



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

Citation: 2012 TMOB 26
Date of Decision: 2012-02-14

**IN THE MATTER OF AN OPPOSITION
by Roca Sanitario, S.A. to application
No. 1,251,967 for the trade-mark
PORCELLANA DI ROCCA & Design
filed by Porcellana Di Rocca S.p.A.**

File Record

[1] On March 24, 2005 Porcellana Di Rocca S.p.A. filed application No. 1,251,967 to register the trade-mark PORCELLANA DI ROCCA & Design as illustrated hereinafter:



The words PORCELLANA DI ROCCA are white, the rectangular background is grey and the vertical element shown between the words PORCELLANA and DI is orange. Those colours are claimed as features of the Mark. The Applicant advised the Registrar that the translation into English of the Mark is “porcelain of Rocca”.

[2] Subsequent to an office action a revised application was filed. During the course of the opposition the Applicant submitted a further revised application. I shall hereinafter only refer to the further revised application dated June 12, 2008, unless otherwise indicated, as the Application.

[3] The Application is based on use in Canada since at least as early as June 4, 2004 in association with stoneware, ceramic and marble tiles for floors, building walls and ceilings made in Italy (the Wares). The Applicant claims a priority filing date under s. 34 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) on the ground that an application for registration of the same or substantially the same trade-mark was filed in or for Italy by the Applicant on March 16, 2005.

[4] The application was advertised on September 27, 2006 in the *Trade-marks Journal* for opposition purposes. Roca Sanitario, S.A. (the Opponent) filed a statement of opposition on November 27, 2006 which was forwarded by the Registrar on December 7, 2006 to the Opponent.

[5] The Applicant denied all grounds of opposition in a counter statement filed on April 10, 2007. On October 4, 2009 the Opponent requested leave to amend its statement of opposition. By decision rendered on December 4, 2009 the Registrar denied such request.

[6] The Opponent filed as its evidence a certificate of authenticity of registration number TMA287,139 for the trade-mark ROCA & Design and the affidavit of Esteban Altarriba Sanpons while the Opponent filed the affidavits of Shannon Young, Elena Gravina and Luigi Bedeschi.

[7] Only the Applicant filed a written argument. Both parties requested an oral hearing. A hearing was first scheduled but subsequently postponed. After rescheduling the hearing the Registrar was informed by both parties that neither would be represented at the hearing. As such no hearing has been held.

The Grounds of Opposition

[8] The grounds of opposition pleaded by the Opponent can be summarized as follow:

1. The Application, be it on the basis of alleged use in Canada or on the basis of alleged registration and use abroad, does not satisfy the requirements of s. 30 of the Act in that:
 - a) The Applicant never used the Mark in association with the Wares in Canada;
 - b) The Applicant is not the owner of the alleged foreign registration;
 - c) At the filing date of the Application, the Mark was not in use in the country referred to in the Application;
 - d) The Mark was not duly registered in Italy and, prior to the advertisement of the Application, the Applicant did not furnish a copy of the alleged Italian trade-mark registration certified by the Ufficio Italiano Brevetti e Marchi;
 - e) The statement of wares referred to in the Application is wider than the statement of wares referred to in the alleged corresponding Italian trade-mark registration;
 - f) The trade-mark allegedly used is not the Mark;
 - g) Alternatively or cumulatively, the use of the Mark in association with the Wares has not been continuous;
 - h) It is falsely that the Applicant declared itself satisfied that it is entitled to use the Mark in Canada in view of the content of the present opposition, including the Applicant's knowledge of the Opponent's rights as herein alleged and the unlawfulness of said use, if any.
2. The Mark is not registrable pursuant to s. 12(1)(d) of the Act as it is confusing with the Opponent's registered trade-mark ROCA & Design, registration TMA287,139.
3. The Applicant is not entitled to the registration of the Mark pursuant to s. 16 of the Act, as to the basis of alleged use in Canada, in that:
 - a) At the date of real use and at any relevant time, the Mark was confusing with the Opponent's trade-mark ROCA which has been previously used or made known in Canada by the Opponent or its predecessors in title in association with building materials, the whole contrary to s. 16(1)(a) of the Act;
 - b) At the date of real use and at any relevant time, the Mark was confusing with the Opponent's trade-name ROCA which has been previously used in Canada by the Opponent or its predecessors in title in association with wares, services and business relating to building materials, the whole contrary to s. 16(1)(c) of the Act;
 - c) For the reasons previously mentioned, the Application does not comply with the requirements of s. 30 of the Act; the Mark has not been used as said and the Mark is not registrable or does not function as a trade-mark the whole contrary to the introductory paragraph of s. 16(1) of the Act.
4. The Applicant is not entitled to the registration of the Mark pursuant to s. 16 of the Act, as to the basis of alleged registration and use abroad, in that:

