However, the Applicant has not filed any evidence of use of the Mark. The Opponent's evidence, filed by means of Ms. McCaskill's affidavit, establishes the facts that follow.

[18] The Opponent is a Nova Scotian corporation and a wholly owned subsidiary of Sobeys Inc. (Sobeys), which has been a wholly owned subsidiary corporation of Empire Company Limited since 2007. Over the years, Sobeys has grown from a small grocery store operating in Nova Scotia in the early 1990s to what is today the second-largest food retailer in Canada, with over 1,300 stores under various banners (including Sobeys, IGA, Price Chopper, etc.) spread throughout the 10 provinces [paragraphs 3 to 7 and 18 of the affidavit; annual reports and the "Annual Information Form[s]" filed as exhibits "A", "B" and "G" to "O"].

[19] Sobeys' private-label products are marketed in association with the Opponent's mark COMPLIMENTS. Ms. McCaskill explains that the mark was known as "Our Compliments" when Sobeys acquired it through the acquisition of The Oshawa Group Limited in 1998. In 2004, the Mark was relaunched by dropping the "Our" and by expanding the line of products offered [paragraph 8 of the affidavit].

[20] At this stage of my analysis, it should be noted that Ms. McCaskill's reference to "Sobeys" as the acquirer of the mark "Our Compliments" seems inaccurate. In my opinion, this should instead be understood as referring to the Opponent. In fact, the copies of the trade-mark registrations concerning the word mark OUR COMPLIMENTS and the French version, NOS COMPLIMENTS, included among the copies of the Opponent's registrations and applications for registration concerning its "COMPLIMENTS" family of trade-marks filed in a bundle as Exhibit "O", evidence the change of title that occurred on May 2, 1999, registered by the Registrar on April 17, 2001, by which these trade-marks registrations were assigned by The Oshawa Group Limited to the Opponent. Furthermore, Ms. McCaskill notes, later on in her affidavit, that the mark COMPLIMENTS, as well as all of the trade-marks consisting of the word "COMPLIMENTS" evidenced in Exhibit "O", are held by the Opponent [paragraph 28 of the affidavit].

[21] Ms. McCaskill continues her affidavit with a brief description of the COMPLIMENTS line of grocery products offered by Sobeys and of the line's continuous expansion since 2005. She refers to, among other things, the information set out in the various annual reports referenced above, which state that over 2,400 COMPLIMENTS products were introduced in 2005. This number jumped successively to over 3,700 (at the end of the 2006 fiscal year), then to over 4,400 (at the end of the 2007 fiscal year) and last to over 4,800 (at the end of the 2008 fiscal year) [paragraphs 9 and 11 and 15 to 19, 21 and 22 of the affidavit; annual reports and the "Annual Information Form[s]" filed as exhibits "A", "B" and "G" to "M"]. I note that the annual reports filed as exhibits "B", "H", "K" and "M" include, among other things, a number of photographs of sample products bearing the mark COMPLIMENTS.

[22] Ms. McCaskill explains that the launch of the mark COMPLIMENTS was and continues to be supported by the "Inspired by Compliments" magazine and its French version, "Inspirés par Compliments", launched in summer 2005. This magazine is distributed across Canada in all Sobeys, IGA, etc. supermarkets. The magazine is also sometimes distributed to Canadian households by mail and through the newspaper delivery. No fewer than two million copies of each issue of this magazine were distributed between summer 2005 and spring 2009 [paragraph 12 of the affidavit; copies of various issues of the French or English versions, filed in a bundle as Exhibit "C"]. I note, here as well, that these magazines include a number of photographs of products bearing the mark COMPLIMENTS. These magazines also show that Sobeys has organized various contests to promote the COMPLIMENTS products. The prizes offered through these contests include trips, such as a stay at Québec's Hôtel de Glace, two trips to Switzerland (the "Inspired Swiss Chocolate Fantasy Contest"), a trip to California ("The Ultimate Napa Getaway Contest"), etc. [see, among others, Vol. 2, Winter 2005; Vol. 4, Winter 2006; and Vol. 5, Summer 2007, included in Exhibit "C"]. These magazines also show the partnership between the COMPLIMENTS products and the AIR MILES® rewards program [see, among others, Vol. 3, Summer 2006, and the Winter 2007 issue].

