

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

**Citation: 2012 TMOB 143
Date of Decision: 2012-07-31**

**IN THE MATTER OF AN OPPOSITION by
Multi-Marques Inc., Boulangerie Pom
Limitée and Canada Bread Company
Limited to application No. 1,389,758 for the
trade-mark POMEPURE & Design in the
name of Rash Nagar**

[1] On April 2, 2008, Pomepure Ltd. filed an application to register the trade-mark POMEPURE & Design (shown below) (the Mark) based on proposed use of the Mark in Canada in association with the following wares, as revised:

The logo for 'Pomepure' is written in a bold, italicized, sans-serif font. The letters are slanted to the right. A thick, curved underline follows the bottom of the letters.

Fruit flavoured teas, ices, treacle; Non-alcoholic drinks namely, mineral and aerated waters, fruit drinks and fruit juices, fruit juice concentrate, nectars, energy drinks; Alcoholic beverages namely, cocktails, vodka, gin, champagne, sparking and nonsparking [sic] wine (the Wares).

[2] The application is also based on use and registration of the Mark in the United Kingdom in association with the Wares.

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


[4] I shall mention at this point of my decision that by letter dated July 19, 2010, the Registrar recorded an update of ownership of the application for the Mark, which was assigned by Pomepure Ltd. to Rash Nagar. I will refer indiscriminately to both persons as the Applicant.

[5] On April 6, 2009, Multi-Marques Inc., Boulangerie Pom Limitée and Canada Bread Company Limited (collectively referred to as the Opponent) filed a statement of opposition. The Applicant thereafter filed a counter statement in which it denied the Opponent's allegations.

[6] On March 3, 2010, the Opponent requested leave to file an amended statement of opposition, which leave was granted by the Registrar on March 25, 2010. The grounds of opposition, as amended, can be summarized as follows:

1. the application for the Mark does not comply with the requirements of section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) in that:
 - (a) the application does not comply with section 30(a) of the Act in that the application does not contain a statement in ordinary commercial terms of the Wares in association with which the Mark is proposed to be used;
 - (b) the application does not comply with section 30(d) of the Act in that the application does not include the name of a country of the Union (as defined in the Act) in which the Mark has been used by the Applicant. More particularly, the Applicant was not using and has not used the Mark at all relevant dates in the United Kingdom in association with the Wares as set out in the application;
 - (c) the application does not comply with section 30(i) of the Act in that the Applicant could not have been satisfied that it was entitled to use the Mark given the use of the trade-mark POM by the Opponent since at least as early as 1930;
2. the Mark is not registrable pursuant to section 12(1)(b) of the Act in that it is clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the Wares;

3. the Mark is not registrable pursuant to section 12(1)(d) of the Act in that it is confusing with the following registered trade-marks of the Opponent (hereinafter the POM Registered Marks):

Trade-mark	Registration No. / Date	Wares
	TMA469,001 January 17, 1997	<i>Produits de boulangerie et de pâtisserie, notamment pain, pain biologique, petits pains, beignes, brioches, gâteaux, biscuits, galettes, pâtisseries, tartes, muffins, muffins anglais, croissants, pâte à pizza, tortillas, pita, bagels, breadsticks et kaisers</i>
"POM GOLD" (POM D'OR)	UCA40516 February 1, 1952	Bread.
POM	TMDA049765 June 20, 1930	Bread, cake and confectionery namely pastries, cookies, waffles and candies.
POM LITE	TMA335,814 December 31, 1987	Bread.

4. the Applicant is not the person entitled to registration of the Mark pursuant to section 38(2)(c) of the Act in view of the following:
- (a) pursuant to sections 16(2)(a) and 16(3)(a) of the Act, at the date of filing of the application, the Mark was confusing with at least one of the POM Registered Marks, which had been previously used in Canada by the Opponent;
 - (b) pursuant to sections 16(2)(b) and 16(3)(b) of the Act, at the date of filing of the application, the Mark was confusing with at least one of the POM Registered Marks in respect of which applications for registration had been previously filed

in Canada by the Opponent, or with the Opponent's trade-marks listed in the attached Schedule A (hereinafter the POM Pending Marks), in respect of which applications for registration had been previously filed in Canada either by the Opponent itself through Boulangerie Pom Limitée, or through the Opponent's predecessor in title PomWonderful LLC (PomWonderful). I shall mention at this point of my decision that the Registrar recorded on November 27, 2009, an update of ownership of the "POM" trade-marks that formed part of the Canadian trade-mark portfolio of PomWonderful, which were assigned by PomWonderful to the Opponent; and

- (c) pursuant to sections 16(2)(c) and 16(3)(c) of the Act, at the date of filing of the application, the Mark was confusing with the Opponent's trade-names POM, Boulangerie POM Limited, Boulangerie POM Limitée, and POM WONDERFUL that had been previously used in Canada by the Opponent.