- a) At the date of filing of the Application and at any relevant time, the Mark was confusing with the Opponent's trade-mark ROCA which has been previously used or made known in Canada by the Opponent or its predecessors in title in association with building materials, the whole contrary to s. 16(2)(a) of the Act;
 - b) At the date of filing of the Application and at any relevant time, the Mark was confusing with the Opponent's trade-name ROCA which has been previously used in Canada by the Opponent or its predecessors in title in association with wares, services and business relating to building materials, the whole contrary to s. 16(2)(c) of the Act;
 - c) For the reasons previously mentioned, the Application does not comply with the requirements of s. 30 of the Act; the Mark has not been used or duly registered as said and the Mark is not registrable or does not function as a trade-mark the whole contrary to the introductory paragraph of s. 16(2) of the Act.
5. Pursuant to s. 38(2)(d), the Applicant's Mark is not distinctive of the Applicant's Wares nor can it be because:
- a) The Mark does not actually distinguish the wares or services in association with which the Mark is used or proposed to be used by the Applicant from the wares or services of others, including those of the Opponent nor is it adapted to distinguish them;
 - b) The Mark is used outside the scope of the licensed use provided for by s. 50 of the Act, including by Premier Floor Covering and Southampton Brick & Tile;
 - c) As a result of the transfer of the Mark, rights subsist in two or more persons, including Premier Floor Covering and Southampton Brick & Tile, to the use of trade-marks confusing with the Mark and those rights were exercised by those persons contrary to the provisions of s. 48(2) of the Act.

Legal Onus and Burden of Proof in Trade-marks Opposition Proceedings

[9] The legal onus is upon the Applicant to show that the Application complies with the provisions of the Act, but there is however an initial evidential 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. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd. et al 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.) and *Wangler Apparel Corp. v. The Timberland Company* [2005] F.C. 722].

Relevant dates

[10] The relevant date for the analysis of each ground of opposition varies depending on the ground of opposition to be assessed:

- Non-compliance with the requirements of s. 30 of the Act: the filing date of the Application (March 24, 2005);
- Registrability of the Mark under s. 12(1)(d) of the Act: the date of the Registrar's decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A.)]
- Entitlement to the registration of the Mark, where the application is based on use: the alleged date of first use (June 4, 2004) [see s. 16(1) of the Act];
- Distinctiveness of the Mark: the filing date of the statement of opposition (November 27, 2006) [see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

Grounds of Opposition summarily dismissed

[11] The Opponent has an initial evidential burden when alleging non-compliance with s. 30 of the Act. The Opponent has not filed any evidence to support any of its grounds of opposition based on the non-compliance to the requirements listed under s. 30. Moreover as it will appear from a detailed summary of the Applicant's evidence none of it can support any of those grounds of opposition. Consequently grounds of opposition 1a) to g) inclusive are dismissed since the Opponent failed to meet its initial burden.

[12] As for the ground of opposition pleaded under sub-paragraph 1(h), as drafted it is not a proper ground of opposition. Section 30(i) of the Act only requires that the Applicant declares itself satisfied that it is entitled to the registration of the Mark. Such a statement is included in the application. The allegation that the Applicant had knowledge of the existence of the Opponent's rights cannot form the basis of a ground of opposition under s. 30(i) of the Act. One may rely on s. 30(i) in specific cases such as where fraud by the Applicant is alleged [see *Sapodilla Co. Ltd. v. Bristol Myers Co.* (1974) 15 C.P.R.

(2d) 152 (T.M.O.B.)). There is no allegation of that nature in the statement of opposition or any evidence in the record to that effect.

