



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

**Citation: 2012 TMOB 11**  
**Date of Decision: 2012-01-27**

**IN THE MATTER OF AN OPPOSITION  
by Canada Bread Company, Limited to  
application No. 1,311,210 for the trade-  
mark POMTINI & Design in the name of  
Beverages Brands (UK) Limited.**

[1] On July 19, 2006, Beverages Brands (UK) Limited (the Applicant), filed an application to register the trade-mark POMTINI & Design, shown below, on the basis of use in Canada since at least as early as April 7, 2006.



[2] The statement of wares of the application of record (amended application filed March 16, 2009 - accepted by the Registrar on May 13, 2009) reads:

(1) Pre-mixed alcoholic drinks with a spirit base, pre-mixed alcoholic coolers and prepared alcoholic cocktails. (2) Alcoholic fruit drinks with a spirit base, alcoholic coolers, prepared alcoholic cocktails, spirit mixers with fruit flavours.

[3] The Applicant has disclaimed the right to the exclusive use of the word “vodka”.

[4] The application was advertised in the *Trade-marks Journal* of June 13, 2007.

[5] Boulangerie Pom Limitée (Pom Bakery) and Multi-Marques Inc. (Multi-Marques) jointly filed a statement of opposition on November 13, 2007. On February 24, 2010, the co-opponents

requested leave to file an amended statement of opposition alleging approximately twenty additional trade-marks and one additional trade-name, all of which were formally owned by PomWonderful LLC, in support of the non-entitlement grounds of opposition. On behalf of the Registrar, I refused the request for leave pursuant to r. 40 of the *Trade-marks Regulations*, SOR/96-195 (the Regulations) on March 30, 2010. That being said leave to file an amended statement of opposition dated July 2, 2010 to reflect the opponent as Canada Bread Company, Limited (Canada Bread) was granted on July 20, 2010. This change was requested further to the merger of Pom Bakery and Multi-Marques with and into Canada Bread. Unless indicated otherwise, the term “Opponent” is used throughout my decision to refer to the opponent at the relevant time, that is to say Pom Bakery and Multi-Marques jointly or Canada Bread.

[6] The Applicant filed a counter statement essentially denying each ground of opposition, as pleaded.

[7] Both parties filed evidence, written arguments and were represented at an oral hearing held on December 1, 2011.

[8] After the oral hearing, but on the same day, the Opponent filed a request for leave to file a further amended statement of opposition. By way of letter dated December 6, 2011, the Applicant objected to the Opponent’s request. In these circumstances, I shall first deal with the Opponent’s outstanding request of December 1, 2011 by discussing the grounds of opposition to be decided in the present proceeding.

### Grounds of Opposition

[9] Before dealing with the Opponent’s request of December 1, 2011, I wish to go over the main points of a preliminary discussion that took place at the oral hearing as to the grounds of opposition set forth in the amended statement of opposition of July 2, 2010, which was of record at the time.


[10] Given submissions made by the parties in written arguments, I started the oral hearing by pointing out to the Opponent’s agent that contrary to what was stated in the Opponent’s written argument, none of the pleaded grounds of opposition alleged non-distinctiveness of the Mark

pursuant to s. 38(2)(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act). I also pointed out that the non-entitlement grounds of opposition were based upon s. 16(2)(a) to (c) and s. 16(3)(a) to (c) of the Act and not upon s. 16(1)(a) to (c) of the Act as stated in the Opponent's written argument. I specifically invited the Opponent's agent to use the opportunity of his oral submissions to address the submissions made by the Applicant in its written argument that the pleaded non-entitlement grounds of opposition were inaccurate and incorrect. Finally, I asked the agent to clarify whether the Opponent would still be relying upon all of the grounds of opposition alleged in the amended statement of opposition of July 2, 2010 as some of them were not set out in the Opponent's written argument.

[11] Further to my remarks, the Opponent's agent indicated that the Opponent would not be relying upon all of the alleged grounds of opposition. Actually, the Opponent's agent specifically withdrew the grounds of opposition alleging that: the application does not conform to the requirements of s. 30(a) of the Act; the trade-mark is not registrable pursuant to s. 12(1)(b) of the Act; and the trade-mark is not registrable pursuant to s. 14(1)(a), 14(1)(b) and 14(1)(c) of the Act. Furthermore, the agent acknowledged that the Opponent did not raise a non-distinctiveness ground of opposition. Finally, I note that the Opponent's agent did not make any submissions on the inaccuracy of the non-entitlement grounds of opposition, be it when replying to my remarks or during his oral submissions.





