

TRADUCTION/TRANSLATION

**IN THE MATTER OF AN OPPOSITION BY
Tradition Fine Foods Ltd. to application
No. 844912 for the registration of the trade-mark
BAGEL TRADITION'L and design, owned by
3102-6636 Québec Inc.**

I The Proceedings

On May 13, 1997, 3102-6636 Québec Inc. (“the Applicant”) filed an application for the registration of the trade-mark BAGEL TRADITION'L and design, as illustrated hereunder,



(“the Trade-Mark”)

based on proposed use in association with baked goods, namely bagels, pizza bagels, dough and pastry and other food products, namely cream cheese (collectively “the Wares”) and with the operation of restaurants and related services, namely preparation of take-out foods and catering services (collectively “the Services”). The application for registration was published in the *Trade-marks Journal* on January 28, 1998.

The Opponent, Tradition Fine Foods Ltd., filed a notice of opposition on May 14, 1998. Its grounds of opposition can be summarized as follows:

(1) The Trade-Mark is not registrable under paragraph 12(1)(d) of the *Trade-marks Act* (“the Act”) because it is confusing with the Opponent’s registered trade-marks, specifically:

-TRADITION, certificate of registration TMA406696 in association with frozen bakery products, namely muffin, cake and cookie batters, croissants, danishes and other pastries;

-TRADITION, certificate of registration TMA487365 in association with baked goods, namely muffins, croissants, cookies, cakes and pastries;

-TRADITION SCOOP ’N BAKE and design, certificate of registration TMA409680 for [frozen] bakery products, namely cake and muffin batters;

(2) The Applicant is not a person entitled to the registration of the Trade-Mark under subsection 16(3) of the Act because the Trade-Mark is confusing with the Opponent’s trade-marks, in respect of which applications for registration have been previously filed, specifically:

-Application No. 807969 for the registration of the trade-mark HEALTHY TRADITION in association with [fresh and] frozen muffins, cookies and cakes, filed March 22, 1996 (the Opponent is no longer basing this ground of opposition on the application in question because it is deemed to have been abandoned under subsection 40(3) of the Act);

-Application No. 831734 for the registration of the trade-mark TRADITION & MUFFINS DESIGN in association with muffin batter, [baked] muffins, cookies and cakes, filed December 16, 1996, based on use since March 24, 1995 (subsequently registered on November 4, 1998, under No. TMA503636);

and on the Opponent’s prior use of its trade-name Tradition Fine Foods Ltd.;

(3) The Trade-Mark is not distinctive of the Applicant’s wares and services as required by section 2 of the Act because it does not actually distinguish the Wares and Services from the wares and services of others, including those of the Opponent, nor is it adapted so to distinguish them; and

(4) The Applicant's application for registration does not comply with the requirements of paragraph 30(i) of the Act because the Applicant could not be satisfied that it was entitled to use the Trade-Mark in Canada in association with the Wares and Services described in the application in view of the Opponent's use of its trade-marks and trade-name.

On October 22, 1998, the Applicant filed a counter-statement in the record, in which it denies the Opponent's grounds of opposition. In the document it also alleges that it is the owner of the trade-marks BAGEL TRADITION'L, certificates of registration TMA497624 and TMA497625, used since May 18, 1989, in association with baked products, namely bagels, pizza bagels, dough and pastry and other food products, namely cream cheese. Lastly, the Applicant claims use of the trade-names Bagel Tradition'l and Bagel Tradition'l Café.

The Opponent tendered an affidavit of Peter Glowczewski, certificates of authenticity for the registered trade-marks TMA406696, TMA487365, TMA409680 and TMA503636 as illustrated below, and application for registration No. 807969 (later abandoned). Mr. Glowczewski was cross-examined on his affidavit and the transcript was placed in the record.

The Applicant tendered the affidavits of François Joyet, Johanne Clouet and Doris Dion. Mr. Joyet was also cross-examined. The transcript and the responses to the undertakings were also placed in the record.