[13] Under these circumstances, the first ground of opposition in its entirety is therefore dismissed.

[14] The Opponent has not adduced any evidence to support sub-paragraphs b) and c) of its fifth ground of opposition. They are also dismissed as the Opponent has not discharged its initial evidential burden.

The Opponent's evidence

[15] Mr. Sanpons has been a legal counsel within the Opponent's organization. He alleges that by reason of his title, duties and position he is generally familiar with the circumstances and events surrounding this matter, having access to all documents and information relevant thereto. However Mr. Sanpons does not state what information in his affidavit is to his personal knowledge and what has been provided to him and by whom. Moreover Mr. Sanpons does not state since when he has been legal counsel for the Opponent. Any ambiguities caused by these deficiencies shall be interpreted against the Opponent [see *Conde Nast Publications Inc. v. Union des éditions modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)].

[16] In its written argument the Applicant submits that the document adduced by the Opponent is not sworn to by Mr. Sanpons and therefore is not an affidavit. The document is entitled "Affidavit". It has the words "solemnly declare" before the paragraphs of his affidavit and it does have the following mention at the end of the document; "Solemnly declared before me in Barcelona, Spain". It is executed before Joseph M. Calmet, Honorary Consul. The Applicant relies on the provisions of s. 41 of the *Canada Evidence Act* to support its contention that the document is not an affidavit. If the Applicant wanted to attack the validity of the document as an affidavit on the basis that Mr. Calmet is not a person in authority to receive oath as per the provisions of s. 41 of the *Canada Evidence Act* it had the burden to do so. I have no evidence to prove that Mr. Calmet by his functions is not a person authorized by law to administer an oath. In the absence of any

evidence that would prove otherwise, I consider the document executed before Mr. Calmet to be a valid affidavit.

[17] Mr. Sanpons alleges that the Opponent has been in the business of manufacturing, selling and distributing building materials such as flat paving stones, mosaic paving tiles, mosaics, floor-tiles, tiles and other building materials in connection with mosaics (the Roca Products).

[18] Mr. Sanpons asserts that the Roca Products have been sold in Canada and around the world by the Opponent or through licensees under the trade-mark ROCA since at least 1996. He states that today the Roca Products are sold in more than 70 countries around the world, including Canada and the United States.

[19] He alleges that the Opponent has secured registration of the trade-mark ROCA in Canada and in fact a certificate of authenticity for registration TMA287,139 for the trade-mark ROCA & Design as hereinafter illustrated has been filed:



It covers: flat paving stones, mosaic paving tiles, mosaics, floor-tiles and tiles.

[20] He asserts that Ceramicas del Foix, S.A. is the Opponent's licensee for Canada and under the license the Opponent has direct control over the character or quality of the Roca Products sold in association with the trade-mark ROCA. He states that both the Opponent and Ceramicas del Foix, S.A are owned by Roca Corporación Empresarial, S.A., the mother company. I should point out that the deponent is referring to the trade-mark ROCA as opposed to the registered trade-mark ROCA & Design. There is no ground of opposition wherein the Opponent is relying on the word mark ROCA. In fact wherever there is reference to ROCA as a trade-mark it is always with reference to registration TMA287,139.

[21] He provides the yearly sales figures in Euros between 2000 and 2006 of the Roca Products by Ceramicas del Foix, S.A. He filed samples of invoices issued by Ceramicas del Foix, S.A between 1996 and 2006 for the sale in Canada of some of the Roca Products bearing the trade-mark ROCA. However we do not know if the deponent is referring to the word mark ROCA, the trade-mark ROCA & Design as registered or any other form of the ROCA & Design trade-mark.

[22] The Applicant argues that the trade-mark appearing on the invoices issued after August 2003 is different than the one registered and thus the Opponent would have abandoned the use of its trade-mark ROCA & Design at least as of that date. For ease of reference I reproduce herein below the trade-mark appearing on the invoices filed and bearing a date subsequent to July 2003:



It should be noted that only the script is the trade-mark as the rectangle is part of the portion of a brochure reproduced to illustrate how the trade-mark ROCA & Design is now used. I do not consider such deviation of the Mark to be use of a different trade-mark than the one registered and illustrated earlier [see *Canada (Registrar of Trade-marks) v. Cie. Internationale pour l'informatique CII Honeywell Bull, S.A.* (1985), C.P.R. (3d) 523 (FCA)]. Consequently I shall refer indistinctly to both versions as ROCA & Design, unless stipulated otherwise.

