

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 088

Date of Decision: 2022-04-27

IN THE MATTER OF AN OPPOSITION

**La Espanola Alimentaria Alcoyana, S.A.
and Aceitunas La Española S.L.**

Opponents

and

Aceites del Sur-Coosur, S.A.

Applicant

1,682,175 for LA ESPAÑOLA & Design

Application

INTRODUCTION

[1] La Espanola Alimentaria Alcoyana, S.A. and Aceitunas La Española S.L. (collectively, the Opponent) oppose registration of the trademark LA ESPAÑOLA & Design (the Mark), which is the subject of application No. 1,682,175 by Aceites del Sur-Coosur, S.A. (the Applicant). The Mark is shown below:



[2] The Mark is applied for on the basis of proposed use in Canada in association with “Olive oil”.

[3] The opposition is primarily based on an allegation that the Mark is confusing with the Opponent's LA ESPAÑOLA trademarks, previously registered and used in Canada in association with olive products.

THE RECORD

[4] The application for the Mark was filed on June 20, 2014. The application includes the following foreign character translation:

As per the applicant, LA ESPAÑOLA may be translated as the noun "The Spanish Woman". However, "ESPAÑOLA" is also an adjective meaning "Spanish" (for example, "la marina Española" could also mean "in the Spanish Navy").

[5] The application was advertised for opposition purposes on April 20, 2016. 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 September 20, 2016, La Espanola Alimentaria Alcoyana, S.A. opposed the application by filing a statement of opposition under section 38 of the Act. The Applicant filed a counter statement denying the grounds of opposition. The statement of opposition was subsequently amended to add Aceitunas La Española S.L. as a joint opponent, and the Applicant filed an amended counter statement accordingly.

[7] At the evidence stage of the proceeding, the Opponent filed another amended statement of opposition, which was made of record, and the Applicant filed a final amended counter statement accordingly.

[8] As set out in the final amended statement of opposition, the grounds of opposition are based on non-compliance with sections 30(b), 30(e) and 30(i) of the Act; non-registrability under section 12(1)(d) of the Act; non-entitlement under section 16 of the Act; and non-distinctiveness under section 2 of the Act.

[9] In support of its opposition, the Opponent filed the following evidence:

- Affidavit of Ignacio Alberola Jorda, sworn on March 14, 2017 in Spain (the First Jorda Affidavit);
- Affidavit of Ignacio Alberola Jorda, sworn on September 20, 2017 in London, the United Kingdom (the Jorda Affidavit), submitted as leave evidence – the Jorda Affidavit is substantively similar to the First Jorda Affidavit sworn in Spain, but was submitted in response to alleged deficiencies raised by the Applicant;
- Affidavit of Mary P. Noonan, sworn on March 14, 2017 in Toronto (the First Noonan Affidavit);
- Affidavit of Georgi Paskalev, sworn on March 14, 2017 in Montreal (the Paskalev Affidavit);
- Affidavit of June Ye, sworn on August 16, 2017 (the Ye Affidavit), submitted as leave evidence;
- Affidavit of Mary P. Noonan, sworn on August 16, 2019 in Toronto (the Second Noonan Affidavit), submitted as reply evidence;
- Certified copies of registration Nos. TMA614,458 (expunged in 2018) and TMA683,041, and application No. 1,811,946.

[10] The record also includes a “supplemental” affidavit of Mr. Jorda, two “Acta de Manifestacions”, and the affidavit of Anna Antonetti, a legal assistant employed by the Opponent’s agent. These documents were submitted due to issues with and alleged deficiencies in the First Jorda Affidavit. As the Jorda Affidavit, sworn in the United Kingdom, is substantively similar to the First Jorda Affidavit, it is not necessary to consider these documents further.

[11] None of the Opponent’s deponents were cross-examined.

[12] In support of its application, the Applicant filed the following evidence:

- Affidavit of Sergio Anton Garcia, sworn on July 23, 2018 (the Garcia Affidavit); and

- Affidavit of Tania Treciokas, sworn on July 30, 2018 (the Treciokas Affidavit).

[13] Both of the Applicant's deponents were cross-examined and the cross-examination transcripts and undertakings were made of record.

[14] Following the cross-examination of Mr. Garcia, the Applicant submitted as leave evidence a second affidavit of Sergio Anton Garcia, sworn on July 15, 2019 (the Second Garcia Affidavit). Mr. Garcia was not cross-examined on his second affidavit.

