

Federal Court



Cour fédérale

Date: 20151224

Docket: T-974-13

Citation: 2015 FC 1419

Toronto, Ontario, December 24, 2015

PRESENT: The Honourable Mr. Justice Diner

BETWEEN:

AMIRA FOODS (INDIA) LIMITED

Applicant

and

LES ENTREPRISES AMIRA INC

Respondent

JUDGMENT AND REASONS

I. Nature of the Matter

[1] This is an appeal by Amira Foods (India) Limited [the Applicant], pursuant to section 56 of the *Trade-marks Act*, RSC 1985, c T-13 [the Act] of a March 28, 2013 decision by the Trade-marks Opposition Board [the Board], *Entreprises Amira Inc v Amira Foods (India) Limited*, 2013 TMOB 54 [Decision]. The Board refused to register the Applicant's trade-mark [Mark], the word "AMIRA" and an accompanying design, on two grounds:

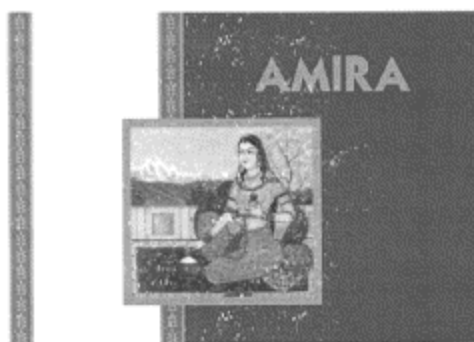
- i. **Prior Use** – namely, that contrary to subsection 30(e) of the Act, the Applicant had used the Mark in Canada prior to the filing date of the application, and
- ii. **Confusion** – namely, that contrary to paragraph 12(1)(d) of the Act, the Mark is confusing with a registered trade-mark belonging to Les Entreprises Amira Inc. [the Respondent].

II. Facts

[2] The Applicant is an Indian corporation that produces, markets, and exports rice and other food products. Its rice is sold in Canada through an importer.

[3] The Respondent is a Canadian corporation that sells food products in Canada, particularly Middle Eastern and imported specialities. The Respondent owns two registered trade-marks, “Amira”, Can No TMA410723 (9 April 1994), and “El Amira”, Can No TMA390629 (22 November 1991).

[4] On May 9, 2006, the Applicant, Amira Foods (India) Limited, filed an application to register the Mark (Application No 1300873), shown below:



[5] The Mark is composed of the word mark, AMIRA, as well as the design, a woman sitting next to a bowl of rice.

[6] On February 9, 2009, the Respondent filed a statement of opposition against the application, arguing that the:

- a. application did not conform to subsections 30(e), 30(h), and 30(i) of the Act;
- b. Mark is not registrable pursuant to paragraph 12(1)(d) of the Act;
- c. Applicant is not entitled to registration pursuant to paragraphs 16(3)(a) and 16(3)(c) of the Act; and
- d. Mark is not distinctive.

III. The Decision

A. *Section 30 Grounds of Opposition (Prior Use)*

[7] The Board dismissed both the Respondent's subsection 30(h) and subsection 30(i) oppositions for a lack of evidence. It then turned to the subsection 30(e) ground of opposition, where the Respondent advanced two arguments:

- 1) the Applicant did not intend to use the Mark in association with all the wares it had listed; and
- 2) the Applicant had used the Mark in Canada prior to the filing date of the application.

[8] During a trade-mark opposition, "[t]he Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act.

However, there is an initial evidentiary burden on the Opponent (the Respondent in this forum) to adduce sufficient admissible evidence from which it could reasonably be concluded that the

facts alleged to support each ground of opposition exist” (*Laura Ashley Limited v Ashley Furniture Industries, Inc*, 2010 TMOB 89 at para 20 [*Laura Ashley*]; see also *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298).

