



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2015 TMOB 190
Date of Decision: 2015-10-27

IN THE MATTER OF AN OPPOSITION

Juice Productions Inc.	Opponent
and	
Oriole Media Corp.	Applicant
1,525,820 for JUICE MOBILE & Design	Application

Introduction

[1] Juice Productions Inc. (the Opponent) opposes registration of the trade-mark:



[2] The application was filed on May 2, 2011 by Oriole Media Corp. (the Applicant) on the basis of proposed use in Canada in association with:

Mobile advertising services provided to advertising companies, brand managers and branded companies, namely (a) delivering advertisements for others to mobile devices, tablets and handheld gaming devices, and distribution of advertisements for others through mobile content channels; (b) collection and analysis of mobile advertising metrics for others, and providing advertising metrics reports to others; (c) design of mobile advertisements for others, including creation of text, audio, video, and graphical content for use in mobile advertisements and mobile landing pages (the Services).

[3] The Opponent filed a statement of opposition under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) wherein the grounds of opposition pleaded are based on sections: 30(a) and (e), 16(1)(a), (c) and 2 (distinctiveness). The main issues to be addressed in this opposition are whether the application meets all of the requirements listed in section 30 and whether there is a likelihood of confusion between the Mark when used in association with the Services and the Opponent's trade-mark JUICE and its trade name Juice Productions Inc.

[4] For the reasons explained below, I refuse the application.

The Record

[5] The application was advertised in the *Trade-marks Journal* on August 29, 2012. The Opponent filed its statement of opposition on October 17, 2012. The Applicant filed and served a counter statement on December 10, 2012 in which it denied each ground of opposition pleaded by the Opponent.

[6] The Opponent filed as evidence the affidavits of Andrew Buck, sworn on April 9, 2013 and Shantelle Garrick sworn on April 8, 2013.

[7] The Applicant filed as its evidence the affidavits of Tamara Shomody sworn on July 31, 2013, Lavinia McElwee sworn on August 1, 2013 and David Wong sworn on August 8, 2013. Mr. Wong was cross-examined and the transcript is part of the record.

[8] The Opponent filed as reply evidence a second affidavit of Mr. Buck sworn on April 28, 2014.

[9] Both parties filed a written argument and no hearing was held.

The parties' respective burden or onus

[10] The legal onus is on an applicant to show that its application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant. However, there is also an evidential burden on the opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the opponent means that in

order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* 2002 FCA 291, 20 CPR (4th) 155; and *Wrangler Apparel Corp v The Timberland Company* 2005 FC 722, 41 CPR (4th) 223].

Preliminary Remarks

[11] I wish to point out that, in reaching my decision, I have considered all the evidence in the file. Even though my decision is based on the relevant portions of the evidence filed by the parties, I will make reference to the exhibits filed by the Opponent, despite the fact that most of them cannot be considered, given the relevant dates associated with the grounds of opposition pleaded.

[12] I also wish to point out that the Applicant has objected to the content of the Buck affidavit filed as reply evidence on the basis that it does not constitute proper reply evidence. I will discuss this issue when reviewing its content.

The Relevant Dates

[13] The grounds of opposition raised by the Opponent must be assessed at the following relevant dates:

- section 30 of the Act: the filing date of the application (May 2, 2011) [see *Delectable Publications Ltd v Famous Events Ltd* (1989), 24 CPR (3d) 274 (TMOB) for section 30(a) and *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) for section 30(e)];
- sections 16(3)(a) and (c): the filing date of the application (May 2, 2011) [see section 16(3) of the Act];
- distinctiveness: it has been generally accepted that the distinctiveness of the Mark must be assessed at the filing date of the statement of opposition (October 17, 2012) [see *Andres Wines Ltd and E & J Gallo Winery* (1975), 25 CPR (2d) 126 at 130 (FCA) and

Metro-Goldwyn-Meyer Inc v Stargate Connections Inc (2004), 34 CPR (4th) 317 (FCTD)].