The Opponent tendered the affidavit of Patricia MacFarlane in reply. The parties made written submissions and a hearing was held.

II The evidence

The certificates of authenticity produced by the Opponent are for the following registered trade-marks:

-TRADITION, certificate of registration TMA487365 in association with baked goods, namely muffins, croissants, cookies, cakes and pastries;



certificate of registration TMA409680 in association with [fresh and] frozen baked goods, namely cake and muffin batters; and



certificate of registration TMA503636 (“TRADITION three muffins and design”) in association with muffin batter, baked muffins and cookies.

Mr. Glowczewski is the Opponent’s president. He produced more than 55 exhibits in an attempt to show the use of the trade-marks TRADITION, TRADITION SCOOP ‘N BAKE and design, TRADITION three muffins and design and the trade-name Tradition Fine Foods Ltd. However, it is important to summarize the evolution of the Opponent’s business in order to properly ascertain the way these trade-marks have been used in association with various baked goods. I should emphasize that, despite this abundance of documentary evidence, Mr. Glowczewski’s affidavit contains little information about the periods during which the various packaging samples in the record were used, and that we must rely on Mr. Glowczewski’s cross-examination in order to attempt to establish the dates when some of the packaging or advertising flyers were used. Thus, the following information comes from a synthesis of the affidavit, the exhibits attached thereto, the cross-examination and the exhibits tendered at the cross-examination.

In 1983, the Opponent began producing and selling frozen baked goods such as muffins, cookies and cake batter, croissants, danishes and other pastries under the trade-name Tradition Fine Foods Ltd. Packaging and advertising flyers bearing the trade-mark

TRADITION and used since as early as 1984 were produced in support of its affidavit. According to Mr. Glowczewski, the Opponent began operating a bakery within its establishment in association with the TRADITION trade-mark in 1986. In 1990, it began selling baked goods and pastries, namely muffins, croissants, cookies and cakes, to food distributors and to the public through its sales counter. In addition, Mr. Glowczewski stated that certain packaging was used exclusively for a Club Price, with which it began doing business in 1990. Certificate of registration TMA503636 for the trade-mark TRADITION three muffins and design states March 24, 1995, as the date of first use. Thus, I will presume that all packaging containing this trade-mark was used subsequent to this date.

For the purposes of this matter, without making a finding to this effect, I will consider the use of one of the design marks of the Opponent and the use of the elliptical portion of the said marks illustrated above to be the use of the word mark TRADITION.

Based on this synthesis, I find that the Opponent has used the word mark TRADITION since at least as early as 1984 in association with frozen baked goods and frozen batter for making baked goods. While there were photos of advertisements illustrating packaging for fresh muffins (Exhibits 27 and 39) no date of first use for this packaging was provided. There is also evidence of the use of the TRADITION word mark since at least as early as 1990 in association with fresh muffins.

Under cross-examination, Mr. Glowczewski also admitted that most of the Opponent's sales involve muffins. Bagel sales began in October 1995. The bagels do not bear the trade-mark TRADITION or the Opponent's other trade-marks. They are sold exclusively to a hotel chain in boxes bearing the Opponent's trade-name. Mr. Glowczewski admitted that the Opponent has never sold pizza bagels or cream cheese. It has never offered restaurant or catering services.

The Opponent also sells its products under private brands; those products are nevertheless packaged in boxes bearing its trade-name, Tradition Fine Foods Ltd.

Exhibit 1 is a table setting out the Opponent's annual sales by trade-mark since 1983. The Opponent's sales in Canada from 1983 to 1998 totalled more than \$77 million, of which \$27 million was from products bearing the trade-marks mentioned above. The table provides no breakdown by product, however. Since 1992, the Opponent's bakery counter sales have never exceeded \$50,000, and they average \$40,000. Bagel sales are approximately \$3,000 per month.

Figures concerning advertising related to the Opponent's trade-marks were provided, but, unfortunately, we do not have a breakdown of these figures by trade-mark and by product. Moreover, under cross-examination, the affiant admitted that the advertising figures set out in his affidavit cover Canada and the United States.

