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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 054
Date of Decision: 2022-03-23

IN THE MATTER OF AN OPPOSITION

Groupe Première Moisson Inc.

Opponent

and

Pumpernickel's Franchise

Applicant

Corporation

1,792,209 for PUMPERNICKEL'S &

Application

P Design

OVERVIEW

[1] On July 20, 2016, Pumpernickel's Franchise Corporation (the Applicant) filed an application to register the trademark PUMPERNICKEL'S & P Design (the Mark), shown below, which consists of a large stylized letter P sprouting a curvy shoot underneath the word PUMPERNICKEL'S in much smaller font, all within a solid circle bordered by a ring of dots. This Mark was applied for in association with the following services based on use in Canada since at least as early as November 2014:



Services:

Restaurant services, fast food outlets, catering services, food take-out and delivery services; restaurant and fast food outlet franchising services, namely business

management advisory services relating to franchising, and offering technical assistance to the establishment and operation of restaurant and fast food franchise outlets; Online food ordering services; provision of a website containing information, blogs, and videos in the areas of food, food preparation and recipes.

[2] The application was advertised for opposition purposes in the *Trademarks Journal* of January 31, 2018.

[3] On June 27, 2018, Groupe Première Moisson Inc. (the Opponent) filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). All references in this decision are to the Act as amended on June 17, 2019, with the exception of references to the grounds of opposition which refer to the Act before it was amended.

[4] The Opponent raises grounds of opposition based upon non-registrability under section 12, non-entitlement under section 16 and non-distinctiveness under section 2 of the Act, all of which turn on the issue of a likelihood of confusion between the Mark and the Opponent's P DESSIN trademark (TMA823,762) the particulars of which are set out in Schedule A to this decision. I should note at this stage that this trademark of the Opponent consists of a stylized letter P sprouting curvy tendrils and an ear of wheat or similar cereal.

[5] The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[6] In support of its opposition, the Opponent filed the declaration of Raynald Racine, VP Finances and Administration of the Opponent, dated December 11, 2018, along with Exhibits A to M thereto (the Racine declaration). Mr. Racine provides information with respect to the Opponent's business, including the use and promotion of its relied upon trademark.

[7] In support of its application, the Applicant filed:

- The affidavit of Soly Ziv, Founder, President, Secretary, Director and Manager of Franchising & Marketing, and a principal shareholder, of the Applicant, dated March 26, 2019, along with Exhibits 1 to 20 thereto (the Ziv affidavit). Mr. Ziv provides information with respect to the Applicant's business, including the use and promotion of the Mark. He further opines on a number of issues, such as consumer perception and the

likelihood of confusion, including on the degree of resemblance between the marks at hand. I should also note at this stage that I have given no weight to any opinion or conclusion statements made by Mr. Ziv on issues of fact and law that are to be determined by the Registrar in the present proceeding.

- The affidavit of Robyn Benmore, a trademark searcher and owner of Robyn Benmore Trademarked (an entity which conducts searches of the trademark records of the Canadian Intellectual Property Office), dated March 14, 2019, along with Exhibits 1 and 2 thereto (the Benmore affidavit). Ms. Benmore introduces state of the register evidence.

[8] None of the deponents were cross-examined.

[9] Both parties filed a written argument. An oral hearing was not held.

PARTIES' BURDEN OR ONUS

[10] 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. If this burden is met, the Applicant then bears the legal onus of establishing, on a balance of probabilities, that no grounds of opposition prevent the registration of its Mark. The presence of a legal onus on the Applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD)]

SECTION 12(1)(D) – CONFUSION WITH THE OPPONENT'S REGISTERED TRADEMARK

[11] The Opponent pleads that the Mark is not registrable having regard to the provisions of section 12(1)(d) of the Act because it is confusing with its registered trademark P DESSIN (TMA823,762). In support, the Opponent filed the particulars of its relied upon registration through the Racine declaration under Exhibit A. Having exercised the Registrar's discretion, I confirm that registration No. TMA823,762 is extant as of the date of this decision.

[12] The Opponent having met its initial evidential burden with respect to this ground, the Applicant must now establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's relied upon trademark.

Test for confusion

[13] The test to determine the issue of 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. Therefore, section 6(2) of the Act does not concern confusion of the trademarks themselves, but confusion of the goods or services from one source as being from another.

