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Court File No.

FEDERAL COURT

B E T W E E N:

(Court Seal)

OBSIDIAN GROUP INC.

Applicant

- and -

LES CHOCOLATS VADEBONCOEUR INC.

Respondent

NOTICE OF APPLICATION

TO THE RESPONDENT:

A PROCEEDING HAS BEEN COMMENCED AGAINST YOU by the applicant. The relief claimed by the applicant appears below.

THIS APPLICATION will be heard by the Court at a time and place to be fixed by the Judicial Administrator. Unless the Court orders otherwise, the place of hearing will be as requested by the applicant. The applicant requests that this application be heard at Toronto, Ontario.

IF YOU WISH TO OPPOSE THIS APPLICATION, to receive notice of any step in the application or to be served with any documents in the application, you or a solicitor acting for you must prepare a notice of appearance in Form 305 prescribed by the *Federal Courts Rules* and serve it on the applicant's solicitor, or if the applicant is self-represented, on the applicant, WITHIN 10 DAYS after being served with this notice of application.

Copies of the *Federal Courts Rules*, information concerning the local offices of the Court and other necessary information may be obtained on request to the Administrator of this Court at Ottawa (telephone 613-992-4238) or at any local office.

IF YOU FAIL TO OPPOSE THIS APPLICATION, JUDGMENT MAY BE GIVEN IN YOUR ABSENCE AND WITHOUT FURTHER NOTICE TO YOU.

Date _____ Issued by _____
(Registry Officer)

Address of
local office: 180 Queen Street West
Suite 200
Toronto, Ontario
M5V 3L6

TO: **THE ADMINISTRATOR**
Federal Court of Canada

AND TO: **LES CHOCOLATS VADEBONCOUER INC.**
9400 Blvd. Ray Lawson
Anjou, Quebec
H1J 1K9

Respondent

AND TO: **SELENA ALTRO**
4141 Sherbrooke St. W.
Suite 650
Westmount, Quebec
H3Z 1B8

Lawyer for the Respondent

APPLICATION

THE APPLICANT APPEALS to the Federal Court pursuant to section 56 of the *Trademarks Act*, R.S.C.1985, c. T-13, as am., (the “**Act**”) from the decision of The Registrar of Trademarks (the “**Registrar**”), notice of which was dispatched to the parties on July 10, 2024, refusing trademark application no. 2115662 (the “**Application**”) to register the trademark FREDDO (the “**Trademark**”).

THE APPLICANT MAKES APPLICATION FOR:

1. a declaration that the Registrar erred in refusing the Application;
2. an Order pursuant to section 56 of the Act allowing this appeal, setting aside the above-noted decision of the Registrar, and rejecting the Respondent’s opposition to the Applications pursuant to subsection 38(12) of the Act;
3. its costs of this application; and
4. such further and other relief as this Honourable Court may permit.

THE GROUNDS FOR THE APPLICATION ARE:

5. the Applicant filed the Application on June 22, 2021;
6. the Respondent opposed the Application pursuant to section 38 of the Act on May 4, 2023;
7. in the Registrar’s decision of July 10, 2024, various grounds of opposition advanced by the Respondent were not considered, except for the ground based on paragraph 12(1)(d) of the Act, namely that the Trademark was not registrable because it was confusing with the trademark FREDDO registered by the Respondent under number TMA601964;
8. in allowing the opposition to the Application, the Registrar concluded that the Applicant had not established, on a balance of probabilities, that there was no reasonable likelihood of confusion between the Trademark and the mark relied upon by the Respondent;

9. the Registrar's decision was unreasonable and the Registrar erred in both fact and law in refusing the Application, for at least the following reasons:
- (a) the Registrar's decision that the average Canadian consumer would consider the word "Freddo" to be a coined term was incorrect and unreasonable;
 - (b) the Registrar erred in finding that the Applicant's Trademark had only become known to a minimal extent in Canada, despite the Applicant's inclusion in its evidence of extensive sales figures and multiple examples of its use of the Trademark since 2012;
 - (c) the Registrar incorrectly concluded that the overall assessment under paragraph 6(5)(b) of the Act of the inherent distinctiveness of the parties' trademarks and the extent to which they have become known was a neutral factor favouring neither party despite the fact that the Applicant's evidence clearly described the extent of its sales of goods bearing the Trademark and the Respondent's evidence did not do so; and
 - (d) the Registrar erred in concluding that there is a "remote overlap" between the parties' goods based on the Registrar's view that the Applicant's coffee-based beverages could be flavoured with the Opponent's chocolates;
 - (e) the Registrar erred in concluding that the factors set out in subsection 6(5) of the Act "possibly slightly favour the [Respondent]";
 - (f) the Registrar erred in not giving weight to the evidence regarding the absence of actual confusion between the parties' marks despite the parties' use of their marks since 2012 without confusion;
 - (g) the Registrar, in not giving weight to the evidence of the lack of actual confusion, appears to have used the Respondent's lack of detail regarding the extent to which it had used the FREDDO mark as a basis upon which to ignore the evidence of lack of actual confusion and, in doing so, prejudiced the Applicant's position as a result of the Respondent's own failure to adduce evidence on the issue;
 - (h) the Registrar's error on this issue was particularly relevant given their finding that "Had the evidence of record convincingly established extensive coexistence of the

parties' respective trademarks FREDDO without confusion, I might have concluded otherwise”;

- (i) the Registrar erred in dismissing the relevance of the fact that the Respondent's own registration of the mark FREDDO was preceded by a third party's registration of the same mark for use in association with ice cream and the operation of ice cream shops and, as such, the Respondent had already conceded that multiple parties could co-exist in their use of the trademark FREDDO in association with food items;
 - (j) the Registrar erred in concluding that the balance of probabilities on the issue of confusion was, at best, evenly balanced;
 - (k) the Registrar's decision in respect of the issue of confusion between the Trademark and the mark relied upon by the Respondent was incorrect in view of several material facts relevant to the issue of confusion, evidence of which was not before the Registrar during the opposition proceedings but will be before the Court on this appeal;
- 10. the Trademark is not confusing with any of the trademarks or trade names asserted by the Respondent in its statement of opposition and the Applicant is entitled to registration of the Trademark;
 - 11. sections 6, 12, 16 and 56 of the Act; and
 - 12. such further and other grounds as counsel may advise and this Honourable Court may permit.

THIS APPLICATION WILL BE SUPPORTED BY THE FOLLOWING MATERIAL:

- 13. Documents in the possession of the Registrar relating to the above-noted proceeding;
- 14. One or more affidavits or certified copies of documents that the Applicant may serve and file pursuant to Rule 306 of the *Federal Courts Rules*; and
- 15. Such further and other material as counsel may advise and this Honourable Court may permit.

THE APPLICANT REQUESTS THE REGISTRAR OF TRADEMARKS TO SEND A CERTIFIED COPY OF THE FOLLOWING MATERIAL THAT IS NOT IN THE POSSESSION OF THE APPLICANT BUT IS IN THE POSSESSION OF THE REGISTRAR OF TRADEMARKS TO THE APPLICANT AND TO THE REGISTRY:

16. The pleadings, evidence and written arguments filed by the parties with the Opposition Board in the decision being appealed from.

September 9, 2024



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