



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

Citation: 2012 TMOB 155
Date of Decision: 2012-08-09

TRANSLATION

**IN THE MATTER OF AN OPPOSITION
by Mondo Foods Co. Ltd. to application
No. 1,428,639 for the trade-mark
MONDOUX & Design in the name of Les
Distributions Mondoux Inc.**

[1] On February 23, 2009, Les Distributions Mondoux Inc. (the Applicant) filed an application for the registration of the trade-mark MONDOUX & Design, reproduced below (the Mark), on the basis of use of the Mark in Canada in association with certain wares and services:



[2] The statement of wares and services of the amended application filed by the Applicant on May 16, 2012, and accepted by the Registrar on June 22, 2012, reads as follows:

Wares: (1) Confectionery products, namely candy, chocolates, chewing gum, caramels, licorice, jujubes, fruit pastes, chews, lollipops, dragees, marshmallow candies, sweet and sour gelatine candies. (Hereafter sometimes referred to as the Wares)

Services: (1) Importing confectionery products. Distributing confectionery products.
(2) Packaging confectionery products for retail. (Hereafter sometimes referred to collectively as the Services)

Claims: Used in Canada since at least as early as 1986 on wares (1) and on services (1).
Used in Canada since at least as early as 1990 on services (2).

[3] The application was advertised for opposition purposes in the November 4, 2009, edition of the *Trade-marks Journal*.

[4] On December 17, 2009, Mondo Foods Co. Ltd. (the Opponent) filed a statement of opposition against the application. The grounds of opposition, as amended by the Opponent on February 18, 2010, with leave from the Registrar on March 8, 2010, can be summarized as follows:

1. The application does not meet the requirements of s. 30(a) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), in that the Wares and Services are not defined in ordinary commercial terms.
2. The application does not meet the requirements of section 30(b) of the Act in that the Applicant had not used the Mark in association with each of the Wares and each of the Services since the dates of first use claimed in the application.
3. The application does not satisfy the requirements of s. 30(i) of the Act in that the Applicant could not have been satisfied that it was entitled to use the Mark in association with the Wares and Services given the previous use by the Opponent of the family of registered trade-marks “MONDO” described in Schedule A to this decision (hereafter referred to collectively as the MONDO Marks);
4. With regard to s. 12(1)(d) of the Act, the Mark is not registrable in that it is confusing with the MONDO Marks;
5. With regard to ss. 16(1)(a) and (c) of the Act, the Applicant is not the person entitled to the registration of the Mark in that, at the dates of first use claimed in the application, the Mark was confusing with the MONDO Marks and the Opponent’s trade-names Mondo Foods and Mondo Foods Co. Ltd. (hereafter referred to collectively as the Trade-names) previously used in Canada by the Opponent; and
6. With regard to s. (38)(2)(d) of the Act, the Mark is not distinctive of the Applicant’s Wares and Services in that it is not adapted to distinguish and does not actually distinguish those Wares and Services from the wares and services of others, in particular the wares and services of the Opponent used in association with the Opponent’s MONDO Marks and Trade-names.

[5] The Applicant filed a counter statement denying each and every one of the grounds of opposition.

[6] In support of its opposition, the Opponent filed the affidavit of Tom De Nardi, the Opponent's director of sales and marketing, sworn June 16, 2010. In support of its application, the Applicant filed the affidavit of Jean Mondoux, the president of the Applicant, sworn October 21, 2010.

[7] Only the Opponent filed a written argument. Both parties participated in an oral hearing. The grounds of opposition based on ss. 30(a) and (i) of the Act were voluntarily withdrawn by the Opponent at the hearing. With the exception of the ground of opposition based on s. 30(b) of the Act, the remaining grounds of opposition all hinge on the likelihood of confusion between the Mark and the Opponent's MONDO Marks and Trade-names.

