



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

Citation: 2017 TMOB 167

Date of Decision: 2017-12-06

IN THE MATTER OF AN OPPOSITION

Ferrero S.p.A.

Opponent

and

**Dotchirne pidpriemstvo Konditerska
korporatzia Roshen**

Applicant

1,548,679 for ROSHEN Design

Application

INTRODUCTION

[1] On October 21, 2011, the Applicant filed an application to register the trade-mark ROSHEN Design (the Mark), as shown below. The application is based upon use in Canada since at least as early as January, 2009, in association with chocolate confectioneries, sugar confectioneries, almond confectioneries and peanut confectioneries.



[2] Colour is claimed as a feature of the Mark. Colour is claimed as a feature of the mark. The words FINE CHOCOLATE, ROSHEN, SINCE 1996 and CLASSIC are gold. The dots at both extremities of the words FINE CHOCOLATE are gold, the line below the word ROSHEN is gold and the two lines at both extremities of the word CLASSIC are gold. The inner rectangle is filled with red, outlined with gold, then outlined with red and then a thicker outline in gold.

[3] The Opponent is the owner of the trade-mark ROCHER (TMA565,125), for use in association with “packaged chocolate confectionery”, as well as the trade-mark FERRERO ROCHER & Design (shown below), for use in association with “chocolates, confectionery, namely, pastry and confectionary products containing chocolate as an ingredient, wafers”.



[4] The Opponent alleges that there is a likelihood of confusion between its trade-marks and the Mark. It has opposed the application for the Mark on this basis, and on the basis that there are technical deficiencies in the use claim in the application.

[5] For reasons discussed below, I have come to the conclusion that there is no reasonable likelihood of confusion between the parties' trade-marks. However, the opposition succeeds on a technical basis.

FILE HISTORY

[6] The application for the Mark was advertised for opposition purposes in the *Trade-marks Journal* dated March 20, 2013. On August 19, 2013, the Opponent opposed it by way of filing a statement of opposition, as per section 38(1) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[7] The grounds of opposition were initially based upon sections 12(1)(d), 16(1)(a) and 2 of the Act. However, on January 13, 2016, the Opponent amended the statement of opposition, with leave of the Registrar, such that it now also includes a ground based upon section 30(b) of the Act, and an additional ground based upon section 2 of the Act.

[8] A counter statement denying each of the allegations set out in the statement of opposition was filed by the Applicant on October 17, 2013.

[9] In support of its opposition, the Opponent relies upon the affidavit of Allan B. Cosman, sworn January 6, 2015 and certified copies of its registration Nos. TMA565,125 for ROCHER and TMA658,233 for FERRERO ROCHER & Design. Mr. Cosman was not cross-examined.

[10] In support of its application, the Applicant relies upon the affidavits of: Vladislava Shneider, sworn August 3, 2015; Nikolay Kovalenko, sworn July 31, 2015; Christina St. Peter, sworn August 3, 2015; Patrick Balzamo, sworn July 29, 2015; and Sandro Romeo, sworn July 29, 2015. Only Ms. St. Peter and Mr. Balzamo were cross-examined. The transcripts of their cross-examinations form part of the record.

[11] Both parties filed written arguments.

[12] Both parties attended a hearing held on October 26, 2017.

ONUS

[13] The Applicant bears the legal onus of establishing, on a balance of probabilities that its application complies with the requirements of the 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 [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

MATERIAL DATES

[14] The material dates that apply to the grounds of opposition are:

- sections 38(2)(a)/30(b) - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- sections 38(2)(b)/12(1)(d) - the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- sections 38(2)(c)/16(1)(a) – the claimed date of first use [section 16(1) of the Act].
However, when an opponent successfully challenges an application based on the date of first use claimed therein, the material date becomes the filing date of the application [*Everything for a Dollar Store (Canada) Inc v Dollar Plus Bargain Centre Ltd* (1998), 86 CPR (3d) 269 (TMOB); and
- sections 38(2)(d)/2 - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 2004 FC 1185 (CanLII), 34 CPR (4th) 317 (FC)].

ANALYSIS OF GROUNDS OF OPPOSITION

Section 30(b) – Non-compliance

[15] The Opponent’s section 30(b) ground of opposition is pleaded as follows:

The application does not conform to the requirements of Section 30(b) in that, at the date of filing the application or at any other material date, the Applicant had not used the Trade-mark in Canada since the claimed date of first use. In the event that there had been such use, such use was not by the Applicant itself as claimed in the application at Paragraph 3. ie.: “The trade-mark has been used in Canada by the applicant in association with all the specific wares listed hereafter and the applicant requests registration in respect of such wares”, but only through a licensee and/or a predecessor in title which was not claimed in the application. Further, and in the event that there was any such use, such use was not continuous from the claimed date of first use which is required.

[16] Section 30(b) of the Act provides:

30. Contents of application - An applicant for the registration of a trade-mark shall file with the Registrar an application containing...

(b) in the case of a trade-mark that has been used in Canada, the date from which the applicant or his named predecessors in title, if any, have so used the trade-mark in association with each of the general classes of wares or services described in the application

[17] At paragraphs 31-50 of its written argument and at the hearing, the Opponent raised a number of technical arguments with respect to its section 30(b) ground of opposition. At the hearing, the Applicant submitted that not all of its arguments are within the scope of its pleading.