Ms. Clouet is employed by the Applicant's agents. She visited certain food businesses in the Québec region to look for food products with packaging containing the word "tradition." Once the instances of purely descriptive words contained in a slogan are eliminated, the following exhibits remain:

JC-2: TRADITION MENTHE for candies

JC-3: TRADITION MAISON for soup

JC-8 : TRADITION for lemonade

JC-9 : TRADITION for coffee

JC-11 : TRADITION ANGLAISE for tea

JC-14 : POM' OR TRADITION for cider

Ms. Dion is also employed by the Applicant's agents. She did a search of the Register, updated to April 25, 2000, for a listing of all trade-marks containing the word "tradition". She found 188 trade-marks, 67 of which were in association with food wares or services. At least 21 trade-marks, related to food products, strike me as relevant. I should mention the Opponent's counter-evidence disclosed that it is opposing three of those trade-marks.

Mr. Joyet is the Applicant's president. He presented a history of the Applicant's activities. While all this may be interesting, the information provided is of little use to the Applicant's case because its application for registration is based on proposed use. Mr. Joyet further claims that the Applicant owns the following trade-marks:

-BAGEL TRADITION'L, certificate of registration TMA497625 in association with baked goods, namely bagels, pizza bagels, dough and pastry and other food products, namely cream cheese, and operation of restaurants and related services, namely preparation of take-out foods and catering services;

-BAGEL TRADITION'L CAFÉ & DESIGN, certificate of registration TMA497624 in association with the same wares and services.

The affiant also alleges that the Applicant has been using the trade-name "Bagel Tradition'l" since at least as early as 1993. Since the issue is whether the Trade-Mark is registrable, whether the Applicant is entitled to the registration or whether the Trade-Mark is distinctive, the use of a trade-name, however close it may be to the word portion of the Trade-Mark, cannot be of great relevance to the matter at hand. The only relevant evidence in Mr. Joyet's affidavit pertains to the use of the Trade-Mark as illustrated above.

Various exhibits were tendered in support of Mr. Joyet's affidavit to establish use of the Trade-Mark by the Applicant. I will consider only those exhibits for which Mr. Joyet provided a period of use under cross-examination. The exhibits in question are:

FJ-15: advertising flyer used in 1997;

FJ-16 and FJ-17: instruction sheets for handling bagels, in use since 1996;

FJ-32 and FJ-33: photographs taken at the Toronto Food & Beverages Show in 1997;

FJ-42: packaging for bagels, in use since 1997 or 1998;

FJ-50: packaging for bagels exclusive to Costco, in use since 1998; and

FJ-54, FJ-55 and FJ-56: packaging for bagels, in use since 1998.

The Applicant did not provide a sales figure associated solely with the use of the Trade-Mark. The Applicant's sales figures are of no help because the Applicant did not break down these amounts by ware or service and by trade-mark in use since at least as early as 1995.

III The law

In proceedings to oppose the registration of a trade-mark, the Opponent must raise enough evidence pertaining to the grounds of opposition on which it relies to make it plain that facts exist that justify the grounds of opposition. Once this is done, the onus moves to the Applicant, which must satisfy the Registrar that the grounds of opposition should not prevent registration of its trade-mark (*Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd. (1984), 3 C.P.R. (3d) 325*).

The material date for assessing grounds of opposition depends on the specific ground involved. The material date for assessing grounds of opposition based on section 30 of the Act is the filing date of the application (May 13, 1997) [see *Dic Dac Holdings (Canada) Ltd v. Yao Tsai Co. (1999), 1 C.P.R. (4th) 263*]. For the ground of opposition based on paragraph 12(1)(d) of the Act, the material date is the date of the Registrar's decision [see *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R. (3d) 413 (F.C.A.)*]. Where the ground of opposition is based on subsection 16(3) of the Act, the date of filing of the Applicant's application for registration is the reference date, as stated in the provision. Lastly, the date of filing of the opposition (May 14, 1998) is generally recognized as the material date for assessing the ground of opposition alleging that the Trade-Mark is not distinctive [see *Andres Wines Ltd. and E&J Gallo Winery (1975), 25 C.P.R. (2d) 126 (F.C.A.)* at 130 and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd., supra*].

