

IN THE MATTER OF AN OPPOSITION by Aliments Delisle Ltée/
Delisle Foods Ltd. to application No. 610,059 for the trade-mark
YOGOURT D'LITE filed by Anna Beth Holdings Ltd.

On June 29, 1988, the applicant, Anna Beth Holdings Ltd., filed an application to register the trade-mark YOGOURT D'LITE based upon proposed use of the trade-mark in Canada in association with "frozen yogurt". Subsequent to filing its application, the applicant submitted an amended application in which it disclaimed the right to the exclusive use of the words YOGOURT and LITE apart from its trade-mark.

The opponent, Aliments Delisle Ltée/ Delisle Foods Ltd., filed a statement of opposition on April 3, 1989. As its first ground of opposition, the opponent alleged that the applicant's application does not comply with Section 30(e) of the Trade-marks Act in that the applicant did not have the intention to use the trade-mark in Canada in association with the wares covered in its application. The second ground is that the applicant's trade-mark is not registrable in that it is either clearly descriptive or deceptively misdescriptive of the character or quality of the applicant's wares, contrary to Section 12(1)(b) of the Trade-marks Act.

The third ground is that the applicant's trade-mark is not registrable in view of the provisions of Section 12(1)(d) of the Trade-marks Act in that the applicant's trade-mark YOGOURT D'LITE is confusing with the opponent's registered trade-marks: DELISLE & Design, registration No. 225,355; DELISLE LE GOURMIEL & Design, registration No. 253,464; and DELISLE HONEY UP & Design, registration No. 253,465. As its fourth ground, the opponent alleged that the applicant is not the person entitled to registration in that, as of the applicant's filing date, the applicant's trade-mark was confusing with the opponent's following trade-marks: YOGOURT DELISLE; DELISLE YOGOURT; DELISLE; DELISLE & Design; DELISLE LE GOURMIEL & Design; DELISLE HONEY UP & Design; and DELISLE & Design. The fifth ground is that the applicant is not the person entitled to registration in that, as of the applicant's filing date, the applicant's trade-mark YOGOURT D'LITE was confusing with the opponent's previously filed application for the trade-mark DELISLE & Design, application No. 566,788.

The sixth ground of opposition is based on the allegation that the applicant is not the person entitled to registration in that, as of the applicant's filing date, the applicant's trade-mark was confusing with the opponent's trade-name Aliments Delisle Ltée/ Delisle Foods Ltd. which had been previously used in Canada by the opponent in association with various food products including yogurt. The final ground is that the applicant's trade-mark is not distinctive in that it does not distinguish and is not adapted to distinguish the applicant's wares from those of the opponent

associated with the opponent's trade-marks and trade-name which have been used in Canada.

The applicant filed a counter statement in which it denied the allegations of confusion set forth in the statement of opposition.

The opponent requested and was granted leave to amend its statement of opposition pursuant to Rule 42 of the Trade-mark Regulations in order to provide that the prior use of the trade-marks identified in the fourth ground of opposition was by the opponent and its predecessor-in-title.

The opponent filed as its evidence the affidavit of Yolande Desrochers while the applicant filed an undated letter as its Rule 44 evidence. However, as the applicant's alleged evidence has not been submitted either by way of affidavit or statutory declaration, it does not constitute admissible evidence in this opposition and has therefore been disregarded.

Further, the opponent alone submitted a written argument and neither party requested an oral hearing.

In this opposition, the applicant has done nothing more than the minimum required of it, that is, to serve and file a counter statement to the opponent's opposition. Considering that the legal burden is on the applicant to establish the registrability and distinctiveness of its trade-mark, I would have thought that the applicant, were it serious in its attempt to register the trade-mark YOGOURT D'LITE, would have at least made some effort to substantiate some of the allegations contained in its counter statement.

On the other hand, the opponent has done a very thorough job of establishing its case by submitting a detailed affidavit of Yolande Desrochers, coordinator of consumer services with the opponent. In particular, the Desrochers affidavit confirms that the opponent's trade-marks are very well known, if not famous, in Canada, the opponent having produced more than 586,000,000 containers of cottage cheese, sour cream and yogurt in association with its trade-marks in Canada from October of 1979 to December of 1989. The approximate net sales of its products from October 1975 to December of 1989 were approximately \$667,440,000 while the opponent's advertising expenditures relating to its products between 1978 and 1989 amounted to more than \$6,300,000.

The issue of distinctiveness of the applicant's trade-mark YOGOURT D'LITE in view of the opponent's use of the mark YOGOURT DELISLE appears to be the most relevant of the grounds

raised by the opponent in its statement of opposition. As noted above, the legal burden is on the applicant to establish the distinctiveness of its trade-mark YOGOURT D'LITE. Nevertheless, there is an initial evidential burden on the opponent to establish the facts underlying this ground of opposition. In this regard, the Desrochers affidavit establishes that the opponent has made extensive use of its mark YOGOURT DELISLE as applied to yogurt in Canada prior to the date of opposition, the material date for assessing the distinctiveness of the applicant's trade-mark.

In view of the above, the legal burden is on the applicant to show that there would be no reasonable likelihood of confusion between its trade-mark YOGOURT D'LITE and the opponent's mark YOGOURT DELISLE, such that the applicant's trade-mark would be adapted to distinguish that applicant's frozen yogurt from the opponent's yogurt in the marketplace. While the opponent's mark possesses little, if any, inherent distinctiveness in view of the surname significance of Delisle, the opponent's evidence has established that its trade-marks, including the trade-mark YOGOURT DELISLE, has become very well known in Canada in association with yogurt. As a result, the opponent's mark is entitled to a relatively broad ambit of protection when assessing the issue of confusion between trade-marks in the marketplace.

The trade-marks YOGOURT D'LITE and YOGOURT DELISLE bear little resemblance in appearance although there does appear to be a fair degree of similarity in the sounding of the trade-marks when considered in their entirety.

When assessing the issue of confusion, the trade-marks at issue must be considered from the point of view of the average hurried consumer having an imperfect recollection of the opponent's mark who might encounter the trade-mark of the applicant in association with the applicant's wares in the marketplace. In the present case, and while I have my doubts as to whether the trade-marks at issue are confusing, the applicant has done nothing in support of its application. As a result, I have concluded that the applicant has failed to meet the legal burden upon it in respect of the non-distinctiveness ground of opposition.

I refuse the applicant's application pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 30th DAY OF November, 1992.

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