

**IN THE MATTER OF AN OPPOSITION
by Orchid Brands Limited and Orchid
Drinks Limited to application No. 1,087,546
for the trade-mark AMEEL filed by Calpis
Co., Ltd.**

On December 22, 2000, Calpis Co., Ltd. (the “Applicant”) filed an application to register the trade-mark AMEEL (the “Mark”). The application claims a convention priority filing date of November 14, 2000 and is based upon use and registration of the Mark abroad in association with:

milk; milk products, namely, cream, cheese, butter, whipped cream, condensed milk, powdered milk; whey; yogurt; lactic acid beverages namely non-carbonated soft drinks containing water, sugar, skim milk powder, pectin, citric acid, lactic acid, sodium citrate and flavors; dairy products in the form of tablets; sour milk beverages; fermented milk; cultured milk; soft drinks; whey beverages; isotonic drinks; fruit juice drinks; mineral water (beverages); carbonated soft drinks; soda water; ginger ale.

The application was advertised for opposition purposes in the Trade-marks Journal of October 2, 2002.

On February 28, 2003, Orchid Brands Limited and Orchid Drinks Limited (collectively the “Opponent”) filed a statement of opposition against the application. The Applicant filed and served a counter statement, in which it denied the allegations contained in the statement of opposition.

The Opponent did not file any evidence under r. 41 of the *Trade-marks Regulations (1996)*.

Pursuant to r. 42, the Applicant filed certified copies of Canadian trademark registrations Nos. TMA566,180 for AMEAL and TM 543,918 for Characters Design, as well as a certified copy of Canadian trade-mark application No. 1,002,014 for AMEAL.

The Opponent filed the affidavit of John Michael Gibney as evidence under r. 43.

Only the Applicant filed a written argument. An oral hearing was not held.

Grounds of Opposition

The Opponent has pleaded three grounds of opposition, each of which turns on the issue of the likelihood of confusion between the Mark and the Opponent's mark AMÉ, which the Opponent pleads it has previously used and registered in Canada in association with the following wares:

mineral waters and aerated waters; non-alcoholic beverages namely fruit juices, fruit drinks and soft drinks; syrups and preparations for making fruit juices, fruit drinks and soft drinks.

The grounds of opposition are as follows:

1. registrability under s. 12(1)(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the "Act"), based upon the Opponent's registration No. TMA476,894 for AMÉ, for the aforementioned wares;
2. entitlement under s. 16 due to confusion with the Opponent's previously used AMÉ mark;
3. distinctiveness because the Mark does not actually distinguish, and is not adapted so as to distinguish, the Applicant's wares from the Opponent's wares.

Preliminary Issue re Admissibility of Gibney Affidavit

The Applicant has argued, and I agree, that the Gibney affidavit is inadmissible as it is not proper reply evidence.

Mr. Gibney, a Director of Orchid Drinks Limited, attests to sales of AME (*sic*) product in Canada and the outcome of an opposition with respect to a Community Trade Mark Application. It is impossible to categorize this evidence as being in reply to the certified copies filed by the Applicant. Mr. Gibney's evidence is clearly in the nature of evidence-in-chief. As such, it should have been filed under r. 41 or r. 44, not r. 43.

I am therefore disregarding Mr. Gibney's affidavit.

Onus

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial 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. [*John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)]

Although the Opponent has not filed evidence to show that its registration remains in good standing, I have exercised the Registrar's discretion to check the register in order to confirm the existence of its registration. [*Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.*, 11 C.P.R. (3d) 410 (T.M.O.B.)] The initial burden regarding the registrability ground has thereby been satisfied.

However, the Opponent has not satisfied its initial burden with respect to its two remaining grounds. Regarding the entitlement ground, it was required to show use of its mark prior to the Applicant's convention priority filing date and non-abandonment of its mark as of the date of advertisement of the Applicant's application [s. 16]. It has not done this. With regard to its distinctiveness ground, it was required to show that, as of the filing of the opposition, its mark had become known sufficiently to negate the distinctiveness of the Mark. [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.); *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.); and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)] It has also not done this. Accordingly, both the entitlement and distinctiveness grounds of opposition are dismissed on the basis that the Opponent has not met its initial burden.

Section 12(1)(d) Ground of Opposition

The material date with respect to this ground of opposition is today's date. [*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.)]

the test for confusion

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. In applying the test for confusion, the Registrar 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 or trade-names and the extent to which they have become known; b) the length of time each has 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 or trade-names in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight.

The Supreme Court of Canada has discussed the appropriate process for assessing all the surrounding circumstances to be considered in determining whether two trade-marks are confusing in *Mattel, Inc. v. 3894207 Canada Inc.* [2006] 1 S.C.R. 772, and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* [2006] 1 S.C.R. 824. It is with these general principles in mind that I shall now assess all of the surrounding circumstances.

s. 6(5)(a) - inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

Neither of the marks appears to have any meaning in the French or English language; they are thus each inherently distinctive.

The strength of a trade-mark may be increased by means of it becoming known through promotion or use. There is however no evidence that either party has used or promoted its mark in Canada to date.

s. 6(5)(b) - the length of time each trade-mark has been in use

There is no evidence of the length of time that either party has used its mark in Canada.

s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

The parties' wares overlap to the extent that they are both associated with beverages, in particular, mineral water, fruit juices/drinks, and soft drinks. Although there is no evidence concerning either party's channels of trade, it is fair to assume that their wares could travel the same channels of trade.

s. 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

The Applicant submits, "it is the entirely different end portions of the trade-marks that gives the marks their uniqueness and distinguishes them from each other." [page 15, written argument] This argument is contrary to the generally accepted principle that the first component of a mark is typically considered more important for the purpose of distinction. [*Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)] Nevertheless, I agree with the Applicant that overall there are significant differences between AMEEL and AMÉ in appearance and sound. There are also differences in the ideas suggested to the extent that AMEEL might suggest "a meal" when sounded whereas AMÉ does not.

other surrounding circumstances

The Applicant has submitted that its Mark "should be permitted to registration in light of the fact that its phonetically identical trade-mark AMEAL covering various food and beverage products was permitted to registration under No. TMA 566,180 notwithstanding the existence of the Opponent's registration for the trade-mark AMÉ." [page 4, written argument] However, as discussed in *Coronet-Werke Heinrich Schlerf GmbH v. Produits Menagers Coronet Inc.*, 4 C.P.R. (3d) 108 at 115, s. 19 of the Act does not give the owner of a registration the automatic right to obtain any further registrations no matter how closely they may be related to the original registration. [See also *Groupe Lavo Inc. v. Procter & Gamble Inc.*, 32 C.P.R. (3d) 533 at 538.] In addition, a decision by the examination section of the Trade-marks Office is not binding on this Board and does not have precedential value for this Board. [*Thomas J. Lipton Inc. v. Boyd Coffee*

Co. (1991), 40 C.P.R. (3d) 272 at 277 and *Procter & Gamble Inc. v. Morlee Corp.* (1993), 48 C.P.R. (3d) 377 at 386]

conclusion re likelihood of confusion

Having considered all of the surrounding circumstances, I find that on a balance of probabilities confusion between AMEEL and AMÉ is not likely, due to the differences between the marks and bearing in mind that the Opponent has not shown that its mark has acquired any reputation.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8).

DATED AT TORONTO, ONTARIO, THIS 27th DAY OF SEPTEMBER 2007.

Jill W. Bradbury
Member
Trade-marks Opposition Board