



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2019 TMOB 99

Date of Decision: 2019-09-19

IN THE MATTER OF AN OPPOSITION

Groupe Première Moisson Inc.

Opponent

and

Pumpernickel's Franchise Corporation

Applicant

1,735,131 for P Design

Application

[1] Groupe Première Moisson Inc. (the Opponent) opposes application no. 1,735,131 (the Application) for registration of the trademark P Design (the Mark) filed by Pumpernickel's Franchise Corporation (the Applicant). The Mark consists of the letter P sprouting a curvy shoot, all within a solid circle bordered by a ring of dots, as shown below:



[2] For the reasons that follow, the opposition is successful.

PRELIMINARY REMARKS

[3] Numerous amendments to the *Trademarks Act*, RSC 1985, c T-13, (the Act) came into force on June 17, 2019. In the context of opposition proceedings, the date that determines which version of the Act applies is the date on which the application being opposed was advertised in the *Trademarks Journal* for opposition purposes. In the present case, the Application was advertised prior to June 17, 2019. Consequently, pursuant to the transitional provisions in section 70 of the Act as amended, the grounds of opposition will be assessed in accordance with the Act as it read immediately before June 17, 2019, with the exception that, in assessing confusion, sections 6(2) to (4) of the Act as it currently reads will be applied.

[4] All other references to the Act in these reasons are to the Act as amended on June 17, 2019, unless otherwise indicated.

THE RECORD

[5] The Application was filed on June 30, 2015. It is based on use of the Mark in Canada since at least as early as November 2014 in association with the following services:

Restaurant services, fast food outlets, catering services, food take-out and delivery services; restaurant and fast food outlet franchising services; Online food ordering services; provision of a website containing information, blogs, and videos in the areas of food, food preparation and recipes (the Services).

[6] The Application was advertised in the *Trademarks Journal* on May 18, 2016 for the purposes of opposition.

[7] On October 17, 2016, the Opponent filed a statement of opposition. The grounds of opposition pleaded are based on sections 30(b) (compliance), 12(1)(d) (registrability), 16(1)(a) (entitlement), and 2 (distinctiveness) of the Act as it read immediately before June 17, 2019. Going forward, all references to these particular sections of the Act will be to the Act as it read immediately before June 17, 2019.

[8] The Applicant filed a counter statement on February 24, 2017, denying each of the grounds of opposition.

[9] The Opponent filed as its evidence the declaration of Josée Fiset, dated June 21, 2017. Ms. Fiset identifies herself as the Opponent's Co-founder and Vice-president, Retail Network ("*Co-Fondatrice et Vice-présidente, Réseau de détail*") since August 2014, having previously been its director of marketing for over twenty years.

[10] The Applicant filed two affidavits as its evidence. The first is that of Soly Ziv, dated October 3, 2017. Mr. Ziv identifies himself as the Founder, President, Secretary, Director and Manager of Franchising & Marketing, and a principal shareholder, of the Applicant. The second affidavit is that of Lynda Palmer, dated September 29, 2017. Ms. Palmer identifies herself as a trademark searcher and owner of Lynda Palmer Trade Mark Searching, a company that conducts searches of the trademark records of the Canadian Intellectual Property Office.

[11] None of the affiants was cross-examined.

[12] Both parties filed written arguments; an oral hearing was not held.

EVIDENTIARY BURDEN

[13] The legal onus is on the applicant to show that its application complies with the provisions 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. Once this initial burden is met, the applicant must satisfy the Registrar, on a balance of probabilities, that the grounds of opposition pleaded should not prevent the registration of the trademark at issue [*Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *Christian Dior SA v Dion Neckwear Ltd*, 2002 FCA 29, 20 CPR (4th) 155].

GROUND OF OPPOSITION SUMMARILY DISMISSED: COMPLIANCE WITH SECTION 30(B)

[14] Compliance with section 30(b) of the Act requires that a trademark be used continuously in the normal course of trade from the date of first use claimed in the application to the application's filing date [see *Benson & Hedges (Canada) Ltd v Labatt Brewing Co* (1996), 67 CPR (3d) 258 (FCTD); *Ivy Lea Shirt Co v Muskoka Fine Watercraft & Supply Co*, 2001 FCT 253, 11 CPR (4th) 489]. The Opponent pleads that the Application does not conform to the

requirements of section 30(b) in that the Applicant had not used the Mark in Canada in association with the Services since at least as early as November 2014, the date of first use claimed. However, there is no evidence in the record to support such an allegation. I also note that the Opponent has not addressed this ground of opposition in its written argument. Accordingly, the ground of opposition based on section 30(b) of the Act is dismissed, as the Opponent has failed to meet its evidential burden.

GROUND OF OPPOSITION BASED ON REGISTRABILITY UNDER SECTION 12(1)(D)

[15] The Opponent pleads that the Mark is not registrable under section 12(1)(d) of the Act, because it is confusing with the Opponent's registered trademark P Design, reproduced below (the Opponent's P Design):



[16] The Opponent's P Design consists of the letter P sprouting tendrils and a spike of wheat or similar cereal. It was registered on May 10, 2012 under no. TMA823,762 (the Opponent's Registration) for use in association with the goods and services set out in Schedule A to this decision. The goods comprise various food items, including bakery products, prepared meals, salads, sandwiches, delicatessen items, beverages, and confectionery, among others; housewares, namely general use bags, grocery bags, napkins and drinking glasses; and gift certificates and loyalty cards. The services comprise operational services for a store selling gourmet foods, delicatessen items, groceries, pastries, baked goods, prepared foods, preserves and confectionery; café bistro; and catering services.

[17] The registration claims that the Opponent has used this trademark in association with the goods "caramelized almonds, meats, and charcuterie" since at least as early as September 2010. A declaration of use was filed with respect to the remaining registered goods and services on April 23, 2012. A printout of the registration particulars from the Canadian Trademarks Database

maintained by the Registrar and available online has been furnished as Exhibit A to the Fiset declaration.

[18] The relevant date for the analysis of a section 12(1)(d) ground of opposition is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[19] The opponent's initial burden with respect to this ground is met if the registration relied upon is in good standing at the date the Registrar's decision. The Registrar has discretion to check the Register in this respect [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Having exercised that discretion, I confirm that the Opponent's Registration is extant; the Opponent has thus met its evidential burden. The onus is now on the Applicant to satisfy the Registrar, on a balance of probabilities, that the Mark is not likely to cause confusion with the Opponent's trademark.

The test for confusion

[20] The test for confusion is outlined in section 6(2) of the Act, which stipulates that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person.

[21] Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trademarks are set out in section 6(5) of the Act: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time the trademarks have been in use; (c) the nature of the goods, services, or business; (d) the nature of the trade; and the degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401; *Mattel USA Inc v 3894207 Canada Inc*, 2006 SCC 22, 49 CPR (4th) 321; *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361].

