

O P I C



C I P O

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 175

Date of Decision: 2021-08-09

IN THE MATTER OF AN OPPOSITION

LT Overseas North America, Inc.

Opponent

and

AFOD Ltd.

Applicant

1,787,233 for ROYAL SAMPAGUITA

Application

INTRODUCTION

[1] LT Overseas North America, Inc. (the Opponent) opposes registration of the trademark ROYAL SAMPAGUITA (the Mark), which is the subject of application No. 1,787,233 by AFOD Ltd. (the Applicant).

[2] The Mark is applied for in association with the following goods and services:

Goods: (1) Rice; rice products, namely, rice flour and rice vermicelli, glutinous rice, glutinous rice flour, Corn starch, potato starch and tapioca starch (2) Beans, namely red beans and green mung beans, yellow mung beans (3) Canola, corn, coconut and edible oil.

Services: Retail sale of food; Wholesale sale of food; Retail grocery store services; Import and export agencies.

[3] The opposition is primarily based on an allegation that the Mark is confusing with the Opponent's ROYAL trademarks, previously registered or applied for in association with identical or related goods.

THE RECORD

[4] The application for the Mark was filed on June 15, 2016 on the basis of proposed use in Canada. The application includes the following foreign character translation:

The translation provided by the applicant of the word SAMPAGUITA is JASMINUM SAMBAC, the common name of a species of flower.

[5] The application was advertised for opposition purposes on January 31, 2018. Numerous amendments to the *Trademarks Act*, RSC 1985, c T-13 (the Act) came into force on June 17, 2019. Pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read immediately before June 17, 2019, an exception being that, with respect to confusion, sections 6(2) to (4) of the Act as it currently reads will be applied.

[6] On June 29, 2018, the Opponent opposed the application by filing a statement of opposition under section 38 of the Act. The grounds of opposition are based on non-registrability under section 12(1)(d), non-entitlement under section 16(3), non-distinctiveness under section 2, and non-compliance with section 30(i) of the Act.

[7] In support of its opposition, the Opponent filed certified copies of two registrations and three applications.

[8] In support of its application, the Applicant filed the affidavit of Hong Bing Xia, sworn April 8, 2019 in Vancouver, British Columbia (the Xia Affidavit). Mr. Xia was not cross-examined.

[9] Both parties submitted written representations and were represented at an oral hearing.


[10] Before assessing the grounds of opposition, I will first provide an overview of the parties' evidence, the evidential burden on the Opponent, and the legal onus on the Applicant.

OVERVIEW OF THE OPPONENT'S EVIDENCE

[11] The Opponent submitted certified copies of the following two registrations (the Opponent's ROYAL Registrations):

Trademark	Registration Particulars	Goods
	Royal & Design TMA468651 Reg. date: January 14, 1997	Rice.
	Royal & Queen Design TMA480082 Reg. date: August 11, 1997	Rice.

[12] The Opponent also submitted certified copies of the following three applications (the Opponent's ROYAL Applications):

Trademark	Application Particulars	Goods
ROYAL CHEF'S BLEND	Word Mark 1756699 Filed: Nov. 26, 2015	Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour; preparations made from cereals, namely, corn flour, whole grain oat, corn bran, rice; bread, pastry; confectionery, namely, chocolates, candies, gumdrops, mints, caramels, toffees, chewing gum, frozen confectionery; ices, honey, treacle; yeast; salt, mustard; vinegar; spices; ice.
ROYAL AUTHENTIC ADVENTURES	Word Mark 1787382 Filed: June 16, 2016	Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour; preparations made from cereals, namely, corn flour, whole grain oat, corn bran, rice; bread, pastry; confectionery, namely, chocolates, candies, gumdrops, mints, caramels, toffees, chewing gum, frozen confectionery; ices, honey, treacle; yeast; salt, mustard; vinegar, condiments, namely, simmer sauces; spices; ice.
	1799424 A Tradition of Excellence Royal Authentic Chef's Blend & Design Filed: Sept. 8, 2016	Rice.

[13] I note that the application for the word mark ROYAL CHEF'S BLEND was withdrawn by the owner in July 2019. However, as that application was still pending on the date of advertisement of the application for the Mark (January 31, 2018), the Opponent may rely on it for the purposes of section 16(3)(b) of the Act. I also note that although the other two applications subsequently proceeded to registration, as the Opponent did not amend its statement of opposition to include these subsequent registrations within the scope of its section 12(1)(d) ground, they will only be considered in respect of the Opponent's non-entitlement grounds of opposition.

