



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

Citation: 2011 TMOB 30
Date of Decision: 2011-02-11

**IN THE MATTER OF AN OPPOSITION
by Agropur Cooperative to application
No. 1,178,194 for the trade-mark
ÉCRÉMÉPLUS Design in the name of
Parmalat S.p.A.**

The File Record

[1] On May 15, 2003 Parmalat Dairy & Bakery Inc. filed application number 1,178,194 to register the trade-mark ÉCRÉMÉPLUS Design (the Mark) as illustrated hereinafter:

ÉcréméPlus

[2] The application was filed on the basis of proposed use. The application was subsequently assigned to Parmalat S.p.A. (the Applicant).

[3] The application as it stands now covers the following wares: dairy products namely, milk, cream, powdered milk, butter, yogurt, cheese, sour cream, ice cream, frozen yogurt, iced milk and eggnog (the Wares), and the following services: advertising and promotion of dairy products, namely, distribution of coupons and educational

brochures concerning nutrition, the provision of food products for sampling, conducting contests (the Services).

[4] By letter dated January 20, 2004 an examiner raised some objections based on s. 12(1)(d) of the *Trade-marks Act*, R.C.S. 1985, c. T-13 (the Act), and s. 30(a) of the Act; and requested a disclaimer to the right of the exclusive use of the word ÉCRÉMÉ apart from the Mark pursuant to s. 12(1)(b) and s. 35 of the Act. The examiner was of the opinion that ÉCRÉMÉ clearly describes the Applicant's Wares, namely that they consist of or are made with skim milk.

[5] The Applicant filed a revised application on September 27, 2004 to overcome some of those objections. It filed a further revised application on October 23, 2006 to delete some of the wares listed in the original application.

[6] The application was advertised on February 21, 2007 in the *Trade-marks Journal* for opposition purposes. Agropur Cooperative (the Opponent) filed a statement of opposition on July 20, 2007. The Applicant filed a counter statement on December 14, 2007 denying the allegations contained in the statement of opposition. The Applicant further re-amended its application on December 4, 2008.

[7] The Opponent filed as its evidence certified copies of registrations TMA536,005 for the trade-mark FARMERS SKIM PLUS & Design and TMA394,053 for the trade-mark BECKER'S SKIM PLUS as well as the affidavit of Lynda Maureen Palmer and two affidavits of Zeina Waked while the Applicant filed the affidavits of Enrico Bondi and David Takagawa.

[8] Both parties filed a written argument and no oral hearing was requested.

The Grounds of Opposition

[9] The grounds of opposition raised by the Opponent are:

- 1) The application contravenes the provisions of s. 30 of the Act and rule 31(e) of the *Trade-marks Regulations* since the wares: margarine and sherbet could not be claimed as they were not included in the initial wording of the application;

- 2) The Applicant did not have the intention to use the Mark as a trade-mark at the filing date of the application in association with all of the Wares and Services;
- 3) The application does not satisfy the requirements of s. 30 of the Act as the Applicant does not, by itself or through a licensee, have the intention to use the Mark in Canada in association with all of the Wares and Services;
- 4) The Mark is not registrable as whether depicted, written or sounded, it is clearly descriptive or deceptively misdescriptive in the French or English language of the character or quality of the Wares or Services in association with which it is proposed to be used;
- 5) The Mark is not registrable pursuant to s. 12(1)(d) of the Act as it is confusing with the registered trade-marks BECKER'S SKIM PLUS & Design, certificate of registration TMA394,053 covering skim milk with added milk solids and FARMERS SKIM PLUS & Design, certificate of registration TMA536,005 covering milk;
- 6) The Mark is not distinctive and is not apt to distinguish the Wares and Services of the Applicant from those of third parties as the Mark is clearly descriptive or deceptively misdescriptive in the French or English language of the character or quality of the Wares or Services and also because of the confusion it creates with the registered trade-marks BECKER'S SKIM PLUS & Design and FARMERS SKIM PLUS & Design.