[12] Having regard to the foregoing, the oral hearing proceeded on the grounds of opposition remaining in the amended statement of opposition dated July 2, 2010. In summary, those grounds of opposition allege that:

- the application does not conform to the requirements of s. 30(b) and (i) of the Act;
- the Mark is not registrable pursuant to s. 12(1)(d) of the Act since it is confusing with the following registered trade-marks of the Opponent:

<u>Trade-mark</u>	<u>Registration No.</u>	<u>Registration Date</u>
 (POM & Design)	TMA469,001	January 17, 1997

POM GOLD (POM D'OR)	UCA40516	February 1, 1952
POM	TMDA49765	June 20, 1930
POM LITE	TMA335,814	December 31, 1987

- the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(2)(a) and s. 16(3)(a) of the Act because at the filing date of the application the Mark was confusing with previously used (made known) trade-marks of the Opponent, in particular the registered trade-marks, the trade-mark POM and the following trade-marks:

<u>Trade-mark</u>	<u>Application No.</u>	<u>Filing Date</u>
	1,037,297	November 23, 1999
	1,037,299	November 23, 1999
	1,038,744	December 6, 1999
	1,037,298	November 23, 1999
POM	1,122,704	November 23, 2001

- the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(2)(b) and s. 16(3)(b) of the Act because at the filing date of the application the Mark was confusing with the trade-marks of the Opponent that had been previously applied for registration; and
- the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(2)(c) and s. 16(3)(c) of the Act because at the filing date of the application the Mark was confusing with the trade-names POM, BOULANGERIE POM LIMITÉE

and POM BAKERY LIMITED previously used in Canada by the Opponent and its predecessors in title.

[13] I note that the Opponent's agent submitted in oral argument that the Opponent's ownership of registration No. TMA774,041 for the trade-mark POM WONDERFUL should be taken into consideration in the present proceeding. I disagree. Besides the fact that the said registration has not been alleged in the pleading, the Opponent did not introduce the registration into evidence. Considering the sufficiency of the pleading in association with the evidence [see *Novopharm Ltd. v. Astra AB* (2002), 21 C.P.R. (4th) 289 (F.C.A.)], it cannot be concluded that the Opponent was also relying upon registration No. TMA774,041 under the registrability ground of opposition. I am precluded from considering a ground of opposition that has not been raised by the Opponent [see *Imperial Developments Ltd. v. Imperial Oil Limited* (1984), 79 C.P.R. (2d) 12 (F.C.T.D.)].

[14] I shall now revert to the Opponent's request for leave to file the amended statement of opposition dated December 1, 2011.

[15] Leave to amend a statement of opposition will only be granted if the Registrar is satisfied that it is in the interest of justice to do so having regard to all the surrounding circumstances including: 1) the stage the opposition proceeding has reached; 2) why the amendment was not made earlier; 3) the importance of the amendment; and 4) the prejudice which will be suffered by the other party.

[16] For ease of reference, I will discuss the proposed amendments by dividing them in three categories, namely: (1) removal of the grounds of opposition that were withdrawn at the oral hearing; (2) change to the non-entitlement grounds of opposition to rely upon s. 16(1) of the Act; (3) reliance on the POM related Canadian trade-mark portfolio of PomWonderful LLC (the PomWonderful Marks).

[17] The first category of amendments is not important nor is it of any consequences since the grounds of opposition were officially withdrawn at the oral hearing. The Opponent did not provide any explanation as to why the second category of amendments could not have been made earlier. Again, the deficiency of the non-entitlement grounds of opposition was first raised

in the Applicant's written argument. As the Applicant's written argument of June 2010 was forwarded to the Opponent by the Registrar on July 20, 2010, the Opponent has had in excess of sixteen months to correct the deficiency of the non-entitlement grounds of opposition prior and up to the oral hearing. Furthermore, as I previously indicated, I specifically invited the Opponent's agent to address the deficiency of the non-entitlement grounds of opposition at the beginning of the oral hearing. Yet, the Opponent's agent did not make any submissions on this issue. In other words, when specifically provided at the oral hearing with the opportunity to explain the incorrect references to s. 16(2) and s. 16(3) of the Act and to request leave to amend the pleadings to refer to s. 16(1), the Opponent did not do so. Finally, there is still no representation of the Opponent in its request of December 1, 2011 to explain the reasons for the incorrect pleadings and why the proposed changes could not have been made earlier.

[18] Insofar as the third category of amendments is concerned, it is apparent that reliance on the PomWonderful Marks would result in a significant number of additional registrations, previously used marks, previously filed applications, and one additional trade-name being alleged in support of the grounds of opposition. It is noteworthy that the Opponent indicates in its request that the proposed reliance on the PomWonderful Marks was the subject of its request for leave of February 24, 2010, which I refused on March 30, 2010. While the proposed amendments are made under the pretence of the proposed changes to the non-entitlement grounds of opposition (from s. 16(2) and (3) to s. 16(1) of the Act), it seems to me that the Opponent is indirectly attempting to have me reconsider my decision of March 30, 2010. I see no reason to reverse my decision of March 30, 2010, as the Opponent has not demonstrated that I committed any error in law or in my interpretation of the facts.

[19] Having considered the surrounding circumstances of this case, I am not satisfied that it is in the interest of justice to grant the Opponent's request of December 1, 2011 and so I hereby refuse the Opponent's request pursuant to r. 40 of the Regulations. Accordingly, the grounds of opposition to be considered in the present proceeding are those remaining in the amended statement of opposition dated July 2, 2010, as summarized at paragraph 12 of my decision.

