

TRADUCTION/TRANSLATION

IN THE MATTER OF AN OPPOSITION by Literie Primo Inc./Primo Bedding Company Inc. to application No. 1,024,632 filed by Albums DF Ltée/DF Albums Ltd. for the registration of the trade-mark PRIMO

Albums DF Ltée / DF Albums Ltd. ("the Applicant") filed an application for registration of the trade-mark PRIMO (the "Mark") on August 4, 1999 on the basis of proposed use in Canada in association with photograph albums.

The application was advertised for opposition purposes in the *Trade-marks Journal* of November 8, 2000. Literie Primo Inc./Primo Bedding Company Inc. (the Opponent) filed a statement of opposition on September 29, 2000.

The first two grounds of opposition are essentially the same, namely that the application for registration does not meet the requirements of section 30 of the *Trade-marks Act* (the "Act") because, as of the date of the application, the Applicant knew or should have known that it was not entitled to registration of the Mark because it caused confusion with the trade-names of the Opponent as well as with the family of PRIMO trade-marks registered by the Opponent, which are specifically identified in the statement of opposition as being the following marks: PRIMO (Registration No. 411,602), PRIMO BEDDING (registration No. 400,641), PRIMO INTERNATIONAL (Registration No. 403,312), PRIMO INTERNATIONAL (Registration No. 502,142), CLUB PRIMO PLUS (Registration No. 442,453), PRIMOTION (Registration No. 468,510) and PRIMO LEATHER (Registration No. 481,118).

The third ground of opposition, in support of which the Opponent relied on paragraph 38(2)(a) of the Act, is that the Mark is not a trade-mark within the meaning of section 2 because it cannot distinguish and is not adapted to distinguish the wares of the Applicant from the wares and services of the Opponent. It is my opinion that the third ground of opposition is correctly based on paragraph 38(2)(d) but has no legal basis under paragraph 38(2)(a). Consequently, I reject this ground of opposition as argued under paragraph 38(2)(a).

The fourth ground of opposition is that the Mark is not registrable in accordance with the provisions of paragraph 12(1)(d) of the Act because it is confusing with the family of PRIMO trade-marks registered by the Opponent, as identified earlier.

The Opponent relies on paragraphs 38(2)(b) and 38(2)(c) respectively as the basis for its fifth and its sixth ground of opposition, namely that the Applicant is not the person entitled to registration of the Mark in accordance with the provisions of section 16 of the Act, because it is confusing with the Opponent's trade-names and family of PRIMO registered trade-marks, all used and made known prior to the month of August 1999. The ground of opposition alleging that the Applicant is not the person entitled to registration is correctly based on paragraph 38(2)(c) but there is no legal basis for this under paragraph 38(2)(b). Consequently, I reject the fifth ground of opposition as argued.

The last ground of opposition is that the Mark is not distinctive because it does not distinguish and is not adapted to distinguish the Applicant's wares from those associated with the Opponent's registered trade-marks, as identified earlier.

On January 9, 2001, the Applicant filed a counter statement denying each and every one of the allegations contained in the statement of opposition.

The Opponent's evidence under section 42 consisted of the affidavit of George Itzkovitz dated February 5, 2001. The Applicant's evidence under section 43 consisted of an undated affidavit of Jean-Marc Therrien, an affidavit of Frédéric Billon dated March 27, 2001, an affidavit of Benoit Lemay dated March 27, 2001 and an affidavit of Chantal Messen dated March 28, 2001. On September 10, 2002, the Registrar granted the Applicant leave to file additional evidence consisting of a second affidavit of Jean-Marc Therrien dated October 10, 2001 to replace his first affidavit. There was no cross-examination.

Only the Applicant filed a written argument. No hearing was held.

Opponent's evidence

George Itzkovitz identified himself as the manager and director of the Opponent, which he described as a business that had, since 1967, been active in manufacturing, selling and distributing furnishings and effects for homes, industry and offices, including beds, chairs, tables, sofas, recliners, sofa-beds, desks, cupboards, office chairs, mattresses, box springs, mirrors, lamps, chests, hutches, stools, sideboards, work desks and chests of drawers. Mr. Itzkovitz stated that the Opponent sold its wares across Canada to its customers, which included retail businesses and distributors.