[8] The onus is on the Applicant to show that its application meets the requirements of the Act. However, it is up to the Opponent to ensure that each of its grounds of opposition is duly argued and to meet its initial evidentiary burden by establishing the facts used to support its grounds of opposition. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that none of the grounds of opposition impedes the registration of the Mark. It is not necessary for the Registrar to be satisfied beyond any doubt that confusion is unlikely. In fact, as indicated in *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA) at page 163, "[s]hould the 'beyond doubt' standard be applied, applicants would, in most cases, face an unsurmountable burden because certainty in matters of likelihood of confusion is a rare commodity" [see also *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FC)].

[9] Applying those principles to this case, I will begin my analysis with regard to the ground of opposition based on the non-registrability of the Mark under s. 12(1)(d) of the Act.

Ground of opposition based on section 12(1)(d) of the Act

[10] The material date for the ground of opposition based on the non-registrability of a trade-mark as regards its being confusing with a registered trade-mark is the date of my decision [see

Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd (1991), 37 CPR (3d) 413 (FCA)]. I have exercised my discretion and verified that each of the Opponent's registrations listed in Schedule A are still indicated as being active in the register of trade-marks. Since this is the case, the Opponent has met its initial burden of proof. The Applicant must now show, on a balance of probabilities, that there is no likelihood of confusion between the Mark and one or more of the Opponent's registered marks.

[11] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that the use of a trade-mark or trade-name causes confusion with another trade-mark or another trade-name if the use of both trade-marks or trade-names in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks or trade-names are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[12] In determining whether trade-marks or trade-names are confusing, the Registrar must have regard to all of the surrounding circumstances, including those listed at s. 6(5) of the Act, namely (a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; (b) the length of time the trade-marks or trade-names 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 or trade-names in appearance or sound or in the ideas suggested by them. This is not an exhaustive list, and different weight may be given to the each of these factors depending on the context [see *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); and *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401, (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 92 CPR (4th) 361 (SCC)].

(a) the inherent distinctiveness of the trade-marks and the extent to which they have become known

[13] I agree with the Opponent that the Mark is less inherently distinctive than each of the Opponent's MONDO Marks.

[14] The Mark is based on the family name of the founder of the Opponent, namely, Normand Mondoux, the father of affiant Jean Mondoux. In that, I agree with the Opponent that the word “MONDOUX” as a part of the Mark is not inherently distinctive since it corresponds to a Canadian family name. The design component, namely, the picture of a carousel, somewhat increases the inherent distinctiveness of the Mark.

[15] In comparison, the word “MONDO” found in each of the Opponent’s MONDO Marks has no meaning in French or English and is therefore inherently distinctive (I will return to the idea suggested by the word “MONDO” later on, when assessing the degree of resemblance between the trade-marks). The same is true of “BEL’ MONDO”.

[16] The strength of a trade-mark can be increased by making it known through promotion and use. This leads me to review the evidence of use of the marks at issue provided by each of the parties.

[17] First, with regard to the evidence submitted by the Applicant, the affidavit of Mr. Mondoux establishes the following.

[18] Mr. Mondoux provides a brief history of the Opponent, which also does business under Les Bonbons Mondoux and the head office of which is in Laval, Quebec. As mentioned earlier, the company was founded by Mr. Mondoux’s father in 1967. Mr. Mondoux states that the Opponent was incorporated in 1977 and, in the last 30 years, has grown from a small family business to a large company with over 150 employees and selling over 3,000 different products across Canada [paragraphs 4 and 5 of his affidavit; Exhibit JM-1, an advertisement used to launch the distribution of the Applicant’s confectionery products in the Atlantic provinces, showing, among other things, a delivery truck displaying the Mark].

[19] Mr. Mondoux states that the Opponent adopted the Mark in at least as early as 1986, when it started using the Mark in Canada in association with confectionery products [paragraph 7 of his affidavit]. Mr. Mondoux indicates that, later, in 1990, the Opponent added the packaging of confectionery products in yellow, blue and red bags displaying the Mark to its activities [paragraph 7 of his affidavit; Exhibit JM-2, a set of samples of the bags in question].

