



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

**Citation: 2013 TMOB 4**  
**Date of Decision: 2013-01-07**

**IN THE MATTER OF AN  
OPPOSITION by 100 Mile Market  
Inc. to application No. 1,397,374  
for the trade-mark 100 GREEN  
MILES in the name of Catch  
International Inc.**

[1] On May 29, 2008, Catch International Inc. filed an application to register the trade-mark 100 GREEN MILES, based on proposed use in Canada, in association with the following wares:

cheese; cheese by-products; meats; meat by-products; fish; fish by-products; vegetables; vegetable by-products; fruit; fruit by-products; oils for cooking, namely, olive oil, avocado oil, sesame oil, peanut oil, vegetable oil, almond oil, pistachio oil, truffle oil, flavored herbal oils, canola oil, soya oil, corn oil, sunflower oil, walnut oil, basil oil, garlic oil; crackers; bread; preserves; honey; vinegar; pasta; rice.

[2] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated May 6, 2009 and was opposed by 100 Mile Market Inc. on July 6, 2009. The Registrar forwarded a copy of the statement of opposition to the applicant on July 30, 2009, as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[3] The opponent's evidence consists of the affidavit of Paul Knechtel as well as certified copies of a trade-mark registration and two trade-mark applications relied on in

the statement of opposition. The applicant's evidence consists of the affidavit of Giselle Baerveldt. Neither party filed a written argument and neither party requested an oral hearing.

#### STATEMENT OF OPPOSITION

[4] The opponent pleads that it is the owner of the registered mark 100 MILE MARKET and two trade-mark applications for 100 MILE MARKET and 100 MILE MENU, both based on proposed use in Canada. The opponent's registered mark covers the wares "peanut butter" while the two above mentioned applications cover a large variety of food and beverage items as well as retail and wholesale food distribution. Various grounds of opposition are pleaded, however, the determinative issue for decision is whether the applied-for mark 100 GREEN MILES is confusing with the opponent's mark 100 MILE MARKET. The material times to consider the issue of confusion are the date of decision, with respect to the ground of opposition alleging non-registrability; the date of filing, that is, May 29, 2008, with respect to the ground of opposition alleging non-entitlement; and the date of opposition, that is, July 6, 2009, with respect to the ground of opposition alleging non-distinctiveness: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 CPR(3d) 198 at 206 - 209 (FCTD).

#### OPPONENT'S EVIDENCE

##### *Paul Knechtel*

[5] Mr. Knechtel identifies himself as the Vice President and co-founder of the opponent company. The opponent operates out of Kitchener, Ontario and provides infrastructure to deliver locally grown foods to restaurants, caterers, food service companies and end consumers. The opponent performs sales, marketing, logistics and distribution for local growers. The business began in 2007 selling peanut butter. Since then the business has expanded to other food products and food services. Cumulative sales to the end of February 2010 amounted to about \$400,000. The opponent has used its mark 100 MILE MARKET since May 2007. The mark allows consumers to "recognise us [the opponent] as a leader in providing locally grown and locally produced products

and related services.” In paragraphs 11 -16 of his affidavit, Mr. Knechtel describes how its mark 100 MILE MARKET is used in association with its wares and services on labels, stickers, invoices, signs, and business cards. Exhibit materials corroborate Mr. Knechtel’s descriptions. By 2008 the opponent was using its mark 100 MILE MARKET in association with vegetables, dairy products, meats, fruits, cooking oils and grain products. The opponent advertises and promotes its wares and services sold under its mark 100 MILE MARKET, mostly in Central and South Western Ontario, through printed media, electronic media and tradeshow. Advertising expenses to the end of February 2010 amounted to about \$40,000.

#### APPLICANT’S EVIDENCE

##### *Gieselle Baerveldt*

[6] Ms. Baerveldt identifies herself as the Treasurer and co-founder of the applicant company. The applicant is in the business of importing, procuring, distributing and marketing food products. The applicant operates out of Toronto, Ontario where it also operates a warehousing facility. As of August 2010, the applicant was selling cheese, pate and mousse products in Canada under its mark 100 GREEN MILES.

[7] Various exhibits attached to Ms. Baerveldt’s affidavit support her contention that the term “100 MILE” connotes “locally produced” and that the term GREEN connotes “environmentally friendly.” The applicant’s mark is intended to suggest both “locally produced” and “environmentally friendly.” The applicant launched its 100 GREEN MILES brand of products in September 2009. Sales of food products under the mark to the end of August 2010 amounted to about \$10,400.

#### MAIN ISSUE FOR DECISION

[8] As mentioned earlier, the determinative issue in this proceeding is whether the applied-for mark 100 GREEN MILES is confusing with the opponent’s mark 100 MILE MARKET. The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of s.6(2) of the *Act*, shown below:

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

. . . or performed by the same person, whether or not the wares or services . . . are of the same general class.

[9] Thus, s.6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by s.6(2) is whether there would be confusion of wares sold in association with the applied-for mark 100 GREEN MILES as being wares sold, licensed or endorsed by the opponent.

[10] The test for confusion is one of first impression and imperfect recollection, as explained by Mr. Justice Denault in *Pernod Ricard v. Molson Breweries* (1992) 44 CPR (3d) 359 at 369 (FCTD):

The test of confusion is one of first impression. The trade marks should be examined from the point of view of the average consumer having a general and not a precise recollection of the earlier mark. Consequently, the marks should not be dissected or subjected to a microscopic analysis with a view to assessing their similarities and differences. Rather, they should be looked at in their totality and assessed for their effect on the average consumer as a whole.