The Opponent abandoned the fourth ground of opposition at the hearing.

The outcome of the three other grounds of opposition will depend on the answer to the question whether, on a balance of probabilities, there is a reasonable likelihood of confusion between the Trade-Mark and the Opponent's trade-marks or trade-name. The burden of proof is on the Applicant, which must satisfy the Registrar that there is no reasonable likelihood of confusion, within the meaning of section 2 of the Act, between the parties' trade-marks on the relevant dates identified above [see *Sunshine Biscuits Inc. v. Corporate Foods Ltd. (1982)*, 61 C.P.R. (2d) 53].

Before analyzing the issue of confusion, it is helpful to consider the following excerpt from *Christian Dior, S.A. v. Dion Neckwear Ltd [2002] 3 F.C. 405*, where the Honourable Mr. Justice Décary wrote:

The Registrar must therefore be reasonably satisfied that, on a balance of probabilities, the registration is unlikely to create confusion; he need not be satisfied beyond doubt that confusion is unlikely. Should the "beyond doubt" standard be applied, applicants would, in most cases, face an unsurmountable burden because certainty in matters of likelihood of confusion is a rare commodity. At best, it is only where the probabilities are equal that a form of doubt may be said to arise, which is to be resolved in favour of the opponent. But the concept of doubt is a treacherous and confusing one in civil proceedings and a registrar should avoid resorting to it.

This analysis must be done with reference to the factors in subsection 6(5) of the Act:

(5) In determining whether trade-marks or trade-names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including

(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 the trade-marks or trade-names have 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.

For the purposes of this matter, I will compare the Trade-Mark to the Opponent's word mark TRADITION, since I believe this is the instance where the Opponent has the greatest chance of success because the design portions of the Opponent's other Trade-Marks are totally different from the Trade-Mark. For the purpose of this analysis, I will even consider that the use of any of the Opponent's design marks as evidence of the use of the word mark TRADITION.

(a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known

The inherent distinctiveness of the Trade-Mark is very weak because its word element is highly suggestive of traditional bagels. The design element of the Trade-Mark confers it little inherent distinctiveness. The inherent distinctiveness of the Opponent's trade-mark TRADITION is also very weak. In this regard, I refer to the following excerpt from *Tradition Fine Foods Ltd. v. The Oshawa Group Ltd. et al.*, 2004 FC 1011, July 20, 2004, where O'Reilly J. held:

The defendants contend that the plaintiff's trade-mark is an ordinary, commonplace dictionary word that is used by many other food producers and vendors, lacks distinctiveness and is entitled to little protection. In the context of a claim of confusion, the question is not whether the plaintiff's trade-mark is entitled to protection but whether the distinctiveness of the trade-mark makes it likely that the average consumer would associate the plaintiff's goods with the defendants' stores.

On this point, I must agree with the defendants. The plaintiff's trade-mark is a common word, suggestive of qualities worthy of respect and preservation, naturally associated with good food. This kind of trade-mark is less distinctive and generally merits less protection than unique trade-marks: *Toys "R" Us (Canada) v. Manjel Inc.*, above; *ITV Technologies, Inc. v. WIC Television*

Ltd., 2003 FC 1056, [2003] F.C.J. No. 1335 (T.D.) (QL). The evidence shows that the name “Tradition”, or some close variation of it, is used by many other food producers who co-exist in the marketplace seemingly without confusion.

The distinctiveness of a trade-mark may be enhanced by its use. In the present case, as shown by the evidentiary summary submitted, the Opponent has shown that its trade-mark TRADITION has been used since at least as early as 1984 in association with frozen baked goods, and since 1990 in association with fresh muffins. As for the Applicant, it has tendered packaging that bears the Trade-Mark and has been used since 1997 or 1998. No sales figure for products bearing the Trade-Mark has been provided and it is therefore difficult for me to determine the extent to which the Trade-Mark has become known to the public. It would therefore appear that the Opponent’s trade-mark TRADITION is more known than the Applicant’s Trade-Mark.