[7] In support of its opposition, the Opponent filed the affidavit of Jean-Pierre Galardo, the Director of Marketing of the Opponent, sworn January 20, 2010. In support of its application, the Applicant filed the affidavits of Rash Nagar, who is the named applicant and the Managing Director of the prior listed applicant Pomepure Ltd., sworn May 28, 2010; Simone Ndiaye, paralegal with the firm representing the Applicant in the instant proceeding, sworn April 12, 2010; and Emilie Bureau, also a paralegal with the firm representing the Applicant, sworn May 28, 2010.

[8] Only the Opponent filed a written argument and was represented by counsel at an oral hearing as the Applicant's representative advised the Registrar that:

[...] the [A]pplicant has exhausted its resources allocated to this matter, will not file written arguments and will not request an oral hearing [...].

The [A]pplicant still believes that [the Mark] is not confusing with the Opponent's marks and wishes to rely upon the fair judgment of the Board.

[9] I shall mention at this point of my decision that the Opponent's written argument contains various inaccuracies. To name a few, contrary to what is stated in the Opponent's written argument, none of the pleaded grounds of opposition alleges non-distinctiveness of the Mark

pursuant to section 38(2)(d) of the Act. Also contrary to what is stated in the Opponent's written argument, the section 12(1)(d) ground of opposition does not allege confusion with the Opponent's trade-mark POM WONDERFUL that is the subject of registration TMA774,041, which registration has moreover not been introduced into evidence. I am precluded from considering grounds of opposition that have not been raised by the Opponent [see *Imperial Developments Ltd v Imperial Oil Limited* (1984), 79 CPR (2d) (FCTD)].

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[10] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidentiary 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); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

[11] Applying these principles to the instant case, the sections 30(a) and 30(i) grounds of opposition and non-registrability ground of opposition based on section 12(1)(b) of the Act can be summarily dismissed as follows:

- the section 30(a) ground of opposition, as pleaded, does not raise a proper ground of opposition in that the Opponent has not pleaded any material facts in respect thereof. I further note that the Opponent made no representation with respect to this particular ground of opposition either in its written argument or at the hearing;
- the section 30(i) ground of opposition, as pleaded, does not raise a proper ground of opposition. The mere fact that the Applicant may have been aware of the existence of the POM trade-mark(s) of the Opponent does not preclude it from making the statement in its application required by section 30(i) of the Act. Even if the ground had been properly pleaded, where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional circumstances 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 CPR (2d) 152 (TMOB)]. There is no such evidence in the instant case; and

- the section 12(1)(b) ground of opposition, as pleaded, does not raise a proper ground of opposition in that the Opponent has not pleaded any material facts in respect thereof. I further note that the Opponent made no representation with respect to this particular ground of opposition either in its written argument or at the hearing.

[12] I shall now turn to the remaining grounds of opposition.

Section 12(1)(d) ground of opposition

[13] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of section 12(1)(d) of the Act in that it is confusing with each of the POM Registered Marks. Unless indicated otherwise, I will focus my analysis on the Opponent's registration No. TMDA049765 for the word mark POM, which presents the Opponent's strongest case. If the Opponent is not successful with this cited registration, it would not achieve a more favourable result with the other registrations.

[14] I have exercised the Registrar's discretion to confirm that this registration is in good standing as of today's date, which date is the material date to assess a section 12(1)(d) ground of opposition [see *Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[15] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's word mark POM.

[16] 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.

[17] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at 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 the trade-marks have been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered, and are not necessarily attributed 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); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion].

6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[18] The Applicant’s Mark and the Opponent’s word mark POM are inherently distinctive, although less so in the case of the Mark given the suggestive character of the prefix “POME” and the descriptive character of the suffix “PURE” in the context of the Wares, especially the Applicant’s fruit juices and beverages. Indeed, the Mark can fairly be considered evocative of beverages made from pure pomegranate or apple (which translates into French as “pomme”) juice. The design feature of the Mark does little to increase its inherent distinctiveness since the fanciful script and the font employed are intrinsic with the word portion forming the essential part of the Mark [see *Canadian Jewish Review Ltd v The Registrar of Trade Marks* (1961), 37 CPR 89 (Ex C)].

[19] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. However, there is no evidence that the Applicant’s proposed use Mark has been used in Canada pursuant to section 4 of the Act or that it has become known to any extent whatsoever in Canada as per my review below of the Nagar affidavit.

[20] Mr. Nagar first briefly goes over his qualifications and experience as a corporate branding and packaging designer in the United Kingdom. Mr. Nagar states that because of his background and extensive experience of over 40 years of practising his profession, he fully

“understand[s] and object[s] to the Opponent’s opposition to the [Applicant’s application for the Mark], which [he] consider[s] in no way confusing or misleading by consumers in the global market place” [paragraphs 2 and 3 of his affidavit]. I am not prepared to accord weight to this latter statement of Mr. Nagar. First, Mr. Nagar cannot properly be qualified as an expert in this proceeding. Indeed, it seems to me that an expert qualification necessarily includes independence from the parties on the outcome of the case [see *Black Entertainment Television, Inc v CTV Limited* (2008), 66 CPR (4th) 212 (TMOB)]. Second, the test for confusion involves questions of fact and law to be determined by the Registrar.

