



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 100

Date of Decision: 2023-06-14

IN THE MATTER OF AN OPPOSITION

Opponent: Mondo Foods Co. Ltd.


Applicant: Lidl Stiftung & Co. Kg.

Application: 1,807,085 for VEMONDO

OVERVIEW

[1] Mondo Foods Co. Ltd. (the Opponent) opposes registration of the trademark VEMONDO (the Mark), which is the subject of application No. 1,807,085 (the Application), standing in the name Lidl Stiftung & Co. Kg. (the Applicant), for use in association with a long list of goods, including a variety of food and beverage products, as detailed in Schedule A to this decision (collectively, the Goods).

[2] The main issue in this proceeding is whether the Mark is confusing with one or more of the Opponent's trademarks listed below, comprising its alleged family of MONDO trademarks (collectively, the Opponent's Trademarks):

Trade-mark	Reg. No./ Reg. Date	Used Since	Goods & Services
MONDO	TMA996083 May 17, 2018	(1) Jun. 2011 (2) 2010	(1) brewed coffee; meat products, namely fresh sausages (2) dry cured pizza pepperoni
MONDO	TMA766777 May 13, 2010	Aug. 1999	ice cream and gelato
	TMA490664 Mar. 2, 1998	1991	flour, wine grapes and canola oil sold at wholesale; importing, packaging and distributing foods and beverages.
MONDO FOODS	TMA452101 Dec. 22, 1995	(1) 1989 (2) 1981	(1) fruits juices, candies; (2) importing, packaging and distributing foods and beverages.
BEL' MONDO	TMA462081 Aug. 30, 1996	(1) Aug. 1987 (2): Jul. 10, 1996	(1) food products, canned and/or otherwise, namely, vegetables, namely, tomatoes and fruits, namely pineapples; olive oil; (2) anchovies and vegetable oils.
MONDO	TMA466497 Nov. 27, 1996	(1) Aug. 1981 (2) Mar. 1989 (3) Jul. 1991 (4) Dec. 1991 (5) Aug. 9, 1996	(1) food products, canned and/or otherwise, namely, fruits and vegetables, namely, tomatoes, tomato puree/sauce, tomato paste and olives; (2) vegetable oils, dried pasta and cheeses; (3) flour; (4) alcohol-based food flavourings/extracts; (5) olive oil, canned fruits.
BEL' MONDO	TMA318653 Sep. 19, 1986	Jul. 9, 1986	canned goods, namely tomatoes, tomato sauce, tomato paste, pineapple, olives, beans, and artichoke paste; vegetable oil and olive oil; fruit nectars and juices; and dried pasta.
MONDO	TMA317799 Aug. 29, 1986	(1) Aug. 1981 (2) Jun. 23, 1986	(1) canned goods, namely tomatoes, tomato sauce, tomato paste and olives; (2) canned beans, canned pineapple, canned artichoke paste, vegetable oil, olive oil, fruit nectars and juices, and dried pasta.

[3] For the reasons that follow, the opposition succeeds in part.

THE RECORD

[4] The Application was filed on October 31, 2016 and claims the priority of a corresponding application filed on June 16, 2016 with the European Union Intellectual Property Office. The Application was advertised for opposition purposes in the *Trademarks Journal* on September 9, 2020.

[5] On November 2, 2020, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition raised by the Opponent are based on non-registrability of the Mark under

section 12(1)(d) of the Act; non-entitlement of the Applicant under sections 16(1)(a), and 16(1)(c) of the Act; and non-distinctiveness of the Mark under section 2 of the Act. Each of these grounds of opposition turns on the issue of the likelihood of confusion between the Mark and either one or more of the Opponent's Trademarks or trade name Mondo Foods, which have been previously used in Canada in association with the Opponent's registered goods and services, reproduced above.

[6] On January 11, 2021, the Applicant filed and served a counter statement denying the grounds of opposition.

[7] In support of its opposition, the Opponent filed an affidavit of its President, Tom De Nardi, sworn on August 5, 2021 (the De Nardi Affidavit). The De Nardi Affidavit speaks to the issue of promotion and use of the Opponent's Trademarks and trade name Mondo Foods. Mr. De Nardi was not cross-examined on his affidavit.

[8] The Applicant elected not to file any evidence.

[9] Both parties submitted written representations. Only the Opponent attended an oral hearing.

EVIDENTIAL BURDEN AND LEGAL ONUS

[10] The Opponent has the initial evidential burden to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once that burden is met, the Applicant bears the legal onus of establishing, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd*, 1990 CanLII 11059 (FC), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155].

ANALYSIS

Section 12(1)(d) Ground – Non-registrability of the Mark

[11] The Opponent has pleaded that the Mark is not registrable because it is confusing with each and all of the Opponent's Trademarks. I have exercised the

Registrar's discretion to confirm whether each of the Opponent's Trademarks is in good standing as of the date of this decision, which is the material date for assessing a section 12(1)(d) ground of opposition [*Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[12] As the Opponent has met its evidential burden, the Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and any one of the Opponent's Trademarks.

[13] In this regard, I stress that the Opponent's Trademarks must be reviewed individually and not collectively as a "family of marks" for the purpose of assessing the likelihood of confusion with the Mark. As discussed below, however, evidence of a family of marks is a relevant surrounding circumstance in each case. That said, and unless indicated otherwise, I will focus my analysis on the Opponent's word mark MONDO of registration Nos. TMA996,083, TMA766,777, TMA466,497, and TMA317,799 (the MONDO Mark).

The test for confusion

[14] 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 they have no more than an imperfect recollection of the opponent's trademark, and do not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[15] Thus, section 6(2) of the Act does not concern the confusion of the trademarks themselves, but of the goods or services from one source as being from another. In the present case, the question is essentially whether a consumer, with an imperfect recollection of either one of the Opponent's pleaded registrations, who sees the Applicant's Goods in association with the Mark, would think that they are sold or otherwise emanate from or are licensed, approved or sponsored by the Opponent.