## Onus

[20] 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 Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.) and *Wrangler Apparel Corp. v. The Timberland Company* (2005), 41 C.P.R. (4th) 223 (F.C.)].

## Evidence

[21] I am providing hereafter a somewhat detailed overview of the parties' evidence.

### Opponent's Evidence

[22] The Opponent filed an affidavit of Jean-Pierre Galardo of August 19, 2008, including its Exhibits JPG-1 to JPG-8. Mr. Galardo was not cross-examined by the Applicant.

[23] Mr. Galardo is the Marketing Director of Canada Bread, Multi-Marques and Pom Bakery. He has occupied this position for the latter two corporations since at least 1991 [par. 1].

[24] I note from the outset that I will not afford weight to Mr. Galardo's statements that go to the questions of facts and law to be determined by the Registrar in the present proceeding. Consequently, the parties' submissions regarding the reliability of Mr. Galardo's testimony based on his experience in the food industry are a moot point.

[25] Mr. Galardo states that Pom Bakery owns the trade-marks POM (No. TMDA49765), POM GOLD (POM D'OR) (No. UCA40516), POM LITE (No. TMA335,814) and POM & Design (No. TMA469,001) registered in association with the following wares [par. 6]:

- TMDA49765: Bread, cake and confectionery namely pastries, cookies, waffles and candies.
- UCA40516: Bread.
- TMA335,814: Bread.

- TMA469,011: Produits de boulangerie et de pâtisserie, notamment pain, pain biologique, petits pains, beignes, brioches, gâteaux, biscuits, galettes, pâtisseries, tartes, muffins, muffins anglais, croissants, pâte à pizza, tortillas, pita, bagels, breadsticks et kaisers.

[26] I note that Mr. Galardo introduces the evidence by referring to the aforementioned registered trade-marks collectively as “*les Marques*” (translation: the Marks) and to the registered wares collectively as “*les Marchandises*” (translation: the Wares). My subsequent use of the terms “Registered Marks” reflects Mr. Galardo’s collective reference to the registered trade-marks in his affidavit. Likewise, my subsequent use of the terms “Registered Wares” reflects his collective reference to the wares covered by the registrations.

[27] According to Mr. Galardo’s statements, the billing and invoicing of Pom Bakery is done by Multi-Marques. The Registered Wares associated with the Registered Marks are sold by Pom Bakery and Multi-Marques [par. 3]. Pom Bakery is a subsidiary of Multi-Marques [par. 5]. Pom Bakery has granted a licence to Multi-Marques for the use of the Registered Marks and their different versions. Pom Bakery directly controls the character and quality of the wares associated with the Registered Marks and Multi-Marques must follow strict use guidelines [pars. 8-10].

[28] According to Mr. Galardo’s statements, the Registered Marks have been used in Canada in association with the Registered Wares and a multitude of related products (“*une multitude de produits connexes*”) since at least as early as the following years: POM - 1930; POM GOLD (POM D’OR) - 1952; POM LITE - 1987; POM & Design – 1991 [par. 11]. Mr. Galardo files specimens stating that they evidence use of the Registered Marks [par. 12, Exhibit JPG-2]. He also files copies of invoices relating to the sales of the Registered Wares in association with the Registered Marks [par. 13, Exhibit JPG-3].

[29] I note that the specimens filed as Exhibit JPG-2 appear to be photocopies of product packages, presumably plastic bags which would explain the quality of their reproduction. I agree with the Applicant that the packages seem to be for bread-type products and do not display all of the Registered Marks. In fact, the specimens mostly display one or both of the two design marks shown hereafter. However, I accept the use of these design marks as use of the word mark POM alleged as one of the Registered Marks.





[30] According to the sale figures provided by Mr. Galardo, the total approximate value of sales of the Registered Wares in association with the Registered Marks exceeded \$674 million for the years 1999 to 2008 (up to June 30) [par. 16]. Although Mr. Galardo provides a yearly breakdown of the sale figures, he does not provide separate amounts for each of the Registered Marks.

[31] Mr. Galardo states that the Registered Wares associated with the Registered Marks are sold in convenience stores (“*dépanneurs*”), grocery stores and supermarkets; they are also distributed and sold in the food services sector, including restaurants, bars, fast food counters, cafeterias, canteens, hospitals, daycares and schools [par. 17].

[32] According to Mr. Galardo’s statements, Pom Bakery and Multi-Marques invest approximately \$3 million annually in promoting the Registered Marks across Canada through various media, such as radio and television stations, as well as print and virtual media [par. 22]. Mr. Galardo provides evidence of promotion through sweepstakes organized in collaboration with television stations [pars. 23-25] and of promotion at the Montreal Alouettes football games [par. 14, Exhibit JPG-4] and the Montreal Canadiens hockey games at the Bell Centre [pars. 15 and 26, Exhibit JPG-5]. He also provides copies of promotional and advertising printed materials [par. 21, Exhibit JPG-7] and of pages of Multi-Marques’ website [par. 27, Exhibit JPG-8].

