



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

Citation: 2013 TMOB 108
Date of Decision: 2013-06-18

**IN THE MATTER OF AN OPPOSITION
by Canada Bread Company, Limited to
application No. 1,277,280 for the trade-
mark POME GREAT in the name of
Jarrow Formulas, Inc.**

[1] This is a decision accepting an opposition under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) by Canada Bread Company, Limited to an application filed by Jarrow Formulas Inc. for the registration of the trade-mark POME GREAT.

[2] Each party filed evidence and a written argument. Both parties were represented at a hearing.

I. The Record

I.1 The Application

[3] The application filed on October 27, 2005 by Jarrow Formulas Inc. (the Applicant) is based upon proposed use of the trade-mark POME GREAT (the Mark) in Canada; it claims the priority of a corresponding application filed in the United States on May 23, 2005.

[4] The statement of wares of the application of record, as amended on January 10, 2011, reads: “dietary supplements namely fruit juice concentrates containing pomegranate and vitamin and fruit extract supplements containing pomegranate in liquid form sold through retailers that specialize in health foods, natural foods, vitamins, or nutritional supplements”.

I.2 The Statement of Opposition

[5] Boulangerie Pom Limitée (Pom Bakery) and Multi-Marques Inc. (Multi-Marques) jointly filed the original statement of opposition on July 30, 2007. On two occasions during the course of the opposition proceeding, the Registrar granted leave to file an amended statement of opposition. It is in the second amended statement of opposition dated May 20, 2010 (the 2010 Statement of Opposition) that Pom Bakery and Multi-Marques were replaced by Canada Bread Company, Limited (the Opponent) because they had merged with and into the Opponent.

[6] At the oral hearing, the Opponent sought leave to amend the 2010 Statement of Opposition. The Applicant objected to the request. As I was not prepared to rule on a verbal request, both parties agreed to the following: the Opponent would file a written request after the hearing; the Applicant would then be invited to file written submissions; and I would rule on the request in this decision. It was also agreed that both parties' oral representations about the grounds of opposition would take into consideration the Opponent's proposed request.

[7] The Opponent filed a request for leave to amend the 2010 Statement of Opposition on March 11, 2013 and the Applicant filed submissions with the Registrar on April 2, 2013. Thus, I shall now deal with the Opponent's request.

I.2.1 Leave to Amend the 2010 Statement of Opposition

[8] For ease of reference, I divide the proposed amendments in three categories, namely: (1) removal of the grounds of opposition raised under section 14 of the Act; (2) addition of registration Nos. TMA774,041 and TMA832,083 to the ground of opposition raised under section 12(1)(d) of the Act; and (3) addition of a ground of opposition alleging non-distinctiveness of the Mark.

[9] Leave to amend a statement of opposition will only be granted if the Registrar is satisfied that it is in the interest of justice to do so having regard to all the surrounding circumstances including: 1) the stage the opposition proceeding has reached; 2) why the amendment was not made earlier; 3) the importance of the amendment; and 4) the prejudice which will be suffered by the other party.

[10] For the reasons that follow, I consider it is in the interest of justice to partly grant the Opponent's request despite its extreme tardiness.

[11] The first category of amendments reflects the withdrawal of the grounds of opposition by the Opponent at the oral hearing.

[12] The Applicant submits that the second category of amendments is "in no way important". It also submits that the delay in making these amendments "could not have been more egregious" and allowing them would be highly prejudicial. In a nutshell, the Applicant's submissions about the unimportance of the amendments are that the likelihood of confusion between the Mark and the marks POM WONDERFUL and POM WONDERFUL & Design (collectively the POM WONDERFUL Marks) is already an issue in this proceeding and the Opponent has tendered no evidence of use of those marks.

[13] I find it somewhat difficult to reconcile the Applicant's submissions that the amendments to the section 12(1)(d) ground of opposition are not important with its submissions that they are prejudicial. It seems to me that the Applicant's submissions about the unimportance of the amendments lend support to the Opponent's submissions that the Applicant will not be prejudiced. Further, the Applicant acknowledges that the applications corresponding to registration Nos. TMA774,041 and TMA832,083 for the POM WONDERFUL Marks were identified among the previously filed applications alleged in the 2010 Statement of Opposition. Finally, neither registration was issued at the time of the 2010 Statement of Opposition; although registration No. TMA774,041 was issued on August 10, 2010, registration No. TMA832,083 was issued on September 17, 2012, that is less than six months before the hearing.

[14] However, I disagree with the Opponent's submissions that the inclusion of a non-distinctiveness ground of opposition is only a formality. I agree with the Applicant that the Opponent has offered no explanation as to why the amendment could not have been made earlier. As previously indicated, the original statement of opposition filed in 2007 was amended twice during the course of the opposition. It can fairly be concluded that the Opponent sought the amendment only because I pointed out at the hearing that its written argument incorrectly referenced non-distinctiveness of the Mark as a pleading included in the 2010 Statement of Opposition.

