



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

Citation: 2018 TMOB 163

Date of Decision: 2018-12-24

IN THE MATTER OF AN OPPOSITION

Lumber Liquidators, Inc.

Opponent

and

Grespania, S.A.

Applicant

1,608,432 for BELLACASA Design

Application

INTRODUCTION

[1] Lumber Liquidators, Inc. (the Opponent) opposes registration of the trade-mark BELLACASA Design (the Mark) shown below, which is the subject of application No. 1,608,432 by Grespania, S.A. (the Applicant):

The image shows the handwritten logo for "Bella Casa". The word "Bella" is written in a large, cursive script, and "Casa" is written in a smaller, simpler cursive script below it.

[2] The application contains the following colour claim:

Colour is claimed as a feature of the trade-mark. The Applicant claims the colour blue (PANTONE S191-E)* and blue (PANTONE S221-4)* as essential features of the trade-mark. The letters BEL in the word 'Bella' and the letters CA in the word 'Casa' are the colour blue (PANTONE S191-E)*. The second letter 'l' in the word 'Bella' fades from blue (PANTONE S191-E)* to blue (PANTONE S221-4)*. The letters SA in the word 'Casa' are blue (PANTONE S221-4)*. *PANTONE is a registered trade-mark.

[3] The application is based on use and registration in Spain, and proposed use in Canada in association with “wall tiles, ceramic and stoneware pavements and floor covering, floor tiles” (the Goods).

[4] A key issue in this proceeding is the likelihood of confusion with the Opponent’s registered trade-mark BELLAWOOD in association with “wood flooring products, namely, prefinished hardwood flooring for interior use”. For the reasons set out below, I find that the application ought to be refused.

THE RECORD

[5] The application for the Mark was filed on January 2, 2013 and was advertised for opposition purposes in the *Trade-marks Journal* of June 18, 2014.

[6] On November 5, 2014, the Opponent filed a statement of opposition under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). Following a notice from the Registrar regarding compliance with section 38(4) of the Act, an amended statement of opposition was filed on December 16, 2014, which was accepted by the Registrar.

[7] The Applicant filed a counter statement on March 2, 2015, and at the same time, requested an interlocutory ruling, which issued on April 24, 2015. The grounds of opposition as amended by the interlocutory ruling are summarized below:

- a) Contrary to sections 38(2)(b) and 12(1)(d) of the Act, the Mark is confusing with the Opponent’s trade-mark BELLAWOOD which had previously been filed, registered and used in Canada by the Opponent and its predecessor in title.
- b) Contrary to sections 38(2)(c), 16(2)(a), 16(2)(b), 16(3)(a) and 16(3)(b) of the Act, the Mark was confusing with the Opponent’s trade-mark BELLAWOOD which had

previously been filed, registered and used in Canada by the Opponent and its predecessor in title.

- c) Contrary to sections 38(2)(d) and 2 of the Act, the Mark is not distinctive as it is confusing with the Opponent's BELLAWOOD trade-mark which had previously been filed, registered, used and made known in Canada by the Opponent in association with the Opponent's services and is therefore not distinctive of (nor is it adapted to distinguish) the Applicant's proposed services.

[8] I note that the ground of opposition pleaded under sections 38(2)(d) and 2 of the Act contains typographical errors whereby the applied-for Goods are referred to as services and reference is made to the Opponent's goods and services whereas only goods are covered in its registration. In its written argument, the Applicant takes the position that it cannot respond to this ground and it should be struck as the Opponent has not objected to the distinctiveness of the Mark in respect of *goods*, or relied on non-distinctiveness on the basis of prior use in association with *goods* associated with the Opponent's mark. However, despite these typographical errors the Opponent's meaning was clear, and therefore I do not consider them to be of any consequence. In this regard, the Applicant did respond to this ground of opposition in its counter statement, stating that the Applicant's Mark "does in fact distinguish the Applicant's goods covered by the application from the wares and services of the Opponent".

[9] In support of the opposition, the Opponent filed the affidavit of Edward Livingston Burrill Haskell. The Opponent was subsequently granted leave to file the affidavit of Marco Q. Pescara, in substitution for the Haskell affidavit. Mr. Pescara was not cross-examined on his affidavit.

[10] The Applicant elected not to file any evidence in support of its application.