[23] Ms. McCaskill adds that the launch and continuous use of the mark COMPLIMENTS was and is also supported through the operation of the www.compliments.ca Web site. The site, formerly operated under the name www.complimentscanada.ca, was launched in 2005. There

have been between 150,000 and 180,000 unique visitors to the site every year since it was launched [paragraph 13 of the affidavit; copy of a screen capture taken on March 8, 2009, filed as Exhibit “D”].

[24] Ms. McCaskill also provided, as Exhibit “E”, a representative sample of a promotional insert distributed in Sobeys supermarkets advertising various COMPLIMENTS products. Hundreds of thousands of these inserts have been published every week since 2004 [paragraph 14 of the affidavit].

[25] Ms. McCaskill states that sales of COMPLIMENTS products for the fiscal year ending on May 6, 2006, exceeded \$500 million. She also states that sales of COMPLIMENTS products for the 2007 and 2008 fiscal years totalled some \$2 billion [paragraphs 17 and 23 of the affidavit; annual reports referenced above].

[26] Given the sales figures and the expansion of the COMPLIMENTS product line she filed in evidence, Ms. McCaskill states that, when the Mark was advertised in the *Trade-marks Journal* of May 21, 2008, the mark COMPLIMENTS was by then well established and used to a considerable extent in Canada [paragraph 24 of the affidavit].

[27] In her affidavit, Ms. McCaskill goes on to explain the launch of “Club Sobeys”, which is a customer loyalty program that allows “Club Sobeys” cardholders to collect points and apply those points to their purchases at Sobeys stores. This program also includes a credit card, the “Club Sobeys Mastercard”, which bears the mark COMPLIMENTS in a stylized version that uses the font covered by registration TMA675,493 referenced above. Over 800,000 Canadians subscribed to the program between when it was launched, in September 2008, and the filing of the statement of opposition in this case, on October 21, 2008. Ms. McCaskill adds that another several hundred thousand consumers have since subscribed to the program, that is, between October 21, 2008, and the date of her affidavit [paragraphs 25 to 27 of the affidavit; sample brochure describing the program and the credit card filed as Exhibit “N”].

[28] Ms. McCaskill states that, as part of its commercial activities, Sobeys commissioned a survey on the Canadian public's recognition of the mark COMPLIMENTS. The survey, entitled "Private Label Brand Analysis", was conducted during the last quarter of 2007 and the first quarter of 2008. According to Ms. McCaskill, this survey confirms that the mark COMPLIMENTS enjoys significant recognition among the Canadian population. More specifically, she states that the mark COMPLIMENTS was recognized by approximately 80% of the Canadian population. Ms. McCaskill explains that, owing to sensitive commercial information contained in this survey, a copy of the survey is not attached to her affidavit. On this point, she adds that a copy of the relevant portions of this survey could be filed in the record at the Registrar's request, provided that this information can be protected by a confidentiality agreement. I am not prepared to give any weight to this survey, given that it was not filed in evidence by a qualified expert and there is no way for me to determine whether this survey was properly designed and conducted in an impartial manner [to this effect, see *Mattel, supra*, in which the admissibility of survey evidence is also discussed]. I should also add that, under s. 45(2) of the *Trade-marks Regulations*, SOR/96-195, all of the documents filed in an opposition are open to public inspection, such that the confidentiality of any document filed cannot be ensured by the Registrar, as proposed by Ms. McCaskill.

[29] In any event, even without this survey, I am of the opinion that it is reasonable to conclude from all of the evidence filed by Ms. McCaskill that the mark COMPLIMENTS was used by Sobeys such that it has become well known in Canada. The question that must then be asked is whether this use by Sobeys accrues to the benefit of the Opponent in accordance with s. 50 of the Act.