[18] I note that the Federal Court has directed that an opposition is to be assessed in view of the grounds of opposition as pleaded. Where an opponent has pleaded that the application fails to comply with a section of the Act based on a particular set of circumstances, it is not permissible to refuse it on the basis that it does not comply with that section of the Act for reasons different than those pleaded [*Massif Inc v Station Touristique Massif du Sud (1993) Inc* (2011), 95 CPR (4th) 249 (FC) at paras 27-29].

[19] Based upon a fair reading, I understand the Opponent's pleading to allege that the application is contrary to section 30(b) of the Act because: 1) at the date of filing of the application, the Mark had not been used since the claimed date of first use in the application; 2) if there has been any use, such use was not by the Applicant itself, as claimed in the application; and 3) if there has been any use, such use was not continuous from the claimed date of first use, namely, since at least as early as January, 2009. I will address these issues in my analysis below.

[20] Prior to doing so, it is useful to review some of the jurisprudence relating to section 30 grounds of opposition. First, I note that it has been held that the initial burden on an opponent is light respecting the issue of non-compliance with section 30(b) of the Act. This is because facts regarding an applicant's first use are particularly within the knowledge of the applicant [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986) 10 CPR (3d) 84 (TMOB) at 89]. Second, I note that an opponent can meet its initial burden under section 30(b) by reference not only to its own evidence but also to the applicant's evidence [*Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. However, an opponent may only successfully rely upon the applicant's evidence to meet its initial burden if it can show that the applicant's evidence puts into issue the claims set forth in the applicant's application

[*Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd* 2014 FC 323 at paras 30-38 (CanLII); *Garbo Group Inc v Glamour Secrets Pro Inc*, 2016 TMOB 59 (CanLII) at para 48].

[21] In this case, the Opponent has not provided any evidence to support its section 30(b) ground of opposition. The question therefore becomes whether the Opponent is able to meet its burden by relying upon the Applicant's evidence. Evidence pertaining to use of the Mark is found in the Shneider and Kovalenko affidavits. I will discuss each of these below. However, I note that the Shneider affidavit is not particularly helpful, as for the most part, its contents post-date the material date for assessing the Opponent's section 30(b) ground of opposition.

Shneider Affidavit

[22] Ms. Shneider is the Office Manager for Roshen USA LLC ("Roshen USA") [para 1]. She has held this position since October 2011. Ms. Shneider attests that Roshen USA is an importer and wholesaler of confectionery. According to Ms. Shneider, Roshen USA is the exclusive distributor of the products of the Applicant in North America [para 3]. Ms. Shneider refers to the products of the Applicant as "the ROSHEN products" and defines the trade-marks used in association with the ROSHEN products as ROSHEN & RIBBON Design (application No. 1,548,677), ROSHEN Design (application No. 1,548,678) and ROSHEN Design (application No. 1,548,679) [para 4].

[23] According to Ms. Shneider, Roshen USA has marketed and sold products since 2011. It does not sell to retailers or consumers in Canada, but rather, exclusively to distributors in Canada who, in turn, wholesale the ROSHEN products to retailers who sell to consumers [para 5].

[24] Roshen USA provides in-store displays to its Canadian distributors. Attached as Exhibit A are representative samples of such displays [para 7]. Ms. Shneider attests that the ROSHEN products are clearly marked, both on the packaging for sales by Roshen USA to its Canadian distributors, and on the ROSHEN products sold to consumers. Attached as Exhibit B are samples of ROSHEN products bearing the ROSHEN trade-marks [para 8]. Ms. Shneider states that although the samples in Exhibit B are 2015 products, the packaging for the ROSHEN products has remained consistent since 2011 [para 8].

[25] Gross sales figures for wholesales made by Roshen USA to Canadian distributors since 2011 are provided in paragraph 9 of the Shneider affidavit. The figures range from approximately US\$150,000 in 2015 (as of the date of swearing of the affidavit) to US\$800,000 in 2013. Attached as Exhibit C, are samples of invoices issued to retailers of ROSHEN brand products in Canada from 2011 to 2015.

[26] Ms. Shneider also notes that the ROSHEN products are advertised on the roshen.com website, which is available in Canada. Attached as Exhibit D, are samples of pages from this website. According to Ms. Shneider, the website provides distributors and consumers wishing to order the ROSHEN products from Canada with Roshen USA's company details and consumers are then redirected to its Canadian distributors [para 11].

[27] The Opponent has pointed out that Roshen USA didn't commence business until 2011 and its earliest invoice is dated September 9, 2011, which post-dates the claimed date of first use in the application for the Mark. The Opponent submits that to the extent that the Applicant relies upon Ms. Shneider's evidence to establish use of the Mark, this evidence is clearly inconsistent with continuous use since the claimed date of first use.

[28] I have some difficulty accepting this argument. Ms. Shneider's affidavit essentially consists of evidence from the Applicant's current North American distributor for the Applicant's products to Canadian distributors. In my view, this evidence is not inconsistent with the Applicant's claimed date of first use, it simply doesn't date back that far. I do not consider an absence of evidence from the Applicant's former North American distributor(s), assuming there was one, to be sufficient to put into issue the Applicant's claimed date of first use.