[11] Only the Applicant filed a written argument, however both parties were represented at a hearing.

ONUS AND MATERIAL DATES

[12] 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].

[13] The presence of a legal onus on the Applicant means that if a determinate conclusion cannot be reached (on the usual civil balance of probabilities standard) once all the evidence is in, then the issue must be decided against the Applicant [*Project Futureproof Inc v Shane Wolfe*, 2018 TMOB 43 at para 27].

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

- 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)(b)/16(2) and (3) – the date of filing of the application [sections 16(2) and (3) of the Act]; 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)].

PRELIMINARY REMARKS

Applicant's objections to the Haskell affidavit (attached as Exhibit A to the Pescara affidavit)

[15] Marco Q. Pescara is the Chief Merchandising and Marketing Officer of the Opponent (para 1, Pescara affidavit). As Exhibit A to his affidavit, Mr. Pescara attaches a copy of the affidavit of Mr. Edward Livingston Burrill Haskell, previously filed in this proceeding. Mr. Pescara states that Mr. Haskell ceased being employed by the Opponent on June 1, 2016, and that he is informed by counsel that the Applicant in this matter wishes to cross-examine on the

Haskell affidavit (para 2, Pescara affidavit). Mr. Pescara states that given the fact that Mr. Haskell is no longer employed by the Opponent, he hereby repeats and relies on all of the facts and information in the Haskell affidavit, in the form set out therein (except for the personal facts regarding Mr. Haskell personally). He further states that he has personal knowledge of these facts given his employment with the Opponent (para 3, Pescara affidavit).

[16] The Applicant submits that the contents of the Haskell affidavit comprise inadmissible hearsay, whereas the Opponent takes the position that the Haskell affidavit is incorporated by reference by Mr. Pescara in his affidavit. The Opponent further submits that even if the Haskell affidavit is hearsay, that the requirements of necessity and reliability have been met. Considering that Mr. Haskell was no longer an employee of the Opponent and could not practically be compelled to attend at a cross-examination, and given that the Applicant had an opportunity to cross-examine Mr. Pescara on the contents of the Haskell affidavit, I agree that the requirements of necessity and reliability have been met and consider the Haskell affidavit to be admissible [*R v Khan*, 1990 CanLII 77 (SCC), [1990] 2 SCR 531 (SCC)].

ANALYSIS OF THE GROUNDS OF OPPOSITION

Grounds of opposition summarily dismissed

Section 16(2)(b) and 16(3)(b) grounds

[17] The grounds of opposition pleaded under sections 16(2)(b) and 16(3)(b) of the Act allege that the Applicant is not the person entitled to registration of the Mark as it is confusing with the Opponent's prior application for its BELLAWOOD trade-mark. However, as the Opponent's application had matured to registration and was not pending as of the date of advertisement of the Applicant's application (ie, June 18, 2014) as required by section 16(4) of the Act, these grounds of opposition are invalid.

Section 12(1)(d) ground of opposition

[18] The Opponent has pleaded that the Mark is not registrable because it is confusing with the Opponent's registration No. TMA648,781 for the trade-mark BELLAWOOD.

[19] Having exercised the Registrar's discretion to check the Register [*Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)], I confirm that this registration is in good standing. The Opponent has therefore met its initial burden for this ground of opposition.

[20] As the Opponent has satisfied its initial burden, I now have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with the Opponent's BELLAWOOD registration.

Test to determine confusion

[21] 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.

[22] Thus, the issue is not confusion between the trade-marks themselves, but confusion of goods and services from one source as being from another source. In the instant case, the question posed by section 6(2) of the Act is whether purchasers of the Goods sold in association with the trade-mark BELLACASA Design would believe that those items were produced, authorized or licensed by the Opponent.

[23] 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), 2006 SCC 22 (CanLII), 49 CPR (4th) 321 (SCC); and *Masterpiece v Alavida Lifestyles Inc* (2011), 2011 SCC 27 (CanLII), 92 CPR (4th) 361 (SCC) (*Masterpiece*)].

Inherent distinctiveness of the trade-marks and the extent to which they have become known

[24] The Applicant, in its written argument, submits the following regarding the inherent distinctiveness of the parties' marks:

40. The word elements of the marks in question comprise dictionary terms. Of the two, BELLACASA has greater inherent distinctiveness owing to the fact that it comprises two foreign terms and because it does not contain the name of the associated goods, as is the case in respect of the Opponent's mark, which contains the term WOOD...