[30] I note, first, that the Opponent cannot rely on the presumption set out at s. 50(2) of the Act since none of the exhibits attached to Ms. McCaskill's affidavit establishes that public notice was given of the identity of the owner and of the fact that the use of the mark COMPLIMENTS (or any other mark in the "COMPLIMENTS" family of trade-marks alleged in the statement of opposition) is a licensed use. The Opponent also cannot rely on s. 50(1) of the Act in that Ms. McCaskill's affidavit makes *absolutely* no mention of the fact that the mark COMPLIMENTS (or any other mark in the "COMPLIMENTS" family of trade-marks alleged in

the statement of opposition) is used under licence and that the Opponent has, under the licence, direct or indirect control of the character or quality of the wares or services associated with the mark COMPLIMENTS.

[31] The mere fact that the Opponent is a wholly-owned subsidiary of Sobeys is not, in itself, sufficient to infer that there is such a licence or that the Opponent exercises control in respect of any such licence, especially since the various copies of the annual reports filed in evidence by Ms. McCaskill show the total number of Sobeys subsidiaries and establish the fact that Sobeys has or franchises, directly or indirectly, some 1,300 stores spread across the 10 Canadian provinces. The case law is consistent that organizational structure, in itself, is insufficient to establish that there is a licence and does not support a deduction that the owner of a trade-mark controls the character or quality of the wares and services used in respect of such a licence. See, among others, the decisions in *Loblaws Inc v No Frills Auto Truck Rental Ltd*, 2004 CarswellNat 3135 (TMOB) reversed on other grounds (2006) 49 CPR (4th) 179 (FC); *Loblaws Inc v Triptap Food Broker* (1999), 3 CPR (4th) 108 (TMOB); *Automobility Distribution Inc v Jiangsu Electronics Industries* (2005), 43 CPR (4th) 157 (TMOB); *MCI Communications Corp v MCI Multinet Communications Inc* (1995), 61 CPR (3d) 245 (TMOB); *Dynatech Automation Systems Inc v Dynatech Corp* (1995), 64 CPR (3d) 101 (TMOB); and *3082833 Nova Scotia Co v Lang Michener LLP*, 2009 FC 928, in which the Court stated at paragraph 32:

32. . . . A licensing agreement may be inferred from the facts. A licensing agreement need not be in writing However, the mere fact that there is some common control between the applicant's companies is not sufficient to establish that the use of the trade-mark was controlled and therefore infer a licensing agreement Evidence of control has to be adduced.

[32] To conclude on this point, the evidence of use filed by Ms. McCaskill is too vague and incomplete to allow me to infer that the Opponent has direct or indirect control of the character or quality of the wares and services associated with the mark COMPLIMENTS under a licence for its use. Thus, the evidence of use of the mark COMPLIMENTS by Sobeys cannot accrue to the Opponent's benefit under s. 50 of the Act.

[33] Considering the above, I am of the opinion that the overall assessment of the inherent distinctiveness of the trade-marks at issue and the extent to which they have become known does not weigh in either party's favour. However, the degree of resemblance between the marks significantly favours the Opponent, since the marks are identical.

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

[34] Since the evidence of use of the mark COMPLIMENTS filed by Ms. McCaskill does not accrue to the Opponent's benefit, the length of time the marks have been in use favours neither party.

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

[35] In considering the nature of the wares and services and the nature of the trade, I must compare the statement of the wares and services contemplated by this application for registration with the statement of the wares and services covered by registration TMA675,272 [see to this effect *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[36] I reproduce, as an appendix to my decision, the statement of the wares and services covered by registration TMA675,272, which includes a wide range of grocery products, including food products and personal hygiene and household maintenance products, as well as services related to the operation of supermarkets and grocery stores and to the retail sale of cooking tools and utensils. By their very nature, these wares and services are entirely different from the wares and services contemplated by this application.

[37] I understand that credit cards, prepaid cards or various coupons may be used to obtain grocery products from the Opponent, just as from any merchant in general that operates in the retail trade. However, I am of the opinion that such cards or coupons cannot, by that mere fact, be considered a "natural extension" of the wares covered by registration TMA675,272. Moreover, it should be recalled, on this point, that the various types of cards and coupons

contemplated by this application expressly exclude all such wares for the acquisition of food products, in-store or online.