(b) the length of time the trade-marks or trade-names have been in use

For the reasons set out under the previous heading, this factor also favours the Opponent.

(c) the nature of wares, services or business

The Applicant wares grouped under the “*produits de boulangerie*” category fall under the same general class (“baked goods”) set out in the Opponent’s certificate of registration TMA487365 for the trade-mark TRADITION. However, there is a difference between a bagel and a muffin. As for the other wares and services listed in the Applicant’s application for registration, they are not of the same nature as the wares listed in the Opponent’s certificates of registration TMA487365, TMA409680 and TMA503636.

(d) the nature of the trade

There is an overlap between the Applicant's business activities in relation to the sale of its baked goods and the Opponent's business activities in relation to the sale of the wares listed in certificate of registration TMA487365. As for the other business activities described in the instant application for registration (preparation of take-out foods and catering services), they are distinct from those listed in the Opponent's aforementioned certificate of registration.

(e) the degree of resemblance between the trade-marks or trade names in appearance or sound or in the ideas suggested by them

The trade-marks must be looked at as a whole, as opposed to comparing each of their elements separately [see *Molson Companies Ltd. v. John Labatt Ltd. (1994)*, 58 C.P.R. (3d) 527 (F.C.A.)]. In addition, the first element of a trade-mark cannot be considered an important element in this analysis [see *Conde Nast Publications Inc. v. Union des Editions Modernes (1979)*, 46 C.P.R. (2d) 183].

In my opinion, when these criteria are applied to the matter before me, the degree of resemblance between the Trade-Mark and the trade-mark TRADITION is rather small. Indeed, the Trade-Mark contains a design, and the word "bagel" as well as "I" symbols are added, thereby distinguishing it from the Opponent's trade-mark TRADITION.

(f) other additional circumstances

The Applicant submits that it has already obtained certificates of registration for trade-marks containing the word portion of the Trade-Mark without protest from the Opponent. However, the registration of a trade-mark does not automatically entitle its owner to the registration of a similar trade-mark [see *Coronet-Werke Heinrich Schlerf GmbH v. Produits Menagers Coronet Inc. (1984)*, 4 C.P.R. (3d) 108 (T.M.O.B.)].

The Applicant notes that there are several trade-marks and corporate names in the Register containing the word “tradition”. There has also been evidence of the use of marks containing the word “tradition” in the trade (Exhibits JC-2, JC-3, JC-8, JC-9, JC-11 and JC-14). The Opponent replies that it is the only one that owns registered trade-marks covering baked goods and that there has been no proof of use of a trade-mark containing the word “tradition” in association with baked goods. To accept such an argument by the Opponent would be to grant it a monopoly over a dictionary word that is commonplace in the food industry. The proof of the use of the word “tradition” as an element of a trade-mark in association with food products denotes that the average consumer is able to distinguish each of these trade-marks. Thus, the average consumer will be able to distinguish the origin of a muffin bearing the trade-mark TRADITION from a bagel sold in association with the Trade-Mark.

In conclusion on this subject, I quote from the statements of Mr. Justice Joyal in *Clorox Co. v. Sears Canada Inc. (1992)*, 41 C.P.R. (3d) 483 at 490:

Fourthly, I should observe that in my view, the “narrow protection” doctrine applies equally when dealing with the similarity of the wares test. It is quite true that fruit-cake and barbecue sauce may be said to belong to the general category of foodstuffs, but the test cannot be applied on a black or white basis. One only needs to look at the thousands of different foods, meats, condiments, confectioneries, cereals and what-not, found in some supermarket to be wary of giving too much weight in some circumstances to the “same general class” test. Otherwise, in the case of a weak mark like MASTERPIECE, the effect of the test standing alone

would be to grant a monopoly over a particular dictionary word, a status which the courts have historically challenged.