[22] The test for confusion is described in the following terms by Justice Binnie in *Veuve Clicquot, supra*, at paragraph 20:

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 [applicant's mark], at a time when he or she has no more than an imperfect recollection of the [opponent's] trademarks, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

[23] This test does not concern confusion of the marks themselves, but rather confusion as to whether the goods and services associated with each of the trademarks come from the same source.

Degree of resemblance between the trademarks

[24] As indicated by the Supreme Court of Canada in *Masterpiece, supra*, in most instances, the degree of resemblance between the trademarks at issue is the most important factor in assessing the likelihood of confusion. One must consider the degree of resemblance between the trademarks from the perspectives of appearance, sound, and ideas suggested. The preferable approach is to begin by determining whether there is an aspect of each trademark that is “particularly striking or unique” [*Masterpiece, supra*, at paragraph 64]. However, it is not the proper approach to set the trademarks side by side and carefully examine them to find similarities and differences; each trademark must be considered as a whole [see *Veuve Clicquot, supra*].

[25] As noted by Mr. Justice Denault in *Pernod Ricard v Molson Breweries* (1992), 44 CPR (3d) 359 (FCTD) at para 34:

The trade marks should be examined from the point of view of the average consumer having a general and not a precise recollection of the earlier mark. Consequently, the marks should not be dissected or subjected to a microscopic analysis with a view to assessing their similarities and differences. Rather, they should be looked at in their totality and assessed for their effect on the average consumer as a whole [citations omitted].

[26] In his affidavit, Mr. Ziv makes some comments on the degree of resemblance between the trademarks at issue. However, Mr. Ziv has not established himself as an expert in Canadian

trademark law. I will therefore disregard the opinions he expresses on the degree of resemblance between the marks.

[27] The Opponent submits that the dominant element of both trademarks in this case is the letter P; that the designs of the two trademarks are very similar; and that, as a matter of first impression, neither trademark suggests any particular idea other than a letter of the alphabet. The Opponent further submits that the marks at issue are the most similar of all the trademarks featuring the letter P located in Ms. Palmer's search of the Register, as set out in her affidavit, discussed below.

[28] The Applicant submits that the differences between the trademarks in this case are clearly apparent and serve to distinguish the trademarks from each other. The Applicant submits that these differences include the typefaces, only one of which has serifs; the embellishments, being a sprouting chick pea emanating from the middle left of the letter in the Applicant's mark as opposed to a wheat motif emanating from the lower right of the letter in the Opponent's trademark; and the backgrounds, being a solid circle in a ring of dots in the Applicant's mark and being empty in the Opponent's trademark. The Applicant further submits that the letter P in its mark is representative of its name and "primary mark" PUMPERNICKEL'S, whereas the Opponent's P Design represents the word PREMIÈRE from the Opponent's name and "primary mark" PREMIÈRE MOISSON.

[29] I would first note that it is the Mark itself that must be considered when assessing resemblance, not the combination of the Mark and any additional matter with which it may be used. Accordingly, the fact that the Mark may be recognized as the initial letter of the Applicant's name or "primary mark" when the Mark is displayed next to the word PUMPERNICKEL'S does not assist the Applicant's case. Furthermore, there is no evidence that the Mark is so well known and so strongly associated with the Applicant's brand that the Mark on its own has acquired a secondary meaning as an abbreviation for PUMPERNICKEL'S. Likewise, the Opponent's P Design is to be considered on its own, and there is no evidence to suggest that the ordinary Canadian consumer would understand it to mean PREMIÈRE or recognize it as a reference to PREMIÈRE MOISSON.

[30] I note that, in *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD), where the two trademarks at issue were derived from the initial letters of their owners' names, it was held that "the natural inclination of an observer is to relate the letters back to the source of their derivation and think in terms of the corporate names, which are substantially different, and of which the letters are in reality abbreviations" [at para 67]. However, in that case, the letters of the opponent's trademark were interspersed with periods and the letters of the applicant's trademark were enclosed by a line featuring "two indentations protruding to the space between the letters..., which are suggestive of periods" [*ibid.*]. The present case is distinguishable, in that each of the trademarks at issue contains a single letter, without any period or similar indication that the letter might be an abbreviation.

[31] In my view, both trademarks at issue in the present case convey, as a matter of first impression, the idea of the letter P sprouting short, curving shoots, and it is this combination that is the most striking feature of both trademarks, visually and conceptually.

[32] I do not consider the background circle with a dotted outline in the Applicant's Mark to be a particularly striking or unique feature. Its effect is to draw attention to the embellished P and make the letter appear off-centre, which does lend some visual interest. However, it remains a background element and, in my view, its framing effect falls short of being striking or unique.

[33] Furthermore, the Applicant has not convinced me that the differences in the fonts for the letter P or in the positioning and stylization of the plant motifs result in significant differences in appearance between the two trademarks. Rather, I am of the view that there is a fair degree of resemblance between the designs in general appearance. In identifying subtle differences, the Applicant has performed a side-by-side analysis, in an attempt to distinguish the marks by focusing on their details. However, as noted above, this type of dissection and careful analysis is not the correct approach. Rather, the trademarks must be considered on the basis of imprecise recollection. In my view, the visual differences between the marks at issue in the present case would not suffice to eliminate a likelihood of confusion on the part of an average consumer having only a general recollection of the Opponent's trademark.

[34] When sounded, both trademarks are identical, as the only verbal element in each is the letter P. In this respect, I note again that neither mark includes either the English word

PUMPERNICKEL'S or the French words PREMIÈRE MOISSON. Accordingly, there is nothing to suggest that either an English pronunciation or a French pronunciation is more likely for either trademark.

[35] Finally, the idea suggested by each trademark is basically the same: the letter P sprouting curvy shoots.

[36] In his affidavit, Mr. Ziv explains that the Mark was adopted to depict “a sprouting chick pea”, chickpeas being a main ingredient of the hummus spread used and sold by the Applicant and, as a vegetarian product, conveying a healthy lifestyle image [at para 12]. However, there is no evidence that an average consumer would identify the plant motif in the Mark as a chickpea. Nor is there any evidence that an average consumer would necessarily turn his or her mind to the precise nature of the cereal in the Opponent's plant motif.

[37] In summary, the differences between the two trademarks at issue are in the details. On balance, I do not consider any of these differences—alone or in combination—to be so significant as to stand out in the mind of an average consumer having only a general recollection of the earlier trademark.

[38] Given the degree of resemblance between the parties' trademarks in appearance, in sound and in the ideas suggested by them, this factor favours the Opponent.

Inherent distinctiveness of the trademarks

[39] Trademarks lacking in distinctiveness are only entitled to a narrow ambit of protection, in the sense that a greater degree of discrimination may fairly be expected from the public and relatively small differences between the trademarks may suffice to avert confusion [see *Prince Edward Island Mutual Insurance v Insurance Co of Prince Edward Island* (1999), 86 CPR (3d) 342 (FCTD); and *GSW, supra*].