[20] Mr. Mondoux states that in the “Nielson Convenience Track” analysis of the 100 best-known marks for the 52 weeks ending July 3, 2010, the Applicant ranked in fifth place in the field of confectionery, as shown in the excerpt from the analysis filed as Exhibit JM-3. It should be noted at this stage of my analysis that I am not prepared to give any weight to this excerpt. As rightly argued by the Opponent, the excerpt, as presented, constitutes hearsay evidence in that such an analysis ought to have been introduced as evidence by its author. It is impossible, moreover, to correctly estimate that parameters of this analysis. In any event, even without this analysis, I find it reasonable to conclude from all of the statements in Mr. Mondoux’s affidavit, including the Applicant’s substantial sales figures discussed below, that the Applicant is a well-established company in the field of confectionery.

[21] Mr. Mondoux states that the Applicant’s confectionery products displaying the Mark are sold in Canada in their millions and distributed through convenience stores, supermarket chains, grocery stores and specialized stores. He states that, in the last 10 years, the Opponent’s annual sales have never dropped below \$20 million and that the sale of confectionery products displaying the Mark during the same period accounted for approximately 60% of this figure. In that respect, Mr. Mondoux provided a sales report for 1998 to 2009 for confectionery products packaged in yellow bags displaying the Mark [paragraphs 9 to 11 of his affidavit].

[22] As an example of the manner in which the confectionery products of the Opponent displaying the Mark are packaged, Mr. Mondoux filed as Exhibit JM-4 samples of the reference documents used by the Opponent in the normal course of trade to sell, promote and advertise the Wares and Services sold and rendered under the Mark. I note that this sampling includes one-page photo-illustrated inserts describing several confectionery product lines offered under the Mark in bags of various colours (including the yellow, blue and red bags mentioned above), including surprise bags, individuals bags and family-size bags. Also included in this sampling are inserts showing various forms of displays for candy and other confectionery products offered in association with the Mark by the Applicant. Some of the inserts show empty displays, while others show displays filled only with the Applicant’s confectionery products displaying the Mark or confectionery products of the Applicant and of third parties, including “WONKA” and “PEZ”. I will return to these third parties when I assess the ground of opposition based on s. 30(b) of the Act.

[23] Mr. Mondoux adds on this point that, since 2008, the Opponent has been running a Web site, www.mondoux.ca, where it advertises and promotes the confectionery products it sells under the Mark. As Exhibit JM-5, he filed samples of pages from this Web site and confirms that they are a typical representation of how the Opponent's confectionery products have been advertised on this site since 2008 [paragraph 13 of his affidavit]. I note that the home page of this Web site describes the Applicant as a "family company [established] since 1967, [which] imports, repacks, distributes and manufactures candy" and "[a]lso [as] the distributor of", a statement followed by about 20 logos, including the marks "WONKA", "HERSHEY'S", "CADBURY", "NESTLÉ", "PEZ" and "ALLAN".

[24] From all of the above, including the Applicant's substantial sales figures in the last 10 years, I find it reasonable to conclude that the Mark at least enjoys a degree of recognition in Canada in the field of confectionery products. Consequently, regardless of its inherently low distinctiveness, Mark has acquired a significant degree of distinctiveness.

[25] Turning now to the Opponent's evidence, the affidavit of Mr. De Nardi establishes the following.

[26] The Opponent has been operating a food and beverage import and distribution company since 1975. Mr. De Nardi states that the products are produced by or for the Opponent and that they display either the Opponent's MONDO Marks or those of third-party suppliers such as H.G. Heinz and Kraft Foods [paragraph 3 of his affidavit].

[27] Specifically with regard to the MONDO Marks, Mr. De Nardi states that these have been used in Canada by the Opponent in association with the wares and services described in the relevant registrations since as early as the dates of first use claimed in these registrations [paragraphs 4 to 6 of his affidavit].

