

**IN THE MATTER OF AN OPPOSITION by
Clic Import Export Inc. to
application No. 1,027,777
for the trade-mark AAAAA Jaguar Brand & Design
in the name of 3430961 Canada Inc.**

On September 2, 1999, Amico Fine Foods Inc. filed an application to register the trade-mark AAAAA Jaguar Brand & Design, which is shown below.



The applicant claims colour as part of the trade-mark. The letters A are in black, the word JAGUAR and the JAGUAR are in yellow with black spots throughout.

The application is based upon use of the trade-mark in Canada since August 1, 1993. At present, the statement of wares reads, “Food Products, namely: rice.”

The application was advertised for opposition purposes in the Trade-marks Journal of April 18, 2001. The opponent, Clic Import Export Inc., filed a statement of opposition on June 18, 2001.

On September 17, 2001, the Canadian Intellectual Property Office recorded the assignment of the application from Amico Fine Foods Inc. to 3430961 Canada Inc. On December 11, 2001, a counterstatement was filed and served on behalf of Amico Fine Foods Inc. By letter of April 26, 2002, the applicant's agent noted that it had incorrectly referred to Amico Fine Foods Inc. in the counterstatement and authorized the Opposition Board to change the reference to the current owner.

On May 15, 2002, the opponent filed the affidavit of Assad Abdelnour as its rule 41 evidence. On December 5, 2002, the applicant filed the affidavit of Maurice Yammine as its rule 42 evidence. In reply, the opponent filed rule 43 evidence, namely a further affidavit of Assad Abdelnour, on May 2, 2003.

On May 2, 2003, the opponent also requested leave to file an amended statement of opposition. Leave was granted by letter dated November 17, 2003.

Only the opponent filed a written argument. An oral hearing was not requested.

There are three grounds of opposition. I will begin with the third ground of opposition.

The third ground of opposition alleges that the application does not comply with subsection 30(b) of the *Trade-marks Act* in that neither the applicant 3430961 Canada Inc., nor its named

predecessor in title, has used the trade-mark AAAAA Jaguar Brand & Design in association with food products, namely rice, since August 1, 1993.

There is an initial evidential burden on the opponent respecting the issue of the applicant's non-compliance with subsection 30(b) but this burden is a light one [see *Tune Masters v. Mr. P's Mastertune* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.) at 89]. This burden can be met by reference not only to the opponent's evidence but also to the applicant's evidence [see *Labatt Brewing Company Limited v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.) at 230].

The applicant's own evidence satisfies the opponent's initial evidence in the present case. Mr. Yammine, the applicant's General Manager, makes the following attestations in his affidavit:

- **“the Applicant's predecessor in title sold Jaguar rice to customers of theirs beginning as early as January 1995” [paragraph 1];**
- **“the trade-mark comprising the word ‘Jaguar’ has been in use in Canada since at least January 1995” [paragraph 2];**
- **“notwithstanding the distinctive nature of the trade-mark exemplified by the pictorial representation of a ‘jaguar’, which is distinctive itself, we decided to add the letters AAAAA in order to make it more distinctive” [paragraph 5];**
- **“the trade-mark has constantly been in use since the year 1995, with the exception of ‘AAAAA’, which was added in 2001” [paragraph 11].**

Apart from the fact that Mr. Yammine gives no evidence of use prior to 1995, there is the fatal admission that the trade-mark as applied for was not used until 2001. Use of the Jaguar Brand & Design without the letters AAAAA does not qualify as use of AAAAA Jaguar Brand & Design. In *Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535 (T.M.O.B.) at 538-9, two basic principles were enunciated concerning permissible deviations in a trade-mark. The second principle is applicable here: “A particular trade mark will be considered as being used if the trade mark actually used is not substantially different and the deviations are not such as to deceive or injure the public in any way . . . In general . . . this principle would appear applicable only where the variations are very minor.”

The applicant’s own President has stated that the component AAAAA serves to make the applicant’s mark more distinctive. The importance of this feature of the mark is further enhanced by its inclusion as the first part of the trade-mark, a location traditionally accepted to be the dominant position. It is therefore reasonable to conclude that this addition was not “very minor”.

I do not believe that the applicant could reasonably argue that it was accurate to state in its application that the mark AAAAA Jaguar Brand & Design has been used since August 1, 1993. Given the sworn statement that the mark comprising the letters AAAAA was not used until 2001, the application should have been based on proposed use, rather than use since August 1, 1993. This is not a case where a trade-mark owner has made minor adjustments to its mark over the years. Rather this is a case where an applicant, who has applied for an exclusive right, has based its

application on incorrect facts. Such an application cannot be allowed to proceed and the third ground of opposition therefore succeeds.

