

IN THE MATTER OF AN OPPOSITION by Astro Dairy Products Limited to application No. 609,006 for the trade-mark BIO DANONE & Design filed by Compagnie Gervais Danone, une société anonyme

On June 10, 1988, the applicant, Compagnie Gervais Danone, une société anonyme, filed an application to register the trade-mark BIO DANONE & Design, a representation of which appears below, based upon proposed use of the trade-mark in Canada in association with "LAITS ET PRODUITS LAITIERS, nommément: lait frais, lait à longue durée de conservation, lait fermenté, beurre, yogourt, crème, fromage, fromage blanc".



The trade-mark BIO DANONE & Design was advertised for opposition purposes in the *Trade-marks Journal* of August 8, 1990 and the opponent, Astro Dairy Products Limited, filed a statement of opposition on June 10, 1991, a copy of which was forwarded to the applicant on July 4, 1991. The opponent requested and was granted leave to amend its statement of opposition pursuant to Rule 42 [now Rule 40] of the *Trade-marks Regulations*. The opponent alleged the following grounds of opposition in its amended statement of opposition:

(a) The applicant's trade-mark is not registrable in view of Paragraph 12(1)(b) of the *Trade-marks Act* in that the mark when depicted, written or sounded is clearly descriptive or deceptively misdescriptive in the English and French languages of the biological character or quality of the wares in association with which the mark is used or proposed to be used and of the biological conditions employed in their production;

(b) The trade-mark is not registrable in view of the provisions of Paragraph 12(1)(d) of the *Trade-marks Act* in that the applicant's trade-mark is confusing with the following registered trade-marks:

(i)	<u>Trade-mark</u>	<u>Registration No.</u>
	BIOSEDRA	152,657
	BIOHALBE	212,920
	BIO-MARGARINE	235,829

BIOSLIM	270,340
BIOMANAN	282,979
BIONORM	289,997
BIODYN & Design	292,642
BIOLAC	322,949
BIOBEST	350,094
BIOPLAIT	374,745
BIOGHURT	385,013
BIO-FRAIS	362,911
BIO-FRESH	362,912

(ii)	<u>Trade-mark</u>	<u>Registration No.</u>
	BIO-BAR	245,913
	BIOBEL	273,422
	BIOBLEND	268,827
	BIOGERM	200,974
	BIOGRAIN	277,137
	BIOGUETTE	296,428
	BIO-HEALTH	192,518
	BIOLOGICAL EDGE	311,197
	BIOLIGNE	273,423
	BIOMEL	280,173
	BIOMIX	267,927
	BIO-ORGANIC	237,459
	BIO-PLUS	299,919
	BIO-SOURCE	276,613
	BIO-ST-JOSEPH	225,305
	BIO-STRATH	133,946
	BIO-TE	281,119
	BIO-VEG	289,354
	BIO-GOLD	365,708

(c) The applicant is not the person entitled to registration of the trade-mark in that, as of the filing date of the present application, the applicant's trade-mark was confusing with the opponent's trade-mark BIOBEST which was adopted by the opponent by at least as early as October 22, 1987, prior to the filing date of the present application, and which was in use by the opponent at the date of advertisement of August 8, 1990 in connection with biologically cultured dairy products;

(d) The applicant's trade-mark is not registrable in that it is not distinctive as it is neither adapted to distinguish the applicant's wares nor does it actually distinguish the applicant's wares from those of others. The prefix BIO, which forms a dominant portion of the trade-mark, has been at all material times in common use as a formative part of trade-marks used by persons in connection with dairy products as exemplified by the trade-marks set out above in paragraph (b)(i), and by persons in connection with other food and dietary products as exemplified by the trade-marks set out above in paragraph (b)(ii).

The applicant served and filed a counter statement in which it generally denied the opponent's grounds of opposition. Further, the applicant was subsequently granted leave pursuant to Rule 40 of the *Trade-marks Regulations* to amend its counter statement. The opponent filed as its evidence the affidavit of Jack Marshall while the applicant submitted as its evidence the affidavit of Karen Smythe. Both parties filed written arguments and both were represented at an oral hearing.

As its first ground of opposition, the opponent alleged that the applicant's trade-mark is not registrable in view of the provisions of Paragraph 12(1)(b) of the *Trade-marks Act* in that the trade-mark BIO DANONE & Design, when depicted, written or sounded, is clearly descriptive or deceptively misdescriptive in the English and French languages of the biological character or quality of the wares in association with which the mark is used or proposed to be used and of the biological conditions employed in their production. With respect to the Paragraph 12(1)(b) ground of opposition, the legal burden is on the applicant to establish that its trade-mark BIO DANONE & Design is registrable. However, there is an initial evidential burden on the opponent to adduce sufficient evidence which, if believed, would support the truth of its allegations that the applicant's mark is clearly descriptive of the character or quality of the applicant's wares or of the biological conditions employed in their production. The relevant date for considering a ground of opposition based on Paragraph 12(1)(b) of the *Act* is as of the date of decision [see *Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers*, 41 C.P.R. (3d) 243 (F.C.A.)]. As no evidence has been adduced by the opponent in support of this ground, the opponent has failed to meet the evidential burden upon it. In any event, I do not consider the trade-mark BIO DANONE & Design, when considered in its entirety, to be descriptive of any of the applicant's wares. As a result, I have dismissed the first ground of opposition.