The Opponent's evidence

The Garrick affidavit

[14] Ms. Garrick has been a secretary employed by the agent for the Opponent's since April 2008. She states that, as part of her secretarial duties with the Opponent's agent firm, she has occasion to access various online databases and to conduct online searches throughout various search engines.

[15] Ms. Garrick visited on April 5, 2013 what appears to be the Applicant's website located at *www.juicemobile.org* and she filed as exhibit A print screen shots of the various webpages. On the same day, she also visited the Canadian Intellectual Property Office's (CIPO) website and she filed, as exhibits B and C respectively to her affidavit, extracts of the Online Wares and Services Manual concerning the terms 'delivery' and 'electronic' found under 'Services'.

The Buck Affidavit

[16] Mr. Buck is the Opponent's President and has held this position since June, 2004. He states that the Opponent is in the business of creating, writing and producing marketing material for others. The services offered by the Opponent in association with its trade mark JUICE and its trade name Juice Productions Inc. may be summarized as follows:

creating, writing and producing marketing materials for others for use in the entertainment, film, television and music fields; graphic design services; motion design and animation services; web interface application design services; digital asset management services; digital distribution services of content for film, music and television; operation of post-production facilities for film, music and television; authoring services for Digital Versatile Discs (DVDs) and high definition digital video discs (blue-rays).

[17] Mr. Buck states that more specifically, the Opponent delivers feature films and TV content to online platforms on behalf of the content rights holder (the "CRH"). The CRH will send the Opponent a copy of their content, such as a feature film, television show, music video, or

the like, and the Opponent would digitize, encode and package it in the format required by the particular distribution platform, be it iTunes, Netflix, Rogers VOD, etc.

[18] Mr. Buck affirms that:

- The Opponent typically receives prepared content such as movie trailers which it would then edit to a specific length for broadcast. Once the cut is complete and has been approved by its client, the final files or tapes are sent to the broadcaster;
- The Opponent also writes scripts, records voice-overs and performs final sound design.

(all the services described in paragraphs 16 to 18 will be referred to hereinafter as the JUICE Services).

[19] Mr. Buck alleges that the JUICE trade mark appears on all Non-Disclosure Agreements, contracts, the slates used in association with the Opponent's commercial editing services, all correspondence with the Opponent's clients, on all of its e-mails as well as on all invoices. To support such contention he filed, as exhibit A-1 to A-5, copies of such documentation.

[20] I note that exhibits A1, A2 and A5 are dated after the latest relevant date (October 17, 2012) and as such cannot be taken into consideration. As for the invoices filed as exhibit A4, the inscription 'Juice Productions' appears on them.

[21] Mr. Buck asserts that the Opponent has sold, marketed and performed its JUICE Services in Canada since at least as early as June 29, 2004 and continues to sell, market and perform its JUICE Services in association with the JUICE trade mark. He further states that the Opponent does business in every province and territory of Canada. He lists some of the Opponent's clients which include CBC, Alliance Films, Google, MTV, NetFlix, The NFB, Sony Music, Warner Brothers, Universal Music, to name a few.

[22] Mr. Buck affirms that the Opponent is one of the top providers of iTunes encoding and distribution services worldwide for movies, music and television. To support such allegation, he filed as exhibit B printouts of lists of Apple approved iTunes Movie, Music and TV Encoding Houses which lists 'Juice' under 'North America' heading. However, those printouts refer to

dates (January 9 and February 13, 2013) that are later than the latest relevant date (October 17, 2012). As such, they will not be considered in this decision.

[23] Mr. Buck provides the Opponent's annual revenues in association with its JUICE Services from July 1, 2004 to February 13, 2013 which vary from an excess of \$ 750,000 to over 2 million dollars.

[24] Mr. Buck filed as exhibit C samples of letterhead and stationary used by the Opponent on which appears the trade-mark JUICE and the inscription 'Juice Productions'. He states that such letterhead and stationary is representative of the manner in which the Opponent has used its trade name and trade-mark in Canada in association with its JUICE Services since June 29, 2004.