Mr. Itzkovitz attached to his affidavit copies of registrations of eight (8) trade-marks (Exhibits 1 to 8) which he identified as constituting the Opponent's family of PRIMO trade-marks, namely:

<u>Trade-mark</u>	<u>Reg. No.</u>	<u>Wares/Services</u>
PRIMO	411,602	"Furniture, namely, beds, mattresses, chairs, tables, sofas, recliners, sofa-beds, desks, cupboards, box springs, office chairs, office desks, steno chairs and bicycles"
PRIMO	503,312	"Business of manufacturing, importing, selling and distributing of furniture, namely beds, bunk beds, cribs, mattresses, bed frames, box springs, sofas, sofa beds, futons, chairs, ottomans, stools, tables, end tables, coffee tables, loveseats, buffets, hutches, lamps, mirrors, dressers, bureaus, chests, dinettes and armoires"
PRIMO INTERNATIONAL	403,312	"Furniture namely: beds, mattresses, chairs, tables, sofas, recliners, sofa-beds, desks, cupboards, box springs, office chairs, office desks, steno chairs and bicycles"
PRIMO INTERNATIONAL	502,142	"Business of manufacturing, importing, selling and distributing of furniture, namely beds, bunk beds, cribs, mattresses, bed frames, box springs, sofas, sofa beds, futons, chairs, ottomans, stools, tables, end tables, coffee tables, loveseats, buffets, hutches, lamps, mirrors, dressers, bureaus, chests, dinettes and armoires"
PRIMO BEDDING	400,641	" (1) Beds, mattresses, box springs. (2) Chairs, tables, sofas, recliners, sofa beds, desks, cupboards, office chairs, office desks, steno chairs. (3) Bicycles"
PRIMO BEDDING	502,141	"Business of manufacturing, importing, selling and distributing of furniture, namely beds, bunk beds, cribs, mattresses, bed frames, box springs, sofas, sofa beds, futons, chairs, ottomans, stools, tables, end tables, coffee tables, loveseats, buffets, hutches, lamps, mirrors, dressers, bureaus, chests, dinettes and armoires"
PRIMO LEATHER	481,118	"Leather furniture, namely leather chairs, leather upholstered chairs, leather club-chairs, leather recliners, leather sofas, leather chesterfields, leather couches, leather settees, leather love-seats, leather stools, leather futons, leather hassocks, leather foot-rests and tables and desks with leather tops"
CLUB PRIMO PLUS	442,453	"Service of offering gifts and incentives to customers who buy furniture and furnishings"

The following dates are identified in the affidavit as the dates on which the trade-marks in question were first used:

PRIMO - since October 1967 (Reg. No. 411,602) and since at least 1967 (Reg. No. 503,312);
PRIMO INTERNATIONAL – since at least January 16, 1991 (Reg. No. 403,312) and since at least
January 1991 (Reg. No. 502,142);
PRIMO BEDDING since at least January 1967 (Reg. No. 400,641 and Reg. No. 502,141);
PRIMO LEATHER since at least 1996 (Reg. No. 481,118); and
CLUB PRIMO PLUS since at least July 1992 (Reg. No. 442,453).

I note that Mr. Itzkovitz did not refer to the mark PRIMOTION (Reg. No. 468,510) alleged in the statement of opposition but referred to the trade-marks PRIMO of Registration No. 503,312 and PRIMO BEDDING of Registration No. 502,141, these last two not having been alleged in the statement of opposition. In all the grounds of opposition in support of which the Opponent relied on trade-marks, it specifically refers to the registered trade-marks identified in the statement of opposition. Consequently, I shall not consider the marks PRIMO of Registration No. 503,312 and PRIMO BEDDING of Registration No. 501,141 as part of the opposition [*Imperial Developments Ltd. v. Imperial Oil Limited* (1984), 79 C.P.R. (2d) 12 (F.C.T.D.)].

I have checked the Trade-marks Register to determine the status of the registrations referred to in the statement of opposition and have confirmed that they are all in force in the Opponent's name [*Quaker Oats Co. of Canada v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)].

