

IN THE MATTER OF AN OPPOSITION by The Oshawa Group
Limited to application No. 562,530 for the trade-mark BONIPORC
& Design filed by Boniporc Inc.

On May 13, 1986, the applicant, Boniporc Inc., filed an application to register the trade-mark BONIPORC & Design, a representation of which appears below, based upon use of the trade-mark in Canada since December 14, 1982 in association with "produits de porc et sous-produits de porc destinés à l'alimentation".

The opponent, The Oshawa Group Limited, filed a statement of opposition on February 15, 1988 after the applicant's application was advertised for opposition purposes in the Trade-marks Journal on January 14, 1987. In its statement of opposition, the opponent alleged, inter alia, that the applicant's trade-mark BONIPORC & Design is not registrable in that it is confusing with the opponent's registered trade-marks: BONIMART Design, registration No. 196,788; BONIMART, registration No. 197,219; BONI, registration No. 204,480; BONI MAID OVEN, registration No. 207,563; BONIPRIX, registration No. 215,715; BONISOIR, registration No. 215,716; BONI, registration No. 217,037; LE MARCHE BONI, registration No. 302,282; BONICHOIX, registration No. 314,856; BONIFRUIT, registration No. 327,227; BONIFRUIT Design, registration No. 327,228; and BONIFRUIT Design, registration No. 327,229.

The second ground of opposition is that the applicant is not the person entitled to registration of the trade-mark BONIPORC & Design in that the applicant's trade-mark is confusing with the opponent's trade-marks BONIMART Design, BONIMART, BONI, BONI MAID OVEN, BONIPRIX and BONISOIR previously used in Canada in association with the wares identified in the statement of opposition.

The third ground of opposition is that the applicant is not the person entitled to registration of the trade-mark BONIPORC & Design in that the applicant's trade-mark is confusing with the opponent's trade-names BONI, BONIMART, BONIPRIX and BONISOIR previously used in Canada by the opponent.

The opponent also alleged that the applicant's application is not in compliance with Section 29 (now Section 30) "because the applicant could not have been satisfied that it was entitled to use the trade mark". The opponent's final ground is that the applicant's trade-mark is not distinctive.

The applicant served and filed a counter statement in which it denied the opponent's grounds of opposition.

The opponent filed as its evidence the affidavit of Mary Obelyn Buie while the applicant submitted as its evidence the affidavits of André Dion, Anne Roy, Richard Breault and Marc Bouthot.

Both parties filed written arguments although neither party requested an oral hearing.

With respect to a ground of opposition based on Section 12(1)(d) of the Trade-marks Act, the material date would appear to be as of the date of my decision in view of the decision of the Federal Court of Appeal in Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, (1991), 37 C.P.R. (3d) 413 and the decision of the Opposition Board in Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, (1991), 37 C.P.R. (3d) 538. The material date in relation to the non-entitlement and non-distinctiveness grounds of opposition are respectively the applicant's claimed date of first use (December 14, 1982) and the date of opposition (February 15, 1988).

Considering initially the grounds of opposition based on Section 12(1)(d) of the Act, the most relevant of the registered trade-marks relied upon by the opponent would appear to be its registered trade-mark BONI, registration No. 204,480 covering, inter alia, canned, preserved and packages meats.

In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances, including, but not limited to, the criteria which are specifically enumerated in Section 6(5) of the Trade-marks Act. Further, 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 material dates in this opposition.

With respect to the inherent distinctiveness of the trade-marks at issue, the opponent's trade-

mark BONI comprises the word "boni" which, in the French language, means a bonus or something additional. In view of its laudatory connotation, the opponent's trade-mark BONI possesses little inherent distinctiveness. The applicant's trade-mark BONIPORC & Design includes the element PORC which is the name of the applicant's wares and the element BONI which possesses the laudatory connotation noted above. The combination of the elements BONI and PORC suggests that the purchaser gets something additional when he or she purchases the applicant's BONIPORC & Design pork products. As a result, the applicant's trade-mark BONIPORC & Design must be considered as possessing somewhat more inherent distinctiveness than does the opponent's registered trade-mark BONI.

Having regard to the sales figures set forth in the Dion affidavit, I consider that the applicant's trade-mark BONIPORC & Design has become relatively well known at the wholesale level in association with its pork products in Canada. In particular, sales of the applicant's BONIPORC & Design products from 1983 to 1989 have exceeded \$90,000,000. On the other hand, the only specific reference to the volume or dollar value of sales relating to the opponent's BONI products is the statement in paragraph 12 of the Buie affidavit that such sales in calendar year 1987 exceeded \$1,174,500. However, no breakdown was provided by Ms. Buie as to which of the wares associated with the trade-mark BONI were represented in the sales figure provided by her. At most, one could conclude that the trade-mark BONI has become known to some extent in Canada in association with a broad variety of food products. However, there is no evidence that the opponent's trade-mark BONI has become known to any extent in association with its canned, preserved and packaged meats or, indeed, that it has even used its trade-mark BONI in association with such wares.