[15] Accordingly, pursuant to section 40 of the *Trade-marks Regulations*, SOR/96-195 (the Regulations), I hereby grant leave to amend the 2010 Statement of Opposition to remove the grounds of opposition raised under section 14 of the Act and to add registration Nos. TMA774,041 and TMA832,083 to the section 12(1)(d) ground of opposition. However, I hereby refuse leave to amend the 2010 Statement of Opposition to add a non-distinctiveness ground of opposition.

I.2.2 Governing Grounds of Opposition

[16] I summarize hereafter the governing grounds of opposition further to the grant of leave to partly amend the 2010 Statement of Opposition.

- a) The application does not comply with section 30 of the Act because:
 - it does not contain a statement in ordinary commercial terms of the wares associated with the Mark, contrary to section 30(a);
 - it does not include the name of a country of the Union in which the Mark has been used, contrary to section 30(d); and
 - the Applicant could not have been satisfied of its entitlement to use the Mark, contrary to section 30(i) of the Act.
- b) The Mark is not registrable because:
 - it is clearly descriptive or deceptively misdescriptive of the character or quality of the wares, contrary to section 12(1)(b) of the Act; and
 - it is confusing with the Opponent's registered trade-marks identified in Schedule "A" to my decision (collectively the POM Registered Marks), contrary to section 12(1)(d) of the Act.
- c) The Applicant is not the person entitled to registration of the Mark under sections 16(2) and 16(3) of the Act in view of confusion with:
 - the POM Registered Marks, the trade-mark POM and the trade-marks identified in Schedule "B" to my decision (the POM Pending Marks) that had

been previously used (made known) in Canada, contrary to sections 16(2)(a) and 16(3)(a);

- the POM Registered Marks and POM Pending Marks that had been previously applied for registration in Canada, contrary to sections 16(2)(b) and 16(3)(b); and
- the trade-names POM, BOULANGERIE POM LIMITÉE, POM BAKERY LIMITED and POM WONDERFUL previously used in Canada by the Opponent and its predecessors in title, contrary to sections 16(2)(c) and 16(3)(c) of the Act.

I.3 The Evidence

I.3.1 Opponent's Evidence

[17] It consists of an affidavit of Jean-Pierre Galardo of August 19, 2008, including its Exhibits JPG-1 to JPG-8. At the time of his affidavit, Mr. Galardo was the Marketing Director of the Opponent, of Multi-Marques and of Pom Bakery. Mr. Galardo was not cross-examined.

I.3.2 Applicant's Evidence

[18] As a first matter, I shall deal with the Applicant's outstanding request of February 22, 2013 for leave to file an affidavit of Lynda Palmer, dated February 14, 2013, as further evidence. This request was received less than two weeks before the hearing.

[19] Pursuant to section 44 of the Regulations, I hereby grant the Applicant's request as I am satisfied that it is in the interest of justice to do so. The affidavit only aims to correct a date in Ms. Palmer's first affidavit of September 17, 2009. Further, the Opponent did not object to the Applicant's request. Accordingly, the Applicant's evidence now consists of:

- the affidavits of September 17, 2009, including its Exhibit A, and February 14, 2013 of Lynda Palmer. Ms. Palmer, a trade-mark searcher, was not cross-examined;

- an affidavit of Peilin Guo of September 18, 2009, including its Exhibit A. Ms. Guo, the Executive Vice President of the Applicant, was not cross-examined; and
- a certified copy of the corresponding U.S. application for the Mark.

[20] I note that Exhibit A to the Guo affidavit was not certified as prescribed by the *Federal Courts Rules*, SOR/98-106, which are generally followed in opposition proceedings. Although unnotarized exhibits would probably be found inadmissible by the Federal Court, the Registrar does not strictly adhere to the rules of practice of the Federal Court. Further, the Opponent never raised the fact that the exhibit had not been certified by the notary public. Given these circumstances, I will have regard to Exhibit A to the Guo affidavit.

II. Legal Onus and Evidential Burden

[21] The legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA) and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FC)].

III. Grounds of Opposition Summarily Dismissed

[22] The grounds of opposition raised under sections 30(d), 30(i), 12(1)(b), 16(2)(a) through (c) and 16(3)(c) of the Act are summarily dismissed for the reasons that follow.

[23] Since the application is solely based upon proposed use of the Mark, the non-compliance ground of opposition raised under section 30(d) of the Act is improperly pleaded. Likewise, the non-entitlement grounds of opposition raised under sections 16(2)(a) through (c) of the Act are

improperly pleaded. Incidentally, the Opponent did not make any submissions about these grounds of opposition in its written argument and did acknowledge their inappropriateness at the hearing.

[24] Section 30(i) of the Act requires an applicant to include a statement in the application that the applicant is satisfied that it is entitled to use the trade-mark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) can be found only where there are exceptional circumstances that render the applicant's statement untrue, such as evidence of bad faith or non-compliance with a federal statute [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155; and *Canada Post Corporation v Registrar of Trade-marks* (1991), 40 CPR (3d) 221 (FCTD)]. Those circumstances do not exist in the present case.

