



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

**Citation: 2014 TMOB 157**  
**Date of Decision: 2014-07-31**

**IN THE MATTER OF AN OPPOSITION**  
**by Pepperidge Farm, Incorporated to**  
**application No. 1,467,149 for the trade-**  
**mark ECCO IL PANE in the name of**  
**A. Bosa & Co. Ltd.**

[1] A. Bosa & Co. Ltd. (the Applicant) has applied for the trade-mark ECCO IL PANE for use with a variety of bakery and confectionary products. Pepperidge Farm, Incorporated (the Opponent) has primarily opposed this application on the basis that the trade-mark ECCO IL PANE is confusing with its registrations for and use of the trade-mark ECCE PANIS in association with bakery goods and retail bakery services.

[2] For the reasons that follow, I find that the opposition should be rejected.

Background

[3] On January 26, 2010, the application for the trade-mark ECCO IL PANE (the Mark) based on proposed use in association with the following wares (as amended) (the Wares) was filed in the name of A. Bosa & Co.

Food products, namely bakery products namely, bread, breadsticks, biscuits, cakes, Italian specialties namely, torrone, panettone, gubana, and crackers, pies and spreads namely jams, jellies, fruit dessert spreads, chocolate dessert spreads, and nut dessert spreads, and confectionery products, namely: pastries, candies, and chocolate.

The Applicant subsequently confirmed that there was a typographical error “where the legal designation of ‘Ltd.’ inadvertently was left out.” The application was advertised for opposition purposes in the *Trade-marks Journal* of August 3, 2011.

[4] On October 3, 2011, the Opponent opposed the application on four grounds. The Opponent pleads that the application does not comply with sections 30(e) and 30(i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) on the basis that the Applicant was misidentified in the application as filed. The Opponent pleads that the application is not registrable pursuant to section 12(1)(d) of the Act as it is confusing with the Opponent’s registration Nos. TMA742,000 and TMA742,001 for the trade-mark ECCE PANIS. The remaining two grounds of opposition turn on the determination of the likelihood of confusion between the Mark and the Opponent’s use of the ECCE PANIS trade-mark (see sections 2 and 16 of the Act). The Applicant filed and served a counter statement in which it denies the Opponent’s allegations.

[5] The Opponent filed as its evidence the affidavits of Graham Cornech, Business Director for Dinner, Artisan, Seasonal and Dessert of the Opponent, and Karen Thompson, a trade-mark searcher employed by its agent, and certified copies of its registrations. The Applicant filed as its evidence the affidavit of Chris MacDonald, Business Development Manager of the Applicant. As its reply evidence, the Opponent filed the affidavit of Joanne Araus, a law clerk employed by its agent. Both parties filed a written argument. No hearing was held.

#### Onus and Material Dates

[6] 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 CPR (3d) 293 (FCTD) at 298].

[7] The material dates with respect to the grounds of opposition are as follows:

- sections 38(2)(a)/30 of the Act - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475]. However, where

an application is amended after filing, the amendment is to be considered [*Ipex Inc v Royal Group Inc* (2009), 77 CPR (4th) 297 (TMOB) at para 34];

- sections 38(2)(b)/12(1)(d) of the Act - the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- sections 38(2)(c)/16(3)(a) of the Act – the date of filing the application;
- and section 38(2)(d) of the Act - the date of filing the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

### Section 30 Ground of Opposition

[8] The Opponent has opposed the application on the basis of non-compliance with section 30. This ground of opposition is set out below:

Section 30 of the [Act] requires the applicant to be identified in the application, and to include certain statements made by the applicant, including for a proposed use application, the statements required by subsections 30(e) and 30(i). The application does not comply with these requirements in that the original application was filed in the wrong name, and the applicant that was identified did not intend to use the trade-mark, and could not have been satisfied that it was entitled to use the trade-mark. The subsequent amendment to the applicant's name was improper, in that the applicant did not file sworn evidence attesting that no company by the name "A. Bosa & Co." existed at the time the application was filed.

[9] The initial burden on the Opponent is light with respect to this ground of opposition because the facts regarding the entity that filed the application and the statements of intention to use and entitlement made in the application are particularly within the knowledge of the Applicant [*Tune Masters v Mr P.'s Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89]. An opponent can meet its evidential burden by reference to the actions taken by an applicant during prosecution of the application [*SmithKline Beecham Corp v Pierre Fabre Médicament*, [1998] TMOB No 141 at para 10]. If there is an amendment to the name of the applicant, the Registrar may consider the propriety of the amendment if challenged by an opponent [*LendingTree, LLC v Lending Tree Corp* 2006 FC 373 (CanLII) at paras 19-20, (2006), 48 CPR (4th) 355 (FC), aff'd 2007 FCA 70 (CanLII), (2007), 55 CPR (4th) 385 (FCA)].