Legal Onus and Burden of Proof in Trade-marks Opposition Proceedings

[10] The legal onus is upon the Applicant to show that its application complies with the provisions of the Act, but there is however an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325; *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company* [2005] F.C. 722].

The Opponent's Evidence

[11] As mentioned above the Opponent has filed certified copies of registrations TMA536,005 for the trade-mark FARMERS SKIM PLUS & Design and TMA394,053 for the trade-mark BECKER'S SKIM PLUS. The affidavit of Ms. Palmer, a trade-mark searcher, serves to file in the record a copy of the file wrapper of the present application.

One affidavit of Ms. Waked (dated July 7, 2008) contains the results of searches on the Internet using the search engine Google for the term “margarine”. She also filed extracts of the website of Radio Canada that discuss the results of an enquiry on margarine. Since the Applicant has deleted from the list of wares “margarine”, the content of that affidavit is no longer relevant to the remaining issues raised in the statement of opposition. Finally the content of the second affidavit of Ms. Waked (dated June 11, 2008) will be described in more details when assessing the ground of opposition based on s. 12(1)(b) of the Act.

The Applicant’s Evidence

[12] Mr. Takagawa is a lawyer with the Applicant’s agent firm. On February 18, 2009 he conducted a search and retrieved from the Canadian Intellectual Property Office Database records 11 extracts of the register which shall be described in more details when assessing the ground of opposition based on s. 12(1)(b) of the Act.

[13] Mr. Bondi is the Managing Director of the Applicant. He states that Parmalat Canada Inc. is a subsidiary of the Applicant that is licensed to use in Canada the Applicant’s trade-marks. He provides some information on the use of the Mark in Canada in association with milk. He files samples of milk packaging bearing the Mark which appears as a secondary trade-mark to the Applicant’s main trade-marks namely, BEATRICE and PARMALAT. He states that the Mark as well as the trade-mark SKIMPLUS appears in opposite sides of the carton in order to meet the Canadian labelling requirements.

[14] He provides a list of the chain stores in Canada that sell BEATRICE products, and more particularly, milk bearing the Mark. He alleges that the Opponent (sic) has been selling milk bearing the Mark in Canada since 2003 and presents the annual sales figures for the period between 2003 and 2008 (November). He files promotional material used in Canada since 2003 to market milk bearing the Mark. Most of the material filed makes reference to SKIM PLUS on English language material but Mr. Bondi asserts that similar material has been distributed in the French Language in the province of Quebec wherein reference is made to the Mark in association with milk.

[15] He states that the Applicant had and does have the intention to use the Mark in Canada in association with the goods and services listed in the application.

[16] I shall disregard the content of the last paragraph of his affidavit as it constitutes an opinion on the likelihood of confusion between the Mark and the registered trademarks cited by the Opponent in its statement of opposition. This is one of the issues that the Registrar has to determine on the basis of the factual evidence in the file.

[17] I will now assess the grounds of opposition described above, not necessarily in the order listed.

The First Ground of Opposition

[18] This ground of opposition is moot in view of one of the amendments made to the application wherein “margarine” and sherbet” have been deleted from the list of wares.

The Second Ground of Opposition

[19] In its written argument the Opponent has indicated that it was withdrawing this ground of opposition.

The third Ground of Opposition

[20] In *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.) the Registrar ruled that when such ground of opposition is raised the Opponent's evidential burden is lighter than under other grounds of opposition as the evidence is mainly to the Applicant's knowledge. The Opponent may succeed under this ground of opposition if the Applicant's evidence is clearly inconsistent with the statements made in the application [see *York Barbell Holdings Ltd. v. ICON Health & Fitness, Inc.* (2001), 13 C.P.R. (4th) 156 (T.M.O.B.)].

[21] In this instance the application is based on proposed use in Canada. Therefore there is no obligation on the Applicant to use the Mark in association with each of the Wares and Services until the application obtains final allowance from the Registrar.

