

TRADUCTION/TRANSLATION

**IN THE MATTER OF AN OPPOSITION BY
Frantz Vancol and Tania Vancol to application
No. 1209627 for the trade-mark LIBON owned by
Technobev S.E.C**

I Proceedings

- [1] On March 8, 2004, Breuvages Kiri S.E.C. (“Kiri”) filed an application to register the trade-mark LIBON (the “Mark”), based on use since July 2000 in association with the following wares: non-alcoholic soft drinks, carbonated and non-carbonated natural spring water, non-alcoholic, carbonated and non-carbonated juice (the “Wares”). This application was advertised for opposition purposes in the *Trade-marks Journal* on January 5, 2005.
- [2] On July 18, 2005, Frantz Vancol and Tania Vancol (“the Opponent”) filed a statement of opposition, which the Registrar forwarded to Kiri on November 10, 2005.
- [3] For reasons of brevity, it is sufficient to summarize only the substantive and procedural elements that are relevant to the case. A number of events occurred along the way that will have no impact on the outcome of this decision.
- [4] By excluding the arguments and evidence in the Opponent’s statement of opposition, the grounds of opposition may be summarized as follows:
- i) The term “libon” or “li bon” is a Haitian Creole expression meaning “it is good” or “it is delicious” that is clearly descriptive and laudatory of the Wares; therefore, the Mark is not registrable under sections 12(1)(b) and (c) of the *Trade-Marks Act*, R.S.C. 1985, c. T-13 (the “Act”);
 - ii) The Mark is not registrable under section 12(1)(d) of the Act because it is confusing with the certificates of registration TMA369784 for the trade-mark QUISQUEYA and Design, TMA455953 for the trade-mark QUISQUEYA BOYO and Design, TMA464259 for the trade-mark QUISQUEYA BOYO and Design, TMA565375 for the trade-mark BOYO

KIS-K-YA and Design, TMA565392 for the trade-mark BOYO KIS-K-YA and Design, and TMA565385 for the trade-mark BOYO DIVA and Design. All the above-mentioned certificates of registration cover soft drinks.

[5] I note that the statement of opposition refers to all of the above-mentioned sections of the Act. The Opponent alleges previous use of the trade-marks stated above. However, the Opponent does not argue that the Applicant is not entitled to register the Mark on the basis of section 16(3)(a) of the Act and does not use any words in the statement of opposition that might resemble this ground of opposition. However, to dispel any doubts on this subject, I will analyze this ground of opposition last.

[6] On March 10, 2006, Kiri filed a counter statement essentially denying the grounds of opposition raised by the Opponent.

[7] The Opponent filed in evidence the affidavit of Frantz Vancol, whereas Kiri filed those of Roger Martel and Richard Viger.

[8] Both parties filed written arguments, and neither requested a hearing.

[9] It seems that, while this opposition was pending, Kiri changed its business name to Technobev S.E.C (“Technobev”). I will use “Applicant” to refer to Kiri or Technobev, as the case may be.

II General principles

[10] In proceedings to oppose the registration of a trade-mark, the Opponent must present enough evidence concerning the grounds of opposition raised to show that there are facts supporting those grounds. If the Opponent meets this requirement, the Applicant must then satisfy the Registrar, on the balance of probabilities, that the grounds of opposition should not prevent its trade-mark from being registered [see *Sunshine Biscuits Inc. v. Corporate Foods Ltd.* (1982), 61 C.P.R. (2d) 53, *Joseph Seagram & Sons Ltd. v. Seagram Real Estate*

Ltd. (1984), 3 C.P.R. (3d) 325 and *John Labatt Ltd. v. Molson Companies Limited* (1990), 30 C.P.R. (3d) 293].

III Relevant dates

[11] The ground of opposition based on section 12(1)(d) of the Act must be analyzed as of the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A.)], whereas the ground of opposition based on section 12(1)(b) of the Act is analyzed as of the filing date of the application for registration [see *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]. Lastly, regarding the ground of opposition based on section 12(1)(c) of the Act, the Act is silent on the subject. Consequently, I will analyze this ground as of the date of my decision [see *Park Avenue, op. cit.*].

IV Preliminary remarks

[12] Mr. Vancol is one of the parties in this opposition proceeding. At paragraph 24 of his affidavit, he states that he has [TRANSLATION] “. . . attached to this affidavit all of the relevant documents that form an integral part thereof as if set out in full, to add to [his] evidence”. None of these documents were certified by the commissioner for taking affidavits who swore Mr. Vancol at the signing of his affidavit, contrary to the provisions of Rule 80 of the *Federal Courts Rules*. Moreover, the practice notice for opposition proceedings dated October 1, 2007, states that, in general, the rules of evidence that are applicable in the Federal Court are applicable in opposition proceedings.

