



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2022 TMOB 075**

**Date of Decision: 2022-04-21**

**IN THE MATTER OF AN OPPOSITION**

**Puratos N.V.**

**Opponent**

**and**

**Satin Fine Foods, Inc.**

**Applicant**

**1,764,541 for Satin Ice & Design**

**Application**

INTRODUCTION

[1] Puratos N.V. (the Opponent) opposes registration of the trademark Satin Ice & Design, depicted below (the Mark), which is the subject of application No. 1,764,541 by Satin Fine Foods, Inc. (the Applicant).



[2] The application is based on proposed use of the Mark in association with the following goods (the Goods):

Fondants, icing, cake icing, buttercream icing, icing mixes, icing sugar, cake frosting, edible decorations for cakes.

[3] The opposition is primarily based on allegations that the Mark is confusing with the Opponent's trademark SATIN associated with bakery and pastry products.

[4] For the reasons that follow, the application is refused.

#### THE RECORD

[5] The application filed on January 22, 2016 claims the priority of a corresponding application filed on January 7, 2016 in the United States.

[6] The application was advertised in the *Trademarks Journal* of December 6, 2017.

[7] The Opponent opposed the application on May 3, 2018, pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The Act was amended on June 17, 2019. All references to the Act are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act before it was amended (see section 70 of the Act).

[8] The grounds of opposition may be summarized as follows:

- the application does not comply with the requirements of sections 30(e) and 30(i) of the Act;
- the Applicant is not the person entitled to the registration of the Mark under section 16(3)(a) of the Act in view of confusion with the Opponent's trademark SATIN; and
- the Mark is not distinctive.

[9] The Applicant filed and served a counter statement denying the grounds of opposition.

[10] In support of its opposition, the Opponent filed the affidavit of Roel Straetmans, sworn September 18, 2018. Mr. Straetmans is the Group Legal and Tax Director of the Opponent. He was not cross-examined on his evidence.

[11] The Applicant elected not to file evidence.

[12] Both parties filed written representations. Only the Opponent attended a hearing.

## EVIDENTIARY BURDEN

[13] The legal onus is on the Applicant to show that the 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 Mark [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (CAF)].

## ANALYSIS OF THE GROUNDS OF OPPOSITION

### **Non-compliance with sections 30(e) and 30(i) of the Act**

[14] The grounds of opposition alleging that the application does not comply with sections 30(e) and 30(i) of the Act are summarily dismissed by reason of the Opponent's failure to meet its initial evidential burden.

[15] At the hearing, the Opponent acknowledged that there is no evidence with respect to the section 30(e) ground of opposition.

[16] With respect to the section 30(i) ground of opposition, this section of the Act requires an applicant to include a statement in the application that the applicant is satisfied that it is entitled to use the trademark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant's statement untrue, such as evidence of bad faith [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. There is no such evidence in this case.

### **Non-entitlement to registration under section 16(3)(a) of the Act**

[17] This ground of opposition alleges that the Applicant is not the person entitled to registration of the Mark since, at the filing date of the application and at any relevant date, the

Mark was confusing with the Opponent's trademark SATIN that has been previously used or made known in Canada in association with the following goods:

Products to improve the quality of bakery and pastry goods intended for industrial and artisanal use; preserved, dried and cooked fruit and vegetables; jellies, jams, compote; eggs, milk and dairy products; edible oils and fats; flour and cereal preparations, bread, bakery and pastry products, cake mixes, muffin-mixes, honey, treacle, yeast, baking-powder; and/or for the goods mentioned in the opposed Application, of the same nature or similar thereto.

[18] The material date for assessing this ground of opposition is the priority filing date claimed in the application [section 16(3)(a) of the Act].

[19] In order to meet its evidential burden under this ground of opposition, the Opponent must show that its trademark SATIN had been used or made known in Canada prior to January 7, 2016. Further, the Opponent must show that it had not abandoned the trademark SATIN at the date of advertisement of the application, namely December 6, 2017.

[20] I find the Opponent's evidence discussed below is sufficient to meet its burden to show prior use and non-abandonment of its trademark SATIN in Canada in association with bakery and pastry products.