[23] He lists some of the Canadian distributors who are selling the Roca Products. He filed samples of catalogues distributed in Canada by Ceramicas del Foix between 2004 and 2007 wherein the trade-mark ROCA & Design as registered or the new ROCA & Design trade-mark appears.

[24] He refers to the Opponent's website which has been in operation since 2004 and has been consulted by Canadians. However we have no information on the number of hits

from Canadians. He filed sample pages of such website where the new version of the ROCA & Design trade-mark appears.

Registrability of the Mark under s. 12(1)(d) of the Act

[25] In order to meet its initial burden under this ground of opposition, the Opponent needs to establish the existence of the registration cited under this ground of opposition. I checked the register and registration TMA287,139 is extant [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats Ltée. v. Manu Foods Ltd.*, 11 C.P.R. (3d) 410].

[26] Therefore the Opponent has met its initial burden of proof. As such the Applicant has the burden to prove, on a balance of probabilities, that the use of the Mark in association with the Wares is not likely to cause confusion with the Opponent's registered trade-mark ROCA & Design. The test to determine this issue is set out in s. 6(2) of the Act. I must take into consideration all the relevant surrounding circumstances, including those listed in s. 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the wares, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them.

[27] Those criteria are not exhaustive and it is not necessary to give each one of them equal weight. In its recent judgment in *Masterpiece Inc. v. Alavida Lifestyles Inc. et al.* 2011 S.C.C. 27 the Supreme Court of Canada has clearly indicated that the most important factor amongst those listed under s. 6(5) of the Act is often the degree of resemblance between the marks.

The inherent distinctiveness of the trade-marks and the extent to which they have become known

[28] Mr. Gravina is a trade-mark attorney with a firm located in Turino, Italy. Such firm represents the Applicant in relation to its trade-marks portfolio in Italy and internationally. Mr. Gravina is the attorney responsible for providing instructions to the

Canadian trade-mark agents in relation to this application and the subsequent opposition filed by the Opponent.

[29] Mr. Gravina states that he is fluent in the Italian language. He states that the word “rocca” in the Italian language means “stronghold; fortress, fort” or could also mean “rock” and to support his contention he filed extracts of an online Italian-English dictionary.

[30] I have no evidence that the average Canadian consumer interested in purchasing the Wares would be able to translate the Mark from Italian to English or French. I consider the Mark as a whole to be inherently distinctive.

[31] As for the Opponent’s trade-mark, the Applicant through the affidavit of Shannon Young tried to demonstrate that the word “Roca” is a first name and also a geographical location in many countries around the world. Therefore it would be a weak trade-mark.

[32] In so far as being a first name, the evidence does not establish that it is a common first name in Canada. The search results for Canada on the website Canada411 attached to her affidavit shows only 9 individuals with such surname. The other search result attached to her affidavit contains the information on 10 individuals but there appears to be some duplication of individuals on those two search reports. There is also a report from a website entitled Poke my Name. The results are compiled from the United States of America population and are thus irrelevant to this case. As for the business registrations that include the word “Roca” not only the business names with the word “Roca” were listed but also names made of the element “Roca” such as for example “Rochad”, “Rocand” and “Proca”, which are not relevant.

[33] With respect to the argument that the word “Roca” represents a geographical location in many countries around the world, the listings filed as exhibits D and E to Ms. Young’s affidavit reveal only 3 cities, all located in Brazil. The other cities have as a component the word “Roca” but with the addition of a distinctive element.

[34] Finally Ms. Young filed an extract of a Spanish/English dictionary wherein the Spanish word “roca” is translated in English by “reef”.

[35] In all I consider the Opponent's registered trade-mark ROCA & Design to have also a certain degree of inherent distinctiveness.

