

TRADUCTION/TRANSLATION



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

Citation: 2011 TMOB 55
Date of Decision: 2011-03-25

**IN THE MATTER OF AN OPPOSITION by
Yoplait Marques Internationales, Société par
actions simplifiée, to application No. 1,317,789
for the trade-mark IMMUNITAS in the name
of Compagnie Gervais Danone (société de droit
français)**

Proceedings

[1] On September 25, 2006, Compagnie Gervais Danone (société de droit français) (the Applicant), filed an application to register the trade-mark IMMUNITAS (the Mark) based on proposed use in association with:

[TRANSLATION]

Milk-based liquid dietary supplements acting as meal replacements; milk-based liquid dietary supplements to improve intestinal function. Yogurt; yogurt-based drinks, namely, plain non-alcoholic drinks composed mainly of yogurt; non-alcoholic yogurt-based drinks containing fruit (Wares)

[2] This application was advertised for opposition purposes in the *Trade-marks Journal* on July 18, 2007. On December 18, 2007, Yoplait Marques Internationales, Société par actions simplifiées (the Opponent), filed a statement of opposition which the Registrar forwarded to the Applicant on January 31, 2008. On February 27, 2008, the Applicant filed a counter statement denying all of the grounds of opposition described below.

[3] The Opponent filed as evidence a “testimonial” by Jean-Baptiste Devade and the affidavit of Gerry Doutre. The Applicant adduced no evidence.

[4] Both parties filed written arguments. Although the Applicant requested a hearing, it did not participate.

Grounds of opposition

[5] The grounds of opposition pleaded are as follows:

[TRANSLATION]

1. The application for registration does not meet the requirements of paragraph 30(a) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (Act), in that the wares: “milk-based liquid food supplements used as meals substitutes; milk-based liquid food supplements to improve intestinal function” are not described in ordinary commercial terms;

2. The application for registration does not meet the requirements of paragraph 30(i) of the Act, in that the Applicant could not have stated that it was satisfied that it was entitled to use the Mark in association with the wares for the reasons given below;

3. The application for registration does not meet the requirements of paragraph 30(e) of the Act, in that the Applicant did not intend to use the Mark in Canada, or, in the alternative, it abandoned use of the Mark in Canada;

4. The Applicant is not the person entitled to the registration of the Mark pursuant to the provisions of paragraph 16(3)(b) of the Act, since, at the date of filing of the application, the Mark was confusing with the following trade-marks, for which applications for registration had previously been filed by the Opponent:

(i) IMMUNI+, application for registration No. 1,292,294 in association with milk and milk products, namely, yogurts, fresh cheese and fermented milk;

(ii) YOPTIMAL IMMUNI+ & Design, application for registration No. 1,292,297 in association with milk and milk products, namely, yogurts, fresh cheese and fermented milk;

(iii) YOPTIMAL IMMUNI+, application for registration No. 1,274,213 in association with milk and milk products, namely, yogurts, fresh cheese and fermented milk.

5. The Mark is not distinctive, in that it does not actually distinguish, nor is it adapted to distinguish, the Wares from the wares of others, including those of the Opponent, for the reasons given above.

Burden of proof when opposing the registration of a trade-mark

[6] In proceedings to oppose the registration of a trade-mark, the Opponent must present enough evidence concerning the grounds of opposition raised to show that there are facts supporting those grounds. If the Opponent meets this requirement, the Applicant must satisfy the Registrar, on a balance of probabilities, that the grounds of opposition should not prevent its trade-mark from being registered [see *Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 and *John Labatt Ltd. v. Molson Companies Ltd.*, (1990), 30 C.P.R. (3d) 293].

Grounds of opposition summarily dismissed

[7] The Opponent has not produced any evidence to support the allegations contained in the first and third grounds of opposition. In the circumstances, these grounds of opposition are dismissed.

[8] The second ground of opposition, as worded, is not a ground of opposition in itself. Paragraph 30(i) of the Act requires only that the Applicant state that it is satisfied that it is entitled to the registration of the Mark. The references to the allegations of a likelihood of confusion with trade-marks for which the applications for registration are currently pending or that the Mark lacks distinctiveness are redundant, as these grounds have already been raised. Paragraph 30(i) may be raised, for example, in cases where an applicant has made its statement in bad faith [see *Sapodilla Co. Ltd. v. Bristol Myers Co.* (1974) 15 C.P.R. (2d) 152]. This has been neither alleged nor proven.

