

**IN THE MATTER OF AN OPPOSITION by Culinar Inc. to  
application No. 752,883 for the trade-mark CULINAIR & Design  
filed by BOTMAN INTERNATIONAL B.V.**

On April 22, 1994, the applicant, BOTMAN INTERNATIONAL B.V., filed an application to register the trade-mark CULINAIR & Design, a representation of which appears below, based on use of the trade-mark in The Netherlands and registration of the mark in Benelux under registration No. 820,350 in association with “fresh fruits and vegetables”.



The applicant claimed and was accorded a priority filing date of January 17, 1994 based on its application for registration filed in Benelux.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of July 31, 1996 and the opponent, Culinar Inc., filed a statement of opposition on September 20, 1996, a copy of which was forwarded to the applicant on October 9, 1996. The applicant served and filed a counter statement in response to the statement of opposition on November 8, 1996. The opponent filed as its evidence the statutory declaration of Jean Joncas while the applicant submitted as its evidence the affidavit of Rene Kamminga under Rule 44(1) of the *Trade-marks Regulations*. Both parties filed a written argument and an oral hearing was not conducted in respect of this opposition.

The first two grounds of opposition are based on Subsections 30(d) and 30(i) of the *Trade-marks Act*. While the legal burden is upon the applicant to show that its application complies with Section 30 of the *Trade-marks Act*, there is an initial evidential burden on the opponent to establish the facts relied upon by it in support of its Section 30 grounds [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; and *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R.(3d) 293]. The material time for considering the circumstances respecting the issues of non-compliance with Section 30 of the *Act* is the filing date of the

application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R.(3d) 469, at p. 475].



The opponent has alleged that the applicant, as of the filing date of the present application, had not used its trade-mark in The Netherlands in association with the wares covered in the present application, contrary to Subsection 30(d) of the *Trade-marks Act*. However, no evidence has been furnished by the opponent in support of this ground and the applicant's evidence is not clearly inconsistent with its claim that it has used its trade-mark in The Netherlands in association with fresh fruit and vegetables prior to filing the present application. I have therefore dismissed this ground of opposition.

With respect to the ground of opposition based on Subsection 30(i) of the *Act*, the opponent alleged that the applicant's statement in the present application that it is satisfied that it is entitled to use the trade-mark CULINAIR & Design in Canada in association with the wares covered in the application is false in view of the allegations set forth in the remainder of the statement of opposition. However, no evidence has been adduced by the opponent to show that the applicant was aware of the opponent's use of its CULINAR trade-marks prior to filing the present application. In any event, even had the applicant been aware of the opponent's trade-marks prior to filing its application, such a fact is not inconsistent with the statement in the present application that the applicant was satisfied that it was entitled to use its trade-mark CULINAIR & Design in Canada on the basis *inter alia* that its trade-mark is not confusing with the opponent's trade-marks. Thus, the success of this ground is contingent upon a finding that the trade-marks at issue are confusing [see *Consumer Distributing Co. Ltd. v. Toy World Ltd.*, 30 C.P.R. (3d) 191, at p.195; and *Sapodilla Co. Ltd. v. Bristol-Myers Co.*, 15 C.P.R. (2d) 152, at p. 155]. I will therefore consider the remaining grounds which are based on allegations of confusion between the applicant's trade-mark CULINAIR & Design and one, or more, of the opponent's CULINAR trade-marks.

The opponent next alleged that the applicant's trade-mark CULINAIR & Design is not registrable in view of Paragraph 12(1)(d) of the *Trade-marks Act* in that the applicant's mark is confusing with its registered trade-marks CULINAR, registration No. 424,686 and CULINAR & Design, registration Nos. 237,739 and 423,762. In determining whether there would be a reasonable

likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Subsection 6(5) of the *Trade-marks Act*. Further, the Registrar must bear in mind that the legal burden is on 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. In this regard, the material date for considering a ground of opposition based on Paragraph 12(1)(d) of the *Trade-marks Act* is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)].