[36] The distinctiveness of a trade-mark may be enhanced through use or promotion in Canada. The Opponent's evidence described above shows that the Opponent's registered trade-mark ROCA & Design is known to some extent in Canada. As mentioned previously I consider the use of the newer version of the ROCA & Design trade-mark to be use of the registered version of the trade-mark ROCA & Design.

[37] Mr. Bedeschi is the Applicant's President and has occupied such function since June 14, 2000, namely the date of its incorporation. He alleges that the Applicant began shipping tiles made in Italy associated with the Mark to its Canadian distributor in early June of 2004. He provides the yearly sales figures in Euros of the Wares bearing the Mark from 2004 to 2007 inclusive. He also provides the names and addresses of the Applicant's distributors in Canada since June 2004.

[38] To support his contention of sales made to Canadian distributors of Wares bearing the Mark since June 2004, he filed sales reports evidencing such sales going back to June 2004. Finally he filed scanned representations of product packaging for the Wares bearing the Mark.

[39] The yearly sales figures mentioned in Mr. Sanpons' affidavit of products bearing the trade-mark ROCA & Design are lower than the Applicant's sales for the years 2004 to 2006. However the Opponent has provided yearly sales figures since 2000. Consequently, it is difficult to conclude which trade-mark is more known than the other.

The length of time the trade-marks have been in use

[40] From the evidence described above, this factor favours the Opponent as it has been using the trade-mark ROCA & Design in Canada since at least 2000.

The nature of the wares and their channels of trade

[41] The Applicant is arguing that the Wares are restricted to tiles “made in Italy”. There is no such restriction in the Opponent’s registration TMA287,139. Consequently the Opponent’s wares could also originate from Italy. By their nature, the parties’ wares overlap and so would their channels of trade, as admitted by the Applicant in its written argument [see paragraph 36 of the Applicant’s written argument].

Degree of resemblance

[42] As stated earlier this factor is the most important one amongst those listed under s. 6(5) of the Act. One must look at the marks in their totalities and should not dissect each one of them into its components.

[43] As stated by Mr. Justice Denault of the Federal Court in *Pernod Ricard v. Molson Breweries* (1992), 44 C.P.R. (3d) 359, the first portion of a trade-mark is the most relevant for purposes of distinction. The only resemblance between the marks is the fact that the third element of the word portion of the Mark is phonetically identical to the Opponent’s registered trade-mark ROCA. It is difficult to assess the ideas suggested by the parties’ respective trade-marks as they are composed of foreign words and I have no evidence that the average Canadian consumer would associate the word “porcellana” to “porcelain” and “roca” to “rock”. Even though the design features of the parties’ trade-marks are not a dominant characteristic they are still different.

[44] Viewed as a whole, the Mark is different visually and in sound from the Opponent’s registered trade-mark ROCA & Design.

[45] Taking into consideration all the relevant factors, I conclude that the Applicant has discharged its burden to prove, on a balance of probability, that there is no likelihood of confusion between the Mark and the Opponent’s registered trade-mark ROCA & Design. I reach this conclusion on the basis that the Mark is inherently distinctive and does not resemble phonetically and visually to the Opponent’s registered trade-mark ROCA & Design.

[46] Consequently the second ground of opposition is dismissed.

Entitlement and Distinctiveness

[47] The third and fourth grounds of opposition as well as sub-paragraph a) of the fifth ground of opposition are based on the likelihood of confusion between the Mark and the Opponent's trade-mark ROCA & Design. The only difference between the registrability ground of opposition based on s. 12(1)(d) on one hand and entitlement based on s. 16(2) or (3) of the Act and distinctiveness of the Mark based on s. 2 of the Act on the other hand, is that the analysis of the surrounding circumstances listed under s. 6(5) of the Act would be done at earlier dates (see relevant dates above). Even if I would not be able to conclude that the Mark was known to some extent at those dates, the conclusions reached after the analysis of the relevant factors under the registrability ground of opposition would still apply, namely that the Mark is inherently distinctive and it does not resemble phonetically and visually to the Opponent's trade-mark ROCA & Design. As for the Opponent's trade-name Roca as a basis of a ground of opposition under entitlement, the same conclusion would apply.

[48] Consequently, the third and fourth grounds of opposition and sub-paragraph a) of the fifth ground of opposition are also dismissed.

Disposition

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

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office