

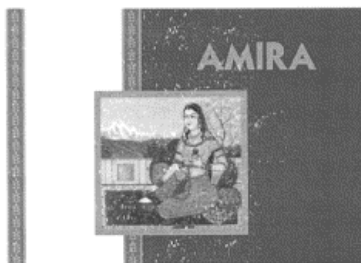


LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2013 TMOB 54
Date of Decision: 2013-03-28

**IN THE MATTER OF AN OPPOSITION
by Les Entreprises Amira Inc. to
application No. 1,300,873 for the trade-
mark AMIRA & Design in the name of
Amira Foods (India) Limited**

[1] On May 9, 2006, Amira Foods (India) Limited (the Applicant), filed an application for the trade-mark AMIRA & Design (the Mark), shown below, based upon proposed use of the Mark in Canada. The statement of wares was subsequently amended to “rice”. The application was advertised for opposition purposes in the *Trade-marks Journal* of December 10, 2008.



[2] On February 9, 2009, Les Entreprises Amira Inc. (the Opponent), filed a statement of opposition against the application. The grounds of opposition are that the Applicant’s application does not conform to the requirements of sections 30(e), 30(h) and 30(i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), the Mark is not registrable pursuant to section 12(1)(d) of the Act, the Applicant is not the person entitled to registration of the Mark pursuant to section 16(3)(a) and section 16(3)(c) of the Act and the Mark is not distinctive. Each of the last four grounds of opposition is based on confusion with either the Opponent’s use and

registration of its trade-marks AMIRA, registration No. TMA410,723 and EL AMIRA, registration No. TMA390,629 or the Opponent's trade-name Amira Enterprises Inc.

[3] The Applicant filed and served a counter statement, in which it denied the Opponent's allegations.

[4] The Opponent's evidence consists of the statutory declaration of Adel Boulos, and certified copies of registration Nos. TMA410,723 and TMA390,629. The Applicant filed the affidavit of Anita Daing. Both affiants were cross-examined and cross-examination transcripts, exhibits and replies to undertakings form part of the record.

[5] Both the Applicant and the Opponent filed a written argument. An oral hearing was conducted at which both parties were represented.

Preliminary Issue

[6] Just prior to the commencement of the oral hearing, I received a request from the Opponent's agent for leave pursuant to section 44(1) of the *Trade-marks Regulations*, SOR/96-195, to file a second statutory declaration of Mr. Adel Boulos, as well as the statutory declaration of Brij Sehgal. The Applicant's agent was given the opportunity at the oral hearing to make its submissions regarding this request.

[7] In order to decide whether or not to grant leave to the Opponent to file this additional evidence, I considered whether or not it was in the interests of justice to do so. After hearing both parties' submissions, I decided that it was not. In addition to this request having been brought at a very late stage in the proceeding, the granting of leave to file either of these statutory declarations would have seriously prejudiced the Applicant. In this regard, granting leave would have either deprived the Applicant of the opportunity to challenge the statements made by the declarants, or required the adjournment of the oral hearing to permit the Applicant to cross-examine the declarants, and/or file evidence in reply and further written arguments. Further, the facts provided by the Opponent gave little justification for the lateness of the Opponent's request. The Opponent submitted that Mr. Boulos only discovered that there were boxes of documents related to the Opponent in the basement of his mother's private home on

March 16, 2013 and that Mr. Sehgal was only recently contacted on March 12, 2013, to come forward to give testimony in the present proceeding. Finally, I was not satisfied that either of these statutory declarations, if permitted to be filed, would be likely to have had any fundamental effect on the decisions to be reached in this opposition. As a result, these statutory declarations have not been made of record.

Onus and Material Dates

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

[9] The material dates that apply to the grounds of opposition are as follows:

- Section 38(2)(a)/Section 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Section 38(2)(b)/Section 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- Section 38(2)(c)/Section 16(3) - the filing date of the application [see section 16(3)];
- Section 38(2)(d)/non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 CPR (4th) 317 (FC)].