[10] The application for the Mark was filed on January 26, 2010 in the name of A. Bosa & Co. On September 23, 2010, the Applicant confirmed that it was a legal entity and a typographical

error was contained in the Applicant's name "where the legal designation of 'Ltd.' inadvertently was left out." Mr. MacDonald states in his affidavit that A. Bosa & Co. Ltd. was incorporated on January 29, 1957 (para 2). Mr. MacDonald indicates that he instructed KLS Trademark Services to file applications to register the trade-marks ECCO IL PANE and ECCO IL BISCOTTI in the name of A. Bosa & Co. Ltd. and that the unincorporated company "A. Bosa & Co." does not exist (para 5). I note that Mr. MacDonald was not cross-examined on his affidavit. Further, the Opponent has not adduced any evidence which contradicts or refutes Mr. MacDonald's evidence.

[11] The Opponent argues that the Applicant was required to submit sworn evidence that no company with the name "A. Bosa & Co." existed at the time the application was filed. No such statement has been submitted by way of affidavit. However, I do not find that a sworn statement was required. I note that there is no evidence that "Co." designates a legal entity and the *Trade-marks Examination Manual* indicates in section II.5.1.7 Wrong Identification of Applicant that:

When an application is filed in the name of a non-legal entity, no affidavit is required to correct the applicant's name to a legal entity such as changing Farm Foods to Farm Foods Ltd. or to Mary Smith trading as Farm Foods.

[12] When viewed as a whole, the evidence does not support the inference that the application was filed by an entity other than the Applicant or that the amendment was improper. To the contrary, the Applicant has indicated that there was a typographical error in the application as filed and stated that the Applicant was in existence at the date of filing. Thus, I find that the Opponent has failed to meet its burden under this ground. Accordingly, this ground of opposition is rejected.

#### Section 12(1)(d) Ground of Opposition

[13] I have exercised my discretion and checked the register to confirm that the registrations relied on by the Opponent, and set out below, are extant [*Quaker Oats Co Ltd of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Therefore, the Opponent has met its initial burden.

Registration No.	Trade-mark	Wares
TMA742,000	ECCE PANIS	retail bakery services
TMA742,001	ECCE PANIS	bakery goods

[14] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated that the use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would likely lead to the inference that the wares and services associated with those trade-marks are manufactured, sold or leased by the same person, whether or not the wares and services are of the same general class. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the wares and 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.

[15] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Mattel, Inc v 3894207 Canada Inc*, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* [2011] 2 SCR 387 at paragraph 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

[16] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the Mark when he or she has no more than an imperfect recollection of the Opponent's ECCE PANIS trade-mark and does not pause to give the matter any detailed consideration or scrutiny [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* [2006] 1 SCR 824 at para 20]. Furthermore, this consumer is either Anglophone, Francophone or bilingual in English and French [*Pierre Fabre Médicament v SmithKline Beecham Corp* (2001), 11 CPR (4th) 1 at para 15 (FCA)].

*Inherent distinctiveness*

[17] The Applicant states that the Mark is in Italian and means “Here the bread”. The Opponent’s registrations state that ECCE PANIS means “behold the bread”. In its written argument, the Opponent states that ECCE PANIS is a Latin term.

[18] There is no evidence that the average Canadian would know the meaning of either ECCE PANIS or ECCO IL PANE. Therefore, the marks of each party are inherently distinctive [*Thai Agri Foods Public Co v Choy Foong Int’l Trading Co Inc*, 2012 TMOB 61 at para 11]. Therefore, this factor favours neither party.

*Extent known and length of time in use*

[19] A trade-mark may also acquire distinctiveness through use or promotion. The Applicant’s evidence is silent on whether use of the Mark has commenced. Mr. Corneck provides:

- that the Opponent has used the ECCE PANIS trade-mark in association with bakery goods sold at the retail level in the United States and Canada (para 4);
- one sample of packaging for bread showing the ECCE PANIS trade-mark which he says is representative of Canadian packaging (para 4; Exhibit A); and
- that the Opponent markets its ECCE PANIS bread on the *www.eccepanis.com* website which features the ECCE PANIS trade-mark (para 5; Exhibit B).

[20] Although the Opponent does not provide evidence as to the extent or length of use, in contrast to the Applicant, it has evidenced at least some use. Accordingly, these factors favour the Opponent.

