



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2010 TMOB 126
Date of Decision: 2010-08-03

**IN THE MATTER OF AN OPPOSITION by
Mövenpick Holding AG to application
No. 1,124,172 for the trade-mark MARCHÉ
EXPRESS in the name of ExxonMobil Oil
Corporation**

[1] On December 4, 2001, ExxonMobil Oil Corporation (the Applicant) filed an application to register the trade-mark MARCHÉ EXPRESS (the Mark) as shown below, based on use in Canada since July 19, 2001 in association with convenience store and fast food services offered at gasoline stations.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of September 17, 2003, with the right to the exclusive use of the words MARCHÉ and EXPRESS disclaimed separately apart from the trade-mark.

[3] On November 16, 2004, Mövenpick-Holding (the Opponent) filed a statement of opposition against the application.

[4] The Applicant filed and served a counter statement generally denying the allegations against it.

[5] In support of its opposition, the Opponent filed the statutory declaration of Robert Staub, and the affidavits of Mary Ogilvie and Dawn Brennan.

[6] In support of its application, the Applicant filed the affidavits of Barry Murphy, Mélissa Boudreault, Maurice Asselin, Marie-Geneviève Latour, Robert James Thomson, Lisa Saltzman and Scott Trip.

[7] Upon the Opponent's request, an order was issued for the cross-examination of all of the Applicant's affiants. However, the Opponent did not proceed with any of the cross-examinations.

[8] Both parties filed written arguments and were represented at a hearing.

[9] A few days prior to the hearing, the Opponent sought leave to file an amended statement of opposition, deleting two grounds of opposition and restricting another. The amended statement of opposition further reflected a change to the Opponent's name from Mövenpick-Holding to Mövenpick Holding AG. The Applicant has no objection to any of the amendments and the Opponent is hereby granted leave pursuant to r. 40 of the *Trade-marks Regulations* to file its amended statement of opposition dated January 26, 2010.

[10] The grounds of opposition as amended may be summarized as follows:

- The Opponent bases its opposition on the grounds as set out in s. 38(2)(a) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) namely, that:
 - the application does not comply with the requirements of s. 30(b) because the Applicant cannot be satisfied that its Mark has been used in Canada since July 19, 2001 in association with “convenience store and fast food services offered at gasoline stations”;
- The Opponent bases its opposition on the grounds as set out in s. 38(2)(b) of the Act, namely that:
 - by virtue of s. 12(1)(d), the Mark is not registrable since it is confusing with the Opponent's registered trade-marks;
 - by virtue of s.12(1)(b), the Mark is not registrable since it is clearly descriptive, or deceptively misdescriptive, in the French and English

languages of the character of “convenience store” in association with which it has allegedly been used since July 19, 2001;

- The Opponent bases its opposition on the grounds as set out in s. 38(2)(c) of the Act, namely that:
 - by virtue of s. 16(1)(a) the Applicant is not entitled to registration of the Mark because at the date of alleged first use it was confusing with the Opponent’s previously used or made known registered trade-marks;
 - by virtue of s. 16(1)(c) the Applicant is not entitled to registration of the Mark because at the date of filing the application and at the alleged date of first use claimed, it was confusing with a trade-name that had been previously used in Canada by other persons;
- The Opponent alleges that pursuant to s. 38(2)(d) the Applicant’s Mark is not distinctive within the meaning of s. 2 and s. 12(1)(b) the Act.

Onus and Material Dates

[11] The Applicant bears the legal onus of establishing, on a balance of probabilities that its application complies with the requirements of the Act. There is however an initial 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 Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

[12] The material dates that apply to the grounds of opposition are as follows:

- s. 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)];
- s. 12(1)(b) - the filing date of the application [see *Fiesta Barbeques Ltd. v. General Housewares Corp.* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)];

- s. 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 16(1)(a) and s. 16(1)(c) - the date of first use claimed in the application [see s. 16(1)];
- non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

Opponent's Evidence

[13] I will summarize below those portions of the evidence that I consider to be the most pertinent.