OVERVIEW OF THE APPLICANT'S EVIDENCE

The Xia Affidavit

[14] Mr. Xia is the General Manager of the Applicant [para 1]. The Applicant is a food importer, marketer and distributor specializing in East Asian and Southeast Asian foods for the grocery market in Canada [para 5]. The Xia Affidavit evidences the following:

- The Applicant's use of the Mark in Canada since filing the subject application. In particular, the Applicant has sold ROYAL SAMPAGUITA-branded "rice, glutinous rice, beans, pasta and macaroni" in various provinces and territories through independent stores and retail store chains such as Wal-Mart, No Frills and Shoppers Drug Mart [para 8].
- The meaning of SAMPAGUITA, as a species of jasmine plants [para 10, Exhibit B].
- State of the register evidence, namely five registered trademarks that include the word ROYAL, all in association with "rice" [para 11, Exhibit C].
- Purported irregularities regarding the Opponent's predecessor-in-title and subsequent assignment of the two trademark registrations relied on by the Opponent [paras 14 to 18, Exhibit D].

[15] Representative packaging of the Applicant's ROYAL SAMPAGUITA-branded products is provided at Exhibit A to the Xia Affidavit.

EVIDENTIAL BURDEN AND LEGAL ONUS

[16] In accordance with the usual rules of evidence, there is an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Ltd v Molson Companies Ltd*, 1990 CarswellNat 1053, 30 CPR (3d) 293 (FCTD)]. The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

[17] For those allegations for which the opponent has met its evidential burden, the legal onus is on the applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. The presence of a legal onus on an applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, then the issue must be decided against the applicant.

SECTION 12(1)(D) GROUND OF OPPOSITION – CONFUSING WITH A REGISTERED TRADEMARK

[18] The Opponent pleads that the Mark is not registrable in association with the applied-for goods and services because, contrary to section 12(1)(d) of the Act, it is confusing with the Opponent's ROYAL Registrations, namely TMA468,651 and TMA480,082.

[19] The material date with respect to confusion with a registered trademark is the date of this decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd et al*, 1991 CarswellNat 1119, 37 CPR (3d) 413 (FCA)].

[20] In its representations, the Applicant submits that “the Opponent may not be the legal owner of the two cited Canadian trademark registrations”, noting that the Opponent's predecessor-in-title “may have already been dissolved some time ago” [paras 15 and 16]. However, I have exercised my discretion and checked the register to confirm that the Opponent's ROYAL Registrations are extant and in the name of the Opponent [per *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Accordingly, the Opponent meets its initial burden with respect to this ground.

[21] As such, the Applicant must establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and either of the Opponent's ROYAL Registrations.

[22] I will first consider confusion with respect to the Opponent's Royal & Queen Design, though I note the analysis is essentially the same for both registrations.

Test to determine confusion

[23] The test to determine the issue of confusion is set out in section 6(2) of the Act which provides 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, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[24] The test to be applied is a matter of first impression in the mind of a casual consumer "somewhat in a hurry" who sees the Mark in association with the applied-for goods or services at a time when they have no more than an imperfect recollection of the Opponent's trademark and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[25] In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods, services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them.

[26] The criteria or factors in section 6(5) of the Act are not exhaustive and different weight will be given to each one in a context-specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, 1 SCR 772 at para 54]. In *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, the Supreme Court of Canada stated that section 6(5)(e), the resemblance between the trademarks, will often have the greatest effect on the confusion analysis [at para 49] and that,

while the first word in the trademark may be the most important in some cases, the preferable approach is to consider whether there is an aspect of the trademark that is particularly “striking or unique” [at para 66].

Inherent Distinctiveness and the Extent Known

[27] The first portion of both parties’ trademarks is the word ROYAL. As the Registrar may take judicial notice of dictionary definitions [*Tradall SA v Devil’s Martini Inc*, 2011 TMOB 65], I note that the *Merriam-Webster Dictionary* includes the following definitions for ROYAL:

- 1 a: of kingly ancestry
b: of, relating to, or subject to the crown
c: being in the crown's service
- 2 a: suitable for royalty: MAGNIFICENT
b: requiring no exertion: EASY
- 3 a: of superior size, magnitude, or quality