There is evidence of use of the Mark in Canada in association with milk. It does not necessarily mean, as suggested by the Opponent in its written argument, that the Applicant does not intend to use the Mark in association with the other Wares and the Services. In any event such use is subsequent to the relevant date, namely the filing date of the application [see *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293 and *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469].

[22] Additionally Mr. Bondi reiterates in his affidavit that the Applicant intends to use the Mark in association with all of the Wares and Services. There is no contradiction between the Applicant's evidence and the statement made by the Applicant in its application under s. 30(e) of the Act. The Opponent has not adduced any evidence to contradict such statement.

[23] Consequently I dismiss the third ground of opposition.

The Fifth Ground of Opposition

[24] The Opponent has met its initial burden of proof under its ground of opposition based on s. 12(1)(d) of the Act by filing certified copies of registrations TMA536,005 for the trade-mark FARMERS SKIM PLUS & Design and TMA394,053 for the trade-mark BECKER'S SKIM PLUS. I used my discretion and checked the register. I confirm that those third parties' registrations are extant. Therefore I have to determine if, on a balance of probabilities, there is a likelihood of confusion between the Mark and those registered trade-marks.

[25] The test to determine this issue is set out in s. 6(2) of the Act wherein it is stipulated that the use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would likely lead to the inference that the wares and services associated with those trade-marks are manufactured, sold or leased by the same person, whether or not the wares and services are of the same general class. In making such assessment I must take into consideration all the relevant surrounding circumstances, including those listed in s. 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-

marks have been in use; the nature of the wares and services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them.

[26] Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Clorox Co. v. Sears Canada Inc.* (1992), 41 C.P.R. (3d) 483 (F.C.T.D.) and *Gainers Inc. v. Marchildon* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)]. I also refer to the judgments of the Supreme Court of Canada in *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401 where Mr. Justice Binnie commented on the assessment of the criteria enumerated under s. 6(5) of the Act to determine if there is a likelihood of confusion between two trade-marks.

[27] It is not necessary, at this stage, to determine if the Mark is descriptive. I shall do so when assessing the ground of opposition based on s. 12(1)(d) of the Act. Suffice to say that it is at least highly suggestive; thus a very weak mark. Ms. Waked has been a paralegal working for the Opponent's agent firm. Part of her second affidavit consists in the filing of extracts of various Dictionaries: French, English, French-English and English-French. From these extracts I conclude that the word "écrémé" in French translates into English to "skim". The word "plus" is a common word both in French and English languages.

[28] Both trade-marks cited by the Opponent are more inherently distinctive than the Mark. The addition of the distinctive element FARMER'S in one case and BECKERS in the other trade-mark make the cited registered trade-marks more distinctive. There is no evidence of use of any of these third parties' registered trade-marks while the Applicant has shown use of the Mark in association with milk since 2003. Although the certificates of registration do refer to a declaration of use filed by the registrant, I can only infer from such statement a *de minimis* use of those marks [see *Entre Computer Centers Inc. v. Global Upholstery Co.* (1992), 40 C.P.R. (3d) 427 (TMOB)]. I shall not afford significant weight to such use. There is definitively an overlap in some of the wares as the

registrations cover either milk or skim milk. I would have to presume that the parties' channels of trade would be similar at least for those wares.

[29] Finally the degree of resemblance between two trade-marks is one of the most important criteria when assessing the likelihood of confusion between them [see *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145].

[30] In assessing the likelihood of confusion between two trade-marks one must consider not only the average unilingual English or French speaking consumer but also the average bilingual consumer [see *Pierre Fabre Médicament v. SmithKline Beecham Corp* (2001) 11 C.P.R. (4th) 1 (F.C.A.)]. Therefore there is no doubt that a bilingual consumer will identify "Écrémé Plus" as the French translation of "Skim Plus". I do not give much weight to the Applicant's argument that the word portion of the Mark is a coined word, being the juxtaposition of the words ÉCRÉMÉ and PLUS. This position has been discussed by the Federal Court in *Mr. P's Mastertune Ignition Services Ltd. v. Tune Masters Inc.* (1984), 82 C.P.R. (2d) 128.