[25] The section 12(1)(b) ground of opposition is insufficiently pleaded. The Opponent did not allege any material facts in support of its allegation; it essentially reiterated the wording of the Act. It should also be noted that the Opponent did not make any submissions about this ground of opposition either in its written argument or at the hearing.

[26] Finally, I agree with the Applicant that the Galardo affidavit fails to establish use of any of the trade-names alleged in support of the non-entitlement ground of opposition raised under section 16(3)(c) of the Act. Accordingly, the Opponent failed to meet its evidentiary burden of showing that the alleged trade-names had been used in Canada before the priority filing date of the application for the Mark, namely May 23, 2005.

IV. Issues Arising from the Remaining Grounds of Opposition

[27] All but one of the remaining grounds of opposition are premised on allegations of a likelihood of confusion between the Mark and one or more of the Opponent's trade-marks comprising the word "pom". In the end, there are two issues in this proceeding that arise from these grounds of opposition, namely:

- Is the Mark confusing with the POM Registered Marks?
- Was the Applicant the person entitled to registration of the Mark at the priority filing date of the application?

[28] The third issue in this proceeding arises from the ground of opposition alleging that the application does not conform to the requirement of section 30(a) of the Act. It is:

- Are the wares identified in the application specifically defined in ordinary commercial terms?

V. Analysis of the Issues

V.1 Is the Mark Confusing with the POM Registered Marks?

[29] This issue arises from the ground of opposition raised under section 12(1)(d) of the Act. The material date that applies is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[30] Having exercised the Registrar's discretion, I confirm that each of the alleged registrations is extant in the Opponent's name. I have reflected the statement of wares of each registration in Schedule "A". As the Opponent met its evidentiary burden, the issue becomes whether the Applicant has satisfied its legal onus to show that the Mark is not reasonably likely to cause confusion with any of the Opponent's POM Registered Marks.

Assessment of the likelihood of confusion

[31] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[32] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time the trade-marks have been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR. (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v. Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 for a thorough discussion of the general principles that govern the test for confusion.]

[33] During its oral submissions, the Applicant extensively referenced the decision *Multi-Marques Inc v Nagar* (2012), 104 CPR (4th) 267 (TMOB) (*Pomepure*) involving an opposition by the Opponent to the registration of the trade-mark POMEPURE & Design where all of the grounds of opposition premised on allegations of confusion were dismissed. The Applicant also referenced the decision *Canada Bread Co v Beverages Brands (UK) Ltd* (2012), 99 CPR (4th) 459 (TMOB) (*Pomtini*) involving an unsuccessful opposition by the Opponent to the registration of the trade-mark POMTINI & Design.

[34] Even though it seems that the Opponent's evidence in both *Pomepure* and *Pomtini* was similar to the Opponent's evidence in the present proceeding, it is trite law that each case has to be decided based upon its own merit. For instance, *Pomtini* is distinguishable if only because the mark was associated with alcoholic beverages. Also, as the Opponent noted at the hearing, *Pomepure* is under appeal before the Federal Court [Court File No. T-2108-12].

[35] Reverting to the case before me, I note that the evidence introduced by the Galardo affidavit relates to the trade-marks that comprise the word "pom" under the ownership of Pom Bakery.

[36] I also note that the Galardo affidavit does not reference the POM WONDERFUL Marks. The affiant essentially introduces evidence for the trade-marks POM (TMDA49765), POM GOLD (POM D'OR) (UCA40516), POM LITE (TMA335,814) and POM & Design (TMA469,001) for bakery products. He refers to these marks collectively as "*les Marques*" and

to the wares covered by the registrations collectively as “*les Marchandises*”. My subsequent use of the term “Marks” reflects Mr. Galardo’s collective reference to the four registered trade-marks in his affidavit. Likewise, my subsequent use of the term “Wares” reflects his collective reference to the corresponding registered wares.

[37] Mr. Galardo explains that Pom Bakery, a subsidiary of Multi-Marques, had granted a licence to Multi-Marques for the use of the Marks; Pom Bakery directly controlled the character and quality of the Wares associated with the Marks and Multi-Marques had to follow strict use guidelines [paras 5, 8 to 10 of his affidavit]. The Applicant does not dispute that the licensed use of the Marks by Multi-Marques complied with the requirements of section 50(1) of the Act, which requires the owner to control, either directly or indirectly, the character or quality of the wares or services in order to benefit from the use of its trade-mark by a licensee. Accordingly, I find it reasonable to give full weight to Mr. Galardo’s statements and accept his affidavit as sufficient to establish that the licensed use of the Marks by Multi-Marques accrued to the benefit of Pom Bakery.