[16] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at 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 the trademarks have 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. This list is not exhaustive; all relevant factors are to be considered, and are not necessarily attributed equal weight [see *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22; *Veuve Clicquot, supra*; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 for a thorough discussion of the general principals that governs the test for confusion].

[17] In this regard, I note that in its written representations, the Applicant apparently mixes the factors of the test for confusion together, essentially ignoring or failing to consider some of these statutory factors individually. For example, the Applicant submits under the heading “Length of use of the [Mark]” that “the mere distinctiveness of its [Mark] is sufficient for it to be considered registrable”. More particularly, the Applicant submits under such factor that the Mark “is distinctive because of its phonetics and its distinct and invented visuals” and that “the other evaluation factors are therefore secondary to the present analysis and should not be given too much consideration”. As another example, the Applicant’s sole submission under the heading “The nature of the trade” is that such factor “is not a determining one in the present case as the inherent distinctiveness of [the Mark] suffices to distinguish the Applicant’s Goods from the Opponent’s”.

[18] That said, in *Masterpiece, supra* at paragraph 49, the Supreme Court of Canada discussed the importance of the section 6(5)(e) factor in conducting an analysis of the likelihood of confusion between the parties’ trademarks in accordance with section 6 of the Act:

[...] the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis [...] if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become

significant only once the marks are found to be identical or very similar [...] As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start.

[19] Under the circumstances of the present case, I consider it appropriate to analyse the degree of resemblance between the parties' trademarks first.

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

[20] When considering the degree of resemblance between trademarks, they must be considered in their totality; it is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trademarks [*Veuve Clicquot, supra* at para 20].

[21] In *Masterpiece, supra* at paragraph 64, the Court further advised that, while in some cases, the first word or syllable of a trademark will be the more important for the purpose of distinction, the preferable approach to considering resemblance "is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique".

[22] In this case, the parties take diametrically opposed positions.

[23] The Opponent submits in its written representations that the Mark is "virtually identical" to the Mondo Mark, "bearing in mind that the [Mark] is composed of MONDO preceded by "VE"". The Opponent submits that "VE" "is a minor component since it is composed of just two letters and one syllable" and that the Mark "sends the clear message that the Applicant's Goods are a version of the food and beverage-related goods in association with which the [Opponent's Trademarks] have been used for over 40 years."

[24] In contrast, the Applicant submits in its written representations that "it goes without saying that VEMONDO and MONDO can easily be distinguished by the first letters of the marks as well as by their pronunciation." The Applicant submits that "the prefix "VE" is not descriptive in nature as it doesn't carry any meaning in the French or

English languages” and that this prefix “impacts the structure of the [Mark] and gives it a distinctive sound and appearance”. More particularly, the Applicant submits that:

40. In the present case, VEMONDO, on its own, is the striking component of the [Mark]. Unlike the marks in *Masterpiece*, the [Mark] is not comprised of many words that have varying levels of emphasis and distinctiveness. [...]

43. [...] the prefix “VE”, in itself, does not refer to anything in particular and does not serve to draw attention to the element MONDO. It also does not sound like any word in the French or English languages. VEMONDO cannot be read separately and divided in separate sections. In fact, it is the prefix VE that brings distinctiveness to the invented word VEMONDO.

[25] In my view, the striking element of the Opponent’s MONDO Mark, indeed its only element, is MONDO, while the striking aspect of the Applicant’s Mark is the coined term VEMONDO.

[26] As the Mark incorporates the Opponent’s trademark in its entirety, I find there to be a meaningful degree of resemblance between the parties’ trademarks. While the prefix “VE” in the Applicant’s Mark provides a different sound and appearance, the Applicant’s Mark nonetheless contains the Opponent’s trademark, resulting in some overall similarity in sound and appearance. With respect to ideas suggested, I note that the Opponent’s registration No. TMA996,083 indicates that “the translation provided by the applicant of the Italian word MONDO is WORLD” and that the Opponent’s website excerpts for 2016 attached as Exhibit 2 to the De Nardi Affidavit (discussed below under the section 6(5)(a) factor) include the following introductory text under the heading “About Mondo Foods”: “Mondo Foods Co. Ltd. (*literally translates as World Foods*) is a broadline Importer and Distributor of Canadian & International food products” [my emphasis]. However, there is no evidence that this meaning would necessarily be known to the average Canadian consumer. Thus, in my view, each of the parties’ trademarks would more likely be seen as a coined term having no readily apparent meaning in relation to the parties’ respective goods.

[27] If, on the other hand, the average Canadian were to associate the word “mondo” with “world” (either because of its meaning in Italian or because of its similarity to the French word “monde”), I would still find there to be a meaningful degree of resemblance

between the parties' trademarks in appearance and sound. However, in terms of ideas suggested, the meaning to be ascribed to the Applicant's Mark would remain unclear. In this regard, one can only speculate if the prefix "VE" would be perceived as qualifying the word MONDO and the idea suggested, "world". Stated differently, the Mark would likely be seen as a coined term, thus holding no similarity in ideas suggested with the Opponent's MONDO Mark.

[28] To sum up, I find that there is a meaningful degree of resemblance between the parties' trademarks, at least in sound and appearance.

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

[29] Both parties' trademarks are inherently distinctive since neither describes any aspect of the parties' respective goods.

[30] The degree of distinctiveness of a trademark may be increased by means of it becoming known through promotion or use.

[31] There is no evidence that the Mark has been used or has become known in Canada in association with the Goods to any extent.

[32] In contrast, the evidence of use and promotion of the Opponent's Trademarks filed through the De Nardi Affidavit establishes quite extensive use of the MONDO Mark, as per my review below of this affidavit.