Statutory Declaration of Robert Staub

[14] In his statutory declaration, Mr. Staub identifies himself as the Opponent's legal counsel in Switzerland. Mr. Staub explains that the Opponent is an international restaurant and hotel chain based in Switzerland and is a holding company with four operationally independent operating units: Mövenpick Restaurants, Marché International, Hotels & Resorts, and Wine.

[15] Mr. Staub asserts that the Opponent is the owner of several trade-names and registrations that include the word MARCHÉ used in association with the operation of restaurant related services, food concept businesses, including the sales of food products, bakery, related beverages and consumer goods which he identifies as the "MARCHÉ Services", and includes the following chart :

Trade-Mark	Registration Number	Registered Services
MARCHÉ	TMA 460,114	(1) Operation of restaurant
	TMA 540,161	(1) Operation of restaurants; retail sale of prepared food and beverages; take-out food services.
MARCHÉLINO	TMA 459,991	(1) Operation of restaurants; retail sale of prepared food and beverages; take-out food services.
	TMA 416,591	(1) Operation of restaurants; consulting to hotels and restaurants.
	TMA 416,921	(1) Restaurant services. (2) Operation of restaurants

[16] Mr. Staub further testifies that the Opponent by itself, through its predecessor-in-title, through its licensees, or a combination of all three, commenced operations of restaurant services in Canada as early as May 26, 1992, when the “Restaurant Marché Mövenpick” opened in Toronto. He states that as of 2004 there were ten MARCHÉ restaurants in Canada.

[17] Mr. Staub declares that as at the 2004 fiscal year, the MARCHÉ Services had yielded more than \$346.4 million (Canadian) in sales over the previous seven years, averaging in excess of \$49 million annually.

[18] Mr. Staub appends as Exhibit B to his statutory declaration materials which he claims represent use of the MARCHÉ trade-marks in Canada.

Affidavit of Dawn Brennan

[19] Dawn Brennan is an administrative assistant employed by the agents for the Opponent and appends to her affidavit Exhibits A to U. These exhibits include certified copies of the Opponent's above-noted registered trade-marks, encyclopaedia entries and dictionary definitions. Exhibits B to I are excerpts from various websites originating from the Opponent as well as from third parties.

Applicant's Evidence

[20] I will summarize below those portions of the evidence that I consider to be the most pertinent.

Affidavit of Barry Murphy

[21] Barry Murphy identifies himself as the Convenience Retail Manager of Imperial Oil. He states that Imperial Oil is a licensee of the Applicant. He explains that Imperial Oil has operated MARCHÉ EXPRESS convenience stores in Canada since July 19, 2001. Mr. Murphy adds that there are 54 MARCHÉ EXPRESS locations in the province of Québec. Appended as Exhibit A to his affidavit are representative photographs of these convenience stores in Montréal. The total sales in Canada under the Mark since 2001 are in excess of \$60 million, and \$1.4 million have been expended in radio and billboard advertising of the Mark, samples of which are appended as Exhibit B-1. Mr. Murphy also provides samples of Motomedia advertising occurring in July 2006 in Montréal (Exhibit C). I note that the Mark is clearly displayed on all of the samples provided.

Affidavit of Mélissa Boudreault

[22] Mélissa Boudreault is an investigator who carried out a telephone directory search in December 2006 for businesses in the city of Gatineau, Québec with the word "marché" as a component of their name, covering grocery stores, convenience stores, specialized product shops and restaurants. She indicates that her search yielded many results and appends as Exhibit A to her affidavit a listing of 28 of these businesses. She further attests to having provided this listing to a fellow investigator, Maurice Asselin.

Affidavit of Maurice Asselin

[23] Maurice Asselin, an investigator, attests to receiving the above noted listing from Mélissa Boudreault, which is included as Exhibit A to his affidavit. In December 2006, Mr. Asselin attended and took photographs of the exterior signage, and in some instances, the interior signage of 21 of these businesses. I note that the word “marché” is featured in most of these photographs. Mr. Asselin also describes the nature of these businesses namely, grocery stores, convenience stores, delicatessens, pastry shops and markets.

