

IN THE MATTER OF AN OPPOSITION  
by Vitasoy International Holdings Limited  
and Vitasoy USA Inc. to application No.  
874,855 for the trade-mark VITA & Design  
filed by Gold Coast Olives Inc.

On April 14, 1998, the applicant, Gold Coast Olives Inc., filed an application to register the trade-mark VITA & Design (shown below) for the wares “olive oil” and the services “importation and wholesale distribution of olive oil.” The application as filed included a disclaimer to the word OLEARIA. The application is based on use in Canada since February of 1998 for both wares and services and was advertised for opposition purposes on July 21, 1999.




The opponents, Vitasoy International Holdings Limited (“Vitasoy International”) and Vitasoy USA Inc. (“Vitasoy U.S.”), filed a statement of opposition on September 20, 1999, a copy of which was forwarded to the applicant on October 5, 1999. On August 30, 2001, the opponents sought leave to file an amended statement of opposition pursuant to Rule 40 of the Trade-marks Regulations and leave was granted on December 13, 2001.

The first ground of opposition is that the applicant’s application does not conform to the requirements of Section 30(b) of the Trade-marks Act because the applicant has not used the applied for trade-mark in Canada since the date claimed or at all. The second ground is that the applied for

trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with the following registered trade-marks owned by Vitasoy International:

<u>Trade-mark</u>	<u>Reg. No.</u>	<u>Wares</u>
VITASOY	247,464	(1) non-alcoholic vegetable based beverages (2) soybean based non-carbonated non-alcoholic drinks, namely, fruit and vegetable juice beverages, concentrates for making non-carbonated and non-alcoholic beverages, namely, fruit and vegetable juice beverages, extracts of fruits and soybeans for making non-alcoholic, non-carbonated drinks, namely, fruit and vegetable juice beverages (3) vegetable based milk substitute made from soya beans (soybean milk), tofu, canned or dried soybean curd, soybean-based yogurt, soybean-based meat substitutes, namely meatless sausage; soybean-based pudding, custard, ice cream and frozen yogurt, non-dairy noodles and pasta
VITASOY	254,100	(1) soy bean drink (2) soy bean curd (3) soy bean yogurt (4) soy bean cake
<b>維他</b>	429,015	vegetable based food beverage used as a milk substitute made from soya beans (soybean milk), tofu, and canned, dried soybean curd; soybean-based non-carbonated non-alcoholic drinks, namely, fruit and vegetable juice beverages, concentrates for making non-carbonated and non-alcoholic drinks, namely, fruit and vegetable juice beverages and extracts of fruits and soybeans for making non-alcoholic, non-carbonated drinks, namely, fruit and vegetable juice beverages

	247,978	(1) non-alcoholic vegetable based beverages (2) soybean based non-carbonated non-alcoholic drinks, namely, fruit and vegetable juice beverages, concentrates for making non-carbonated and non-alcoholic beverages, namely, fruit and vegetable juice beverages, extracts of fruits and soybeans for making non-alcoholic, non-carbonated drinks, namely, fruit and vegetable juice beverages (3) vegetable based milk substitute made from soya beans (soybean milk), tofu, canned or dried soybean curd, soybean-based yogurt, soybean-based meat substitutes, namely meatless sausage; soybean-based pudding, custard, ice cream and frozen yogurt, non-dairy noodles and pasta
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The third ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(1)(a) of the Act because, as of the applicant’s claimed date of first use, the applied for trade-mark was confusing with the four registered trade-marks noted above previously used in Canada by Vitasoy International’s predecessor in title and/or Vitasoy U.S. as the licensee of Vitasoy International. The fourth ground is that the applicant is not the person entitled to registration pursuant to Section 16(1)(b) of the Act because, as of the applicant’s claimed date of first use, the applied for trade-mark was confusing with the trade-mark VITA for which an application (No. 719,609) had previously been filed by Vitasoy International for “extracts of fruits for making non-alcoholic, non-carbonated drinks, namely, fruit and vegetable juice beverages.” The fifth ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(1)(c) of the Act because, as of the applicant’s claimed date of first use, the applied for trade-mark was confusing with the “corporate names” of the two opponents previously used in Canada.

The sixth ground of opposition is that the applicant’s application does not conform to the

requirements of Section 30(i) of the Act because the applicant was aware of the prior use of the opponents' trade-marks in Canada. The seventh ground is that the applied for trade-mark is not distinctive because it is confusing with the opponents' trade-marks.

