



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

Citation: 2011 TMOB 39
Date of Decision: 2011-03-03

**IN THE MATTER OF AN OPPOSITION
by Level Ground Trading Ltd. to
application No. 1,232,847 for the trade-
mark SAN MIGUEL PUREFOODS in
the name of San Miguel Corporation**

[1] On September 29, 2004, San Miguel Corporation (the Applicant) filed an application to register the trade-mark SAN MIGUEL PUREFOODS (the Mark).

[2] The Mark was applied for registration for the following wares based on proposed use in Canada:

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products, namely, milk concentrates and milk-based beverages; edible oils and fats

(collectively the Wares).

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of November 21, 2007.

[4] On April 17, 2008, Level Ground Trading Ltd. (the Opponent) filed a statement of opposition. The grounds of opposition are reproduced below:

- (a) The trade-mark is not registrable as it is confusing with the opponent's trade-marks CAFÉ SAN MIGUEL (registration number TMA646848) and SAN MIGUEL COFFEE (registration number TMA569431) [collectively the Opponent's Trade-marks].

- (b) The proposed registration includes the same words (SAN MIGUEL) as the opponent's trade-marks and is in connection with certain wares for which the opponent's trade-marks are also used.

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

[6] The Opponent filed a statement that it did not wish to file any evidence in support of its opposition.

[7] In support of its application, the Applicant filed an affidavit of Megan Sargent, sworn May 21, 2009, with Exhibits A and B. Ms. Sargent was not cross-examined on her affidavit.

[8] Only the Applicant filed a written argument. Neither party requested an oral hearing.

Evidence

Applicant's Evidence: Megan Sargent

[9] Ms. Sargent is a legal assistant for the Applicant's agent.

[10] Ms. Sargent conducted searches of the Canadian Intellectual Property Office (CIPO) Database on May 21, 2009. Ms. Sargent states that her searches located seven trade-marks which have been registered or allowed for registration containing the word SAN MIGUEL for use in association with "edible products", as follows:

- (a) SAN MIGUEL COFFEE, registration No. TMA569,431, registered by the Opponent for *inter alia* "ground and whole bean coffee";
- (b) CAFÉ SAN MIGUEL, registration No. TMA646,848, registered by the Opponent for *inter alia* "ground and whole bean coffee";
- (c) SAN MIGUEL PUREFOODS & Design, registration No. TMA712,106, registered by the Applicant for "meat";
- (d) SAN MIGUEL PUREFOODS CORNED BEEF & Design, registration No. TMA714,071, registered by the Applicant for "meat products, namely, canned corned beef";

- (e) SAN MIGUEL GOLD LABEL, application No. 1,285,347, applied for by the Applicant for “ice cream, mellorine, butter and cheese”;
- (f) SAN MIGUEL GOLD LABEL & Design, application No. 1,336,176, applied for by the Applicant for “ice cream, mellorine, butter and cheese”; and
- (g) SAN MIGUEL PALE PILSEN & Design, registration No. TMA474,335, registered by the Applicant for “beer, lager, ale, pilsen/pilsener/pils, stout and bock”.

[11] Ms. Sargent states that she also conducted a search to locate the definition for “coffee bean”. Ms. Sargent states that she found a definition on Wikipedia which describes “coffee bean” as “the seed of the coffee plant (the pit inside the red or purple fruit)”. Ms. Sargent attached a copy of the definition as Exhibit B to her affidavit.

Onus

[12] 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 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 [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Analysis of the Grounds of Opposition

[13] I note that the Opponent has not alleged any sections of the Act in support of its grounds of opposition. According to *Novopharm Limited v. AstraZeneca AB* (2002), 21 C.P.R. (4th) 289 (F.C.A.), I must assess the sufficiency of the pleadings in association with the evidence. Based on a review of the pleadings in association with the evidence of record, I find that at most the Applicant would have interpreted the grounds of opposition as being based on s. 12(1)(d) of the Act. I will conduct my analysis accordingly.

Section 12(1)(d) Grounds of Opposition

[14] The material date for assessing confusion between the Mark and the Opponent’s Trade-marks pursuant to s. 12(1)(d) of the Act is the date of my decision [see *Park Avenue Furniture*

Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks (1991), 37 C.P.R. (3d) 413 (F.C.A.).