[25] I agree with this characterization. As the Mark is made up of the foreign words BELLA and CASA - the translation provided by the Applicant of these words in the application is beautiful house - I find that it possesses a fair degree of inherent distinctiveness as it would be perceived by the public as words in a foreign language [*Thai Agri Foods Public Co v Choy Foong Int'l Trading Co Inc*, 2012 TMOB 61 (CanLII) at para 11]. I further note that the application for the Mark includes a colour claim and is presented in scripted font.

[26] The Opponent's trade-mark BELLAWOOD is comprised of the foreign word BELLA and the descriptive English word WOOD, and as such, I consider it to possess a lower degree of inherent distinctiveness than the Mark. The Opponent's registration appears in capital lettering so is not restricted to any particular font or colour [*Les Restaurants La Pizzaiolle Inc v Pizzaiolo Restaurants Inc* (2015), 2015 FC 240 (CanLII)].

[27] Later in its written argument, the Applicant made further submissions with respect to the element BELLA, stating that it is "most commonly recognized in English as being a female's first name". At the hearing, the Applicant submitted that given that BELLA is recognized as a female name, it cannot be afforded a broad scope of protection. However, in the absence of evidence that BELLA would be recognized by Canadian consumers as a *common* given name, I do not consider this element to minimize the inherent distinctiveness of either of the parties' trade-marks [*Nada Fashion Designs Inc v Groupe Boyz Inc*, 2011 TMOB 155; *Industria de Diseno Textil, SA v ZARA Natural Stones Inc*, 2015 TMOB 10].

[28] I will now turn to the extent to which the trade-marks have become known in Canada.

[29] The Applicant has provided no evidence of use of the Mark with the result that I can only assume that the Mark has not become known to any extent in Canada.

[30] While the Opponent has filed evidence of use of the BELLAWOOD trade-mark through the affidavit of Marco Q. Pescara, the evidence indicates that the BELLAWOOD trade-mark is also being used in Canada by another party whose use of the trade-mark has not been shown to enure to the Opponent.

[31] Further, there are additional deficiencies (noted below) in the Opponent's evidence which make it difficult to draw any meaningful conclusions with respect to the extent to which the Opponent's BELLAWOOD trade-mark may have become known through use in Canada with the registered goods "prefinished hardwood flooring for interior use".

[32] Mr. Pescara is the Chief Merchandising and Marketing Officer of the Opponent. Pertinent facts and information from the Haskell affidavit, which are repeated and relied on by Mr. Pescara (para 3, Pescara affidavit; Exhibit A to the Pescara affidavit), are summarized as follows:

- The Opponent is a specialty retailer of hardwood flooring products (para 6), and has grown to include 366 US retail stores as of December 31, 2015 (paras 7, 8).
- Lumber Liquidators Canada Inc. (Lumber Liquidators Canada), an "affiliated entity of the Opponent", also operates 8 retail stores located in Canada (para 8).
- In addition to the sale of its hardwood flooring products through retail stores, the Opponent also sells hardwood flooring products through other retail channels, namely through a call centre, and through several websites of the Opponent (paras 10, 21).
- The Opponent has also sold hardwood flooring products to Canadian residents and Canadian domiciled businesses and has regularly shipped products to Canada in conjunction with telephone and online retail channels. The Opponent's first sale to Canadian customers through online orders or telephone orders dates back to at least as early as 2007 (para 11). I note that the Opponent has not indicated whether the hardwood flooring products sold were in association with the trade-mark BELLAWOOD.
- To supplement its servicing of the Canadian marketplace through mail order, telephone and online retail channels, Lumber Liquidators Canada, which runs the Canadian retail operations, opened its first Canadian retail store in March of 2011. Lumber Liquidators Canada is the Canadian licensee of the Opponent's trade-marks, including the BELLAWOOD trade-mark (para 12). I note that there is no indication that the Opponent has care and control over the character and quality of the Opponent's goods pursuant to section 50 of the Act, with the result that I cannot conclude that the use of

BELLAWOOD by Lumber Liquidators Canada enures to the Opponent [*Loblaws Inc v No Frills Auto & Truck Rental Ltd*; 2004 CarswellNat 3135 (TMOB); reversed on other grounds]. While there appears to be a relationship between the Opponent and Lumber Liquidators Canada (it is identified as an affiliated entity of the Opponent), it has been established that evidence of common ownership is not sufficient to satisfy the care and control requirement of section 50 of the Act [*MCI Communications Corp v MCI Multinet Communications Inc* (1995), 61 CPR (3d) 245 TMOB].