The applicant has used its trade-mark BONIPORC & Design in Canada since December of 1982 while Buie indicated in her affidavit that the trade-mark BONI has been used in Canada since July of 1972. Accordingly, the length of time that the trade-marks have been in use favours the opponent in this opposition.

In his affidavit, Mr. Dion states the following with respect to the applicant's wares and channels of trade:

"4. Depuis aussi tôt que le 14 décembre 1982, ma compagnie a vendu et vend sous la marque BONIPORC & Dessin, des carcasses ou sections de carcasses de porcs ainsi que des sous-produits de carcasses nommément foi, coeur, poumons, etc., uniquement à des distributeurs de viande, lesquels transforment à nouveau et revendent lesdits produits à des grossistes ou bouchers/détaillants. Ma compagnie ne vend jamais aux détaillants directement."

While Mr. Dion describes in ordinary commercial terms the specific wares in association with which the applicant has used its trade-mark in Canada, as well as clearly identifying the channels of trade associated with the applicant's wares, the applicant in its application elected to describe its wares more broadly as "produits de porc et sous-produits de porc destinés à l'alimentation". The statement of wares set forth in the applicant's application determines the scope of the monopoly which will be accorded the applicant should its application proceed to registration. As a result, the scope of the applicant's trade must be assessed by reference to the applicant's statement of wares rather than being based on the applicant's actual trade to date (see Mr. Submarine Ltd. v. Amandista Investments Ltd., 19 C.P.R. (3d) 3, at pages 10-12). As the applicant's statement of wares contains no restriction as to the channels of trade associated with its pork products, I must presume that the applicant is seeking protection for its trade-mark for all normal channels of trade associated with pork products.

The applicant's application covers pork products and such wares would normally be sold both at the wholesale and the retail level. Further, the wares covered in the opponent's registration for the trade-mark BONI include canned and packaged meats and canned and packaged pork products could fall within the scope of that description, as well as being pork products as contemplated by the applicant's statement of wares. As a result, the applicant's wares fall within the scope of the wares covered in the opponent's registration for the trade-mark BONI and could therefore travel through the same channels of trade as the wares of the opponent.

As for the degree of resemblance between the trade-marks at issue, the applicant has adopted the entirety of the opponent's registered trade-mark BONI as the initial element of its trade-mark. Thus, the trade-marks BONI and BONIPORC & Design are, to that extent, similar both in appearance and in sounding. Additionally, while there is some similarity in ideas suggested by the trade-marks in view of the laudatory connotation association with the word "boni", I do not consider that the opponent has established that it is entitled to a monopoly in respect of such an idea.

The applicant submitted that the absence of evidence relating to instances of actual confusion between the trade-marks at issue despite the concurrent use of the trade-marks in the marketplace supports the conclusion that there would be no likelihood of confusion between the marks of the parties. However, the applicant's sales of its BONIPORC pork products have, to date, been restricted to meat distributors while the opponent's wares are sold in retail outlets to the general public. However, the applicant's statement of wares is not restricted to pork products sold to meat distributors. As a result, the absence of evidence relating to instances of actual confusion is not a relevant circumstance in the present case. On the other hand, had the applicant's BONIPORC pork

products been sold to the general public through retail outlets similar to those of the opponent, the absence of evidence of actual confusion might well have been a relevant consideration in this opposition.

As a further surrounding circumstance, the applicant relied upon the Breault and Bouthot affidavits in support of its submission that the word "boni" is not distinctive of the opponent as it is broadly used in a descriptive manner on the packaging of food products in the marketplace. While the opponent's trade-mark BONI is the subject of a trade-mark registration and its validity cannot be challenged in opposition proceedings (see Sunshine Biscuits, Inc. v. Corporate Foods Ltd., 61 C.P.R. (2d) 53, at page 62), the applicant's evidence does support the conclusion that the opponent's trade-mark BONI is not entitled to a broad ambit of protection.

The opponent submitted in its written argument that its evidence establishes the existence of a series of trade-marks including the prefix BONI which augments the distinctiveness of other of its trade-marks identified in the statement of opposition. In this regard, the Buie affidavit establishes that the opponent has made significant use of the trade-marks BONICHOIX, BONIPLUS, BONISOIR and BONIPRIX to distinguish its grocery and convenience stores, as well as the trade-mark BONIMART in association with the operation of department stores selling, inter alia, food products. The applicant's pork products as defined in its statement of wares could be sold in retail outlets similar to the opponent's retail outlets bearing one or other of its trade-marks including the prefix BONI. Accordingly, the opponent's evidence supports its position relating to the existence of a series of trade-marks having the prefix BONI as applied to the operation of retail outlets selling groceries including food products.

In view of the above, 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 BONIPORC & Design as applied to the wares covered in its application and the opponent's registered trade-mark BONI.

I refuse the applicant's application in view of the provisions of Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC, THIS 30th DAY OF October, 1992.

G.W. Partington,
Chairman,
Trade Marks Opposition Board.