[25] Mr. Bucks also states that the Opponent has a website at *www.juiceproductionsinc.com* which has been operational since August 10, 2004. He asserts that this website is accessible to all Canadians with Internet access and receives approximately 1,000 hits per month. He filed as exhibit D printouts of some of the webpages from such website on which appears the trade-mark JUICE.

[26] The pages filed contain the following inscription: © JUICE 2012. Therefore those documents are not relevant when assessing the grounds of opposition having as a relevant date the filing date of the application (May 2, 2011). As for the distinctiveness ground of opposition, since the relevant date is August 29, 2012, it is not clear if those pages were on the Opponent's website prior to that relevant date. Mr. Buck does not state that those pages are representative of the webpages that appeared on the Opponent's website prior to any of the relevant dates. Consequently, they will not be considered as well.

[27] Mr. Buck further states that the Opponent has expended in excess of \$115,000 on advertising and has provided an annual breakdown from July 1, 2004 to February 2013. He alleges that the Opponent has recently participated in various media sponsorship events such as the Toronto International Film Festival (TIFF) as well as the Canadian International Documentary Festival (HotDocs). To support such allegation he filed as exhibit E a pamphlet advertising the 2011 TIFF as well as copies of relevant pages from the 2012 HotDocs Program Guide on which appears the trade-mark JUICE.

[28] Again, in so far as the TIFF pamphlet is concerned, there is no indication that it was distributed prior to the filing date of the application. It will therefore not be considered as relevant insofar as the grounds of opposition based on sections 30 and 16(3) are concerned. As for HotDocs, it refers to an event that took place between April 26 and May 6, 2012. There is no indication in Mr. Buck's affidavit that they were distributed prior to May 2, 2011. It will not be considered when determining if the application meets the requirements of section 30 and if the Applicant is entitled to the registration of the Mark.

[29] Finally, Mr. Buck filed as exhibit F a copy of the *Canada411.ca* Yellow Pages listing for Juice Productions. It has the reference © 2012. For the same reasons explained above, it will not be considered as relevant evidence for any of the grounds of opposition pleaded.

[30] I did not take into consideration the allegations made by Mr. Buck in paragraphs 10 and 22 of his affidavit. In paragraph 10, he alleges that the consuming public has identified and associated the trade-mark JUICE with the Opponent and in paragraph 22 he is alleging that the Applicant attempts to pass off on the Opponent's goodwill. The allegation contained in paragraph 10 relates to the distinctiveness of the Opponent's trade-mark and it is an issue that I have to rule on from the evidence in the record. Mr. Buck has not established himself as an expert in trade-mark law and as such I am giving no weight to such assertion. As for paragraph 22, it does not support any of the grounds of opposition pleaded.

The Applicant's evidence

The Shomody Affidavit

[31] Ms. Shomody has been employed as a Paralegal by the Applicant's agent firm. She states that on July 25, 2013 she instructed Lesley Rybchynski of Accu-Search Inc., a provider of NUANS corporate name searches and corporate registry services, to conduct a Canada-wide Preliminary Search of all companies whose corporate name either begins with the term 'Juice' or have such term as part of their corporate name and she filed as exhibit A the results of that search.

[32] Then, Ms. Shomody did 15 different Google searches to determine whether some of the entities revealed in the Preliminary Search are using their business names, trade names and/or trade-marks in the marketplace. The results of those searches were filed as exhibit B1- to B15 inclusive.

[33] I wish to point that such searches were conducted after all of the relevant dates.

The McElwee Affidavit

[34] Ms. McElwee is employed by the firm of the Applicant's agent as a Trade-mark paralegal. Between July 22 and July 31, 2013 she conducted various searches of the CIPO Trade-mark Database. I will refer later to the relevant portions of those searches. They were all performed after all of the relevant dates.

The Wong Affidavit

[35] Mr. Wong has been the Applicant's Director of Finance since August 20, 2012. He states that the Applicant was founded in 2010 and works with advertising agencies and brands to assist them in connecting with their consumers through mobile devices by providing mobile marketing, advertising, ad platforms, analytics and creative technology services.