[38] I find that the trade-mark POM of registration No. TMDA49765 presents the Opponent’s strongest case when considering the four POM Registered Marks associated with bakery products. Insofar as the POM WONDERFUL Marks are concerned, I consider that the trade-mark POM WONDERFUL & Design (TMA832,083) for “fruit juices and fruit juice concentrates, except apple juice and apple concentrate” presents the Opponent’s strongest case. Accordingly, my assessment of the surrounding circumstances focuses on comparing the Mark with the registered trade-marks POM and POM WONDERFUL & Design.

[39] In *Masterpiece, supra*, the Supreme Court of Canada discusses the importance of the degree of resemblance between trade-marks in conducting an analysis of the likelihood of confusion. In the reasons for judgment, Mr. Justice Rothstein states at paragraph 49:

[...] the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis [...] if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar... As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start [...].

[40] I turn to the assessment of the section 6(5) factors starting with the degree of resemblance between the trade-marks.

The degree of resemblance between the marks in appearance or sound or in the ideas suggested by them

[41] The law is clear that when assessing confusion it is not proper to dissect trade-marks into their component parts; rather, marks must be considered in their entirety. I find that the consideration of the section 6(5)(e) factor particularly favours the Opponent when considering its mark POM WONDERFUL & Design.

[42] The Applicant made several submissions about differences between the marks in issue. The Applicant's submissions are partly based on its contention that the Mark is "highly visually and aurally suggestive of pomegranate" because of its first letters "pomegr" and final "t" sound.

[43] Although I find that the element "pome" is evocative of pomegranate in the context of dietary, vitamin and fruit extract supplements *containing pomegranate*, the Applicant did not convince me that the Mark will be seen by consumers as the word "pomegranate", nor did it convince me that the Mark sounds like the word "pomegranate". When considered as a whole, I believe consumers are more likely to react to the Mark by thinking that it is formed from the prefix "pome" and the suffix "great". Further, as "great" is a word of the ordinary English language, it is only common sense to conclude that the suffix of the Mark would be pronounced as the word "great". Finally, given the meaning of the adjective "great", I find it can fairly be concluded that the Mark suggests the idea that the dietary, vitamin and fruit extract supplements associated with it are above average.

[44] The Applicant submits that there are differences between "pome" and "pom" in sound because the "e" in "pome" is not silent. Even though I find that there is merit to the Applicant's submissions when considering English speaking consumers, I find that there is merit to the Opponent's position about identity between the prefix "pome" and its mark POM in sound when considering French speaking consumers. Indeed, my own knowledge of my mother tongue leads me to conclude that "pom" and "pome" would be pronounced identically by French speaking consumers; both "pom" and "pome" sounds like the French word "*pomme*" (in English: apple).

Nonetheless, considering the Mark in its entirety, I disagree with the Opponent's contention that the Mark is "identical in appearance, sound and meaning" to the mark POM.

[45] There is merit to the Applicant arguing differences between the Mark and the mark POM WONDERFUL & Design in appearance when I consider the heart-shaped "o" in the word "pom" combined to this word being above the word "wonderful". However, its visual aspects are of no consequence on the idea suggested by the mark POM WONDERFUL & Design and the resulting similarity between the ideas suggested by it and the Mark. The fact that the words "wonderful" and "great" are synonymous cannot be ignored. Accordingly, I find it fair to conclude to a significant similarity, if not identity, between the ideas suggested by the Mark and the mark POM WONDERFUL & Design. In my view, the resemblance between the ideas suggested by the Mark and the trade-mark POM WONDERFUL & Design are important enough to outweigh the differences in appearance or sound.

The inherent distinctiveness of the trade-marks and the extent to which they have become known

[46] The section 6(5)(a) factor involves a combination of inherent and acquired distinctiveness of the parties' marks. The consideration of this factor favours the Opponent, but only to the extent that its trade-mark POM is concerned.

[47] The mark POM in the context of bakery products possesses a significant degree of inherent distinctiveness. Further, even though the collective references to the Marks and the Wares open the Galardo affidavit to criticism, based on a fair reading of the affidavit in its entirety, I am satisfied that it establishes significant use and promotion of the mark POM in Canada in association with bread-type products. Since this is not disputed by the Applicant, I will not extensively detail the evidence. Suffice it to say that Mr. Galardo asserts that the mark POM has been used in Canada since at least as early as 1930 [para 11 of his affidavit]. He also provides the following evidence:

- specimens of use of the Marks [para 12 of his affidavit, Exhibit JPG-2]. They appear to consist of photocopies of product packages, presumably plastic bags which would explain the quality of their reproduction. The packages are for

bread-type products (e.g. milk bread, buns, bagels, hamburger buns, pita breads, dinner rolls, etc.). The specimens mostly display one or both of the following two design marks, which I accept as use of the word mark POM:



- copies of invoices dating from 1997 to 2005 relating to the sales of the Wares in association with the Marks [para 13 of his affidavit, Exhibit JPG-3];
- a yearly breakdown of the sales figures for the Wares associated with the Marks from 1999 up to June 30, 2008. The total approximate value of these sales figures exceeds \$674 million [para 16 of his affidavit]; and
- at the date of his affidavit, Pom Bakery and Multi-Marques invested approximately \$3 million annually in promoting the Marks across Canada through various media, such as radio and television stations, as well as print and virtual media [para 22 of his affidavit].