The De Nardi Affidavit

[33] As a preliminary remark, I note that Mr. De Nardi explains in his affidavit that Mondo Foods Co. Ltd. (a Manitoba corporation distinct from the Opponent) was the original owner of the Opponent's Trademarks (with the exception of registration No. TMA996,083) and that it changed its name to De Nardi Properties Ltd. (the Predecessor) on August 31, 2011. He states that the Predecessor then transferred to the Opponent "all right, title, and interest in and to [the Opponent's Trademarks] and the underlying common law trademarks and associated goodwill" on September 30, 2011. That assignment was recorded by the Registrar on February 25, 2013 [para 5]. For the

sake of clarity, all references to the Opponent in my decision will encompass the Predecessor.

[34] Also, because the Opponent's evidence of use of its other MONDO-formative registered trademarks will be relevant as an additional surrounding circumstance, I summarize below those portions of the De Nardi Affidavit that I consider to be the most pertinent regarding the extent of use and promotion of both the MONDO Mark and the Opponent's other relied-upon trademark registrations comprising its alleged MONDO family of marks.

[35] Mr. De Nardi states that the Opponent has been in business since 1975, importing and distributing a large variety of food and beverage products, including coffee, coffee beans, espresso, espresso beans, cappuccino, tea, grape juice, dairy, confectionary, baking, beverages, nuts, snacks, jams, fruits, vegetables, fish, soups, meats, oils, condiments, pasta, pickled products, rice, spices and wine (the Products) [para 3]. He states that the Products are manufactured by or for, and bear the trademarks of (i) third-party food and beverage suppliers—such as Agropur, Parmalat, H.G Heinz, Kraft Foods, Unilever (T.J. Lipton), Nestlé, Maple Leaf Foods, Saputo—which Products the Opponent purchases from such suppliers; or (ii) the Opponent or an affiliated company, where the Mondo Foods' Goods (as defined below) are concerned [para 3].

[36] Mr. De Nardi states that since at least 1975, the Opponent has used the trademarks and trade names MONDO and MONDO FOODS throughout Canada in association with the importation and distribution of foods and beverages (the Mondo Foods' Services) and a variety of MONDO-branded food and beverage products [para 6]. More particularly, he states that since at least as early as the dates set out in the table reproduced above at paragraph 2 of my decision, the Opponent has used the Opponent's Trademarks in association with the corresponding registered goods set out in such chart (the Mondo Foods' Goods) [para 7].

[37] Typical end users of Mondo Foods' Services are retail food/beverage and grocery stores, food/beverage distributors and restaurants (Mondo Foods' Customers)

[para 8]. Typical end users of Mondo Foods' Goods include (i) restaurants that are Mondo Foods' Customers; and (ii) Canadian residents who purchase Mondo Foods' Goods from retail food/beverage and grocery stores that are Mondo Foods' Customers [para 9].

[38] Sales in Canada by the Opponent of Mondo Foods' Goods in association with the Opponent's Trademarks have been in the range of \$1 million annually during 1990-91 to 2015-16 and in excess of \$2.5 million annually between April 2016 to the date of his affidavit. Mr. De Nardi specifies that approximately 5% of these sales were in association with the BEL'MONDO trademark while approximately 95% were in association with the MONDO trademark [para 11].

[39] Since 1990-91, annual sales in Canada by the Opponent of Mondo Foods' Services in association with the Opponent's Trademarks (excluding BEL' MONDO) have exceeded \$10 million. Since 2002-03, such annual sales have exceeded \$12 million and since 2016-17, they have exceeded \$18 million [para 12].

[40] In the course of promoting Mondo Foods' Goods and Mondo Foods' Services, representatives of the Opponent attended and have hosted several industry trade shows held in various Canadian cities including Winnipeg, Vancouver and Calgary [para 14].

[41] In support of his assertions of use and promotion of the Opponent's Trademarks and trade names, Mr. De Nardi attaches to his affidavit the following exhibits:

- Exhibits 1 and 2: printouts of excerpts from the Opponent's website at *mondofoods.com* as of the date of his affidavit and 2016, respectively. Upon review of these exhibits, I note that the excerpts prominently display the Opponent's trade name Mondo Foods as well as slight variations of the Opponent's design mark of registration No. TMA490,664 (the Opponent's Logo). I am reproducing below the Opponent's Logo with underneath the slight variations thereof:



- Exhibit 4: representative invoices in respect of Mondo Foods' Services and certain Mondo Foods' Goods the Opponent has sold or provided through the years 1993-2021 inclusive. Mr. De Nardi explains that every time an invoice has been delivered to a customer together with a shipment from the Opponent, the invoice was printed on paper showing the Opponent's name, logo and address at the top, as demonstrated by most of the exhibited invoices [para 10]. Upon review of this exhibit, I note that the invoices do indeed display the Opponent's corporate name and relate to both Mondo Foods' Goods described as such and products of third-party suppliers (e.g. Heinz, Kraft, Saputo). The invoices dated back to the early 1990's display the following logo (the Old Logo), whereas the subsequent invoices generally display the Opponent's Logo (or slight variations thereof as reproduced above):



- Exhibit 5: representative samples of labels attached to Mondo Foods's Goods and on cartons containing Mondo Foods' Goods when they are shipped to Mondo Foods' Customers. Upon review of this exhibit, I note that the vast majority of the labels and cartons prominently display the MONDO Mark. Many of the specimens of labels and cartons also do display the Opponent's Logo or trademark BEL'MONDO (or stylized versions thereof) and the Opponent's corporate name;
- Exhibits 6 and 7A to 7E: representative examples of leaflets and price lists. Mr. De Nardi explains that the Opponent distributes to its customers as well as prospective customers, including at trade shows, a variety of leaflets and price lists concerning Mondo Foods' Services and Mondo Foods' Goods. He specifies that approximately 1000 copies of each of the exhibited leaflets were distributed in Canada on or about the dates specified on such leaflets and that several thousands of copies of each of the exhibited price lists have been distributed [paras 15 and 16]. Upon review of these exhibits, I note that the leaflets and price lists dated back to the early 90's display the Opponent's Old Logo, whereas the subsequent ones generally display the Opponent's Logo and/or corporate name;
- Exhibit 8: a sampling of newspaper and magazine articles that discuss the Opponent's business and its original president Maria De Nardi. Upon review of this exhibit, I note that the vast majority of the articles touch on the history of the Opponent (also referred to as Mondo Foods) and how it has evolved from a small specialty cheese and delicatessen outlet in West Winnipeg into one of Western Canada's largest independent specialty cheese distributors and importers of international foods.