[21] Mr. Nagar then turns to the Applicant’s use of the Mark. He states that the Applicant was one of the first companies to introduce 100% pure pomegranate juice not made from concentrate and free from any additives. He attaches to this effect as Exhibit RN-1 extracts from the Applicant’s website showing a bottle of pure pomegranate juice on which is prominently displayed the Mark [paragraph 6 of his affidavit]. He further attaches as Exhibits RN-2 pictures of two bottles of pure pomegranate juice and of a label displaying the Mark [paragraph 7 of his affidavit].

[22] Mr. Nagar states that products used in association with the Mark were launched in 2006 in the United Kingdom and have been “stocked since then in the countries’ major supermarkets, namely, MORRISON, CO-OP, WAITROSE and SAINSBURY’S” [paragraph 5 of his affidavit]. More particularly, he states that POMEPURE products used in association with the Mark are currently distributed in the following countries: Brunei, Greece, Hong Kong, Indonesia, Italy, Japan, Malaysia, Philippines, Singapore, Sweden, Switzerland, Thailand, the U.K., the U.S.A., and Vietnam [paragraph 8 of his affidavit]. He further states that currently, products used in association with the Mark are also available online via the Applicant’s website *www.pomepure.com* and have catered for delivery in the U.K., Europe, U.S.A. and Asia. [paragraph 10 of his affidavit; Exhibit RN-3]. Upon review of Exhibit RN-3, I note that it apparently refers to the Applicant’s pomegranate juice and fruit beverages only.

[23] Mr. Nagar provides a list of the countries of the world in which the Mark is registered [paragraph 11 of his affidavit] as well as a list of the countries in which applications for registration of the Mark have been filed [paragraph 12 of his affidavit]. I shall mention at this

point of my analysis that the fact that the Mark is registered in foreign jurisdictions is not binding upon the Registrar. It is worth referring to the following observation from this Board in *Quantum Instruments Inc v Elinca SA* (1995), 60 CPR (3d) 264:

As yet a further surrounding circumstance in respect of the issue of confusion, the applicant submitted evidence of registrations obtained by both parties in Great Britain and in the United States of America for the trade-marks QUANTA and QUANTUM. However as noted ... in *Re Haw Par...*, little can be drawn from the fact that the trade-marks at issue coexist in other jurisdictions ... the Registrar must base [the] decision on Canadian standards, having regard to the situation in Canada. Further, in *Sun-Maid* ... [the court] pointed out that ‘no significance can be attached to failure to oppose or object to registrations in other jurisdictions since such actions, of necessity, have their basis entirely in foreign law and procedure.’ Additionally, while the applicant has relied upon evidence of coexistence of the trade-marks at issue on the registers in Great Britain and the United States of America, no evidence has been adduced of the coexistence of the trade-marks at issue in the market-place in either of these countries... Accordingly, I do not consider this evidence to be persuasive in this proceeding.

[24] As in the *Quantum* case, no evidence has been adduced of the coexistence of the trade-marks at issue in the marketplace, be it in Canada or in any other country.

[25] Mr. Nagar states that products used in association with the Mark “are not stocked side by side with bread and [that he does not] see consumers getting confused in any way” [paragraph 9 of his affidavit]. He further states that “[p]roducts used in association with [the Mark] are aimed at consumers looking for premium high quality products and personal services” [paragraph 13 of his affidavit] and that “[t]he POMEPURE brand is distinctive and our consumers as well as potential consumers are able to differentiate easily those products especially when compared with different products. Based on the significant global awareness of the [Mark], [he] believe[s] that [the Mark] is distinctive and should be entitled to registration in Canada” [paragraphs 14 and 15 of his affidavit]. Again, I am not prepared to accord weight to these latter statements of opinion of Mr. Nagar.

[26] Turning to the Opponent’s word mark POM, the Galardo affidavit establishes the following.

[27] Mr. Galardo first briefly goes over the corporate structure of the Opponent. He explains the business relationship existing between Multi-Marques Inc., Boulangerie Pom Limitée and Canada Bread Company Limited and provides details as to the license agreement entered into

between Boulangerie Pom Limited, as owner of the POM Registered Marks, and its parent company Multi-Marques Inc. [paragraphs 1 to 9 incl. of his affidavit; and Exhibit JPG-1 consisting of a printout obtained from the Quebec register of enterprises (“*Le Registraire des Entreprises Système CIDREQ*”) pertaining to Boulangerie Pom Limited]. I do not wish to go over each and every statement of Mr. Galardo pertaining to the use under license of the POM Registered Marks by Multi-Marques Inc. and control over such license by Boulangerie Pom Limitée. Suffice it to say that I am satisfied that the licensed use of the POM Registered Marks by Multi-Marques Inc. accrues to Boulangerie Pom Limitée pursuant to section 50(1) of the Act. For the ease of discussion, I will refer to use of the POM Registered Marks by Multi-Marques Inc. as evidenced by Mr. Galardo, as use by the Opponent.