[33] Mr. Galardo appends to his affidavit a copy of application No. 1,122,704 filed by Pom Bakery on November 23, 2001 as evidence of the intended use of the trade-mark POM in association with a very diverse range of wares, including fruit juices and beverages [par. 20, Exhibit JPG-6].

#### Applicant’s Evidence

[34] The Applicant’s evidence of record consists of affidavits of Finiam James O’Driscoll of March 16, 2009, including its Exhibits A-1 to F-3, and Petra J. McDonald of March 13, 2009, including its Exhibits A to D. Only Mr. O’Driscoll was cross-examined by the Opponent. The

transcript of the cross-examination was filed by the Opponent with leave from the Registrar (decision of March 30, 2010) as were the replies to undertakings (decision of July 20, 2010). I will refer to the cross-examination of Mr. O’Driscoll to the extent that it is relevant to my consideration of his affidavit and the parties’ submissions.

*Affidavit and cross-examination of Finiam James O’Driscoll*

[35] Mr. O’Driscoll has been employed by the Applicant, a corporation organized under the laws of Scotland, since February 2001. He started as Commercial Manager, then moved to Commercial Director and has been the Applicant’s Managing Director since the beginning of 2009 [par. 1, Q48-Q49].

[36] According to Mr. O’Driscoll’s statements, he is familiar with the Applicant’s business activities in the United Kingdom as well as in foreign countries, including Canada. He comes to Canada at least six times per year mostly in the province of Ontario, but also in the provinces of Quebec, British Columbia, Nova Scotia and Newfoundland, to oversee the distribution of the Applicant’s products. He visits retail outlets where the Applicant’s products are sold, meet with the Applicant’s sales representatives and distributors, and generally reviews the market including the products of the Applicant’s competitors [par. 2].

[37] Mr. O’Driscoll’s states that he has over twenty years experience in the alcoholic beverage industry and “is an expert in the alcoholic beverages business including the distribution, sale and promotion thereof, in Canada and elsewhere in the world” [par. 4]. His statements lead me to address the parties’ submissions as to the acceptability of Mr. O’Driscoll’s testimony based on his expertise in the alcoholic beverage industry.

[38] I agree with the Opponent that Mr. O’Driscoll has failed to qualify himself as an expert of the Canadian alcoholic beverages industry. However, I see no reason to doubt the reliability of his evidence as to the channels of trade associated with the Mark in Canada. I would add that I agree with the Applicant that it is clear from his cross-examination that Mr. O’Driscoll has travelled extensively in Canada for business. That being said, the Applicant did not convince me that Mr. O’Driscoll’s testimony based on his experience in the alcoholic beverages industry should be afforded more weight than Mr. Galardo’s testimony. In other words, I will not afford

weight to Mr. O’Driscoll’s statements that go to the questions of facts and law to be determined by the Registrar in the present proceeding.

[39] According to Mr. O’Driscoll’s testimony, in Canada the Applicant’s alcoholic beverages, including the wares associated with the Mark, have only been sold in retail stores, licensed bars and restaurants pursuant to the laws and regulations set out in the province in which that place is located [pars. 7 and 16]. The Applicant’s alcoholic beverages are sold in Quebec in SAQ controlled liquor stores and in Ontario in LCBO stores [par. 7].

[40] Mr. O’Driscoll states in his affidavit that the POMTINI alcoholic beverages cannot be sold in grocery stores in any province in Canada and goes on to say: “In other words, there is no province in Canada where a customer could purchase baked goods along with alcohol. The two stores must be separate.” [par. 16]. On cross-examination, Mr. O’Driscoll testifies that in Alberta, the Applicant’s alcoholic beverages can be sold outside of the liquor board controlled stores, “[b]ut again, they are controlled in a liquor sales environment” [Q135]. To explain what he means by a liquor sales environment, Mr. O’Driscoll testifies that “the store in question has a license to sell hard liquor” [Q136]. In response to the question whether the store can be a store that sells other products or must be a store that sells only liquor, Mr. O’Driscoll testifies: “My knowledge is that it has to have a segregated area of the store for selling the hard liquor” [Q137]. In other areas of the store, “[i]t can sell other products that are not hard liquor” [Q138]. Mr. O’Driscoll elaborates that the segregated area is “a segregated store within a store” [Q155]. He understands that the segregated store “has to have a separate entrance” [Q156].

[41] According to Mr. O’Driscoll’s statements, the Applicant licensed companies to promote and sell its products in Canada, including the wares associated with the Mark, to the government regulated retail stores and to licensed bars and restaurants. The Kirkwood Group (Kirkwood) and Bruce Ashley Group (Ashley Group) are two of the licensed representatives of the Applicant in Canada [pars. 8, 19-20].

[42] Mr. O’Driscoll files a Certificate of Authenticity of registration No. TMA693,310 for the trade-mark POMTINI owned by the Applicant [par. 9, Exhibit B]. He affirms that the Opponent did not oppose the corresponding application [par. 10].