[14] In making such an assessment, the Registrar must have regard to all the relevant surrounding circumstances, including those listed in section 6(5) of the Act, namely: the inherent distinctiveness of the trademarks and the extent to which the trademarks 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. These factors are not exhaustive and different weight will be given to each one in a context-specific assessment [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at para 49, where the Supreme Court of Canada indicated that the resemblance between the trademarks will often have the greatest effect on the confusion analysis.

Inherent distinctiveness and extent known

[15] The trademarks at hand possess a similarly low degree of inherent distinctiveness notwithstanding their respective inclusion of stylization and additional elements. Both are in my view dominantly comprised of the letter P, albeit stylized. The solid circle bordered by a ring of dots design in the Mark does little for its distinctiveness as a whole, as does the term

PUMPERNICKEL’S which I find could be suggestive in relation to the Applicant’s food related services arguably implying that bread or baking may somehow be involved [see for example the online dictionary definitions of the word PUMPERNICKEL from *Collins English Dictionary*, *Merriam-Webster* and *Larousse* reproduced in Schedule B to this decision; and see *Borden Ladner Gervais v CIBC Mellon Global Securities Services Co* (2004), 34 CPR (4th) 571 at 573 (TMOB) and *Tradall SA v Devil’s Martini Inc*, 2011 TMOB 65 re the Registrar’s discretion to take judicial notice of dictionary definitions and consult others than those provided by the parties].

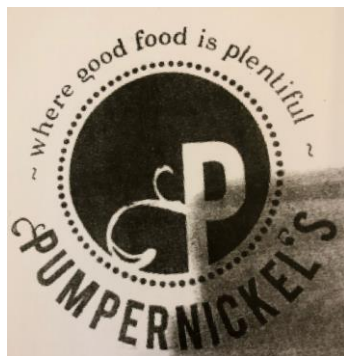
[16] As the strength of a trademark may be increased by it becoming known through promotion or use, I will now consider the extent to which the marks have become known in Canada.

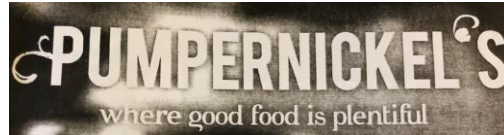
[17] The Applicant’s evidence regarding use and promotion of its trademarks — including the Mark — in Canada is comprised of the Ziv affidavit, the most salient portions of which are outlined below.

- The Applicant, along with its predecessor-in-title Pumpernickel’s European Style Sandwiches Ltd., which Mr. Ziv is asserted to have also founded and operated, along with franchisees and licensees (collectively the Pumpernickel’s Companies) have been operating fast food 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. [para 2]
- Mr. Ziv asserts that the PUMPERNICKEL’S restaurants are predominately 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. [para 4]
- Mr. Ziv asserts that the first PUMPERNICKEL’S fast food restaurant commenced operations in 1986 in the food court at First Canadian Place, in downtown Toronto. He further asserts that the daily customer traffic at this location “is very substantial”, “is [in]

one of the busiest office buildings in Canada, with tens of thousands of people working at, or visiting the building, on a daily basis”. [para 3]

- At the date of his affidavit, Mr. Ziv asserts that the Pumpernickel’s Companies operated 16 PUMPERNICKEL’S locations, all in and around the greater Toronto area, eleven having opened between 1986-2013 and five having opened between 2016-2019. Mr. Ziv also indicates that there had been another PUMPERNICKEL’S outlet which operated in Toronto “from about 2000 until its closing in December of 2013”. [para 6]
- Since adopting the Mark in November 2014, Mr. Ziv asserts that the Pumpernickel’s Companies have used the Mark in all manner of marketing and promotional materials, including but not limited to displaying the Mark on both plastic and paper take-out and delivery bags, on wax paper sleeve style bags for sandwiches and pastries, on napkins, paper coffee cups, catering boxes, sandwich wrappers, on shirts worn by serving staff at PUMPERNICKEL’S locations, on delivery trucks, on both hard copy and downloadable catering menus, on the Applicant’s website, and on signage in the fast food restaurant locations. Mr. Ziv indicates that the materials shown in Exhibits 4-19 to his affidavit display all of the above-noted uses of the Mark since November 2014 and are representative of the manner in which the Mark has been used by the Pumpernickel’s Companies since at least November 2014. [paras 14, 31] I note that many of the exhibited materials do not show use of the Mark as applied for, but rather use of the word PUMPERNICKEL’S, of the Applicant’s P design alone without the word PUMPERNICKEL’S and of various combinations thereof other than the Mark, as per some of the examples below.