[28] Mr. Galardo states that the Opponent has extensively used the POM Registered Marks in Canada for more than 75 years. More particularly, he states that the POM Registered Marks have been used by the Opponent in association with the wares covered by the above-described registration Nos. TMA469,001; UCA40516; TMDA049765; and TMA335,814 since at least as early as the dates of first use indicated in these registrations [paragraph 10 of his affidavit]. My subsequent use of the terms “Registered Wares” reflects Mr. Galardo’s collective reference to the wares covered by these registrations.

[29] In support of his assertions of use of the POM Registered Marks, Mr. Galardo attaches the following exhibits:

- Exhibit JPG-2 that appears to consist of photocopies of product packages, presumably plastic bags, which would explain the poor quality of their reproduction [paragraph 11 of his affidavit]. The packages are for bread-type products (e.g. milk bread, buns, bagels, hamburger buns, pita breads, dinner rolls, etc.) and do not display all of the Registered Marks. In fact, the specimens mostly display one or both of the two design marks shown hereafter. However, I accept the use of these design marks as use of the word mark POM [see *Canada Bread Company, Limited v Beverages Brands (UK) Limited*, 2012 TMOB 11 (CanLII) (*Pomtini*)]:



- Exhibit JPG-3 that consists of invoices dating from 1997 to 2009, relating to the sales of the Registered Wares in association with the POM Registered Marks [paragraph 12 of his affidavit].

[30] Mr. Galardo states that sales of the Registered Wares in association with the POM Registered Marks have constantly increased over the years since 1930. He provides a yearly breakdown of the sales figures from 1999 to September 2009, the total approximate value of which exceeded \$796 million. However, no breakdown for each of the Registered Wares is provided [paragraph 15 of his affidavit].

[31] Mr. Galardo states that the Registered Wares associated with the POM Registered Marks are distributed and sold in Canada in convenience stores, grocery stores and supermarkets to Canadian consumers. They are also distributed and sold in the food services sector including in restaurants, bars, fast food counters, cafeterias, canteens, hospitals, daycares, schools and other locations [paragraph 16 of his affidavit].

[32] Mr. Galardo further states that the Opponent invests approximately \$3 million annually on marketing and promoting the POM Registered Marks. Such advertising and promotion is conducted on various media platforms across Canada such as on radio and television stations, as well as print and virtual media [paragraphs 13, 14 and 22 to 28 of his affidavit]. Mr. Galardo provides evidence of promotion through sweepstakes organized in collaboration with television stations and of the promotion at the Montreal Alouettes football games and the Montreal Canadiens hockey games at the Bell Centre. He also provides copies of promotional and advertising printed materials and of pages of the Opponent's website [Exhibits JPG-4; JPG-5; JPG-8; and JPG-9 attached to his affidavit].

[33] Mr. Galardo concludes his affidavit making statements of opinion as to the distinctiveness of the Mark and the merit of the instant opposition proceeding [paragraphs 29 to 32 of his affidavit]. As for Mr. Nagar's personal statements of opinion, I am not prepared to accord weight to these statements of opinion of Mr. Galardo.

[34] In view of the foregoing, the overall consideration of the inherent distinctiveness of the parties' marks and the extent to which they have become known favours the Opponent.

6(5)(b) – the length of time the trade-marks have been in use

[35] In view of my comments above, this factor also favours the Opponent. I shall mention however that while the Opponent's evidence satisfactorily establishes that the use of its word mark POM predates the use of the Mark, such evidence is insufficient to establish continuous use of the Opponent's mark since the 1930s.

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

[36] Turning to the nature of the wares and the nature of the trade, I must compare the Applicant's statement of Wares with the statement of wares in the Opponent's registration [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[37] The Opponent contends that the parties' wares, businesses and trades are essentially the same, namely food products, fruit juices and alimentary products. More particularly, the Opponent contends that it has demonstrated use in Canada of the POM Registered Marks in association with food products, beverages and alimentary products. I disagree.

[38] First, contrary to the Opponent's contention, there is no evidence of use of any of the POM Registered Marks in association with beverages. While Mr. Galardo states in his affidavit that the Opponent intends to use the trade-mark POM in association with a large variety of other food and alimentary related products including fruit juices and beverages, as evidenced by the filing of the Opponent's pending application No. 1,122,704 for the trade-mark POM based on proposed use of the mark in association with a very diverse range of wares including alcoholic and non-alcoholic beverages, and that such intention has since come to fruition, at least in part, following the acquisition of the "POM" trade-marks that formed part of the Canadian trade-mark portfolio of PomWonderful [paragraphs 19 to 21 of his affidavit], the evidence of use of record is restricted to the Opponent's bakery products only. In this regard, I wish to address at this point of