[28] Similar definitions are found in other online dictionaries, such as www.collinsdictionary.com. While most definitions relate to royalty in the “kingly” or regal sense, consistent with the 3a definition above, the jurisprudence has generally viewed ROYAL as having essentially a laudatory connotation [see *Molson Cos v Richmond Breweries Ltd*, 1985 CarswellNat 538 (TMOB) at para 22; *Nabisco Brands Ltd/Nabisco Brands Ltée v Little Oly’s Coffee Service Ltd*, 1987 CarswellNat 730 (TMOB) at para 5; *Nabisco Brands Ltd/Nabisco Brands Ltée v Harvest Inn Inc*, 1988 CarswellNat 1393 (TMOB) at para 7; *Mafcote Industries Inc v Roylco Ltd*, 1994 CarswellNat 3068 (TMOB) at para 12; *McGregor Industries Inc v Park Lane Neckwear Inc*, 1997 CarswellNat 3170 (TMOB) at para 6; *Royal & Sun Alliance Insurance Group PLC v Royal Bank*, 2008 CarswellNat 395 (TMOB) at para 14; *Scenic Holidays (Vancouver) Ltd v Royal Scenic Holidays Ltd*, 2010 TMOB 63 at paras 24 and 32].

[29] While the laudatory connotation of ROYAL is likely derived from or related to the regal connotation, given the particular figure design, I agree with the Opponent that its ROYAL trademark invokes the regal connotation, rather than a merely laudatory connotation. However, it is that particular figure design (and to some extent, the particular font of the word ROYAL) that provides the Opponent’s Royal & Queen Design its inherent distinctiveness.

[30] Similarly, it is the word SAMPAGUITA that provides the Mark with its inherent distinctiveness. Whether a consumer recognizes the word as referring to a flower or whether it is viewed as a coined term, that word and the Mark as a whole has no clear meaning in association with the applied-for goods and services. Accordingly, I find that the Mark also has some inherent distinctiveness.

[31] With respect to the extent to which the parties' trademarks have become known, noting that its trademark has been registered in Canada since 1997, the Opponent submits that "it is probable that it has been used for a comparable period and that it will have acquired the sort of reputation and goodwill that the Act is designed to protect" [Opponent's written representations at para 30]. However, the Opponent furnished no evidence of use of its trademarks and there is no evidence with respect to the extent to which the Opponent's Royal & Queen Design has become known in Canada.

[32] With respect to the Applicant's Mark, while the Xia Affidavit provides no particular volume or dollar amounts, the uncontroverted evidence with respect to sales in multiple large retail stores across various provincial and territorial jurisdictions permits an inference that the Mark has become known at least to some extent in Canada as of the date of this decision.

[33] In view of the foregoing, this factor favours the Applicant.

Length of Time in Use

[34] With respect to the Mark, the Xia Affidavit evidences at least some use in association with rice and other food goods at some unspecified point between the application's filing date in June 2016 and the date of the Xia Affidavit in April 2019. I accept that this evidence demonstrates a length of use of just over two years.

[35] There is no evidence of use of the Opponent's ROYAL Registrations. However, the Opponent notes that the registration for its Royal & Queen Design includes a claim of use in Canada "since at least as early as January 1996". Citing *Cartier Men's Shops Ltd v Cartier Inc* (1981), 58 CPR (2d) 68 (FCTD) (*Cartier*) at para 10, the Opponent submits that there is a presumption that the date of first use shown in a registration is correct and, as such, can be used

to prove the length of time the registered trademark has been in use [Opponent's written representations at para 35].

[36] While not directly referenced in *Cartier* or in the Opponent's representations, presumably this principle flows from section 54 of the Act, which states in part as follows:

54(1) Evidence of any document in the official custody of the Registrar or of any extract therefrom may be given by the production of a copy thereof purporting to be certified to be true by the Registrar.

(2) A copy of any entry in the register purporting to be certified to be true by the Registrar is evidence of the facts set out therein.

[37] In response, the Applicant submitted that there is no *affidavit* evidence that any of the trademarks relied upon by the Opponent are in use or have ever been used in Canada [Applicant's written representations at para 10]. As the claim of use set out in the Royal & Queen Design registration is not subject to cross-examination, the Applicant argued that it would be unfair to allow the Opponent to benefit from such a bare claim. In this respect, the Applicant essentially submits that the "fact" set out in the registration is at best a *claim* of use, rather than evidencing actual use in compliance with the Act, as there is no evidence that any purported use was i) in association with the trademark as registered, ii) by the Opponent or a proper licensee, iii) continuous since the claimed date; or iv) otherwise in compliance with the definition of use set out in section 4 of the Act. Accordingly, the Applicant submits that this factor should favour the Applicant, rather than the Opponent.