[48] Insofar as the Mark is concerned, I consider its inherent distinctiveness to be rather limited in the context of dietary, vitamin and fruit extract supplements containing pomegranate. As discussed above, I find that consumers are more likely to react to the Mark by thinking that it is formed from the prefix “pome”, which is suggestive of pomegranate, and the laudatory word “great”.

[49] Likewise, the mark POM WONDERFUL & Design does not possess an important degree of inherent distinctiveness. The element “pom” in the context of fruit juices and fruit juice concentrates can be considered suggestive of beverages made from pomegranate. Also, as previously discussed, a French speaking consumer could react to the word “pom” by thinking of the word “*pomme*”. Thus, even though apple juice and apple concentrate are specifically excluded from the wares associated with the mark POM WONDERFUL & Design, it remains that “pom” can also be considered suggestive of fruit beverages and fruit concentrates containing apple juice or apple concentrate. The word “wonderful” is a laudatory word. The design features of the mark POM WONDERFUL & Design do little to increase its inherent distinctiveness. The

heart-shaped “o” is intrinsic with the word “pom”. Likewise, the stylized script and font employed are intrinsic with the words forming the mark [see *Canadian Jewish Review Ltd v The Registrar of Trade Marks* (1961), 37 CPR 89 (Ex C)].

[50] There is no evidence to conclude that the Mark has acquired distinctiveness in Canada through promotion or use. It is the same for the mark POM WONDERFUL & Design. Also, the mere existence of the Opponent’s registration for the trade-mark POM WONDERFUL & Design can establish no more than minimal use and cannot give rise to an inference of significant and continuous use of the trade-mark [see *Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)].

The length of time each trade-mark has been in use

[51] Although the Galardo affidavit is insufficient to establish continuous use of the mark POM since 1930, it is clearly sufficient to conclude that the Opponent is favoured by the section 6(5)(b) when considering the length of time the mark POM has been used in Canada.

[52] However, the section 6(5)(b) factor is of no significance when considering the Opponent’s mark POM WONDERFUL & Design. Even though registration No. TMA832,083 shows that a declaration of use of the mark POM WONDERFUL & Design was filed on September 17, 2012, as discussed above the use of that mark is assumed to be only minimal.

The nature of the wares, services or business; and the nature of the trade

[53] The evidence provided by the Applicant through the Guo affidavit is essentially about the nature of the wares and the nature of the trade associated with the Mark. Although the evidence concerns the United States, it establishes that the Applicant would sell the same products in Canada, under the same or substantially the same labels, and through the same or similar channels of trade [para 8 of the Guo affidavit].

[54] It is the statement of wares in the application for the Mark and the statement of wares in the Opponent’s registrations that must be taken into consideration when assessing the section 6(5)(c) and (d) factors under the registrability ground of opposition [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe, Inc v Bohna*

(1994), 58 CPR (3d) 381 (FCA)]. I find that the overall consideration of these factors favours the Opponent, but only to the extent that its mark POM WONDERFUL & Design is concerned.

[55] The Opponent did not convince me that the nature of the Applicant's wares, i.e. "dietary supplements namely fruit juice concentrates containing pomegranate and vitamin and fruit extract supplements containing pomegranate in liquid form [...]", is the same than the nature of the wares registered in association with its mark POM, i.e. "bread, cake and confectionery namely pastries, cookies, waffles and candies". I rather agree with the Applicant that there are significant differences between these wares.

[56] However, the Applicant did not convince me that there is no relationship whatsoever between the wares associated with the Mark and the fruit juices and fruit juice concentrates associated with the mark POM WONDERFUL & Design. It remains that the dietary supplements associated with the Mark are specifically defined as *fruit juice concentrates* containing pomegranate. Also, the evidence provided by Ms. Guo establishes that the Applicant's wares are liquid dietary supplements that consist primarily of highly concentrated juices; they are intended for consumption in a quantity of 15 ml per serving; they may be taken directly, or mixed into milk, water or juice to increase palatability [paras 5 and 6 of her affidavit, Exhibit A].

[57] Turning now to the nature of the trade, the application for the Mark contains a restriction for the distribution of the wares. The channels of trade are restricted to "retailers that specialize in health foods, natural foods, vitamins, or nutritional supplements". Further, Ms. Guo testifies that the wares associated with the Mark are not sold "through ordinary grocery outlets or bakeries" [para 7 of her affidavit].