I however note that the Mark is displayed on some of the following materials depicted in the exhibits:

- Catering delivery cardboard boxes. [para 19, Exhibit 8]
- Wax paper sleeve style bags and paper coffee cups used at restaurant locations. [paras 20-21, Exhibits 9-10]
- Interior, exterior and menu board signage from PUMPERNICKEL'S restaurants. Mr. Ziv attests that the photographs are representative of how the Mark is displayed at all PUMPERNICKEL'S locations and how it has been used in these locations since November 2014. [paras 27-28, Exhibits 16-17]
- Copy of the main page of the Applicant's website at *www.pumpernickels.ca*. Mr. Ziv asserts that the website is used to advertise the Applicant's products, fast food restaurant and catering services and that, since at least as early as November 2014, the Mark has been displayed at the bottom of each page of this website. [para 30, Exhibit 19] The Mark is indeed displayed in the footer of the webpage included as Exhibit 19. However, I note that the trademark displayed in the footer of the webpage included as Exhibit 16 — also from the Applicant's website — is rather a variation of the Mark without its solid circle bordered by a ring of dots design.

- Mr. Ziv asserts that the approximate sales of the Pumpnickel’s Companies, including both their restaurants and catering services, between 2012-2018 has been: \$11.6M in 2012, \$12.8M in 2013, \$13.9M in 2014, \$15.7M in 2015, and \$17.2M in 2016, \$19.8M in 2017 and \$22.94M in 2018. [para 32]
- Mr. Ziv further asserts that the approximate advertising expenses by the Pumpnickel’s Companies, to promote the “Pumpnickel’s brand” between 2012-2018, which expenses include but are not limited to operating the Applicant’s website, creation and distribution of catering brochures, media advertising, and packaging, bags, napkins, and other materials displaying the Mark, are as follows: \$173,500 in 2012, \$126,716 in 2013, \$206,788 in 2014, \$201,073 in 2015, \$320,917 in 2016, \$281,001 in 2017, and \$377,370 in 2018. [para 33]

[18] As for the Opponent, its evidence in this regard is comprised of the Racine declaration, the most salient portions of which are outlined below.

- Mr. Racine asserts that the Opponent has used the P DESSIN trademark in association with its registered services (listed in Schedule A below) since at least as early as October 2010. [para 3] He also asserts that the P DESSIN trademark was used in Canada in association with the registered goods (10) and (11) — *i.e.* caramelized almonds, meats and delicatessen meats — since at least as early as September 2010 and confirms use in Canada in association with all of the remaining registered goods of the Opponent, for which a declaration of use was filed on April 23, 2012. [paras 11-14]
- Mr. Racine asserts that, at the date of his declaration, the Opponent, by itself or through franchisees and licensees, operated 26 bakery, pastry, deli, ready-to-eat, gourmet food, chocolate, preserves and confectionery shops — collectively referred to as Bakeries (“*Boulangeries*”) throughout his declaration — in association with the P DESSIN trademark. Mr. Racine asserts that 24 of these Bakeries are located in the Montreal area, one is in Quebec City and one is in the province of Ontario (Ottawa). He also states that several of these Bakeries have a sit-down “Café bistro” section and that several of them

have offered a catering service since well before (“*bien avant*”) November 2014.
[paras 4-6, Exhibit B]