[38] I note that in *Tokai of Canada Ltd v Kingsford Products Company, LLC*, 2018 FC 951, the Federal Court stated the following with respect to the filing of certified copies and the weight to be afforded claims therein:

I should caution, however, that notwithstanding that there are a few cases before the Trademark Opposition Board and this Court that have given at least *de minimis* weight to the dates of use claimed in trademark registrations, without any evidence of actual use whatsoever, I would be inclined to give no weight to these allegations of use unless, at the very least, certified copies of the registrations are filed as evidence. [at para 37]

[39] In my view, while the Federal Court in *Tokai* stopped short of revisiting the purported principle from *Cartier*, it left the door open to adopting an approach that – in the absence of at least some evidence of actual use – gives no weight to a claim of use set forth in a registration for

purposes of determining the length of time the relied-upon trademark has been used. I note that such an approach would appear to be consistent with a some recent decisions of the Registrar, which have stated that a registration based on use does not in itself support a conclusion that the trademark has been used *continuously* [see, for example, *Yardley v American Girl, LLC*, 2015 TMOB 218 at para 24; and *SoftCom Inc v Your Holding BV*, 2018 TMOB 103 at para 28].

[40] In any event, as noted by the Opponent at the hearing, nothing really turns on this issue. The jurisprudence subsequent to *Cartier* has consistently found that, at best, only *de minimis* use can be inferred from the claim set out in a registration and that, further, even if nominally favouring an opponent, it tends towards little to no weight in the overall confusion analysis [see, for example, *Entre Computer Centers Inc v Global Upholstery Co*, 1991 CarswellNat 1361 (TMOB) at paras 9 and 10; *Uniboard Surfaces Inc v Quickstyle Industries Inc*, 2007 CarswellNat 2211 (TMOB) at para 16; *Sun Media Corp v Montreal Sun (Journal Anglophone) Inc*, 2010 TMOB 49 at para 20; *1772887 Ontario Ltd v Mohammadi*, 2012 TMOB 246 at para 39; *MAPA GmbH v 2956-2691 Quebec Inc*, 2013 TMOB 22 at para 29; *Nada Fashion Designs Inc v Ghodsi*, 2013 TMOB 115 at para 31; *Monster, Inc v Mattel, Inc*, 2014 TMOB 197 at 34; *Advance Magazine Publishers Inc v NASDAQ Corporate Solutions Canada ULC*, 2018 TMOB 10 at para 44].

[41] Indeed, in this case, accepting that the claim set out in its registration results in this factor favouring the Opponent, it is only nominally so and outweighed by the conclusion above regarding the extent to which the Applicant's Mark has become known.

Nature of the Goods, Services or Business / Nature of the Trade

[42] When considering the nature of the goods and services of the parties in respect of the issue of confusion, it is the statements in the subject application and registration that govern [*Mr Submarine Ltd v Amandista Investments Ltd*, 1987 CarswellNat 749 (FCA); *Miss Universe Inc v Bohna*, 1994 CarswellNat 1443 (FCA)].

[43] The Opponent's Royal & Queen Design is registered in association with "rice", overlapping most closely with the following applied-for goods: "Rice; rice products, namely rice flour and rice vermicelli, glutinous rice, glutinous rice flour". To the extent that the Applicant's

broad services include the sale and import/export of rice or rice products, I consider the applied-for services to overlap with the Opponent's registrations as well. The remaining applied-for goods are related in the sense that they are staples and other food products.

[44] Although there is no evidence with respect to the Opponent's channels of trade, given the overlap in the goods and the evidenced extent of the Applicant's own channels of trade, it is likely that there is also overlap with respect to the parties' trades.

[45] Accordingly, these factors favour the Opponent.

Degree of Resemblance

[46] As noted above, the first portion of both parties' trademarks is the word ROYAL. However, given that it is an ordinary dictionary word with low inherent distinctiveness, I do not consider the word ROYAL to be the striking or unique aspect of either trademark. Rather, the striking aspect of the Opponent's Royal & Queen Design is the particular figure design whereas the striking aspect of the Mark is the word SAMPAGUITA. As such, viewing the trademarks each as a whole, I consider there to be significant differences in appearance and when sounded, notwithstanding the shared ROYAL element. With respect to the idea suggested, while the Opponent's trademark suggests the idea of a royal or queen figure, this idea is not reflected in the Mark, which perhaps suggests the idea of a fine flower, and not that of a queen figure or the like.

[47] Accordingly, this factor favours the Applicant.

Additional Surrounding Circumstance – State of the Register

[48] The Xia Affidavit includes reference to five third-party trademarks, registered in association with "rice" goods and incorporating the element ROYAL [para 11]. The five registrations include TMA929177 for ROYAL BLEND, TMA899943 for ROYAL PRINCESS, TMA813726 for ROYAL BLUE, and two design marks.