[40] Trademarks consisting primarily of one or more letters of the alphabet are generally considered to possess a low degree of inherent distinctiveness [see *GSW, supra*]. It has also been held that a single trader should not be entitled to obtain exclusive property rights over a letter or combination of letters that happen to be its initials, to the detriment of other traders who may

have the same initials [*Afred Grass v Grand Industries* (1991), 47 FTR 231]. Accordingly, letter marks generally owe what inherent distinctiveness they have to their other elements, namely their design features. Indeed, in the case of single letter marks, differences in the design features may suffice to distinguish one mark from the other [see, for example, *Cerruti 1881 SA v Conte of Florence SPA* (1990), 34 CPR (3d) 452 (TMOB)].

[41] The Applicant submits that the Mark, containing more and different design elements, particularly the added background elements of the solid circle behind the letter P and the ring of dots surrounding the circle, is clearly the more distinctive of the two trademarks at issue.

[42] However, in my view, the design features in each trademark are essentially embellishments of the letter P.

[43] In this respect, generally, design features such as fanciful scripts or other embellishments that are intrinsic to the letters in a trademark, and cannot be dissociated from the letters themselves, add little to the inherent distinctiveness of a trademark [see *Canadian Jewish Review Ltd v The Registrar of Trade-marks* (1961), 37 CPR 89 (Ex Ct); and *John Labatt Ltd v Canada (Registrar of Trade Marks)* (1984), 79 CPR (2d) 110 (FCTD)]. In the present case, although I would not characterize the plant motifs as being *intrinsic* to the letters, the plant motifs are at least quite closely associated to their respective letters.

[44] Moreover, these design features could well create an association with the parties' food-related goods and services, by suggesting vegetarian ingredients, particularly in the nature of sprouts or cereal grains.

[45] It has often been held that, when the dominant portion of a trademark is a common descriptive or suggestive word, its importance diminishes [see *Park Avenue, supra*, and *Vancouver Sushiman Ltd v Sushiboy Foods Co* (2002), 22 CPR (4th) 107 (TMOB)]. In this respect, it is well established that descriptive marks are not inherently distinctive [see *Prince Edward Island Mutual Insurance v Insurance Co of Prince Edward Island* (1999), 86 CPR (3d) 342 (FCTD)]. Similarly, design elements that are suggestive of an aspect of the trademark owner's goods or services might not add significantly to the trademark's distinctiveness [see, for example, *CanWest Global Communications Corp v TV Globo Ltda*, 2007 CarswellNat 1061

(TMOB)]. Thus, in the present case, there may be a tendency for consumers to discount the importance of the plant motifs, to the extent that they suggest an aspect of the parties' goods and services.

[46] Even so, to the extent that the plant motif in the Opponent's trademark is more elaborate than the simpler curves of the Applicant's design, I consider the Opponent's plant feature to be the more inherently distinctive of the two motifs.

[47] The Mark also includes an additional design element: the background circle with a dotted outline. However, I do not consider a backdrop consisting of such a simple geometric shape to be a particularly distinctive feature. The fact that it has a dotted outline does not add significantly to its distinctiveness. In my view, the effect of this background element is primarily to frame the embellished P. Indeed, as discussed below, the Ziv affidavit shows that the Mark is at least occasionally displayed without this background, which tends to support the conclusion that this element is not an essential feature of the Mark.

[48] Accordingly, although each trademark's design features give it some inherent distinctiveness, overall, neither trademark has a high degree of inherent distinctiveness. Moreover, when each trademark is considered as a whole, I do not find one trademark to be more inherently distinctive than the other.

Extent to which the trademarks have become known

[49] The degree of distinctiveness of a trademark can be enhanced through use and promotion in Canada [see *Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD); *GSW*, *supra*]. Both parties filed evidence in this respect.

Applicant's evidence of use and promotion

[50] The Applicant's evidence with respect to use and promotion of the Mark in Canada consists of the affidavit of Soly Ziv, the Founder, President, Secretary, Director and Manager of Franchising & Marketing of the Applicant.

[51] In his affidavit, Mr. Ziv states that the Applicant, in association with its predecessor-in-title Pumpernickel's European Style Sandwiches Ltd. and its franchisees and licensees (collectively the Applicant Companies), has been operating fast food restaurant outlets and providing catering, food delivery and take-out services, in association with the name and trademark PUMPERNICKEL'S, since at least as early as May 1986. He explains that PUMPERNICKEL'S restaurants are predominantly quick service restaurants that also offer catering specializing in deli-style foods, including but not limited to cold and hot sandwiches and meals, salads, soups, breakfast food items, soft drinks and deserts. According to Mr. Ziv, at the date of his affidavit, there were 12 PUMPERNICKEL'S restaurants in Canada, all located in and around the greater Toronto area, ten having opened between 1986 and 2013 and two having opened in 2016; in addition, a thirteenth restaurant had operated in Toronto from "about 2000" to December 2013. Mr. Ziv notes in particular that the daily customer traffic at the First Canadian Place food court restaurant location—opened in 1986—is "very substantial", with "tens of thousands of people working at, or visiting the building, on a daily basis" [at para 33].

[52] As Exhibits 16 and 17 to his affidavit, Mr. Ziv attaches representative photographs of interior, exterior and menu board signage from PUMPERNICKEL'S restaurants. Mr. Ziv attests that these examples are representative of the manner in which the Mark has been used since at least November 2014. Indeed, the Mark is prominently displayed on such signage. In many of the photographs, the word PUMPERNICKEL'S is displayed next to the Mark, within the Mark's background circle, or elsewhere on the same sign or on a different sign in the same field of view. In these cases, the word PUMPERNICKEL'S is often stylized: the initial P features the same plant shoot as the Mark (but not the circular background) and the apostrophe is in the form of a sprouting chickpea. I also note that in one instance—on the exterior corner wall of the TD Centre restaurant location—the Mark is displayed on its own *without* the background circle (Exhibit 17).

[53] As Exhibit 18 to his affidavit, Mr. Ziv attaches a copy of the 2016 edition of the Pumpernickel's catering brochure, representative of the manner in which the Mark has been used since at least November 2014. He attests that the brochure is available for download on the Pumpernickel's website and for pickup as a hard copy catalogue at restaurant locations. He adds that such hard copies are generally also mailed out when the brochure is updated or when a new location opens, and sent upon request with catering deliveries. He states that "[m]any thousands"

of these catalogues have been mailed to potential customers or picked up by customers at the restaurants since November 2014 and that thousands of customers have ordered catered products by viewing the downloadable brochure. The Mark is prominently displayed next to the stylized word PUMPERNICKEL'S above the table of contents and again by itself next to the ordering information on the last page. Some of the images in the brochure also show the Mark on items similar to those featured in other exhibits (discussed below), including on signage, as well as on sandwich wrappers, and a delivery truck.