[28] Mr. De Nardi states that the customers using the Opponent's services are retail food stores, grocery stores, food distributors and restaurants, while the regular end consumers of the wares are Canadians who purchase the Opponent's wares in retail food stores or grocery stores [paragraphs 7 and 8 of his affidavit].

[29] Mr. De Nardi states that the Opponent's MONDO Marks appear on labels affixed to these wares and on cardboard boxes in which the wares are packed while being transported to clients [paragraphs 9 and 14 of his affidavit]. In support of these statements, Mr. De Nardi produced the following evidence:

- Exhibit 3, copies of invoices issued from 1993 to 2010 relating to both products displaying the MONDO Marks and products of third-party suppliers. In perusing these invoices, I note that two regard the sale of MONDO anise candies ("MONDO ANISE CANDIES 5KG", invoice No. 59229 dated February 24, 2004, and "CANDY – ANICE MINI 1 X 10KG MONDO", invoice No. 601162 dated April 2, 2009). The invoices postdating February 1998 also all display the mark MONDO FOODS COMPANY LTD & Design registered under TMA490,664;
- Exhibit 4, samples of labels affixed on the wares. In looking at these, I note that one is for BEL' MONDO candies (crunchy nougat). These samples also show the MONDO mark in its name and design form in association with several of the wares covered by the various relevant registrations, such as canned tomatoes, canned pineapple, vegetable oil, cheese, fruit juice and flour, and the use of the Trade-names; and
- Exhibit 5, samples of labels as affixed on cardboard boxes in which the wares displaying the MONDO Marks are packaged when being delivered to clients. In looking at these, I note that one matches the BEL' MONDO label described under Exhibit 4, two refer to "MONDO IMPORTED CANDIES" and another refers to "MONDO FOODS IMPORTED CANDIES". These labels also show use of the Trade-names.

[30] According to Mr. De Nardi, the sales of wares associated with the Opponent's MONDO Marks have exceeded \$1 million/year since 1990–1991 and \$2 million annually since 2004–2005. Approximately 95% of these sales are attributable to sales in association with the MONDO mark (5% for the BEL' MONDO mark). Specifically with respect to the annual sales of candies respectively displaying the MONDO and BEL' MONDO marks, these have ranged between \$5,000 and \$10,000 since 1989. The revenues generated by the Opponent's services ranged between \$13 and \$14 million a year between 2003 and 2010 and have exceeded \$10 million a year since 1990–1991 [paragraphs 10 to 13 of his affidavit].

[31] The Opponent promotes its wares and services by distributing leaflets and price lists [samples appended as Exhibits 6 and 7], participating in trade shows and organizing such events in various Canadian cities, running a Web site [excerpts filed as Exhibit 1] and advertising in trade publications [samples appended as Exhibits F-1 to F-4]. According to Mr. De Nardi, the Opponent has spent over \$100,000 to promote its wares and services over the last 10 years [paragraphs 15 to 19 of his affidavit].

[32] From all of the above, including the Opponent's annual sales figures in the last seven years, I find it reasonable to conclude that the Opponent is a well-established company in the field of importing and distributing food products in Canada and that the MONDO Marks used in association with such services enjoy at least a degree of recognition in Canada. In my opinion, however, this recognition is more limited when it comes to the wares sold in association with the MONDO Marks. The Opponent's annual sales figures are substantially lower for its wares than its annual sales figures for its services, particularly with regard to its confectionery products of which sales range between only \$5,000 and \$10,000. I am consequently of the view that the distinctiveness acquired by the Opponent's MONDO Marks in association with such confectionery products is substantially lower than that acquired by the Mark.

(b) the length of time the trade-marks have been in use

[33] In light of my previous comments, this factor does not weigh significantly in either party's favour. We are dealing with two companies that have been established in Canada for over 40 years: both are arguing that their respective marks have been in continuous use since the 1980s or the early 1990s, depending on the dates of first use claimed in the present application or the Opponent's registrations.