Conclusion on the first factor

[42] From all of the above, including the Opponent's annual sales for the Mondo Foods' Goods provided for the last 30 years, I find it reasonable to conclude that, in association with most, if not all, of the Opponent's registered goods, the MONDO Mark has become known to a significant extent in Canada, especially in Western Canada

where the majority of the Opponent's sales shown in Exhibit 4 have been made. I will comment on the evidenced extent to which the Opponent's other pleaded registrations have become known in association with the Mondo Foods' Goods and Services when considering the additional surrounding circumstances.

[43] The overall assessment of the section 6(5)(a) factor, which is a combination of inherent and acquired distinctiveness, thus favours the Opponent.

The length of time the trademarks have been in use

[44] As noted by the Federal Court of Appeal, "[a] mark that has been in use a long time, versus one newly arrived on the scene, is presumed to have made a certain impression which must be given some weight" [*United Artists Pictures Inc v Pink Panther Beauty Corp*, [1998] 3 FC 534].

[45] As there is no evidence of use of the Mark in Canada and as the De Nardi Affidavit establishes steady use of the MONDO Mark in association with most, if not all, of the registered goods since the Opponent's claimed dates of first use, this factor also favours the Opponent.

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

[46] When considering the nature of the goods, services or business and the nature of the trade, I must compare the Applicant's statement of Goods with the statement of goods and services in the registrations relied upon by the Opponent [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd*, 1987 CanLII 8953, 19 CPR (3d) 3 (FCA)].

[47] In its written representations, the Opponent submits that:

31. The [Opponent's Trademarks' registrations] cover a wide range of food and beverage products, including coffee, fruit juices, fruit nectars, flour, wine grapes, canola oil, olive oil, candies, tomatoes, olives, beans, artichoke paste, fruits, anchovies, pasta cheese, food flavourings, food extracts and ice cream. The Opponent has evidenced the sale of many of these food products in association with the [Opponent's Trademarks].

32. The Opponent has also evidenced the prior distribution in association with the MONDO FOODS trademark (word and design versions) of a wide range of third party food and beverage products falling within the categories: coffee/tea, beverages, dairy, fish, frozen foods, gravy/soups, meats, jams, snacks, oils/condiments, pasta, pickled products, rice/flour/semolina, sauces/pastes, spices, spreads, vegetables and baked goods.

33. As a result, typical purchasers of the Opponent's Services have become accustomed to associating the [Opponent's Trademarks] (excluding BEL'MONDO) with practically all categories of food and beverage products.

34. The vast array of food and beverage products in respect of which the Opponent's Services have been provided is not the only reason why the relevant universe would be likely to assume the Opponent is the source of a food or beverage product sold in association with a trademark composed of MONDO (including the Applicant's Mark]). In addition to having come to associate the [Opponent's Trademarks] with the Opponent's Services, the relevant class of consumer is aware that the [Opponent's Trademarks] are also used as brand names for the Opponent's Goods.

35. In that the [Opponent's Trademarks' registrations] for the MONDO mark do not restrict the channels of trade through which the Opponent's Goods & Services may be sold and provided, the Opponent is free to do so in any manner it sees fit. Likewise, the Application does not restrict the Applicant's channels of trade. Accordingly, it must be assumed the parties' channels of trade overlap.

[48] For its part, the Applicant submits that:

28. [...] despite alleging that the Applicant's Goods [...] are overlapping with the Opponent's Products [...], the evidence submitted in the De Nardi Affidavit as Exhibit 4 does not show an overlap in any way with regard to the classes 5, 20 and 31 described in the Application. For the other classes, some of the goods are covered in the adverse registration but there is no real evidence of use.

29. The fact is that the Application covers an array of goods that are in no way connected, even remotely, to those covered in the Opponent's trademarks and even less to those for which there is an indication of use in Canada.

30. Absent any explanations as to the alleged overlapping, the evidence submitted by the Opponent therefore does not support [its] broad claim and this factor should not be given excessive weight in the current analysis.

[49] I agree with the Applicant that the following goods falling under IC 5 do not overlap with the Opponent's registered goods and services:

[...] Medical and veterinary preparations, namely, medicinal alcohol, [...] medicated bath preparations for therapeutic use, diagnostic preparations for medical laboratory use and

veterinarian purposes, eye drops, first aid kits, animal feed supplements, personal lubricants, medical dressings [...]; Dental preparations and articles, namely dental impression materials, material for repairing teeth and for dental crowns and bridges, medicated mouth care and treatment preparations, namely medicated mouthwashes and dentifrices; Hygienic preparations and articles, namely, all-purpose disinfectants for hygienic purposes, air deodorant, antibacterial soaps and medicated soaps for the treatment of psoriasis and rosacea; astringents for medical purposes, sanitary preparations for medical use, namely preparations for cleansing the skin for medical use [...]