[15] Both parties submitted written representations. An oral hearing was scheduled but cancelled by request and on consent of the parties.

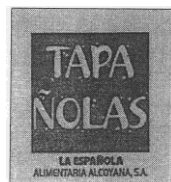
OVERVIEW OF THE OPPONENT'S EVIDENCE

[16] Aceitunas La Espanola S.L. (ALE) is the owner of trademark registration No. TMA683,041 for LA ESPAÑOLA (& Design) (the Opponent's Design Trademark), and is the successor-in-title to the joint opponent, La Espanola Alimentaria Alcoyana, S.A. (LEAA). The Opponent's Design Trademark has been registered since March 2007 in association with "Preserved olives of all kinds", and is shown below:



[17] I note the registration includes the following disclaimer text: "The right to the exclusive use of ESPAÑOLA is disclaimed apart from the trademark".

[18] The Opponent also owns two other LA ESPAÑOLA design trademarks, shown below:



TAPAÑOLAS Design



LA ESPAÑOLA Logo

[19] The TAPAHÑOLAS Design was the subject of registration No. TMA614,458, but was expunged in April 2018. The LA ESPAÑOLA Logo is the subject of pending application No. 1,811,946.

Jorda Affidavit

[20] Mr. Jorda is the Chief Executive Officer of LEAA [para 2], and is involved in overseeing the operations of ALE [para 3]. Throughout his affidavit, he refers to both companies, collectively, as “La Espanola” or the “Opponent” [para 4]. He states that the Opponent is a leading manufacturer and distributor of Spanish food products, specializing in production and sale of olive-based food products since 1941. He attests that the Opponent has “a long history” of selling olives and other food products in Canada, and more specifically that the Opponent has used the trademark LA ESPAÑOLA and various design marks incorporating this element in association with olives in Canada since at least as early as 1984 [paras 7 to 10]. The Jorda Affidavit details the following:

- The Opponent’s history and business, both worldwide and in Canada [paras 7 to 14, Exhibits 1 and 2];
- Identification of the Opponent’s LA ESPAÑOLA trademarks, including the Opponent’s Design Trademark, the LA ESPAÑOLA Logo and the unregistered word mark, LA ESPAÑOLA, used in Canada in association with “various food products, including olives, olive-based food products, and gazpacho” [paras 15 to 18, Exhibit 3];
- Products associated with the Opponent’s LA ESPAÑOLA trademarks, including products sold in Canada [paras 19 to 22, Exhibits 4 and 5];
- Sales of the Opponent’s LA ESPAÑOLA-branded products in the normal course of trade in Canada generally since 1984 and more specifically with volumes of sales since 2000 [paras 23 to 30, Exhibit 6];
- Promotion and advertising of the Opponent’s LA ESPAÑOLA-branded products through various media and the Internet, including in Canada [paras 31 to 38, Exhibits 2 and 7 to 11];

- Use and registration of the Opponent’s LA ESPAÑOLA trademarks in other jurisdictions [para 39, Exhibit 13]; and
- Two decisions in favour of the Opponent in other jurisdictions, where the Opponent opposed trademarks similar to the Mark [para 44, Exhibits 14 and 15].

[21] Mr. Jorda also notes the translation of LA ESPAÑOLA as meaning “Spanish woman”, and therefore opines that the design element of a woman in the Mark “simply serves to reinforce the similar meanings” of the Mark and the Opponent’s LA ESPAÑOLA trademarks [para 43].

First Noonan Affidavit

[22] Ms. Noonan is a trademark searcher employed by the Opponent’s agent [para 1]. The First Noonan Affidavit evidences searches of the Canadian Trademarks Database for trademark applications and registrations in Nice class 29 that contain the element LA ESPANOLA [para 3, Exhibit 1]. Also attached to the affidavit are the file histories for i) the Applicant’s trademark application No. 1,599,948 for the trademark LA ESPAÑOLA [Exhibit 2] and ii) the Opponent’s application No. 1,103,791 for the Opponent’s Design Trademark [Exhibit 3].