[9] Under subsection 30(e) of the Act, if the opponent to a trade-mark application can demonstrate that there is sufficient evidence that the trade-mark had been in use prior to the material date May 9, 2006, the Applicant’s filing date, and if the applicant cannot subsequently demonstrate otherwise on a balance of probabilities, the application must be refused (*BlackIce by Design Inc v Molson Canada 2005*, 2010 TMOB 111 at paras 10-11).

[10] The Board’s decision on this ground hinged on the testimony of Anita Daing, the Applicant’s Finance Director. The Board found that her testimony under cross-examination conflicted with her Affidavit: while she initially stated that there were no sales in Canada using the trade-mark and/or the design before January 2009, under cross-examination she stated that goods bearing the Amira brand were sold in Canada at least as early as 2002. Furthermore, at another point, she stated that there had been sales totalling \$108,000 since 2005 in association with both the word mark and the design mark. These contradictions were enough for the Board to conclude that the Applicant had not met its burden to demonstrate compliance with subsection 30(e) of the Act and that this ground of the Respondent’s opposition was successful (*Amira* at paras 14-17).

B. *Paragraph 12(1)(d) Ground of Opposition (Confusion)*

[11] The Board first decided that, since the Respondent's remaining grounds of opposition all involved the likelihood of confusion between the Respondent's registered trade-marks and/or trade-name, it would focus on what it felt was the Respondent's strongest argument: confusion between the Mark and the Respondent's registered trade-mark, "AMIRA". Per paragraph 12(1)(d) of the Act, a trade-mark is not registrable if it is confusing with a registered trade-mark. Subsection 6(2) states that confusion results "if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class". The Board must, when assessing the likelihood of confusion, consider all surrounding circumstances, and in particular, those enumerated in subsection 6(5), namely the:

- (a) inherent distinctiveness of the trademarks or trade-names and the extent to which they have become known;
- (b) length of time the trade-marks or trade-names have been in use;
- (c) nature of the goods, services or business;
- (d) nature of the trade; and
- (e) degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them.

[12] The Board found for the Respondent with respect to each of these subsection 6(5) circumstances. Specifically, it found:

- (a) the Respondent's registered trade-mark had both inherent distinctiveness *and* acquired distinctiveness in association with food products;
- (b) the Respondent's mark had been in use for some time;

- (c) both parties' wares included rice;
- (d) both parties sell rice and so their channels of trade would overlap;
- (e) there is a high degree of resemblance between the marks since AMIRA is the most striking and unique aspect of both.

[13] So finding, the Board applied the test for confusion as established by the Supreme Court in *Veuve Cliquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20 [Veuve Clicquot]: “a matter of first impression in the mind of a casual consumer somewhat in a hurry . . . at a time when he or she has no more than an imperfect recollection . . . and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks”. Placing specific weight on the high degree of resemblance between the marks and the fact that the parties' wares (rice) overlapped, the Board concluded that the Mark would be confusing and thus that this ground of opposition was successful.

C. *The Additional Grounds*

[14] The Board did not consider it necessary to assess the arguments on paragraphs 16(3)(a) and 16(3)(c) of the Act or on distinctiveness, because the Respondent had succeeded on the two above noted grounds of opposition (prior use and confusion).

IV. Issues

[15] Three material issues are raised by the Applicant in this judicial review:

- 1) new evidence and resulting standard of review;
- 2) the Board's finding of prior use; and

3) the Board's finding of confusion.

A. *Issue 1: Standard of Review and New Evidence*

1. Standard of Review

[16] In Board appeals before this Court, parties may adduce additional evidence (subsection 56(5) of the Act). As a result, two standards of review may apply. If the Board erred in law or new evidence is adduced that would have materially affected the Board's decision, the standard is correctness; otherwise, the standard is reasonableness (*Wrangler Apparel Corp v Timberland Co*, 2005 FC 722 at para 4 [*Wrangler*]; *Molson Breweries v John Labatt Ltd* (2000), 5 CPR 4th 180 at 196 (FCA)).