Mr. Itzkovitz also alleged that the Opponent had used the trade-name PRIMO for several decades and that the customers and distributors of the Opponent referred to it under this trade-name.

There was no information in the affidavit concerning the Opponent's turnover or concerning the volume or value of sales of wares associated with any of the marks alleged at any time whatsoever. There was also no information concerning the Opponent's promotional activities relating to either the type of advertising or the amounts spent.

Mr. Itzkovitz filed catalogues "*showing some of the wares of the Opponent that it has been making, selling and distributing in Canada, prior to and since 1998, in association with the Opponent's PRIMO trade marks and trade name*" (paragraph 10, Exhibits 9 to 12), as well as a sample of invoices "*reflecting sales of the Opponent's wares in Canada in association with one or more of its PRIMO trade-marks*" (paragraph 11, Exhibit 13). Before commenting specifically on these allegations and the related exhibits, I shall note at once that the evidence in the record does not allow me to find that the Opponent owned a family of PRIMO trade-marks. In this regard, I note

the comments of Cattanach J. in *McDonald's Corporation et al v. Yogi Yogurt Ltd. et al* (1982), 66 C.P.R. (2d) 101 at page 114:

While the presumption of the existence of a series of trade marks can arise at the time of an application for the registration of a trade mark with the consequence indicated the same presumption does not arise in opposition proceedings. Before any similar inference as would arise from the presumption can arise in the opposition proceedings based upon the use of other marks any such use must be established by evidence.

The question therefore is whether the appellants have discharged the onus cast upon them of establishing the existence of a series of marks owned by the corporate appellant with which the application by the corporate respondent for the registration of the trade mark MCYOGURT may conflict. That is to be discharged by the establishment of the use of the trade marks sufficient to constitute a family.

On the subject of the catalogues, I note, on the one hand, that Mr. Itzkovitz's allegation concerning the length of time they were in use is ambiguous, to say the least. On the other hand, there is no information concerning the distribution of these catalogues. A logo consisting of the word PRIMO appears only once in the top left-hand corner of the cover page of the first catalogue in Exhibit 9. The mere mention of a trade-mark on the cover page of a catalogue does not constitute use of the trade-mark in association with wares [*Bereskin & Parr v. Hamac International Ltd.* (1999), 3 C.P.R. (4th) 269 (T.M.O.B.)]. I reproduce below the other logo shown in the catalogues and consisting of the words PRIMO INTERNATIONAL:

While we can acknowledge an emphasis on the word PRIMO as compared with the word INTERNATIONAL, because of its position, the word INTERNATIONAL is still linked to the word PRIMO. Consequently, and as argued by the Applicant, it is my opinion that the only mark shown in the catalogues is the mark PRIMO INTERNATIONAL. The logo illustrated above appears practically on the upper part of all the pages of the catalogues. Numeric or alphanumeric codes accompanied by descriptions appear beside or under the products illustrated. Only in exceptional cases do we find a model name instead of a numeric or alphanumeric code. In some catalogues, data sheets are reproduced on the backs of the pages. The name Primo International followed by an address and telephone and fax numbers is found at the bottom of several pages in the catalogues (Exhibit 9).

Although the use of a trade-mark in catalogues may constitute use in association with services, such use in itself does not constitute use in association with wares. However, the inclusion of a trade-mark in a catalogue may be considered to be use in association with wares if the circumstances in a case create an association between the trade-mark and the wares when ownership is transferred. In this connection, I note the comments of P.C. Cooke in *Timothy's Coffees of the World Inc. v. Starbucks Corp* (1997), 79 C.P.R. (3d) 147 (T.M.O.B.) at page 151:

*It has been established by the jurisprudence that merely advertising a trade-mark in publications which circulate in Canada does not by itself constitute use of the mark in Canada in association with wares, within the meaning of the Act. However, the opponent has referred to case law which supports the position that the appearance of the mark in catalogues may be sufficient to show use in Canada in association with wares (see the Senior Hearing Officer's decisions in *Bereskin & Parr v. Kimberly-Clark of Canada Ltd.* (1995), 64 C.P.R. (3d) 121; and *Globe-Trotter Suit Case Co. v. Bagages Holiday Inc./Holiday Luggage Inc.* (1992), 44 C.P.R. (3d) 158). In my opinion, mail order catalogues and similar order forms which show a trade-mark may be considered use of that mark when used in combination with other materials that show the trade-mark to the consumer at the time the wares are transferred, such as invoices. In this way, the mark is brought to the attention of the purchaser at the time the order is made, and at the time that the wares are received, satisfying the criterion in Section 4(1).*