- To show the manner in which the Opponent’s P DESSIN trademark is used in association with the Opponent’s registered goods and services, Mr. Racine provides the exhibits described below. I note that this trademark is displayed on its own throughout some of the exhibited materials, but also appears above or next to the words PREMIÈRE MOISSON on a number of items depicted therein. Nevertheless, in my view, use of this combination amounts to use of the Opponent’s P DESSIN trademark *per se*, as I find that the Opponent’s stylized P design sufficiently stands out to create a distinct impression apart from the words PREMIÈRE MOISSON (be they stylized or not) [per *Registrar of Trade-marks v Compagnie Internationale pour l’informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA); and *Nightingale Interloc v Prodesign* (1984), 2 CPR (3d) 535 (TMOB)].
 - Photographs of Bakeries’ storefronts displaying the Opponent’s P DESSIN trademark. Mr. Racine asserts that each of the four locations showcased therein began displaying the Opponent’s mark at some point between January 14, 2013 (Kirkland location) and April 2014 (Masson street location in Montreal). [paras 8-9, Exhibit C]
 - A postcard proof with two coupons redeemable in the Longueuil and Greenfield Park Bakeries, which Mr. Racine states was sent to print in October 2010 and subsequently mailed out to promote the Opponent’s goods and Bakeries. [Exhibit D]
 - The cover page of a 2010 Christmas brochure, which Mr. Racine states was mailed out in November 2010 to promote the Opponent’s goods and Bakeries. [Exhibit E]
 - A photograph of a paper napkin displaying the Opponent’s P DESSIN trademark. Mr. Racine states that over 25M such napkins have been provided to clients in Bakeries since 2011. [Exhibit F]
 - Photographs of interior signage at the Quebec City and Masson street Bakeries. [Exhibits G, H]

- Photographs of product labels, packages, cards, signs and reusable shopping bags, displaying, amongst other things, the Opponent’s P DESSIN trademark; as well as photographs showing how some products bearing the Opponent’s P DESSIN trademark are displayed on shelves or counters at its Bakeries. Mr. Racine states that these photographs are representative of the manner in which the Opponent’s goods have been commercialized in its Bakeries since well before (“*bien avant*”) November 2014. [para 14, Exhibit I]
- Printouts from the Opponent’s website at *www.premieremoisson.com*, as well as traffic statistics for this website between January 1, 2012 and December 31, 2017. The printouts include excerpts from the “Products” and “Catering” sections of the Opponent’s website. Mr. Racine states that the goods depicted therein were advertised for sale (“*annoncés en vente*”) on this website since at least January 2011 with respect to those appearing on the exhibited “Products” pages, and since well before (“*bien avant*”) November 2014 with respect to those appearing on the exhibited “Catering” pages. It is not clear however whether, or how, the Opponent’s P DESSIN trademark was displayed on this site and on the Opponent’s goods advertised thereon since the stated times. The website traffic report for its part indicates over 1.7M visitors and over 13M page views for the captured period. [paras 15-18, Exhibits J-M]
- Mr. Racine asserts that, since fiscal 2017-2018, sales of goods in Bakeries have exceeded \$70M per fiscal year. [para 19]
- Mr. Racine further asserts that, since fiscal 2017-2018, the Opponent has expended over \$1M per fiscal year on promoting its Bakeries and the goods sold therein through media placement alone, and that total promotional expenditures with respect to the brand and goods have exceeded \$2M. [para 20]

[19] To summarize, with respect to the Opponent’s P DESSIN trademark, Mr. Racine asserts that it has been used in association with the Opponent’s registered services since at least as early as October 2010. There is evidence showing the Opponent’s P DESSIN trademark on postcard coupons sent to print in October 2010 and subsequently mailed out, on a 2010 Christmas brochure mailed out in November 2010 as well as on paper napkins available in Bakeries

since 2011. There is also evidence of Bakeries' storefronts displaying the Opponent's P DESSIN trademark since at least as early as January 2013 at one location, with three others following suit by April 2014. With respect to sales and advertising, sales of goods in the Opponent's Bakeries have exceeded \$70M in fiscal 2017-2018 alone and at least \$1M was expended promoting the Opponent's Bakeries and the goods sold therein during the same period.

[20] The Opponent's figures are not broken down for the different goods/services covered by its registration or for the trademark being relied upon versus the Opponent's PREMIÈRE MOISSON brand. Similarly, with respect to the Mark, none of the figures provided by Mr. Ziv are broken down per trademark used and illustrated in my review of his evidence above. Nevertheless, the Applicant's evidence establishes that some of the Applicant's storefront and in-store signage includes the Mark, as do some of its marketing and promotional materials (see for example Ziv affidavit, Exhibit 8 at pages 1 and 2; Exhibit 9 at page 1; Exhibit 10 at page 1; Exhibit 17 at pages 4, 6 and 9-11) and Mr. Ziv attests that such evidence is representative of the Mark's use since at least November 2014.

