IN THE MATTER OF AN OPPOSITION by LAWLER FOODS INC. to application No. 875,655 for the trade-mark SEDUCTION filed by SOCIÉTÉ DES PRODUITS NESTLÉ S.A.

On April 20, 1998, the applicant, SOCIÉTÉ DES PRODUITS NESTLÉ S.A., filed an application to register the trade-mark SEDUCTION based on proposed use of the trade-mark in Canada by the applicant itself and/or through a licensee in association with "Confectionery, namely chocolate bars".

The present application was advertised for opposition purposes in the ***Trade-marks Journal*** of November 4, 1998 and the opponent, LAWLER FOODS INC., filed a statement of opposition on December 30, 1998, a copy of which was forwarded to the applicant on February 15, 1999. The applicant served and filed a counter statement in response to the statement of opposition on March 3, 1999. The opponent submitted as its evidence a certified copy of registration No. 500,264 for the trade-mark SEDUCTION covering "Cakes" while the applicant submitted as its evidence the affidavit of Alexander Stack together with a certified copy of registration No. 460,581 for the trade-mark SICILIAN SEDUCTIONS & Design covering "Ice creams, ices, frozen dairy desserts, gelati". The applicant alone filed a written argument and neither party requested an oral hearing.

The following are the grounds of opposition asserted by the opponent in its statement of opposition:

a) The present application does not comply with the provisions of subsection 30(i) of the ***Trade-marks Act*** in that the applicant could not have been satisfied that it was entitled to use the applied for trade-mark in Canada in association with "confectionery, namely chocolate bars" in view of the facts set out in the remaining grounds of opposition;

b) The applied for trade-mark is not registrable having regard to the provisions of paragraph 12(1)(d) of the ***Trade-marks Act*** in that the applicant's trade-mark SEDUCTION is confusing with the its registered trade-mark SEDUCTION, registration No. 500,264, covering "cakes";

c) The applicant is not the person entitled to registration of the applied for trade-mark having regard to the provisions of paragraph 16(3)(b) of the ***Trade-marks Act*** in that, at the date of filing the present application, the applicant's trade-mark was confusing with the opponent's trade-mark in respect of which an application for registration had previously been filed in Canada;

d) The applied for trade-mark is not distinctive of the wares of the applicant in that the applicant's trade-mark does not actually distinguish the wares in association with

which the applicant proposes to use it from the wares of others including the opponent and it is neither adapted to distinguish nor capable of distinguishing them.

The first ground of opposition is based on subsection 30(i) of the ***Trade-marks Act***. While the legal burden is on the applicant to show that its application complies with section 30 of the ***Trade-marks Act***, there is an initial evidential burden on the opponent to establish the facts relied on by it in support of its section 30 ground [see ***Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.***, 3 C.P.R. (3d) 325, at pp. 329-330; and ***John Labatt Ltd. v. Molson Companies Ltd.***, 30 C.P.R.(3d) 293]. Further, the material time for considering the circumstances respecting the issues of non-compliance with section 30 of the ***Act*** is the applicant's filing date [see ***Georgia-Pacific Corp. v. Scott Paper Ltd.***, 3 C.P.R.(3d) 469, at p. 475]. No evidence has been furnished by the opponent to show that the applicant could not have been satisfied that it was entitled to use its trade-mark SEDUCTION in Canada. Furthermore, to the extent that the subsection 30(i) ground is founded upon allegations set forth in the remaining grounds of opposition, the success of this ground is contingent upon a finding that the applicant's trade-mark is not registrable or not distinctive, or that the applicant is not the person entitled to registration of the trade-mark SEDUCTION, as alleged in those grounds [see ***Consumer Distributing Co. Ltd. v. Toy World Ltd.***, 30 C.P.R. (3d) 191, at p.195; and ***Sapodilla Co. Ltd. v. Bristol-Myers Co.***, 15 C.P.R. (2d) 152, at p.155]. I will therefore consider the remaining grounds of opposition relied on by the opponent.