[29] In any event, as discussed below, Mr. Kovalenko states in his affidavit that the Applicant's Canadian distributor, KNV FOOD Corp., has sold ROSHEN products since prior to the Applicant's claimed date of first use and he has provided sales figures and invoices dating back to 2004 [paras 3, 5 and 9-11].

Kovalenko Affidavit

[30] Mr. Kovalenko is the owner and director of KNV FOOD Corp. ("KNV") [para 1]. He has held this position since July 2004.

[31] In his affidavit, Mr. Kovalenko explains that KNV is an importer and wholesaler of confectionery and other products, and that it is the distributor of the products of the Applicant in Canada [para 3]. As noted by the Opponent, Mr. Kovalenko somewhat circularly refers to the Applicant's products in his affidavit as "the ROSHEN products", without specifying what those products are [para 3]. Further, the particular types of products associated with the Mark are not clearly or consistently identified in the invoices attached as Exhibits 3 and 4 to Mr. Kovalenko's affidavit. Mr. Kovalenko simply states that Exhibit 3 consists of samples of invoices issued to KNV for ROSHEN products for sale in Canada and that Exhibit 4 consists of samples of invoices from KNV to retailers, for, among other things, ROSHEN products [paras 10 and 11]. The Opponent further notes that in the images of products attached as Exhibit 2 to the Kovalenko affidavit, it is not always clear what the precise nature of the products is, as the packaging is not in English or French. In view of this, the Opponent submits that the evidence of use provided by the Applicant is inconsistent with use in association with the *specific goods* claimed in the application.

[32] Such an argument appears to fall outside the scope of the Opponent's pleading. However, even if that were not the case, I note that Mr. Kovalenko clearly states in his affidavit that the Applicant is well-known as a maker of confectionary and candies and the application for the Mark covers only these types of goods (notably, "candy" is a type of confectionery) [para 6]. In view of this, and in the absence of any cross-examination on this point, I see no reason to conclude that the ROSHEN products referred to by Mr. Kovalenko as being distributed by KNV were something other than products of that nature.

[33] According to Mr. Kovalenko, KNV has marketed and sold the ROSHEN products since July 2004. KNV's marketing of the ROSHEN products is limited to providing in-store displays to its Canadian retailers. Attached as Exhibit 1 are photos of in-store displays, representative of displays provided to retailers by KNV [para 7]. Mr. Kovalenko states that KNV sells the products to retailers in Canada who sell to consumers [para 5]. According to Mr. Kovalenko, the vast majority of the ROSHEN products are sold in Canada to consumers by specialty eastern European retailers [para 6; see also para 6 of the Shneider affidavit, which provides the same information].

[34] In paragraph 8, Mr. Kovalenko confirms that the ROSHEN products are clearly marked, both on the packaging for sales by KNV to its retailers in Canada and on the packaging when the ROSHEN products are sold to the end consumer [para 8]. Attached as Exhibit 2, are samples of ROSHEN products, which Mr. Kovalenko states bear the ROSHEN trade-marks (defined in para 4 as ROSHEN & RIBBON Design (application No. 1,548,677), ROSHEN Design (application No. 1,548,678) and ROSHEN Design (application No. 1,548,679)). I confirm that at least some of the products shown in Exhibit 2 feature the Mark, while others feature the other marks identified by Mr. Kovalenko as the ROSHEN trade-marks.

[35] In paragraph 9 of his affidavit, Mr. Kovalenko provides gross sales figures pertaining to sales made by KNV to Canadian retailers since 2004. He indicates that these figures represent the wholesale revenues of KNV. The figures range from approximately US\$100,000 in 2004 to US\$860,000 in 2014. Given that the claimed date of first use in the application for the Mark is “since at least as early as January, 2009”, I consider it reasonable to infer that only a portion of the figures from 2009 onward relate to sales of products in association with the Mark.

[36] I acknowledge that Mr. Kovalenko has not broken these sales figures down on a product by product or trade-mark by trade-mark basis. I also acknowledge that the Applicant’s invoices [Exhibits 3 and 4] do not consistently identify the name of the company issuing the invoice, list ROSHEN or identify the precise nature of the products, and that Mr. Kovalenko has not addressed these issues in his affidavit.

[37] However, I do not consider the lack of precision in Mr. Kovalenko’s affidavit in these respects sufficient to call into question whether the Mark has been used since the claimed date of first use, continuously or otherwise. In my view, this lack of precision in Mr. Kovalenko’s affidavit is more akin to a gap or deficiency in the evidence, than it is to an inconsistency or an ambiguity, which may suffice to call into question whether the Mark has been used continuously since the claimed date of first use or otherwise. An absence of evidence is not necessarily evidence of absence [*Masterfile Corp v Ebrahim* 2011 TMOB 85 (CanLII); *7666705 Canada Inc v 9301-7671 Québec Inc*, 2015 TMOB 150 (CanLII)].

