

Court File No.

FEDERAL COURT

B E T W E E N:

(Court Seal)

996660 ONTARIO LTD. TRADING AS MOLISANA IMPORTS

Applicant

and

FALESCA IMPORTING LTD.

Respondent

NOTICE OF APPLICATION

(Appeal pursuant to section 56 of the Trademarks Act)

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 file 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 ON M5V 3L6

TO: **FALESCA IMPORTING LTD.**
113 Charles Street
North Vancouver BC V7H 1S1

AND TO: **FALESCA IMPORTING LTD.**
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Kwan T. Loh
Tel. 604.6682-7295
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AND TO: Registrar of Trademarks
50 Victoria Street
Place du Portage I
Gatineau QC K1A 0C9

(To be served pursuant to Rule 133 of the *Federal Courts Rules*)

APPLICATION

THE APPLICANT MAKES APPLICATION FOR:

1. An Order:
 - (a) allowing this appeal,
 - (b) setting aside the decision of the Trademarks Opposition Board dated March 6, 2024 rejecting the Applicant's opposition to the registration of the Respondent's Trademark Application No. 1,838,474, and
 - (c) directing the Registrar of Trademarks to refuse Trademark Application No. 1,838,474 for all applied-for goods and services.
2. The Applicant's costs of this appeal.
3. Such further and other relief as counsel may request and this Honourable Court may deem just.

THE GROUNDS FOR THIS APPLICATION ARE:

The Trademark Applications

4. On May 18, 2017, Falesca Importing Ltd. (the "**Respondent**") applied to register the trademark FALESCA MOLISANA (Application No. 1,838,474) (the "**Respondent's Mark**" and the "**Application**", respectively) in association with the following goods (the "**Respondent's Goods**"):



Canned tomatoes; sundried tomatoes; tomato paste; tomato puree; tomato sauce; pizza sauce; pesto sauce; dried pasta; olive oils; vinegar; canned processed olives; dried olives; olives in oil; olive pastes; preserved vegetables in oil; canned vegetables; pickled vegetables; pickled vegetables; vegetable spreads; preserved artichokes; capers; pickled peppers; preserved roasted peppers; canned processed eggplant; dried edible mushrooms; canned processed mushrooms; canned beans; canned chickpeas; canned lentils; dried beans; dried chickpeas; dried lentils; soup; dried figs; pickled onions; bruschetta spreads; tapenades spreads; fruit nectars; honey; cured meat; cookies; crackers; shopping bags; bread; frozen confectionery; frozen bread; frozen pizza; flour.

5. The Application was advertised by the Registrar of Trademarks for opposition on March 13, 2019.

The Opposition

6. The Applicant, 996660 Ontario Ltd., trading as Molisana Imports (“**Molisana Imports**”) is a Canadian food importer and distributor. Molisana Imports imports and distributes a variety of goods including processed vegetables, processed meats, vegetable sauces, dried vegetables, cured meats, dried breads, pasta, olive oil, potato dumplings, biscuits, herbs and spices, cheeses, preserved fruits, cakes, candy, and chocolate (collectively, “**Molisana Imports’ Goods**”) in Canada.

7. Molisana Imports carries on business in association with various trademarks consisting of or incorporating the term REGINA MOLISANA, including a word mark registration for REGINA MOLISANA (Registration No. TMA577,102) and two design mark registrations for marks that prominently feature the words REGINA MOLISANA (Registration Nos. TMA784,082 and TMA794,246) (collectively, the “**REGINA MOLISANA Marks**”), as summarized below:

Trademark	Application/Registration Details	Goods
REGINA MOLISANA	App. No.: 1003844 App. Date: 1999-02-03 Reg. No.: TMA577102 Reg. Date: 2003-03-07	(1) Processed vegetables. (2) Processed meats. (3) Vegetable sauces. (4) Dried vegetables. (5) Cured meats. (6) Dried bread. (7) Pasta and olive oil. (8) Potato dumplings, biscuits, herbs and spices, cheeses, preserved fruits, cakes, and confectionery, namely, candy and chocolate
	App. No.: 1393326 App. Date: 2008-04-24 Reg. No.: TMA784082 Reg. Date: 2010-12-03	(1) Processed vegetables, processed meats, vegetable sauces, dried vegetables, cured meats, dried bread, pasta and olive oil, potato dumplings, biscuits, herbs and spices, cheeses, preserved fruits, cakes, and confectionery, namely, candy and chocolate.
	App. No.: 1471368 App. Date: 2010-03-01 Reg. No.: TMA794246 Reg. Date: 2011-03-30	(1) Processed vegetables; processed meats; sauces, namely, vegetable-based sauces, tomato-based sauces, spaghetti sauces, pizza sauces; dried vegetables; processed tomato products, namely processed tomatoes, tomato paste, chopped tomato, tomato puree, strained tomatoes; cured meats; dried bread; pasta; olive oil; vinegar; vegetable oil; potato dumplings; biscuits; herbs and spices; cheeses; preserved fruits; coffee; olives in tins and glass; cakes; confectionery, namely, candy and chocolate.