[58] By contrast, the Opponent's evidence establishes that the bread-type products associated with the mark POM are sold in convenience stores ("*dépanneurs*"), grocery stores and supermarkets; they are also distributed and sold in the food services sector, including restaurants, bars, fast food counters, cafeterias, canteens, hospitals, daycares and schools [para 17 of the Galardo affidavit]. There is no evidence about the channels of trade for the mark POM WONDERFUL & Design. Nonetheless, I find it fair to infer that the fruit juices and fruit juice concentrates associated with it are sold by the Opponent through the same channels of trade as the bread-type products associated with its mark POM.

[59] Given the restriction in the application for the Mark and the Opponent's evidence, I agree with the Applicant that there is an apparent distinction between the parties' channels of trade. That said, in attempting to establish confusion, it is not necessary to prove that the parties' wares are sold in the same outlets, as long as the parties are entitled to do so [see *Eminence SA v Registrar of Trade Marks* (1977), 39 CPR (2d) 40 (FCTD) at 43]. The Opponent correctly submits that its registrations do not contain any restrictions for the distribution of its wares. However, in dealing with the Opponent's submissions, I find the following comments of Mr. Justice Jerome in *Canada Wire & Cable Ltd v Heatex Howden Inc* (1986), 13 CPR (3d) 183 (FCTD) at 186 to be of interest:

Counsel for the respondent correctly then referred me to the decision of my colleague, Mr. Justice Dubé, in [*Eminence SA, supra*] and clearly he went on from that point to say that it is maybe true that these products are not sold in competitive circumstances at the present time, but the parties do have the right to sell them in competitive circumstances. It seems to me that test is entirely valid, but it must also be asked: is it likely? Is it likely that they will sell them in competitive circumstances? Because, indeed, likelihood of confusion is the very essence of the test of this appeal. Of course, there is evidence that these parties have the right to go on and sell in competitive circumstances, but there's no evidence that it's at all likely. It hasn't happened now in many years of history of both of these fairly large and fairly successful companies, selling rather high volumes of their products. There's no reason for me to infer that while they do have the right to go on and do it that there's any likelihood that they are going to do it.

[60] In my view, this is a case where it could be asked: Are the wares associated with the parties' marks likely to be sold in competitive circumstances?

[61] Since the bread-type products associated with the mark POM have never been sold in health foods, natural foods, vitamins or nutritional supplements retail stores despite long, continuous and extensive use of the mark POM, it seems to me that it is unlikely to happen. In other words, it seems to me unlikely that the wares associated with the mark POM and those associated with the Mark would be sold in competitive circumstances.

[62] However, there is no evidence of use of the mark POM WONDERFUL & Design. Further, the fruit juices and fruit juice concentrates associated with the mark POM WONDERFUL & Design are different in nature from the bread-type products associated with the mark POM. Thus, it could be that the channels of trade for the wares associated with the

mark POM WONDERFUL & Design would not be restricted to those associated with the mark POM. In the end, contrary to the mark POM, there is not a long enough historical pattern of sales for me to say conclusively that it is unlikely that the wares associated with the mark POM WONDERFUL & Design would be sold in health foods, natural foods, vitamins or nutritional supplements retail stores.

Additional surrounding circumstance: ordering information for the wares associated with the Mark

[63] I do not intend to engage into a lengthy discussion of the Opponent's oral submissions about the fact that the Applicant is using POM as one of the order codes for the wares associated with the Mark [Exhibit A to the Guo affidavit]. Suffice it to say that this proceeding decides whether the Applicant can obtain registration of the trade-mark POME GREAT.

Additional surrounding circumstance: state of the register

[64] State of the register evidence is introduced to show the commonality or distinctiveness of a mark or portion of a mark in relation to the register as a whole. Evidence of the state of the register is only relevant insofar as inferences may be made on it concerning the state of the marketplace, and inferences about the state of the marketplace can only be drawn when a significant number of pertinent registrations are located [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

[65] The Applicant relies on the state of the register evidence introduced through the first Palmer affidavit as an additional surrounding circumstance supporting its case.

[66] Ms. Palmer files the results of the search she conducted "to locate active marks commencing with POM in classes 29, 30, 31 and 32", not including the marks owned by Multi-Marques, Pom Bakery or the Applicant. Ms. Palmer states that she conducted her search through the CDNameSearch Corp system [para 3 of her first affidavit]; what she files as the results of her search are print-out of applications and registrations from the Canadian Trade-

marks Database [Exhibit A]. It must be noted that a few print-outs do not show the full particulars of the trade-mark applications or registrations.

[67] The Applicant submits that the evidence establishes that trade-marks including the prefix “pom” are commonly adopted by third parties in association with food and beverages products. At paragraph 14 of its written argument, the Applicant provides a table of the located registered trade-marks that it considers pertinent. The Opponent submits that the number of relevant marks disclosed is not sufficient to afford any significance to the state of the register evidence.

[68] For the reasons that follow, I find that the state of the register evidence favours the Applicant but only to a limited extent.