(c) the nature of the wares, services or business; and (d) the nature of the trade

[34] In considering the nature of the wares and services and the nature of the trade, I must compare the statement of the wares and services contemplated by this application with the statement of the wares and services covered by the Opponent's registrations [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[35] The nature of the parties' services overlap to some extent in that the Applicant's Services concern the importing, distributing and packaging of confectionery products, while those of the Opponent registered under TMA490,663 (MONDO FOODS COMPANY & Design) and TMA452,101 (MONDO FOODS) relate generally to importing, packaging and distributing food products and beverages. The nature of the parties' wares also overlaps to a certain degree in that the Applicant's Wares relate to confectionery products, while the wares covered by registration TMA452,101 (MONDO FOODS) also include candies. Even though the "confectionery" segment represents only a very small percentage of the Opponent's sales, as appears from my review of the affidavit of Mr. De Nardi, it cannot be ignored, particularly as the parties' confectionery products are ultimately sold in the same type of establishment, supermarket chains and grocery stores. Consequently, I find that the overall assessment of the third and fourth factors favours the Opponent.

(e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[36] As noted by the Supreme Court in *Masterpiece*, above, at paragraph 49, the factor likely to have the most importance in the confusion analysis, and which is decisive in most cases, is the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them.

[37] Moreover, as mentioned above, it is well established in the case law that likelihood of confusion is a matter of first impression and imperfect recollection. In that respect, "[w]hile the marks must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public's perception of it" [see *Pink Panther Beauty Corp v United Artists Corp* (1998), 80 CPR (3d) 247 (FCA), at paragraph 34].

[38] Therefore, while in some cases the first word will be the most important element for the purposes of a trade-mark's distinctiveness, the Supreme Court stated at paragraph 64 of *Masterpiece* that a preferable approach is to first consider whether any aspect of the trade-mark is particularly striking or unique.

[39] Applying those principles to this case, I agree with the Applicant that there are significant differences between the parties' marks and that it is easy to distinguish them.

[40] As noted earlier, the word "MONDO" found in each of the Opponent's MONDO Marks has no meaning in French or English and is therefore inherently distinctive. At the hearing, both parties agreed that the word "MONDO" means world ("*monde*" in French) in Italian, with the Applicant adding that the Opponent itself indicates on its Web site that "Mondo Foods Co. Ltd. (literally translates as World Foods) For over 30 years Winnipeg based Mondo Foods has brought the flavours of the world to retail shelves and western kitchens" [Exhibit 1 referred to above]. I agree with the Opponent, however, that apart from its Web site, there is no evidence on the record that would allow me to conclude that the average Canadian is likely to associate the word "MONDO" with the French word "*monde*". Moreover, even if I were to find that the word "MONDO", through its Italian connotation and resemblance to the world "monde" (and also through the juxtaposition of the element constituting the design of a sphere conjuring up Earth in registration No. TMA490,664), is likely to be associated with the word "monde", I agree with the Opponent that this word is not descriptive of the wares and services associated with the Opponent's MONDO Marks.

[41] As to the Mark, the Opponent submits that it includes all of the word "MONDO". The Opponent has not satisfied me. Even though the letters "M", "O", "N", "D" and "O" are the first four letters of "MONDOUX", the word "MONDO" does not as such stand out from the Mark. As noted earlier, the idea suggested by the Mark is that of the family name "MONDOUX". Alternatively, as submitted by the Opponent, the Mark can possibly be interpreted as meaning "my sweet" ("*mon doux*"). The only way of identifying the word "MONDO" in the Mark is by dissecting it in an unnatural manner. Yet it is trite law that this is not the proper approach.

[42] Furthermore, even though the carousel design is secondary in that the determining component of the Mark is the word "MONDOUX", such a design nonetheless adds to what distinguishes the Mark from each of the Opponent's MONDO Marks visually and in terms of the ideas suggested. The carousel picture evokes childhood—children generally being fond of confectionery products—while the Opponent's MONDO Marks evoke no such concept.

[43] In conclusion on this fifth factor, I find that the significant differences between the parties' trade-marks in appearance, sound and the ideas they suggest favour the Applicant.