[31] The trade-marks in issue must be viewed as a whole. The trade-marks cited by the Opponent do contain an additional distinctive element: BECKER'S in the case of registration TMA394,053 and FARMERS in the case of registration TMA536,005.

[32] In the context of this case, the differences in sound and appearance between the Mark and the trade-marks cited by the Opponent are sufficient to distinguish them.

[33] Therefore I conclude that, on a balance of probabilities, there is no likelihood of confusion between the Mark and the registered trade-marks cited by the Opponent. The fifth ground of opposition is therefore dismissed.

The Fourth Ground of Opposition

[34] The test under s. 12(1)(b) has been laid down in *Thomas J. Lipton Ltd. v. Salada Foods Ltd (no.3)* (1979), 45 C.P.R. (2d) 157 in the following terms:

Connotation means an implication or a suggestion. Even a "specific descriptive suggestion or implication" or "a clear implication or suggestion" that a mark is descriptive or misdescriptive is not sufficient to disqualify it for registration under s-s. 12(1)(b). That enactment admits of no mere implication or suggestion. Parliament used the word "clearly" before the word "descriptive" and "deceptively" before the word "misdescriptive" and the Registrar has made no finding that the word was either clearly descriptive or deceptively misdescriptive. As to whether a mere suggestive description suffices, one might refer to a decision of the former Exchequer Court of Canada in the case of *Kellogg Co. of Canada Ltd. v. Registrar of Trade Marks*, [1939] 3 D.L.R. 65, [1940] Ex. C.R. 163 at pp. 170 and 171.

The concept of clearness where the word is descriptive and of deception where it is misdescriptive are essential elements.

[35] The registrability of the Mark under s. 12(1)(b) of the Act is to be assessed at the filing date of the application (May 15, 2003) [see *Dic Dac Holdings (Canada) Ltd v. Yao Tsai Co.* (1999), 1 C.P.R. (4th) 263, *Zorti Investments Inc.v. Party City Corporation* (2004), 36 C.P.R. (4th) 90; *Havana Club Holdings S.A. v. Bacardi & Company Limited*, (2004) 35 C.P.R. (4th) 541].

[36] As mentioned before, Ms. Waked has filed various extracts of dictionaries in order to provide the meaning of the words "skim", "plus" and "écrémé". From those extracts I conclude that the French verb "écrémer" means "Dépouiller (le lait) de la crème, de la matière grasse" [see *Le Petit Robert*, Exhibit ZW-2 to Ms. Waked's affidavit]. In such extract we find the example "lait écrémé". The word "plus" is defined in the same dictionary as "Mot servant de comparatif à *beaucoup* et entrant dans la formation des comparatifs de supériorité et dans celle du superlatif relatif à la supériorité."

[37] Ms. Waked did some research on the Internet using the search engine Google to locate hits where the word "écrémé" is found in conjunction with other terms such as "produits latiers", "lait", "crème", "beurre", "margarine" and "yogurt". The number of hits for each of those terms varies from 1,220 to 243,000.

[38] Ms. Waked has also filed extracts of the *Food and Drugs Regulations* on dairy products wherein there are numerous references to the word “écrémé”. This evidence demonstrates that the term “écrémé” in the context of dairy products is regulated and even obligatory if the dairy products meet certain criteria.