- The Opponent has “used BELLAWOOD in Canada since at least 2011, and has been used continuously thereafter” (para 14). According to a review of the Opponent’s and Lumber Liquidator Canada’s business records, the 2011-2015 sales of BELLAWOOD flooring products and flooring accessory products (including cleaner and underlayment) total approximately \$7,851,901 (CAD or USD is not indicated) (para 14). However, the sales figures do not indicate what amount of sales is attributable to the Opponent and what amount of sales is attributable to Lumber Liquidators Canada; nor do they reflect what amount is attributable to hardwood flooring (versus accessories).
- The Opponent advertises the BELLAWOOD brand through point of sale displays, print publications, radio ads, as well as through the internet. Since 2010 – August 2015, the Opponent has spent over USD \$370 Million in respect of marketing its brand, including the BELLAWOOD brand, in Canada and the United States. Of this total, over USD\$3 Million was spent since 2013 in respect of the Canadian market alone (para 16). I note that it is not clear from this statement the amount/percentage attributable to promotion of the BELLAWOOD brand in Canada (versus promotion of the Opponent’s brand).
- “Applicable advertisements” prominently display the trade-mark BELLAWOOD, which also appears on product packaging, which are sent in conjunction with delivery of the hardwood flooring products to customers (para 16).
- BELLAWOOD is also marked on the packages of flooring products offered for sale in Canada. Exhibit C is described as “samples of packaging for BELLAWOOD branded products”. I note that the samples, which prominently feature the BELLAWOOD mark, are limited to packaging for flooring accessory products (hardwood floor cleaner and a floor care kit). One sample label includes the notice “Manufactured by Lumber Liquidators Services, LLC”; this entity is not identified or discussed in the affidavit.
- The BELLAWOOD trade-mark is displayed on the Opponent’s websites www.lumberliquidators.com, www.lumberliquidators.ca, and www.bellawood.com and representative webpages are attached at Exhibit D. I note that there is no indication of the number of visits by Canadian consumers to these websites.
- Since at least 2010, the Opponent has distributed product catalogues prominently displaying the BELLAWOOD trade-mark to Canadian customers. In 2011, 215,540 catalogues were mailed to customers, and 73,630 were sent to stores in Canada. I note that Exhibits E and F contain copies of 2012 and 2015 catalogues, but no other catalogue distribution information (for any other years) is provided. A representative (and undated) advertisement and coupon for BELLAWOOD products issued by the Opponent to

customers in Canada is attached as Exhibit G. I note that there is no information on the extent of circulation of these materials in Canada.

[33] The Haskell affidavit also includes statements that constitute personal opinion on the likelihood of confusion between the parties' marks (paras 25, 26). As the likelihood of confusion is a question of fact and law to be determined by the Registrar based on the evidence of record in this proceeding, I have afforded these statements no weight.

[34] Considering that the Opponent's evidence makes it difficult to draw any meaningful conclusions with respect to the extent to which the Opponent's BELLAWOOD trade-mark may have become known through use in Canada by the Opponent with "prefinished hardwood flooring for interior use", I find that overall, this factor favours the Applicant.

The length of time in use

[35] The application for the Mark is based on proposed use and as discussed above, there is no evidence to suggest that use of the Mark has commenced in Canada.

[36] The Opponent's registration for the trade-mark BELLAWOOD is based on use and registration in the United States. While the Opponent has filed evidence of use, in view of the above referenced deficiencies in this evidence, including evidence indicating use of the Mark by another party which has not been shown to be to the benefit of the Opponent, I cannot make any conclusions as to the length of time in use. As a result, I do not find that this factor significantly favours either party.