[69] For one thing, I do not agree with the Applicant’s position that all of the registered trade-marks referenced in its written argument are pertinent. More particularly, I am not affording any significance to the following registered trade-marks referenced by the Applicant:

- MADAME DE POMPADOUR (TMA671,886) because “de Pompadour” refers to a surname;
- POM DE VIE (TMA572,346) because I do not consider alcoholic beverages to be part of the same industry as food products [see *Pomtini, supra*, at para 76];
- POMMALEFUN & Design (TMA574,423) and POMMERY & Design (TMA203,991) because the print-out of each registration in Exhibit A does not show the statement of wares; and
- POMTINI (TMA693,330) because it is not found in Exhibit A.

[70] Excluding the above-identified registrations from the state of the register evidence, the remaining registered marks referenced by the Applicant are:

- LES MOUTS DE P.O.M. & Design (TMA637,054) for sparkling non-alcoholic apple juice;
- POM-POM (UCA36133) for fresh citrus fruits;
- POME GRANDE (TMA691,908) for pomegranate juice;

- POMEGRAN and POMEGRAN PLUS (TMA728,700 and TMA736,466) for breakfast cereals and toasters pastries, and for breakfast cereals and waffles respectively;
- POMI' (TMA487,616) for sauces;
- POMITO (TMA173,678) for fruit juices and other food products;
- POMMONDE (TMA687,980) for potatoes and products made of potatoes;
- POMOCOCO (TMA253,148) for cakes;
- POMPEIAN (TMA343,924) for olive oil; and
- POMPOMS (TMA256,352) for frozen French fried potatoes and frozen fried potatoes croquettes.

[71] I accept to infer from these registered marks that the prefix “pom” has been commonly adopted as a component of trade-marks for food products generally. However, too few registrations have been evidenced to allow me to infer that such trade-marks have been commonly adopted for non-alcoholic beverages in particular.

Conclusion on the likelihood of confusion

[72] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection.

[73] Considering the marks in their entirety, I find that the degree of resemblance between the Mark and the mark POM does not significantly advance the Opponent’s case, especially when the state of the register evidence as to common adoption of the prefix “pom” as a component of trade-marks for food products generally is factored in. Further, even though the mark POM has been used for a significant length of time in Canada and may have achieved a significant reputation for bakery products, there are significant differences between the parties’ wares. Finally, the Opponent’s own evidence lends support to a finding that the channels of trade associated with its bakery products and the channels of trade described in the application for the Mark do not overlap and are unlikely to overlap.

[74] Accordingly, having considered all of the surrounding circumstances of this case, I am satisfied that the Applicant has discharged its legal onus of establishing that the Mark is not reasonably likely to cause confusion with the registered the trade-mark POM (TMDA49765).

[75] Since I previously indicated that the trade-mark POM presents the Opponent's strongest case for the POM Registered Marks associated with bakery products, I also conclude that the Applicant has discharged its legal onus of establishing that the Mark is not reasonably likely to cause confusion with the registered trade-marks POM GOLD (POM D'OR) (UCA40516), POM LITE (TMA335,814) and POM & Design (TMA469,001).

[76] However, having considered all of the surrounding circumstances of this case, I am not satisfied that the Applicant has discharged its legal onus of establishing that there is no reasonable likelihood of confusion between the Mark and the registered trade-mark POM WONDERFUL & Design (TMA832,083).

[77] Indeed, considering the marks in their entirety, I find that the degree of resemblance between the ideas suggested by the Mark and the trade-mark POM WONDERFUL & Design significantly advances the Opponent's case. The degree of resemblance between the marks combined with the relationship between the nature of the wares and the potential for overlap in the channels of trade favour the Opponent in the overall assessment of the balance of probabilities as to a likelihood of confusion. Even if I acknowledge that the state of the register evidence shows that the prefix "pom" is commonly adopted as a component of trade-marks for food products generally, I do not find this additional surrounding circumstance significant because too few registrations have been evidenced for non-alcoholic beverages. At best for the Applicant, I would find that this additional surrounding circumstance results in an even balance of probabilities between a finding of confusion and a finding of no confusion. As the onus is on the Applicant to establish on a balance of probabilities that the Mark is not confusing with the trade-mark POM WONDERFUL & Design, I would still decide against the Applicant.

[78] Since I accept the section 12(1)(d) ground of opposition based on registration No. TMA832,083 for the trade-mark POM WONDERFUL & Design, I am not considering the ground of opposition based on registration No. TMA774,041 for the trade-mark POM WONDERFUL registered in association with "fresh fruits, except apples".

V.2 Was the Applicant the Person Entitled to Registration of the Mark at the Priority Filing Date of the Application?

[79] This issue arises from the grounds of opposition alleging that the Applicant is not the person entitled to registration of the Mark in view of confusion with:

- the POM Registered Marks, the trade-mark POM and the POM Pending Marks alleged to have been previously used (made known) in Canada [section 16(3)(a) of the Act]; and
- the POM Registered Marks and POM Pending Marks that had been previously applied for registration in Canada [section 16(3)(b) of the Act].