[50] Moreover, none of the Opponent's products and services referred to in the De Nardi Affidavit appear to be related, directly or indirectly, to those particular types of products, which essentially consist of pharmaceuticals and other preparations for medical or veterinary purposes. As set out in the Opponent's exhibited website excerpts [Exhibits 1 and 2], the categories of products carried by the Opponent are essentially described as follows: "Chocolate, Cookies, Baking"; "Coffee, Beverages, Syrups"; "Cheese, Milk, Dairy"; "Flour, Semolina, Yeast"; "Meat, Poultry, Deli Meats"; "Nuts, Snacks, Nut paste"; "Olive oil, Vinegars, Condiments"; "Olives, Pickled Vegetables, Capers"; "Pasta, Rice, Legumes"; "Preserves, Dried fruit, Honey"; "Seafood, Anchovies, Sardines"; "Soups, Sauces, Gravies"; "Spices, Salts, Peppers"; "Fresh and Canned Produce"; and "Containers, Tissue, Foil, Wrap". In this regard, while I acknowledge that the Opponent's exhibited price lists [Exhibit 7] show that the Opponent also carries "kitchen/cleaning products", I find these goods appear to be different from the Applicant's applied-for hygienic preparations and articles, not to mention that the Opponent's written and oral representations, like Mr. De Nardi's written testimony, only focussed on the Opponent's food and beverage products.

[51] Except for the goods described as "Fresh fruits, fresh nuts, fresh vegetables and fresh herbs" and "Malts for brewing and distilling and unprocessed cereals", I also agree with the Applicant that the applied-for goods under CI 31 do not overlap with the Opponent's registered goods and services. Furthermore, none of the Opponent's products and services referred to in the De Nardi Affidavit appear to be related, directly or indirectly, to these other applied-for goods, which essentially consist of raw agricultural, horticultural and forestry products as opposed to food products for human consumption *per se*.

[52] However, I find that all of the remaining applied-for goods of the Applicant (the Remaining Goods) overlap to varying degrees with either the Opponent's registered goods or services for the following reasons.

[53] As indicated above, the MONDO Mark registrations cover a variety of food and beverage products, including coffee, fruit nectars and juices, dairy, meats, oils, pasta, pickled products, and confectionary, which are either identical to or directly overlapping with some of the Remaining Goods. I further note that two of the other relied-upon trademark registrations pleaded by the Opponent also cover the services of "importing, packaging and distributing food and beverages", which could on its face encompass the importation, packaging and distribution of all of the Remaining Goods. As a matter of fact, the De Nardi Affidavit shows that the Opponent carries a wide variety of food and beverage products, either its own MONDO branded products or by way of distributing third-party products. Many of the Remaining Goods are either identical or almost identical to the food products carried by the Opponent. In this regard, and commenting on more particularly the Applicant's submission concerning its applied-for goods described as "honeycomb" under CI 20, I note that the Opponent's exhibited website excerpts and price lists include third-party "honey" (e.g. "Bee Maid White Honey", "Kraft Liquid Honey", and "Kraft Honey Churned"). In the absence of evidence to the contrary, I find there is at least some overlap between these third-party honey products carried by the Opponent and the Applicant's honeycomb. I will return to the Opponent's other relied-upon trademark registrations when considering the additional surrounding circumstances.

[54] Finally, as the Applicant has not restricted the statement of Goods to any particular channels of trade, and in the absence of evidence to the contrary, I find the parties' channels of trade could also potentially overlap insofar as the Applicant's Remaining Goods are concerned.

Additional surrounding circumstances

General use of MONDO in Opponent's business

[55] As per my review above of the De Nardi Affidavit, the Opponent's corporate name, Mondo Foods Co. Ltd. (or trade name Mondo Foods) appears on almost each and every exhibited material. The same comment applies to the Opponent's corporate logos (i.e. the Opponent's Logo and, prior to the mid 1990s, the Old Logo). In view of the very significant annual sales figures provided for the Opponent's services in association with the Opponent's Trademarks (excluding BEL'MONDO), and as the dominant and distinctive element of each of the Opponent's corporate name, trade name, and Trademarks (excluding BEL'MONDO) is the word MONDO, I find the extent known of MONDO in association with the Opponent's business of importing and distributing food and beverage products must also be taken into account as an additional surrounding circumstance favouring the Opponent under the present ground of opposition.

Family of marks

[56] As a surrounding circumstance with respect to the issue of confusion, in its written representations, the Opponent has relied upon its MONDO family of trademarks. The Opponent has submitted that since it has established the existence of a family of marks, the Opponent's Trademarks are entitled to a broader ambit of protection and that this factor acts to further increase the likelihood of confusion.

[57] In response, the Applicant has submitted in its written representations that:

52. [...] However, the Opponent fails to recognize the common denominator in each of the [Opponent's Trademarks]. In fact, each share a very specific identity as they all put the emphasis on the MONDO element which is never combined with another prefix or suffix. Even BEL' MONDO, which is separated in two sections, puts the emphasis on the MONDO element similarly to NUMONDO in [*Mondo Foods Co. Ltd. v Saverio Coppola*, 2011 TMOB 228]. Effectively, "BEL" is a French adjective that translates to "beautiful" and therefore contributes to characterizing the MONDO element. It must also be noted that the Italian expression BEL MONDO also translates to "Beautiful World".

53. For this reason, it is the Applicant's view that VEMONDO does not share the common denominator claimed by the Opponent with regard to the [Opponent's

Trademarks] as VEMONDO is inherently distinctive and easily distinguishable due to its different phonetics, structure and visuals.

[58] At the hearing, commenting on the Applicant's submissions, the Opponent submitted that I need not address this additional surrounding circumstance in order to find in favour of the Opponent. I agree with the Opponent. I shall add in this regard that even if I were to accept that the Opponent has established the existence of a MONDO-formative family of trademarks, this would not change the ultimate outcome of my decision.

Conclusion on the likelihood of confusion

[59] As indicated above, the Applicant bears the legal onus of establishing, on a balance of probabilities, that there is not a reasonable likelihood of confusion as to the source of the parties' goods or services. The presence of an onus on the Applicant means that if, after all the evidence is in, a determinate conclusion cannot be reached, the issue must be decided against the Applicant [see *John Labatt, supra*].