[43] Mr. O’Driscoll states that the “POMTINI product as sold since April 2006 falls within the wares listed in (1) and (2)” in the application for the Mark [par. 13]. He goes on to state that the product bearing the Mark “is a spirit cooler comprised of premium, quadruple-distilled vodka with juices, such as pomegranate, blueberries. The product is primary a ‘cooler’ which is an alcoholic-based beverage, i.e. vodka-based, in combination with juices.” [par. 14].

[44] According to Mr. O’Driscoll’s statements, the wares associated with the Mark are sold in each Canadian province. There were 3.8 million bottles of POMTINI cooler sold in 2007 and more than 3.6 million bottles sold in 2008. As of December 5, 2008, POMTINI alcoholic beverages had captured 20.74% of the Canadian market share [par. 17]. I am not affording weight to the affiant’s statement on the Applicant’s share of the Canadian market as it is based on statistics provided by a third party and thus constitutes inadmissible hearsay evidence. Further no reasons were given as to why a person having direct knowledge could not have provided the evidence [see *R. v. Khan* [1990] 2 S.C.R. 531].

[45] Mr. O’Driscoll states that the wares bearing the Mark are always sold in 4-pack cartons [par. 18]. He files a representative 4-pack carton bearing the Mark [Exhibit D-1]. On cross-examination, Mr. O’Driscoll testifies that the POMTINI product could be sold by single bottle in the LCBO stores, in restaurants and bars [Q167-Q168]. The Mark is also on the bottles [Q180].

[46] According to the yearly breakdown provided by Mr. O’Driscoll, the total approximate value of Canadian sales of coolers in association with the Mark exceeded \$20.9 million for the years 2006 to 2008 [par. 21]. Mr. O’Driscoll files copies of representative invoices [par. 21, Exhibit D-3]. The average price of a 4-pack is \$9.95 [Q186].

[47] According to Mr. O’Driscoll’s statements, from 2006 to 2008 the Applicant spent more than \$1,131,000 for advertising and promoting the Mark throughout Canada in partnership with Ashley Group and Kirkwood [par. 22]. The means of promotion and advertising include: promotion within the government regulated stores; sampling in licensed bars, restaurants and at trade shows; temporary price reduction within certain provincial liquor stores; advertisements in trade publications [pars. 23-24, 26-28, Exhibits E-1, E-3 to E-5]. In reply to an undertaking, the Applicant confirmed that there has been billboard advertising. The POMTINI vodka

pomegranate cooler won the 2007 Elsie Award of the LCBO for “Best New Product Launch” for beers and special markets [par. 24, Exhibit E-2].

*Affidavit of Petra J. McDonald*

[48] At the time of her affidavit Ms. McDonald, a registered trade-mark agent since April 1984, was employed by the then trade-marks agent of the Applicant [par. 1].

[49] On March 10, 2009, Ms. McDonald conducted a search of the Canadian Trade-marks Office record, via *Namereporter*, for trade-marks including the prefix “pom” and alcoholic or non-alcoholic beverages in the statement of wares. She files a chart identifying the results of her search [par. 5, Exhibit A].

[50] Throughout her affidavit, Ms. McDonald makes several observations as to the results of the aforementioned search. Among others, Ms. McDonald mentions that 13 trade-marks are owned by PomWonderful LLC. She files pages from the website *www.pomwonderful.com* and states that the listed products are non-alcoholic [par. 6, Exhibit B].

[51] Ms. McDonald lists in her affidavit 17 trade-marks noted in Exhibit A, stating that they include the prefix “pom” only and are for alcoholic wares [par. 7]. She accessed the website of the LCBO to locate any product listing having the prefix “pom” and files the results of her search, once again making several observations [par. 7, Exhibit C]. She also accessed the website to locate POMMERY products [par. 8, Exhibit D].

[52] Ms. McDonald concludes her affidavit by opining that the Mark should be allowed to co-exist with the Opponent’s marks and to be registered.

[53] Since Ms. McDonald was an employee of the Applicant’s agent at the time of her affidavit, I cannot agree with the Applicant’s position that she should not be considered biased. I would add that I find the Applicant’s position that Ms. McDonald’s affidavit is “factual in nature” to be somewhat contradicted by its contention that the affidavit “centered around disputing the Opponent’s allegation of confusion with its registered marks, primarily for bread-type products”. Regardless of her qualifications as a registered trade-mark agent, in the circumstances of this case, Ms. McDonald is clearly not an independent witness giving unbiased

evidence [see *Cross Canada Auto Body Supply (Windsor) Limited et al. v. Hyundai Auto Canada* (2005) F.C. 1254]. In the end, I find that no weight should be given to those portions of her affidavit that contains argument as opposed to evidence.

### Analysis of the Grounds of Opposition

[54] Before analyzing the grounds of opposition, I wish to make preliminary remarks to partly deal with submissions from the parties.