Additional circumstances

Family of MONDO Marks

[44] The Opponent argues that the fact that it holds a family of trade-marks consisting of the word MONDO used alone or in combination with other words or elements serves as an additional circumstance supporting the Opponent's position.

[45] More particularly, the Opponent submits that, as a family of marks, its MONDO Marks deserve a wide ambit of protection since the evidence in the file does not support a conclusion that third parties use similar marks.

[46] Although I agree with the Opponent that it has shown use of a family of trade-marks comprised of the MONDO, MONDO FOODS and BEL' MONDO marks, I find such a circumstance inconclusive itself in view of the differences between the Mark and the Opponent's MONDO Marks. As argued by the Applicant at the hearing, the Mark is not a [TRANSLATION] "variation" of the MONDO mark, unlike the *MONDO FOODS* and BEL' *MONDO* marks (emphasis added). In that sense, the Mark cannot, on its face, be interpreted as being another member of the family of MONDO Marks.

Coexistence of the parties' marks

[47] The Applicant raises as an additional circumstance the absence of confusion between the parties' marks despite their having been used significantly and having coexisting in Canada for several years. As indicated in *Dion Neckwear*, above:

With respect to the lack of evidence by the opponent of actual confusion, the Registrar expressed the view that an opponent does not need to file that kind of evidence. This is true in theory, but once an applicant has filed some evidence which may point to unlikelihood of confusion, an opponent is at great risk if, relying on the burden of proof the applicant is subject to, it assumes that it does not need to file any evidence of confusion. While the relevant issue is "likelihood of confusion" and not "actual confusion", the lack of "actual confusion" is a factor which the courts have found of significance when determining the "likelihood of confusion". An adverse inference may be drawn when concurrent use on the evidence is extensive, yet no evidence of confusion has been given by the opponent. (See *Pink Panther [Beauty Corp. c. United Artists Corp.]* [1998], 80 C.P.R. (3d) 247 (C.A.F.); *Multiplicant Inc. v. Petit Bateau Valton S.A.* (1994), 55 C.P.R. (3d) 372 (F.C.T.D.); *Bally Schuhfabriken AG/Bally's Shoe Factories Ltd. v. Big Blue Jeans Ltd.* (1992), 41 C.P.R. (3d) 205 (F.C.T.D.); *MonSport Inc. v. Vêtements de Sport Bonnie (1978) Ltée* (1988), 22 C.P.R. (3d) 356 (F.C.T.D.).)

[48] The Opponent submits, on the contrary, that no negative inference based on the lack of evidence of confusion can be drawn in this case since none of the evidence indicates that the parties carried out activities in the same parts of Canada. The Opponent argues that it appears from the evidence that the Applicant solely does business in Quebec and the Atlantic provinces (Prince Edward Island, New Brunswick, Nova Scotia and Newfoundland), while the Opponent's commercial activities are centralized in the Western provinces (Alberta, British Columbia, Manitoba and Saskatchewan). I disagree.

[49] Even though it appears from the evidence appended to the affidavit of Mr. De Nardi that the Opponent's commercial activities are concentrated in Western Canada (the Opponent head office is located in Winnipeg), some of the invoices filed as Exhibit 3 also report sales in Ontario. Mr. De Nardi expressly states moreover, in paragraph 15 of his affidavit, that some of the trade shows in which the Opponent participates to promote its wares and services are sponsored by "La Boutique del Vino Wine Education and Taste of Quebec". The Opponent's commercial clients also include nationwide grocery stores, such as Loblaw's and Costco.

[50] Similarly, even though the evidence appended to Mr. Mondoux's affidavit provides a picture of commercial activities in Quebec and in the Atlantic Provinces, nothing in Mr. Mondoux's affidavit suggests that the Applicant's commercial activities are limited to these provinces alone. On the contrary, Mr. Mondoux expressly states at paragraph 5 of his affidavit that the Applicant sells its some 3,000 products [TRANSLATION] "*throughout* Canada" (emphasis added).