[9] The second ground of opposition is also dismissed.

Distinctiveness of the Mark

[10] The distinctiveness of the Mark must be considered from the filing date of the statement of opposition (December 18, 2007) [see *Andres Wines Ltd. and E&J Gallo Winery* (1975), 25 C.P.R. (2d) 126, and *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317]. The Opponent must first show that its trade-marks had become sufficiently known in Canada by December 18, 2007 [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44].

[11] Mr. Devade is the Legal Director for the Yoplait Group, an entity that holds 100% of the Opponent's shares. I began by questioning the admissibility of the document signed by Mr. Devade and identified as a "testimonial". I informed the Applicant of this, despite its absence from the hearing, and I asked the parties to make submissions on the admissibility of this document. The Applicant indicated that it would respect the Registrar's decision, and the Opponent submitted detailed arguments about the admissibility of the document.

[12] In light of the Applicant's lack of objection, I shall admit Mr. Devade's testimonial as evidence.

[13] The statements contained in this testimonial serve to identify the entities that have obtained rights, whether under a licence, sub-licence or distribution contract, in the Opponent's trade-marks. According to the allegations contained in Mr. Devade's testimonial, which are uncontested, these various contracts contained provisions governing quality control of the wares bearing the trade-marks IMMUNI+, YOPTIMAL IMMUNI+ and YOPTIMAL IMMUNI+ & Design (the Opponent's Marks). In the absence of evidence to the contrary, I find that any use in Canada of the Opponent's Marks by the licensees or distributors identified by Mr. Devade, including Ultima Foods Inc. (Ultima) or its predecessors in title, constitutes use of these marks for the Opponent's benefit pursuant to the provisions of section 50 of the Act.

[14] Mr. Doure is the President of Ultima. He provides details about the use of the YOPLAIT trade-mark in Canada, but I do not see how this evidence is relevant, given that I must determine whether the Mark is confusing with the trade-marks identified by the Opponent in its statement of opposition. The trade-mark YOPLAIT is not listed in the statement of opposition. However, I note that the evidence shows that the Opponent's Marks are used in conjunction with the trade-mark YOPLAIT.

[15] Mr. Doutré explains that in October 2006, Ultima was the first to introduce in the Canadian market yogurt containing a combination of two active probiotic cultures and polyphenols. Yogurts with this combination are sold in Canada in association with the trade-mark YOPLAIT in combination with the Opponent's Marks. He explains that these new products were the result of effort and investment to develop a unique product.

[16] These yogurts are sold in ten different flavours and in three different formats. He has filed photographs of the different packaging bearing the Opponent's Marks, as well as samples of this packaging.

[17] He has provided the annual sales figures since 2006 for products bearing the Opponent's marks. However, these sales figures are not broken down by trade-mark. Moreover, only the sales prior to December 18, 2007, are relevant. Therefore, for the purposes of this ground of opposition, I may only consider the sales in 2006 (October to December 2006) and from January 1, 2007, to December 18, 2007, inclusively. I do not have the exact figures for these sales. I do, however, have the total sales of products bearing the Opponent's Marks for the period from November 1, 2006, to October 31, 2007. Approximately 1.5 million kilograms of yogurt were sold.

[18] He states that yogurts bearing the Opponent's Marks were distributed to national and regional grocery chains such as Métro, Super C, A&P, Loeb, Loblaws, Provigo, Maxi, No Frills, Safeway and Sobey's, as well as retail stores such as Zellers and Wal-Mart.

[19] He has filed samples of invoices demonstrating the sale of these products in 2006 and 2007.

[20] Mr. Doutré alleges that Ultima spent more than \$7 million to promote yogurt products bearing the Opponent's Marks in Canada.

[21] He gives examples of these promotional activities and has filed photographs or samples of the promotional materials. In October, 2006, when this line of new products was launched, there was advertising in Montréal's public transportation system; on the delivery trucks used to deliver the products; and at the points of sale, including banners, tents, posters and flags.

[22] The advertising has been carried out at three levels since October 2006:

- (1) to health professionals such as dieticians. Mr. Doutré has filed samples of brochures distributed to these individuals in 2007;
- (2) through product sampling, presentation or delivery activities targeted at consumers in 2007. Photographs of these events are appended to his affidavit;
- (3) through more traditional advertising campaigns in Canadian dailies such as Vancouver Province, Journal de Montréal, La Presse, Le Soleil, Toronto Star, The Globe & Mail and Calgary Herald, to name but a few; and in magazines such as Chatelaine. Samples of these advertisements have been filed. There was also radio advertising.