[38] Likewise, although I can understand the interest for the Opponent, just as for any merchant in general, to improve the provision of its services through a customer loyalty program, I am not prepared to conclude that the types of services contemplated by this application are a “natural extension” of the services covered by registration TMA675,272. I should note, on this point, that the services for the organization of commercial customer loyalty programs contemplated by this application expressly concern hotel services, transportation services, vehicle rental services and leisure and entertainment services, and expressly exclude all such services for the acquisition of food products, in-store or online. This exclusion applies to each type of service contemplated by this application.

[39] Given the differences between the natures of the parties’ wares and services, I am of the opinion that it is reasonable to infer that the natures of the parties’ businesses are also different, although the customer base targeted by each seems to me to be the same, that is, the Canadian population in general.

Additional circumstances

Reply to the Examiner's Report

[40] Although the Applicant did not expressly refer to this in its written argument, the Applicant seems to wish to use, as an admission against the Opponent's interest, the reply to the Examiner's Report filed by the Opponent in the prosecution of its application No. 1,227,875 for the word mark COMPLIMENTS, which resulted in registration TMA675,272.

[41] More specifically, this reply was aimed at overcoming the objection raised under paragraph 12(1)(d) of the Act by the Examiner in his Examiner's Report in respect of the Applicant's mark COMPLIMENT (TMA507,227), for which the statement of the wares and services overlapped most of the wares and services contemplated by this application, although without the exclusions, and also covered other types of wares and services. As for the Opponent's original application, it contemplated the list of wares and services appended to my decision (that is, those possibly covered by registration TMA675,272) in addition to other wares and services that were removed or given greater specificity in the amended application for registration attached to the Opponent's reply.

[42] In its reply, the Opponent had argued, among other things, that the parties' wares and services did not overlap. More specifically, the Opponent had submitted that its application "is now restricted to wares and services completely unrelated to those in respect of which [Accor/Edenred's COMPLIMENT trade-mark] is registered".

[43] The Opponent submits that this reply cannot be validly accepted against it in this case, considering, in particular, the fact that application No. 1,227,875 was filed on August 23, 2004, on the basis of the *proposed* use of the mark COMPLIMENTS in Canada and that, at the date of the reply to the Examiner's Report, the Opponent's mark COMPLIMENTS had been used and become known to a far lesser extent than the extent prevailing at the date of the statement of opposition in this case.

[44] However, as stated above, the extent to which the Opponent's mark COMPLIMENTS has become known cannot be taken into account in this case, considering the information left out of Ms. McCaskill's affidavit on the licensed use of the mark and the control exercised under such a licence. Therefore, in my opinion, the argument developed by the Opponent in its reply to the Examiner's Report regarding the lack of overlap between the nature of the parties' wares and services applies, to a certain extent, in this case, given the similarities between the statements of the wares and services that were at issue in the examination file for the application for registration No. 1,227,875 and those at issue in this case.

[45] Although this additional factor is not determinative in itself and each case must be decided in accordance with the circumstances of the case, this additional factor lends some support to the conclusions I reached previously in respect of s. 6(5)(c) of the Act.

Family of trade-marks

[46] The Opponent argues that it holds a family of trade-marks consisting of the word COMPLIMENTS used alone or in combination with other words or elements, since the exhibits attached to Ms. McCaskill's affidavit evidence, among other things, the use of the word mark COMPLIMENTS and the illustrated stylized version in registration TMA675,493, as well as the marks INSPIRÉ PAR COMPLIMENTS (TMA684,657), INSPIRED BY COMPLIMENTS (TMA695,183), COMPLIMENTS VALUE ÉCONOMIQUE & Design (application No. 1,274,391), alleged in support of the statement of opposition, as well as the marks COMPLIMENTS SENSATIONS, COMPLIMENTS BALANCE – ÉQUILIBRE, COMPLIMENTS BIOLOGIC ORGANICS, COMPLIMENTS JUNIOR, etc.