With respect to the invoices and despite the accuracy of the Applicant's remark that in many cases the length of time was shortened, it is possible to see from some of the invoices that they were issued in the years from 1995 to 2000 for wares invoiced or delivered to businesses located in the provinces of Nova Scotia, Quebec, Newfoundland, Saskatchewan, Ontario, Alberta, British Columbia, Manitoba and New Brunswick. The invoices contain descriptions of the products, all preceded by codes. No description is followed by a reference to a trade-mark. The term PRIMO appears in stylized form as a watermark on the invoices for 1995. The logo PRIMO INTERNATIONAL, which is identical to that included in the catalogues, appears as a watermark from 1996 on. I also note that PRIMO INTERNATIONAL, in the form of words or a logo, appears above an address in the top left-hand corner of the invoices issued between 1995 and 1998. The logo PRIMO INTERNATIONAL appears above the name Primo International followed by an address in the top left-hand corner of the invoices issued in 1999 and 2000. I note the comments of D. Savard in the decision in *Goudreau Gage Dubuc & Martineau Walker v. Niagara Mist Marketing, Ltd.* (1997), 78 C.P.R. (3d) 255 (T.M.O.B.) at pages 259-260:

I note that trade-marks are not identified in the body of the invoices beside each of the products, but the words NIAGARA MIST appear at the top of the invoices, on the left hand side and on the right hand side. Although I am of the view that the words NIAGARA MIST as they appear on the left hand side followed by a street address, would probably be perceived as identifying the originator for the wares, I am not

convinced that the words NIAGARA MIST appearing on the right hand side would not be perceived as a trade-mark distinguishing the registrant's wares. Bearing in mind that none of the particular products listed in the invoices have been identified under a particular trade-mark, and given that Mr. Prentice has clearly described the registrant company as the manufacturer of the products, I am prepared to accept that the use of the trade-mark in such manner satisfies the requirements of Section 4(1) of the Act in that the invoices would provide notice of the association to the person to whom the property or possession is being transferred.

Mr. Itzkowitz did not indicate whether the invoices accompanied the wares when ownership was transferred. However, in most cases, the delivery address shown on the invoices is the same as the invoice address. Furthermore, in each case, the delivery date indicated on the invoice is the same as the invoice date. I note the comments of J.W. Bradbury in *Thomas Adams & Assoc. v. Visx, Inc.* (2001), 13 C.P.R. (4th) 380 (T.M.O.B.) at page 382:

The affiant has not stated that the invoices accompanied the wares and I am aware of the recent decision of the Federal Court, Trial Division in Riches, McKenzie & Herbert v. Pepper King Ltd. (T-1431-99, September 28, 2000) [now reported 8 C.P.R. (4t) 4718 C.P.R.] that held that the Registrar cannot assume that invoices accompany wares in the absence of evidence to that effect. I will however accept that these invoices did accompany the wares given that they indicate a ship date that is identical to the invoice date and include customs information.

Because of the circumstances of this case, I am prepared to accept that the evidence in the record shows an association between the trade-mark PRIMO INTERNATIONAL and the wares when ownership was transferred. Despite the reasonableness of the Applicant's argument that the catalogues and invoices do not illustrate all the wares listed in Mr. Itzkowitz's affidavit, especially mirrors and lamps, the fact is that the catalogues and invoices identify wares that correspond to furnishings and furniture.

Given what has been said above, I find that the mark PRIMO INTERNATIONAL was used in association with the wares identified in Registration No. 403,312, excluding bicycles, as well as in association with the services identified in Registration No. 502,412 at the very least since 1996. However, it is my opinion that the evidence does not show that the trade-name Primo was used or that the Opponent is known under this name. The Opponent's evidence establishes, at the very most, use of the trade-name Primo International.