The applicant filed and served a counter statement. As their evidence, the opponents submitted an affidavit of Yvonne M. Lo, the President of Vitasoy U.S. As its evidence, the applicant submitted an affidavit of its Secretary, Michele Belchior. Only the opponents filed a written argument and no oral hearing was conducted.

The opponents' evidence establishes that Vitasoy International, through its licensee Vitasoy U.S., has sold soybean-based foods and beverages in Canada for a number of years under the trade-mark VITASOY. According to Ms. Lo, Vitasoy International has also sold fruit and vegetable drinks in Canada for many years in association with the trade-mark VITA. Ms. Lo also provides some evidence of Canadian advertising of the opponents' products.

The applicant's evidence is of little assistance. Ms. Belchior provides no evidence of use of the applicant's mark in Canada. Exhibit 1 to her affidavit is a photocopy of a letter which enclosed a photograph of the applicant's product as it is sold in Canada. Exhibit 2 purports to be a photocopy of an Italian registration for the applicant's mark.

As for the opponents' first ground of opposition, the onus or legal burden is on the applicant

to show that its application conforms with the requirements of Section 30(b) of the Act: see the opposition decision in Joseph Seagram & Sons v. Seagram Real Estate (1984), 3 C.P.R.(3d) 325 at 329-330 and the decision in John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 (F.C.T.D.). There is, however, an evidential burden on the opponents respecting their allegations of fact in support of that ground. That burden is lighter respecting the issue of non-conformance with Section 30(b) of the Act: see the opposition decision in Tune Masters v. Mr. P's Mastertune (1986), 10 C.P.R.(3d) 84 at 89. Furthermore, Section 30(b) requires that there be continuous use of the applied for trade-mark in the normal course of trade since the date claimed: see Labatt Brewing Company Limited v. Benson & Hedges (Canada) Limited and Molson Breweries, a Partnership (1996), 67 C.P.R.(3d) 258 at 262 (F.C.T.D.). Finally, the opponents' evidential burden can be met by reference to the applicant's own evidence: see Labatt Brewing Company Limited v. Molson Breweries, a Partnership (1996), 68 C.P.R.(3d) 216 at 230 (F.C.T.D.).

The opponents have relied on the Belchior affidavit to show that the applicant has not used its applied for mark in Canada. In this regard, the product label shown in the photograph comprising part of Exhibit 1 to the Belchior affidavit uses a slight variation of the applied for mark. The wording beneath the word VITA on the label reads "Vita Casa Olearia" rather than just "Casa Olearia." Furthermore, the label includes the word "Calabria" in small print as well as the non-distinctive product description "Extra Virgin Olive Oil" and its French language equivalent. Given the minor variations in the applicant's mark as it appears on the product label and the non-distinctive nature of much of the additional wording on the label, I find that use of the label would also constitute use of the applied for mark: see Nightingale Interloc Ltd. v. Prodesign Ltd. (1984), 2

C.P.R.(3d) 535 at 538 (T.M.O.B.) and Munsingwear Inc. v. Promafil Canada Ltee. (1992), 44 C.P.R.(3d) 59 (F.C.A.).

In view of the above, the opponents have failed to point to any evidence that shows non-use of the applicant's mark in Canada. Thus, the opponents have not met their evidential burden respecting the first ground of opposition. That ground is therefore unsuccessful.

As for the second ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark pursuant to Section 12(1)(d) of the Trade-marks Act is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

Initially, it should be noted that there is no resemblance between the applicant's trade-mark and Vitasoy International's third and fourth registered marks (Nos. 429,015 and 247,978). Thus, I find that the applicant's mark is not confusing with either of those two marks and that aspect of the second ground is unsuccessful.

As for the first aspect of the second ground of opposition based on Vitasoy International's

first and second registered marks, the trade-mark VITASOY is inherently distinctive in relation to the opponents' food and beverage products. Given that those products are soy-based and given that the component VITA suggests "vitality", "vitamins" or the like, the trade-mark VITASOY is somewhat suggestive of the opponents' products and is therefore not an inherently strong mark. The Lo affidavit establishes that there have been fairly significant sales in Canada of the opponents' products such that I can conclude that the mark VITASOY has become fairly well known in this country.