[21] Thus, the issue becomes whether the Applicant has met its legal onus to establish, on a balance of probabilities, that there was no reasonable likelihood of confusion between the Mark and the Opponent's trademark SATIN as of January 7, 2016.

#### The test for confusion

[22] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act provides that 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. This test does not concern confusion of the trademarks themselves, but rather confusion as to whether the goods and services associated with each of the trademarks come from the same source.

[23] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time each trademark has been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks, including in appearance or sound or in the ideas suggested by them.

[24] 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; *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 states that section 6(5)(e) of the Act, the resemblance between the marks, will often have the greatest effect on the confusion analysis.

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

[25] The overall consideration of this factor involves a combination of inherent and acquired distinctiveness of the trademarks. The acquired distinctiveness of a mark refers to the extent to which it has become known.

[26] I find that both trademarks possess some measure of inherent distinctiveness, although that of the Mark in the context of the Goods is diminished by ICE (as a verb) meaning “spread or cover (a cake etc.) with icing” [see *The Canadian Oxford Dictionary* (2 ed)]. The design feature of the Mark does very little, if anything, to increase its inherent distinctiveness. The words SATIN ICE are the dominant part of the Mark and the fanciful script employed are intrinsic with the words [see *Canadian Jewish Review Ltd v The Registrar of Trade Marks* (1961), 37 CPR 89 (Ex Ct)].

[27] I have no evidence of the extent to which the Mark had become known in Canada as of January 7, 2016.

[28] As for the Opponent’s trademark, I start by briefly addressing the Applicant’s contention that the evidence does not establish use of the trademark SATIN, pursuant to section 4(1) of the Act, by the Opponent or use that accrues to its benefit.

[29] Based on a fair reading of Mr. Straetmans' affidavit as a whole, I am satisfied that it establishes use of the trademark SATIN in Canada by the Opponent in the normal course of trade since 1996 in association bakery and pastry products, pursuant to section 4(1) of the Act.

[30] Indeed, Mr. Straetmans provides the Opponent's Canadian sales figures of SATIN bakery and pastry products, a listing of some of the Opponent's Canadian clients, and photographs showing branding on the bakery and pastry products sold in Canada by the Opponent since at least as early as 1996 [paras 11-14, Exhibits A-3 to A-5].

[31] I acknowledge that Mr. Straetmans could have been more specific in explaining the role of Puratos Canada Inc. in the commercialization of the Opponent's bakery and pastry products in Canada, especially since its name appears on the technical data sheets included in Exhibit A-2. However, Mr. Straetmans clearly states in his affidavit that "any use of the [trademark] SATIN made by Puratos Canada Inc. is under the licence of [the Opponent] who is controlling, directly or indirectly the quality and character of the goods" associated with the trademark [para 6]. This sworn statement is sufficient to demonstrate the control required by section 50(1) of the Act for the Opponent to benefit from the use of the trademark by Puratos Canada Inc., as the case may be [per *Empresa Cubana del Tabaco v Shapiro Cohen*, 2011 FC 102, at para 84].

[32] As regards to the extent to which the Opponent's trademark has become known, I note the following evidence provided by Mr. Straetmans:

- For the years 2011-2015, the Opponent's sales of branded bakery and pastry products totalled over \$8.357 million (plus approximate sales of \$2.476 million for the year 2016, and \$2.050 million for the year 2017) [paras 12-13];
- Since 2011, the Opponent has spent approximately \$3,000 annually to promote its branded bakery and pastry products in Canada [paras 15-16, Exhibit A-6].

[33] In the end, I am satisfied that the Opponent's evidence allows me to conclude that the Opponent's trademark SATIN had become significantly known in Canada as of January 7, 2016.

[34] Accordingly, the consideration of this factor favours the Opponent.

*The length of time the trademarks have been in use*

[35] As discussed above, the evidence satisfactorily establishes use of the Opponent's trademark in Canada since 1996. Thus, this factor favours the Opponent.