[17] Therefore, if any new evidence is filed on appeal before this Court, it "must be assessed to determine if it would have materially affected the [Board's] decision" (*Servicemaster Company v 385229 Ontario Ltd (Masterclean Service Company)*, 2014 FC 440 at para 5). To trigger a correctness review, that evidence must have an impact: "[e]vidence that merely supplements or confirms earlier findings, or which pertains to facts posterior to the relevant material date, will be insufficient to displace the deferential standard of reasonableness" (*Hawke & Company Outfitters LLC v Retail Royalty Company*, 2012 FC 1539 at para 31 [*Hawke*]).

[18] The Applicant has submitted two new pieces of evidence: a new affidavit from Anita Daing, the Applicant's Director of Finance [Daing Affidavit], and an affidavit from Pamela Christoforakis, a law clerk at the firm of the Applicant's counsel [Christoforakis Affidavit].

2. New Evidence: The Daing Affidavit

[19] The Daing Affidavit seeks to address the finding by the Board that the Mark had been in use prior to the application. It states that the Board misunderstood Ms. Daing's previous evidence on the issue of first use: what she had intended to say was that only the brand name AMIRA, *not* the design mark, had been in use in Canada before 2009:

I have read the decision of Member Folz. In it she expresses confusion concerning my evidence of first use of the Trade-mark which is the subject of this application. Just to be clear, what was intended and what I thought I had expressed in paragraph 5 of my December 14, 2009 affidavit was that the Trade-mark that is the subject of this application had been used since in or about January 2009. The evidence from the cross examination referenced in the decision was intended, and I thought that I was clear, to respond to the matter of the use of "Amira", not the design mark that is the subject of the trade-mark application. (Application Record, pp 69-70 [AR])

[20] The Applicant claims that this is evidence that would have materially affected the Board's decision since it clarifies what Ms. Daing said and would have led to a different conclusion on the question of when the Mark was first used.

[21] The Respondent counters that the Daing Affidavit is purely duplicative of evidence already adduced and has no probative significance: it contains the bald assertion reproduced above, without supporting documentation, and does not specify what "the evidence from the cross examination referenced in the decision" is. The Respondent also notes that the Daing Affidavit does not address the inconsistency identified by the Board that "that there have been sales since 2005 in association with both the word mark and the design mark" (Decision at para 17).

[22] I agree with the Respondent that the Daing Affidavit would not have materially affected the Decision. The Affidavit amounts to an assertion by the affiant that the Board erred in its interpretation of her testimony, a claim that requires additional evidentiary support. Furthermore, the Daing Affidavit does not address the Board's finding of sales since 2005. Had this "new evidence" been before the Board at the time of the Decision, it would simply have added to the uncertainty created by Ms. Daing's testimony overall, because it conflicts with Ms. Daing's statements on cross-examination.

3. New Evidence: The Christoforakis Affidavit

[23] The Christoforakis Affidavit purports to adduce two new pieces of evidence. First, Ms. Christoforakis states that she was "struck by [the Board's] observation that 'Amira' was not a common name" (AR, p 23). In response, she performed a Google search of the word "Amira", geographically biased to Canada, concluding that "there are a number of professionals with the name 'Amira' and their related businesses" (AR, p 24). The results of Ms. Christoforakis' search are attached to her Affidavit.

[24] Second, Ms. Christoforakis states that, in regard to the Board's finding on Ms. Daing's testimony on prior use, she "believe[s] that the evidence was that the word 'Amira' was used prior to the filing date, not the trade-mark which is the subject of this application" and that her "own independent search does not disclose use of the trade-mark that is the subject of the application before the application date" (AR, p 24). A Yahoo Canada Finance printout on "Amira (Nature Foods Ltd.)" – the product of this search – is also attached to her Affidavit.

[25] The Respondent takes the position that the searches could not have materially affected the Board's assessment of distinctiveness because:

- most of the results do not show whether the individuals or the entity had a presence in Canada at the date of the Decision (in this case, that was March 28, 2013 – the material date that applies to non-registrability under paragraph 12(1)(d) of the Act (*Alticor Inc v Nutravite Pharmaceuticals Inc*, 2005 FCA 269 at para 11));
- for those that do, the dates come after the date of the Decision; and
- there are too few results (17) to lead to a different conclusion than the Board reached on the issue of whether the average Canadian would consider “AMIRA” to be a coined word.