my decision, the argument made by the Opponent concerning the Ndiaye affidavit that was filed as part of the Applicant's evidence. The Ndiaye affidavit apparently purports to file a portion of the file history of an opposition proceeding brought by the Opponent against trade-mark application No. 1,118,804 for POM WONDERFUL originally filed by PomWonderful. More particularly, Ms. Ndiaye attaches to her affidavit as part of Exhibit SN-1, a copy of an affidavit (excluding the exhibits) of Mr. Matthew Tupper, President and Chief Operating Officer of PomWonderful, sworn November 22, 2006. The Opponent contends that as it is now the owner of application No. 1,118,804, any reliance previously attempted to be made by the Applicant based on these materials is no longer relevant to the Applicant. The Opponent submits that the fact that it is now the owner of the trade-mark POM WONDERFUL could only be regarded as being to the benefit to and favorable to the Opponent, to the detriment of the Applicant. The Opponent further submits that the Tupper affidavit evidences use of the trade-mark POM WONDERFUL in Canada. I disagree. Hearsay issues aside, suffice it to say that the wares covered by application No. 1,118,804, namely fresh fruits, except apples, differ in their exact nature from the Applicant's Wares and that the exhibits referred to by Mr. Tupper in his affidavit are not included in the copy that was filed by Ms. Ndiaye so that the copy of affidavit so produced does not show how the trade-mark POM WONDERFUL was associated with the wares at the time of transfer of the wares in Canada pursuant to section 4 of the Act. I will revert to the Opponent's pending application No. 1,122,704 for the trade-mark POM as well as the "POM" trade-mark portfolio of PomWonderful acquired by the Opponent, which form part of the Opponent's POM Pending Marks, later on in my decision when assessing the section 16 grounds of opposition.

[39] Second, I do not consider the Applicant's applied for wares described as alcoholic beverages to be part of the same industry as the Opponent's bakery products [see *Pomtini, supra*, at para 76]. Third, while I acknowledge that the Applicant's applied for wares described as non-alcoholic drinks and the Opponent's bakery products could normally be found in the same outlets (as moreover evidenced by the Applicant itself through the affidavit of Ms. Bureau, who has attached to her affidavit as Exhibit EB-4 photographs of the juice and bread aisles of a Loblaws grocery store in Montreal, Quebec, that she visited on March 26, 2010), this is not sufficient to lead to a finding that the parties' wares are similar [see *Clorox Co v Sears Canada Inc* (1992), 41

CPR (3d) 483 (FCTD) and *Tradition Fine Foods Ltd v Groupe Tradition'l Inc* (2006), 51 CPR (4th) 342 (FC)]. As stated by the Federal Court in *Clorox*, at page 490:

One only needs to look at the thousands of different foods, meats, condiments, confectioneries, cereals and what-not, found in some supermarkets to be wary of giving too much weight in some circumstances to the “same general class” test.

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

[40] The Opponent contends that the Mark is identical in all respects to the Opponent’s word mark POM. I disagree. While the prefix “POME” in the first part of the Mark is identical in sound to the Opponent’s word mark POM and is the most important for the purposes of distinction, there are significant differences between the marks in appearance and in the ideas suggested by them. The prefix “POME” combined with the suffix “PURE” in the context of the Applicant’s fruit juices and beverages calls to mind the word “pomegranate” or the French word “pomme”, whereas the word “POM” in the context of the Opponent’s wares is a coined word, even though it may sound like the French word “pomme”.

[41] This brings me to consider as an additional surrounding circumstance, the state of the register evidence submitted by the Applicant through the Bureau affidavit.

State of the register evidence

[42] State of the register evidence is introduced to show the commonality or distinctiveness of a mark or portion of a mark in relation to the register as a whole. Evidence of the state of the register is only relevant insofar as inferences may be made on it concerning the state of the marketplace, and inferences about the state of the marketplace can only be drawn when a significant number of pertinent registrations are located [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

[43] Ms. Bureau states that she personally accessed the website *www.trademark.com* and conducted a search using the Nice classes 5, 29, 30, 31, 32 and 33 in association with the active

Canadian trade-marks containing the term “POM”. She attaches as Exhibit EB-2 to her affidavit, the report produced by *www.trademark.com* listing the details of some 197 trade-mark applications or registrations, without any further explanation. I have no intention of undertaking a thorough review of this report in order to try to find, somewhere among the 147 pages or so which make up this report, the supposed relevant trade-marks. For instance, I note that many of the trade-marks revealed by the search report include the English word “pomegranate” or the French word “pomme” standing for apple or potato (“pomme de terre”) as an element of the mark or a descriptive word featured on the label for the wares associated thereto, as opposed to the prefix “POM” *per se*. Also included in the search report are the Opponent’s POM Registered Marks and POM Pending Marks, which no more assist the Applicant’s case. The onus is on the Applicant to substantiate its contentions in this regard [see *Novalab Inc v Lidl Stiftung & Co Kg* (2008), 73 CPR (4th) 470 (TMOB)].