Section 30 Grounds of Opposition

[10] The Opponent has pleaded three grounds of opposition under section 30 of the Act. The legal burden on the Applicant to show that its application complies with section 30 includes both the question as to whether or not the Applicant has filed an application which formally complies

with the requirements of section 30 and the question as to whether or not the statements contained in the application are correct. To the extent that the Opponent relies on allegations of fact in support of its section 30 grounds, there is an evidential burden on the Opponent to prove those allegations [see *Joseph E Seagram & Sons Ltd et al v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB), affd 33 CPR (3d) 454]. This burden can be met by reference not only to the Opponent's evidence but also to the Applicant's evidence [see *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) (FCTD) 216 at 230].

[11] With respect to the section 30(h) ground of opposition, the Opponent has not pointed to any evidence nor made any arguments under this ground. This ground is therefore dismissed.

[12] With respect to the section 30(i) ground, where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. As there is no evidence of bad faith in the present case, I am dismissing this ground of opposition.

[13] With respect to the section 30(e) ground of opposition, while the Opponent may rely upon the Applicant's evidence to meet its evidential burden in relation to this ground, the Opponent must show that the Applicant's evidence is 'clearly' inconsistent with the Applicant's claims as set forth in its application.

[14] In the present case, the Opponent pleaded the Applicant did not have the intention to use the Mark in Canada in association with all of the wares listed in the original application or, alternatively, the Applicant had used the Mark in Canada prior to the filing date of the application. The Opponent argues that despite Ms. Daing's statement at paragraph 5 of her affidavit that the Applicant only started commercial use of the Mark in Canada in January, 2009, there are contradictory statements made on cross-examination that the Applicant really started commercial use of the Mark in Canada as far back as 2002 and probably earlier. In this regard, the Opponent relies on the following excerpt from Ms. Daing's testimony:

Q. 141: ...When did you start selling Amira branded products in North America for the first time? And by Amira-branded products I mean products bearing the Amira brand not just the name, corporate name Amira India.

A. Can we get back on that?

Mr. Zive: We'll take it under advisement.

Mr. Archambault: Take it under advisement. And with that undertaking also do the same specifically for Canada?

Mr. Zive: Yes. Same answer. Take it under advisement.

Undertaking #7: There were certainly sales in 2002, and probably earlier.

[15] The Applicant, on the other hand, submits that the evidence of Ms. Daing is not clearly inconsistent with the Applicant's claim that that the Mark is based on proposed use in Canada. In this regard, the Applicant noted that the Mark is a design mark while the Opponent's questions were directed to the AMIRA brand. Further excerpts from Ms. Daing's testimony pointed out by the Applicant are as follows:

Q. 142: Now if I may ask you in the same question for Canada do you know if it was before 2006?

A. What was before 2006?

Q. 143: Use of the Amira trade-mark as a trade-mark in Canada.

A. You're talking of the trade-mark again, not the trade-name?

Q. 144: I'm talking about the trade-mark, correct, not the trade-name.

A. Before 2006?

Q. 145: Yes, in other words, did you start selling AMIRA branded products before 2006 in Canada?

A. I think...not before 2006 maybe.

Q.146: Okay.

A. Let me clarify. The trade-name, yes, before 2006. The trade-mark probably not.

Q. 147: The same question for the Amira design mark, the lady.

A. Yes.

Q. 148: Before 2006 in Canada?

A. Not in Canada, but yes, internationally, yes...

[16] I also found the following testimony relevant to the issue of prior use of the Mark prior to the Applicant's claimed date of first use:

Q. 172: Now looking at paragraph 5 again you said that, or it is stated rather you commence commercial use of the trade-mark in Canada in January or about January 2009. Could you undertake to give me sales amounts in Canada since January 2005 of Amira branded products and indicate whether these sales amounts concern Amira word mark or the Amira design mark as applied in Canada.

Mr. Zive: And we'll take that under advisement.

U/T 12: Sales appear to have totaled about \$108,000 since 2005 in association with both the word mark and design mark.

[17] From my review of the above-noted testimony, there does appear to be some inconsistencies with Ms. Daing's answers. I am confused that her answer to Q. 148 is that the Applicant did not use the Mark in Canada before 2006 but then the answer to undertaking for Q. 172 states that there have been sales since 2005 in association with both the word mark and the design mark. In my view, Ms. Daing's testimony as a whole is sufficient to meet the Opponent's evidential burden under this ground.