[26] Additionally, the Respondent argues that the affiant's beliefs are not material and that her statements on what Ms. Daing intended to say amount to hearsay. As for the “independent search”, the Affidavit does not disclose any search methods, nor is it clear that the affiant has attached all of the results of the search.

[27] I once again agree with the Respondent that the evidence contained in the Christoforakis Affidavit would not have had a material effect on the Board's decision.

[28] The Board never concluded that Amira was a “coined word” – merely that, to the average Canadian, it would be more likely than not to be interpreted as coined. While it is certainly possible that the average Canadian would recognize Amira as a proper name, evidence of 17

individuals across Canada – even assuming they were present in Canada at the material time – is too limited a sample size to draw any relevant conclusion.

[29] Second, the search post-dates the Decision. Post-dated evidence cannot be material to a Board's decision (see *Wrangler* at para 10; *Hawke* at para 31). This is especially true in the case at hand, where there is no way to assess whether the individuals the affiant identified were present in Canada at the relevant time.

[30] In short, neither of the new pieces of evidence adduced by the Applicant would have had a material effect on the Decision. Furthermore, the Applicant's arguments on appeal relate entirely to the Board's interpretation of the facts and the application of the law to those facts, and no error of law has been alleged.

[31] As a result, this Court must review the Decision on a reasonableness standard. In reasonableness review, "[t]he question is whether the Board's decision is supported by reasons that can withstand 'a somewhat probing' examination and is not 'clearly wrong'" (*Mattel Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 40, citing *Canada (Director of Investigation and Research) v Southam Inc*, [1997] 1 SCR748, at paras 56 and 60). A reasonableness review "is concerned mostly with the existence of justification, transparency and intelligibility within the decision-making process. But it is also concerned with whether the decision falls within a range of possible, acceptable outcomes which are defensible in respect of the facts and law" (*Dunsmuir v New Brunswick*, 2008 SCC 9 at para 47).

B. *Issue 2: Prior Use (Subsection 30(e))*

[32] The Applicant's argument on this point depends heavily on the Daing and Christoforakis Affidavits. The Applicant claims that the Board reached an unreasonable conclusion in interpreting Ms. Daing's statements. The only reasonable interpretation of the contradictions in her testimony and her original affidavit, the Applicant asserts, is that she meant that the name "Amira" had been in use in Canada prior to 2009, not the Mark (which is composed of the word "Amira" *and* the design).

[33] The Respondent takes the position that the Decision was reasonable in that the Applicant had not met the legal burden of establishing that it was, in light of the Respondent's opposition, in compliance with subsection 30(e) – in other words, demonstrating that the Mark was not in use prior to the filing date of the application. The Respondent further argues that neither of the new affidavits bring the Applicant any closer to meeting that burden.

[34] Having already determined that neither Affidavit would have had a material effect on the Board's decision, the Court does not afford either any substantial weight in this analysis. Both consist of bare assertions that the Board's interpretation of Ms. Daing's earlier statements was incorrect without any evidence to support this point. The Christoforakis Affidavit does disclose that Ms. Christoforakis conducted an "independent search" that found no evidence of use of the Mark before the application date, but nothing is said on the scope or methodology of this search. As a result, both the Daing Affidavit and the Christoforakis Affidavit serve less as evidence than as reiterations of the Applicant's current position on the Board's original findings.

[35] As for those original findings, they disclose no reviewable error. The task of this Court is not to conduct its own analysis of Ms. Daing's statements. Instead, it must be asked whether it was open to the Board to determine from the conflicting testimony – the only evidence available on the issue – that the Applicant had not proven on a balance of probabilities that the application was in compliance with subsection 30(e) of the Act (Prior Use). Looking to paragraphs 14 to 17 of the Decision, it is clear that the Board considered the available evidence, noted the contradictions in Ms. Daing's testimony, considered both the Applicant's and the Respondent's arguments on the issue, and reached a justifiable, and thus reasonable, conclusion.