[11] Factors to be considered, in making an assessment as to whether two marks are confusing, are “all the surrounding circumstances including” those specifically mentioned in s.6(5)(a) to s.6(5)(e) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive and all relevant factors are to be considered. Further, all factors do not necessarily have equal weight as the weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 CPR(3d) 308 (FCTD). However, as noted by Mr. Justice Rothstein in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 CPR(4<sup>th</sup>) 361 (SCC), although the degree of resemblance is the last factor cited in s.6(5), it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

*Consideration of s.6(5) Factors*

[12] The applicant's mark 100 GREEN MILES possesses a relatively low degree of inherent distinctiveness as it is comprised of a number and dictionary words in common usage. Further, the mark is suggestive, as admitted by the applicant, of food products that have been produced locally in an environmentally responsible way. Similarly, the opponent's mark 100 MILES MARKET possesses a low degree of inherent distinctiveness as it is comprised of a number and dictionary words in common usage. I am prepared to infer from Mr. Knechtel's evidence that the opponent's mark 100 MILE MARKET had acquired some reputation in Canada at all material times. Of course, the applied-for mark is a proposed use mark and would not have acquired any reputation in Canada at the earliest material date which is the date of filing the application. There is some evidence that the applied-for mark acquired at least some reputation at the later material dates. Thus, the first factor in s.6(5), which is a combination of inherent and acquired distinctiveness, favours the opponent at the later material dates, but only to a limited extent. In this regard, it should be noted that the acquired distinctiveness of the opponent's mark 100 MILES MARKET is slight and inadequate to overcome the low inherent distinctiveness of the mark so as to entitle the opponent to a wide ambit of protection for its mark.

[13] The length of time that the marks have been in use also favours the opponent who had been using its mark for about a year prior to the filing of the subject application. Thus, the second factor in s.6(5) favours the opponent, but again only to a limited extent. The nature of the parties' wares, services, businesses and trades are essentially the same or closely overlapping. The third and fourth factors in s.6(5) therefore favour the opponent.

[14] The parties' marks necessarily resemble each other owing to the components 100 and MILE which comprise each of the parties' marks. The first component of a mark is often considered more important for the purpose of distinction, however, when the first component is a common, descriptive or suggestive word, the significance of the first component lessens: see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.*, [1991], 37 CPR (3d) 413 (FCA); *Phantom Industries Inc. v. Sara Lee Corp.*

(2000), 8 CPR (4th) 109 (TMOB). In the instant case, the first portion of the parties' marks is the fairly non-distinctive number 100. By comparison, the suffix components GREEN MILES and MILE MARKET are the more distinctive and dominant portions of the parties' marks. The parties' marks suggest similar ideas, that is, produce produced locally, that is, within a 100 mile radius. However, in my view, when the marks in issue are compared in their entirety, their visual and auditory differences offset the similarities in ideas suggested. Thus, the resemblance between the marks in issue is a factor which favours neither party.

#### JURISPRUDENCE

[15] I have also been guided by the approach taken in *Coventry Inc. v. Abrahamian* (1984), 1 CPR (3d) 238 (FCTD) wherein the opponent was relying on its mark SARAH. The opponent's mark was not inherently strong and had not acquired significant distinctiveness through use or advertising or other means (at para. 6):

The trade mark SARAH is a commonly used female Christian name and as such offers little inherent distinctiveness: *Bestform Foundations Inc. v. Exquisite Form Brassiere (Canada) Ltd.* (1972), 34 C.P.R. (2d) 163. Such marks are considered to be weak marks and are not entitled to a broad scope of protection: *American Cyanamid Co. v. Record Chemical Co. Inc.* (1972), 7 C.P.R. (2d) 1, [1972] F.C. 1271; and *GSW Ltd. v. Great West Steel Industries Ltd. et al.* (1975), 22 C.P.R. (2d) 154. In the case of a weak mark, small differences will be sufficient to distinguish it from another mark: *American Cyanamid Co., supra*, at p. 5. Zaréh, which is also a Christian name, but the name of a male Lebanese, is not commonly used in this country. Obviously, there are at least small differences to distinguish those two names. However, the degree of distinctiveness attributed to a weak mark may be enhanced through extensive use: *GSW Ltd. v. Great West Steel, supra*. Most of the evidence led by the appellant show considerable use and publicity for the trade name Sarah or Sarah Coventry or Sarah Fashion Show, etc., but very limited use of the trade mark SARAH. And it has been well established that it is not sufficient for the owner of the trade mark to make a statement of use, he must show use: *Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (2d) 62, [1981] 1 F.C. 679, 34 N.R. 39.

(underlining added)

[16] In the instant case, the mark relied on by the opponent is an inherently weak mark and I am unable to conclude, on the basis of the evidence before me, that its distinctiveness has been so enhanced by use and advertising that it is entitled to a broad scope of protection.

[17] In view of the foregoing, I find that at all material times the applicant has met the legal onus on it to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the applied-for mark 100 GREEN MILES and the opponent's mark 100 MILE MARKET.

DISPOSITION

[18] As the first, second and third grounds of opposition turn on the issue of confusion, those grounds are rejected. The fourth and final ground alleges non-compliance with s.30(i), however, the pleadings therein are not germane to the allegation of non-compliance. The fourth ground is therefore rejected. Accordingly, the opposition is rejected. This decision has been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

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Myer Herzig  
Member, Trade-marks Opposition Board  
Canadian Intellectual Property Office