I do not attach any significance to Mr. Itzkowitz's allegations that the Applicant had no right to register the Mark. Finally, his allegation that several of the Opponent's clients sell wares likely to be used in places where the Applicant's wares are likely to be used is not relevant in light of the evidence in the record.

Applicant's evidence

I shall begin my analysis of the evidence with the second affidavit of Jean-Marc Therrien, the Applicant's Vice President of Business Development, whose duties included managing the Applicant's trade-marks.

Mr. Therrien described the Applicant as a leader in the photograph-album industry serving the retail market, specialist photography stores and the professional sector. The range of its products includes photograph albums, professional wedding albums, replacement sheets, strips for negatives, slide holders, professional albums, document holders and ring binders.

Mr. Therrien explained that the Applicant produced professional-style photograph albums under the name DF ALBUM PRO, which was divided into two types of products, namely mid-range photograph albums associated with the Mark and high-quality photograph albums associated with another trade-mark of the Applicant. According to Mr. Therrien, the Applicant began using the Mark following the filing of the application for registration. However, he did not indicate the date it was first used.

Mr. Therrien described the types of stores in which the photograph albums associated with the Mark were sold as being camera stores, gift stores and specialist photography stores. He identified specific stores in which consumers could obtain the wares associated with the Mark, albeit without referring to the Canadian provinces where these stores were located. Mr. Therrien did not provide any information concerning the volume or value of sales of the wares associated with the Mark or relating to the Applicant's promotional activities. However, he attached a catalogue (Exhibit JMT-1) to show that the Mark was associated with photograph albums and passe-partouts for photographs. I observe that the Mark appears on the cover page and in the text of the catalogue. For all practical purposes, I note that Mr. Therrien explained in his affidavit that the assets of Desmarais & Frères Ltée, a company that had worked in the field of producing photograph albums since the 1950s, were acquired by the Applicant in 1997. I assume that this explanation by Mr. Therrien was the result of the fact that "*La collection Primo de Albums DF Ltée est une tradition depuis 1951*" [Albums DF Ltée's Primo collection has been a tradition since 1951] appeared on the second-last page of the catalogue.

As indicated earlier, use of the Mark in the catalogue does not in itself constitute use in association with wares. Furthermore, there was no other evidence in the record that would allow me to find that the Mark was used in association with wares in accordance with the provisions of section 4(1)

of the Act. Having said this, I note that none of the grounds of opposition brings the use of the Mark into question, whether such use is planned or real. Furthermore, since the application was based on proposed use of the Mark, the Applicant does not have any duty to start using the Mark before it is approved [*Molson Canada v. Anheuser-Busch Inc.*, (2003) 29 C.P.R. (4th) 315 (F.C.T.D.)].

Mr. Therrien stated that the wares associated with the Mark were not likely to be sold in the same types of stores as those associated with the Opponent's trade-marks and that the distribution and trade channels were not the same. He stated finally that he had never been made aware of a case of confusion between the wares associated with the marks at issue since the Applicant began using the Mark.

Each of the signatories of the other affidavits identified himself or herself as a trade-mark analyst in the employ of Thomson & Thomson Canada, an intellectual property research firm linked to the Thomson & Thomson group, and submitted the results of searches conducted on March 9, 2001.

Frédéric Billon introduced in evidence the results of the search he had conducted from Intelpro/Thomson & Thomson's databank to locate all the Canadian marks that contained the word PRIMO. Mr. Billon indicated that this databank, which provided duplicates of the registrations contained in the Canadian Trade-marks Register and additional information provided by Intelpro/Thomson & Thomson, contained the registrations and applications made since 1967, as well as all the registrations abandoned since 1978. He explained that when he conducted his search, the last formalized date for applications that were opened for public inspection was February 26, 2001.