[51] To conclude on this surrounding circumstance, I find it reasonable to infer from all of the evidence in the record that the parties' marks have coexisted to some extent for many years in Canada. In that regard, I consider this to be an additional circumstance favouring the Applicant, even though it is not determinative as such.

Conclusion – likelihood of confusion

[52] In light of my analysis above, I am of the opinion that the Applicant has established, on a balance of probabilities, that a consumer having an imperfect recollection of the Opponent's MONDO Marks would be unlikely to conclude that the Applicant's Wares and Services are from the same source or are otherwise related to or associated with the Opponent's wares and services.

[53] Consequently, I reject the ground of opposition alleging non-registrability.

Ground of opposition based on non-distinctiveness

[54] To meet its initial evidentiary burden for non-distinctiveness, the Opponent must show that at least one of its MONDO Marks or one of its Trade-names had become sufficiently known in Canada at the date of the statement of opposition to negate the distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FC); and *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)]. Since this initial burden has been met in the present matter, the Applicant must now show, on a balance of probabilities, that there is no likelihood of confusion between its Mark and these marks or trade-names of the Opponent's at the date of the statement of opposition.

[55] My above analysis of the likelihood of confusion between the Mark and the MONDO Marks also applies to the Trade-names. As I came to the conclusion that, based on the evidence

of record, there is no likelihood of confusion under s. 12(1)(d) of the Act and since the difference in relevant dates does not affect my analysis, I dismiss the ground of opposition based on the Mark's lack of distinctiveness.

Grounds of opposition based on ss. 16(1)(a) and (c) of the Act

[56] To discharge its initial burden of proof regarding ss. 16(1)(a) and (c) of the Act, the Opponent must establish that at least one of its MONDO Marks or one of its Trade-names had been used in Canada prior to the dates of first use claimed in the present application and had not been abandoned at the date of advertisement of the Applicant's application [see s. 16(5) of the Act]. Since this initial burden has been met in the present matter, the Applicant must now show, on a balance of probabilities, that there is no likelihood of confusion between its Mark and these marks or trade-names of the Opponent's at the dates of first use claimed in the application.

[57] My above analysis of the likelihood of confusion between the Mark and the MONDO Marks also applies to the Trade-names. As I came to the conclusion that, based on the record, there is no likelihood of confusion under s. 12(1)(d) of the Act and since the difference in material dates does not affect my previous analysis, I dismiss the grounds of opposition based on ss. 16(1)(a) and (c) of the Act.

Ground of opposition based on s. 30(b) of the Act

[58] As indicated above, according to this ground of opposition, the Applicant has not used the Mark in association with each of the Wares and each of the Services since the dates of first use claimed in the application. At the hearing, the Opponent restricted this ground to the Applicant's Services, relying for this purpose on the evidence filed by the Applicant on the basis that this evidence was clearly inconsistent with the dates of first use claimed by the Applicant. Specifically, the Opponent submits that the affidavit of Mr. Mondoux does not establish use of the Mark in association with such Services.

[59] To the extent that the relevant facts pertaining to a ground of opposition based upon s. 30(b) of the Act are more readily available to the Applicant, the evidentiary burden on the Opponent with respect to such a ground of opposition is lower [see *Tune Masters v Mr P's*

Mastertune Ignition Services Ltd (1986), 10 CPR (3d) 84 (TMOB)]. Also, the Opponent may rely upon the Applicant's evidence as long as such evidence is clearly inconsistent with the Applicant's claim [see *York Barbell Holdings Ltd v ICON Health & Fitness, Inc* (2001), 13 CPR (4th) 156 (TMOB)]. In this regard, s. 30(b) of the Act requires that there be continuous use of the trade-mark applied for since the date claimed [see *Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD)].

[60] In the circumstances, I agree with the Opponent that the Applicant's evidence is clearly inconsistent with the portion of the Services described as "Importing confectionery products" and "Packaging confectionery products for retail". However, it is not clearly inconsistent with the portion of the Services described as "Distributing confectionery products", for the following reasons.