[13] I am well aware that, in some cases, the Registrar has accepted evidence that violated certain technical rules. However, there are cases where, as here, the absence of a jurat on the documents was fatal for the party that had filed that inadequate evidence [see *Salomon S.A. v. Tricots Exclusive*, 2000 CarswellNat 3980]. In this case, not only is there no jurat on any of the documents attached to Mr. Vancol’s affidavit, but there is also no alphabetic or numeric

identification, making it nearly impossible to match the attached documents to the allegations in the affidavit. My reasons will clearly show that the refusal to enter into evidence the documents attached to Mr. Vancol's affidavit will not be determinative of the outcome of this opposition.

[14] Thus, since the only grounds of opposition in the statement of opposition that are valid are based on sections 12(1)(b), (c) and (d) of the Act, any evidence unrelated to one of these grounds of opposition becomes irrelevant. The rejection of the certificates of registration for the trade-marks cited by the Opponent and attached to Mr. Vancol's affidavit will not be fatal for the Opponent, since the Registrar has the discretion to consult the register to verify the Opponent's allegations on this subject, which I intend to do. As for the ground of opposition based on section 12(1)(b), I may also exercise discretion and consult French and English dictionaries. Lastly, I can dispose of the ground under section 12(1)(c) on the basis of Mr. Vancol's bald allegations in his affidavit.

[15] I noted Mr. Vancol's allegations regarding the parties' past business relationship. The legal framework of an opposition proceeding is not the appropriate forum for addressing the possibility that the Applicant's use of trade-marks, other than the Mark (which is a word mark and not a design mark), amounts to unfair competition or infringement of the trade-marks filed by the Opponent.

[16] I would also like to point out that, in trade-mark cases, the owner of a registered trade-mark is granted a monopoly on the trade-mark in association with the wares and/or services stated in the certificate of registration. There is no monopoly on an idea or concept that might be associated with this trade-mark. Therefore, any allegation that the Applicant is infringing an idea or concept "belonging" to the Opponent is irrelevant.

V Relevant evidence

[17] Mr. Martel worked for Kiri between 1996 and 2003 and was its president from 1998 to 2003. He alleges that the Applicant has used the Mark in association with soft drinks since at least as early as July 2000. He also claims to be familiar with the soft drink distribution market. He states that, between 1999 and 2003, he never knew of or saw any of the Opponent's products with the trade-marks QUISQUEYA and Design, QUISQUEYA BOYO and Design, BOYO DIVA and Design and BOYO KIS-K-YA and Design being sold in any supermarket chains or independent grocery stores. In his affidavit, Mr. Vancol also admits in part to this fact, since he states that the Opponent's products were distributed up until 2002 [see paragraph 21 of his affidavit].

[18] Mr. Viger has been the president and general manager of Kiri since December 2003. He describes the Applicant's activities as follows: bottling, distribution and sale of non-alcoholic beverages, mineral water and demineralized water. He also alleges Kiri's use of the Mark and filed labels bearing the Mark and invoices dating back to August 2, 2000. He alleges \$600,000 in sales since use of the Mark in association with the Wares, representing the sale of more than 675,000 bottles. He claims that the Applicant spends approximately \$10,000 per year on advertising and marketing of the Wares. He also states that he has not seen any products with the Opponent's above-mentioned trade-marks since December 2003.

VI Ground of opposition based on section 12(1)(b)

[19] Section 12(1)(b) of the Act states that a trade-mark, whether depicted, written or sounded, is not registrable if it is either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the Wares or of the conditions of or the persons employed in their production or of their place of origin.

[20] The Opponent claims that the Mark or LI BON means "it is good" in Creole. Even if it does, the criteria for the application of section 12(1)(b) of the Act have not been met.

Parliament intended to exclude the right to a monopoly over words in the two official languages that could describe one or more of the characteristics of the wares or services listed in an application for registration. Since this is a Creole word, this ground of opposition is dismissed.

VII Ground of opposition based on subsection 12(1)(c) of the Act

[21] Section 12(1)(c) prohibits registration of a trade-mark that is the name in any language of the wares. However, according to Mr. Vancol’s allegations, the Mark is not the name of the Wares in Creole but rather describes one of its qualities. Under the circumstances, I must dismiss this second ground of opposition.