[21] Despite the shortcomings in both parties' evidence, based on a fair review of the whole of it, I am prepared to accept that the Opponent's P DESSIN trademark has been used since October 2010 in Quebec at least in association with its operation of Bakeries services and has become known to some extent in association with such services, mainly in this province. I am also prepared to accept that the Mark has been used since November 2014 in and around the Toronto area in Ontario in association with the Applicant's fast food restaurant services and has therefore become known to at least some extent in association with such services, mainly in this province.

[22] In the end, the evidence of use and therefore the extent to which the Opponent's P DESSIN trademark has become known is slightly greater. Accordingly, I find that the overall assessment of the section 6(5)(a) factor favours the Opponent.

Time in use

[23] As per the above, the Opponent's P DESSIN trademark has been used for a greater length of time. Accordingly, the section 6(5)(b) factor favours the Opponent.

Goods, services, businesses and trade

[24] The Applicant, in its written representations, conceded that the factors in sections 6(5)(c) and (d) are somewhat similar in respect of the parties' services and that both parties provide services which relate to the food industry, namely bakeries, delicatessens, grocery stores and bistros for the Opponent, and fast food style restaurants for the Applicant [Applicant's written argument at para 10.1.24].

[25] In my view, there is overlap between the nature of the parties' services and trades. Based on the evidence reviewed above, I note that there is also overlap between the goods sold in the Applicant's fast food restaurants and some of those sold in the Opponent's Bakeries. Further, while the parties generally appear to operate in different provinces, the Applicant is applying for registered exclusive rights across Canada and neither statement of goods or services covered by the marks at issue contains a territorial limitation. What is more, the likelihood of confusion assessment under section 6(2) of the Act must consider the circumstances if the two marks were to be used in the same geographic area [*Masterpiece, supra*, at paras 28-30]. Accordingly, overall the sections 6(5)(c) and (d) factors also favour the Opponent.

Degree of resemblance

[26] In essence, the Applicant submits that:

- The particularly striking or unique component of the Mark is the word PUMPERNICKEL'S — which is also the Applicant's brand name, has been separately registered as a word mark, has been used as such for over 30 years, is the main word in the Applicant's corporate name Pumpernickel's Franchise Corporation — considering the length of this word (14 letters or symbols including the apostrophe), the fact that it is displayed in capital letters, and its positioning at the top of the Mark, above the letter P;
- There are several other additional differences between the trademarks, including their typefaces (only one of which is shown with serifs); their stylization (being a sprouting chick pea which emanates from the left of the letter P in the Applicant's Mark as opposed to a sheaf of wheat or tendril emanating from the lower right side of the P in the

Opponent's trademark); and their backgrounds (being a black or dark circle as well as a continuous row of black dots which form an outer circle around the dark circular background in the Applicant's Mark and being empty in the Opponent's trademark);

- Letter marks in themselves are weak, so even the smaller differences become more important, particularly when there are several such differences which cumulatively create a different overall impression than that provided by the Opponent's trademark.

[27] The Opponent for its part submits that the dominant element of both trademarks is the letter P; that the stylized renditions of this letter in both trademarks are very similar; and that, visually and conceptually, the ideas suggested by both trademarks are similar seen that they both feature the letter P sprouting short curving shoots. I agree.

[28] Notwithstanding the Applicant's submissions, and while the degree of inherent distinctiveness of the stylized letter P is low, in my view, it is nevertheless the most prominent element of both parties' trademarks. It follows that there is a fair degree of resemblance between the trademarks, despite the differences noted by the Applicant. Furthermore, to the extent that the word PUMPERNICKEL would be perceived as a type of bread, its presence in the Mark could arguably create an association with the Opponent's Bakeries, the Opponent's bakery goods and its breads in particular. Accordingly, I find that on balance, the section 6(5)(e) factor favours the Opponent.

Other surrounding circumstance – State of the register/marketplace

[29] As mentioned above, the Benmore affidavit introduces state of the register evidence. Such evidence is with respect to trademarks that include the letter P alone, or the letter P in combination with a word where the P is prominent and which entries cover food products in Nice classes 29, 30 or 31 and/or services including restaurants, cafes, bistros, bakeries, charcuteries, fast food outlets, grocery or convenience stores, and the like, in Nice classes 35, 42, or 43, and any section 9 marks. The search revealed some 114 trademark entries. A "Design Report" revealing the retrieved trademark entries and logo summaries related to Ms. Benmore's search are shown in Exhibit 1. A "Full Search Report" revealing further details of all trademarks falling

within parameters of her search are shown in Exhibit 2. [Benmore affidavit, paras 3-6, Exhibits 1 and 2]