[38] Mr. Kovalenko clearly states that KNV has marketed and sold the ROSHEN products since July 2004 [para 5] and that the ROSHEN products are marked, both on the packaging for

sales by KNV to retailers in Canada and on the packaging when the products are sold to end consumers [para 8]. While he may not say what the products are marked with, he has attached samples of the ROSHEN products as Exhibit 2 and at least some show the Mark. Given that Mr. Kovalenko's evidence was not tested on cross-examination, I do not consider it reasonable to doubt the veracity of these statements. However, once again, given that the claimed date of first in the application for the Mark is "since at least as early as January, 2009", I consider it reasonable to infer that use of the Mark only would have occurred on the packaging for the ROSHEN products from the end of January, 2009 onward.

[39] There still remains the issue as to whether the Applicant's evidence is sufficient to call into question whether the Applicant itself used the trade-mark. I am of the view that it is. In this regard, I note that the Applicant is identified in the application as Dotchirne pidpriemstvo Konditerska korporatzia Roshen. In paragraph 3 of his affidavit, Mr. Kovalenko states that KNV is the distributor of the products of the Applicant. He then defines these products as the "ROSHEN products". He goes on to state that KNV has sold the ROSHEN products since July 2004 [para 4].

[40] As previously discussed, the Applicant has submitted evidence by way of the Shneider affidavit to establish that from 2011 and onwards, KNV received ROSHEN products via the Applicant's North American distributor (Roshen USA LLC). However, no similar affidavit has been filed from either a representative of a former North American distributor or from a representative of the Applicant to explain where KNV obtained the ROSHEN products it sells in Canada prior to that date.

[41] Mr. Kovalenko simply indicates that the invoices attached as Exhibit 3 to his affidavit are "samples of invoices issued to KNV for ROSHEN products for sale in Canada". He does not specify whether the invoices were issued by the Applicant, a licensee, a predecessor in title or some other entity. Of the five documents attached as Exhibit 3, three of them are in a language other than English or French and they do not appear to reference the Applicant. The remaining two make reference to ROSHEN Confectionery Corporation. Those same two documents also provide an invoice No. and make reference to a contract dated October 25, 2004 between KNV and an entity identified as DP « ROSHEN Confectionery Group ». At the hearing, the Applicant

argued that I should infer that all of these entities are all one and the same. However, I do not consider there to be any reasonable basis on which to draw such an inference.

[42] In my view, this evidence is sufficient for the Opponent to meet the light initial evidential burden upon it to put into issue whether it was the Applicant itself using the Mark at the claimed date of first use, which in this case would have been January, 2009 or whether it was perhaps used by an unnamed predecessor at that time or at some point prior to the filing date of the application.

[43] It was only after the Applicant filed its evidence that the Opponent requested leave to amend its statement of opposition to raise non-compliance with section 30(b) as a ground of opposition. In so doing, it effectively put the Applicant on notice that it intended to challenge the correctness of the statement made in its application. It was open to the Applicant at that time to request leave to file additional evidence pursuant to Rule 44(1) of the *Trade-marks Regulations* SOR/96-195 in order to address this ground of opposition, but it did not do so. Since I have found that the Applicant's evidence is sufficient for the Opponent to meet its light evidential burden and since the Applicant has not filed evidence to establish on a balance of probabilities that its application complies with the requirements of the Act, the section 30(b) ground of opposition is successful.

Section 12(1)(d) – Likelihood of Confusion

Preliminary Remarks

[44] In finding against the Applicant under the section 30(b) ground of opposition, I have done so on a technical basis. More particularly, on the basis that the evidence is sufficient to call into question whether the application incorrectly claims use by the Applicant, as opposed to use by the Applicant *and* use by a predecessor in title. Under its section 30(b) ground of opposition, the Opponent has not alleged that use of the Mark would have inured to the benefit of an entity other than the Applicant, and the evidence does not establish this to be the case. In view of this, I consider it appropriate to assess this ground of opposition (and the remaining grounds), on the basis that the Mark has been used since the date of first use claimed in the application. If I am wrong in doing so, I wish to note that it would not have changed the outcome of my decision, as

I would have come to the same conclusion regardless of whether such use was taken into account.

Evidential Burden/Legal Onus on Parties under Section 12(1)(d)

[45] For a section 12(1)(d) ground of opposition, an opponent's initial evidential burden is met if a registration relied upon in the statement of opposition is in good standing as of the date of the decision.

[46] The Registrar has discretion to check the register in order to confirm the existence of a registration relied upon by an opponent [*Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[47] In this case, I have exercised that discretion and confirm that the Opponent's registration Nos. TMA565,125 for ROCHER and TMA658,233 for FERRERO ROCHER & Design are extant and in good standing.

[48] Since the Opponent has met its initial evidential burden in respect of this ground, I must therefore go on to determine whether the Applicant has met the legal onus upon it to establish, on a balance of probabilities, that there is no likelihood of confusion between the parties' trade-marks.

Test for Confusion

[49] 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 goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[50] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the goods, services or business; (d) the

nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [*Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)].

[51] In *Masterpiece (supra)*, at para 49, the Supreme Court of Canada had the following to say about conducting a confusion analysis under section 6(5) of the Act:

[...] the degree of resemblance, although the last factor listed in s.6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis [...] if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar [...] As a result, it has been suggested that a consideration of resemblance is where more confusion analyses should start.