While the opponent has not filed copies of its registrations as evidence, the Registrar does have the discretion, in view of the public interest to maintain the purity of the register, to check the register in order to confirm the existence of the registrations relied upon by the opponent [see *Quaker Oats of Canada Ltd./ La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.*, 11 C.P.R. (3d) 410]. In doing so, I noted that the opponent's registrations are presently in good standing and cover the following:

| <u>Trade-mark</u>   | <u>Registration No.</u> | <u>Wares/Services</u>   |
|---|-------------------------|---|
|  | 237,739                 | Biscuiterie. Pâtisserie. Tartinade. Garniture pour dessert. Confitures, marmelades, gelées, sirops de table, mélasse, miel, cacao, noix de coco; moutarde, sauces, marinades à base de légumes, fruits et épices; légumes et fruits en conserve; enrobage en chocolat; fruits de base pour la fabrication du yoghourt.  |
|  | 423,762                 | Biscuiteries, craquelins; pâtisseries; pains, tartinades, garnitures pour desserts; confiseries, nommément: bonbons, menthes vertes, gomme à bulles, jujubes, fèves à la gelée et arachides pralinées; confitures, marmelades, gelées, sirops de table, mélasse, miel, cacao, noix de coco; soupes, moutarde, sauces, marinades à base de légumes, fruits et épices; légumes et fruits en conserve; enrobage en chocolat; fruits de base pour la fabrication du yoghourt.   |
| CULINAR   | 424,686                 | Biscuiteries, craquelins. Pâtisseries, pains. Tartinades Garnitures pour desserts Confiseries, nommément: bonbons, menthes vertes, gomme à bulles, jujubes, fèves à la gelée et arachides pralinées; confitures, marmelades, gelées, sirops de table, mélasse, miel, cacao, noix de coco; soupes, moutardes, sauces, marinades à base de légumes, fruits et épices; légumes et fruits en conserve; enrobage en chocolat; fruits de base pour la fabrication du yoghourt.<br>Exploitation d'une entreprise offrant des services de fabrication sur commande, de distribution et de |

vente de produits alimentaires.

Considering initially the inherent distinctiveness of the trade-marks at issue, both the applicant's trade-mark CULINAIR & Design as applied to "fresh fruits and vegetables" and the opponent's registered trade-mark CULINAR and CULINAR & Design as applied to the wares and services covered in the opponent's registrations are inherently distinctive.

The opponent submitted the statutory declaration of its Director, Jean Joncas, in support of its opposition. The Joncas declaration establishes that the opponent has used the trade-marks CULINAR and CULINAR & Design in Canada in association with the wares and services covered in its registrations. In this regard, Mr. Joncas has annexed to his statutory declaration specimen invoices covering the sale of a broad range of food products, the invoices bearing the trade-mark CULINAR & Design covered by registration No. 423,762. I disagree with the applicant's submission that the invoices evidence use of the trade-name Culinar, as opposed to use of the opponent's trade-marks. In my view, the invoices evidence the sale by the opponent to wholesalers and retailers in Canada of the wares identified in the invoices in the normal course of trade in association with the trade-mark CULINAR & Design within the scope of Subsection 4(1) of the *Trade-marks Act*. As well, the invoices constitute evidence of use of the trade-mark CULINAR in association with the wares identified in the invoices, as well as evidencing use of the trade-mark in association with services relating to the distribution of food products as covered in registration No. 424,686.

In his declaration, Mr. Joncas has provided the annual sales in Canada by the opponent of food products to retailers in association with its trade-marks from 1975 to 1996, the approximate total during this time being \$9,795,000,000. Thus, I am satisfied that the opponent's trade-marks CULINAR and CULINAR & Design are fairly well known in Canada to wholesalers and retailers in the food industry. On the other hand, and while the opponent has evidenced use of its marks on certain of the labels and packaging for its food products which are annexed as exhibits to the Joncas statutory declaration, the opponent's marks appear as secondary or tertiary marks on a number of the specimens furnished by Mr. Joncas. In this regard, I again disagree with the applicant's position that

the mark CULINAR appearing on these labels or packaging is use of the trade-name Culinar, as opposed to use of the trade-mark CULINAR. In any event, I find that the opponent's marks have become known to only a limited extent to the average consumer of food products in Canada.

In his affidavit, Rene Kamminga, Logistics Manager with the applicant, states that the applicant's mark is not displayed in Canadian retail settings such as grocery stores or fruit vendors and does not appear on labelling on fresh fruits and vegetables, nor does it appear on surrounding merchandising material. Rather, according to the affiant, the applicant's trade-mark is associated with fresh fruit and vegetables when they are being transported from growers to fruit and vegetable auction houses which are not open to the public and therefore only those persons concerned with the transport and auction of fruit and vegetables would see the trade-mark while those purchasing fruits and vegetables at auction would not see the trade-mark. In paragraph 5 of his affidavit, Mr. Kamminga states that the applicant began shipping peppers to Canadian fruit and vegetable auction houses in April of 1997 in boxes bearing the trade-mark CULINAIR & Design and, between April and August 28, 1997, the applicant shipped 137,500 boxes of peppers bearing the applicant's mark to Canada. Having regard to the foregoing, I find that both the extent to which the trade-marks at issue have become known and the length of time the marks have been in use both favour the opponent.