Second Noonan Affidavit

[23] The Second Noonan Affidavit evidences two documents. The first document is an April 7, 2008 Office Action from the United States Patent and Trademark Office (USPTO) relating to the Opponent’s trademark application No. 77/199,055 for the trademark LA ESPANOLA [Exhibit 1]. The second document is a Statistics Canada “Census in Brief” document released in August 2017 titled “Linguistic diversity and multilingualism in Canadian homes”, relating to the 2016 census [Exhibit 2].

Paskalev Affidavit

[24] Mr. Paskalev is employed by the Opponent’s agent. The Paskalev Affidavit evidences Mr. Paskalev’s attendance of various grocery stores in Montreal in March 2017 and his photographing and purchase of olive and olive-related food products, including various LA ESPAÑOLA-branded products [paras 2 to 10, Exhibits 1 to 13]. The affidavit also evidences a

page from Statistics Canada website, titled “Number of Canadians whose mother tongue is one of the 22 immigrant languages reported by more than 100,000 persons, Canada, 2011” [para 11, Exhibit 14].

Ye Affidavit

[25] Ms. Ye is a legal assistant employed by the Opponent’s agent [para 1]. The Ye Affidavit puts into record email communications between the parties regarding the cross-examination of the Applicant’s deponents [paras 3 and 4, Exhibits 1 and 2].

OVERVIEW OF THE APPLICANT’S EVIDENCE

Garcia Affidavit

[26] Mr. Garcia is the International Director of the Applicant. He states that the Applicant is a leading manufacturer and distributor of olive oil in Spain and throughout the world [para 3], and has produced and distributed olive oil under the LA ESPAÑOLA brand since 1840 [para 4], with exports to over 50 countries [para 5]. The Garcia Affidavit evidences the following:

- The history and corporate profile of the Applicant [paras 3 to 7];
- The use and reputation of the Applicant’s LA ESPAÑOLA brand worldwide [paras 8 to 11];
- Sales of LA ESPAÑOLA olive oil in Canada, including sales data since 2004 [paras 12 to 14, Exhibit 4];
- Details regarding purported co-existence of the parties’ LA ESPAÑOLA brands and trademarks in Canada and other jurisdictions [paras 16 to 18, Exhibits 5 and 6].

[27] Relevant portions of the cross-examination of Mr. Garcia will be discussed below. However, I note that the Second Garcia Affidavit clarifies answers Mr. Garcia gave during his cross-examination [Second Garcia Affidavit, paras 2 to 10]. In particular, Mr. Garcia confirms that the Mark was not used in Canada prior to the subject filing date, June 20, 2014 [para 10].

Treciokas Affidavit

[28] Ms. Treciokas is employed by the Applicant's agent [para 1]. Ms. Treciokas conducted various database and Internet searches between June and August 2016. The Treciokas Affidavit evidences the following:

- Particulars for the Opponent's Canadian trademark registration No. TMA683,041 for the Opponent's Design Trademark, noting the aforementioned disclaimer that states "The right to the exclusive use of ESPAÑOLA is disclaimed apart from the trade-mark" [para 2, Exhibit TT-1];
- Search results from the USPTO trademarks database [para 3, Exhibit TT-2], including application particulars and correspondence filed with the USPTO relating to the Opponent's application for the trademark LA ESPANOLA [paras 4 and 5, Exhibits TT-3 to TT-5];
- Search results from Statistics Canada's website, including an infographic titled "Immigrant languages in Canada" based on 2016 census data [para 6, Exhibit TT-6];
- A printout from Google Translate showing that "La Espanola" means "the Spanish" [para 7, Exhibit TT-7];
- Correspondence and representations relating to the section 45 expungement proceeding regarding the registration for the Opponent's Design Trademark [paras 8 to 10, Exhibits TT-8 and TT-9]; and
- Correspondence, representations and a decision relating to the Applicant's European Union Intellectual Property Office application No. 13047238 [paras 11 and 12, Exhibit TT-10].

EVIDENTIAL BURDEN AND LEGAL ONUS

[29] 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 (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.

[30] 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 it.

30(B) GROUND – NON-COMPLIANCE

[31] The Opponent pleads that the application contravenes section 30(b) of the Act because the Applicant has, in fact, used the Mark in Canada in association with “olive oil” from 2004 until at least 2014.

[32] The material date for this ground is the filing date of the application, namely, June 20, 2014.