The evidence concerning the state of the register is relevant only to the extent that inferences can be drawn from it concerning the state of the market [*Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.)]. Moreover, inferences concerning the state of the market cannot be drawn from this evidence unless a large number of relevant registrations are found [*Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

On the basis of my examination of the results of Mr. Billon's search, it would seem that he found 39 trade-marks, that is 30 registrations and 9 applications for registration in association with wares and services of all kinds. The Opponent owns 9 registrations and 11 corporations share the ownership of the remaining 21 registrations. Only 4 applications, ownership of which is shared

among 3 entities, had been accepted for registration at the time the search was conducted. Consequently, it seems that of the 39 marks noted, 25 owned by entities other than the parties hereto, may be relevant. However, none of these marks is associated with wares similar to those associated with the marks at issue. At the very most, I can consider that 3 of the 25 marks, namely the marks BLANCOPRIMO for “*wash basins and sinks; built-in wash basins and sinks*”, PRIMO ZOOM for “*series of zoom lenses*” and PRIMO L for “*series of cameras lens*”, are associated with wares that have some connection with those of the parties.

Chantal Messen introduced in evidence the results of her search of the official companies register of the governments of Quebec and British Columbia as well as of the NUANS database to find all occurrences of the term PRIMO (Exhibit CM-1). Ms. Messen did not give any details concerning the information contained in the sources consulted. Even if we do not question the reliability of these sources, there is no evidence showing that the companies found are still operating. Assuming that a number of them are, there is no evidence that they use their names as trade-marks or trade-names [*Maritime Life Assurance v. Maritime Medical Care*, [1999] T.M.O.B. No. 164 (*per C. Folz*, August 24, 1999)]. Furthermore, it appears that a large number of the companies listed in the Government of Quebec data are the names of individuals whose family name is Primeau or the names of businesses that include the names of individuals with this surname.

Benoit Lemay introduced in evidence the results of his search of Thomson & Thomson Canada’s databank of Canadian common law sources covering the names of companies and trade-names to find all occurrences of the term PRIMO (Exhibit BL-1). Although Mr. Lemay noted that the report on the results of his search identified the list of the sources in question, he did not specifically indicate those which he consulted and gave no details concerning the information that was contained in them. Even if we do not question the reliability of these sources, the comments I made earlier concerning the results of Ms. Messen’s search in terms of the lack of evidence showing that the companies found were still operating and, if so, that they use their individual names as trade-marks or trade-names also apply to the evidence introduced by Mr. Lemay. This having been said, unlike the results of Ms. Messen’s search, some of the sources consulted by Mr. Lemay identified the area of activity of the companies listed. It is possible that the references to the mark PRIMO for companies that are identified as active in the field of furniture are references to distributors of the Opponent’s wares. Despite the fact that no two cases are exactly the same, the comments of D.J. Martin in *Venator Group Canada Inc. v. Upstein’s Ltd.* (2000), 7 C.P.R. (4th) 142 (T.M.O.B.) seem relevant to my analysis of Mr. Lemay’s affidavit:

Ms. Corbeil also states that she instructed others to perform a "Common Law" search in various registers, directories and printed sources. Exhibit LC-3 to her affidavit comprises the results of that search. Little weight can be given to those results, however, since they constitute inadmissible hearsay having been compiled by someone other than Ms. Corbeil. Apart from the hearsay deficiency, the results would appear to be of little help in this case since there is no clear indication of what sources were searched, what the results mean and whether or not any references located refer to business entities engaged in the retail clothing trade. A cursory review of some of the results suggests that many of the references located may, in fact, be individual retail outlets operated by the opponent under its various trade-marks throughout Canada. This highlights the potential danger in making inferences about the state of the marketplace from unreliable evidence. (p. 151)

Given what was stated earlier, I do not ascribe any significant impact to the evidence introduced by the Applicant in the affidavits of Mr. Billon, Ms. Messen and Mr. Lemay.

Following my analysis of the evidence of the parties, I shall consider below the different grounds of opposition, noting that although the ultimate onus of proof is on the Applicant, the Opponent has the initial onus of establishing the facts that support its grounds of opposition [*Joseph E. Seagram & Sons Limited v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 (T.M.O.B.); *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.)].

Section 30

The relevant date for considering the first two grounds of opposition is the date on which the application for registration was filed [*Georgia-Pacific Corp v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)].

There is no evidence in the record that would allow us to conclude that the Applicant was aware of the Opponent's trade-marks or trade-names as of the date of the application. Consequently, the Opponent did not discharge its onus of proving the facts alleged in support of these grounds of opposition to the effect that the application did not meet the requirements of section 30(i). However, and more importantly, even if this knowledge had been proved, it would not be sufficient to justify a finding that the Applicant could not validly state that it was satisfied that it was entitled to register the Mark on the ground, *inter alia*, that it caused confusion with the Opponent's marks. Consequently, I reject the first two grounds of opposition.