8. On August 13, 2019, Molisana Imports filed a Statement of Opposition opposing the Application. Molisana Imports alleged, *inter alia*, that the Respondent's Mark was not registrable because it is confusing with the REGINA MOLISANA Marks.

9. Molisana Imports' Statement of Opposition raised the following grounds of opposition:

- (a) Pursuant to s. 38(2)(a) of the *Trademarks Act*, RSC 1985, c. T-13 (the "**Act**"), the Application does not comply with the requirements of section 30(i) of the *Act*, as the Respondent could not have been satisfied that it was entitled to use the Respondent's Mark in Canada in association

with the Respondent's Goods, since at the date of filing the Application, the Respondent was or should have been aware of Molisana Imports' previous use in Canada of the REGINA MOLISANA Marks;

- (b) Pursuant to s. 38(2)(a.1) of the *Act*, the Application was filed in bad faith, since on June 21, 1994, the Respondent assigned to La Molisana S.P.A. ("**La Molisana**") its right, title and interest in the LA MOLISANA trademark (the "**LA MOLISANA Mark**"), registered under Registration No. TMA222,070 for use with the same or similar goods as the Respondent's Goods;
- (c) Pursuant to s. 38(2)(b) and 12(1)(d) of the *Act*, the Respondent's Mark is not registrable since it is confusing, within the meaning of s. 6 of the *Act*, with the REGINA MOLISANA Marks; and
- (d) Pursuant to s. 38(2)(d) of the *Act*, the Respondent's Mark is not distinctive within the meaning of s. 2, in that the Respondent's Mark does not distinguish the Respondent's Goods from the goods of others, including Molisana Imports' Goods, nor is the Respondent's Mark adapted so as to distinguish the Respondent's Goods.

10. In the course of the opposition proceedings, Molisana Imports filed extensive evidence in support of the distinctiveness of the REGINA MOLISANA Marks and confusion with the Respondent's Mark.

The Board's Decision

11. On March 6, 2024, the Trademarks Opposition Board (the "**Board**") issued its decision (the "**Decision**"). The Board rejected the opposition.

12. The Board focused its analysis on Molisana Imports' non-registrability ground of opposition under s. 38(2)(b) and held that most of Molisana Imports' remaining grounds of opposition turned on the same confusion analysis.

13. The Board correctly found that the onus was on the Respondent to demonstrate that the Respondent's Mark was not confusing with any of the REGINA MOLISANA Marks.

14. In assessing confusion, the Board purported to apply the test set out in s. 6(2) of the Act, which requires consideration of all relevant surrounding circumstances, including the statutory confusion factors set out in s. 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, sound, and/or the idea suggested by them.

15. In assessing distinctiveness, the Board erred in finding that:

- (a) the REGINA MOLISANA Marks had low inherent distinctiveness;
- (b) the word “Molisana” would be recognized by the average Canadian consumer as referring to the geographic region of Molise, Italy;
- (c) the REGINA MOLISANA Marks describe the place of origin of the goods sold in association with those trademarks;
- (d) both parties’ trademarks are geographically descriptive; and
- (e) the acquired distinctiveness of the REGINA MOLISANA Marks was insufficient to overcome any perceived deficiencies in the inherent distinctiveness of the REGINA MOLISANA Marks.

16. S. 6(5)(a) of the Act requires the court or the Registrar to consider the inherent distinctiveness of the trademarks **and** the extent to which they have become known. The Board erred by failing to properly consider and apply this conjunctive test.