[54] As Exhibit 19 to his affidavit, Mr. Ziv attaches screen captures of representative pages of the Applicant's website at *www.pumpernickels.ca*, used to advertise the Applicant's products, fast food restaurant services, and catering services, as well as franchising opportunities. I note that the photographs of restaurant signage at Exhibit 16 were also printed from this site. Mr. Ziv states that, since at least as early as November 2014, the Mark has been displayed on the top banner of each webpage, and occasionally elsewhere on such pages, and that the furnished examples are representative of the manner in which the Mark has been used since at least November 2014. Indeed, Exhibit 19 shows both the Mark and the stylized word PUMPERNICKEL'S prominently displayed on the top banner of the webpages. The variation of the Mark that includes the word PUMPERNICKEL'S within the circle is displayed in the page footer. I note, however, that on the printout at Exhibit 16, this variation of the Mark appears in the footer *without* the circular background.

[55] Mr. Ziv states that, since the Mark's adoption in November 2014, it has also been used by the Applicant Companies in various other marketing and promotional materials. In support, he attaches photographs or copies of the following items to his affidavit, and attests that these specimens are representative of the manner in which the Mark has been used since at least November 2014:

- take-out and delivery bags (Exhibits 4 to 6);
- a cocktail napkin of the type provided with catered food orders (Exhibit 7);
- a catering delivery box (Exhibit 8);
- food sleeves and wrappers used at restaurant locations (Exhibits 9 to 11);
- a paper coffee cup of the type used at restaurants and provided with catered food orders (Exhibit 10);

- staff shirts (Exhibits 12 to 13);
- a partially redacted invoice for a catered food order (Exhibit 14); and
- a catering delivery truck, which Mr. Ziv attests is one of six such vehicles in operation (Exhibit 15).

[56] The Mark is prominently displayed on each of the foregoing items, typically next to the stylized word PUMPERNICKEL'S. Exceptions include the button-down shirt at Exhibit 12, where PUMPERNICKEL'S is displayed within the Mark's background circle; the short-sleeved shirt at Exhibit 13, where the Mark is displayed by itself on the sleeve (it is not clear whether PUMPERNICKEL'S might be displayed elsewhere on the shirt); and, notably, the delivery bag depicted at Exhibit 6, where the Mark is displayed by itself *without* the background circle.

[57] I also note the Mark displayed on the following items depicted in images on the Applicant's website (Exhibit 19):

- restaurant signage, including the TD Centre signage that displays the Mark without its background circle;
- sandwich wrappers;
- a gift card;
- a large cheque presented as part of a 2015 charity campaign; and
- video thumbnails.

[58] Finally, Mr. Ziv provides figures for the Applicant's sales and expenditures on advertising and branding. According to these figures, the Applicant's annual expenditures for advertising and branding have grown from over \$150,000 to over \$300,000 from 2012 to 2016 and its annual sales have grown from over \$10 million to over \$15 million over the same period.

Opponent's evidence of use and promotion

[59] The evidence with respect to use and promotion of the Opponent's P Design in Canada consists of the declaration of Josée Fiset, a co-founder of the Opponent and the vice-president responsible for managing its retail network.

[60] Ms. Fiset asserts use of the Opponent's P Design in association with the registered services—set out at Schedule A below—since at least as early as October 30, 2010. She also confirms use of the Opponent's P Design in association with the goods caramelized almonds, meats and charcuterie since at least as early as September 2010 (albeit without any further evidence in support) and confirms use in Canada in association with all of the remaining registered goods, for which a declaration of use was filed on April 23, 2012.

[61] More particularly, Ms. Fiset states that, at the date of her declaration, the Opponent, itself or through franchisees and licensees, operated 26 shops selling baked goods, pastries, Viennese pastries, charcuterie, prepared foods, delicatessen items, chocolates, preserves and confectionary. She refers to these shops collectively as "*Boulangeries*" (Bakeries). She specifies that 24 of the Bakeries are located in the Montreal area, while one is in Quebec City and one is in Ottawa. She further states that several of the Bakeries offer a sit-down "Café bistro" section and that several of them have offered a catering service since well before ("*bien avant*") November 2014.

[62] To demonstrate the manner in which the Opponent's P Design is used in association with these services, Ms. Fiset provides, as exhibits to her declaration, photographs of Bakery storefronts and interior signage; photographs of Bakery goods and branded amenities; and examples of promotional publications, including printouts from the Opponent's website at www.premieremoisson.com. The Opponent's P Design appears throughout the exhibited materials, often above or next to the words PREMIÈRE MOISSON.

[63] I note in particular Exhibit C, which contains photographs of four Bakeries' storefronts. According to Ms. Fiset, each of these locations began displaying the Opponent's P Design at some point between January 14, 2013 (Kirkland location) and April 2014 (Masson street location). Each storefront displays the Opponent's P Design. In at least two of the locations, the words PREMIÈRE MOISSON are displayed next to the Opponent's P Design or on nearby signage.

[64] The Opponent's P Design is displayed on its own in the following areas depicted in the exhibits:

- on the wall immediately behind an amenities station at the Quebec City Bakery location (Exhibit G);
- on a wall displaying promotional text above faucet-like fixtures at the Masson street Bakery (Exhibit H);
- on reusable shopping bags (Exhibit I);
- on dessert topper medallions, including ones shown on the Opponent's website (Exhibits I and K-L); and
- on a cake ribbon, although the words PREMIÈRE MOISSON are also displayed on the same ribbon (shown on a webpage at Exhibit K).

[65] The Opponent's P Design is displayed above the words PREMIÈRE MOISSON on the following items depicted in the exhibits:

- a postcard with two coupons, which Ms. Fiset states was sent to print in October 2010 and subsequently mailed out to promote the Opponent's Bakeries and products (Exhibit D);
- the cover page of a Christmas brochure, which Ms. Fiset states was mailed out in November 2010 to promote the Opponent's Bakeries and products (Exhibit E);
- a paper napkin; Ms. Fiset states that over 25 million such napkins have been provided to clients in Bakeries since 2011 (Exhibit F);
- signs for recycling, compost and waste bins at the aforementioned amenities station (Exhibit G);
- various product labels, packages, cards and signs; on some of these the Opponent's P Design is followed by the number 25 and two words that cannot be made out from the photographs (Exhibit I);
- outdoor and indoor signs shown on the Opponent's website (Exhibit J);
- jar labels for jams and spreads shown on the Opponent's website (Exhibit K); and
- a gift card shown on the Opponent's website (Exhibit K).

[66] I also note the Mark's display on an employee's shirt depicted in one of the images from the website (Exhibit J); the wording below the Mark cannot be made out in the blurred image, but it appears to be consistent with other occurrences of the words PREMIÈRE MOISSON.

[67] On some of the printouts from the website, a symbol consisting of a question mark in a box appears in the webpage header and other locations. Ms. Fiset attests that, on-screen, this symbol is replaced by the Opponent's P Design followed by the words PREMIÈRE MOISSON.

