



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 180

Date of Decision: 2021-08-16

IN THE MATTER OF AN OPPOSITION

National Importers Inc.

Opponent

And

Tosca Reno Media Inc.

Applicant

**1,722,431 for EAT CLEAN BY
TOSCA RENO**

Application

INTRODUCTION

[1] Tosca Reno Media Inc. (the Applicant) has filed application No. 1,722,431 (the Application) to register the trademark EAT CLEAN BY TOSCA RENO (the Mark). The filing date of the Application is April 7, 2015.

[2] The Application, as amended on February 15, 2018, is in association with the goods and services set out in Schedule A to this decision (the Goods and Services). The Application is based on proposed use of the Mark in Canada in association with the Goods, and use of the Mark in Canada in association with the Services since at least as early as January 2015.

[3] The Application was advertised for opposition purposes in the *Trademarks Journal* on February 8, 2017. On July 10, 2017, National Importers Inc. (the Opponent) filed a statement of

opposition against the Application pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). I note that the Act was amended on June 17, 2019, and pursuant to section 70 of the Act, the grounds of opposition in this proceeding will be assessed based on the Act as it read prior to June 17, 2019.

[4] The Opponent raises grounds of opposition based on registrability under sections 12(1)(b) and 12(1)(d), entitlement under sections 16(1)(a) and (b) and sections 16(3)(a) and (b), distinctiveness under section 2, and non-compliance with sections 30(a), (b), (e) and (i) of the Act. For the grounds of opposition that are based on an alleged likelihood of confusion, the Opponent relies on the following trademarks:

Trademark	Reg. / App. No.	Goods
TOSCA	TMA934487	(1) Vanilla beans. (2) Food flavourings; spices.
TOSCA	TMA291909	Vegetables, fruits, oils ,fats, vinegars, canned fish, condiments (i. e. mustard, horse radish), pickles, juices, cooking wines and wine vinegars.
TOSCA	1,709,581	Pasta.
TOSCA SQUEEZE	1,581,679	Food products

[5] The Applicant filed a counter statement denying the grounds of opposition.

[6] The Opponent filed as its evidence certified copies of registration Nos. TMA291,909 and TMA934,487 and application No. 1,709,581. The Applicant elected not to file any evidence.

[7] Only the Applicant filed written representations. No hearing was requested.

[8] For the reasons set out below, I reject the opposition.

ONUS

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the Application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

GROUND OF OPPOSITION SUMMARILY DISMISSED

Sections 30(a), (b), (e), (i) and Section 12(1)(b) Grounds of Opposition

[10] There is no evidence of record speaking to these grounds of opposition, and the Opponent did not make any submissions regarding these grounds. Accordingly, the Opponent has not met its initial evidential burden and these grounds of opposition are rejected.

Sections 16(1)(a) and 16(3)(a) and Section 2 Grounds of Opposition

[11] The Opponent did not file any evidence of use of its trademarks. Consequently, there is no evidence on which it can rely for the purposes of its sections 16(1)(a) and 16(3)(a) and section 2 grounds of opposition. While the Opponent filed certified copies of two registrations, a certified copy alone only permits the Registrar to assume a *de minimis* use of an opponent's trademark [see *Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)] and is not sufficient to meet an opponent's evidential burden for a non-entitlement or non-distinctiveness ground of opposition [see *1772887 Ontario Ltd. v. Bell Canada*, 2012 TMOB 41].

[12] Therefore, the sections 16(1)(a) and 16(3)(a) and section 2 grounds of opposition are rejected.

SECTION 12(1)(D) GROUND OF OPPOSITION

[13] The Opponent pleads that the Mark is not registrable because it is confusing with the Opponent's registered trademark TOSCA which is the subject of TMA291,909 and TMA934,487. I have exercised my discretion to check the Register and confirm that these two registrations remain extant [see *Quaker Oats Co Ltd of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent has therefore met its initial evidential burden with respect to this ground of opposition.