Affidavit of Marie-Geneviève Latour

[24] Marie-Geneviève Latour, an investigator, conducted a Québec city telephone directory search of businesses that are listed with the word “marché” as part of their name. Her search revealed 53 businesses in the food trade industry. In December 2006 and January 2007 she attended 26 of these businesses and appends to her affidavit photographs of their exterior signage, and in some instances, the interior signage. I note that the word “marché” is featured in most of these photographs. Ms. Latour also describes the nature of the businesses she attended namely, grocery stores, convenience stores, a butcher shop, restaurants and public markets.

Affidavit of Robert James Thomson

[25] Robert James Thomson identifies himself as a retired supermarket owner. In August and November of 2006, Mr. Thomson describes having attended and taken photographs of various businesses that have the word “marché” as part of their name, in several cities in Québec. Appended to Mr. Thomson’s affidavit are photographs of these businesses depicting the exterior and, in some instances, the interior signage, which include the word “marché”. He also describes the nature of the businesses he attended namely, grocery stores, convenience stores, restaurants, fish stores, shopping malls and public markets which include restaurants.

Affidavit of J. Scott Tripp

[26] J. Scott Tripp, an investigator, conducted an investigation of businesses in Canada that have the word “marché” alone or in combination as a part of their business names or business styles in association with restaurants, take-out services, convenience stores, grocery stores selling prepared meals and carry-out food. The results of his telephone directory search showed there are approximately 1855 such businesses across Canada. The on-line Yellow Pages.ca search results show 793 retail groceries, 197 farmer markets, 181 convenience stores and 43 restaurants that were associated with the word “marché”. In January 2007, he repeated his on-line search yielding 1891 results. Exhibit A is a print out of the first 600 results. Keeping similar parameters, he narrowed his search to geographic locations such as Alberta, Québec and New Brunswick, the results of which are included in his affidavit or appended thereto. He further conducted a telephone directory search in Québec for restaurants with the term “marché” and lists 22 of these restaurants as representative samples. His search also revealed that there are over 150 convenience stores across Canada that have the word “marché” as part of their name. In October 2006, Mr. Tripp attended 34 businesses located in several cities in Québec and appends to his affidavit photographs of the store front signage and, in some instances, the interior signage of these businesses, which feature the word “marché”. He further describes the nature of the businesses he attended which are restaurants, convenience stores and grocery stores.

Affidavit of Lisa Saltzman

[27] Lisa Saltman identifies herself as Director of the trade-mark searching department with Onscope a division of Marques d’Or Inc. Part of her employment responsibilities is to review and search the files and records of the Canadian Intellectual Property Office (CIPO) on the ONSCOPE/Marques d’Or Inc. database. At the request of the Applicant, a trade-mark search was conducted for registered and pending applications for “marché” in association with restaurants, take-out food services, food stores and convenience stores the results of which are appended as Exhibit LS to her affidavit. This search yielded 73 trade-marks.

Grounds of opposition

[28] I shall analyse the grounds of opposition, however not necessarily in the order they were pleaded.

Ground of opposition based on s. 30(b)

[29] As its first ground of opposition, the Opponent pleads that the trade-mark sought to be registered by the Applicant, has not been filed in compliance with s. 30(b) of the Act since the Applicant cannot be satisfied that its Mark has been used in Canada since July 19, 2001 in association with convenience store and fast food services offered at gasoline stations.

[30] The Opponent submits the application ought to be refused, as the Applicant has failed to evidence use of its Mark since the alleged date of first use and also failed to show continuous use of the Mark. The Opponent further submits that the burden rests on the Applicant to show that the Mark has been used since the date of first use claimed and that its failure to do so is sufficient to justify a refusal of the subject application. I respectfully disagree.

[31] In order for this ground of opposition to be considered at all, it is the Opponent that has an initial evidential burden to prove the facts in support of its allegations. To the extent that the relevant facts with respect to this ground of opposition are more readily available to the Applicant, the evidentiary burden on the Opponent with respect to this ground of opposition is lower, and can be met by reference to the Applicant's own evidence [see *Tune Master v. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.); *Labatt Brewing Co. v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.)]. However, while an Opponent may rely upon an Applicant's evidence to meet its evidential burden in relation to this ground, the Opponent must show that the Applicant's evidence is clearly inconsistent with the Applicant's claim as set forth in its application [see *York Barbell Holdings Ltd. v. ICON Health & Fitness, Inc.* (2001), 13 C.P.R. (4th) 156 (T.M.O.B.)].