[44] That being said, I note that the Applicant has listed in its counter statement examples of marks “currently pending or registered at the Canadian Trade-mark Office” that include the word “POM”, which it considers pertinent and which have further been revealed by Ms. Bureau’s search. More particularly, I note that numerous trade-marks incorporating the prefix “POM” have been registered or allowed for registration, including:

- POM DE VIE (TMA572,346) for spirits and liqueurs, which further includes a disclaimer of the right to the exclusive use of the word “POM” apart from the trade-mark;
- POM POM TOMS (application No. 1,406,073) for tomatoes;
- POMAGNE (TMA177,560) for cider;
- POME GRANDE (TMA691,908) for pomegranate juice;
- POMEGRAN & POMEGRAN PLUS (TMA736,466 & TMA728,700) for breakfast cereals and toaster pastries;
- POMI’ (TMA487,616) for sauces;
- POMITO (TMA173,678) for fruit juices and other food products;
- POMMALEFUN & Design (TMA574,423) for fruit juices and other food products;
- POMMERY (TMA203,991) for mustard;

- POMMERY (TMA281,357), POMMERY & Design (TMA302,581) and POMMERY & GRENO Design (TMA130,197) for wines;
- POMMONDE (TMA687,980) for potatoes and products made of potatoes;
- POMMUM (application No. 1,318,373) for spirits and ciders;
- POMOCOCO (TMA253,148) for cakes;
- POMONA (TMA761,102) for cider;
- POM'OR TRADITION (TMA556,557) for cider;
- POMPEIAN (TMA343,924) for olive oil;
- POM-POM (UCA036133) for fresh citrus fruits;
- POMPOMS (TMA256,352) for frozen fried potatoes;
- POMTINI (TMA693,310) for alcoholic fruit drinks; etc.

[45] While none of the above registrations or allowed applications covers bakery products such as the ones marketed by the Opponent under the word mark POM, they do cover a variety of products including alcoholic and non-alcoholic beverages, which clearly overlap with the Wares covered by the Applicant's application. Given the number of registered marks and allowed applications located by Ms. Bureau, it can fairly be concluded that at least some of these marks are in use. It can therefore also be concluded that consumers would be accustomed to some extent to seeing marks made up of the prefix "POM" in the marketplace for alcoholic and/or non-alcoholic beverages. Accordingly, those consumers would be likely to distinguish such marks by focusing on their other components.

Conclusion re likelihood of confusion

[46] Having considered all the surrounding circumstances, I find that there is not a reasonable likelihood of confusion between the parties' marks. While I acknowledge that the Opponent's word mark POM as associated with its bakery products may have achieved a significant reputation in Canada, there is little similarity in the exact nature of the parties' wares. The differences existing between the parties' wares combined with the ones existing between the parties' marks in appearance and ideas suggested by them shift the balance of probabilities in favour of the Applicant, especially in view of the fairly common adoption in the context of

alcoholic and/or non-alcoholic beverages of trade-marks that are made up of the prefix “POM”, which is evocative of beverages made from apple or pomegranate juice.

[47] In view of the foregoing, I conclude that the Applicant has satisfied its burden to show that there is not a reasonable likelihood of confusion between the marks in issue. Accordingly, the section 12(1)(d) ground of opposition is dismissed.

Non-entitlement grounds of opposition

[48] As indicated above, the Opponent has pleaded various grounds of opposition pursuant to section 16 of the Act. I will assess them in turn.

Sections 16(2)(a) and 16(3)(a) grounds

[49] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark having regard to the provisions of sections 16(2)(a) and 16(3)(a) of the Act in that at the date of filing of the Applicant’s application, the Mark was confusing with the Opponent’s POM Registered Marks, which had been previously used in Canada by the Opponent.

[50] An opponent meets its evidentiary burden with respect to a section 16(2)(a) or (3)(a) ground if it shows that as of the date of filing of the Applicant’s application, its trade-mark had been previously used in Canada and had not been abandoned as of the date of advertisement of the Applicant’s application [section 16(5) of the Act]. As per my review of the Galardo affidavit above, the Opponent has met its evidentiary burden with respect to use of the word mark POM in association with bakery products.

[51] The difference in relevant dates does not substantially affect my analysis above under the section 12(1)(d) ground of opposition. While the Bureau affidavit is dated after the material date to be considered under the sections 16(2)(a) and 16(3)(a) grounds of opposition, the vast majority of the registrations and allowed applications discussed above (including the ten or so registrations and allowed applications in association with alcoholic and non-alcoholic beverages) were issued prior to the date of filing of the Applicant’s application. That being so, my findings made above concerning the state of the register evidence remain applicable to the non-

entitlement grounds of opposition. Accordingly, the sections 16(2)(a) and 16(3)(a) grounds of opposition are dismissed.

Sections 16(2)(b) and 16(3)(b) grounds

[52] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark having regard to the provisions of sections 16(2)(b) and 16(3)(b) of the Act in that at the date of filing of the Applicant's application, the Mark was confusing with the Opponent's POM Registered Marks and POM Pending Marks in respect of which applications for registration had been previously filed in Canada by the Opponent.

[53] An opponent meets its evidentiary burden with respect to a section 16(2)(b) or (3)(b) ground if it shows that its application was filed prior to the date of filing of the Applicant's application and was pending when the Applicant's application was advertised [section 16(4) of the Act]. As the Opponent's POM Registered Marks were not pending when the Applicant's application was advertised, the Opponent has failed to satisfy its evidentiary burden in respect thereof. Accordingly, the sections 16(2)(b) and 16(3)(b) grounds of opposition are dismissed with respect to the Opponent's POM Registered Marks.