Consideration of Section 6(5) Factors

Degree of Resemblance

[52] When considering the degree of resemblance between trade-marks, they must be considered in their totality; it is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the marks [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 (CanLII), CarswellNat 1402 at para 20].

[53] In *Masterpiece (supra)*, at para 64, the Supreme Court further advises that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-marks that is particularly striking or unique.

[54] In the case of the Mark, it is the word ROSHEN which stands out as being striking and unique. It has no clear meaning or significance in relation to confectionery and it is prominently featured in the center of the Mark, within a surrounding box design and suggestive or descriptive text. The Opponent's ROCHER trade-mark is composed of only a single word and no one particular part of it stands out as a matter of first impression. The Opponent's trade-mark FERRERO ROCHER & Design features a very prominent confectionery design in colour, which

stands out in combination with the words FERRERO ROCHER, which are prominently featured inside oval shaped bands.

[55] I will begin by assessing the degree of resemblance between the Mark and the Opponent's word mark ROCHER. Visually, the marks bear some similarity to one another, in that the part of the Mark which most stands out, namely, the word ROSHEN, and the word ROCHER, have some letters in common ("r", "o" and "e"). However, the Mark also features a design component, as well as additional descriptive text (i.e. the words "fine chocolate", "since 1996", and "classic"), which results in some visual dissimilarity between the marks. Overall, I consider the marks to be somewhat different in terms of appearance.

[56] In terms of sound, the word ROSHEN in the Mark and ROCHER would likely be pronounced quite differently by a unilingual English speaking consumer, and somewhat differently by a unilingual French speaking or bilingual consumer. As a whole, the Mark is quite different phonetically, due to the inclusion of the additional descriptive terms "fine chocolate", "since 1996", and "classic" and would be pronounced quite differently by all three consumer groups.

[57] In terms of suggested idea, there is very little similarity between the parties' marks. To a unilingual French, unilingual English or bilingual consumer, the word ROSHEN may be perceived as being foreign or coined in nature, or perhaps as a surname. The same may be said with respect to the Mark for unilingual English speaking and some bilingual consumers. However, given the differences in spelling, it is fair to say that such consumers would not assume that the marks have the same meaning or that they are the same surname. With respect to the unilingual French consumer, as well as some bilingual consumers, as will be discussed in more detail below, the word ROCHER would be somewhat suggestive or descriptive in the French language of a type of confectionary or confectionary in the shape of a rock. To the extent that chocolate is a type of confectionary, the word "chocolate" in the Mark may result in some similarity in suggested idea to bilingual consumers, but when the marks are viewed in their totality, I do not consider there to be a high degree of resemblance between them in terms of suggested idea, amongst French speaking, English speaking or bilingual consumers.

[58] Overall, I consider the parties' marks to be more different than alike amongst all three consumer groups (i.e. unilingual French speaking, unilingual English speaking and bilingual consumers).

[59] The Opponent's FERRERO ROCHER & Design trade-mark is even more different than the Mark. It's FERRERO ROCHER & Design trade-mark differs considerably from the Mark both visually and phonetically, in view of the added design components and the word FERRERO, which appears in a dominant first position in the Mark when read or spoken.

[60] There is some similarity in terms of suggested idea between the Opponent's trade-mark FERRERO ROCHER & Design and the Mark, in that the Mark includes the word "chocolate" and the Opponent's trade-mark features an image of confectionary. However, the remaining aspects of the marks differ in terms of suggested idea.

Inherent Distinctiveness and Extent to which the Trade-marks have Become Known

[61] I consider the Mark to be inherently distinctive, as ROSHEN, the part of the Mark which stands out most, is in no way descriptive or suggestive of confectioneries. The Opponent does not dispute that the Mark is inherently distinctive [see Opponent's Written Argument, para 61].

[62] With respect to the Opponent's trade-mark ROCHER, the Applicant submits that it is highly suggestive for two reasons. First, because the word "rocher" describes a type of confectionery in the French language. Second, because it also means "rock" in the French language, and the Opponent's products are somewhat rock-shaped [Cosman affidavit, Exhibit D].

[63] In support of its argument, the Applicant relies upon Exhibit PB-1 to the Balzamo affidavit, which includes a dictionary definition for "rocher" from the Larousse Online Dictionary. The word "rocher" is defined as a French term meaning "rock" or "rocher (rock-shaped chocolate)". I note that similar definitions appear in *Le Nouveau Petit Robert* (1996), which defines "rocher" as "Gâteau ou confiserie ayant l'aspect d'un petit rocher. *Rocher au chocolat*" and *Le Petit Larousse illustré* (2001), which defines it as "Gâteau ou bouchée au chocolat ayant la forme et l'aspect rugueux de certains rochers". The Applicant also makes reference to a number of websites located in a web common law search conducted by Mr.

Balzamo, which show use of the term “rocher” in a descriptive manner in connection with various baked goods and confectionery products [Balzamo affidavit, Exhibit PB-1]. However, it is unclear how many of the websites are Canadian or whether any Canadians have ever visited them.