[30] The Applicant submits that Ms. Benmore's evidence establishes that the register contains a substantial number of marks which contain the letter P in association with food related goods and for food related services which include restaurants, fast food outlets, cafes, bistros, bakeries and the like. The Applicant also submits that judicial notice of the register can likely be taken to establish that other letter marks are also often used as trademarks for goods and services, including those in the food related fields. In this last respect, it should be noted that the Registrar will not take judicial notice of the state of the register in order to assist an applicant in such a manner [*Molson Breweries, A Partnership v John Labatt Ltd/John Labatt Ltée* (1999), 3 CPR (4th) 543 at 552 (TMOB)].

[31] As regards the use of marks which contain the letter P in the marketplace, the Applicant essentially relies on Mr. Ziv's comments of Ms. Benmore's evidence [Ziv affidavit, paras 34-35]. As already indicated above, considering that Mr. Ziv's comments touch on issues that are ultimately for the Registrar to decide, they have been disregarded.

[32] Upon review of Ms. Benmore's evidence, I note that it includes many irrelevant results (such as the Mark, trademarks owned by the Opponent, a number of other formalized, searched, examined or opposed applications, as well as a few trademarks that cover completely unrelated goods/services). Nevertheless, in my view, Ms. Benmore's search results show that there is at least some co-existence on the trademarks register of third party trademarks composed of or comprising a stylized letter P in association with services similar to those of the parties. However, the Applicant's evidence is devoid of information as to the extent of any third party use. Further, and more importantly, I do not find that any of the third party marks located by Ms. Benmore so nearly resemble the Opponent's P DESSIN trademark as does the Mark. Accordingly, this is a surrounding circumstance which favours the Applicant, but only slightly.

Other surrounding circumstance – No instances of actual confusion

[33] The Applicant submits that a further surrounding circumstance to be considered is the fact that no instances of actual confusion have been put into evidence.

[34] More specifically, relying on Mr. Ziv's assertion that he is unaware of any instances of actual confusion between the marks at issue having been reported [Ziv affidavit, para 38], the Applicant submits that since November 2014 both marks have co-existed in the marketplace, that the respective sales figures of the parties are in the millions of dollars each year, that the respective advertising figures are likewise substantial, and that the lack of any evidence of actual confusion is telling and must be given at least some weight, which factor favors the Applicant.

[35] Notwithstanding the Applicant's submissions, considering that the parties have predominantly carried out their activities in different geographical areas, I find the lack of evidence of actual confusion to be of no significance in the instant case.

Other surrounding circumstance – Applicant's prior registration

[36] The Ziv affidavit includes particulars of the Applicant's trademark registration No. TMA963,518 for PUMPERNICKEL'S. The Applicant submits that this trademark covers similar services as applied for herein, was shown to have been used by the Applicant for its restaurant and fast food outlets and related services for over 30 years, and is presumed to be distinctive by virtue of its registration as well as substantial and longstanding use. As such, and considering the existence of that word in the subject Mark, the Applicant contends that this is an additional surrounding circumstance that cannot be ignored.

[37] It is well established that section 19 of the Act does not give the owner of a registration the automatic right to obtain any further registrations no matter how closely they may be related to the original registration [*Coronet-Werke Heinrich Schlerf GmbH v Produits Menagers Coronet Inc* (1984), 4 CPR (3d) 108 at 115 (TMOB); *Groupe Lavo Inc v Proctor & Gamble Inc* (1990), 32 CPR (3d) 533 at 538 (TMOB)].

[38] That being said, use of a prior registered trademark in Canada may be a relevant surrounding circumstance that decreases the likelihood of confusion [*Caesarstone Sdot-Yam Ltd v Ceramiche Caesar SPA*, 2016 FC 895]. I note that the Applicant's applied-for services here are nearly identical to the ones covered by its existing registration. I also note that the Applicant has established at least some use of the trademark PUMPERNICKEL'S in association with its fast food restaurant services. However, while the Applicant's previously registered trademark is

comprised in the Mark in its entirety, I remain of the view that PUMPERNICKEL'S is not the Mark's most striking feature and there is virtually no degree of resemblance between the registered trademark PUMPERNICKEL'S and the Opponent's P DESSIN trademark. Accordingly, this is a surrounding circumstance which favours the Applicant, but only slightly at best.

