

**IN THE MATTER OF AN OPPOSITION
by Kabushiki Kaisha Kaminomoto Hongo also
trading as Kaminomoto Co. Ltd. to application
No. 1,028,792 for the trade-mark AJINOMOTO
& Design filed by Ajinomoto Co., Inc.**

On September 13, 1999, the applicant, Ajinomoto Co., Inc. (“Ajinomoto”), filed an application to register the trade-mark AJINOMOTO & Design (shown below) based on proposed use in Canada for the following wares:

- (1) Chemicals for use in industry, namely amino acids, amino acid preparations, amino acid polymers, nucleotides, hydrolyzed proteins, enzymes, enzyme preparations, surfactants, humectants, dispersants, flame retardants, food preservatives, fertilizers, artificial sweeteners, pharmaceutical preparations for the treatment of liver diseases, diabetes, immune disease, tumors, aids (acquired immune deficiency syndrome) and bone disease; nutritious preparations for parenteral administration namely, intravenous administration or infusion solution; veterinary preparations for the treatment of liver disease and diseases of the digestive; nutritional additives for livestock feed; dietetic foods adapted for medical purpose; dietetic beverages adapted for medical purposes.
- (2) Prepared foods, processed foods, dried foods, frozen foods, cooked foods all consisting primarily of meat, fish, shellfish, poultry and vegetables; soups, preparations for soups, namely, soup stocks; meat extracts; edible fats and oils; milk and dairy products, lactic acid drinks, namely, fermented milk drink.
- (3) Hydrolyzed proteins for seasoning purposes; coffee; cocoa; tea; seasonings; flavourings for non-nutritional purposes; flavour enhancers for non-nutritional purposes; sauces, namely, pasta sauces, Chinese sauces and white sauces, salt and pepper; salad dressings; meat tenderizers; mayonnaise; sugar and natural sweeteners; prepared foods, processed foods, dried foods, frozen foods, cooked foods consisting primarily of rice, noodles, dumplings and pasta; breakfast cereals; bread; and frozen confections.
- (4) Animal foodstuffs; animal feed additives for non-nutritional purposes for use as flavoring, ingredient or filler; additives to fodder for non-nutritional purposes for use as flavoring, ingredient or filler.
- (5) Milk and dairy products, namely, yogurt, cheese and butter.
- (6) Dietetic foods adapted for medical purposes, namely, dietetic foods containing amino acids.

(7) Dietetic beverages adapted for medical purposes, namely, dietetic beverages containing amino acids.

The application was advertised for opposition purposes on March 13, 2002.

AJINOMOTO

The opponent, Kabushiki Kaisha Kaminomoto Hongo also trading as Kaminomoto Co. Ltd. (“Kaminomoto”), filed a statement of opposition on August 13, 2002, a copy of which was forwarded to the applicant on September 23, 2002. The sole ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the opponent’s trade-mark KAMINOMOTO registered under No. 187,482 for “cosmetics, hair preparations, namely, oils, creams and tonics” and its trade-mark KAMINOMOTO & Design (shown below) registered under No. 434,956 for “health and beauty products, namely, hair tonics, hair grooming preparations and shampoos.”

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The applicant filed and served a counter statement. As its evidence, the opponent submitted an affidavit of Kozo Kawamata. As its evidence, the applicant submitted the affidavits of Tokuo HIRAMA and Herb McPhail. As evidence in reply, the opponent submitted the affidavits of Shuji Sumi, Deborah Thomas and Laura Thompson. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

THE OPPONENT'S EVIDENCE

In his affidavit, Mr. Kawamoto identifies himself as Section Chief, International Trading Section of the opponent, Kaminomoto. He states that the opponent has used its trade-marks KAMINOMOTO and KAMINOMOTO & Design in Canada with the wares set out in the associated registrations since 1972 and January 20, 1993, respectively. He describes the manner of distribution of the opponent's wares in Canada and sets out Canadian sales figures for the years 1997-2002 totalling only about \$50,000. Canadian advertising has been very limited.

Exhibit B to the Kawamoto affidavit is a product package for the opponent's hair tonic. It displays the trade-mark KAMINOMOTO and the elements of the opponent's registered design mark but not the registered mark as a whole. Exhibit C comprises photocopies of representative invoices which cover such wares as hair tonic, cream, shampoo and conditioner. However, it appears that only the hair tonic is sold under the trade-mark KAMINOMOTO whereas the other wares are sold under other marks such as ELASTECT, YAKUYO and ACCELERATOR. Thus, the limited sales attested to by Mr. Kawamoto may be even more limited than he has stated.