[64] Based on the above definitions and the nature of the Opponent’s products, I find that the Opponent’s ROCHER trade-mark possesses little, if any, inherent distinctiveness for the average unilingual French speaking and some bilingual consumers. For the average unilingual English speaking consumer, it would be inherently distinctive.

[65] The Opponent’s trade-mark FERRERO ROCHER & Design also contains the word “rocher”, along with a design component which serves to reinforce the idea of confectionery. However, due to the inclusion of FERRERO, which does not appear to have any significance in relation to confectionery, I find it to be more inherently distinctive than the Opponent’s ROCHER trade-mark.

[66] Overall, I am of the view that the Opponent’s ROCHER word mark is significantly less inherently distinctive than the Mark for unilingual French speaking and some bilingual consumers and slightly less inherently distinctive than the Mark for unilingual English speaking consumers, primarily owing to the added design/colour features which are present in the Mark. The Opponent’s FERRERO ROCHER & Design trade-mark possesses no more inherent distinctiveness than the Mark amongst any of the relevant consumer groups.

[67] The distinctiveness of a trade-mark may be further increased through promotion or use.

[68] As previously discussed, there has been limited promotion and some use of the Mark in Canada. The marketing of the ROSHEN products in Canada is limited to its Canadian distributors providing in-store displays to Canadian retailers [Kovalenko affidavit, para 7; Exhibit 1]. In terms of sales, the ROSHEN products have been sold in Canada since July 2004 [Kovalenko affidavit, para 5]. Wholesale revenues for sales of the ROSHEN products to Canadian retailers have ranged from between US\$100,000 in 2004 to US\$860,000 in 2014 [Kovalenko affidavit, para 9]. As mentioned previously, Mr. Kovalenko has not broken these sales figures down on a product by product or trade-mark by trade-mark basis. However,

Exhibits 1 and 2 of his affidavit do show clear examples of use of each of the Applicant's trade-marks on in-store displays and product packaging [paras 7 and 8; see also Shneider affidavit, paras 7-8 and Exhibits A and B].

[69] The Cosman affidavit speaks to the promotion and use of the Opponent's trade-marks. In his affidavit, Mr. Cosman states that the Opponent's ROCHER products have been sold in Canada in association with the ROCHER marks, since at least as early as 1996 [para 10]. The ROCHER marks are defined in paragraph 8 of Mr. Cosman's affidavit as the marks which are the subject of its registration Nos. TMA565,125 (ROCHER) and TMA658,233 (FERRERO ROCHER & Design). Likewise, the ROCHER products are defined as those which are covered by its registrations, namely, "packaged chocolate confectionery" and "chocolates, confectionery, namely pastry and confectionery products containing chocolate as an ingredient, wafers" [paras 8 and 9].

[70] Mr. Cosman provides representative sample product packaging for its products sold in association with the ROCHER marks in Canada from 2001-2014 as Exhibit D to his affidavit [para 12]. It is worth noting that the packaging shown in Exhibit D appears to almost exclusively show use of the mark FERRERO ROCHER & Design. At the hearing, the Opponent attempted to point out a couple of possible exceptions. However, they were not entirely or particularly visible and arguably, might constitute use of FERRERO ROCHER, rather than ROCHER, *per se* (the instances in question purportedly featured the words on a ribbon extending around both sides of the packaging, with FERRERO being shown on one side and ROCHER on the other).

[71] Examples of in-store displays available to help showcase the Opponent's products are attached as Exhibit E to the Cosman affidavit. Exhibit E appears to be comprised of information sheets which show the various types of displays that are available for the Opponent's products. There are no clear examples of use of ROCHER on its own on any of the products or displays shown in Exhibit E. While the word ROCHER does appear as part of the text on the information sheets, it seems to appear in a descriptive sense, as it appears in the same manner as words like "pralines" Interestingly, FERRERO does appear on its own on some of the displays.

[72] In paragraph 14, Mr. Cosman provides volume and sales figures for the Opponent's products sold in Canada since 1996. The sales have been substantial, ranging from in excess of

20 million dollars in 1996/1997 to 52 million dollars in 2013/2014. Representative samples of invoices issued to a warehouse club, department store and grocery stores in Canada in the years of 2006 to 2014 are attached as Exhibit F to Mr. Cosman's affidavit [para 16].

[73] Details pertaining to the Opponent's advertising and promotion of its products, in association with its ROCHER trade-marks are outlined in paragraphs 17 to 22 of Mr. Cosman's affidavit. According to Mr. Cosman, no less than \$2,000,000 has been spent promoting and marketing the Opponent's products each and every year in Canada since the 1996/1997 fiscal year [para 17]. Its advertising includes: television advertising, since 1996 [paras 18-21; Exhibit G]; website advertising on websites maintained by the entities within the same group of companies as the Opponent, since 2008 [Exhibit H]; promotional events and giveaways, such as in-store sampling [Exhibit I] and contests; internet advertising and social media promotion [Exhibit J]; and print publications [Exhibit K].