[47] Given that the use of this family of trade-marks does not accrue to the benefit of the Opponent under s. 50 of the Act, the Opponent has not established such use. Thus, the Opponent cannot allege that there is a family of trade-marks [see, to this effect, *Techniquip Ltd v COA* (1998), 3 CPR (4th) 298 (FCA)].

Prior registration

[48] Although the Applicant does not expressly refer to this in its written argument, it seems that the Applicant wishes to submit that it already holds a trade-mark registration for the mark COMPLIMENT, that is, the above-noted registration TMA507,227.

[49] However, it is well known in law that s. 19 of the Act does not give the owner of one registration the right to obtain the registration of other marks, even if those marks are closely associated with the mark contemplated by the initial registration [see *Coronet-Werke Heinrich Schlerf GmbH v Produits Menagers Coronet Inc*, 4 CPR (3d) 108 (TMOB); *Groupe Lavo Inc v Proctor & Gamble Inc*, 32 CPR (3d) 533 (TMOB)]. In the case at hand, this application is opposed by the Opponent and I must rule on the merits of the opposition given the particular circumstances in this file.

Conclusion – likelihood of confusion

[50] In light of my analysis above and considering, more specifically, the relatively moderate inherent distinctiveness of the marks at issue and the differences between the parties' wares and services, I am of the opinion that the Applicant has established, on a balance of probabilities, that a consumer having an imperfect recollection of the Opponent's mark COMPLIMENTS would be unlikely to conclude that the Applicant's wares and services are from the same source or are otherwise related to or associated with the Opponent's wares and services.

[51] On this point, I would add that, although I focused my analysis on the likelihood of confusion between the Marks and the Opponent's word mark COMPLIMENTS (TMA675,272), my conclusion on this ground of opposition remains the same if I instead consider the Opponent's other registered marks alleged in support of this ground of opposition. The differences between these other trade-marks belonging to the Opponent and the Mark are another factor weighing in the Applicant's favour. Although the statements of the wares and services covered by these other registrations held by the Opponent are not necessarily identical to the statement covered by registration TMA675,272 in that they include, among other things, "a

consumer brands magazine featuring products and meal ideas” (marks INSPIRED BY COMPLIMENTS and INSPIRÉ PAR COMPLIMENTS) and “operating cooking schools and culinary education centres” (marks CENTRE CULINAIRE COMPLIMENTS and COMPLIMENTS CULINARY CENTRE (word and design versions)), these wares and services are still very different from those contemplated by this application.

[52] Given the above, I completely dismiss the ground of opposition based on the non-registrability of the Mark.

Ground of opposition based on non-distinctiveness

[53] To meet its initial evidentiary burden for non-distinctiveness, the Opponent must show that one or several of its “COMPLIMENTS” trade-marks had become sufficiently known in Canada at the date of the statement of opposition to negate the distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FC); and *Bojangles’ International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)]. However, since the evidence of use of the marks “COMPLIMENTS” alleged by the Opponent does not accrue to its benefit, I must conclude that the Opponent has failed to meet its initial evidentiary burden for this ground of opposition. Consequently, I reject the non-distinctiveness ground of opposition.

[54] On this point, I would add that if the evidence of use filed by Ms. McCaskill had accrued in the Opponent’s favour, or if the Opponent had argued Sobeys’ use of the marks “COMPLIMENTS” in its ground of opposition, my conclusion on this ground of opposition could have been different. My analysis of the likelihood of confusion would have taken into account, among other things, the fact that the use of the mark COMPLIMENTS had expanded continuously since it was relaunched in 2004 and was well known in Canada. In addition, my analysis of the differences between the types of wares and services and the nature of the parties’ trades would not have been limited to the statement of the wares and services covered by the Opponent’s registration TMA675,272 (as in the case of the ground of opposition based on the non-registrability of the Mark), but would have also taken into account the fact that there is some overlap between the types of wares and services contemplated by this application and the

“incidental” products and services offered by Sobeys through its customer loyalty and credit card program launched in September 2008, the holding of contests to promote trips, the partnership with the AIR MILES® program, etc.