[32] The Opponent has not led any evidence with respect to this ground. As earlier stated, in order to meet its burden under this ground, it was up to the Opponent to either file evidence that raises doubt with respect to the Applicant's claim that its Mark was first used on July 19, 2001, or point to enough ambiguities or inconsistencies in the Applicant's evidence to cast doubt on the veracity of the Applicant's claimed date of first use, which, in my opinion, it failed to do.

[33] Since the Opponent did not raise any doubt about the veracity of the Applicant's claim that it had used its trade-mark since as early as July 19, 2001, the Applicant was not obliged to evidence the use of its Mark since such date. Had the Opponent wished to pursue this issue, it could have chosen to cross-examine Mr. Murphy, particularly in light of the cross-examination order issued to this effect.

[34] Accordingly, this ground of opposition is unsuccessful.

Ground of opposition based on s. 12(1)(b)

[35] As its third ground of opposition the Opponent alleges that the Applicant's Mark is not registrable in view of s. 38(2)(b) and s. 12(1)(b) of the Act because MARCHÉ EXPRESS is clearly descriptive or deceptively misdescriptive, in the French and English languages, of the character of the services described as "convenience store". Although the Opponent has restricted its allegation in respect of this ground to "convenience store", it is recalled that the statement of services reads as "Convenience store and fast food services offered at gasoline stations".

[36] Section 12 (1)(b) of the Act reads as follows:

12. (1) Subject to section 13, a trade-mark is registrable if it is not

[...]

(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin [...]

[37] The issue as to whether the Mark is clearly descriptive must be considered from the point of view of the average consumer of the services. Furthermore, the Mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd. v. Canada (Registrar of Trade Marks)* (1978), 40 C.P.R. (2d) 25 (F.C. T.D.); *Atlantic Promotions Inc. v. Canada (Registrar of Trade Marks)* (1984), 2 C.P.R. (3d) 183 (F.C.T.D.)]. Character means a feature, trait or characteristic of the service and "clearly" means "easy to understand, self-evident or plain" [see *Drackett Co. v. American Home Products Corp.* (1968), 55 C.P.R. 29 (Can. Ex. Ct.)].

[38] When viewed from the perspective of the English language, the Mark is comprised of a French word “marché” and an English word “express”. The combination of French and English words even when individually descriptive of the services does not offend the provisions of s. 12(1)(b) of the Act which precludes registration of a trade mark that is

(b) ... whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English *or* French language ...(emphasis added)

[39] Accordingly, the Mark cannot be said to clearly descriptive in the English language of convenience stores.

[40] However, as “marché” and “express” are both French words, the question then becomes whether the Mark is clearly descriptive in the French language of the character of convenience stores.

[41] The Opponent's submissions in respect of this ground are supported by dictionary definitions for the words "marché" and "express". The word “marché” is French for “market” and, as defined in the dictionary *Le Petit Robert* holds a wide spectrum of meanings, from broad definitions to more specific ones. The Opponent however highlights the following definition: “Lieu public de vente de biens et de services”. This definition is rather broad in scope defining many businesses including the Opponent’s. In this respect I am of the view that it does not serve to show how the word “marché” in the context of the Applicant’s services is clearly descriptive. The word “express” is defined

in the same dictionary as: “qui assure un déplacement ou un service rapide.” The examples provided are: “un train express, un ascenseur express, le metro express”.

[42] Additionally, the Opponent submits that the Applicant’s evidence establishes that the word “marché” is commonly used in the marketplace to describe convenience stores and argues that the word “express” implies quick and fast service. The Opponent contends that as convenience stores by their very definition are quick services, it follows that MARCHÉ EXPRESS is clearly descriptive of the Applicant’s services. In addition, the Opponent points to the voluntary disclaimer by the Applicant of the words MARCHÉ and EXPRESS, and points out that no one person should be able to appropriate a descriptive word or words, placing legitimate competitors at an undue disadvantage in relation to language that is common to all.