[60] In view of all of the above, I find that, at best for the Applicant, the balance of probability as to the likelihood of confusion between the Mark and the Opponent's MONDO Mark is evenly balanced insofar as the Applicant's Remaining Goods are concerned. Specifically, I am not satisfied that the differences existing between the parties' trademarks are determinant in themselves and sufficient to outweigh the factors favouring the Opponent. Indeed, I am not satisfied that the Applicant has sufficiently distinguished its Mark from the Opponent's well-established MONDO brand so as to conclusively tip the balance of probability in its favour, considering the Opponent's long and extensive use of its MONDO brand in association with the Mondo Foods' Goods and Services, the significant reputation acquired by the MONDO brand and the Opponent's business, and the fact that the Remaining Goods of the Applicant and their corresponding channels of trade are potentially overlapping with those of the Mondo Foods' Goods and Services. As the Applicant has failed to demonstrate, on a balance of probabilities, that an average consumer seeing the Mark in association with the Applicant's Remaining Goods and having only a vague recollection of the Opponent's MONDO Mark would not, as a matter of first impression, infer that these particular

goods are sold or otherwise emanate from or are licensed, approved or sponsored by the Opponent, the section 12(1)(d) ground of opposition is successful with respect to these goods. It is otherwise rejected with the following applied-for goods of the Applicant falling under CI 5 and 31 due mainly to the greater differences in the nature of these goods and the Opponent's goods and services:

CI 5 (1) Medical and veterinary preparations, namely, medicinal alcohol, medicated bath preparations for therapeutic use, diagnostic preparations for medical laboratory use and veterinarian purposes, eye drops, first aid kits, animal feed supplements, personal lubricants, medical dressings; Dental preparations and articles, namely dental impression materials, material for repairing teeth and for dental crowns and bridges, medicated mouth care and treatment preparations, namely medicated mouthwashes and dentifrices; Hygienic preparations and articles, namely, all-purpose disinfectants for hygienic purposes, air deodorant, antibacterial soaps and medicated soaps for the treatment of psoriasis and rosacea; astringents for medical purposes, sanitary preparations for medical use, namely preparations for cleansing the skin for medical use

CI [31] (5) Agricultural and aquacultural crop seeds, horticulture and forestry products, namely, flower seeds, fruit seeds, vegetable seeds, grass seeds, mulch, live trees, live bushes, saplings, seeds and bulbs for planting

[61] Indeed, I am satisfied that the Applicant has discharged its legal onus of establishing that there is no reasonable likelihood of confusion between the Mark in association with these particular applied-for goods and the Mondo Foods' Goods and Services, as these goods appear to be fairly specialized and differ substantially from the Opponent's food and beverage products and there is no indication that such applied-for goods overlap with the nature of the Opponent's business.

[62] As such, the section 12(1)(d) ground of opposition succeeds in part and is rejected in part.

[63] As the Opponent has partly succeeded with its MONDO Mark, it is unnecessary to consider the remaining trademark registrations pleaded under this ground, as I find the Opponent would not achieve a more favourable result with any of these other trademarks.

Remaining grounds of opposition

[64] As the Opponent has already partially succeeded under the section 12(1)(d) ground of opposition, and as I consider such ground of opposition to represent the Opponent's strongest case, I do not consider it necessary to address the remaining grounds of opposition. Indeed, had it been decided that the Opponent met its evidential burden under each of these grounds, the Opponent would not achieve a more favourable result with either one of these latter grounds of opposition.

DISPOSITION

[65] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition with respect to the following goods:

CI [5] (1) Medical and veterinary preparations, namely, medicinal alcohol, medicated bath preparations for therapeutic use, diagnostic preparations for medical laboratory use and veterinarian purposes, eye drops, first aid kits, animal feed supplements, personal lubricants, medical dressings; Dental preparations and articles, namely dental impression materials, material for repairing teeth and for dental crowns and bridges, medicated mouth care and treatment preparations, namely medicated mouthwashes and dentifrices; Hygienic preparations and articles, namely, all-purpose disinfectants for hygienic purposes, air deodorant, antibacterial soaps and medicated soaps for the treatment of psoriasis and rosacea; astringents for medical purposes, sanitary preparations for medical use, namely preparations for cleansing the skin for medical use

CI [31] (5) Agricultural and aquacultural crop seeds, horticulture and forestry products, namely, flower seeds, fruit seeds, vegetable seeds, grass seeds, mulch, live trees, live bushes, saplings, seeds and bulbs for planting

and I refuse the Application with respect to all of the remaining goods pursuant to section 38(12) of the Act.

Annie Robitaille
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

The Goods, as listed in the Application for the Mark, together with the associated Nice classes (CI)

CI [5] (1) Dietary supplements and dietetic foods adapted for medical use, namely food supplements consisting of amino acids and trace elements; Medical and veterinary preparations, namely, medicinal alcohol, medicinal drinks, medicinal oils, medicinal herbs and medicinal tea for the treatment of nausea, headaches and insomnia, medicated bath preparations for therapeutic use, diagnostic preparations for medical laboratory use and veterinarian purposes, eye drops, first aid kits, animal feed supplements, personal lubricants, medical dressings, food supplements, namely vitamin and mineral supplements, dietetic foods and beverages adapted for medical use, namely diabetic fruit juice beverages adapted for medical purposes; Dental preparations and articles, namely dental impression materials, material for repairing teeth and for dental crowns and bridges, medicated mouth care and treatment preparations, namely medicated mouthwashes and dentifrices; Hygienic preparations and articles, namely, all-purpose disinfectants for hygienic purposes, air deodorant, antibacterial soaps and medicated soaps for the treatment of psoriasis and rosacea; astringents for medical purposes, sanitary preparations for medical use, namely preparations for cleansing the skin for medical use; Pharmaceuticals and natural remedies, namely, food supplements in the nature of antioxidants pills, appetite suppressants, pain relief medication, diet capsules; Food for babies; Dietetic beverages for babies adapted for medical purposes, namely infant formula; Dietetic substances for babies, namely infant foods; Infant formula; Beverages for infants being food for infants; medicinal tea and tisanes to aid digestion and sleep

