

IN THE MATTER OF AN OPPOSITION by Provigo Inc. to  
application No. 568,443 for the trade-mark PROVIMI filed by  
Provimi Veal Corporation

On August 28, 1986, the applicant, Provimi Veal Corporation, filed an application to register the trade-mark PROVIMI based upon use of the trade-mark in Canada in association with "raw meat for human consumption, namely veal" since at least as early as July 1977.

The opponent, Provigo Inc., filed a statement of opposition on April 9, 1987 in which it alleged that the applicant's application is not in compliance with Section 29(a) (now Section 30(a)) of the Trade-marks Act in that the applicant has not used the trade-mark PROVIMI in Canada since the claimed date of first use and has not used the trade-mark continuously in this country since July 1977. The opponent also alleged that the applicant's application is not in compliance with Section 29(i) (now Section 30(i)) of the Act in that the applicant could not have been satisfied that it was entitled to use the trade-mark in Canada in association with the sale of veal for human consumption in view of the existence of the large number of confusingly similar trade-marks of the opponent having the prefix PROVI which have been registered in association with food products. Further, the opponent alleged that the applicant's trade-mark is not registrable in that it is confusing with the opponent's registered trade-marks: PROPRIO; PROVI; PROVI D'OR ; PROVI-NIGHT; PROVI-NUIT; PROVI-NITE; PROVI-SOIR; PROVI-SOIR & Dessin; PROVI-VIANDE; PROVIBEC; PROVICENTRE; PROVICHOIX; PROVIGAIN; PROVIGET; three registrations for the trade-mark PROVIGO; PROVIGO & Dessin; PROVIGO Dessin; PROVIGOR; PROVIPOP; and PROVIPRIX. The opponent also challenged the applicant's entitlement to registration of the trade-mark PROVIMI in view of the prior use by the opponent in Canada of its trade-marks PROVIGO, PROVISOIR and PROVI in association with the sale of food products and services related to the operation of stores selling food products. Finally, the opponent alleged that the applicant's trade-mark is not distinctive.

The applicant served and filed a counter statement in which it asserted that its application complies with Section 30 and further that its trade-mark PROVIMI is not confusing with the opponent's trade-marks.

The opponent was granted leave pursuant to Rule 46(1) of the Trade-marks Regulations to file as its evidence the affidavits of Linda Thiffault and Robert Charbonneau. The applicant failed to file evidence in a timely manner in this opposition.

The applicant alone filed a written argument and both parties were represented at an oral

hearing.

The Charbonneau affidavit has annexed to it copies of the trade-mark registrations relied upon by the opponent in its statement of opposition. The Thiffault affidavit has annexed to it English and French versions of the opponent's Annual Report for 1988. However, the Annual Reports are dated subsequent to the date of opposition and the applicant's claimed date of first use, the material dates in this proceeding, and are therefore of little evidentiary value in this opposition.

With respect to the Section 30 grounds of opposition, the legal burden is on the applicant to establish that its application complies with Section 30 of the Trade-marks Act. However, there is an initial evidentiary burden on the opponent to establish the fact relied upon by it in respect of its Section 30 grounds. In this regard, no evidence has been adduced by the opponent in support of its allegations that the applicant has not used its trade-mark in Canada since July 1977 or continuously since that date. Accordingly, the first Section 30 ground of opposition is rejected.

The opponent has relied upon prior use of its trade-marks PROVIGO, PROVISOIR and PROVI in challenging the applicant's entitlement to registration. However, the opponent has failed to meet the burden upon it under Sections 16(5) and 17(1) of the Trade-marks Act of establishing its use of these trade-marks in Canada in association with the sale of food products and the operation of stores selling food products prior to the applicant's claimed date of first use of July 1977, as well as establishing non-abandonment of the trade-marks in this country as of the date of advertisement for opposition purposes of the applicant's trade-mark in the Trade-marks Journal (March 4, 1987). Accordingly, this ground of opposition is also rejected.

The opponent's Sections 12(1)(d) and 30(i) grounds of opposition are based on the allegation that the applicant's trade-mark is not registrable and not distinctive in that the applicant's trade-mark PROVIMI is confusing with one, or more, of the opponent's registered trade-marks identified above.

In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue as of the date of opposition, the material date with respect to the section 12(1)(d) ground of opposition, the Registrar must have regard to all the surrounding circumstances, including those criteria which are enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks of the parties as of the material date.

The trade-marks of the parties are inherently distinctive and as no relevant evidence has been adduced by the parties in respect of the issue, I must consider for the purposes of deciding the outcome of this opposition that neither the applicant's trade-mark PROVIMI nor any of the opponent's registered trade-marks set forth in its statement of opposition have become known to any extent in Canada as of the date of opposition. Likewise, the length of time that the trade-marks have been in use is not a relevant factor in this opposition.

With respect to the nature of the wares and the channels of trade associated with the wares of the parties, the applicant's application covers raw veal for human consumption while the opponent's registered trade-marks PROVI, PROVIGO, PROVIGO & Design, PROVIPRIX and PROVI-SOIR cover lengthy lists of food products including such meat products for human consumption as "viande en conserve, saucisses au porc, saucisses fumées, jambon cuit, jambon désossé, ragout de boulettes, bologna ciré, bacon, gelée de veau, pain de porc, pain de poulet, roll de poulet, roll salami boeuf long, pain poulet, pain porc, boeuf fumé". Further, and in the absence of any evidence to the contrary or any limitation in the applicant's statement of wares or in the statements of wares set forth in the opponent's registrations, the channels of trade associated with the wares of the parties must be considered as being overlapping for the purposes of deciding the outcome of the present opposition proceeding.

As to the degree of resemblance between the trade-marks at issue, I consider the trade-marks PROVIMI and PROVI to be very similar both in appearance and in sounding although the trade-marks do not suggest any ideas in common. On the other hand, I consider there to be somewhat less similarity in appearance and sounding between the applicant's trade-mark and the opponent's registered trade-marks PROVIGO, PROVIGO & Design, PROVI-SOIR and PROVIPRIX.

Having regard to the above, I have concluded that the applicant has failed to discharge the burden upon it of establishing that there would be no reasonable likelihood of confusion between its trade-mark PROVIMI and the opponent's registered trade-mark PROVI. Accordingly, the applicant's trade-mark is not registrable in view of the provisions of Section 12(1)(d) of the Trade-marks Act.

I refuse the applicant's application pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 31st DAY OF July, 1990.

G.W.Partington,  
Chairman,  
Trade Marks Opposition Board.