[43] On the other hand, the Applicant submits that the combination of the words MARCHÉ EXPRESS is a coined phrase which does not convey a specific meaning, nor does it describe the type of services offered at a gasoline station. It further argues that MARCHÉ EXPRESS is not part of a linguistic construction that is part of spoken or written English or French.

[44] I would first remark that the wording of s. 12(1)(b) contemplates the prohibition against “clearly” descriptive trade-marks. For a word to be clearly descriptive it must describe something which is material to the composition of the goods or intrinsic to the actual services offered. While it is true that the Applicant’s own evidence establishes that the word “marché” is used by other traders to describe convenience stores, it is recalled that the Mark is not solely the word MARCHÉ, it is the combined words MARCHÉ EXPRESS. I agree with the Applicant that MARCHÉ EXPRESS is not a linguistic construction which flows in the French language. These combined words do not have a precise meaning with respect to the character of convenience store services. This finding is supported by the lack of evidence of use of “marché express” by other traders in the marketplace. In my view, the most the Mark suggests is that the ease of purchasing items at a convenience store could save consumers some time. In this respect the Mark is

merely suggestive of the result it is liable to produce as opposed to being intrinsically linked to the services themselves.

[45] Considering the above, I am therefore of the view the Mark is not clearly descriptive of the character of convenience stores in either the French or English language. As it is not clearly descriptive it cannot be found to be deceptively misdescriptive [see *Oshawa Group Ltd. v. Canada (Registrar of Trade Marks)* (1980), 46 C.P.R. (2d) 145 (F.C.T.D.)].

[46] Consequently the ground based on s. 12(1)(b) of the Act fails.

Ground of opposition based on s. 12(1)(d)

[47] The Opponent alleges that the Mark is not registrable pursuant to s. 38(2)(b) and s. 12(1)(d) since it is confusing with its five previously identified registered trade-marks.

[48] In my view the most relevant of the Opponent's marks with respect to this ground is MARCHÉ registration No. TMA460,114 covering: operation of restaurant. The four other marks include either additional wording or design elements which render them less relevant for the purpose of confusion, and in some instances cover different services. Thus, the determination of the issue of confusion between the Mark and the trade-mark MARCHÉ, registration No. TMA 460,114 will effectively decide this ground of opposition.

[49] To cast doubt on the Opponent's burden, the Applicant filed a decision pursuant to s. 45 of the Act, wherein the Opponent's registration for the trade-mark MARCHÉ No. TMA460,114 was expunged for failure by the Opponent to file evidence of use of its mark during the relevant period namely February 15, 2003 to February 15, 2006. In response, the Opponent filed a Consent Judgment rendered on November 16, 2009 whereby the Federal Court overturned the Registrar's decision to expunge and maintained the registration of the trade-mark based on the parties consent and agreed statement of facts.

[50] Having exercised my discretion to verify the register, I confirm that the Opponent's registration is in good standing as of today's date, accordingly the Opponent has met its initial evidentiary burden with respect to this ground of opposition.

the test for confusion

[51] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: 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 each has 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. These enumerated factors need not be attributed equal weight.

s. 6(5)(a) - inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

[52] Even though the Opponent's mark is the common French word for market, when used in association with "operation of restaurant" it possesses some measure of inherent distinctiveness.

[53] As for the Mark, I am of the view that it possesses less inherent distinctiveness as its first component is highly suggestive of the services.

[54] Nevertheless, the extent to which the marks at issue have become known may increase their distinctiveness.

[55] In this regard, the Applicant's affiant Mr. Murphy clearly sets out the date of first use, and provides sales and advertising figures supported by evidence clearly showing how the Mark is in use. Based on the foregoing, I conclude that the Mark has become known to a certain extent in Canada.

[56] In contrast, I find the statutory declaration of Robert Staub to be vague and tenuous. Although the sales figures from 1999 to 2004 are impressive, the first ambiguity resides in the fact that Mr. Staub defines the MARCHÉ marks to be all five of the Opponent's registered trade-marks, which makes it impossible to determine which mark or marks were actually being used. Furthermore, there are no photographs or specimens showing use of any of these marks in association with the Opponent's services. The only material provided claiming use of any of these marks is found in Exhibit B, which in my view must be afforded very minimal weight for the following reasons.