#### Preliminary Remarks

[55] The ownership of registration No. TMA693,310 for the word trade-mark POMTINI does not give the Applicant the automatic right to the registration of the Mark no matter how closely the trade-marks may be related [see *American Cyanamid Co. v. Stanley Pharmaceuticals Ltd.* (1996), 74 C.P.R. (3d) 571 (T.M.O.B.); *Ralston Purina Canada Inc. v. H.J. Heinz Co. of Canada* (2000), 6 C.P.R. (4th) 394 (T.M.O.B.)]. Further, I do not afford any significance to the fact that the Opponent did not oppose the application that matures in the said registration.

[56] At the oral hearing, the Applicant's agent observed that product packages filed as Exhibit JPG-2 to the Galardo affidavit identify Multi-Marques as the owner of the trade-marks. In reply, the Opponent's agent explained this marking by submitting that Multi-Marques could have owned the trade-marks at one point in time. I would remark that if such was the case, no evidence was filed to this effect. In fact, according to the Galardo affidavit, the evidence introduced by the Opponent relates to the trade-marks under the ownership of Pom Bakery. That being said, at the oral hearing the Applicant's agent indicated that the Applicant does not dispute that the Opponent's evidence establishes that the marks under the ownership of Pom Bakery were used by Multi-Marques according to the license requirements set out in s. 50 of the Act.

[57] I agree with the Applicant that the Opponent's evidence fails to establish use of any trade-name that includes the word "pom".

[58] The Opponent requests that I take cognizance of the fact that it now owns the trade-marks of PomWonderful LLC identified in Exhibit A to the McDonald affidavit. I will not do so because in opposition proceedings the Registrar does not exercise his discretion to have regard to

anything appearing on the register that is not properly proved by evidence, except to verify whether properly pleaded trade-mark registrations and applications are extant [see *Quaker Oats Co. of Canada v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.); *Royal Appliance Mfg. Co. v. Iona Appliance Inc.* (1990), 32 C.P.R. (3d) 525 (T.M.O.B.)].

Non-conformity to s. 30 of the Act

[59] The material date for considering the circumstances with respect to the grounds of opposition based upon non-conformity to s. 30 of the Act is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)].

Non-conformity to s. 30(b) of the Act

[60] The pleaded ground of opposition, which is reproduced hereafter, alleges that the application does not contain the date as of which the Applicant has used the Mark in Canada in association with wares, and that even if the Mark has been used in Canada it was not used on April 7, 2006 in association with all of the applied-for wares and has not been continuously used since that date.

*... la Demande ne renferme pas la date à compter de laquelle la Requérente ou l'un de ses prédécesseurs en titre désignés, s'il en est, a employé la Marque au Canada en liaison avec des marchandises. En effet, l'Opposante conteste énergiquement l'allégué contenu dans la demande à l'effet que la Requérente (ou un de ses prédécesseurs en titre) aurait employé la Marque au Canada, et plus particulièrement que le Marque aurait été employé en liaison avec des marchandises à quelque date que ce soit et plus particulièrement à la date mentionnée dans la Demande ou depuis cette date.*

*De plus, même si la Marque a été utilisée au Canada, ce que l'Opposante nie, la Marque n'était pas employée (au sens de l'article 4(1)) par la Requérente (ou un de ses prédécesseurs en titre) au Canada le 7 avril 2006, en liaison avec toutes les marchandises mentionnées dans la demande et n'a pas été continuellement ainsi employée depuis cette date.*

[61] To the extent that the relevant facts are more readily available to the applicant, the evidentiary burden on an opponent with respect to a s. 30(b) ground of opposition is lower [see *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.)]. Also, an opponent may rely upon the applicant's evidence to meet its initial burden,

but an opponent must show that the evidence is clearly inconsistent with the applicant's claim as set forth in the application [see *York Barbell Holdings Ltd. v. ICON Health & Fitness Inc.* (2001), 13 C.P.R. (4th) 156 (T.M.O.B.)]. Furthermore, s. 30(b) of the Act requires that there be continuous use of the applied for trade-mark in the normal course of trade from the date claimed to the date of filing of the application [see *Labatt Brewing Co. v. Benson & Hedges (Canada) Ltd.* (1996), 67 C.P.R. (3d) 258 (F.C.T.D.)].

[62] In the present case, the Opponent did not file any evidence in support of this ground of opposition. The Opponent relies on the Applicant's evidence to meet its initial burden. More particularly, in its written argument, the Opponent submits that the only evidence furnished by the Applicant regarding the use of the Mark in Canada is through invoices and promotional materials attached to the O'Driscoll affidavit, none of which is dated April 7, 2006 or earlier. The Opponent further submits that the only invoice for the year 2006 is dated October 19, 2006 and the Applicant did not explain why it could not furnish invoices demonstrating sale of the wares in Canada in association with the Mark on or before April 7, 2006. Finally, the Opponent submits that the Applicant has not filed evidence to support its claimed date of first use and therefore has failed to meet its evidentiary burden in this regard.