The Opponent also claims to hold a family of trade-marks containing the word “tradition.” However, based on the evidence in the record (the state of the Register of trade-marks and the contents of Ms. Clouet’s affidavit), I find that the word “tradition” is commonly used by others in the food industry. One must bear in mind the instructions of the Federal Court of Appeal in *Park Avenue, supra*:

The word “beauty” is a common characteristic found in all these marks. The fact that they are registered to different owners and shown on the evidence to have been used by such owners indicates, in my view, that the common characteristic is common to the trade (open to the trade to use). No family of marks can exist in the circumstances.

In *Man and His Home Ltd. v. Mansoor Electronic Ltd. (1999)*, 87 C.P.R. (3d) 218 (F.C.T.D.), Mr. Justice Deneault issued the following caution regarding rights conferred in respect of a registered trade-mark containing a word that is suggestive of the character or qualities of the wares covered by the certificate of registration:

It is well established that trade-marks containing words which are suggestive of the wares or services offered by the owner are considered to be weak marks and consequently, are afforded a minimal level of protection. In such cases, even a small difference between the marks will be sufficient to diminish the likelihood of confusion. Furthermore, where a person adopts a word in common use and seeks to prevent competitors from doing the same, the trade-marks will have less inherent distinctiveness and the range of protection granted by the Court will be limited. Finally, where a party chooses to use a suggestive non-distinctive name, regardless of any acquired distinctiveness, it must accept a certain amount of confusion without sanction.

Thus, it would appear that the “family of marks” concept is of no assistance to the Opponent in the circumstances.

Lastly, I would like to add that despite the co-existence of the trade-marks in issue since at least as early as 1997, the Opponent has reported no instance of confusion.

Conclusion

In light of the facts and legal principles set out above, I find that the Applicant has discharged its burden to prove on balance of probabilities that there is no reasonable likelihood of confusion between the Trade-Mark and the Opponent's TRADITION trade-mark.

For the following reasons, I have reached this conclusion even though the application for registration covers baked goods:

- a) The Opponent's trade-mark TRADITION has very little inherent distinctiveness when used in association with food products;
- b) The Trade-Mark considered in its entirety is different from the Opponent's TRADITION mark;
- c) Despite the co-existence of marks, no instance of confusion has been proven;
- d) Given the use by others of trade-marks containing the word "tradition", and the existence in the Register of several marks containing this name in association with food products, it can be concluded that the average consumer would be able to distinguish these trade-marks.

I would have reached the same conclusion if I had compared the Trade-Mark to one of the Opponent's trade-marks that contain a design portion. Indeed, the marked difference of the design portions of the trade-marks in issue would add to the distinction between the Trade-Mark and the Opponent's other trade-marks.

I therefore dismiss the first ground of opposition set out above. The likelihood of confusion between the Trade-Mark and the Opponent's trade-marks is also at the heart of the debate regarding the Opponent's second and third grounds of opposition. The difference between the relevant dates for each of the grounds of opposition would have no significant impact on the analysis of the pertinent factors in determining whether there is a likelihood of confusion between the Trade-Mark and the Opponent's

trade-marks or trade-name. It is true that there is proof of the use, from October 1995 to May 1997, of the Opponent's trade-name Tradition Fine Foods in association with bagels, but this name is totally different from the Applicant's Trade-Mark, and, what is more, it is descriptive of the character of the wares. Lastly, the channels of trade are different because the Opponent only sells bagels in association with its trade-name to a hotel chain. Consequently, I dismiss the other grounds of opposition for the same reasons as those set out above.

By virtue of the powers that the Registrar of Trade-marks has delegated to me under subsection 63(3) of the Act, I dismiss the Opponent's opposition in accordance with subsection 38(8) of the Act.

DATED AT MONTRÉAL, QUEBEC, THIS DECEMBER 16, 2004.

Jean Carrière

Member

Trade-marks Opposition Board