C. *Issue 3: Confusion (Paragraph 12(1)(d))*

[36] The Applicant argues that the Board made a number of errors, including that:

- (i) “Amira” was a coined term and is thus inherently distinctive;
- (ii) the Respondent's trade-mark was distinctive in relation to rice, or even used by the Respondent in relation to rice; and
- (iii) there was a high degree of resemblance between its Mark and the Respondent's trade-mark.

[37] As Justice Evans noted in *Garbo Group Inc v Harriet Brown & Co* (1999), 3 CPR (4th) 224 at para 34, in revisiting the Board's finding on confusion, this Court must be respectful of its findings:

[D]espite the inclusion in the Trade-marks Act of an untrammelled right of appeal and the right to adduce additional evidence, a

[A]près avoir évalué ces facteurs, que, malgré l'ajout dans la Loi sur les marques de commerce d'un droit d'appel non restreint et du droit de

considerable degree of deference is called for on the part of the appellate Court when reviewing the Registrar's finding of confusion, provided at least that no significant new evidence has been adduced on a factual issue and it is not alleged that an error of law has been committed.

présenter des éléments de preuve additionnels, la cour d'appel doit faire preuve d'un degré considérable de retenue envers les conclusions de fait tirées par le registraire, à la condition du moins qu'aucun nouvel élément de preuve de poids n'ait été fourni relativement à une question de fait et qu'aucune erreur de droit n'ait été invoquée.

(i) Inherent Distinctiveness of the word "Amira"

[38] The Applicant argues that the Board erred in erroneously assuming without any evidence that 'Amira' was a coined term: Amira is Arabic for 'princess' and also a common name for both businesses and individuals in Canada. Since there is Board jurisprudence to the effect that proper names lack inherent distinctiveness (see, for example, *Laura Ashley* at para 26), and the new evidence demonstrates that Amira is a common name in Canada, the Board erred in concluding that the Respondent's trade-mark was distinctive.

[39] The Board did not, however, conclude that 'Amira' was a coined word. Instead, the Board found that "the average Canadian would be more likely to interpret the word AMIRA as a coined word" (Decision, at para 25). This conclusion was based on an absence of evidence "to support a finding that the average Canadian would be aware of the Arabic meaning of the word AMIRA" (Decision at para 24).

[40] The Applicant submitted the Christoforakis Affidavit to address this absence, but, as discussed above, it is insufficient to ground a finding that, on a balance of probabilities, the

average Canadian would recognize Amira as a proper name. That Affidavit only identified 17 individuals across Canada named Amira, far from enough to reasonably conclude that the average Canadian would know of a person with that name.

[41] It was thus open to the Board, on the evidence before it, to conclude that the average Canadian would be likely to think Amira was a coined word and thus that the Respondent's registered trade-mark was inherently distinctive. Even if it were not, the subsection 6(5) analysis looks at both inherent distinctiveness and acquired distinctiveness (i.e. "the extent to which they have become known"), and the Board found that it was clear from the evidence – including media attention, sales figures, and invoices – that the Respondent's trade-mark "has acquired distinctiveness with respect to the operation of an import and export business specializing in middle east food and non-food products, and in association with various other food products" (Decision at para 33).

(ii) Distinctiveness and use in relation to rice

[42] On this point, the Applicant first argues that the Board erred in concluding that the Respondent's registered trade-mark was distinctive in relation to rice. The Applicant notes that, until at least 2011, the Respondent sold or advertised rice labelled by Shivnath Rai Harnarain [SRH], the original source of that rice. A trade-mark, the Applicant argues, cannot be distinctive if it refers consumers to a multitude of sources. If another party was benefitting from the goodwill associated with the mark, then the mark was not distinctive.