[49] However, state of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [*Ports International Ltd v Dunlop Ltd*, 1992 CarswellNat 1431 (TMOB); and *Welch Foods Inc v Del Monte Corp*, 1992 CarswellNat 178

(FCTD)]. Inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located [*Maximum Nutrition Ltd v Kellogg Salada Canada Inc*, 1992 CarswellNat 124 (FCA)]. In this case, there is no evidence regarding the extent to which these third-party trademarks have been used or become known in Canada. While I accept that the evidence shows co-existence on the trademark register, I do not agree with the Applicant that the evidence shows co-existence in the Canadian marketplace.

[50] Following the hearing, the Applicant attempted to submit further written representations, including four lengthy lists of trademark registrations that include the word element ROYAL, sorted by different goods and/or Nice classes. However, if the Applicant wished such state of the register evidence to be considered, it should have timely furnished such as evidence.

[51] In view of the foregoing, I do not consider the state of the register evidence to be a significant surrounding circumstance.

Additional Surrounding Circumstance – State of the Marketplace

[52] In its representations, the Applicant submitted that if one simply goes to any grocery store and scans the shelves, they can see many third-party “ROYAL” rice products available in the marketplace. The Applicant also invited the Registrar to review evidence filed in an opposition proceeding against one of the Opponent’s ROYAL Applications, asserting that evidence with respect to such third-party use of the element ROYAL in association with rice products was furnished in that proceeding.

[53] Again, however, if the Applicant wished to have that evidence or the like considered, it was obligated to furnish it as part of its evidence in this proceeding.

[54] Accordingly, as there is no state of the marketplace evidence with respect to third parties before me, this circumstance favours neither party.

Conclusion – Confusion with the Opponent’s Trademark

[55] Having considered all of the surrounding circumstances, I find that the Applicant has met its legal burden with respect to the likelihood of confusion between the parties’ trademarks. I reach this conclusion due to the differences in resemblance between the trademarks and the low inherent distinctiveness of the shared element ROYAL, and notwithstanding the overlap in the nature of the parties’ goods, services and trades.

[56] In view of the foregoing, the section 12(1)(d) ground of opposition based on confusion with the Opponent’s Royal & Queen Design trademark is rejected.

[57] As the confusion analysis is essentially identical, the section 12(1)(d) ground based on confusion with the Opponent’s Royal & Design trademark is similarly rejected.

SECTION 16(3)(B) GROUND OF OPPOSITION – NON-ENTITLEMENT – PRIOR APPLICATION

[58] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark, in view of section 16(3)(b) of the Act, with respect to the applied-for goods and services, because at the time of the filing date and at all other material times, the Mark is and was confusingly similar to the Opponent’s ROYAL Applications which had been previously filed and were pending at the advertisement date.

[59] As the Opponent’s ROYAL Applications were pending as of the advertisement date of the application for the Mark, the Opponent meets its initial burden with respect to each of its three applications.

[60] However, as above, I find that the Applicant has met its legal burden with respect to the issue of confusion under this ground. Although the evidenced use and extent known of the Mark is after the material date for this ground (June 15, 2016), the Applicant nonetheless benefits from the inherent distinctiveness of the Mark and the low degree of resemblance between it and the Opponent’s trademarks.

[61] In this respect, I find that the additional matter in each of the Opponent’s ROYAL Applications results in the degree of resemblance factor weighing even more heavily in the

Applicant's favour, such that there is no likelihood of confusion with respect to any of the applied-for goods and services. For example, while the first word of the Opponent's trademark ROYAL AUTHENTIC ADVENTURES is the same as the Mark, the resemblance in appearance, when sounded and in ideas suggested is significantly diminished by the additional AUTHENTIC ADVENTURES element.

[62] In view of the foregoing, this ground of opposition based on non-entitlement is rejected.

REMAINING GROUNDS OF OPPOSITION

[63] The remaining grounds of opposition as set out in the statement of opposition (based on section 16(3)(a), section 2 and section 30(i) of the Act), required evidence in support of such pleadings for the Opponent to meet its initial evidential burden; such evidence was not furnished in this case. Indeed, at the hearing, the Opponent declined to make any substantive submissions with respect to such grounds.

[64] As the Opponent has not met its initial burden with respect to each of the remaining grounds, the grounds based on sections 16(3)(a), 2 and 30(i) of the Act are rejected.

DISPOSITION

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

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: 2021-06-29

APPEARANCES

Michael O'Neil	For the Opponent
Yunwei (Edmund) Xie	For the Applicant

AGENTS OF RECORD

Gowling WLG (Canada) LLP	For the Opponent
Yunwei (Edmund) Xie	For the Applicant