*Nature of the wares, services or business; and nature of the trade*

[21] The nature of the wares significantly favours the Opponent as the wares of each party overlap in that the Wares include bakery products such as bread and pastries and spreads which

may be used in conjunction with breads. With no evidence of the nature of trade of either party, I infer this would also overlap.

#### *Degree of resemblance*

[22] In *Masterpiece Inc, supra*, the Supreme Court of Canada indicates that the most important factor under section 6(5) of the Act will often be the degree of resemblance between the marks. Although the parties' trade-marks both include four letter words beginning with ECC and PAN, I find that the trade-marks as a whole have a different appearance and sound due to their different component parts.

[23] Confusion will be unlikely in situations where marks share common features but also feature dominant differences [see *Foodcorp Ltd v Chalet Bar B Q (Canada) Inc* (1982), 66 CPR (2d) 56 at 73 (FCA)]. The Opponent's focus on the individual parts of words that are the same, appears to involve a side-by-side comparison of the type warned against by the courts [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée supra*; and *International Stars SA v Simon Chang Design Inc*, 2013 FC 1041 at para 9].

[24] Furthermore, the parties' trade-marks cannot be said to suggest the same idea to the ordinary consumer. As neither the trade-marks ECCE PANIS nor ECCO IL PANE consist of words in the English or French language, it seems likely that consumers would respond to both marks as either being invented or in a foreign language. Although when translated the marks suggest similar ideas "behold the bread" and "here the bread", the average Canadian not being familiar with Latin or Italian, would not find any resemblance between the ideas suggested.

#### *Similarity of Words in Latin, Italian and French*

[25] Ms. Auras provides a copy of the definitions for the French word "pain" in three French-English dictionaries showing in each case "pain" means "bread" (Exhibits A1-A3). She also attaches a copy of the definition for "pain" from the French dictionary *Le Petit Robert 1* which shows that the French word "pain" is derived from the latin word "panis" (Exhibit B). The Opponent submits in its written argument that the average consumer would believe the Mark has the same meaning as ECCE PANIS since Italian and French both have roots in Latin and

many words, including bread, are similar in these languages. While consumers may recognize that these languages have common roots and find that the marks both possess a Latin connotation owing to these roots, the evidence does not show that as a matter of first impression without detailed analysis francophone or bilingual consumers would find the marks resemble each other.

*State of the register evidence*

[26] Ms. Thompson's affidavit includes a state of the register search to locate trade-marks that consist of or include words with the components ECC and PAN (Exhibits B, C1-C7). While Ms. Thompson's evidence may show that no other such mark has been applied-for or registered for related wares and services, I do not find that this results in the inference that consumers will find the Mark confusing with the trade-mark ECCE PANIS.

[27] Mr. MacDonald attaches to his affidavit two NUANS reports for the word ECCO dated September 20, 2011 and February 21, 2013 (paras 9-10; Exhibits F and G). The Opponent objects to this evidence on the basis that there is no evidence that Mr. MacDonald conducted these searches. On this basis, I find these exhibits inadmissible.

*Conclusion*

[28] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the Mark when he or she has no more than an imperfect recollection of the Opponent's ECCE PANIS trade-mark, and does not pause to give the matter any detailed consideration or scrutiny [*Veuve Clicquot Ponsardin, supra*]. I conclude that, on a balance of probabilities, there is no reasonable likelihood of confusion between the Opponent's trade-mark and the Mark given the differences between the parties' marks. Accordingly, the section 12(1)(d) ground of opposition is rejected.

Section 16(3)(a)

[29] The Opponent alleges that the Applicant is not the person entitled to register the Mark as it is confusing with its prior use of the ECCE PANIS trade-mark. In order to satisfy its evidential burden, the Opponent must evidence use of this trade-mark as of the filing date of January 26, 2010 and that such use had not been abandoned as of August 3, 2011, the date of



advertisement of the application of the Mark. As there is no evidence that the ECCE PANIS trade-mark was in use at these dates, the Opponent has not met its initial burden and this ground of opposition is rejected.

#### Distinctiveness

[30] The Opponent alleges that the Mark is not distinctive. In order to satisfy its evidential burden, the Opponent must establish that as of October 3, 2011, the date of filing the statement of opposition that its ECCE PANIS trade-mark was known to such an extent it could negate the distinctiveness of the Mark [*Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC) at paras 33-34]. As no evidence showing that the ECCE PANIS trade-mark is known to such an extent has been filed, the Opponent has not met its initial burden and this ground of opposition is rejected.

#### Disposition

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

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Natalie de Paulsen  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office