[54] Turning to the Opponent's POM Pending Marks, the Applicant has met its evidentiary burden at least as far as the Opponent's trade-marks POM and POM & Design (shown below) covered by application Nos. 1,122,704 and 1,278,747 respectively are concerned. Unless indicated otherwise, I will focus my analysis on these two trade-marks of the Opponent, which present the Opponent's strongest cases. If the Opponent is not successful with these cited applications, it would not achieve a more favourable result with the other applications:



[55] As indicated above, the proposed used application No. 1,122,704 covers a very diverse range of wares. I will focus my analysis on the most pertinent wares identified as:

Bières, jus de fruits et boissons aux fruits, jus de légumes, jus de tomate, boissons aromatisées, boissons gazeuses, boissons à base de lactosérum, punch aux fruits, cristaux pour punch aux fruits, thé glacé, nectars, boissons gazeuses, limonades, boissons à base de lait, eaux embouteillées, eaux minérales, eaux aromatisées, eaux gazeuses, liqueurs douces et tous autres produits compris à la classe 32; Boissons alcooliques, nommément: vins, vins de fruits, saké, coolers, boissons aromatisées, spiritueux, liqueurs, sirops et autres préparations pour faire des boissons et tous autres produits compris à la classe 33.

[56] The application No. 1,278,747 is also based on proposed use in association with a lengthy list of wares. I will focus my analysis on the most pertinent wares identified as:

Nutritionally fortified beverages, namely, energy drinks containing vitamin and mineral supplements; topping syrup, namely, pomegranate syrup; iced tea and non-alcoholic tea-based beverages with fruit flavoring; non-alcoholic fruit extracts used in the preparation of beverages; preparation for making fruit drinks; non-alcoholic fruit flavored beverages; non-alcoholic beverages containing fruit juices; smoothies; bottled water; non-alcoholic tea flavored fruit juice beverages; non-alcoholic low calorie fruit flavored beverages; non-alcoholic low calorie fruit juice drinks; non-alcoholic low calories tea flavored beverages.

[57] Contrary to the situation prevailing under the section 12(1)(d) ground of opposition, the parties' wares are either identical or overlapping. It is fair to assume that their associated channels of trade would be the same. Accordingly, the section 6(5)(c) and (d) factors unequivocally favour the Opponent.

[58] However, contrary to the situation prevailing under the section 12(1)(d) ground of opposition, the overall consideration of the section 6(5)(a) factor does not favour the Opponent. Indeed, while the trade-mark POM is inherently distinctive in the context of the Opponent's bakery products and may have achieved a significant reputation in Canada in association with such products, the situation differs in the context of the Opponent's proposed marks covered by application Nos. 1,122,704 and 1,278,747. As per my comments above under the section 12(1)(d) ground of opposition, the word "POM" in the context of the Opponent's applied for wares can fairly be considered evocative of beverages made from apple or pomegranate juice. As such, I assess the inherent distinctiveness of the Opponent's marks POM and POM & Design covered by application Nos. 1,122,704 and 1,278,747 as quite low. As there is no evidence that the Opponent's proposed marks have been used and become known in Canada in association with their associated applied for wares, the strength of the Opponent's marks remains weak, as that of the Applicant's Mark.

[59] Keeping in mind the principle that when marks are weak marks, small differences may suffice to distinguish one mark from the other [see *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD)] and my comments above concerning the state of the register evidence introduced through the Bureau affidavit, I find that the differences existing between the Applicant's Mark and each of the Opponent's POM and POM & Design marks should be sufficient to preclude a likelihood of confusion. While the Mark puts emphasis on the prefix "POME", such prefix is spelled differently from the word "POM" and is further combined with the suffix "PURE". As stated by Mr. Justice Décarie in *Dion, supra*:

The Registrar must therefore be reasonably satisfied that, on a balance of probabilities, the registration is unlikely to create confusion; he need not be satisfied beyond doubt that confusion is unlikely. Should the "beyond doubt" standard be applied, applicants would, in most cases, face an insurmountable burden because certainty in matters of likelihood of confusion is a rare commodity. At best, it is only where the probabilities are equal that a form of doubt may be said to arise, which is to be resolved in favor of the opponent. But the concept of doubt is a treacherous and confusing one in civil proceedings and a Registrar should avoid resorting to it.

[60] Accordingly, the sections 16(2)(b) and 16(3)(b) grounds of opposition are dismissed with respect to the Opponent's POM Pending Marks.

Sections 16(2)(c) and 16(3)(c) grounds

[61] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark having regard to the provisions of sections 16(2)(c) and 16(3)(c) of the Act in that at the date of filing of the Applicant's application, the Mark was confusing with the Opponent's trade-names POM, Boulangerie POM Limited, Boulangerie POM Limitée, and POM WONDERFUL that had been previously used in Canada by the Opponent.

[62] An opponent meets its evidentiary burden with respect to a section 16(2)(c) or (3)(c) ground if it shows that as of the date of filing of the Applicant's application, its trade-name had been previously used in Canada and had not been abandoned as of the date of advertisement of the Applicant's application [section 16(5) of the Act]. As per my review of the Galardo affidavit above, the Opponent's evidence fails to establish use of any trade-name that includes the word "POM". As such, the Opponent has failed to satisfy its evidentiary burden. Accordingly, the sections 16(2)(c) and (3)(c) grounds of opposition are dismissed.