CI [20](2) Honeycomb

CI [29] (3) Fish, seafood and mollusks; Meats; Dairy products and dairy substitutes, namely, artificial cream, raw, non-dairy cheese made from fermented cashews, milk substitutes, non-dairy creamers, soy milk; Processed fruits, fungi and vegetables (including nuts and pulses), namely candied fruits, dried fruits and vegetables, dried fruit mixes, fruit and vegetable salads, fruit compotes, dried edible black fungi; Birds eggs, namely hen eggs and quail eggs; Egg products, namely, powdered eggs, egg whites, egg yolks, deviled eggs, egg salad; Edible oils and fats; Pre-packaged dinners consisting primarily of seafood; Antipasto salads; Organic nut and seed-based snack bars; Broth [soup]; Stock cubes; Desserts made from milk products, namely yoghurt; Snack food dips; Pre-cooked stews; Prepared meals made from meat [meat predominating]; Prepared meals made from poultry [poultry predominating]; Prepared meals containing [principally] eggs; Prepared meals containing [principally] chicken; Prepared meals containing [principally] bacon; Prepared meals consisting substantially of seafood; Prepared meals consisting principally of game; Instant soup; Fish in

olive oil; Fish stock; Fish crackers; Fish cakes; Fish jellies; Fish croquettes; Steamed or toasted cakes of fish paste (kamaboko); Fish sausages; Beef bouillon; Bouillon concentrates; Meatballs; Prepared meat dishes; Fruit desserts, namely fruit compotes, fruit salads, fruit pie fillings, fruit topping; Fruit-based snack food; Chicken salad; Frozen pre-packaged entrees consisting primarily of seafood; Chilled meals made from fish; Potato fritters; Vegetable-based snack foods; Vegetable stock; Vegetable chips; Salted roasted nuts; Frozen prepared meals consisting principally of vegetables; Chicken croquettes; Chicken stock; Chicken balls; Legume salads; Soy-based snack foods; Instant stew; Instant miso soup; Yoghurt desserts; Potato chips; Potato flakes; Potato-based gnocchi; Potato dumplings; Potato pancakes; Potato fritters; Mashed potato; Potato salad; Potato snacks, namely potato chips, potato crisps, potato sticks; Consommés; Mincemeat made from fruits; Stuffed cabbage rolls; Soups; Croquettes; Beef jerky; Powdered milk for food purposes; Mixes for making soup; Sugar-coated fruits on a stick, namely candied fruit; Nut-based snack foods; Nut-based food bars; Spiced roasted nut; Prepared roasted nuts; Olives stuffed with feta cheese in sunflower oil; Olives stuffed with red peppers; Olives stuffed with red peppers and almonds; Olives stuffed with almonds; Olives stuffed with pesto in sunflower oil; Omelets; Pollen prepared as foodstuff, namely processed bee pollen for food purposes; French fries; Rhubarb in syrup; Beef stew; Hash brown potatoes; Roast chestnuts; Roasted nuts; Meat-based snack foods; Tofu-based snacks; Snack foods based on vegetables; Snack foods based on legumes; Potato-based snack foods, namely potato chips, potato sticks; Snack foods based on nuts; Soy chips; Soy burger patties; Puffed pork rind; meat extracts for soups; Soup concentrates; Soup pastes; Soup cubes; Frozen appetizers consisting primarily of chicken; Frozen appetizers consisting primarily of seafood; Tofu; Tofu burger patties; Vegetable burger patties; Vegetarian sausages; Clam juice; Hazelnuts, prepared; Prepared snails [escargot]; Soya [prepared], namely soya bean oil for food, preserved soya beans for food; Edible birds' nests; Sausages in batter; Yuca chips; Tzatziki; Prepared salads; Preparations for making bouillon; Onion rings; pie fillings, buttercream fillings for cakes; Snack food products made from potato flour, namely potato chips; Snack foods products made from soya flour, namely soya bean chips

CI [30] (4) Baked goods, namely muffins, cakes, bread, tarts, pies; Confectionery, namely almond confectionery, chocolate confectionery, fruit-based confectionery, peanut confectionery, sugar confectionery; Chocolate and desserts, namely frozen desserts, dessert mousse, dessert pudding, pastries; Ice, ice creams, frozen yogurts and sorbets; Coffee, teas and cocoa and substitutes therefor; Edible salts, seasonings, food flavourings and condiments, namely ketchup, relish, mustard, mayonnaise, chutney, seaweed, minced garlic, pickled ginger, mayonnaise, cocoa-based condiments, namely cocoa spreads and seasonings for food and drink; Sugars, natural sweeteners, sweet coatings and fillings, namely, chocolate topping, cake frosting, chocolate-based fillings for cakes and pies, confectioner's coatings in the nature of edible shellac coatings for foods, namely cake icing, pastry icing; bee products, namely, honey, propolis; Processed grains, starches, and goods made thereof, namely, starch for food,