The second ground of opposition is based on Paragraph 12(1)(d) of the *Trade-marks Act*, the opponent alleging that the applicant's trade-mark BIO DANONE & Design is confusing with several registered trade-marks identified above including its registered trade-mark BIOBEST, registration No. 350,094. As the submissions made by both parties at the oral hearing relate to the likelihood of confusion between the trade-marks BIO DANONE & Design and BIOBEST, I will initially consider this issue. In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue within the scope of Subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances including those which are specifically enumerated in Subsection 6(5) of the *Act*. Furthermore, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks of the parties as of the date of decision, the material date in respect of the Paragraph 12(1)(d) ground [see *Park Avenue Furniture Corp. v. Wickes/Simmons*

Bedding Ltd. et al, 37 C.P.R. (3d) 413 (F.C.A.)].

With respect to the inherent distinctiveness of the trade-marks at issue, the opponent's trade-mark BIOBEST possesses some measure of inherent distinctiveness as applied to yogurt and cottage cheese even though the element BEST is laudatory and therefore adds no inherent distinctiveness to the opponent's mark and the prefix BIO might suggest to some consumers that there is a biological aspect to the opponent's wares. The applicant's trade-mark BIO DANONE & Design, when considered in its entirety, possesses more inherent distinctiveness than does the opponent's trade-mark. While the word BIO is suggestive of the applicant's wares, the word DANONE appears to be a coined term and the design elements add to the inherent distinctiveness of the applicant's trade-mark.

The Smythe affidavit establishes that the applicant has not yet commenced use of the trade-mark BIO DANONE & Design in Canada. Further, there is nothing in the Smythe affidavit which would point to the applicant's mark having otherwise acquired any measure of a reputation in this country. On the other hand, the Marshall affidavit establishes that the opponent commenced selling its BIOBEST yogurt in Canada in July, 1988 and, since that time, has sold not less than 7,000,000 containers of BIOBEST yogurt having an approximate total retail sales value of \$6,000,000. According to Mr. Marshall, Vice-president Sales/Marketing of the opponent, the opponent's yogurt is sold through chain grocery stores, and independent grocery and delicatessen stores across Ontario and in major metropolitan areas in Manitoba, British Columbia, Quebec and Newfoundland. Thus, both the extent to which the trade-marks at issue have become known and the length of time the marks have been in use clearly weigh in the opponent's favour.

The dairy products of the parties overlap in that the opponent's registration covers yogurt and cottage cheese which are identical to the applicant's yogurt and cottage cheese, as well as being closely related to the applicant's fresh and fermented milk, butter, cream and cheese. Moreover, the channels of trade associated with these wares would overlap.

As for the degree of resemblance between the trade-marks at issue, the trade-marks BIO

DANONE & Design and BIOBEST bear some minor degree of similarity in appearance and in sounding due to the element BIO which is the dominant element in both of the trade-marks at issue. Further, there is a fair degree of similarity in the ideas suggested in that the marks might suggest to some consumers that there is a biological aspect to the wares of the parties.

As a further surrounding circumstance in respect of the issue of confusion, the applicant at the oral hearing pointed to the existence of four registered trade-marks [BIOHALBE, BIODYN & Design, BIOPLAIT and BIOGHURT, registration Nos. 212,920, 292,642, 374,745 and 385,013] which include the prefix BIO as applied to yogurt. The four registrations stand in the names of third parties and copies thereof are annexed to the statement of opposition. However, the mere existence of four trade-marks on the register without evidence of use of any of these marks is, in my view, of little assistance to the applicant. In this regard, I would note that the application for registration of the trade-mark BIOHALBE was based on use and registration in Germany and that Mr. Marshall has stated in his affidavit that he has “never encountered any other yogurt sold in Canada under a trade mark of which the word BIO is a formative part”.

Considering that there is at least some degree of resemblance between the trade-marks at issue as applied to wares which overlap and would travel through the same channels of trade, and bearing in mind that the opponent has demonstrated that its BIOBEST mark has become known in Canada, I have concluded that the applicant has failed to meet the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between its trade-mark BIO DANONE & Design and the opponent's registered trade-mark BIOBEST. Consequently, the trade-mark BIO DANONE & Design as applied to "LAITS ET PRODUITS LAITIERS, nommément: lait frais, lait à longue durée de conservation, lait fermenté, beurre, yogourt, crème, fromage, fromage blanc" is not registrable in view of Paragraph 12(1)(d) of the *Trade-marks Act*.

In view of the above, I refuse the applicant's application pursuant to Subsection 38(8) of the *Trade-marks Act*. I have therefore not considered the remaining grounds of opposition relied upon by the opponent.

DATED AT HULL, QUEBEC, THIS 2nd DAY OF DECEMBER, 1997.

G.W. Partington,
Chairperson,
Trade Marks Opposition Board.