[39] The addition of the descriptive word “plus” to the word “écrémé” clearly describes the quality and character of the Wares, namely that the dairy products covered by the application have gone through an enhanced skim process. Therefore for an average French speaking consumer the word portion of the Mark would be clearly descriptive of the character or quality of the dairy products namely, that the cream has been removed to an optimum level. If that would not be the case for any or all of the Wares, then the Mark would be deceptively misdescriptive

[40] The Applicant submits that the Mark must be viewed as a whole, which I agree, and thus indicates that I must take into consideration the design portion of the Mark. The design portion is simply the use of a special script but it is not a dominant feature of the Mark. What will be remembered in the mind of the average bilingual Canadian or French speaking consumer is the clearly descriptive word portion of the Mark. I do not see the script used to be so particular that such consumer would identify the Mark by such script [see *Canadian Jewellers Assn. v. Worldwide Diamond Trademarks Limited* (2010), 82 C.P.R. (4th) 435 (F.C.T.D.)]. The consumer would refer to the Mark by using the descriptive word portion of the Mark. If I were to allow the registration of the Mark, it would prevent the dairy industry to use those words that are clearly descriptive of the character or quality of dairy products.

[41] The Applicant is arguing that if I were to refuse the registration of the Mark, it would create inconsistencies on the register. To support such contention the Applicant has introduced in evidence through the affidavit of David Takagawa, extracts of the register. Those extracts consist of registered trade-marks that combine a descriptive word of the character and quality of the wares or services covered by the registration with the word “plus”. Such argument was also raised in *Canadian Jewellers Assn. supra*, but the Court concluded that a trade-mark, which clearly describes the goods for which the trade-

mark is sought, is not entitled to be registered notwithstanding decisions which allowed clearly descriptive trade-marks to be registered.

[42] The application covers services. The parties have not address in any details the issue of the descriptive nature of the Mark when used in association with the Services. Clearly from the description of the Services, I can assume that the Services would be promotional and advertising activities to encourage the sale of the Applicant's Wares. Would the Mark be clearly descriptive of those services? In the absence of convincing arguments on that issue I fail to see how the Mark would clearly describe those activities. The fact that it clearly describes the Wares does not necessarily imply that it clearly describes the services of promoting the Wares.

[43] For all these reasons I maintain the fourth ground of opposition in part in so far as the Wares are concerned but dismiss such ground with respect to the Services.

The Last ground of Opposition

[44] The distinctiveness ground of opposition is based on two allegations: the Mark cannot be distinctive as it is clearly descriptive or deceptively misdescriptive of the Wares and Services; and the Mark is confusing with the registered trade-marks cited by the Opponent.

[45] With respect to the latter argument, the fact that the relevant date to consider this ground of opposition (the date of filing of the statement of opposition: see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)) is different than the relevant date to assess the registrability of the Mark under s. 12(1)(d) of the Act, does not have any effect on my analysis of the criteria listed under s. 6(5) of the Act. I would come to the same results, namely that there is no likelihood of confusion between the Mark and those cited registered trade-marks.

[46] As for the argument based on the descriptiveness of the Mark, again the difference in the relevant dates to assess this ground of opposition versus the ground of

opposition based on the registrability of the Mark under s. 12(1)(b) is not a determining factor. In any event, it has been ruled that if a trade-mark is clearly descriptive of the wares and services, it cannot serve to distinguish those wares and services from those of others [see *Canadian Council of Professional Engineers v. APA - The Engineered Wood Assn.* (2000), 7 C.P.R. (4th) 239 (F.C.T.D.)].

[47] Consequently the ground of opposition based on distinctiveness is maintained in so far as the Wares are concerned but dismissed for the Services for the same reasons detailed under the fourth ground of opposition.

Disposition

[48] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application with respect to:

dairy products namely, milk, cream, powdered milk, butter, yogurt, cheese, sour cream, ice cream, frozen yogurt, iced milk and eggnog;

and reject the opposition with respect to:

advertising and promotion of dairy products, namely, distribution of coupons and educational brochures concerning nutrition, the provision of food products for sampling, conducting contests;

pursuant to s. 38(8) of the Act [see *Produits Menagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 C.P.R. (3d) 492 (F.C.T.D.) as authority for a split decision].

Jean Carrière
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Trade-marks Opposition Board
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