

TRADUCTION/TRANSLATION

**In the opposition by Suzanne Ruest to
application for registration No. 1024903
for the trade-mark CARAMIEL
filed by Les Ruches Promiel Inc.**

On August 3, 1999, Les Ruches Promiel Inc. (the Applicant) filed an application to register the trade-mark CARAMIEL (the Mark) in association with honey caramel, based on a proposed use since April 1996.

Suzanne Ruest (the Opponent) filed a statement of opposition on October 18, 2000. The Registrar, in a notice dated November 6, 2000, asked the Opponent to reformulate her statement of opposition so that it would comply with the *Trade-Marks Act* (the Act). On November 22, 2000, following this notice, the Opponent filed a statement of opposition that complied with the Act. Essentially, the Opponent alleges that the Mark is not registrable because it causes confusion with the Opponent's trade-mark CARAMIEL, certificate of registration No. TMA 530719, issued on August 2, 2000 in association with honey caramel.

On January 5, 2001, the Applicant filed a counter-statement alleging an earlier date of first use (April 1996) than the date alleged in the Opponent's application for registration that was the basis for the certificate of registration TMA 530719 (December 1996). She asks that the certificate of registration TMA 530719 be declared invalid and that the opposition be rejected. The Applicant concedes that the Mark and the wares are identical to those covered by the certificate of registration TMA 530719.

The evidence of the Opponent consists of the sworn statement of Suzanne Ruest and its schedules I, II and III. The Applicant filed a letter signed by Mr. Redmond Hayes dated April 18, 2001, to which three documents were attached. This evidence does not satisfy the requirements of section 43 of the *Trade-marks Regulations (1996)* (the Regulations) which stipulates that evidence must be in the form of an affidavit or a statutory declaration. I must therefore dismiss this evidence. [See *Simmons IP Inc. v. Park Avenue Furniture Corp, (1993) 49 C.P.R. (3d) 138*].

None of the parties filed written arguments but they were present at the hearing.

Paragraph 12(1)(d) of the Act stipulates that a trade-mark is not registrable if it causes confusion with a registered trade-mark. There is no doubt, in this file, that the Mark causes confusion with the Opponent's trade-mark, covered by the certificate of registration TMA 530719, because the Marks and the wares of the parties are identical.

Even if the letter from Mr. Hayes, dated April 18, 2001, and the documents appended thereto, i.e. the Applicant's invoices demonstrating that the Mark had been used before the first use alleged by the Opponent in her own application for registration that was the basis for certificate of registration TMA 530719, were to be admitted into the record, the Registrar does not have the power to invalidate a certificate of registration of a trade-mark. [See *Bacardi & Company Limited v. Havana Club Holding S.A.*, 2003 F.C. 938, unreported judgment, dated July 31, 2003]. Section 57 of the Act confers this exclusive power on the Federal Court of Canada.

Under the circumstances, the first ground of opposition based on paragraph 12(1)(d) of the Act is successful. In accordance with the powers delegated to me by the Registrar of Trade-marks under subsection 63(3) of the Act, the Opponent's Opposition is successful and therefore the Applicant's application for registration of the Mark CARAMIEL is refused, the whole in accordance with subsection 38(8) of the Act.

DATED AT MONTRÉAL, QUEBEC, THE 18th DAY OF DECEMBER 2003.

Jean Carrière
Member
Trade-marks Opposition Board