[57] The first document in Exhibit B is a copy of an article from the CBC New's website about Movenpick's operator filing for creditor protection. The article, which contains hearsay, features a photograph of a sign bearing the mark RESTAURANT MARCHÉLINO MÖVENPICK. No information is provided as to when and where the sign was used.

[58] The other item in Exhibit B purports to be a print out from the Opponent's website. Although the word "marché" is clearly displayed on the upper left hand corner of this page, the website does not appear to relate to services offered in Canada as demonstrated by the reference to foreign currency such as Euros and Swiss Francs and by the links to the Opponent's establishments in Germany, Austria, Switzerland and Slovenia. There is no evidence indicating that Canadians have accessed this website, nor whether the products or services therein are available in Canada.

[59] These above noted deficiencies render the entirety of the statutory declaration tenuous and such ambiguities in the Opponent's evidence shall be interpreted against it [see *GWG Ltd. V. Jack Spratt Mfg. Inc.*, (1982), 72 C.P.R. (2d) 93]. It follows that in the absence of supporting documentary evidence of use of the Opponent's mark, I am unable

to determine the extent to which the Opponent's relevant MARCHÉ mark has become known in Canada.

s. 6(5)(b) - the length of time each trade-mark has been in use

[60] The Applicant has evidenced use of the Mark since 2001. The Opponent's most relevant registration is based on use since May 26, 1992, however in the absence of evidence of use of the mark, a claimed date of first use set forth in a registration can establish no more than "*de minimis*" use and cannot give rise to an inference of significant or continuing use of the mark [see *Black Sheep Boutiques (1979) Ltd. v. Langlois* (1985), 5 C.P.R. (3d) 207].

s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

[61] When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark application and registration that govern [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)].

[62] The Opponent submits that the Applicant's services include fast food services and points to evidence establishing that convenience stores and gas stations now offer a wider variety of ready-to-go food items, which it argues falls within the scope of restaurant services, necessarily overlapping with its services [see Brennan affidavit Exhibits C, D and E].

[63] The parties' respective statements of services must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording [see *McDonald's Corp. v. Coffee Hut Stores Ltd.* (1994), 55 C.P.R. (3d) 463(F.C.T.D.), *affd.* 68 C.P.R. (3d) 168(F.C.A.)]. The marks are also to be compared as they are used in business [see *Joseph E. Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1990), 33 C.P.R. (3d) 454

(F.C.T.D.). In this regard, the evidence establishes that the Applicant's convenience stores at gasoline stations, sell a variety of items such as cigarettes, candy bars and salty snacks and offer fast food items such as sandwiches, doughnuts, coffee and soft drinks. As I understand it, the Applicant's services are not fast food restaurant services, but rather convenience stores at gasoline stations where limited food items are sold. In this regard, based on the evidence of record, I find it unlikely that the parties' trades would overlap. On the other hand, I note that the Opponent's statement of services does not include any limitations regarding its trade channels; thus nothing would prevent the Opponent from operating its restaurants, particularly in the form of fast food restaurants at gasoline stations and in such cases, the Applicant's fast food items could potentially overlap with the Opponent's restaurant services [see Brennan affidavit Exhibit P].

s. 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[64] I find that the marks are similar in appearance, insofar as they share the common component MARCHÉ. The word EXPRESS differentiates the marks when sounded and in the ideas suggested by them.

Surrounding circumstances

State of the register

[65] As a surrounding circumstance, the Applicant's affiant, Lisa Saltzman, filed state of the register evidence. This affidavit serves to introduce into evidence particulars of trade-mark registrations and pending applications all of which include "marché" as a component of the marks.

[66] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.);

Welsh Foods Inc. v. Del Monte Corp. (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); *Maximum Nutrition Ltd. v. Kellogg Salada Canada Inc.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

[67] It is recalled that Ms. Saltzman's search yielded 73 trade-marks, 49 of which are registered. I note that six of these registrations stand in the Opponent's name. Of the remaining relevant registrations, two relate to restaurant and catering services, seven are with respect to convenience store services, and the remaining cover mostly grocery stores or retail food stores.