17. The Board considered the length of time, nature of the goods, services, and business, and nature of the trade factors together. The Board correctly held that each of these factors favoured Molisana Imports. Molisana Imports has used the REGINA

MOLISANA Marks extensively and the REGINA MOLISANA Marks have significant acquired distinctiveness. The Respondent has applied to register the Respondent's Mark in association with the same or highly similar goods. The Respondent's goods will likely be sold in the same or highly similar channels.

18. In assessing the degree of resemblance, the Board erred in finding that the "Molisana" element of the REGINA MOLISANA Marks was not inherently distinctive due to its geographical significance. The Board also erred in finding that the REGINA MOLISANA Marks refer, and would be understood to refer, to the geographic region of Molise, Italy. It was a further error for the Board to find that the REGINA MOLISANA Marks would be recognized as having geographic significance such that small differences between the parties respective trademarks would be sufficient to diminish the likelihood of confusion.

19. The Board further erred in dissecting the marks and focusing only on their "unique aspects" before considering their resemblance.

20. It was incorrect for the Board to find that the REGINA MOLISANA Marks have acquired a substantial degree of distinctiveness and then focus exclusively on the perceived (and incorrect) low inherent distinctiveness of the marks in assessing confusion.

21. Conducting the correct and proper analysis, the Board should have concluded that each and every one of the s. 6(5) factors favoured Molisana Imports and that the marks are confusing.

22. The Board considered evidence that La Molisana S.p.A. ("**La Molisana**"), who is also opposing the Application, used the LA MOLISANA mark in Canada.

23. The LA MOLISANA mark has been predominantly used in association with dry pasta.

24. The REGINA MOLISANA Marks are not confusing with the LA MOLISANA mark. Moreover, there are express agreements between Molisana Imports and La Molisana that have ensured the distinctiveness of their respective marks. Consumers can and do distinguish between the REGINA MOLISANA Marks that are used with the

Molisana Imports Goods and the goods offered for sale in association with the LA MOLISANA marks. The Respondent has not shown otherwise.

25. The Board erred in finding that, because the REGINA MOLISANA Marks have co-existed for many years with the LA MOLISANA mark, consumers do not recognize the respective marks as distinctive. Consumers can and do distinguish between each of La Molisana's and Molisana Imports' trademarks. The REGINA MOLISANA marks are distinctive of Molisana Imports in association with the Molisana Imports' Goods.

26. Consumers are able to distinguish between the REGINA MOLISANA Marks and the LA MOLISANA mark. This does not mean, as the Board incorrectly found, that consumers are able to distinguish between the REGINA MOLISANA Marks and the Respondent's Mark. On the contrary, registration of the Respondent's Mark will undermine the distinctiveness that Molisana Imports has established in the REGINA MOLISANA Marks.

27. Consumers have consistently recognized the distinctiveness of the REGINA MOLISANA Marks.

28. In assessing confusion, the Board incorrectly dissected the marks, ignored the differences between the products sold in association with each mark, and incorrectly concluded that the "Molisana" element cannot be relied on by Molisana Imports to establish confusion with the Respondent's Mark.

29. The Board erred in reversing the onus. The onus was on the Respondent to show that the Respondent's Mark is not confusing with the REGINA MOLISANA Marks. The Respondent failed to meet that onus.

30. Consumers encountering the Respondent's Mark are likely to confuse it with the REGINA MOLISANA Mark.

31. Due to the multiple errors of fact and law committed by the Board in rendering the Decision, this appeal should be allowed, the Decision should be set aside, and the Application should be refused in its entirety.

32. The Applicant relies on:

- (a) The *Trademarks Act*, R.S.C. 1985, c. T-13;

- (b) The *Federal Courts Act*, R.S.C. 1985, c. F-7 and *Federal Court Rules*, SOR/98-106; and
- (c) Such further and other grounds as counsel may advise and this Honourable Court may permit.

THIS APPLICATION WILL BE SUPPORTED BY THE FOLLOWING MATERIAL:

1. The pleadings and proceedings herein, including the record before the Trademarks Opposition Board and the file maintained by the Registrar of Trademarks for the Application.
2. Such additional affidavits and documentary exhibits that may be served and filed pursuant to the *Trademarks Act* and the *Federal Courts Rules*.
3. Such additional material as counsel may advise and this Honourable Court may allow.

The Applicant requests that the Registrar of Trademarks send to the Applicant and to the Federal Court Registry a certified copy of the file history of Canadian Trademark Application No. 1,838,474, in accordance with rule 317 of the *Federal Courts Rules*.

May 3, 2024



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