[18] In view of the line of decisions wherein the Registrar has refused proposed use applications where actual use of the trade-mark was evidenced prior to the filing date and in view that the Applicant has not met the burden on it to show compliance with section 30(e) of the Act, this ground of opposition is successful [see *Nabisco Brands Ltd v Cuda Consolidated Inc* (1997), 81 CPR (3d) 537 at 540 and *Canada Post Corp v IBAX Inc* (2001), 12 CPR (4th) 562 (TMOB); *Calvin Klein Trade-mark Trust v Calvin Corporation* (2000), 8 CPR (4th) 397 (TMOB); and *Systèmes de formation & de Gestion Perform Inc v Scissons*, 2004 CarswellNat 1758].

Section 12(1)(d) Ground of Opposition

[19] As previously noted, each of the final four grounds of opposition turns on the issue of the likelihood of confusion between the Mark and each of the Opponent's marks or the Opponent's

trade-name. I consider the Opponent's case to be strongest with respect to the ground that the Mark is not registrable pursuant to section 12(1)(d) of the Act.

[20] I will focus my analysis on the likelihood of confusion between the Opponent's AMIRA mark, registration No. TMA410,723 and the Mark. If the Opponent is not successful based on this mark, then it will not be successful based on its other mark since the AMIRA mark has a greater degree of resemblance to the Mark than does the Opponent's EL AMIRA mark.

[21] I have exercised the Registrar's discretion to confirm that registration No. TMA410,723 of the Opponent for the AMIRA mark is currently extant. The wares and services covered by this registration are as follows:

WARES:

(1) Food products, namely: canned, frozen and packaged vegetable and fruits; vegetable and fruit juices, dried fruits, nuts, beans, grains, seeds, rice, spices, herbs, extracts, vanilla extracts, almond extracts; vegetable oil; olive oil; rose water, orange water; middle east food products, namely: sausages, falafel, tahini, tabouli, tabouli salads, hommos, couscous; confectionery, namely: candies, chocolates, cookies, pastries, cakes.

SERVICES:

(1) Operation of an import and export business specializing in middle east food and non-food products.

Test for Confusion

[22] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 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 each has 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 in appearance or sound or in the ideas suggested by them.

[23] This list of enumerated factors is not exhaustive and it is not necessary to give each one of them equal weight [see *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC)]. Recently, in *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 92 CPR (4th) 361 (SCC) , the Supreme Court of Canada clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks.

section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

[24] The Applicant submits that the Opponent’s mark is not inherently distinctive because the word AMIRA is both the name of an individual, as well as the word “princess” in Arabic [Boulos, para. 10; cross-ex., Q. 502-505]. While it is acknowledged that names do not generally have a great deal of inherent distinctiveness, there is no evidence to support a finding that the average Canadian would equate the word AMIRA with the name of an individual. Further, there is no evidence to support a finding that the average Canadian would be aware of the Arabic meaning of the word AMIRA [see *Miguel Torres, SA v Cantine Giorgio Lungarotti Srl Ltd* (2012), 106 CPR (4th) 206 (TMOB)].

[25] As I am therefore of the view that the average Canadian would be more likely to interpret the word AMIRA as a coined word, I consider both marks to be inherently distinctive. While the Mark may also include a design feature, I agree with the Opponent that this representation of a Middle Eastern woman with a bowl of rice is suggestive of the Applicant’s wares.

[26] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. I will now turn to the evidence of the extent to which the trade-marks have become known in Canada.

[27] The evidence of the Opponent’s affiant, Mr. Boulos, provides the following information and exhibits:

- the Opponent has used its AMIRA trade-mark in Canada since at least 1978 [Boulos, paras. 11,15; Exh. AB-3];

- since 1978 until the date of Mr. Boulos's statutory declaration, the Opponent's gross sales of food products under the AMIRA trade-mark have generated over \$100 million dollars [Boulos, para. 18];
- 80% of these sales were for AMIRA branded products and 20% were for products branded under a different name but sold by the Opponent under its AMIRA service mark [Boulos, UT #3];
- representative sample of invoices for the years 2005-2009 bearing the AMIRA mark [Boulos, Exh. AB-7];
- a product catalogue showing representative examples of all AMIRA trade-mark labels used by the Opponent since at least as early as 1978 [Boulos, Exh. AB-5];
- a sample of the Opponent's rice sold across Canada for several years under the AMIRA trade-mark [Boulos, Exh. AB-6];
- a copy of press articles illustrating some of the Canadian coverage received by the Opponent's business and the AMIRA trade-mark over the years [Boulos, Exh. AB-8].