starch syrup for food, corn starch flour, rice starch flour, starch-based candies; Baking preparations namely, baking powder, baking soda, mixes for baking batters, namely pancake mix, cake mixes and yeasts; Pineapple fritters; French toast; Snack food products consisting of cereal products, namely cereal-based bars; Snack foods prepared from maize, namely maize flakes; Snacks manufactured from muesli, namely muesli-based bars; Flaky pastry containing ham; Pretzels; Brioches; Bean jam buns; Frankfurter sandwiches, namely hot dog sandwiches; Burritos; Calzones; Chimichanga; Chinese steamed dumplings (shumai, cooked); Grain-based chips; Chow mein [noodle-based dishes]; Crackers made of prepared cereals; Crackers flavoured with meat; Crackers flavoured with vegetables; Crackers flavoured with herbs; Crackers flavoured with cheese; Crackers flavoured with spices; Crepes; Egg pies; Empanadas; Enchiladas; Chocolate-based ready-to-eat food bars; Fajitas; Pastries consisting of vegetables and fish; Ricebased prepared meals; Prepared meals in the form of pizzas; Prepared meals containing [principally] pasta; Pies containing meat; Fresh pies; Fresh pizza; Fresh sausage rolls; Stir fried rice cake [topokki]; Egg rolls; Prawn crackers; Fried corn; Chilled pizzas; Frozen pastry stuffed with meat; Frozen pastry stuffed with vegetables; Filled baguettes sandwiches; Pasta containing stuffings; Chinese stuffed dumplings (gyoza, cooked); Filled bread rolls; Vegetable pies; Pellet-shaped rice crackers (arare); Rice based dishes; Meals consisting primarily of pasta; Corn kernels being toasted; Toasted sandwiches; Toasted cheese sandwich; Toasted cheese sandwich with ham; Chips [cereal products], namely corn chips, taco chips, tortilla chips; Cereal-based snack food; Gimbap [Korean rice dish]; Mincemeat pies; Flapjacks; Hamburgers being cooked and contained in a bread roll; Hot sausage and ketchup in cut open bread rolls; Millet cakes; Hot dog sandwiches; Snack food products made from cereal flour, namely cereal-based bars; Rice-based snack food; Snack foods made from corn; Cereal snack foods flavoured with cheese; Caramel coated popcorn with candied nuts; Shrimp dumplings; Preserved pizzas; Korean-style pasta soup [sujebi]; Kimchi pancakes (kimchiijeon); Sticky rice cakes (Chapsalttock); Stir-fried noodles with vegetables (Japchae); Cheese curls [snacks], namely cheese puffs; Macaroni with cheese; Pumpkin porridge (Hobakjuk); Lasagna; Seaweed flavoured corn chips; Corn, roasted, namely corn flakes; Corn chips; Vegetable flavoured corn chips; Macaroni salad; Microwave popcorn; Sandwiches containing fish fillet; Sandwiches containing meat; Crackers filled with cheese; Mung bean pancakes (bindaetteok); Nachos; Ready-made dishes containing pasta; Canned pasta foods; Pasta salad; Pasta dishes; Pastries consisting of vegetables and meat; Pastries consisting of vegetables and poultry; Pies; Pies containing fish; Pies containing poultry; Pies containing vegetables; Pies containing game; Stir-fried rice; Pancakes; Prepared savory foodstuffs made from potato flour; Savory pastries; Pizza crust; Pizza bases, namely pizza sauce; Prepared pizza meals; Pizzas [prepared]; Candy coated popcorn; Pot pies; Puffed cheese balls [corn snacks]; Popcorn; Quesadillas; Quiches; Ravioli; Rice crisps; Prepared rice dishes; Rice dumplings; Rice crackers; Rice cakes; Rice biscuits; Rice salad; Rice-based snack food; Risotto; Salted tarts; Sandwiches; Pork pies; Sesame snacks; Snack foods made from wheat; Snack food products

made from cereal starch, namely cereal-based bars; Snack food products made from maize flour, namely maize flakes; Snack food products made from rusk flour, namely rusks; Snack foods made of whole wheat; Cheese flavored puffed corn snacks; Spaghetti and meatballs; Canned spaghetti in tomato sauce; Extruded wheat snacks, namely wheat-based snack food; Crumble, namely cereal topping; Sushi; Tabbouleh; Taco chips; Tacos; Tamales; Frozen pizzas; Frozen pastry stuffed with meat and vegetables; Tortilla snacks; Tortilla chips; Tortillas; Dry and liquid ready-to-serve meals, mainly consisting of rice; Dry and liquid ready-to-serve meals, mainly consisting of pasta; Uncooked pizzas; Boxed lunches consisting of rice, with added meat, fish or vegetables; Hot dogs (prepared); Ready to eat savory snack foods made from maize meal formed by extrusion, namely maize flakes; Pre-baked pizzas crusts; Meals consisting primarily of rice; Snack foods consisting principally of bread, namely bread sticks, bread crumbs; Pre-packaged lunches consisting primarily of rice, and also including meat, fish or vegetables; Snack foods consisting principally of extruded cereals; Prepared meals containing [principally] rice; Wonton chips; Soft pretzels; Wholewheat crisps, namely wholewheat tortilla chips; Poultry and game meat pies; Sausage rolls; Prepared foodstuffs in the form of sauces, namely barbecue sauce, cheese sauce, chili sauce, hot sauce, pasta sauce, pizza sauce, salad dressings; Pasta-based prepared meals; Onion biscuits; Dairy puddings; frozen yoghurt, ice cream

CI [31] (5) Agricultural and aquacultural crop seeds, horticulture and forestry products, namely, flower seeds, fruit seeds, vegetable seeds, grass seeds, mulch, live trees, live bushes, saplings, seeds and bulbs for planting; Fresh fruits, fresh nuts, fresh vegetables and fresh herbs; Malts for brewing and distilling and unprocessed cereals

CI [32] (6) Beer and brewery products, namely beer-based cocktails; Non-alcoholic beverages, namely, soft drinks, energy drinks, fruit juices, smoothies, fruit juice beverages, soft drinks in the nature of sodas, malt beer, carbonated non-alcoholic drinks, fruit drinks, water beverages, namely flavoured mineral water, carbonated water; Preparations for making beverages, namely syrups, powders and concentrates for making soft drinks and non-alcoholic fruit drinks; Preparations for making alcoholic beverages, namely syrups, powders and concentrates for making alcoholic fruit drinks

CI [33] (7) Alcoholic beverages (except beer), namely wine, wine-based beverages, alcoholic fruit beverages, alcoholic coolers; Alcoholic fruit extracts for making alcoholic fruit drinks; Alcoholic essences, namely liqueurs; Alcoholic coffee extracts

Appearances and Agents of Record

HEARING DATE: 2023-02-16

APPEARANCES

For the Opponent: Steven H. Leach

For the Applicant: No one appearing

AGENTS OF RECORD

For the Opponent: Ridout & Maybee LLP

For the Applicant: Robic