[74] According to Mr. Cosman, "brand awareness" and "top of mind awareness" market research has been conducted in Canada to measure the degree of recognition of the Opponent's products by Canadian consumers [paras 23 and 24]. Brand awareness is simply a measure of the percentage of consumers who are aware of a particular brand. Top of mind awareness measures how well a brand ranks in the mind of consumers. From 2008 to November 2014, ROCHER brand awareness has never rated lower than 92% in any of the measured regions (reporting was divided between English and French speaking Canada. Brand awareness of ROCHER was a category-leading 93-96% in each of the measured regions in 2010-2013 and ROCHER was only tied for the category lead once, in English-Canada in 2012 by Nestle Turtles.

[75] While there is some imprecision in the Opponent's evidence, I am satisfied from the Cosman affidavit that the Opponent has established that its FERRERO ROCHER & Design trade-mark has become very well known in Canada.

[76] Insofar as the Opponent's trade-mark ROCHER is concerned, I am not satisfied from the evidence that it has become known to any significant extent. Although Mr. Cosman refers to both of the Opponent's trade-marks collectively throughout his affidavit, when providing sales and advertising details, the documentary evidence attached to his affidavit shows almost no use of ROCHER on its own. At the hearing, the Opponent was only able to direct my attention to a

few incomplete/barely visible examples and arguably, such examples may not even be perceived by consumers as being use of ROCHER on its own. As noted previously, they appeared on the ribbon on the product packaging, with FERRERO appearing on one side and ROCHER appearing on the other. In view of the foregoing, I do not consider it reasonable to attribute a significant portion of the Opponent's sales figures or advertising efforts to the Opponent's ROCHER trade-mark.

[77] Overall, I find that this factor, which involves an assessment of a combination of the inherent and acquired distinctiveness of the parties' trade-marks, favors the Applicant with respect to the Opponent's ROCHER trade-mark, but favours the Opponent, with respect to its FERRERO ROCHER & Design trade-mark. I have come to my conclusion with respect to the Opponent's ROCHER trade-mark because the Mark possesses a slightly higher degree of inherent distinctiveness and the Opponent has failed to establish that it has acquired a significant degree of distinctiveness in its ROCHER trade-mark. I have come to my conclusion with respect to the Opponent's FERRERO ROCHER & Design trade-mark because it is somewhat inherently distinctive and it has acquired further distinctiveness through substantial promotion and sales, whereas any acquired distinctiveness in the Mark has been much less substantial.

Length of Time the Marks have been in Use

[78] This factor favours the Opponent in relation to its FERRERO ROCHER & Design trade-mark, as the Opponent commenced use in 1996 and has provided many examples of use, as well as sales figures dating back to that date. However, I am unable to come to the same conclusion with respect to the Opponent's ROCHER word mark, in view of the almost complete absence of any documentary evidence showing use of that particular mark.

Nature of the Parties' Goods, Services or Business and Trades

[79] It is the Applicant's statement of goods as defined in its application versus the Opponent's registered goods that governs my determination of these factors [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr. Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); and *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[80] There is direct overlap in the nature of the parties' goods, and both of the parties are in the business of selling confectionery.

[81] According to Mr. Cosman, the Opponent's goods are sold in drug stores, food stores, convenience stores, department stores, mass merchandisers, warehouse clubs, and general merchandise stores [para 13]. According to Mr. Kovalenko, the vast majority of the ROSHEN products are sold in Canada to consumers by specialty eastern European retailers [para 6; see also para 6 of the Shneider affidavit, which provides the same information]. However, there is no restriction to this effect in the application for the Mark and it is entirely possible that despite currently being sold through different outlets, some of the end consumers may be the same.

[82] Accordingly, these factors favour the Opponent.

Surrounding Circumstances

State of the Register/Domain Name/Nuans/Internet Search Results

[83] As part of its evidence, the Applicant filed two affidavits from a Trade-mark Research Analyst (Sandro Romeo) at Thomson CompuMark. Ms. Romeo conducted searches on the Canadian trade-mark Register for ROCHER and ROSHEN, as well as domain name searches for both terms. The Applicant did not make any detailed submissions in relation to these affidavits in its written arguments. Ms. Romeo's search of the Register did not reveal a large number of active trade-marks standing in the names of third parties. Thus, it does not assist me in drawing any meaningful inferences regarding the state of the marketplace. The domain name search results are not helpful to the Applicant either, once those results which appear to be associated with unrelated goods/services and/or are non-Canadian are removed.

[84] Likewise, the NUANS search results provided by way of the Balzamo affidavits are also unhelpful, as it is not clear that the goods and services associated with any of the entities located in Mr. Balzamo's search are the same or similar to those of the parties, and there is no information with respect to the extent of their operations or the length of time for which they have been in business in Canada. Insofar as the results of Mr. Balzamo's internet searches are concerned, I note that many of the websites located by Mr. Balzamo do not appear to be

Canadian and there is no information regarding the extent to which they may have been accessed by Canadians.

Co-existence of Parties' Trade-marks on Registers in Other Jurisdictions

[85] As part of its evidence, the Applicant filed two affidavits from a searcher (Christina St. Peter) at Thomson CompuMark. Ms. St. Peter conducted searches of the records of Trade-mark Offices in other jurisdictions to locate: i) trade-marks containing the term ROSHEN and having DOCHIRNIE, DOTCHIRNE or ROSHEN in the Applicant's name; and ii) trade-marks containing the term ROCHER and having the term FERRERO in the Applicant's name. The Applicant did not make any detailed submissions in relation to these affidavits in its written argument. Suffice it to say, the fact that such marks may co-exist on trade-mark Registers in other jurisdictions, is not determinative of whether they can co-exist on the Canadian trade-mark Register and/or in the Canadian marketplace without any likelihood of confusion.