[68] Finally, I note that some of the items depicted in the exhibits are adorned with a repeating pattern of the Opponent's P Design and a variation thereof. The variation consists of two Opponent's P Designs joined by additional tendrils and wheat spikes. These items include the following:

- bread bags (Exhibit I);
- tape sealing a small plastic container (Exhibit I); and
- dessert topper shards shown on the Opponent's website (Exhibits K and L).

[69] Ms. Fiset states that the various photographs at Exhibit I are representative of the manner in which the Opponent's goods have been marketed in its Bakeries since well before ("*bien avant*") November 2014. She also states that the goods depicted on the website's product pages (Exhibit K) were advertised on the site since at least January 2011 and that the goods depicted on the website's catering pages (Exhibit L) were advertised on the site since well before ("*bien avant*") November 2014. However, it is not clear from her statements whether the website and the goods depicted thereon were *branded with the Opponent's P Design*—in the same manner or otherwise—since those dates.

[70] Google analytics reports showing traffic to the site from January 1, 2012 to December 31, 2016 are attached as Exhibit M to Ms. Fiset's affidavit. These reports indicate that the website received over 200,000 visitors and approximately 2 million page views per year over the course of this period, totalling over a million visitors and over 10 million page views for the entire period.

[71] Finally, Ms. Fiset states that, since fiscal 2011–2012, the Opponent has spent over \$800,000 annually on the promotion of its Bakeries and the goods sold therein, with annual sales in its Bakeries exceeding \$45 million.

Conclusion with respect to the extent to which the trademarks have become known

[72] Neither party specifies which portions of its annual advertising expenditures and sales may be attributed specifically to the trademarks at issue, as opposed to the PUMPERNICKEL’S or PREMIÈRE MOISSON brands in general. It may be that the parties’ advertising efforts and sales have generated more awareness of the PUMPERNICKEL’S and PREMIÈRE MOISSON brands than of the trademarks at issue. Thus a question is raised as to whether the distinctiveness of the trademarks at issue can be isolated from the reputations of the combinations.

[73] Nevertheless, it appears from the evidence as a whole that much of the Applicant’s branding includes the Mark, and Mr. Ziv attests that such evidence is representative of the Mark’s use since at least November 2014. Similarly, it would appear that, by 2014, much of the Opponent’s branding included the Opponent’s P Design.

[74] It is not clear to what extent the Opponent’s P Design was being used earlier and, in particular, prior the Applicant’s date of first use. With respect to “Café bistro” and catering services, Ms. Fiset provides only the vague assertions that they were offered since “*bien avant*” (well before) November 2014. Similarly, with respect to the goods depicted in the photographs at Exhibit I and the catering webpages at Exhibit L, Ms. Fiset asserts only that they were marketed or advertised since “*bien avant*” (well before) November 2014.

[75] However, some of Ms. Fiset’s evidence is more precise. Her evidence with respect to display of the Mark on Bakery storefronts is that it began on January 14, 2013 with one Bakery location, and three others following suit by April 2014. She also furnished evidence showing the Opponent’s P Design displayed above the words PREMIÈRE MOISSON on a coupon postcard sent to print in October 2010 and subsequently mailed out; a Christmas brochure mailed out in November 2010; and paper napkins available in Bakeries since 2011. Her evidence with respect to the goods depicted on the Opponent’s website’s product pages (Exhibit K) is that such goods were advertised on the site since at least January 2011; however, as noted above, it is not clear

whether the furnished printouts are representative of how the Opponent's P Design was displayed on the site since that time. For example, Ms. Fiset does not specify when the Opponent's P Design was first displayed on the page headers or when it was first displayed on the types of get-up depicted on the site, such as jar labels, dessert toppers and cake ribbons, or on gift cards.

[76] Nonetheless, in general, the evidence described above, and in particular the sales and advertising figures, favour the Opponent. On the basis of this evidence, I conclude that the Mark has become known to some extent—specifically, in the Toronto area—but that the Opponent's P Design has become known to a greater extent—primarily in the Montreal area. Since it appears from the evidence that the Opponent's P Design has become known to a greater extent than the Mark, this factor favours the Opponent.

Length of time the trademarks have been in use

[77] As it appears from the evidence described above, the Applicant has used the Mark in association with the Services since at least as early November 2014, whereas use of the Opponent's P Design in association with operational services for its Bakery stores goes back to at least as early as October 2010. Furthermore, although Ms. Fiset only attests to use of the Opponent's P Design in association with café bistro and catering services since "*bien avant*" (well before) November 2014, the Opponent's declaration of use filed on April 23, 2012 allows me to infer at least *de minimis* use of the Opponent's P Design in association with such services since that date [see *Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB) with respect to the inferences that can be made from a registration on its face].

[78] Likewise, the Opponent's Registration allows me to infer at least *de minimis* use of the Opponent's P Design in association with caramelized almonds, meats and charcuterie since at least as early as September 2010, and in association with all of the remaining registered goods since April 23, 2012.

[79] Accordingly, this factor also favours the Opponent.

Nature of the parties' goods, services and trades

[80] When considering the nature of the goods and services and the nature of the parties' trades under section 12(1)(d) of the Act, it is the statement of goods and services as defined in the applicant's application and the statement of goods and services in the opponent's registration that must be assessed, having regard to the channels of trade that would normally be associated with such goods and services[see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); and *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export* (1986), 12 CPR (3d) 110 (FCA)]. The 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; evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA)].

[81] From a plain reading of the statements of services in the Application and the Opponent's Registration, it appears that the nature of the parties' services and trades is largely the same. Indeed, the evidence shows that both parties operate and franchise quick-service and catering establishments with a similar focus on natural and artisanal foods.

[82] Services advertised on the Opponent's webpages furnished as Exhibits J to L include the creation, preparation and sale of bakery goods, pastries, Viennese pastries, delicatessen meats, prepared foods, and gourmet specialties, as well as catering services. The website also provides recipes from the Opponent's chefs. One of the images at Exhibit J shows a storefront with tables and seating, although I note that the signage in this particular image does not feature the Opponent's P Design.

[83] These services overlap with the restaurant, catering, food take-out and delivery services listed in the Application and promoted on the Applicant's website. There is also overlap with the service of providing a website containing videos in the area of food preparation and recipes, as listed in the Application. In this respect, I note that some of the video thumbnails on the Applicant's website have captions that reference sandwich making, which suggests that such videos illustrate recipes for making sandwiches.

[84] The evidence shows that there is also significant overlap between the products sold in the Applicant's "fast food outlet restaurants" and the products sold in the Opponent's "Bakeries".

[85] In this respect, Mr. Ziv attests that the Applicant's restaurants specialize in deli-style foods, including but not limited to cold and hot sandwiches and meals, salads, soups, breakfast food items, soft drinks and deserts. The brochure and webpages attached as Exhibits 18 and 19 to his affidavit show that the food items offered by the Applicant include breakfast fare; various fruit, vegetable, bread, and delicatessen platters; sandwiches and wraps; salads; meat and pasta entrées; side dishes; hors d'oeuvres; sweets and desserts; and beverages.