[14] I note that the Opponent's application No. 1,709,581 for the trademark TOSCA, referenced in the statement of opposition, subsequently proceeded to registration No. TMA1036981 on July 5, 2019. However, the Opponent did not amend its statement of

opposition to rely on TMA1036981 as part of its section 12(1)(d) ground of opposition. Consequently, the Opponent's application No. 1,709,581 is considered in respect of the Opponent's sections 16(1)(b) and 16(3)(b) grounds of opposition, discussed later in this decision. The analysis of the section 12(1)(d) ground is solely in respect of the Opponent's registration Nos. TMA291,909 and TMA934,487.

[15] The material date for assessing the section 12(1)(d) ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

Test for confusion

[16] The test for confusion is set out in section 6(2) of the Act where it is stipulated that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods and services are of the same general class or appear in the same class of the Nice Classification. 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 and 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.

[17] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772 at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

[18] The test for confusion is assessed as 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 trademark, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot, supra*, at para 20].

The inherent distinctiveness of the trademarks and the extent to which they have become known

[19] The Opponent's trademark TOSCA is inherently distinctive. Aside from being the title of an opera composed in 1900 by Giacomo Puccini (see the entry for Puccini in the *Canadian Oxford Dictionary*, 2nd Ed; and *Tradall SA v Devil's Martini Inc*, 2011 TMOB 65 at para 29 for the principle that the Registrar may take judicial notice of dictionary definitions), there is no evidence that the word TOSCA has a dictionary meaning in English or French, or otherwise describes the Opponent's goods and services.

[20] The Applicant's Mark is also inherently distinctive, though in my view somewhat less so than the Opponent's trademark, given that the Mark is suggestive of healthy eating.

[21] As neither party filed evidence of the use of their respective trademarks, there is no basis on which to assess the degree to which the trademarks have become known.

[22] In view of the above, this factor favours the Opponent to a slight degree.

The length of time the trademarks have been in use

[23] Neither party filed evidence of continuing use of their trademarks, and therefore this factor does not favour either party.

The nature of the goods, services or business; and the nature of the trade

[24] The goods listed in the Opponent's registrations include various food and beverage items. The Goods and Services listed in the Application do not include any food or beverage items. The Goods in the Application include publications, videos and other products generally related to health, exercise and nutrition, and the Services in the Application similarly include entertainment and educational services related to health, exercise and nutrition.

[25] While there is a connection between the parties' respective goods and services, in as much as some of the Applicant's Goods and Services relate in a general sense to food or nutrition, I do not consider that connection to be particularly strong. Also, I have no evidence to suggest that the parties' likely channels of trade would overlap, and I do not consider the descriptions of the parties' goods and services to inherently suggest an overlap in the channels of trade.

[26] At best for the Opponent, I consider this factor to be neutral and not to favour either party.

Degree of resemblance

[27] As indicated by the Supreme Court of Canada in *Masterpiece*, the degree of resemblance between the trademarks is often the most important factor. One must consider the degree of resemblance 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].

[28] With the Opponent's trademark, the striking or unique element is the word TOSCA.

[29] With the Applicant's Mark, in my view, the striking or unique element is the phrase EAT CLEAN. While suggestive of healthy eating, in my view, this phrase does not directly describe the Goods and Services, and combined with its presence at the beginning of the Mark results in this phrase being the most striking element. The remaining words "BY TOSCA RENO" are likely to be understood as a reference to the Applicant's EAT CLEAN Goods and Services coming from an individual having the name TOSCA RENO.

[30] In my view, the presence of the term "TOSCA" in the Mark, alone, is insufficient to give rise to a high degree of resemblance. The Applicant's Mark is significantly longer and comprised of more words and characters than the Opponent's trademark, and thus is different in appearance and sound. In addition, the ideas conveyed by the trademarks are different. The Opponent's trademark conveys no particular idea given that TOSCA is not an English or French word. In contrast, the Applicant's Mark is a phrase in which the words "TOSCA RENO" are likely to be understood as an individual's given name and surname, respectively.