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

[36] As a first matter, I note that Mr. Straetmans states that the bakery and pastry products associated with the Opponent's trademark in Canada consist of pastry mixes, pastry dough and pastry dough mixes, cake mixes, muffin-mixes, yeast, and baking powder [para 8].

[37] Thus, although the parties' respective goods are not identical, there is obviously an overlap between the Applicant's Goods and the Opponent's bakery and pastry products.

[38] As regards to the nature of the trade, Mr. Straetmans explains that the Opponent offers a full range of innovative products, raw materials and application expertise to the bakery, patisserie and chocolate sectors [para 5]. Therefore, I disagree with the Applicant's argument that the Opponent has failed to provide evidence detailing the nature of its business.

[39] Furthermore, while Mr. Straetmans could have been more specific with respect to the Opponent's channels of trade, I have no evidence to suggest differences between the parties' likely channels of trade. Thus, considering the overlap between the parties' goods, I find it reasonable to conclude that there is a potential overlap in their channels of trade.

[40] Accordingly, these factors favour the Opponent.

*The degree of resemblance between the trademarks in appearance or sound or in the ideas suggested*

[41] As noted above, the degree of resemblance between the trademarks is often the most significant factor in the confusion analysis. When considering the degree of resemblance, it is preferable to first consider whether there is an aspect of the trademark that is "particularly striking or unique" [*Masterpiece*, above, at para 64].

[42] The Opponent's trademark SATIN is comprised of a single striking element.

[43] The Mark is a composite mark featuring the dominant words SATIN and ICE inside two ellipses, with one dark ellipse inside the other. I consider that the most striking aspect of the Mark is the word SATIN since ICE is descriptive in the context of the Goods.

[44] Notwithstanding the design feature of the Mark, the trademarks have a significant degree of resemblance in appearance due to the shared component SATIN. Likewise, their shared component SATIN results in a significant degree of resemblance in sound.

[45] Finally, the only idea suggested by the Opponent's trademark is a smooth, glossy fabric. The Mark in the context of its associated Goods suggests the idea of dessert icing products which impart a satin surface finish. Thus, there is a certain overlap between the ideas suggested by the trademarks owing to their shared component SATIN.

[46] Accordingly, the degree of resemblance factor favours the Opponent.

#### Conclusion - Likelihood of confusion

[47] Having considered all of the surrounding circumstances of this case, I conclude that the Applicant has not discharged its legal onus to show, on a balance of probabilities, that there was no reasonable likelihood of confusion between the Mark and the Opponent's trademark SATIN, as of January 7, 2016.

[48] Accordingly, the section 16(3)(a) ground of opposition is successful.

#### **Non-distinctiveness under section 2 of the Act.**

[49] The Opponent pleads that the Mark is not distinctive nor is it adapted to distinguish the Applicant's Goods from the goods of the Opponent.

[50] The material date for assessing the distinctiveness of the Mark is the filing date of the statement of opposition, namely May 3, 2018.

[51] In order to meet its evidential burden in support of the non-distinctiveness ground of opposition, the Opponent must show that its trademark, as of May 3, 2018, was known to some extent at least and its reputation in Canada was substantial, significant or sufficient [*Motel 6, Inc*



*v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FCTD)].

[52] In view of the evidence discussed above, I am satisfied that the Opponent has met its initial evidential burden under this ground of opposition. Furthermore, the difference in the material date under this ground of opposition does not materially affect my findings under the section 16(3)(a) ground of opposition.

[53] Therefore, in view of the likelihood of confusion between the Mark and the Opponent's trademark SATIN, I conclude that the Applicant has not discharged its legal onus to show, on a balance of probabilities, that the Mark was distinctive as of May 3, 2018.

[54] Accordingly, the distinctiveness ground of opposition is successful.

#### DISPOSITION

[55] 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.

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Céline Tremblay  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

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

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**HEARING DATE** 2022-04-13

**APPEARANCES**

Barry Gamache	For the Opponent
No one appearing	For the Applicant

**AGENTS OF RECORD**

ROBIC	For the Opponent
JENSEN IP	For the Applicant