[28] The Applicant, however, submits that AMIRA is not distinctive of the Opponent in respect to rice because the Opponent's evidence shows a different company as the source for such rice products. In this regard, the Applicant points to page 55 of the 2009 catalogue attached to Mr. Boulos statutory declaration where the AMIRA label on one of the rice products appears to show Shivnath Rai Harnarain (SRH), a rice producer in India, as the source of such rice products [Boulos, Exhibit AB-05]. The Applicant further noted that the Opponent's rice was sold with the SRH label until 2007 and the Opponent's catalogue and website displayed rice products with the SRH labels until at least 2011 [Boulos, cross-ex. Q. 289-293].

[29] The Applicant therefore submits that since the Opponent advertised its rice products online and in its catalogues for years in association with the SRH labels which informed consumers in large and prominent letters on the label that such rice originated from an unrelated company in India, namely SRH, and not the Opponent, the Opponent's trade-mark did not acquire distinctiveness in association with the Opponent's rice product.

[30] The Applicant further submits that in view that there is no evidence that SRH has a license from the opponent to use the AMIRA mark, or that the Opponent exercises any control over SRH, it appears that the Opponent was not more than a distributor of such rice in Canada [Boulos, cross-ex. Q. 100-105 and 314-320]. The Applicant relies on the decision in *Royal Doulton Tableware Ltd v Cassidy's Ltd* (1984), 1 CPR (3d) 214 at para. 16.

[31] The Opponent, on the other hand, submits that this case can be distinguished from the decision in *Royal Doulton* on the basis that the registered mark in that case was not distinctive of the rightful owner of the registration whereas, in the present case, the validity of the Opponent's registered mark is not an issue. Further, contrary to the Applicant's submission that the Opponent is only a distributor of SRH's rice, the Opponent argues that SRH is acting as an agent for the Opponent through its importer Nutrifresh Foods Ltd. Canada. The Opponent explains that it ordered rice from Nutrifresh Foods Ltd. Canada, who bought from SRH to the Opponent's specifications, and that SRH was producing private label products for the Opponent under its private label [Boulos, p. 22-23 and p. 57-69; Q. 71,78, 81].

[32] The evidence of record, however, does not support the Opponent's submissions. In this regard, Mr. Boulos stated the following on cross-examination:

Q. 305: But have you heard of Shivnath Rai Harnarain?

A. Yes, but I don't – I see it on the label but I've never been contact [sic], I don't know them...

Q. 306: So what you're saying is they're...

A. I don't deal with them.

Q. 307: Okay.

A. I have no contact with them. I deal only with my importer here.

Q. 308: Okay. So you have --- there's essentially, a middleman between Shivnath Rai Harnarain and you that delivers the rice to you?

A. Yes.

Q. 309: So, do you know who creates this package? It's not – so the product label that has Shivnath Rai Harnarain on it –

A. Yes?

Q. 310: -- you don't create that, that sac with that label on it, somebody else is creating that sac?

A. The sac, yes. It's not us who is creating the sac.

Q. 311 No. And you're not the ones filling that sac up with the rice and then –

A. No.

Q. 312: So somebody else probably Shivnath Rai Harnarain is creating the sac with the label, putting the rice in, shipping it to your importer, who then is shipping it to you?

A. Yes.

Q. 313: Yes. So you don't have any contracts with Shivnath Rai Harnarain?

A. No.

[33] The evidence appears to support a conclusion that *some* of the goodwill associated with the mark AMIRA in association with rice prior to 2007 enured to an entity other than the Opponent. This conclusion has a negative impact on the extent to which the Opponent's mark has become known in association with rice. I will add that the reason I say "*some* of the goodwill associated with the mark AMIRA in association with rice" is because this evidence regards Basmati rice sold by the Opponent while the Opponent's evidence also shows that it has used its AMIRA mark in association with other rice products, such as Egyptian rice [Boulos cross-ex. Exh. A]. It is also clear from the evidence that the Opponent's mark has acquired distinctiveness with respect to the operation of an import and export business specializing in middle east food and non-food products, and in association with various other food products.