[31] Overall, when the parties' trademarks are considered as a whole, in my view they are more different than they are similar. Consequently, the degree of resemblance factor favours the Applicant.

Conclusion regarding the Section 12(1)(d) ground

[32] Having considered all of the surrounding circumstances, I conclude that the Applicant has satisfied its legal burden to show that there is no reasonable likelihood of confusion between the parties' trademarks. I do not consider the degree of resemblance between the trademarks to be sufficiently high as to give rise to a likelihood of confusion in respect of any of the Goods and Services listed in the Application.

[33] Consequently, I reject the section 12(1)(d) ground of opposition.

SECTIONS 16(1)(B) AND 16(3)(B) GROUNDS OF OPPOSITION

[34] With this ground of opposition, the Opponent relies on its application Nos. 1,709,581 (TOSCA) and 1,581,679 (TOSCA SQUEEZE). Application no. 1,709,581 subsequently proceeded to registration; however, it was still pending at the date of advertisement of the Application and so the Opponent may rely on it for the purposes of its section 16(1)(b) and 16(3)(b) grounds of opposition. Also, I note that application No. 1,581,679 was deemed abandoned as of July 18, 2017; however, I will nevertheless address this application since it was pending at the date of advertisement of the Application.

[35] With the section 16(1)(b) and 16(3)(b) grounds of opposition, the material dates are April 7, 2015 in respect of the Goods, and January 2015 in respect of the Services. "January 2015" is interpreted as January 31, 2015 for the purpose of these grounds of opposition [see *Pacific Pinnacle Investments Ltd v Desnoes & Geddes Ltd* (1994), 53 CPR (3d) 541 (TMOB) at para 8]. Both of the Opponent's applications have filing dates which pre-date the material dates noted above, and were pending on the date of advertisement of the Application. The Opponent has therefore met its initial evidential burden with respect to these grounds of opposition.

[36] Regardless of which material date is applied, in my view, the confusion analysis for the sections 16(1)(b) and 16(3)(b) grounds of opposition is essentially identical to that for the section

12(1)(d) ground of opposition, conducted above. In short, I am satisfied that the Applicant has met its legal burden to demonstrate on a balance of the probabilities that there is no likelihood of confusion between the Mark and the Opponent's trademarks TOSCA and TOSCA SQUEEZE.

[37] In view of the above, I reject the sections 16(1)(b) and 16(3)(b) grounds of opposition.

DISPOSITION

[38] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

Timothy Stevenson
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Application No. 1,722,431

Goods

(1) Publications and printed material and instructional material, namely, books, magazines and journals in the fields of healthy lifestyles, health, nutrition, exercise, diet, weight loss and weight control; coolers for food and drinks; exercise wear, gym wear; electronic publications and printed material and instructional material, namely, books, magazines and journals in the fields of healthy lifestyles, health, nutrition, exercise, diet, weight loss and weight control; pre-recorded digital videos featuring instructional materials in the field of healthy lifestyles, health, nutrition, exercise, diet, weight loss and weight control; t-shirts.

Services

(1) Entertainment services, namely television performances and appearances by an author relating to healthy lifestyles, health, nutrition, exercise, diet, weight loss and weight control; educational services, namely providing instructions for general health in the fields of healthy lifestyles, health, nutrition, exercise, diet, weight loss and weight control; news, information, editorial and commentary services on social media platforms relating to healthy lifestyles, health, nutrition, exercise, diet, weight loss and weight control; personal appearances and motivational speaking by an author at seminars and conferences relating to healthy lifestyles, health, nutrition, exercise, diet, weight loss and weight control; operation of an Internet website and blog for the purpose of sharing information and instruction relating to healthy lifestyles, health, nutrition, exercise, diet, weight loss and weight control

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

HEARING DATE No Hearing Held

AGENTS OF RECORD

Cameron IP

For the Opponent

Dentons Canada LLP

For the Applicant