Paragraph 12(1)(d)

The Applicant has the onus of establishing, on a balance of probabilities, that there is no risk of confusion between the Mark and the Opponent's marks [*Dion Neckwear Ltd. v. Christian Dior, S.A.*

(2002), 20 C.P.R. (4th) 155 (F.C.A.)). The relevant date in assessing the risk of confusion in accordance with the provisions of section 12(1)(d) is the date of my decision [*Park Avenue Furniture Corp v. Wickers/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

For the purposes of this ground of opposition, I shall begin by comparing the Mark with the trade-marks PRIMO of Registration No. 411,602 and PRIMO INTERNATIONAL of Registration No. 403,312.

When it is a question of determining the risk of confusion between the marks in question, it is necessary to apply the first-impression test. More specifically, it is necessary to ask whether a consumer having an imperfect recollection of the Opponent's marks could wrongly believe that the wares associated with the Mark came from or were authorized by the Opponent. To this end, it is necessary to take into account the circumstances of the case, including the criteria set out in subsection 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 businesses; (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. All these criteria must not necessarily be given the same weight because, depending on its importance, one criterion may take precedence over one or more of the others [*Classic Door & Millwork Ltd. v. Oakwood Lumber & Millwork Co.* (1995), 63 C.P.R. (3d) 337 (F.C.T.D.)].

Concerning the inherent distinctiveness of the trade-marks in question, I note that *Le Petit Robert I* and *Webster's Ninth New Collegiate Dictionary* define "primo" as an adverb meaning "in the first place". According to *Webster's Ninth New Collegiate Dictionary*, "primo" is also a noun meaning "the first or leading part (as in a duet or trio)". Consequently, even though the Mark and the Opponent's marks do not necessarily have a descriptive connotation when we consider the wares that are associated with them, they do not have a distinctiveness that is as important as in the case of invented words, the term INTERNATIONAL not really lending distinctiveness to the mark PRIMO INTERNATIONAL. The Applicant's evidence does not allow me to draw any conclusion on the extent to which the Mark is known in Canada. Nor does the Opponent's evidence allow me to draw any conclusion concerning the extent to which its mark PRIMO is known in Canada. As far as the mark PRIMO INTERNATIONAL is concerned, since there was no information concerning the volume or value of the Opponent's sales, it is difficult for me to determine the extent to which this mark is known in Canada. However, even if we find that there is a minimal level of knowledge of the mark PRIMO INTERNATIONAL, this knowledge does seem to extend throughout Canada.

The Opponent's mark PRIMO was registered on the basis of its use in Canada since at least October 1967, when its mark PRIMO INTERNATIONAL was registered on the basis of its use in Canada since at least January 16, 1991. Although these dates correspond to the date of first use identified in the affidavit, the Opponent has not proved that its marks have been used continuously since the alleged dates. Be that as it may, because of the Opponent's evidence, the length of time of use favours it at least with respect to its mark PRIMO INTERNATIONAL.

When we consider the degree of resemblance between the trade-marks in appearance, sound or the ideas suggested, the marks must be considered as a whole [*Molson Companies Ltd. v. John Labatt Ltd.* (1994), 58 C.P.R. (3d) 527 (F.C.A.)]. Furthermore, the first element of a trade-mark may be considered to be an important factor in this analysis [*Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)]. Consequently, this criterion favours the Opponent not only with respect to its mark PRIMO but also with respect to its mark PRIMO INTERNATIONAL.

If we consider the type of wares and the nature of the trade, I must compare the statement of wares in the application for registration with the statement of wares in the registrations [*Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe, Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)]. Yet, there are important differences between the wares associated with the Mark and the wares identified in the registrations, it being possible to divide the latter into two categories, namely furniture and bicycles. Nor do I believe that it is possible to claim any overlap between the wares of the Applicant and the wares of the Opponent. From the statement of the application and the registrations, it would seem that the nature of the trade associated with the marks in question is very different, and this is also shown by the evidence in the record.