The nature of the goods and trade and business

[37] It is the Applicant's statement of goods as defined in its application versus the Opponent's registered goods that governs my determination of this factor [*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); *Miss Universe Inc v Bohna* (1994), 1994 CanLII 3534 (FCA), 58 CPR (3d) 381 (FCA)]. However, those statements 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.

The evidence of the parties' actual trades is useful in this respect [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 1996 CanLII 3963 (FCA), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[38] The Goods as listed in the application are "wall tiles, ceramic and stoneware pavements and floor covering, floor tiles". The Opponent's registered goods are "wood flooring products, namely, prefinished hardwood flooring for interior use". To the extent that the parties' goods both comprise floor coverings, I consider them to be of the same general nature, although the differences in the composition of the parties' floor coverings are not insignificant.

[39] Evidence of the Applicant's website (as submitted by the Opponent) shows floor covering products, albeit not of wood but porcelain tile (Exhibit I, Haskell affidavit).

[40] With respect to the parties' channels of trade, and in the absence of evidence to the contrary, it is reasonable to assume that there would be some overlap in the parties' channels of trade for these floor covering goods as they fall in the same general class of floor coverings. Regarding the Goods "wall tiles", although they do not fall under the category of floor coverings, in the absence of evidence to the contrary, I assume that they are an ancillary item to floor coverings and that there would similarly be some overlap in the same channels of trade.

Degree of Resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[41] While the degree of resemblance is the last factor cited in section 6(5) of the Act, it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion [*Masterpiece, supra* at para 49].

[42] When considering the degree of resemblance, the trade-marks must be considered in their totality. The appropriate test is not a side by side comparison but a matter of first impression of a consumer with an imperfect recollection of an opponent's trade-mark [*Veuve Cliquot Ponsardin v Boutiques Cliquot Ltee* (2006), 2006 SCC 23 (CanLII), 49 CPR (4th) 401 at para 20].

[43] In *Masterpiece*, the Supreme Court of Canada observed that while the first word of a trade-mark may, for purposes of distinctiveness, be the most important in some cases [*Conde*

Nast Publications Inc v Union des editions modernes (1979), 46 CPR (2d) 183 (FCTD)], a preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique [*Masterpiece, supra*, at para 64].

[44] The Applicant submits that when assessing confusion, it is not proper to dissect trade-marks into their component parts, but that in this case, “a dissection and focus on one descriptive element is what is necessary to find the marks similar in appearance, sounds, and ideas suggested” (Applicant’s written argument at para 47). To this end, the Applicant submits that:

BELLA is most commonly recognized in English as being a female’s first name. It is also a common Spanish word, the meaning of which, *beautiful*, would be known by many English and French speaking Canadians, especially as it is very similar to the French word BELLE, which has the identical meaning. Because of its meaning, it is not surprising that the term would be adopted by many traders. It is therefore submitted that the common word “bella” cannot be afforded a broad scope of protection owing to its ordinary meaning” (Applicant’s written argument at para 51).

[45] As discussed above (see paragraph 27 of this decision), there is no evidence to support the allegation that BELLA would be commonly known by Canadians as a first name. Further, while it may be the case that BELLA is the Spanish word for “beautiful”, there is no evidence that the average Canadian consumer would know this. As there is no evidence that a substantial portion of the Canadian population understands Spanish, [*Krazy Glue, Inc v Grupo Cyanomex, SA de CV* (1992), 45 CPR (3d) 161 (FCTD)] and as such an allegation is not something easily provable or verifiable which I could take judicial notice of, I find that the average Canadian does not understand the Spanish word BELLA to mean “beautiful” [a similar approach was adopted in *Mondo Foods Co Ltd v Mondo Gelato (Denman) Inc*, 2008 CanLII 88226 (CA TMOB); *Vina San Pedro Tarapaca S.A. v Magnotta Winery Estates Limited*, 2015 TMOB 181 (CanLII)].

[46] Considering the above, I find that there are both similarities and differences between the parties’ trade-marks in appearance and sound and ideas suggested. With respect to the Opponent’s trade-mark, it begins with the distinctive element BELLA and ends with the descriptive element WOOD; I consider the prefix BELLA to be the striking element of the trade-mark. With respect to the Mark, it begins with the element BELLA and ends with the distinctive element CASA. I am of the view that both of these elements are striking.