Section 30(d) ground of opposition

[63] The Opponent has pleaded that the application does not comply with section 30(d) of the Act in that the Applicant was not using and has not used the Mark at all relevant dates in the United Kingdom in association with the Wares as set out in the application.

[64] To the extent that the Applicant has easier access to the facts, the burden of proof on the Opponent in regard to the ground of opposition based on the failure to respect section 30(d) is less onerous [see *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. Also, the Opponent may rely upon the Applicant's evidence provided however that such evidence is clearly inconsistent with the Applicant's claim [see *York Barbell Holdings Ltd v ICON Health & Fitness, Inc* (2001), 13 CPR (4th) 156 (TMOB)].

[65] While the Applicant was under no obligation to positively evidence use of the Mark in the United Kingdom as claimed in its application, the Applicant elected to file evidence. As per my review of the Nagar affidavit above, the Applicant's evidence of use of the Mark is restricted to its pomegranate juice and fruit beverages only. When considering the Nagar affidavit in its entirety, I find that the absence of any allegations directed to the use of the Mark in association with the remaining wares described in the Applicant's application as: "Fruit flavoured teas, ices, treacle; Non-alcoholic drinks namely, mineral and aerated waters, fruit juice concentrate, nectars, energy drinks; Alcoholic beverages namely, cocktails, vodka, gin, champagne, sparking and nonsparking [sic] wine" combined with the absence of specimens showing use of the Mark in association with such wares raises at least some doubt as to the correctness of the registration and use abroad basis claimed in the Applicant's application. Thus, I find that the Opponent has satisfied the light evidentiary burden upon it.

[66] In view of the foregoing, I conclude that the section 30(d) ground of opposition succeeds partially. It is dismissed with respect to the wares described as "fruit drinks and fruit juices" on the basis that the Opponent has not met its initial evidentiary burden. It succeeds with respect to the wares described as "Fruit flavoured teas, ices, treacle; Non-alcoholic drinks namely, mineral and aerated waters, fruit juice concentrate, nectars, energy drinks; Alcoholic beverages namely, cocktails, vodka, gin, champagne, sparking and nonsparking [sic] wine" on the basis that the Applicant has not met its burden. That being said, the application can still proceed on the basis of







proposed use of the Mark in association with all the Wares [see *Reitmans (Canada) Ltd v Thymes Ltd*, 2011 TMOB 100 at para 37; and *Canada Dry Mott's Inc v Krush Global Ltd*, 2011 TMOB 86 at para 17].

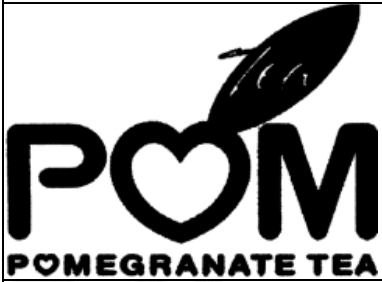




Disposition


[67] In view of the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I reject all grounds of opposition except the ground of opposition based upon non-conformity with section 30(d) of the Act, which I accept in part. Accordingly, the statement of wares applied for registration on the basis of use of the Mark in the United Kingdom is restricted to the following wares: “Fruit drinks and fruit juices”, whereas the statement of wares applied for on the basis of proposed use of the Mark in Canada remains as follows: “Fruit flavoured teas, ices, treacle; Non-alcoholic drinks namely, mineral and aerated waters, fruit drinks and fruit juices, fruit juice concentrate, nectars, energy drinks; Alcoholic beverages namely, cocktails, vodka, gin, champagne, sparking and nonsparking [sic] wine”.

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

Schedule "A"
The POM Pending Marks

TRADE-MARK	APPLICATION NO.	FILING DATE
	1,037,297	1999-11-23
	1,037,299	1999-11-23
	1,038,744	1999-12-06
	1,037,298	1999-11-23
POM'S SMART	1,282,503	2005-12-09
POM	1,122,704	2001-11-23
POM WONDERFUL	1,118,804	2001-10-18
	1,176,267	2003-04-25
POM SPORT	1,261,684	2005-06-17
POMx	1,275,312	2005-10-11
	1,275,319	2005-10-11

TRADE-MARK	APPLICATION NO.	FILING DATE
	1,278,745	2005-11-07
	1,278,747	2005-11-07
	1,305,283	2006-06-13
POM	1,305,286	2006-06-13
POM SHOTS	1,306,694	2006-06-23
POMx SHOTS	1,306,695	2006-06-23
POMx	1,306,696	2006-06-23
	1,306,821	2006-06-23
POM	1,320,694	2006-10-18
POMx	1,320,695	2006-10-18
	1,320,696	2006-10-18
POWERED BY POMx	1,320,697	2006-10-18
POM BREW	1,320,700	2006-10-18
POM COFFEE	1,320,701	2006-10-18
THE ANTIOXIDANT POWER OF POM TEA	1,321,625	2006-10-25

TRADE-MARK	APPLICATION NO.	FILING DATE
	1,329,523	2006-12-2233