

**IN THE MATTER OF AN OPPOSITION by
Amico Fine Foods Inc. to
application No. 1,003,398
for the trade-mark SULTAN
filed by Edsall Group U.S.A., Inc.**

On February 2, 1999, Edsall Group U.S.A., Inc., the applicant, filed an application to register the trade-mark SULTAN. The application is based upon proposed use of the trade-mark in Canada in association with:

**Meat, fish, poultry and game;
meat extracts;
preserved, dried, and cooked fruits and vegetables;
jellies, jams, fruits, meat sauces;
eggs, milk; edible oils and fats;
coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee;
flour, bread, pastry and confectionery namely cookies, cake rusk, puff pastry;
ices;
honey, treacle;
yeast, baking-powder;
salt, mustard;
vinegar;
sauces, namely, marinades (condiments);
spices, namely, seasonings;
ice.**

The application was advertised for opposition purposes in the Trade-marks Journal of June 7, 2000. The opponent, Amico Fine Foods Inc., filed a statement of opposition on June 29, 2000. The applicant filed and served a counter statement in which it denied the opponent's allegations.

The opponent filed as its evidence the affidavit of its president, Maan Abdulwahab. As its evidence, the applicant filed the affidavit of Tonia Pedro, a law clerk.

Only the applicant filed a written argument. An oral hearing was not held.

In the statement of opposition, the opponent alleges that the applicant is not the person entitled to register the trade-mark and that the trade-mark is not distinctive, because there is a likelihood of confusion between the applicant's SULTAN trade-mark and the opponent's trade-mark SULTAN, which the opponent claims to have previously used in Canada in association with a variety of food products.

There is a legal burden on the applicant to establish on a balance of probabilities that there would not be a likelihood of confusion between its mark and the mark pleaded by the opponent. [see *Dion Neckwear Ltd. v. Christian Dior, S.A.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)] However, there is an evidential burden on the opponent to first adduce sufficient evidence to support the truth of its allegations.

With respect to the entitlement ground of opposition, the opponent must evidence use of its trade-mark prior to the applicant's filing date and establish non-abandonment of its mark as of the date of advertisement of the applicant's application [subsections 16(5) and 17(1), *Trade-marks Act*].

Mr. Abdulwahab states, without any supporting documentation, that Amico Fine Foods Inc. purchased the assets of Jericho Foods Inc., including all unregistered trade-marks, in or about March 1999. He further attests that Jericho Foods Inc. commenced usage of the trade-mark SULTAN in February 1990 in association with a variety of food products. As Exhibit "A", he provides "true copies of invoices for the sale and distribution of SULTAN products by Jericho

Foods Inc. and Amico Fine Foods Inc.” The first of these invoices is dated April 18, 1991 and the last August 29, 2000. The sales are to Canadian businesses and the bodies of the invoices that predate February 2, 1999 include references to Sultan olive oil, Sultan sardines, Sultan grape leaves, Sultan basmati rice, Sultan cucumber, and Sultan pickles. Mr. Abdulwahab attests “that since February of 1999 Amico Fine Foods Inc., by itself or through a licensee or through its predecessor(s) in title has displayed the trademark, SULTAN, on all packaging/labelling of the aforesaid wares.” However, he does not provide a representative package or label and “February of 1999” does not necessarily predate February 2, 1999. Moreover, the fact that the opponent does not claim to have acquired the rights to the SULTAN trade-mark until in or about March 1999 raises questions about the role that it played in February 1999.

Mr. Abdulwahab has not provided any information concerning the nature of the opponent’s business or its channels of trade, but Jericho Foods Inc.’s invoices refer to it as “importers & distributors of quality foods”. I also note that there are invoices dated 1996 in the name of Amico Fine Foods Inc., *i.e.* well before the date when it claimed to have acquired the rights to the mark.

Overall, the opponent’s evidence does not show prior use of the trade-mark SULTAN by the opponent or a predecessor-in-title in accordance with section 4 of the *Trade-marks Act*. As of February 2, 1999, the opponent does not claim to have owned a SULTAN trade-mark and there is no evidence that its alleged predecessor acted as other than an importer or distributor in association with any wares bearing a SULTAN trade-mark. In other words, without seeing the labels or packaging that was in use with the invoiced wares as of February 2, 1999, I cannot tell if Jericho Foods Inc. had any rights that it could assign to the opponent.

Mr. Abdulwahab's evidence does not satisfy the opponent's initial burden with respect to its entitlement ground of opposition and that ground therefore fails.

Although Ms Pedro's evidence concerning her purchase of SULTAN olive oil that bore a third party's name post-dates the material date, it appears to support the concerns that arose from Mr. Abdulwahab's affidavit, namely that SULTAN may have been used by someone other than the opponent or its alleged predecessor-in-title.

With respect to the ground of opposition based on non-distinctiveness, the opponent has pleaded that the applicant's mark does not distinguish nor is it adapted to distinguish the wares of the applicant from the wares of the opponent, as the opponent had been using the confusingly similar trade-mark SULTAN in Canada in association with various food items. The material date with respect to this ground of opposition is June 29, 2000 [see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)]. This ground of opposition also fails as a result of the opponent not having satisfied its initial burden. Although the opponent's affiant states that it or a licensee or a predecessor displayed the trade-mark on packaging/labeling, without seeing such packaging/labeling, I cannot tell whose name was associated with the trade-mark. If it was a licensee, then there is no basis on which to conclude that such use enured to the opponent's benefit pursuant to section 50. Overall, the evidence does not support a conclusion that the opponent had been using SULTAN in association with various food items prior to June 29, 2000, as is required to support the pleadings.

Having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the *Trade-marks Act*, I reject the opposition pursuant to subsection 38(8) of the *Act*.

DATED AT GATINEAU, QUEBEC, THIS 20th DAY OF JANUARY 2004.

Jill W. Bradbury
Member
Trade-marks Opposition Board