In this case, I believe that it is appropriate to attach significant weight to the differences between the wares and the nature of the trade associated with the trade-marks. I note the comments of Marceau J. in *Playboy Enterprises Inc. v. Germain* (1978) 39 C.P.R. (2d) 32:

The question whether a mark is likely to be confusing with another mark in the minds of the public and within the meaning of the law, is a question of fact, or more precisely a question of opinion as to probabilities based on the surrounding circumstances and the particular facts of the case... (p. 38)

Given what has been said above, especially because of the major differences between the wares and the nature of the trade associated with the trade-marks, I find that the Applicant discharged the onus of proof it had to establish that the Mark was not confusing with the trade-marks PRIMO of Registration No. 411,602 and PRIMO INTERNATIONAL of Registration No. 403,312. I would have drawn the same conclusion if I had compared the Mark with each of the other trade-marks registered by the Opponent and relied upon in the statement of opposition. Consequently, I reject the fourth ground of opposition.

Paragraphs 16(3)(a) et 16(3)(c)

The relevant date in assessing the risk of confusion between the Mark and the trade-marks and trade-names relied upon by the Opponent in support of its sixth ground of opposition is the date on which the application for registration was filed. Despite the onus of proof on the Applicant to establish, on a balance of probabilities, that there is no risk of confusion, the Opponent has the initial onus of proving that it used its trade-marks and trade-names at the relevant date [subsection 16(3)] and that it had not abandoned using them at the date of advertisement of the application [subsection 16(5)].

I conclude that the Opponent discharged its onus of proof with respect to its use of the trade-marks PRIMO INTERNATIONAL in association with furnishings and furniture as well as in association with the services of furniture manufacturing.

I note that the Opponent has not indicated the trade-names in respect of which it alleges prior use under any of the grounds of opposition raised. Even where a statement of opposition raises a serious question for decision, a ground of opposition must be argued with sufficient particulars to enable the Applicant to reply to it, failing which this ground of opposition cannot be considered [*Carling Breweries Ltd. v. Molson Companies Ltd.* (1984), 1 C.P.R. (3d) 191 (F.C.T.D.); aff'd (1988), 19 C.P.R. (3d) 129 (F.C.A.)]. Although the Applicant never directly raised the question of confusion between its Mark and trade-names in its counter-statement, it is possible to argue that it did so indirectly by making a general denial of the allegations in the statement of opposition. One of the principles set out in *Novapharm Ltd. v. AstraZeneca AB et al.* 21 C.P.R. (4th) 289 (F.C.A.) is that if the sufficiency of allegations are determined after the evidence in the case has been introduced, this evidence must be considered when the assessment is made as to whether the Applicant was able to determine the case it had to face. Following my analysis of the evidence, I find that the Opponent discharged its onus of proving that the trade-name Primo International was used at the very least in association with the services of manufacturing furniture.

The difference between the relevant dates for the ground of opposition based on paragraph 12(1)(d) and that based on paragraph 16(3)(a) and paragraph 16(3)(c) does not really have any impact on the analysis of the relevant criteria, following which I have found that there was no confusion between the Mark and the trade-mark PRIMO INTERNATIONAL of Registration No. 403,312. Consequently, I reject the sixth ground of opposition.

Distinctive

Although the Applicant must establish that the Mark is distinctive across Canada [*Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (T.M.O.B.)], the Opponent has the initial onus of adducing evidence that would permit to establish the facts relied upon in support of its last ground of opposition, which also rests on the question of confusion between the Mark and the Opponent's trade-marks. The relevant date for this ground of opposition is generally accepted as being the date on which the statement of opposition is filed [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)]. Because of the evidence in the record and the fact that the difference in relevant dates does not really have an important impact on my previous findings concerning the fact that there was no risk of confusion between the Mark and the Opponent's mark PRIMO INTERNATIONAL, the final ground of opposition is also rejected.

On the basis of the powers delegated to me by the Registrar of Trade-marks under the provisions of subsection 63(3) of the Act, I dismiss the Opponent's opposition in accordance with the provisions of subsection 38(8) of the Act.

DATED AT MONTREAL, QUEBEC, FEBRUARY 24, 2005.

Céline Tremblay
Member
Trade-Marks Opposition Board