[80] The Opponent has the initial burden of proving that each of the trade-marks alleged in support of the section 16(3)(a) ground of opposition was used in Canada before the priority filing date of the application for the Mark, namely May 23, 2005, and had not been abandoned at the date of advertisement of the application, namely February 28, 2007 [section 16(5) of the Act].

[81] Likewise, the Opponent has the initial burden of proving that each of the applications alleged in support of the section 16(3)(b) ground of opposition was filed before the priority filing date of the application for the Mark and was pending at the date of advertisement of the application [section 16(4) of the Act].

[82] As a first matter, it should be noted that a few trade-marks that I have found relevant when considering the state of the register evidence under the registrability ground of opposition were not registered on May 23, 2005. Thus, the state of the register evidence is of less significance in the assessment of the surrounding circumstances of this case under the non-entitlement grounds of opposition.

[83] I now turn to the analysis of the non-entitlement grounds of opposition starting with the one raised under section 16(3)(b) of the Act.

[84] I have exercised the Registrar's discretion to review the trade-marks register to inspect application No. 1,176,267 for the mark POM WONDERFUL & Design alleged in support of the section 16(3)(b) ground of opposition [see *Royal Appliance Mfg Co v Iona Appliance Inc* (1990),

32 CPR (3d) 525 (TMOB) at 529]. I have confirmed that the application was filed on April 25, 2003 based on proposed use of the mark and was pending on February 28, 2007.

[85] As the Opponent met its evidentiary burden, the issue becomes whether the Applicant has satisfied its legal onus to show that the Mark, as of May 23, 2005, was not reasonably likely to cause confusion with the mark POM WONDERFUL & Design applied for registration in association with, among others, fruit juices and fruit juice concentrates.

[86] When I compare the Mark and the trade-mark POM WONDERFUL & Design (No. 1,176,267) under the section 16(3)(b) ground of opposition, I conclude that assessing each of the section 6(5) factors as of May 23, 2005 does not significantly impact my analysis of the surrounding circumstances of this case under the section 12(1)(d) ground of opposition.

[87] Accordingly, for reasons similar to those expressed under the section 12(1)(d) ground of opposition, I am not satisfied that the Applicant has discharged its legal onus of establishing that, as of May 23, 2005, there was no reasonable likelihood of confusion between the Mark and the trade-mark POM WONDERFUL & Design of application No. 1,176,267 for fruit juices and fruit juice concentrates.

[88] Since I accept the non-entitlement ground of opposition raised under section 16(3)(b) of the Act based upon the trade-mark POM WONDERFUL & Design of application No. 1,176,267, I am not considering the ground of opposition for any of the other previously filed applications alleged by the Opponent. Likewise, I am not considering the non-entitlement ground of opposition raised under section 16(3)(a) of the Act.

V.3 Are the Wares Identified in the Application Specifically Defined in Ordinary Commercial Terms?



[89] This issue arises from the ground of opposition raised under section 30(a) of the Act. As I have already decided in favor of the Opponent under two grounds of opposition, I find it not necessary to consider the section 30(a) ground of opposition.

VI. Disposition







[90] Having accepted the sections 12(1)(d) and 16(3)(b) grounds of opposition in view of confusion with the trade-mark POM WONDERFUL & Design (registration No. TMA832,083; application No. 1,176,267), pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application under section 38(8) of the Act.

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule A

<u>Trade-mark</u>	<u>No.</u>	<u>Date</u>	<u>Wares</u>
	TMA469,001	Jan. 17, 1997	<i>Produits de boulangerie et de pâtisserie, notamment pain, pain biologique, petits pains, beignes, brioches, gâteaux, biscuits, galettes, pâtisseries, tartes, muffins, muffins anglais, croissants, pâte à pizza, tortillas, pita, bagels, breadsticks et kaisers.</i>
POM GOLD (POM D'OR)	UCA40516	Feb. 1, 1952	Bread
POM	TMDA49765	June 20, 1930	Bread, cake and confectionery namely pastries, cookies, waffles and candies.
POM LITE	TMA335,814	Dec. 31, 1987	Bread
POM WONDERFUL	TMA774,041	Aug. 10, 2010	Fresh fruits, except apples.
	TMA832,083	Sept. 17, 2012	Fruit juices and fruit juice concentrates, except apple juice and apple concentrate.

Schedule "B"

<u>Trade-mark</u>	<u>Application No.</u>	<u>Filing Date</u>
	1,037,297	November 23, 1999
	1,037,299	November 23, 1999
	1,038,744	December 6, 1999
	1,037,298	November 23, 1999
POM'S SMART	1,282,503	December 9, 2005
POM	1,122,704	November 23, 2001
POM WONDERFUL	1,118,804	October 18, 2001
	1,176,267	April 25, 2003
POM SPORT	1,261,684	June 17, 2005
POMx	1,275,312	October 11, 2005
	1,275,319	October 11, 2005