The applicant's mark VITA is also inherently distinctive. To the extent that it suggests the word "vitality", "vitamins" or the like, it is somewhat suggestive of olive oil and the related services. Thus, the applicant's mark is also not an inherently strong mark. Since the applicant failed to evidence use or advertising of its mark, I must conclude that it has not become known at all in Canada.

The length of time the marks have been in use favors the opponents. As for Sections 6(5)(c) and 6(5)(d) of the Act, the wares of the parties all fall within the general heading of food products. Thus, they could be sold through the same types of retail outlets although likely in different sections of those outlets. The applicant's services are directly related to its wares and are thus also similar to the opponents' wares.

As for Section 6(5)(e) of the Act, the marks at issue bear a fair degree of similarity in all respects. The applicant's mark is dominated by the word VITA which is the first component of the

registered mark VITASOY.

As an additional surrounding circumstance, I have considered the opponents' evidence of use of the mark VITA for fruit and vegetable drinks. Given that there have been fairly extensive Canadian sales of those products over the years, consumers have come to associate both the trade-marks VITASOY and VITA with the opponents. Thus, there is a greater likelihood that consumers would assume that a new product bearing a trade-mark dominated by the word VITA is produced or sold by one or other of the opponents.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the similarities between the wares, services and marks of the parties, I find that, on a balance of probabilities, the applicant has not discharged the burden on it to show that the marks at issue are not confusing. In other words, I find that I am left in a state of doubt respecting the issue (i.e. - the probabilities one way or the other are equal) and I must therefore resolve that doubt against the applicant. The first aspect of the second ground of opposition is therefore successful.

As for the third ground of opposition, the opponents have evidenced use of the four registered trade-marks prior to the applicant's claimed date of first use and non-abandonment of those marks as of the applicant's date of advertisement. The fourth ground therefore remains to be decided on the issue of confusion between the marks. As before, there is no resemblance between Vitasoy International's third and fourth marks and the applicant's mark and therefore that aspect of the third



ground is unsuccessful. As for the first two registered marks, my conclusions respecting the first aspect of the second ground of opposition are generally applicable here as well notwithstanding the earlier material time (i.e. - the applicant's claimed date of first use). Thus, I find that the applicant has failed to satisfy the legal burden on it to show that its mark is not confusing with Vitasoy International's previously used trade-mark VITASOY. The first aspect of the third ground is therefore also successful.

As for the fourth ground of opposition, Vitasoy International's application No. 719,609 was filed prior to the applicant's claimed date of first use and was pending as of the applicant's date of advertisement. Thus, the fourth ground of opposition remains to be decided on the issue of confusion between the applicant's trade-mark VITA & Design and the trade-mark VITA as of February 28, 1998. Given the high degree of resemblance between the two marks, the similarities between the wares and services and the extensive use of the marks VITASOY and VITA by the opponents for related wares and services, I find that the applicant has failed to satisfy the onus on it to show that its mark VITA & Design is not confusing with the trade-mark VITA which was the subject of application No. 719,609. Thus, the fourth ground is also successful.

As for the fifth ground of opposition, the opponents have evidenced use of their trade-names in Canada prior to the applicant's claimed date of first use and non-abandonment of those names as of the applicant's advertisement date. The fifth ground therefore remains to be decided on the issue of confusion between the applicant's mark and the opponents' trade-names. Given that the opponents failed to evidence any reputation of note in Canada for their trade-names and given the

lower degree of resemblance between those names and the applicant's mark, I find that the applicant's mark is not confusing with either of those two names. Thus, the fifth ground of opposition is unsuccessful.

As for the sixth ground, the opponents have failed to adequately plead a ground of non-conformance with Section 30(i) of the Act. The fact that the applicant may have been aware of the prior use of the opponents' trade-marks would not preclude the applicant from truthfully making the statement required by Section 30(i) *inter alia* on the basis that it believed its mark was not confusing with those previously used marks. Thus, the sixth ground is unsuccessful.

As for the seventh ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares and services from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - September 20, 1999): 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.).

In view of my conclusions respecting the second, third and fourth grounds of opposition, I find that the applicant's mark was confusing with the opponents' trade-mark VITASOY as of the filing of the present opposition. Thus, the applicant's mark was not distinctive as of that date and

the seventh ground is successful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.

DATED AT GATINEAU, QUEBEC, THIS 20<sup>th</sup> DAY OF DECEMBER, 2002.

David J. Martin,  
Member,  
Trade Marks Opposition Board.