The second ground is based on paragraph 12(1)(d) of the ***Trade-marks Act***, the opponent alleging that the applicant's trade-mark SEDUCTION is confusing with its registered trade-mark SEDUCTION, registration No. 500,264, as applied to "cakes". With respect to the second ground, the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the date of decision, the material date with respect to 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.)]. Further, in determining whether there would be a reasonable likelihood of confusion between the applicant's trade-mark SEDUCTION and the opponent's registered trade-mark SEDUCTION, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those specifically enumerated in subsection 6(5) of the ***Trade-marks Act***.

Considering the inherent distinctiveness of the trade-marks at issue [para.6(5)(a)], both the applicant's trade-mark SEDUCTION as applied to "confectionery, namely chocolate bars" and the opponent's registered trade-mark SEDUCTION as applied to "cakes" possess some measure of inherent distinctiveness even though both marks may suggest to some consumers that the respective wares of the parties are of such a quality as to induce or seduce people into consuming them.

Since no evidence of use of the trade-marks at issue has been adduced by the parties, neither the extent to which the trade-marks have become known [para.6(5)(a)] nor the length of time the marks have been in use [para.6(5)(b)] favours either the applicant or the opponent. Moreover, as the trade-marks at issue are identical [para.6(5)(e)] , the only remaining criteria of those enumerated in subsection 6(5) of the ***Act*** are the nature of the wares of the parties [para.6(5)(c)] and the nature of the trade associated with those wares [para.6(5)(d)]. In this regard, the applicant's chocolate bars differ from the opponent's cakes even though the wares of both parties fall within the general class of food products. Furthermore, while the wares of both parties might well be sold through the same grocery stores, supermarkets or the like, the Stack affidavit, which has not been challenged by the opponent, evidences the fact that cakes and chocolate bars are sold in distinct areas of grocery stores and supermarkets.

Apart from the foregoing, and as a further surrounding circumstance in assessing the likelihood of confusion between the trade-marks at issue, the opponent adduced as part of its evidence a certified copy of registration No. 460,581 for the trade-mark SICILIAN SEDUCTIONS & Design covering "Ice creams, ices, frozen dairy desserts, gelati". However, the existence of one third party registration is of no assistance to the applicant. On the other hand, Alexander Stack has annexed to his affidavit a container for SEDUCTIONS ice cream which was purchased by the affiant at Sicilian Ice Cream Company Café in Toronto. Mr. Stack notes that he located cakes and ice cream for sale in two freezers in the counter of the Sicilian Ice Cream Company Café located four or five feet apart. While the applicant has not furnished any admissible evidence relating to the extent of use of the mark SEDUCTIONS in Canada, the evidence which has been adduced relating to the sale of SEDUCTIONS ice cream is at least of some relevance to the determination of the issue of confusion between the applicant's trade-mark and the opponent's registered trade-mark.

Having regard to the foregoing and, in particular, to the differences in the wares and the nature of the trade associated with the respective wares of the parties, and bearing in mind the evidence of at least some use of the third party trade-mark SEDUCTIONS as applied to ice cream which is sold in close proximity to cakes in at least one of the retail outlets visited by Mr. Alexander, I find that the applicant has met the legal burden on it in respect of the issue of confusion. I have therefore rejected the second ground of opposition.

The third ground is based on paragraph 16(3)(b) of the ***Trade-marks Act***, the opponent alleging that the applicant is not the person entitled to registration of the trade-mark SEDUCTION in view of the opponent's previously-filed application for registration of the trade-mark SEDUCTION. However, the opponent's application for registration of the trade-mark SEDUCTION proceeded to registration on September 9, 1998 and therefore was not pending as of the date of advertisement of the present application. As a result, the opponent has failed to meet the initial burden on it under subsection 16(4) of the ***Act*** in relation to this ground and it too is unsuccessful. Furthermore, since both the paragraphs 12(1)(d) and 16(3)(b) grounds have been rejected and as no other evidence has been submitted by the opponent in support of the non-distinctiveness ground, it follows that the final ground of opposition also fails.

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

DATED AT HULL, QUEBEC THIS 4th DAY OF DECEMBER, 2000.

G.W.Partington,
Chairperson,
Trade-marks Opposition Board.