[34] With respect to the Mark, although the evidence may show that it has been used and made known internationally, from the inconsistencies in the evidence furnished I am unable to determine the extent the Mark has been used or made known in Canada.

[35] Based on the foregoing information, this factor favours the Opponent.

section 6(5)(b) - the length of time each trade-mark has been in use

[36] The length of time that each mark has been in use favours the Opponent.

sections 6(5)(c) and (d) - the nature of the wares, services or business and the nature of the trade

[37] It is the Applicant's statement of wares as defined in its application versus the Opponent's registered wares and services that govern my determination of this factor [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); *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[38] Both parties' wares include rice. In the absence of evidence to the contrary, the parties' channels of trade would presumably overlap.

section 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[39] While the Supreme Court of Canada in *Masterpiece* observed that the first word of a trade-mark may be the most important for purposes of distinction [see also *Conde Nast Publications v. Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)], it opined that the preferable approach is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique.

[40] In the present case, the word AMIRA is the most striking and unique aspect of both parties' marks. While the Mark also includes the representation of a Middle Eastern woman, this design appears below the word AMIRA which is written in bold uppercase letters. Further, the Applicant's affiant herself stated that AMIRA is an essential and distinctive feature of the Mark [see Daing, para. 3].

[41] There is therefore a high degree of resemblance between the marks both in appearance and sound because both marks share the identical distinctive component AMIRA. In view that AMIRA is not a word in the English language, there would not appear to be any idea suggested by the Opponent's mark to the average Canadian consumer. Similarly, there would be no idea suggested by the Mark, except perhaps the geographic origin of the Applicant's wares due to the representation of the Middle Eastern woman.

Further surrounding circumstances

[42] Relying on the decision in *Masterpiece* at para. 112, the Opponent submitted as a further surrounding circumstance that it is relevant to note that the Registrar forwarded a notice to the Opponent pursuant to section 37(3) of the Act. The decision in *Masterpiece* can be distinguished from the present case, however, because in that decision two trade-mark applications were initially refused by the Registrar for being confusingly similar to a proposed registration.

[43] In the present case, a decision by the Registrar to forward a notice to the Opponent pursuant to section 37(3) of the Act is not a refusal of a trade-mark application. As set out below, a section 37(3) letter is sent to an owner of a registered trade-mark when the Registrar is in doubt that an application is registrable:

Doubtful cases

(3) Where the Registrar, by reason of a registered trade-mark, **is in doubt** whether the trade-mark claimed in the application is registrable, he shall, by registered letter, notify the owner of the registered trade-mark of the advertisement of the application. (emphasis added)

[44] Further, it has been previously held that a decision by the Registrar has no precedential value for the Board because both the onus and the evidence before a trade-marks examiner differs from that before the Board [see *Thomas J. Lipton Inc v Boyd Coffee Co* (1991), 40 CPR (3d) 272 (TMOB) at 277 and *Procter & Gamble Inc v Morlee Corp* (1993), 48 CPR (3d) 377 (TMOB) at 386]. I must therefore come to a decision in the present case solely on the evidence of record in this opposition proceeding.

[45] Based on the foregoing, I do not find that this forms a relevant surrounding circumstance supporting the Opponent's position.

Conclusion

[46] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees AMIRA & Design on the Applicant's rice at a time when he or

she has no more than an imperfect recollection of the Opponent's AMIRA trade-mark, and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot*].

[47] In view of my findings above, and in particular the high degree of resemblance between the marks and the fact that the wares are identical, it seems to me that such a consumer would, as a matter of first impression, be likely to believe that the rice associated with the Opponent's AMIRA mark and the Mark were manufactured, sold or performed by the same person.

[48] The section 12(1)(d) ground of opposition therefore succeeds.

Remaining Grounds of Opposition

[49] In view that the Opponent succeeds on two grounds of opposition, I do not consider it necessary to decide the remaining grounds of opposition.

Disposition

[50] Having regard to the above, and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Cindy R. Folz
Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office