[86] The goods covered by the Opponent's Registration include breakfast items in the nature of mixes for pancakes and waffles; pastries; breads; jams; canned and dried fruits and vegetables; coffees and fruit juices; delicatessen items; sandwiches; salads; prepared meals; pasta and pasta sauces; flavoured or seasoned rice; appetizers; confectionery; and various beverages; among other goods. Furthermore, the promotional materials, in-store photographs and webpages attached as Exhibits D to E and I to L of the Fiset declaration show that the food items actually offered by the Opponent include pastries; breads; jams and spreads; coffee; products that appear to be cheeses; deli meats; fruit, vegetable, cheese, and deli platters; sandwiches and canapés; salads; sauces and soup in jars; prepared foods (quiche, meat pies, pasta salads, mini-pizzas); finger foods; side-dishes; cookies, muffins, cakes and pies; and sweets in the nature of marshmallows.

[87] Overall, there is considerable overlap in the parties' services—as well as their goods—and in their channels of trade.

[88] I note that the Applicant's services are currently offered only in Ontario—in the Toronto area—whereas the Opponent's services are offered primarily in the province of Quebec, with the exception of a single Bakery in Ottawa, Ontario. However, nothing prevents the parties from operating their respective establishments in the same provinces and even in the same localities.

[89] Therefore, these factors also favour the Opponent.

Additional surrounding circumstances

[90] In its written argument, the Applicant raises several additional surrounding circumstances, as follows.

State of the register and state of the marketplace

[91] The Applicant submits that a trader who uses a trademark that incorporates an element that is common to the trade cannot expect to receive a broad ambit of protection for that trademark.

[92] Indeed, the common occurrence of a certain element tends to cause purchasers to pay more attention to the other features of the such trademarks and to distinguish between them by those other features [see *Polo Ralph Lauren Corp v United States Polo Assn* (2000), 9 CPR (4th) 51 (FCA); *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

[93] The affidavit of Ms. Palmer introduces into evidence, by way of exhibit materials, the results of a search of the Canadian trademarks register that she conducted on August 30, 2017. The search was for trademark entries that include the letter P—either alone or in combination with a word where the P is prominent—for food products; for services of restaurants, cafes, bistros, bakeries, charcuteries, fast food outlets, grocery or convenience stores and the like; and as Prohibited Marks under section 9 of the Act (as it read immediately before June 17, 2019). The search revealed 116 such trademark entries.

[94] Mr. Ziv comments on these search results in his affidavit. He states his belief, “in view of the many P design marks which have been used and are either the subject of pending applications, or have been registered, in Canada, all in association with good [*sic*] and/or services in the food services industry, that consumers are used to distinguishing one such mark from the other” [at para 37]. Mr. Ziv also claims to be aware that it is “extremely common” for entities, including those in the food service industry, to use a letter or letters as trademarks to identify their respective goods and services, particularly when that letter represents the first letter in the brand name or trademark [at para 33]. He claims that it is therefore “natural” for the Applicant to

adopt a P design as a trademark, to represent and complement the PUMPERNICKEL'S brand [*ibid.*].

[95] However, what inferences may be drawn regarding consumer perception and likelihood of confusion from state-of-the-register evidence is an issue for the Registrar to decide. Mr. Ziv has not established himself as an expert in Canadian trademark law and, accordingly, I am not prepared to give any weight to his opinions in this respect.

[96] In its written argument, the Applicant identifies a number of examples in the search results where the letter P represents the first letter of a brand name or trademark, whether used alone or in association with that brand name or mark. However, as discussed above, it is the Mark itself that must be considered when assessing the likelihood of confusion, not the Mark in combination with additional matter with which it may or may not be used. Although there may be cases where a trademark has acquired distinctiveness as an acronym for a trade name, brand name, or trademark, as noted above I am not satisfied that the Applicant's evidence establishes such a secondary meaning for the Mark in the present case. The evidence with respect to registrations for trademarks consisting of the letter P in combination with a word that starts with a P is therefore irrelevant.

[97] The Applicant also identifies 15 registrations and 4 pending applications by third parties for trademarks that it characterizes as consisting solely of a stylized P design, for use in association with food products or services relating to the sale of food products. The Applicant submits that these search results clearly establish that P design trademarks are very common on the register in association with such goods and services.

[98] However, of these particular trademarks, only nine feature the single letter P in a relatively simple font. Eight of the remaining trademarks are highly stylized—some to the point where the letter P is barely recognizable. The remaining two trademarks incorporate additional letter or word elements: the words “we deliver” in the case of Panago Pizza Inc.'s P We Deliver & Arrow Design and the letter L in the case of Lovepizza Inc.'s L P & Design.

[99] Furthermore, only three of the nine designs combine the letter P with a plant motif:



Registration No. TMA356,414



Registration No. TMA413,328



Application No. 1,564,478

[100] However, none of these designs combines the letter P in a standard font with a shoot or tendril. The design of registration no. TMA356,414 features the letter P in a standard font, but the plant motif consists of a flower shape in the eye of the P. The designs of registration no. TMA413,328 and application no. 1,564,478 consist of curving shoots or vines, but they do not embellish a separate letter of the alphabet. Moreover, although these two designs have the general shape of the letter P, they do not, in my view, convey immediately the impression of being a letter of the alphabet.

[101] In any event, in three recent decisions [see *McDowell v Laverana GmbH & Co KG*, 2017 FC 327, 154 CPR (4th) 128, *McDowell v The Body Shop International PLC*, 2017 FC 581, 148 CPR (4th) 195, and *Canada Bread Company, Limited v Dr. Smood APS*, 2019 FC 306, 2019 CarswellNat 694], the Federal Court ruled that, unless a large number of trademarks is identified in the state of the register evidence, use of the trademarks cited must be established. Where a large number of relevant trademarks is identified, the Registrar can infer that the element they all have in common is used in the marketplace, such that consumers are able to distinguish these marks by their additional features. Where the number of trademarks identified is not large, evidence of such use needs to be furnished.

[102] In the present case, the only evidence of use of the trademarks identified by the Applicant is in the affidavit of Mr. Ziv, who attests to being personally familiar with two of the registered trademarks, which he states have been used to promote restaurant and fast food outlet goods and services in Canada for many years. One of these trademarks features the letter P in a sans serif font in an oval design and the other features the letter P in a serif font against the backdrop of the planet Earth:



Registration No. TMA540,756



Registration No. TMA742,570

[103] I am not prepared to make any inferences regarding the state of the marketplace on the basis of the entries identified by the Applicant and the statement by Mr. Ziv. His evidence does not establish the extent to which these two trademarks have been used by their respective owners in promoting the restaurant and fast food outlets in question or the extent to which Canadians may have visited such outlets or otherwise been exposed to those trademarks. Thus his evidence provides an insufficient basis from which to draw conclusions about public perception in Canada.