[63] At the oral hearing, I indicated to the Opponent's agent that I disagreed with the submissions that the evidence of use of the Mark was restricted to invoices and promotional material as exhibits to the O'Driscoll affidavit showed the Mark displayed on a 4-pack carton and on bottles. I also indicated that contrary to the Opponent's submission, the Applicant did not have the *initial* burden of proving use of the Mark as of the date claimed in the application. Accordingly, I specifically asked the Opponent's agent to discuss the inconsistencies in the Applicant's evidence. In reply to my request, the Opponent's agent essentially reiterated the submissions that the earliest invoice accompanying the O'Driscoll affidavit is dated October 19, 2006 and there is no explanation why the Applicant could not furnish invoices demonstrating sale of the wares in Canada on or before April 7, 2006.

[64] In view of the above and considering the Opponent's submissions, what must be determined is whether the Applicant's evidence is clearly inconsistent with the date of first use of the Mark claimed in the application. In my view, considering the testimony of Mr. O'Driscoll



in its entirety, this is not such a case. Suffice it to say that in addition to providing specimens showing use of the Mark, the O’Driscoll affidavit contains statements specifically referencing sales in Canada since April 2006. I would add that, according to my reading of the cross-examination transcript, those statements have not been challenged by the Opponent nor did the Opponent request an undertaking for the production of invoices dated April 7, 2006 or before.

[65] In the end, I conclude that there is nothing inconsistent between Mr. O’Driscoll’s testimony and the Applicant claiming April 7, 2006 as the date of first use of the Mark in Canada. Hence, I dismiss the ground of opposition based upon non-conformity to s. 30(b) of the Act for the Opponent’s failure to meet its evidential burden.

Non-conformity to s. 30(i) of the Act

[66] I dismiss the ground of opposition because the allegation that the Applicant should have been aware of the use of the Opponent’s trade-marks does not raise a proper ground of opposition. Section 30(i) of the Act only requires that an applicant declares itself satisfied that it is entitled to use the applied-for mark. Such statement is included in the application for the Mark. Further, the mere knowledge of an opponent’s rights, at the filing date of the application, is not sufficient to succeed under a s. 30(i) ground of opposition. Section 30(i) of the Act can sometimes be the basis of a ground of opposition in specific cases, such as where by faith on the part of the applicant is alleged and established or if specific statutory provisions prevent the registration of the applied-for mark [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) and *Canada Post Corporation v. Registrar of Trade-marks* (1991), 40 C.P.R. (3d) 221 (F.C.T.D.)]. This is not such a case.

Registrability pursuant to s. 12(1)(d) of the Act

[67] The material date that applies to the registrability ground of opposition 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.)].

[68] Mr. Galardo states in his affidavit that the agent of Multi-Marques will file certified copies of registration Nos. TMA469,001, UCA40516, TMDA49765 and TMA335,814. Yet, certified copies of the registrations were not filed as part of the Opponent's evidence. Nonetheless, I have exercised the Registrar's discretion to check the register so as to confirm the existence of the registrations alleged in support of the ground of opposition [see *Quaker Oats Co. of Canada, supra*]. I note that according to the footnotes to each of the registration pages, the Canadian Intellectual Property Office recorded Canada Bread as owner of the registrations on March 24, 2010 further to an assignment of January 3, 2010 from Pom Bakery, their original owner. In other words, the registrations support my previous remark that the evidence introduced by the Galardo affidavit is directed to the use of the registered marks under the ownership of Pom Bakery.

[69] The Opponent's initial burden under s. 12(1)(d) of the Act has been met because each registration is extant. Therefore, the question becomes whether the Applicant has met the legal onus that lies on it to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's registered trade-marks.

[70] 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.

[71] In applying the test for confusion, I 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 the trade-marks have 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 *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401

(S.C.C.); and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 for a thorough discussion of the general principles that govern the test for confusion].

[72] In view of the evidence of record, I find that the Opponent's case is strongest with respect to the trade-mark POM of registration No. TMDA49765. Thus, comparing the Mark with the trade-mark POM will effectively decide the outcome of the ground of opposition. In other words, if it is found that the Mark is not likely to cause confusion with the registered trade-mark POM, it cannot be found that the Mark is likely to cause confusion with any of the remaining registered trade-marks alleged by the Opponent.

#### Consideration of the s. 6(5) factors

[73] I do not intend to discuss at length the factors set out in s. 6(5)(a) and (b) of the Act and the parties' submissions with respect thereto because I believe that those factors are not significant in the present case. I will only express the opinion that I find both trade-marks to be inherently distinctive and to have become known in Canada through promotion and use so as to benefit of acquired distinctiveness. Also, while the Opponent's evidence satisfactorily establishes that the use of its trade-mark POM predates the use of the Mark, I find that the evidence introduced by the Galardo affidavit is insufficient to establish continuous use of the Opponent's mark since 1930.

[74] In my opinion, the factors set out in s. 6(5)(c), (d) and (e) are the most significant in the present proceeding and I will turn to their consideration.

[75] It is the statement of wares in the application and the statement of wares in the registration that must be taken into consideration when assessing the s. 6(5)(c) and (d) factors under the registrability ground of opposition [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe, Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)].

[76] The trade-mark POM is registered in association with "bread, cake and confectionery namely pastries, cookies, waffles and candies". Obviously, I cannot disagree with the Opponent's submissions that the registered wares are "food products and alimentary products".