[15] I have exercised the Registrar's discretion to confirm that the registrations for the Opponent's Trade-marks are in good standing as of today's date. I note that the Opponent's Trade-marks are registered for the following wares and services:

Wares: Ground and whole bean coffee; and

Services: Coffee roasting and processing services and wholesale, retail sale, mail order and online ordering services for coffee

(the Opponent's Wares and Services).

[16] Since the Opponent's initial burden has been discharged with respect to this ground of opposition, the burden of proof lies on the Applicant to convince the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and either of the Opponent's Trade-marks.

[17] 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.

[18] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 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. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.).]

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

[19] Under the circumstances I consider it appropriate to exercise my discretion and look into the meaning of the words making up the Mark. Specifically, I may refer myself to a dictionary to determine the meaning of words [see *Insurance Co. of Prince Edward Island v. Prince Edward Island Insurance Co.* (1999), 2 C.P.R. (4th) 103 (T.M.O.B.); *Yahoo! Inc. v. audible.ca inc.* (2009), 76 C.P.R. (4th) 222 (T.M.O.B.)]. I have searched the *Canadian Oxford Dictionary* for the term “San Miguel” and found the following definition for “San Miguel de Tucumán”: “a city in northwestern Argentina, capital of the province of Tucumán”. The “San Miguel” element, which is present in both parties’ marks, thus possesses a possible geographical connotation.

[20] I note that “purefoods” appears to be a coined word. Despite it being a coined word, however, I note that the component elements of “purefoods”, namely “pure” and “foods”, suggest that the word refers to foods that are pure. Given that the Wares are all food products, the “purefoods” element is thus suggestive of the Wares.

[21] The Opponent’s Trade-marks also feature either the English word “coffee” or the French word “café”, respectively, both of which are descriptive of the Opponent’s Wares and Services which include coffee and coffee-related services. The Opponent has acknowledged the descriptiveness of the “coffee” and “café” elements as both words have been disclaimed in the respective trade-mark registrations.

[22] Both parties’ marks are not without distinctive character, however, I note that the Mark possesses a somewhat greater degree of inherent distinctiveness.

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

[24] Neither party has filed evidence of use or reputation for their marks and as a result I am unable to conclude as to the extent to which the parties’ marks have become known. Furthermore, I note that the mere existence of the registrations for the Opponent’s Trade-marks can establish no more than *de minimis* use and cannot give rise to an inference of significant and

continuous use of the Opponent's Trade-marks [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.) [*Entre Computer*]].

[25] Based on the foregoing, this factor does not significantly favour either party.

6(5)(b) – the length of time each has been in use

[26] The Mark was applied for on September 29, 2004 on the basis of proposed use in Canada. The Applicant has not established that the Mark has been used in Canada.

[27] The Opponent's trade-mark CAFÉ SAN MIGUEL proceeded to registration on August 29, 2005 based on use in Canada since October 7, 1997; the Opponent's trade-mark SAN MIGUEL COFFEE proceeded to registration on October 23, 2002 based on use in Canada since October 7, 1997. However, as pointed out previously, the mere existence of these registrations can establish no more than *de minimis* use and cannot give rise to an inference of significant and continuous use of the Opponent's Trade-marks [see *Entre Computer, supra*].

[28] Based on the foregoing, in the absence of evidence of use of the Opponent's Trade-marks, this factor does not significantly favour the Opponent.

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

[29] When considering the nature of the wares, services or business and the nature of the trade of the parties, it is the statement of wares in the application and the statements of wares and services in the registrations that govern the assessment of the likelihood of confusion under s. 12(1)(d) of the Act [see *Esprit International v. Alcohol Countermeasure Systems Corp.* (1997), 84 C.P.R. (3d) 89 (T.M.O.B.)].

[30] The Applicant submits that “[c]offee is the ‘seed of a coffee plant’ – it is not a preserved, dried or cooked fruit or vegetable, and not milk concentrate or milk-based beverage, the closest wares included in the Applicant’s list of wares.” I agree.

[31] Even if one were to conclude that the Opponent's wares are “food products”, the mere fact that the parties' wares and services would all arguably belong to the general class of “food products”, is not sufficient to lead to a finding that the parties' wares are similar [see for example

Clorox Co. v. Sears Canada Inc. (1992), 41 C.P.R. (3d) 483 (F.C.T.D.) and *Tradition Fine Foods Ltd. v. Groupe Tradition'l Inc.* (2006), 51 C.P.R. (4th) 342 (F.C.).