[23] Products bearing the mark YOPTIMAL IMMUNI+ are also promoted through discount coupons, displays and Internet advertising. Samples of these discount coupons have been filed. In 2007, Ultima offered food samples in grocery stores. Mr. Doutré has attached to his affidavit photographs illustrating these activities.

[24] Products bearing the Opponent's Marks have been advertised on the yoplait.ca website since their launch in October 2006, as appears from the excerpts of those web pages attached to Mr. Doutré's affidavit.

[25] The affiant concluded his affidavit by describing the recognition and awards earned by the new product. The products bearing the trade-mark YOPTIMAL IMMUNI+ were finalists in the 2007 "Canadian Grand Prix New Product Awards" in the "Dairy and Egg Products" category.

[26] It should be noted that I am disregarding all references to third-party documents such as the surveys, market studies or the distribution volume of certain newspapers or magazines to which Mr. Doutré refers in his affidavit. This evidence is inadmissible, as it constitutes hearsay.

[27] I find that the Opponent has discharged its initial burden of proving that its marks IMMUNI+, YOPTIMAL IMMUNI+ and YOPTIMAL IMMUNI+ & Design were known in Canada on December 18, 2007, so the Applicant must demonstrate that as of that date, the Mark was distinctive or was adapted to distinguish the Wares from the wares sold by the Opponent in association with its trade-marks. In other words, the Applicant must demonstrate, on a balance of

probabilities, that as of December 18, 2007, the use of the Mark in association with the Wares was not confusing to the average consumer with imperfect recollection of one or another of the Opponent's marks.

[28] The likelihood of confusion between two trade-marks must be analyzed in light of the specific circumstances of each case. These circumstances are listed in subsection 6(5) of the Act, namely: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time that 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. This list of criteria is not exhaustive. I refer to the Supreme Court of Canada's decision in *Mattel Inc. v. 3894207 Canada Inc.*, (2006) 49 C.P.R. (4th) 321 for an analysis of the relevant circumstances.

[29] I note that the Opponent has a greater chance of success if I compare the Mark with the trade-mark IMMUNI+. If I find that there is no confusion between these marks, then there can be no confusion between the Mark and the Opponent's other marks.

[30] There is no significant difference in the degree of inherent distinctiveness of each of the marks. Both the Mark and the trade-mark IMMUNI+ include the term IMMUNI, which suggests "immunity". Contrary to what the Opponent claims, I consider its mark weaker than the Mark, since the symbol "+", pronounced "plus", suggests to the consumer that the use of this product will have the effect of improving his or her immune system. However, the evidence of use of this mark, more fully described above, in combination with the lack of evidence of use of the Mark during the relevant period, leads me to conclude that on December 18, 2007, the mark IMMUNI+ was better known in Canada than the Mark.

[31] As for the length of time the marks at issue have been in use, this factor favours the Opponent, who has used the mark IMMUNI+ in association with yogurt since at least October 2006, while there is no evidence of use of the Mark in Canada.

[32] The Wares include milk-based products and yogurt. There is therefore some overlap in the nature of the parties' wares. As for the nature of the parties' trade, I have no evidence regarding the nature of the Applicant's commercial activities. I must therefore refer to the

description of the wares appearing in the application for registration and infer the distribution channels from this. I have also described above the wide range of distribution channels for the Opponent's products bearing the mark IMMUNI+. The application for registration contains no restrictions regarding the distribution of the Wares. As these are similar to those of the Opponent, I infer that the parties use or will be using the same distribution channels for the sale of their respective products.

[33] The degree of resemblance between the parties' marks has long been considered one of the most important factors to assess when analyzing the likelihood of confusion between trade-marks [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145, aff'd 60 C.P.R. (2d) 70]. This factor is even more important when the wares in question are similar.

[34] The marks are similar in appearance and sound and in the ideas suggested by them. In fact, the Opponent's Mark is almost fully contained in the Mark. Only the final components of the marks differ in appearance and sound. It has been held that the first portion of a trade-mark is the most relevant for purposes of distinction [see *Pernod Ricard v. Molson Breweries* (1992), 44 C.P.R. (3d) 359]. The average consumer with imperfect recollection would easily retain the first portion of the Opponent's Mark, IMMUNI. Because the product is an inexpensive consumer good, the consumer would not pay as close attention to the trade-mark to identify the source of the product when purchasing it as he or she would when purchasing an appliance, for example. I find that this factor definitely favours the Opponent.

