

IN THE MATTER OF AN OPPOSITION by Astro Dairy Products Limited to application No. 608,985 for the trade-mark BIO filed by Compagnie Gervais Danone, une société anonyme

On June 10, 1988, the applicant, Compagnie Gervais Danone, une société anonyme, filed an application to register the trade-mark BIO 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's application was advertised for opposition purposes in the Trade-marks Journal of November 30, 1988 and the opponent, Astro Dairy Products Limited, filed a statement of opposition on December 30, 1988 in which it alleged the following grounds of opposition:

(a) The applicant's trade-mark is not registrable in that word BIO when written or sounded is clearly descriptive in the English and French languages of the biological character or quality of the wares with which the mark is proposed to be used and of the biological conditions employed in their production;

(b) The trade-mark BIO is not registrable in view of the provisions of Section 12(1)(d) of the *Trade-marks Act* in that the applicant's trade-mark is confusing with the following registered trade-marks:

<u>Trade-mark</u>	<u>Registration No.</u>
BIOSEDRA	152,657
BIOHALBE	212,920
BIO-MARGARINE	235,829
BIOSLIM	270,340
BIOMANAN	282,979
BIONORM	289,997
BIO Design	292,642
BIOLAC	322,949

(c) The applicant is not the person entitled to registration of the trade-mark BIO in that, as of the filing date of the present application, the applicant's trade-mark was confusing with the opponent's pending applications for the trade-marks BIOBEST, application No. 593,983, covering cultured milk products namely yogurt, cottage cheese and sour cream and BIOGHURT, application No. 567,013, for cultured milk products namely yogurt, cottage cheese and sour cream;

(d) The applicant's trade-mark is not distinctive in that it neither distinguishes the applicant's wares from those of others nor is it adapted to do so. The prefix BIO has been at all material times commonly adopted by persons in the dairy industry including those owners of the registered trade-marks identified in the second ground of opposition, and in non-dairy food products as exemplified by the following trade-marks:

<u>Trade-mark</u>	<u>Registration No.</u>
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BIO-BAR	245,913
BIOBEL	273,422
BIOBLEND	268,827
BIOGERM	200,974
BIO-GRAIN	277,137
BIOGUETTE	296,428
BIO-HEALTH	192,518
BIOLOGICAL EDGE	311,197
BIOLIGNE	273,423
BIOMEL	280,173
BIOMIX	267,927
BIO-ORGANIC	237,459
BIO-PLUS	299,919
BIO-SOURCE	276,613
BIO-ST-JOSEPH	225,305
BIO-STRATH	133,946
BIO-TE	281,119
BIO-VEG	289,354

<u>Trade-mark</u>	<u>Application No.</u>
BIOGRAIN	516,312
BIORDO GOURMET	603,599
BIO-SPORT	600,567

The opponent filed as its evidence the affidavits of Alan Booth and Jack Marshall while the applicant elected not to file any evidence. The applicant alone submitted a written argument and both parties were represented at an oral hearing.

At the oral hearing, the opponent indicated that it was withdrawing its first ground of opposition. Moreover, the opponent indicated that its submissions would be directed initially to the Section 16 ground of opposition based on its previously-filed application for registration of the trade-mark BIOBEST.

With respect to the opponent's Section 16(3)(b) ground, the opponent's evidence establishes that its application for the trade-mark BIOBEST, application No. 593,983, was filed October 22, 1987 and that, in accordance with Section 16(4) of the *Trade-marks Act*, its application was still pending as of the date of advertisement of the present application [November 30, 1988]. Accordingly, the legal burden is upon the applicant to establish that, as of the filing date of the present application, the material date for assessing the Section 16(3)(b) ground, its trade-mark BIO as applied to "LAITS ET PRODUITS LAITIERS, nommément: lait frais, lait à longue durée de

conservation, lait fermenté, beurre, yogourt, crème, fromage, fromage blanc" was not confusing with the opponent's trade-mark BIOBEST as applied to cultured milk products namely yogurt, cottage cheese and sour cream.

In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue within the scope of Section 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances including those which are specifically enumerated in Section 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 material date.

With respect to the inherent distinctiveness of the trade-marks at issue, both the applicant's trade-mark BIO and the opponent's trade-mark BIOBEST possess some measure of inherent distinctiveness as applied to the respective wares of the parties even though the word or prefix BIO might suggest to some consumers that there is a biological aspect to the wares of the parties. As well, the element BEST is laudatory and therefore adds no inherent distinctiveness to the opponent's mark. As of the applicant's filing date, neither of the trade-marks at issue had become known and neither had been used in Canada.

The dairy products of the parties overlap in that the opponent's application 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, I consider the trade-marks BIO and BIOBEST to be very similar in appearance and sounding, as well as in the ideas suggested by them.

Considering the degree of resemblance between the trade-marks at issue as applied to wares which overlap and would travel through the same channels of trade, 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 and the opponent's trade-mark BIOBEST covered by application No. 593,983. As a result, the applicant is not the person entitled to registration of the trade-mark BIO as applied to "LAITS ET PRODUITS LAITIERS, nommément: lait frais, lait à longue durée de conservation, lait fermenté, beurre, yogourt, crème, fromage, fromage blanc" and the applicant's application is therefore refused pursuant to Section 38(8) of the *Trade-marks Act*.

In view of the above, I have not considered the remaining grounds of opposition relied upon by the opponent.

DATED AT HULL, QUEBEC, THIS 18th DAY OF APRIL, 1996.

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