Co-existence in the Marketplace without Instances of Actual Confusion

[86] An absence of confusion despite an overlap between parties' goods or services and channels of trade during a meaningful length of time may entitle one to draw a negative inference about an opponent's case [*Christian Dior SA v Dion Neckwear Ltd* 2002 FCA 29 (CanLII), 20 CPR (4th) 155 (FCA) at para 19]. While both parties' marks have been used in Canada for a fairly lengthy period of time, their products do not appear to have been sold in the same types of stores. This could account for some absence of actual confusion in this case. Thus, while it is a relevant surrounding circumstance, I do not consider it to be one that is overly helpful to the Applicant.

Conclusion Regarding Likelihood of Confusion

[87] Section 6(2) of the Act does not concern confusion of the marks themselves, but confusion of goods and services from one source as being from another source. The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the Mark in association with the goods and/or services at a time when he or she has no more than an imperfect recollection of the Opponent's trade-mark and does not pause to give the

matter any detailed consideration or scrutiny [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* 2006 SCC 23 (CanLII) at para 20].

[88] Bearing this in mind, I have come to the conclusion that there is no reasonable likelihood of confusion between the Mark and the Opponent's ROCHER trade-mark. While there is overlap in the nature of the parties' goods and business, and potential for overlap in their channels of trade, the Opponent's ROCHER trade-mark is significantly less inherently distinctive than the Mark for French speaking and some bilingual consumers and slightly less inherently distinctive than the Mark for unilingual English speaking consumers. The Opponent has not demonstrated that it has acquired any substantial degree of distinctiveness in its ROCHER trade-mark, and I consider the parties' marks to be more different than alike amongst all three consumer groups (i.e. unilingual French speaking, unilingual English speaking and bilingual consumers). Overall, I am of the view that the differences between the parties' marks are sufficient to avoid any reasonable likelihood of confusion.

[89] I have come to the same conclusion with respect to the Opponent's FERRERO ROCHER & Design trade-mark. The Opponent's FERRERO ROCHER & Design trade-mark is more inherently distinctive than its ROCHER trade-mark, and it has also acquired a substantial amount of distinctiveness through promotion and use. Once again, there is overlap in the nature of the parties' goods and business, and potential for overlap in their channels of trade. However, the differences in appearance, sound and suggested idea between the Opponent's FERRERO ROCHER & Design trade-mark and the Mark, are even more substantial than the differences between the Mark and the Opponent's ROCHER trade-mark. In my view, these differences are significant enough to outweigh the other factors in the section 6(5) analysis, the result being that I also find that there is no reasonable likelihood of confusion between the Opponent's FERRERO ROCHER & Design trade-mark and the Mark.

[90] Accordingly, the section 12(1)(d) ground of opposition is rejected.

Sections 16(1)(a) and 2(distinctiveness) – Likelihood of Confusion

[91] At the hearing, the parties agreed that in the circumstances of this case, the date at which the issue of confusion is assessed does not change the result of my analysis. I agree.

Accordingly, to the extent that the Opponent has met its initial burden in respect of these grounds, they both fail for reasons similar to those set out above with respect to the section 12(1)(d) ground of opposition.

Section 2 (distinctiveness) – Non-compliance with section 50 of the Act

[92] As mentioned previously, subsequent to the filing of the Applicant's evidence in this case, the Opponent was granted leave to amend its statement of opposition to include an additional ground of opposition based upon non-distinctiveness. The pleading reads as follows:

The Trade-mark is not distinctive of the Applicant given the use in Canada by third parties of the Trade-mark in association with goods over which the Applicant does not have direct or indirect control of character or quality, pursuant to section 50 of the act.

[93] The Opponent has not indicated in its pleading who these third parties might be, and it has not filed any evidence which can support its pleading. Even if the Opponent could rely upon the Applicant's evidence to meet its burden in respect of this ground, such evidence is, in my view, insufficient. I acknowledge that earlier invoices attached to the Kovalenko affidavit make reference to an entity other than the Applicant, as discussed in detail under the section 30(b) ground of opposition. I also acknowledge that the Applicant's name does not appear on packaging attached to the Kovalenko and Shneider affidavits [Kovalenko affidavit, Exhibit 2; Shneider affidavit, Exhibit B]. Further, that there are registrations for ROSHEN on foreign trade-mark Registers, which stand in the name of entities other than the Applicant [St Peter affidavit]. However, both Mr. Kovalenko and Ms. Shneider clearly indicate in their affidavits that it is the products of the Applicant which are sold in Canada. In the absence of cross-examination or any evidence from the Opponent, I do not consider it reasonable to infer that the Mark has been used in Canada in a manner that is non-compliant with section 50, so as to negate the distinctiveness of the Mark.

[94] Accordingly, this ground of opposition is rejected.

DISPOSITION

[95] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Lisa Reynolds
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE 2017-10-26

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