[35] As an additional relevant factor, the Opponent submits that it was the first to market this type of yogurt in Canada and that it has invested a great deal of effort and money to do so. It alleges that the Applicant is attempting to capitalize on its efforts by trying to register and use a mark similar to its trade-mark IMMUNI+. The originality of a product is not a factor to be considered. The resemblance between the marks has been addressed in the preceding paragraph.

[36] Although the term IMMUNI suggests "immunity", it is still an invented word. Based on an analysis of the relevant factors, I find that the Applicant has not discharged its burden of demonstrating, on a balance of probabilities, that the Mark distinguishes or is adapted so as to distinguish the Wares from the Opponent's wares. The trade-mark IMMUNI+ was known in

Canada on the relevant date; the Opponent's Mark has been used in Canada since October 2006; the parties' wares are similar, or at least of the same nature; in the absence of evidence to the contrary, it can be inferred that their distribution channels are similar; and the marks at issue resemble each other in appearance or sound or in the ideas suggested by them.

[37] I therefore allow the fifth ground of opposition.

Right to register the Mark

[38] The relevant date for analyzing the second ground of opposition is the filing date of the application for registration (September 25, 2006) [see subsection 16(3) of the Act].

[39] To discharge its initial burden of proof, the Opponent must prove the previous filing of the applications for registration identified in its statement of opposition. It must also demonstrate that the applications for registration were still pending at the date of advertisement of the Applicant's application in the *Trade-marks Journal* [see subsection 16(4) of the Act].

[40] Mr. Doutré filed the relevant extracts of the register establishing that the applications for registration of the trade-marks YOPTIMAL IMMUNI+, IMMUNI+ and YOPTIMAL IMMUNI+, which bear the numbers 1,274,213, 1,292,294 and 1,292,297, respectively, were filed before September 25, 2006, and were still pending at the date of advertisement of this application for registration in the *Trade-marks Journal*. The Opponent has therefore discharged its initial evidentiary burden. The Applicant must therefore demonstrate, on a balance of probabilities, that the Mark was not confusing with the Opponent's marks at the date of filing of its application for registration.

[41] As with the previous ground of opposition, I note that the Opponent has the greatest chance of success if I compare the Mark with the trade-mark IMMUNI+.

[42] The difference between the relevant date for this ground of opposition (September 25, 2006) and that associated with the ground of opposition based on the Mark's lack of distinctiveness (December 18, 2007) has the effect of excluding any evidence subsequent to September 25, 2006. Therefore the evidence described above of use of the trade-mark IMMUNI+ by the Opponent must be disregarded, as it is subsequent to the relevant date at issue

here. This changes to some extent the conclusions related to my previous analysis of the circumstances enumerated in subsection 6(5) of the Act.

[43] The Opponent submits that the evidence of use of its trade-mark after the relevant date should be considered an additional relevant factor. With respect for the Opponent's opinion, I cannot accept this position. To consider the evidence of use of the trade-mark IMMUNI+ after September 25, 2006, would be to disregard the different relevant dates that the legislator and the courts have set to crystallize the situation between the parties.

[44] Accordingly, I cannot find that on September 25, 2006, the Opponent's trade-mark was better known than the Mark. Thus, the criterion of length of time that the marks at issue have been in use favours neither of the parties.

[45] Despite these differences in the weighing of the factors enumerated in paragraphs (a) and (b) of section 6(5) of the Act, I am of the view that they do not suffice to enable me to find in the Applicant's favour. There remain the similarity between the wares and their distribution channels and the degree of resemblance between the marks. These factors, which definitely favour the Opponent, are sufficient to justify a finding that the Applicant has not discharged its burden of demonstrating, on a balance of probabilities, that the use of the Mark in association with the Wares was not, as of September 25, 2006, confusing with the Opponent's trade-mark IMMUNI+. The fourth ground of opposition is therefore also allowed.

Conclusion

[46] Pursuant to the authority delegated to me under subsection 63(3) of the Act, I refuse the application for registration of the Mark pursuant to subsection 38(8) of the Act.

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

Certified true translation
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