As for the nature of the wares and services of the parties and the nature of the trade associated with these wares and services, it is the applicant's statement of wares and the statements of wares and services covered in the opponent's registrations which must be considered in assessing the likelihood of confusion in relation to the Paragraph 12(1)(d) ground [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.*, 19 C.P.R.(3d) 3, at pp. 10-11 (F.C.A.); *Henkel Kommanditgesellschaft v. Super Dragon*, 12 C.P.R.(3d) 110, at p. 112 (F.C.A.); and *Miss Universe, Inc. v. Dale Bohna*, 58 C.P.R.(3d) 38,1 at pp. 390-392 (F.C.A.)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful [see *McDonald's Corporation v. Coffee Hut Stores Ltd.*, 68 C.P.R.(3d) 168, at p. 169 (F.C.A.)].

The applicant's fresh fruit and vegetables are similar to the opponent's canned vegetables and fruit covered in each of its registrations in that consumers purchasing fruit or vegetables may purchase either fresh, canned or frozen fruit or vegetables, as the case may be and depending on the seasonal availability of the particular fruit or vegetable. As for the respective channels of trade of the parties, the fact that the applicant may only have sold its peppers to auction houses in Canada to date is of limited relevance when considering the Paragraph 12(1)(d) ground. Rather, as there are no limitations in the statements of wares of the parties, it is necessary to consider the channels of trade which the average consumer would consider as being normally associated with the applicant's fresh fruit and vegetables and the opponent's canned vegetables and fruit. In this regard, the average consumer would expect fresh fruit and vegetables to be sold in the produce section of grocery stores and supermarkets, as well as in retail outlets specializing in the sale of produce. On the other hand, the opponent's canned fruit and vegetables would be sold in those sections of grocery stores and supermarkets where canned food products are available for purchase. Further, I would expect that the average consumer might well be accustomed to seeing certain fresh produce in the marketplace in packaging bearing the trade-mark of a particular distributor or fresh fruit bearing individual stickers identifying the distributor's trade-mark. Thus, the applicant's argument that its mark would not come to the attention of the average consumer at the retail level is of little assistance in assessing the likelihood of confusion in relation to the Paragraph 12(1)(d) ground.

With respect to the degree of resemblance between the trade-marks at issue, I find the applicant's trade-mark CULINAIR & Design and the opponent's registered trade-marks CULINAR and CULINAR & Design to bear a fair degree of similarity in appearance and in sounding although the marks do not suggest any particular idea in common.

Having regard to the above and, in particular, to the degree of resemblance between the trade-marks at issue as applied similar wares which could be sold through the same retail outlets, and considering that the opponent's marks have become known in Canada, I find that the applicant has not met the legal burden on it of satisfying me that there would be no reasonable likelihood of confusion between the trade-marks at issue in relation to the Paragraph 12(1)(d) ground. Consequently, the applicant's trade-mark is not registrable in view of the provisions of Paragraph

12(1)(d) of the *Trade-marks Act*.

The opponent also challenged the applicant's entitlement to registration of the trade-mark CULINAIR & Design as applied to "fresh fruit and vegetables" in view of its prior use of the CULINAR trade-marks in association with the wares and services covered in its registrations. The Joncas statutory declaration establishes that the opponent used its CULINAR trade-mark as applied to food products in Canada prior to January 17, 1994, the applicant's priority filing date, and that the opponent had not abandoned its trade-marks as of the date of advertisement of the present application [July 31, 1996]. As a result, the opponent has met the burden upon it under Subsections 16(5) and 17(1) of the *Trade-marks Act* in relation to the non-entitlement ground of opposition. Thus, the legal burden is upon the applicant to show that there would have been no reasonable likelihood of confusion between the trade-marks at issue as of the applicant's priority filing date. However, most of my previous conclusions concerning the likelihood of confusion between the trade-marks at issue in relation to the Paragraph 12(1)(d) ground likewise apply to the determination of the issue of confusion as of the applicant's priority filing date. Consequently, the Paragraph 16(2)(a) ground of opposition is also successful.

Having concluded that the applicant's trade-mark is not registrable and that the applicant is not the person entitled to registration of the trade-mark CULINAIR & Design as applied to "fresh fruit and vegetables", it follows that the applicant's trade-mark is not distinctive and the final ground of opposition is also successful.

In view of the above, and having been delegated by the Registrar of Trade-marks by virtue of Subsection 63(3) of the *Trade-marks Act*, I refuse the applicant's application pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC, THIS DAY 29<sup>th</sup> OF SEPTEMBER, 2000.

G.W.Partington,  
Chairperson,

Trade-marks Opposition Board.