[43] It is essential, however, that the Board's finding on this point be understood in its larger context. Specifically, the Board found that, while the Respondent was selling basmati rice under the SRH label until at least 2011, it was also selling other types of rice: "[the Respondent's] evidence also shows that it has used its AMIRA mark in association with other rice products, such as Egyptian rice" (Decision at para 33). The Board concluded that the Respondent's trade-mark remained distinctive in relation to rice in spite of the SRH labels because those labels were only associated with one of the rice products it sold.

[44] I find it was reasonable for the Board to look at this broader context, rather than confining its analysis purely to the realm of basmati rice: the consumer in a hurry, with imperfect recollection, cannot be expected to distinguish between types of rice when distinguishing two potentially confusing trade-marks (see *Veuve Clicquot* at para 20).

[45] The Applicant also argues that there was no evidence before the Board that the Opponent was using the registered trade-mark in the sense of the Act:

4(1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

4(1) Une marque de commerce est réputée employée en liaison avec des produits si, lors du transfert de la propriété ou de la possession de ces produits, dans la pratique normale du commerce, elle est apposée sur les produits mêmes ou sur les emballages dans lesquels ces produits sont distribués, ou si elle est, de toute autre manière, liée aux produits à tel point qu'avis de liaison est alors donné à la personne à qui la propriété ou possession est transférée.

[46] However, evidence was indeed submitted to the Board of use, including “a sample of the [Respondent’s] rice sold across Canada for several years under the AMIRA trade-mark” (Decision at para 27). It was therefore reasonable for the Board to find that this, along with the rest of the Respondent’s exhibits, provided sufficient evidence to conclude that the facts alleged to support this ground of opposition existed (see *Laura Ashley* at para 20).

(iii) Resemblance between the marks in question

[47] Finally, the Applicant argues that the Board erred in finding a there is a high degree of resemblance between the Mark and the Respondent’s registered trade-mark, “Amira”. One is a design mark while the other is a word mark. Furthermore, “[t]he ideas suggested by the trade-marks are very different” – the Applicant’s Mark suggests “wealth and premium quality of Indian origin”, while the Opponent’s trade-mark “is a reference to an employee at Les Entreprises Amira”, the owner’s sister (AR, p 1364). Along the same lines, the Applicant submits that the Mark is, in contrast to the Respondent’s trade-mark, highly distinctive, since the design in the Mark, and not the word, is dominant.

[48] In light of the Board’s finding on the distinctiveness of the term “Amira”, there is no readily identifiable error in the Board’s analysis on this ground. Both involve the prominent display of “Amira”. As the Supreme Court noted in *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at para 64, when considering the degree of resemblance between marks, the “striking or unique” aspect of any mark should drive the analysis. Since the Board reasonably found that the word Amira would be more likely than not to be understood as a coined term, the

word itself would be most striking to a consumer and thus the degree of resemblance would be high.

[49] The jurisprudence is clear that in a reasonableness review of a confusion analysis conducted by the Board, this Court must act with a considerable degree of deference. There are no identifiable errors in the Applicant's submissions regarding the outcome that suggest this Court should set aside the Board's findings.

V. Conclusion

[50] Neither the Applicant's new evidence, which would not have had a material effect on the Decision, nor the Applicant's arguments on its unreasonableness, have persuaded me that the Board made a reviewable error refusing registration of the Applicant's mark. This appeal will, accordingly, be dismissed, with costs to the Respondent.

[51] The parties agreed to provide a joint submission on fixed costs after having reviewed this decision. They have 15 days to present that quantum to the Court (i.e., by January 20, 2016).

JUDGMENT

THIS COURT'S JUDGMENT is that:

- 1) This judicial review is dismissed.
- 2) Proposed costs are due by January 20, 2016.

"Alan S. Diner"

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-974-13

STYLE OF CAUSE: AMIRA FOODS (INDIA) LIMITED v LES
ENTREPRISES AMIRA INC

PLACE OF HEARING: TORONTO, ONTARIO

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JUDGMENT AND REASONS: DINER J.

DATED: DECEMBER 24, 2015

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