[61] As my review, above, of Mr. Mondoux's affidavit shows, on its Web site, the Applicant describes itself as the distributor of about 20 products bearing marks including "WONKA", "HERSHEY'S", "CADBURY", "NESTLÉ", "PEZ" and "ALLAN" [see Exhibit JM-5]. Even though the Web site excerpts filed as Exhibit JM-5 are dated October 18, 2010, Mr. Mondoux specifically states at paragraph 13 of his affidavit that the Applicant ran a similar Web site between 2004 and 2008. The distribution of these products is also supported to some extent by Exhibit JM-4, which shows some displays filled with both the Applicant's confectionery products and products of some of these third parties, including "WONKA" and "PEZ". I therefore find that the Opponent has not met its initial burden regarding the portion of the Services described as "Distributing confectionery products" and consequently dismiss the ground of opposition based on s. 30(b) with regard to these Services.

[62] However, the Opponent has satisfied its initial burden with respect to the portion of the Services described as "Importing confectionery products" and "Packaging confectionery products for retail". The evidence on the record regarding these services indeed leads me to conclude that the Applicant does not offer these services for the benefit of third parties. Instead, I agree with the Opponent's argument that the purpose of the importing and packaging activities carried out by the Applicant is simply to sell the Applicant's products under the Mark, as illustrated by the samples of yellow, blue and red bags filed as Exhibit JM-2. In that sense, these

services offer no benefit to the public. Consequently, I conclude that the Applicant has failed to discharge its legal onus with regard to these services, and I allow the ground of opposition based on s. 30(b) in their regard.

Disposition


[63] In view of the foregoing and pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application with respect to the services described as “Importing confectionery products” and “Packaging confectionery products for retail”, and I reject the opposition with regard to the Wares and the portion of the Services described as “Distributing confectionery products” pursuant to s. 38(8) of the Act [See *Produits Ménagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 482 (FCTD) as authority for a split decision].

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation

Johanna Kratz, Translator

Schedule A

Trade-mark	No. and Date of Reg.	Used since at least as early as	Wares and services
	490,664 Mar. 2, 1998	1991	<i>Flour, wine grapes and canola oil sold at wholesale; importing, packaging and distributing foods and beverages</i>
MONDO FOODS	452,101 Dec. 22, 1995	(1) 1989 (2) 1981	(1) <i>fruits juices, candies</i> (2) <i>importing, packaging and distributing foods and beverages</i>
BEL' MONDO	462,081 Aug. 30, 1996	(1) Aug. 1987 (2) Jul. 10, 1996	(1) <i>food products, canned and/or otherwise, namely, vegetables, namely, tomatoes and fruits, namely pineapples; olive oil</i> (2) <i>anchovies and vegetable oils</i>
MONDO	466,497 Nov. 27 1996	(1) Aug. 1981 (2) Mar. 1989 (3) Jul. 1991 (4) Dec. 1991 (5) August 9, 1996	(1) <i>food products, canned and/or otherwise, namely, fruits and vegetables, namely, tomatoes, tomato puree/sauce, tomato paste and olives</i> (2) <i>vegetable oils, dried pasta and cheeses</i> (3) <i>flour</i> (4) <i>alcohol-based food flavourings/extracts</i> (5) <i>olive oil, canned fruits</i>
BEL' MONDO	318,653 Sep. 19, 1986	Jul. 9, 1986	<i>Canned goods, namely tomatoes, tomato sauce, tomato paste, pineapple, olives, beans, and artichoke paste; vegetable oil and olive oil; fruit nectars and juices; and dried pastas</i>
MONDO	317,799 Aug. 29, 1986	(1) Aug. 1981 (2) Jun. 23, 1986	(1) <i>canned goods, namely tomatoes, tomato sauce, tomato paste and olives</i> (2) <i>canned beans, canned pineapple, canned artichoke paste, vegetable oil, olive oil, fruit nectars and juices, and dried pasta</i>