[47] Accordingly, when the parties' trade-marks are viewed in their entirety, I find that the trade-marks have a considerable degree of resemblance in appearance and sound as they both share the distinctive word BELLA as the first component which is often considered to be the most important. Given the meaning of the word "wood", the resemblance between the marks in ideas suggested is somewhat less.

Additional surrounding circumstance – state of the marketplace

[48] While the Applicant has alluded to the adoption of the term BELLA "by many traders", as there is no evidence showing this, I am unable to conclude that there has been any common adoption of this word. Accordingly, I do not consider the state of the marketplace as a factor assisting the Applicant.

Additional surrounding circumstance – the manner in which the Opponent's mark has been used in the marketplace

[49] At the hearing, the Opponent submitted that the scripts of the parties' trade-marks, as used (notwithstanding that the Opponent's registration is not limited to a specific font or format), are similar, helping the average consumer looking at the parties' marks as a whole reach the conclusion that they are related. Notwithstanding the issues raised with respect to the use of the mark enuring to the Opponent, the Opponent's logo in connection with the BELLAWOOD trade-mark is shown below (Pescara affidavit, Exhibit A: Haskell affidavit, para 15). This logo appears on all of the packaging and promotional materials in the Opponent's evidence:



[50] While I agree that the BELLA portion of each party's trade-mark is presented in a handwriting font, the fonts are not identical nor are they in a very similar style – there are obvious and immediate differences between the handwriting styles in the curvature, boldness, and intricacy of the lettering. Moreover, the element WOOD in the Opponent's trade-mark is shown in standard block lettering. Accordingly, I am of the view that the script of the Opponent's logo is not so similar to the design elements of the applied for Mark such that there would be an impact on the likelihood of confusion.

[51] Accordingly, I do not consider this to be a surrounding circumstance of assistance to the Opponent.

Conclusion

[52] 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 trade-mark BELLACASA Design in association with the Goods at a time when he or she has no more than an imperfect recollection of the Opponent’s BELLAWOOD trade-mark and does not pause to give the matter any detailed consideration or scrutiny [*Veuve Clicquot, supra* at para 20].

[53] Having considered all of the surrounding circumstances, and in particular, the degree of resemblance between the marks and the similarity between the parties’ goods and channels of trade, I find that the balance of probabilities is evenly balanced between a finding of confusion between the Applicant’s trade-mark BELLACASA Design and the Opponent’s registered trade-mark BELLAWOOD, and a finding of no confusion.

[54] As the onus is on the Applicant to establish on a balance of probabilities that there is no reasonable likelihood of confusion with the BELLAWOOD trade-mark, I must decide against the Applicant. Accordingly, I find the ground of opposition based on section 12(1)(d) succeeds.

[55] I would add that had there been evidence that the average Canadian consumer would know that BELLA is the Spanish word for ‘beautiful’, or had the Applicant filed evidence of the state of the Register showing there was common adoption of the term BELLA by third parties for trade-marks associated with goods in the parties’ fields of interest, then I may well have reached a different conclusion favouring the Applicant.

Sections 16(2)(a) and 16(3)(a) grounds

[56] With respect to these grounds of opposition, there is an initial burden on the Opponent to evidence use of its BELLAWOOD trade-mark prior to the Applicant’s filing date and non-abandonment of its trade-mark as of the date of advertisement of the Applicant’s application [section 16(5) of the Act]. For the reasons discussed above in paragraphs 30-32, I find that the Opponent fails to meet its evidential burden. Accordingly, this ground of opposition is rejected.

Section 2 ground

[57] In order to meet its evidential burden, the Opponent must show that its BELLAWOOD trade-mark had become sufficiently known to negate the distinctiveness of the Mark [*Bojangles' International, LLC v Bojangles Café Ltd* 2006 FC 657 (CanLII) at paras 33-34]. For the reasons discussed above in paragraphs 30-32, I find that the Opponent fails to meet its evidential burden. Accordingly, this ground of opposition is rejected.

DISPOSITION

[58] 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.

Jennifer Galeano
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2018-08-02

APPEARANCES

Kenneth R. Clark

FOR THE OPPONENT

Grant W. Lynds

FOR THE APPLICANT

AGENT(S) OF RECORD

Aird & Berlis LLP

FOR THE OPPONENT

MARKS & CLERK

FOR THE APPLICANT