As I have already held that the subsection 30(b) ground of opposition succeeds, I will not address the opponent's contention that the applicant cannot claim use since August 1, 1993 because, until 1998, the applicant's predecessor in title was acting as the opponent's distributor.

I turn now to the first ground of opposition, which pleads that the applicant is not the person entitled to register the trade-mark pursuant to paragraph 38(2)(c) of the *Trade-marks Act* because, as of the applicant's alleged date of first use, the applied for mark was confusing with the trade-mark AAAAA Tiger Brand & Design which had been previously used by the opponent in association with rice. The opponent's trade-mark appears below.

The applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks 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 C.P.R. (3d) 293 (F.C.T.D.) at 298]. With respect to this ground of opposition, there is an initial burden on the opponent to evidence prior use of its trade-mark and non-abandonment of its mark as of the date of advertisement of the applicant's application.

Where an opponent has successfully challenged an applicant's claimed date of first use under a subsection 30(b) ground of opposition, the material date for assessing a subsection 16(1) ground of opposition becomes the applicant's filing date [see *American Cyanamid Co. v. Record Chemical Co. Inc.* (1972), 6 C.P.R. (2d) 278 (T.M.O.B.); *Everything for a Dollar Store (Canada) Inc. v. Dollar Plus Bargain Centre Ltd.* (1998), 86 C.P.R. (3d) 269 (T.M.O.B.)]. Therefore, the present opponent must evidence use of its mark prior to September 2, 1999 and non-abandonment as of April 18, 2001.

The opponent's evidence satisfies its initial burden. Mr. Abdelnour, the opponent's President, explains that the opponent "manufactures, exports, imports, distributes, markets, offers for sale and sells ethnic and non-ethnic food products from around the world", including but not limited to rice. He outlines his company's general activities and success in this field. He provides his company's packaging for rice, which displays the AAAAA Tiger Brand & Design mark and provides Canadian sales figures for each of the years 1998 through 2001, as well as Canadian advertising expenditures for each of the years 1995 through 2001. He has also provided copies of pertinent invoices and promotional materials.

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in subsection 6(5) of the Act. Those factors specifically set out in subsection 6(5) are: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, 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. The weight to be given to each relevant factor may vary, depending on the circumstances [see *Clorox Co. v. Sears Canada Inc.* (1992), 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

Each of the parties' trade-marks is inherently distinctive. As of the material date of September 2, 1999 only the opponent's mark had acquired further distinctiveness through use and promotion.

The length of time each mark has been used favours the opponent.

The wares are identical and it is fair to assume that the channels of trade are similar.

The marks are remarkably similar in appearance, each consisting of the letters AAAAA, followed by the name of a wildcat and then a depiction of a wildcat. Although there are many ways to depict a wildcat, both of the marks show a side view of a cat moving to the left. Each of the three

components of the marks is given almost equal prominence. Although initials such as AAAAA are typically considered to be inherently weak [see *GSW Ltd. v. Great West Steel Industries Ltd.* (1975), 22 C.P.R. (2d) 154 (F.C.T.D.)], this common component does appear as the first part of each mark, a position typically considered to be the dominant [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)]. Moreover, the applicant's affiant attests the letters AAAAA were added to its mark to increase its distinctiveness.

The idea suggested by each mark is similar. The greatest difference exists between the marks when sounded.

Having considered all of the surrounding circumstances, I conclude that the applicant has not met the onus on it to show that there is not a likelihood of confusion between the marks. I reach this conclusion in part because the opponent's mark has been used longer and more extensively than the applicant's mark, with the identical wares, and there is no evidence that any other parties use a trade-mark displaying a wildcat in association with rice. Given the resemblance between the marks, it is reasonable to conclude, on a balance of probabilities, that the ordinary consumer who is familiar with the opponent's mark but has an imperfect recollection of it, will, upon seeing the applicant's mark, infer as a matter of first impression that the applicant's rice shares the same source as the opponent's rice. I note that the applicant's election to not file any argument in support of its position did not assist its case. The first ground of opposition therefore succeeds.

Given that the opposition has already succeeded on two grounds, I will not address the remaining

ground of opposition even though the opponent may have also claimed success on its basis.

Having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the *Trade-marks Act*, I refuse the application pursuant to subsection 38(8) of the Act.

DATED AT TORONTO, ONTARIO, THIS 14th DAY OF JANUARY 2005.

**Jill W. Bradbury
Member
Trade-marks Opposition Board**