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

[22] The trade-marks the Opponent refers to are the following:



certificate of registration TMA369784 in association with soft drinks (“QUISQUEYA and Design”);



certificate of registration TMA455953 in association with soft drinks (“QUISQUEYA BOYO and Design”);



certificate of registration TMA464259 in association with soft drinks (“QUISQUEYA BOYO and Design”);



certificate of registration TMA565375 in association with soft drinks (“BOYO KIS-K-YA and Design”);



certificate of registration TMA565392 in association with soft drinks (“BOYO KIS-K-YA and Design”);



certificate of registration TMA565385 in association with soft drinks (“BOYO DIVA and Design”).

[23] I checked the state of the register, and only the mark QUISQUEYA and Design was expunged from the register on February 2, 2006, because the registered owner failed to pay the fee to renew registration of this trade-mark. All the other trade-marks are still listed in the register. I consider that the Opponent has therefore discharged the initial burden of proof.

[24] The Applicant must now prove on a balance of probabilities that there is no likelihood of confusion between the Mark and the registered trade-marks cited by the Opponent. For an analysis of the tests set out in section 6(5) of the Act that must be considered when determining whether there is a likelihood of confusion between the Mark and one of the above-mentioned trade-marks, I refer to the decision of the Supreme Court of Canada in *Mattel, Inc. v. 3894207 Canada Inc.*, (2006) 49 C.P.R. (4th) 321.

[25] In this case, the only relevant connection between the Mark and those cited by the Opponent is the character of the parties’ wares. They are identical. However, the Mark is completely different, both phonetically and visually, from the trade-marks illustrated above.

[26] The Opponent claims that the Mark is a Creole expression, just like the marks listed above. This is not a relevant factor. These registrations do not grant their owner a monopoly over all Creole expressions in association with the Wares.

[27] The Opponent alleges that the labels used by the Applicant are confusing with the trade-marks illustrated above. Suffice it to say that it is the Mark as described in this application for registration that must be compared with the marks listed in the statement of opposition. If the Opponent believes that the Applicant is engaging in unfair competition by using colours or graphic designs on its labels that are similar to the Opponent's registered trade-marks, the opposition proceeding against the registration of the Mark is not the appropriate forum for addressing this issue.

[28] On the basis of all the evidence and an analysis of the relevant factors, I find that the Applicant has discharged its burden of proving, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the trade-marks QUISQUEYA BOYO and Design, QUISQUEYA BOYO and Design, BOYO KIS-K-YA and Design, BOYO KIS-K-YA and Design and BOYO DIVA and Design. Indeed, the word and visual elements of these trade-marks are completely different from the Mark. I therefore dismiss this last ground of opposition as well.

IX Ground of opposition based on section 16(3)(a) of the Act

[29] Even if this ground of opposition had been pleaded, it would have been dismissed outright, since Mr. Vancol himself admitted that the above-mentioned trade-marks have not been used since 2002. Moreover, section 16(5) of the Act states that the right to register a trade-mark is not affected by the previous use of a confusing trade-mark, if the confusing trade-mark was abandoned at the date of advertisement of the application for registration in the *Trade-marks Journal* (January 5, 2005).

[30] However, Mr. Vancol alleges in his affidavit that he intends to re-introduce his products and the marks to the market very soon and that there is one last technicality to be resolved before distribution can begin. In *Labatt Brewing Co. v. Formoa Spring Brewery Ltd.* (1992), 42 C.P.R. (3d) 481, the Federal Court of Appeal ruled that the concept of the abandonment of the opponent's marks must be analyzed as of the date of advertisement of the current

application for registration and not some subsequent date. There is no evidence in the record that the Opponent did not intend to abandon its trade-marks in January 2005. Mr. Vancol's affidavit is dated November 28, 2006, nearly two years after the relevant date.

[31] In any event, even if the Opponent had demonstrated an intention not to abandon the trade-marks on January 5, 2005, the issue would be the same as the one stated under the ground of opposition based on section 12(1)(d) of the Act, that is, the likelihood of confusion between the Mark and the trade-marks cited by the Opponent. I would come to the same conclusion: there is no likelihood of confusion.

[32] Therefore, I would also dismiss this ground of opposition.

IX Conclusion

[33] Having been delegated authority by the Registrar of Trade-Marks by virtue of s. 63(3) of the Act, I reject the opposition to the application to register the Mark, pursuant to s. 38(8) of the Act.

DATED AT BOUCHERVILLE, QUEBEC, THIS 23RD DAY OF JULY 2009.

Jean Carrière
Member, Trade-marks Opposition Board

Certified true translation
Tu-Quynh Trinh