Ground of opposition based on s. 16(3) of the Act

[55] To meet its initial burden of proof as regards s. 16(3)(a) of the Act, the Opponent must show that one or more of its trade-marks “COMPLIMENTS” had been previously used in Canada and had not been abandoned at the date of advertisement of the Applicant’s application [s. 16(5) of the Act]. However, since the evidence of the use of the mark “COMPLIMENTS” alleged by the Opponent does not accrue in its favour, I must conclude that the Opponent has failed to meet its initial evidentiary burden for this ground of opposition. I must therefore reject this ground.

[56] I would add here, as well, that if the evidence of use filed by Ms. McCaskill had accrued in the Opponent’s favour, my conclusion of this ground of opposition could have been different.

Decision

[57] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition under s. 38(8) of the Act.

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

Certified true translation
Sarah Burns, Translator

Appendix

Statement of the wares and services covered by registration TMA675,272

(1) Acetaminophen as an oral analgesic; acetaminophen combined with codeine in tablet or capsule form as an oral analgesic; acetylsalicylic acid; adhesive bandages; adhesive for bandages for skin wounds; adult diapers; after-sun lotions; alcohol for topical use; alcohol swabs; ale; all purpose cotton swabs; all purpose disinfectants; allergy medications; allergy relief medication; almond spreads; aluminum foil; ammonia for cleaning purposes; analgesic balm; analgesics; antacids; anti-aging cream; antibacterial handwash; antibacterial pharmaceuticals; antibiotic creams; antibiotic handwash; antibiotic ointments; antihistamines; anti-inflammatories; anti-microbial handwash; antiperspirants; antiseptics; anti-static dryer sheets; anti-wrinkle cream; artificial sweeteners; baby conditioner; baby formula; baby lotion; baby oil; baby powder; baby shampoo; baby wipes; baked beans; baking chocolate; baking powder; baking soda; bandages; barber scissors; bath and shower gels; bath and shower oils and essential oils; bath oils; bath salts; bathing additives, namely foam, gel, oil, powder and crystals; bathroom tissue; beauty creams; beer; beverages, namely water, aromatised water, mineral water, spring water, soy-based drinks, sodas, pops, fruit juices, vegetable juices, non-alcoholic fruit sodas, carbonated and non-carbonated soft drinks, vegetable juices, non-alcoholic fruit beverages, juice concentrates, fruit drinks namely non-carbonated fruit-flavoured drinks, non-alcoholic vegetable beverages, and concentrates for making such beverages; bird food; biscuits; bleach; body cream; body oil; body powder; body scrubs; body shampoos; body smoothers; boric acid; bottle liners; bread; breath freshener; bronzers and sun tanning creams and lotions; bubble bath; buns; burn relief medication; cake mix; cakes; calcium supplements; camera film; candies; canned, fresh and frozen pasta dishes; cat litter; cereal; cereal based snack bars; cereal based snack food; cheese; chemical preparations for the treatment of premenstrual and menstrual pain; chemical preparations to relieve chest pain; chemical preparations to relieve muscle and back pain; chocolate bars; chocolates; cigarette lighters; cleansers and cleaners namely all-purpose household cleaners, disinfectants, dish detergents, glass cleaners, oven cleaners and powder cleansers; cocoa; coconut; coffee; coffee creamer; coffee filter baskets; coffee filter papers; coffee whiteners; cold cream; cold sore treatment preparations; combinations of fruit and nuts in bar form; compression bandages; condiments; cookies; cooking oil; cosmetic pads; cotton balls; cotton balls for cosmetic purposes; cotton for cosmetic purposes; cotton swabs for cosmetic purposes; cough drops; cough expectorants; cough lozenges; cough syrups; cough treatment pharmaceutical preparations; crab meat; crackers; cream cheese; croutons; curry dip; cuticle conditioners; cuticle knives; cuticle nippers; cuticle pushers; cuticle removing preparations; cuticle scissors; cuticle trimmers; dandruff shampoo; de-alcoholised beer; decongestants, namely nasal sprays and capsules; dental floss; dental hygiene products, namely mouthwash; dental rinse; denture cleaning preparations; dentures; deodorant; deodorant soaps; antiperspirants; dessert topping mix; desserts, namely sorbet, shortbread, puddings, cakes, pastries and crisps; diapers; diarrhea medication; dietary aids, namely a lactase enzyme used to assist in the digestion of lactose; dietary supplements, namely vitamins, minerals and lecithin; dishcloths; dishwasher detergent; disinfectant soaps; disinfecting handwash; dispensers for pills or capsules sold empty; disposable diapers; disposable latex gloves; disposable wipes without chemicals or compounds for household use and personal hygiene; distilled water; diuretic preparations; drain cleaners;