Conclusion on likelihood of confusion

[39] Having considered all the surrounding circumstances and, in particular, the resemblance between the marks, the fact that the Opponent has been using its trademark for a greater length of time and that said mark has become known to a slightly greater extent in Canada, the similarity in the parties' services and trades, and notwithstanding the existence of some state of the register evidence of third party marks for similar services composed of or comprising a stylized letter P and of the Applicant's prior registration and use of its trademark PUMPERNICKEL'S, I find that the Applicant has failed to establish, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's P DESSIN trademark.

[40] Accordingly, the section 12(1)(d) ground of opposition succeeds.

SECTION 16(1)(A) – NON-ENTITLEMENT BASED ON PRIOR TRADEMARK USE

[41] The Opponent pleads that the Applicant is not the person entitled to registration pursuant to section 16(1)(a) of the Act, because the Mark is confusing with the Opponent's P DESSIN trademark previously used in Canada in association with its goods and services set out in Schedule A below.

[42] To succeed with respect to this ground, the Opponent has to show that its relied upon trademark had been used in Canada as of November 30, 2014, and had not been abandoned as of January 31, 2018 [section 16(5) of the Act]. As per my summary above, based on a fair review of the whole of Mr. Racine's evidence, I am satisfied that that the Opponent has met this burden. In my view, the difference in material dates here does not favour the Applicant enough so as to definitively tip the balance of probabilities in its favour. At best for the Applicant, due to the lesser extent to which the Opponent's relied upon trademark was known as of the relevant date, I

find that the probability of confusion between the Mark and the Opponent's P DESSIN trademark is evenly balanced between a finding of confusion and of no confusion. As the onus is on the Applicant to show, on a balance of probabilities, that there is no reasonable likelihood of confusion, I must find against the Applicant.

[43] Accordingly, the section 16(1)(a) ground of opposition also succeeds.

SECTION 2 – NON-DISTINCTIVENESS

[44] Considering that I have already refused the application under two grounds, I will not address the remaining ground of opposition based upon non-distinctiveness.


DISPOSITION

[45] Having regard to all of 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.

Iana Alexova
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

The Opponent's P DESSIN trademark

Trademark	Registration No.	Goods / Services
<p>P DESSIN</p> 	TMA823,762	<p>Goods</p> <p>(1) Pâtisseries, viennoiseries, biscuits, tartes et pains, frais ou congelés.</p> <p>(2) Fromages.</p> <p>(3) Bouillons et soupes.</p> <p>(4) Poissons et fruits de mer.</p> <p>(5) Mets préparés frais et mets préparés congelés, salades, sandwichs, pizza, amuse-gueules.</p> <p>(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.</p> <p>(7) Chocolats, confiseries, nommément, confiseries au chocolat, aux amandes, aux arachides, glacées et sucrées.</p> <p>(8) Articles ménagers, nommément, sacs (général), sacs d'épicerie, serviettes de table, tasses à boire.</p> <p>(9) Certificats-cadeaux et cartes fidélité [<i>sic</i>].</p> <p>(10) Amandes caramélisées.</p> <p>(11) Viandes et charcuteries.</p> <p>Services</p> <p>(1) Services d'opération d'un magasin d'alimentation gastronomique, charcuterie, épicerie, pâtisserie, boulangerie, prêt à manger, conserves et confiserie.</p> <p>(2) Café bistrot.</p> <p>(3) Services de traiteur.</p>
Claims		
<p>Employée au Canada depuis au moins aussi tôt que septembre 2010 en liaison avec les produits (10), (11).</p> <p>Déclaration d'emploi déposée 23 avril 2012 en liaison avec les produits (1), (2), (3), (4), (5), (6), (7), (8), (9) et en liaison avec les services.</p>		

SCHEDULE B

Definitions of the word PUMPERNICKEL

Collins English Dictionary

- Pumpernickel is a dark brown, heavy bread, which is eaten especially in Germany.
- A slightly sour black bread, originating in Germany, made of coarse rye flour.

Merriam-Webster

- A dark coarse sourdough bread made of unbolted rye flour.

Larousse

- *Pain noir de seigle, complet, d'origine westphalienne.*

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

No hearing held

Agents of record

Norton Rose Fulbright Canada LLP

For the Opponent

Sheldon S. Lazarovitz

For the Applicant