However, with due respect, I cannot agree with the Opponent's submissions that the alcoholic based beverages, as described in the application for the Mark, "are themselves food products and alimentary products". Further, I do not consider alcoholic beverages to be part of the same industry as food products.

[77] The Opponent submits that the parties' channels of trade are the same or could be the same. In support of its position, the Opponent contends that Mr. O'Driscoll admitted on cross-examination that the Applicant's wares may be sold in the same establishments as grocery products at least in Alberta. The Opponent further submits that Mr. O'Driscoll's oral testimony is a "clear contradiction" of his written testimony that the Applicant's wares have only been sold in controlled liquor stores.

[78] To the extent that Mr. O'Driscoll testifies that hard liquors sold in a grocery store in Alberta are sold in a segregated store within the grocery store with a separate entrance [see paragraph 40 of my decision], I tend to agree with the Applicant's oral argument that the Opponent is mischaracterizing Mr. O'Driscoll's testimony. In any event, even if one considers that the Opponent rightly submits that Mr. O'Driscoll's oral testimony supports a finding that the Applicant's wares may be sold in the same establishments as grocery products in Alberta, in my opinion the potential overlap in the channels of trade is outweighed by the differences between the nature of the parties' wares.

[79] In the end, the Opponent did not convince me that it is significantly favoured by the overall consideration of s. 6(5)(c) and (d) of the Act.

[80] Turning to the factor set out at s. 6(5)(e), it is trite law that when assessing the degree of resemblance between two marks they are to be looked at in their entirety and not dissected [see *British Drug Houses Ltd. v. Battle Pharmaceuticals* (1944), 4 C.P.R. 48 at 56 (Can. Ex. Ct.), affirmed (1946), 5 C.P.R. 71 (S.C.C.)]. Also, this factor "is often likely to have the greatest effect on the confusion analysis" [see *Masterpiece, supra*]. In his discussion of the approach to be taken in assessing the resemblance between trade-marks, Mr. Justice Rothstein stated in *Masterpiece*, at paragraph 64: "While the first word may, for the purposes of distinctiveness, be the most important in some cases, I think the preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique."

[81] The Opponent's submissions with respect to the degree of resemblance between the trade-marks in appearance, sound and in the ideas suggested by them are basically found at paragraph 76 of its written argument, which reads as follows: "As the Applicant's [Mark] shares the same format as the Opponent's [POM mark], possessing the term POM as its prefix, it is therefore identical thereto in appearance, sound and in meaning." I disagree with the Opponent's contention. I agree with the Applicant that there are significant differences between the marks at issue in appearance and in sound. I also agree with the Applicant that in view of the word "vodka" forming the stylized "i" of the Mark, the latter suggests the idea of alcoholic beverages, which is not an idea suggested by the trade-mark POM.

[82] The Applicant's evidence and submissions advance the state of the register and the absence of actual confusion as additional surrounding circumstances. However, I find it unnecessary to consider those additional circumstances to find in favour of the Applicant.

[83] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. In view of my conclusions above, and in particular the differences in the nature of the parties' wares as well as the differences between the trade-marks in appearance, sound and in the ideas suggested by them, I arrive at the conclusion that the Applicant has discharged its burden of establishing, on a balance of probabilities, that the Mark is not confusing with the trade-mark POM of registration No. TMDA49765.

[84] As I previously indicated, I find that comparing the Mark with the Opponent's trade-mark POM of registration No. TMDA49765 effectively decides the outcome of the ground of opposition. Accordingly, the s. 12(1)(d) ground of opposition is dismissed in its entirety.

#### Non-entitlement pursuant to s. 16(2) and 16(3) of the Act

[85] As the application for the Mark is based upon use in Canada, each of the grounds of opposition based upon s. 16(2) and s. 16(3) of the Act is improperly pleaded. Further, there has been no submissions from the Opponent to suggest that the inaccurate references to s. 16(2)(a) to (c) and s. 16(3)(a) to (c) of the Act are clerical errors. In fact, as previously discussed, the Opponent did not make any submissions whatsoever on the deficiency of the non-entitlement grounds of opposition at the oral hearing. Moreover, as each of the pleading refers to the filing

date of the application for the Mark, which is the relevant date under s. 16(2) and s 16(3) of the Act, I am not prepared to infer that the Opponent meant to refer to s. 16(1) of the Act for which the relevant date is the date of first use claimed in the application. Thus, given the circumstances of this case, I find it would not be appropriate to consider the references to s. 16(2) and s. 16(3) of the Act, rather than s. 16(1), as merely clerical errors.

[86] Having regard to the foregoing, I dismiss each of the non-entitlement grounds of opposition for having been improperly pleaded. For all intent and purposes, I wish to add that even if the Opponent had relied upon s. 16(1)(a) to (c) in support of its non-entitlement grounds of opposition, considering the evidence of record, I would likely have dismissed each of the non-entitlement grounds of opposition.

#### Disposition

[87] Having regard to the foregoing, 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.

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Céline Tremblay  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office