[68] Furthermore, the Applicant has evidenced a plethora of examples of businesses using the word "marché" alone or as a component of their name in the relevant marketplace. Most of these relate to grocery stores, food related businesses and convenience stores. To a lesser extent the evidence also shows use by third parties in respect of restaurant services.

[69] Based on the above I am prepared to infer that the term "marché" is commonly used by third parties in the food trade industry, signifying that consumers are accustomed to seeing this word in the marketplace.

Conclusion re likelihood of confusion

[70] In most instances, it is the first portion of a mark that is the most important for purposes of distinction, except where it is shown that the word is used in the trade, which is the case here. Where a trader uses as its trade-mark an ordinary word which is common to the trade, it cannot expect to hold a wide ambit of protection. In such cases relatively small differences between the marks will suffice to distinguish them.

[71] Having considered all of the surrounding circumstances, I conclude that the Applicant has satisfied its burden to show that there is not a reasonable likelihood of confusion between the marks at issue. The common word "marché" is simply not one that can be given a broad scope of protection given its ordinary meaning and its significant use by other traders in food related industries. I am also of the view that the word EXPRESS serves to distinguish the Applicant's Mark somewhat from the

Opponent's mark particularly since the Opponent has been unsuccessful in establishing that its MARCHÉ mark has acquired any degree of distinctiveness.

[72] As previously mentioned, the determination of the issue of confusion between the Mark and the registered trade-mark MARCHÉ registration No.TMA460,114 effectively decides the registrability ground of opposition.

[73] Having regard to the foregoing, the ground of opposition based on s. 12(1)(d) of the Act is dismissed.

Ground of opposition based on s. 16(1)(a)

[74] The Opponent has also pleaded that the Applicant is not the person entitled to registration pursuant to s. 16(1)(a) on the basis that the Mark is confusing with the marks previously used in Canada by the Opponent in association with related services including food related services.

[75] With respect to this ground of opposition, there is an initial burden on the Opponent to evidence use of its trade-marks prior to the Applicant's claimed date of first use and non-abandonment of its mark as of the date of advertisement of the Applicant's application [s. 16].

[76] For the reasons previously discussed under the s. 12(1)(d) ground I am of the view that the Opponent has not met its initial burden. This ground is therefore dismissed.

Ground of opposition based on s. 16 (1)(c)

[77] As its fifth ground of opposition the Opponent alleges that by virtue of s. 16(1)(c) the Applicant is not entitled to registration of the Mark because at the date of filing the application and at the date of first use claimed, it was confusing with a trade-name that had been previously used in Canada by other persons.

[78] There is an evidential burden on the Opponent to evidence use of the alleged trade-name prior to the applicant's claimed dated of first use. Since the Opponent did not

identify any trade-names nor did it file any evidence on point, it has failed to satisfy its burden and the fifth ground is therefore unsuccessful.

Ground of opposition based on distinctiveness

[79] The Opponent's ground of opposition based on distinctiveness is two fold. Firstly, the Opponent alleges that the Applicant's Mark is not distinctive because it is confusing with the Opponent's MARCHÉ marks and trade-names. Secondly, it alleges that the Applicant's Mark is not distinctive because it is clearly descriptive of the services.

[80] In order to meet its evidential burden with respect to the first prong of this ground, the Opponent must show that as of the filing of the opposition November 16, 2004 the Opponent's marks and trade-names had become known sufficiently to negate the distinctiveness of the Mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.); *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.); and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)]. For the reasons previously set out under the s. 12(1)(d) ground, I am of the view that the Opponent's evidence does not satisfy its initial burden. Accordingly the first prong of this ground based on s. 2 of the Act is dismissed.

[81] Regarding the Opponent's allegation based on s. 12(1)(b) of the Act, while I agree that clearly descriptive trade-marks are inherently non-distinctive, given my previous finding that the Mark does not offend the provisions of s. 12(1)(b) of the Act, the second prong of this ground is also dismissed.

[82] Accordingly, both grounds of opposition pursuant to s. 38(2)(d) are hereby dismissed.

Disposition

[83] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Lynne Pelletier
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office