dried herbs and herb extracts; dried soup mixes; dropper bottles for administering medication, sold empty; droppers for administering medication, sold empty; ear drum protectors; ear plugs for swimming purposes; ear plugs not for medical purposes; egg rolls; eggs; elastic bandages; elastic bands for eyeglasses; emery boards; energy bars; epsom salts; evaporated milk; exfoliants; expectorants; eye droppers; eye drops; eye patches; eyeglass chains and cords; eyeglass comfort pads; eyeglass repair kits; eyelash curlers; eyelid creams and pencils; eyeliners; fabric softener; face and body creams and lotions; facial cleansers; facial creams; facial tissues; feminine pads and panty liners; feminine protection products, namely sanitary napkins and panty shields; files and buffers for use in foot and nail care; finger moisteners; fire logs; first aid kits; flat bread; flour; flowers; folic acid; food supplements, namely granola-based, cereal based, rice-based, wheat-based, fruit-based or soy/flax-based snack foods in liquid powder or bar form, dried herbs and herb extracts, cereals and dried fruits; foot care products, namely corn cutters and, corn cutter blades; frankfurters; fresh pizza; fresh, bottled, tinned and dried fruits; fresh, bottled, tinned and frozen vegetables; fresh, frozen and canned meat, beef and pork and prepared meat, beef and pork products namely ham, bacon, bologna, salami, pepperoni, corned beef, pastrami, sausage and wieners; fresh, frozen and canned poultry and prepared poultry products; fresh, frozen and canned fish; frosting mix; frozen ice cream confections; frozen ice cream novelties; frozen pizza; fruit based snack food; fruit cake; fruit-based snack bars; furniture polish; glycerine and rosewater; glycerine suppositories; glycerine; granola bars; granola-based snack bars; gravy; hair conditioners; hair creams and lotions; hair gel; hair lotions; hair mousse; hair shampoo-conditioners; hair spray; hand cream; hand lotions; health food or health food supplements, namely brewer's yeast, calcium, calcium and phosphorous, camomile, devil's claw, feverfew, garlic and parsley, ginseng, magnesium and wheat germ; hemorrhoid treatment preparations, namely ointments; herbal food beverages; herbal remedies and supplements for the relief of the symptoms associated with menopause, PMS, weakened immune systems, colds, sore throats, influenza and nasal congestion; honey; hosiery; hot chocolate mix; hot water bottles; household gloves for general use; hydrogen peroxide for medical use; ibuprofen as an oral analgesic; ice cream; ice cream cones and cups; incontinence products namely garments and pads; iodine; iron supplements; jams; jellies; jelly powder; jelly rolls; ketchup; lard; laundry detergent; laxatives; lecithin for use as a dietary supplement; lemonade; light bulbs; lighter fluid; lip balms; liquid soaps for hands, face, and body; lunch bags; macaroni; macaroni and cheese; malt beverages; manicure sets; manicure sticks and emery boards; margarine; marmalades; marshmallows; matches; mayonnaise; meal replacement bars; meal replacement drinks; meal replacement powders; dietary supplements, namely meal replacement drink mixes; meat pies; medicated chest rub; medicated cream for the treatment of stiff and sore muscles, arthritis and similar ailments; medicated lozenges; medicated mouthwash; medicated pre-moistened wipes; medicated shampoo; medicated shaving preparations; medicated skin care preparations namely creams, lotions, sunburn creams, soaps; medicated skin, sunburn, hair, facial and body lotions; milk and milk products namely cream, cottage cheese, sour cream, yogurt, eggnog and butter; mineral oil; mineral water; motion sickness treatment pharmaceutical preparations; motor oils; mousse for use on the hair or skin; mouth rinses; mouthwash; muffins; multi-grain chips; muscle relaxants; mustache scissors; mustard; nail brushes; nail buffing preparations; nail care preparations namely nail polish, nail cream, nail polish remover, and nail cuticle softener; nail clippers; nail files; nail nippers; nail scissors; nail white pencils; nasal spray preparations; natural source fiber tablets; non-medicated bath salts; non-medicated dental rinse; non-medicated lip balm; non-medicated