[32] The Applicant's Wares "meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, ...; edible oils and fats" are entirely distinct from the Opponent's "ground and whole bean coffee". Insofar as the Applicant's wares "milk and milk products, namely milk concentrates and milk-based beverages" are concerned, I find that the only relationship they share with the Opponent's "ground and whole bean coffee" is that milk can be used in coffee beverages. Ultimately, I am not satisfied that this is sufficient to find that the wares are similar.

[33] Given the lack of direct overlap between the parties' wares and services, I am unable to conclude that the channels of trade associated with the Mark and the Opponent's Trade-marks would overlap. Furthermore, I note that I have not been provided with any evidence to the contrary.

[34] Based on the foregoing, these factors favour the Applicant.

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

[35] In most instances, the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145, conf. 60 C.P.R. (2d) 70 (F.C.T.D.)].

[36] It is a well-accepted principle that the first portion of a trade-mark is the most relevant for the purposes of distinction [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) at 188]. I note that with respect to the Opponent's registration for the trade-mark SAN MIGUEL COFFEE, the first element of the parties' marks is identical, namely the "San Miguel" element.

[37] The Applicant submits that "the appearance, sound and ideas suggested by the secondary word COFFEE and the invented secondary word PUREFOODS are quite different and sufficient for the average consumer to distinguish one mark from the other."

[38] Ultimately, when considering the marks as a whole, I find that due to the inclusion of the words “San Miguel”, the parties’ marks share some degree of similarity in sound, appearance and ideas suggested. However, the presence of the coined word “purefoods” and the descriptive word “coffee”/“café” decreases these similarities.

[39] Based on the foregoing, when considered as a whole these factors favour the Opponent.

Additional Surrounding Circumstance: Applicant’s SAN MIGUEL Trade-marks

[40] The Applicant submits that the Sargent affidavit evidences the fact that five of the Applicant’s SAN MIGUEL trade-marks already co-exist with the Opponent’s Trade-marks and thus “there is no reasonable basis to conclude that [the Mark] is confusing or likely to be confused with [the Opponent’s Trade-marks] either.”

[41] Firstly, the Applicant has not provided any evidence supporting a finding that these marks have or are presently coexisting with the Opponent’s Trade-marks in the Canadian marketplace. Secondly, I note that s. 19 of the Act does not give the owner of a registration the automatic right to obtain further registrations, no matter how closely they may be related to the original registration [see *Mister Coffee & Services Inc. v. Mr. Coffee, Inc.* (1999), 3 C.P.R. (4th) 405 (T.M.O.B.) at 416 and *American Cyanamid Co. v. Stanley Pharmaceuticals Ltd.* (1996), 74 C.P.R. (3d) 572 (T.M.O.B.) at 576].

[42] Even if I was to infer from the Sargent affidavit that the Applicant was asserting a family of SAN MIGUEL trade-marks, I note that, in order to rely on a family of marks argument, one must prove use in Canada of each member of the family [see *McDonald’s Corp. v. Yogi Yogurt* (1982), 66 C.P.R. (2d) 101 (F.C.T.D.)]. In the present case, the Applicant has failed to provide any evidence of use of the Applicant’s other SAN MIGUEL trade-marks; as a result it is precluded from relying upon a family of SAN MIGUEL trade-marks.

[43] Based on the foregoing, this does not constitute a relevant surrounding circumstance supporting the Applicant’s case.

Conclusion re s. 12(1)(d) of the Act

[44] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, I find that notwithstanding the similarities in sound, appearance and idea suggested between the Mark and the Opponent's Trade-marks, the differences in the nature of the parties' wares and services (s. 6(5)(c) of the Act) serve to shift the balance in favour of the Applicant. Therefore I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and registration No. TMA646,848 for CAFÉ SAN MIGUEL and registration No. TMA569,431 for SAN MIGUEL COFFEE with respect to the Wares.

[45] In so finding, I note that the Opponent did not file any evidence or submissions in support of its opposition. Had the Opponent provided evidence it may have had an impact on the assessment of the surrounding circumstances relevant to this case.

[46] Based on the foregoing, I am dismissing the grounds of opposition based on s. 12(1)(d) of the Act.

Disposition

[47] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office