[33] The Mark is applied for on the basis of proposed use in Canada. However, at paras 53 to 64 of its written representations, the Opponent argues that Mr. Garcia admits to use of the Mark in Canada prior to the filing date. In this respect, the Opponent notes that the Garcia Affidavit includes a table showing the Applicant’s sales of “LA ESPAÑOLA brand olive oil in Canada” between 2004 and 2014, as well as images of various olive oil bottles that Mr. Garcia attests the Applicant sells under its LA ESPAÑOLA brand [Garcia Affidavit at paras 10 and 14, Exhibit 2]. The Opponent then relies on certain exchanges during cross-examination where it appears that Mr. Garcia confirms that the Applicant’s Canadian olive oil sales included sales in association with the Mark.

[34] For its part, the Applicant submits that the Opponent is mischaracterizing Mr. Garcia’s statements, such that the Opponent is essentially conflating prior use of earlier *versions* of the Applicant’s LA ESPAÑOLA branding and trademark with that of the Mark [para 36].

[35] Indeed, although the Applicant appears to have used trademarks that are similar, I agree with the Applicant that the Mark was correctly applied for on the basis of proposed use in Canada [see Applicant's written representations at para 37]. In this respect, any ambiguity arising from the cross-examination was clarified in the Second Garcia affidavit, where Mr. Garcia clearly attests that the applied-for Mark was not used in Canada prior to June 20, 2014 [para 10].

[36] In view of the forgoing, I am satisfied that, on a balance of probabilities, the Applicant has demonstrated that the application complied with section 30(b) of the Act.

[37] Accordingly, the ground based on non-compliance with section 30(b) of the Act is rejected.

30(E) GROUND – NON-COMPLIANCE

[38] The Opponent pleads that the application contravenes the provisions of section 30(e) of the Act because the Applicant did not, as of the filing date of the application, have any intention of using the Mark in Canada in association with the applied-for goods, "olive oil".

[39] As no evidence was filed in support of this ground, the Opponent fails to meet its initial burden.

[40] Accordingly, the ground based on non-compliance with section 30(e) of the Act is rejected.

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

[41] The Opponent pleads that the Mark is not registrable because it is confusing with registration No. TMA683,041 for the Opponent's Design Trademark and registration No. TMA614,458 for the Opponent's TAPAÑOLAS Design, both reproduced above.

[42] The material date with respect to confusion with a registered trademark is the date of this decision [*Simmons Ltd v A to Z Comfort Beddings Ltd*, 1991 CarswellNat 1119 (FCA)]. As only the Opponent's Design Trademark is extant on the register, the Opponent meets its initial burden with respect to that trademark only.

[43] Accordingly, the Applicant must establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's Design Trademark.

Test to Determine Confusion

[44] 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.

[45] 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 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].

[46] In making such an assessment, all the relevant surrounding circumstances must be taken into consideration, 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 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.

[47] 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 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 degree of 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]. Given its importance, I will begin with the degree of resemblance between the parties’ trademarks.

Degree of Resemblance

[48] In its representations, the Opponent submits that the Mark and the Opponent’s LA ESPAÑOLA trademarks are not only identical in sound, but also in the ideas suggested by them, as they both convey the idea of a “Spanish woman” [para 96]. In this respect, it notes the evidenced definitions of LA ESPANOLA as well as the evidence suggesting that the ordinary purchasers of the parties’ food products likely understand Spanish [paras 94 and 95]. In the alternative, the Opponent submits that, whether or not the ordinary purchaser understands Spanish, the striking element of the parties’ trademark is the same, being the words LA ESPAÑOLA [paras 97 to 100].

[49] In its representations, the Applicant emphasizes the differences in the design elements of the parties’ trademarks [paras 87 to 90]. However, notwithstanding the disclaimer of ESPAÑOLA in the registration for the Opponent’s Design Trademark, I consider the striking element of the Opponent’s trademark to be the words LA ESPAÑOLA. As this striking element also appears in the Mark, there is a high degree of resemblance between the parties’ trademarks in appearance and especially in sound. I also agree with the Opponent that, regardless of whether the likely consumer of the parties’ products understands Spanish, the idea suggested by the parties’ trademarks would also be the same, given the common LA ESPAÑOLA element.

[50] Accordingly, this important factor favours the Opponent.