[104] Given the low number of relevant citations and the absence of probative evidence of use of any of the cited marks, I cannot draw any inferences on the state of the marketplace. Therefore, I cannot infer that Canadian consumers are accustomed to seeing numerous trademarks consisting solely of an embellished letter P in the parties' field of interest, whether or not the embellishment consists of a plant motif.

[105] Accordingly, this factor is not a significant surrounding circumstance in the present case.

No instances of actual confusion

[106] The Applicant argues that the parties' trademarks have co-existed for a period of almost three years without any evidence of instances of confusion.

[107] The Applicant underscores that, over the course of this period of coexistence, both parties were operating multiple retail outlets in the food service industry, making substantial sales in the order of "many millions of dollars per year", and expending hundreds of thousands of dollars per year in advertising.

[108] I would first note that an opponent is under no obligation to submit evidence of instances of actual confusion. The burden is on an applicant to demonstrate the absence of a likelihood of confusion. That said, the Supreme Court of Canada held in *Mattel, Inc v 3894207 Canada Inc*

(2006), 49 CPR (4th) 321, that an adverse inference may nevertheless be drawn from a lack of evidence of actual confusion, where such evidence would readily be available if the allegation of likely confusion were justified. Thus, although not a determining factor, if the evidence shows extensive concurrent use of both trademarks in the same area over many years, a lack of evidence of actual confusion *may* support a conclusion that confusion is not likely.

[109] In the present case, in his affidavit, Mr. Ziv states that he is unaware of any instances of actual confusion between the Mark and the Opponent's P Design having been "reported" in the almost three years since the Applicant's adoption of the Mark.

[110] However, he does not explain to whom such a "report" would be made, or how in his position as President, Secretary, Director and Manager of Franchising & Marketing, he would be made aware of any such instances of confusion.

[111] Moreover, as discussed above, the evidence is that the Mark has only been used in the Toronto area, whereas use of the Opponent's P Design in Ontario has been limited to a single Ottawa location. The remaining use of the Opponent's P Design has been in the Montreal area and Quebec City. Therefore, the absence of instances of actual confusion might well be explained by the fact that the parties have been using their respective trademarks in different regions of Canada.

[112] Consequently, I do not consider the absence of evidence of actual confusion to be a relevant factor in the present case.

Opponent's P Design not cited during examination

[113] The Applicant notes that the Registrar did not cite the Opponent's P Design as a confusingly similar trademark—and thus an obstacle to registration—during examination of the Application. The Applicant essentially submits that, by not raising the issue of confusion at the examination stage, the Registrar made it apparent that she did not consider the Mark likely to be confusing with the Opponent's P Design.

[114] However, it has often been said that this Board is not in a position to explain examiners' findings. Examiners do not have before them the evidence that is filed by the parties in an

opposition proceeding, and the onus is different at the examination stage [see *Simmons IP Inc v Park Avenue Furniture Corp (1994)*, 56 CPR (3d) 284 (TMOB); and *Proctor & Gamble Inc v Morlee Corp (1993)*, 48 CPR (3d) 377 (TMOB)]. In this respect, at the examination stage, the Registrar needs to be satisfied that the trademark is *not* registrable to refuse the application under section 37 of the Act. Conversely, in an opposition proceeding under section 38 of the Act, the application must be refused unless the Registrar is satisfied, on a balance of probabilities, that the trademark *is* registrable [see *Joseph E Seagram & Sons, supra*; *Christian Dior, supra*]. Accordingly, a decision to advertise a trademark following examination is not a decision that the trademark is registrable; that determination must be made by the Registrar at the opposition stage, taking into consideration all of the evidence in the file and the arguments raised by both parties [see *Carling Breweries Ltd v Molson Cos*, 1984 CarswellNat 83 (FCTD)].

[115] Therefore, I do not consider the examiner's decision in this case to be a surrounding circumstance that assists the Applicant.

Applicant's prior use and registration of PUMPERNICKEL'S

[116] Finally, the Applicant submits that use of the Applicant's Mark "together with, or in close proximity to, its primary mark PUMPERNICKELS" while the Opponent's P Design is used "together with, or in close proximity to, its primary mark PREMIERE MOISSON" decreases the likelihood of confusion.

[117] Factors such as the branding context in which a trademark is used may be relevant in a passing off action. However, when considering a section 12(1)(d) ground of opposition, it is the effect of the mark applied for and the opponent's registered trademark *themselves* that must be considered, not the effect of entire labels or signage, or of other indicia that may appear together with the trademarks [see *Reno-Dépôt Inc v Homer TLC Inc*, 2010 TMOB 11; *Groupe Fruits & Passion Inc.*, 2007 CarswellNat 2319 (TMOB)]. Such contextual factors do not form part of the trademark the applicant seeks to register; nor do they limit the scope of the opponent's registration.

[118] I would also note that the Applicant's prior registration no. TMA963,518 for PUMPERNICKEL'S in association with its services does not assist the Applicant in

demonstrating that there is no likelihood of confusion between the Mark and the Opponent's P Design. An applicant's ownership of one or more other trademarks does not give it the automatic right to obtain a further registration [*Coronet-Werke Heinrich Schlerf GmbH v Produits Ménagers Coronet Inc* (1984), 4 CPR (3d) 108 at 115 (TMOB); *Groupe Lavo Inc v Procter & Gamble Inc* (1990), 32 CPR (3d) 533 (TMOB)]. Moreover, given that this prior registration does not include the Mark or otherwise incorporate a design motif resembling those at issue in the present case, I am of the view that the Applicant's prior registration is not a relevant surrounding circumstance.

Conclusion with respect to confusion

[119] In the case of letter marks, differences in design features may suffice to distinguish one mark from the other. The issue is whether a consumer who has a general and not precise recollection of the opponent's trademark will be likely to think, upon seeing the applicant's mark, that the goods and services associated with both trademarks might share a common source. However, the onus is not on the opponent to show that such confusion is likely but rather on the applicant to satisfy the Registrar that there is no likelihood of such confusion.

[120] In the present case, the Applicant submits that consumers "are sure to realize that not all food related goods and services sold in association with a mark containing the letter P, emanate from the Opponent" [at para 10.4.5].

[121] However, the trademarks at issue in this case do not share only the letter P but rather a letter P sprouting a short, curving shoot, and there is considerable overlap between the parties' goods, services and trades. In the circumstances, the Applicant has not convinced me that the differences between the parties' respective sprouting Ps are such that consumers with only an imperfect recollection of the Opponent's P Design are *not* likely to think that Services offered under the Mark come from the same source. Furthermore, in my view, the Mark's background does little to decrease the likelihood that consumers with an imperfect recollection of the Opponent's P Design might consider the Mark to indicate the same source.

