

**IN THE MATTER OF AN OPPOSITION by Astro Dairy Products Limited to application No. 616,615 for the trade-mark BIO DANONE & Design filed by Compagnie Gervais Danone, une société anonyme**

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On October 5, 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 applicant claimed the following colours as characteristics of its trade-mark:

“Un rectangle dont les extrémités verticales sont VERT CLAIR vers le centre à l'intérieur duquel l'on retrouve: le mot BIO en lettre BLANCHE surmonté d'un point JAUNE et souligné d'un trait JAUNE; un hexagone dont le contour est BLANC, la partie supérieure interne est BLEU FONCÉ portant le mot DANONE en BLANC et la partie inférieure interne est BLEU PALE”

[Translation: A rectangle whose vertical ends are light green toward the centre; inside the rectangle, the word BIO in white letters surmounted by a yellow dot and underlined by a yellow line; a hexagon whose outline is white; the upper inner part is dark blue, and contains the word DANONE in white, and the lower inner part is pale blue].



The trade-mark was advertised for opposition purposes in the *Trade-marks Journal* of July 7, 1993 and the opponent, Astro Dairy Products Limited, filed a statement of opposition on June 1, 1994, a copy of which was forwarded to the applicant on August 17, 1994. The opponent alleged the following grounds of opposition in its statement of opposition:

(a) 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 registered trade-mark BIOBEST, registration No. 350,094;

(b) 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 July 7, 1993 in connection with biologically cultured dairy products;

(c) The applicant's trade-mark 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 including those, the particulars of which are annexed as Schedule 1, for use with wares related to those covered in the present application.

The applicant served and filed a counter statement in which it generally denied the opponent's grounds of opposition. The opponent filed as its evidence statutory declarations of Jennifer N. Garrett and Jack Marshall while the applicant submitted as its evidence the affidavit of Karen Smythe. Both parties filed written arguments and both parties were represented at an oral hearing.

The first 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 its registered trade-mark BIOBEST, registration No. 350,094. 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 mark. While the word BIO, the dominant element of the applicant's mark, is suggestive of the applicant's wares, the word DANONE appears to be a coined term. Moreover, the design elements add to the inherent distinctiveness of the applicant's trade-mark.

The Smythe affidavit submitted on behalf of the applicant 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 statutory declaration, which has appended to it a copy of Mr. Marshall's affidavit dated June 30, 1994 as submitted in an opposition to registration of the applicant's trade-mark BIO DANONE & Design, application No. 609,006, 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 of the trade-marks at issue. Further, there is a fair degree of similarity in the ideas suggested in that the marks would 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, registration Nos. 212,920, 292,642, 374,745 and 385,013, which include the prefix BIO as applied to yogurt and stand in the names of third parties. However, there is no evidence of record in this opposition relating to the

existence of any of these marks. In any event, 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. Moreover, 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. As a result, the applicant's 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