Inherent Distinctiveness and Extent Known

[51] In its written representations, the Opponent submits that its trademark is inherently distinctive, as LA ESPAÑOLA is not descriptive of the associated goods, whether these words are understood to mean “Spanish woman” or whether they are considered foreign words with no meaning [para 114]. With respect to the extent to which the Opponent’s Design Trademark has become known, it submits that the evidence shows sales, promotion and packaging of the Opponent’s LA ESPAÑOLA-branded olives and other food products in Canada since 2000 [para

104]. At this point, I note that the Jorda Affidavit tends to conflate the evidence with respect to the Opponent's LA ESPAÑOLA trademarks, with exhibited images of the Opponent's products sold in Canada largely displaying the LA ESPAÑOLA Logo rather than the Opponent's Design Trademark [Exhibits 4 and 5]. As such, while I accept Mr. Jorda's assertion that the Owner has used the Opponent's Design Trademark since 1984 [para 18], the extent to which it in particular has become known in Canada is unclear from the evidence.

[52] With respect to the Mark, the Opponent submits that, as the parties' trademarks convey the same idea, the Mark lacks inherent distinctiveness to differentiate it from the Opponent's LA ESPAÑOLA trademarks [para 115]. With respect to the extent the Mark has become known, it submits that the Applicant cannot rely on evidence of reputation abroad and that the Applicant's evidence otherwise shows sales limited to Ontario, noting a gap in supporting invoices between 2007 and 2012 [paras 104 and 105].

[53] In its written representations, the Applicant submits that the words LA ESPAÑOLA mean "the Spanish" and are highly suggestive of products that emanate from Spain. As such, it submits that these words alone do not possess a high degree of inherent distinctiveness [para 58]. It also notes that the Opponent has disclaimed the exclusive right to the use of the word ESPAÑOLA in its extant registration [para 62]. In view of this, the Applicant submits that the Mark possesses a higher degree of inherent distinctiveness than the Opponent's Design Trademark, given the unique design element of a woman holding a pitcher or urn [para 63].

[54] With respect to the extent the Mark has become known, the Applicant submits that the image of "a seated woman, in its various iterations, has become distinctive of the Applicant's olive oil products" [para 64]. In this respect, it submits that, although Canada "is not a significant market for the Applicant", sales in association with the Applicant's LA ESPAÑOLA brand have exceeded those of the Opponent [paras 73 to 75]. As such, the Applicant submits that, based on the evidenced volumes of sales, Canadian consumers "would have had equal if not greater exposure to the Applicant's LA ESPAÑOLA olive oil products" [para 76].

[55] In my view, with respect to the extent to which the specific trademarks at issue have become known, both parties' evidence is somewhat problematic. In this respect, the evidence and submissions largely address the parties' respective LA ESPAÑOLA brands and use of

similar trademarks, but not necessarily the Mark and the Opponent's Design Trademark clearly and specifically. In any event, to the extent that the use and extent known of the parties' brands more generally can be considered an additional surrounding circumstance, I do not consider such extent to obviously favour either party in this case.

[56] However, whether or not LA ESPAÑOLA is considered distinctive, any such distinctiveness is shared between the parties' trademarks with the Mark having a greater degree of inherent distinctiveness due to the additional woman design, as compared to the relatively simple frame and image of olives forming part of the Opponent's Design Trademark.

[57] Accordingly, overall, I find that this factor somewhat favours the Applicant.

Length of Time in Use

[58] Whereas the application for the Mark is based on proposed use – and the evidence shows subsequent use of the Mark as applied for – the registration for the Opponent's Design Trademark claims use in Canada since at least as early as 1984. Again, while the evidence of actual use could have been clearer, I accept Mr. Jorda's assertion that the Opponent has used its LA ESPAÑOLA trademarks, including the Opponent's Design Trademark, "in association with olives since at least as early as 1984" [para 18].

[59] Accordingly, this factor favours the Opponent.

Nature of the Goods or Business / Nature of the Trade

[60] When considering the nature of the goods of the parties in respect of the issue of confusion, it is the statements of goods 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)].

[61] In its representations, the Applicant submits that, while "in smaller specialty stores like the ones visited by the Opponents' Affiant, Mr. Pakalev, there may be overlap between olive products and olive oils due to limited shelf space", in most stores these products are displayed in separate sections [para 80]. The Applicant also notes that, in other jurisdictions, the Opponent

has often argued the *differences* between the parties' goods [paras 81 to 84]. In this respect, the Applicant submits that "canned olives may be differentiated from olive oil since the former is a specialty food, often served as an hors d'oeuvre" and the latter is a typical pantry item [para 83].