lozenges; non-medicated mouth rinse; non-medicated mouthwash and rinse; non-medicated sunburn lotions; noodles; nose clips; nose drops; nuts; odour neutralizing preparations for use on carpets and textiles; olives; oral analgesics; pancake mix; panty shields; pantyhose; paper and plastic tableware; paper bags; paper napkins; paper serviettes; paper towels; pasta; pasta sauce; peanut butter; peat moss; pedicure sets; pepper; personal deodorants; pet foods; petroleum jelly for cosmetic and medical purposes; pharmaceutical preparations for nausea treatments; pharmaceutical preparations for sinus treatment and medication; pharmaceutical preparations for treating colds and allergies; pharmaceutical preparations to assist with sleep in liquid, tablet or capsule form; pharmaceutical preparations to relieve digestive and intestinal disorders; pharmaceutical preparations to relieve heartburn; pickles; pie filling; pie filling mix; pies; pillboxes; pizza mix; plastic garbage and kitchen bags; plastic pillboxes; plastic strips; plastic wrap; popcorn; potato chips; potting soil; powder puffs; pregnancy test kits for home use; preparations made with plant extracts, namely liquids in ampoules and in bottles, capsules and tablets for the treatment of colds, flu and headaches; prepared meals; protein products, namely, herbs, for cooking; protein products containing protein, namely herbs, for cooking; medicinal minerals and vitamins; pudding; puff pastry appetizers; pumice sponges and stones; quiche; quinine water; razor blades; razors; relish; rice; rice cakes; rice-based snack bars; rolls; rubber gloves; rubber household gloves; rubbing alcohol; saccharin; salad dressing; salads; saline solution; salsa; sanitary napkins; sanitary pads; sauces, namely barbecue, spaghetti, pasta, hollandaise, seafood, steak, béarnaise, horseradish, cranberry, marinade, tartar, seafood dipping and dessert sauces; sausages; scissors; sculpting gel; shampoo, conditioner and gel; shaving brush stands; shaving brushes; shaving cream; shaving foam; shaving gel; shaving lotion; shortening; shower gel; skin cleansers; skin cleansing cream; skin cleansing lotion; skin conditioners; skin cream; skin emollients; skin lotion; skin moisturizers; skin soap; skin softeners; skin texturizers; skin toners; skin treatment and moisturizing lotions, liquids, gels, spray, creams and soap; snack food dips; soap; soft drink mixes and crystals; soil; soups; soya/flax bars; spaghetti; spaghetti sauce; spices; sponges; spring rolls; stain remover; styling gels; styling lotions; sugar; sun block preparations; sun protection creams and lotions; sun screen preparations; sun tan gel; sun tan lotions; sundae sauces; sunflower oil; swabs; syrup namely chocolate syrup, corn syrup, flavouring syrup, maple syrup, pancake syrup, table syrup and topping syrup; taco sauces; taco shells; tampons; tarts; tea; tea bags; tea towels; thermometers for medical purposes; throat lozenges; tobacco products; toilet soaps; toilet brushes; toilet deodorizers; toilet tissue; tomato paste; tomato sauce; toothbrushes; topical analgesics; topical anesthetics; topical gel; topical heat rub; tweezers; vegetable cooking spray; vegetable oil; vitamin and mineral supplements; vitamins; waffles; waxed paper; wheat-based snack bars; whipped topping; wintergreen oil; witch hazel; women's hosiery; wrinkle removing skin care creams; yeast; zinc and castor oil ointment; zinc cream.

(1) Operating supermarkets and grocery stores; retail sale of cooking tools and utensils.