THE APPLICANT'S EVIDENCE

In his affidavit, Mr. Hirama identifies himself as a partner with the Canadian trade-mark agency firm representing the applicant. Mr. Hirama states that he is fluent in Japanese and purports to give expert evidence on the meaning of several Japanese words. However, Mr. Hirama failed to qualify himself as a linguistics expert. Attached as Exhibit 1 to Mr. Hirama's affidavit is what purports to be a copy of the applicant's 2003 annual report in the Japanese language. Mr. Hirama makes statements about the applicant's business based on the content of that report. Since Mr. Hirama has not qualified himself as an expert in Japanese and is not employed in any capacity by the applicant, his statements about the applicant are inadmissible hearsay. Thus, his affidavit is of little evidential value in this proceeding.

The McPhail affidavit introduces into evidence the results of Mr. McPhail's state of the trade-marks register search respecting marks of record which include the suffix MOTO or the suffix NOMOTO. Mr. McPhail's search located the opponent's two registered marks and nine registrations owned by the applicant, eight of which comprise or include the word AJINOMOTO or AJI-NO-MOTO. Mr. McPhail's search also revealed more than a dozen third party MOTO marks for various wares.

THE OPPONENT'S REPLY EVIDENCE

Given that the only admissible evidence of value submitted by the applicant is the McPhail affidavit, there is little that the opponent could have submitted that would have been strictly confined to matters in reply as required by Rule 43 of the Trade-marks Regulations. In view of my conclusions respecting the Hirama affidavit, it follows that none of the three

affidavits submitted by the opponent pursuant to Rule 43 qualifies as proper reply evidence.

In his affidavit, Mr. Sumi identifies himself as a technical advisor employed by the opponent's Canadian trade-mark agency firm. He purports to give expert evidence on the Japanese language and the contents of the applicant's 2003 annual report but his statements suffer from the same defects as Mr. Kawamata's. The balance of his affidavit is either irrelevant or inadmissible.

The Thomas and Thompson affidavits also do not qualify as proper reply evidence. Mss. Thomas and Thompson purchased a number of personal care products apparently for the purpose of showing that the items contain 'inter alia' amino acids. To the extent this evidence would have been relevant at all, it should have been adduced as part of the opponent's evidence-in-chief.

THE GROUNDS OF OPPOSITION

As for the sole ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

As for Section 6(5)(a) of the Act, the marks of both parties are inherently distinctive as AJINOMOTO and KAMINOMOTO have no suggestive or descriptive connotations for the average Canadian consumer. There being no evidence of use of the applicant's mark, I must conclude that it has not become known at all in Canada. The evidence of use of the opponent's mark is minimal, at best. Thus, the opponent's mark has also not acquired any reputation of note in this country.

The length of time the marks have been in use favors the opponent. As for Sections 6(5)(c) and 6(5)(d) of the Act, it is the applicant's statement of wares and the statements of wares appearing in the opponent's two registrations that govern: see Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.), Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.) and Miss Universe, Inc. v. Dale Bohna (1994), 58 C.P.R.(3d) 381 at 390-392 (F.C.A.). However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful: see the decision in McDonald's Corporation v. Coffee Hut Stores Ltd. (1996), 68 C.P.R.(3d) 168 at 169 (F.C.A.).

The wares of the parties are different. Presumably the trades would also be different. The opponent contended that there is at least some overlap between the wares since some personal care products contain amino acids. However, there is no admissible evidence on point and, even if there were, it would appear that those manufacturing and selling amino acids are engaged in a different trade from those manufacturing and selling personal care products.

As for Section 6(5)(e) of the Act, the marks at issue bear some visual and phonetic resemblance due to the common use of the component INOMOTO. There is no evidence suggesting that the marks at issue bear any resemblance as to the ideas suggested.

The applicant submitted that the significance of any resemblance between the marks is mitigated by the state of the register evidence introduced by means of the McPhail affidavit. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see the opposition decision in Ports International Ltd. v. Dunlop Ltd. (1992), 41 C.P.R.(3d) 432 and the decision in Del Monte Corporation v. Welch Foods Inc. (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). Also of note is the decision in Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd. (1992), 43 C.P.R.(3d) 349 (F.C.A.) which is support for the proposition that inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.

Although the number of third party MOTO-suffixed marks located by Mr. McPhail is not extensive, it is sufficient to allow me to conclude that at least a few of such marks are in active use in Canada. Thus, to a limited extent, consumers would be used to seeing MOTO-suffixed marks and would therefore distinguish such marks on the basis of their other components.

The applicant submitted that its other registrations have coexisted on the trade-marks register with the opponent's two registered marks. However, the test for confusion is a marketplace test and not a trade-marks register test. Thus, the applicant's submission is of

no relevance in this case.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the inherent distinctiveness of both marks, the differences between the wares and trades of the parties and the state of the register evidence respecting third party MOTO-suffixed marks, I find that the applicant has satisfied the onus on it to show that its trade-mark is not confusing with the opponent's two registered marks. The sole ground of opposition is therefore unsuccessful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I reject the opponent's opposition.

DATED AT GATINEAU, QUEBEC, THIS 20th DAY OF DECEMBER, 2006.

**David J. Martin,
Member,
Trade Marks Opposition Board.**