[62] However, whether or not the Opponent's arguments were successful elsewhere where the parties' positions were effectively reversed, it remains that the parties' goods are olives and products derived from olives and are sold in the same stores.

[63] As such, I agree with the Opponent that there is overlap in the nature of the parties' goods, businesses, and channels of trade.

[64] Accordingly, these factors favour the Opponent.

Additional Surrounding Circumstance(s)

[65] In its representations, the Applicant notes that the parties' trademarks co-exist on the trademark registers of several countries around the world [para 94]. It characterizes such co-existence as *significant*, and further notes that the parties' trademarks have co-existed in the Canadian marketplace without any evidence of actual consumer confusion [para 95]. The Applicant reiterates that the Opponent itself has argued that "there is no reasonable risk of confusion" between the parties' trademarks, such as during the prosecution of the Opponent's application for the word mark LA ESPANOLA before the USPTO [paras 96 to 99]. The Applicant submits that if, by the Opponent's own arguments, there has been a long period of co-existence in Spain, Europe and the United States with no instances of confusion, then it is reasonable to conclude that the risk of confusion is also low in Canada in light of the long period of co-existence between the parties' brands in the Canadian marketplace [para 100].

[66] While I agree that the foregoing may cumulatively amount to a surrounding circumstance in the Applicant's favour, I do not consider it to be significant or determinative in the overall assessment on the issue of confusion in this case. In this respect, the test for confusion contemplates the casual consumer with imperfect recollection – the average consumer would be unaware of the co-existence of the parties' trademarks in other jurisdictions and, in any event, the Supreme Court has confirmed that, in Canada, the degree of resemblance is the factor likely to have the greatest effect in deciding the issue of confusion.

Conclusion – Confusion with the Opponent’s Design Trademark

[67] Having considered all of the surrounding circumstances, I find that the Applicant has not met its legal burden to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the parties’ trademarks. I reach this conclusion mainly due to the resemblance between the parties’ trademarks and the overlap in the nature of the parties’ goods and trades, and notwithstanding the inherent distinctiveness of the Mark and the absence of evidence of actual confusion with respect to the parties’ brands.

[68] In view of the foregoing, the section 12(1)(d) ground of opposition based on confusion with the Opponent’s Design Trademark is successful.

16(3)(A) GROUND – CONFUSING WITH A PREVIOUSLY USED TRADEMARK

[69] The Opponent pleads that the Applicant is not the party entitled to registration of the Mark. In particular, the Opponent pleads that, at the date of filing of the application, the Mark was confusing with the Opponent’s LA ESPAÑOLA trademarks, which had been previously used in Canada in association with preserved olives of all kinds and gazpacho, which are the same or very similar to the applied-for goods.

[70] The material date with respect to this ground is the filing date of the application, being June 20, 2014.

[71] As noted above, I accept that the Opponent has demonstrated use of the Opponent’s LA ESPAÑOLA trademarks prior to June 2014, including the Opponent’s Design Trademark and the LA ESPAÑOLA Logo. As the Opponent meets its initial burden, the Applicant must establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and any of the Opponent’s LA ESPAÑOLA trademarks.

[72] Notwithstanding the earlier material date, I do not find my conclusions above with respect to the confusion analysis to substantially differ under this ground. Indeed, under this ground, I note in particular that the evidence regarding the extent to which the Opponent’s LA ESPAÑOLA Logo has become known is not as problematic as that with respect to the Opponent’s Design Trademark.

[73] As such, having considered all of the surrounding circumstances, I find that the Applicant has not met its legal onus to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the parties' trademarks. I reach this conclusion due to the resemblance between the parties' trademarks and the overlap in the nature of the parties' goods and trades, and notwithstanding the inherent distinctiveness of the Mark and the absence of evidence of actual confusion with respect to the parties' brands.

[74] Accordingly, the ground of opposition based on section 16(3)(a) of the Act is successful.

REMAINING GROUNDS OF OPPOSITION

[75] As the Opponent is successful under two grounds of opposition, I do not consider it necessary to address the remaining grounds of opposition, namely those based on sections 2 and 30(i) of the Act.

DISPOSITION

[76] 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 refuse the application.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
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