[122] In view of the foregoing, and given that the analysis of each surrounding circumstance favours the Opponent, the Applicant has failed to demonstrate, on a balance of probabilities, that the Mark is not confusing with the Opponent's P Design.

[123] Consequently, this ground of opposition is maintained.

GROUND OF OPPOSITION BASED ON ENTITLEMENT TO REGISTRATION UNDER SECTION 16(1)(A)

[124] The Opponent also pleads that the Applicant is not the person entitled to registration of the Mark because, at the date when the Applicant claims to have first used the Mark in association with the Services, namely since at least as early as November 2014, the Mark was confusing with the Opponent's P Design, previously used in Canada by the Opponent in association with its goods and services as claimed in the Opponent's Registration.

[125] To meet its initial burden under this ground, the Opponent must evidence not only the prior use of its trademark in accordance with section 16(1)(a) of the Act, but also that its trademark had not been abandoned at the date of advertisement of the Application, as stipulated in section 16(5).

[126] As discussed above under the section 12(1)(d) ground of opposition, the Fiset affidavit provides evidence of use of the Opponent's P Design prior to November 2014. Furthermore, I am prepared to accept the exhibited printouts from the Opponent's website, dated in 2017, as evidence that the Opponent had not abandoned its trademark at the date of advertisement of the Application, namely May 18, 2016.

[127] Accordingly, I find that the Opponent has also met its initial burden under this ground of opposition.

[128] With respect to the test for confusion according to the factors set out in section 6(5) of the Act, the earlier relevant date associated with the 16(1)(a) ground of opposition does not significantly alter the results of the analysis performed under the previous ground of opposition.

[129] I would note that the evidence with respect to use of the Opponent's P Design prior to November 2014 shows that it was displayed on promotional materials immediately above the

words PREMIÈRE MOISSON, where the second S in MOISSON is stylized to resemble a tendril, as shown in the example below, taken from the napkin at Exhibit F:



[130] Accordingly, to the extent that the Opponent relies on this composite trademark—rather than the Opponent’s P Design as registered—I find that the Opponent’s case is not quite as strong as it was under the section 12(1)(d) ground.

[131] Nevertheless, it is well established that two or more trademarks may be used at the same time so long as they are not combined in a way that renders the individual marks indistinguishable [see *AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD); and *Loro Piana, supra*]. Generally, use of a trademark in combination with additional words or design elements qualifies as use of that trademark if the public, as a matter of first impression, would perceive the trademark *per se* as being used [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)]. In the present case, while the combination of the Opponent’s P Design and the stylized PREMIÈRE MOISSON may constitute a composite trademark, I find that those two elements *per se*, as distinct trademarks, are also identifiable. In applying the principles set out in *Canada (Registrar of Trade Marks) v Cie Internationale pour l’informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA), I am satisfied that the Opponent’s P Design, by virtue of its size and position, stands out sufficiently to have an identity that is distinguishable from the whole [for a similar conclusion, see *Loro Piana, supra, aff’g* (2008), 72 CPR (4th) 220 (TMOB).]

[132] Furthermore, the examples of exterior signage at Exhibit C to the Fiset affidavit show that the Opponent’s P Design had been prominently displayed on its own—on an individual sign or panel—since December 2013 at the Monkland Bakery, since March 2014 at the Mont Royal Bakery, and since April 2014 at the Masson Bakery. In addition, Ms. Fiset attests that the bread bags and sealing tape adorned with the repeating pattern based on the Opponent’s P Design are

representative of the manner in which the Opponent's goods were marketed before November 2014.

[133] In the circumstances, I am satisfied that by November 2014 the Opponent's P Design had become known in its own right to at least some extent . Conversely, there is no evidence of use or promotion of the Mark prior to that date. Accordingly, the section 6(5)(a) and (b) factors of the test for confusion continue to favour the Opponent. Additionally, as noted above, the earlier relevant date does not have a significant impact on the analysis of the remaining factors.

[134] Consequently, this ground of opposition is maintained as well.

GROUND OF OPPOSITION BASED ON DISTINCTIVENESS OF THE MARK UNDER SECTION 2

[135] The Opponent also pleads that the Mark is not distinctive within the meaning of section 2 of the Act, because the Mark is not adapted to distinguish nor capable of distinguishing the Services from the goods and services of others, and, more particularly, from the goods and services at Schedule A to this decision, with which the Opponent's P Design has been used and continues to be used in Canada by the Opponent and its authorised licensees. The relevant date for this ground would be the date of filing the statement of opposition (October 17, 2016) [see *Re Andres Wines Ltd and E & J Gallo Winery* (1975), 25 CPR (2d) 126 at 130 (FCA); and *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 412 at 424 (FCA)].

[136] However, as the Opponent has already succeeded under two other grounds, there is no need to address this remaining ground of opposition.

DISPOSITION:

[137] In view of all the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.

Jean Carrière
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

GOODS:

- (1) Pâtisseries, viennoiseries, biscuits, tartes et pains, frais ou congelés.
- (2) Fromages.
- (3) Bouillons et soupes.
- (4) Poissons et fruits de mer.
- (5) Mets préparés frais et mets préparés congelés, salades, sandwichs, pizza, amuse-gueules.
- (6) Marchandises d'épicerie, nommément, cafés, jus de fruits, jus de légumes, thés, tisanes, chocolats chauds, breuvages santé chauds et froids, nommément, thé glacé, café glacé, lait, eau de source et eau pétillante, cocoa, confitures, noix, cornichons, huiles comestibles, marinades, chapelure, farines, bases pour muffins, gâteaux, crêpes, gaufres et biscuits, levure, miel, sirop d'érable, tartinades sucrées à base de chocolat, caramel, fruits et noix, pâtes alimentaires, sauces pour pâtes alimentaires, riz aromatisés ou assaisonnés, café en grains, céréales, épices, assaisonnements, sel, vinaigres, moutardes, mayonnaises, sucre, fruits et légumes en conserve, fruits et légumes séchés, tapenades, confits salés, chutney, sorbets et crème glacée.
- (7) Chocolats, confiseries, nommément, confiseries au chocolat, aux amandes, aux arachides, glacées et sucrées.
- (8) Articles ménagers, nommément, sacs (général), sacs d'épicerie, serviettes de table, tasses à boire.
- (9) Certificats-cadeaux et cartes fidélité [*sic*].
- (10) Amandes caramélisées.
- (11) Viandes et charcuteries.

SERVICES:

- (1) Services d'opération d'un magasin d'alimentation gastronomique, charcuterie, épicerie, pâtisserie, boulangerie, prêt à manger, conserves et confiserie.
- (2) Café bistrot.
- (3) Services de traiteur.

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

AGENTS OF RECORD

Norton Rose Fulbright Canada LLP/S.E.N.C.R.L.,s.r.l.

FOR THE OPPONENT

Sheldon S. Lazarovitz

FOR THE APPLICANT