[36] Mr. Wong states that the Applicant provides its services to over 100 brands across Canada. He filed as exhibit A a partial list of the Applicant's clients to whom it provides services. It includes Air Canada, BMO, Bell Canada, CBC, Canada Post, Fox Home Movies, Cogeco, Global, IBM, Cossette, Mediacom, to name a few. He explains that the Applicant assists these brands and agencies in crafting, executing and measuring marketing solutions on all connected devices, such as smart phones, computers, and tablets.

[37] Mr. Wong provides the following details in paragraph 8 of his affidavit with respect to the Services:

8. The Applicant's services include mobile database creation, short message service (a form of text messaging), mobile coupons, tickets, location lookup, Click2Call (a form of web-based communication) and surveys. The Applicant also provides its clients with construction and programming of all ad units and landing pages, mobile ad serving,

mobile APR and HTML hosting and cross platform mobile analytics. Additionally, the Applicant provides its clients with access to its professional services group for wireless application protocol and mobile ad creation including: full mobile websites, single and multi-brand landing pages, simple and animative (sic) creative content, rich expandable units and social integration and vanity URL's. Finally the Applicant will host, transcode, serve and measure all creative content on behalf of its clients.

[38] Mr. Wong alleges that the Applicant has been offering the Services in association with the Mark since at least as early as May 5, 2011. He filed as exhibit C a copy of one of the first invoices for Services provided in association with the Mark, dated May 5, 2011. For the same reasons detailed above, this portion of the evidence is not relevant in so far as the grounds of opposition based on sections 30 and 16 are concerned.

[39] Mr. Wong affirms that the Applicant operates a website since as early as November 2010 which was changed in February 2013. He filed excerpts of the Applicant's website as exhibit D1 (dated August 2011) and D2 (July 2013). Clearly exhibit D2 is later than any of the relevant dates and D1 would be relevant only in relation with the question about distinctiveness of the Mark or lack thereof.

[40] Mr. Wong asserts that the Applicant has promoted its Services in association with the Mark through a variety of means including magazines, websites, online promotions, mobile marketing campaigns, Google Adwords, client event sponsorships, speaking engagements, trade shows as well as social media including LinkedIn and Twitter, press releases including several sent over the wire (Market Wired), brochures and premiums. He filed as exhibit F1 to F3 samples of advertisements in magazines; as exhibits G1 to G6 (all dated after May 2, 2011) samples of proposals to prospective clients. Exhibits F2 (dated September 2012) and G1 to G6 are relevant only with respect to the distinctiveness ground of opposition, given the dates associated to these documents.

[41] Mr. Wong provides the Applicant's advertising and promotion spending in association with the Mark on a yearly basis starting in July 2011. The amounts total more than 190,000\$.

[42] To evidence that Services were provided in Canada, Mr. Wong filed invoices as exhibits H1 and H2. They are relevant only in so far as the distinctiveness of the Mark is concerned given the issued dates appearing on them are later than the filing date of the

application. He alleges that the Applicant's total sales for the Services offered in association with the Mark, from July 2011 to June 2013, were over 5 million dollars.

[43] Mr. Wong states that the Mark is also featured prominently in the Applicant's electronic communications and advertisements to Canadian clients. He explains that in communicating, performing, and advertising the Services, employees of the Applicant regularly conduct business and promotional e-mail communications with current and prospective clients in Canada. All e-mail communications with Canadian clients have featured the Mark above the signature line (where the employee name appears) since at least mid-2011. He filed as exhibit I samples of such emails. Again those emails are only relevant in so far as the ground of distinctiveness is concerned.

[44] Mr. Wong goes on to state that the Applicant frequently publishes news releases on its website related to the Services on which appears the Mark. He explains that the press releases can be found under the "News" heading of the Applicant's website. They discuss current marketing and partnership campaigns of the Applicant as well as awards and other industry recognition received by the Applicant. He filed samples of such press releases as exhibits J1 to J9. Given the dates appearing on these press releases, only exhibits J1 to J3 are relevant, and only in so far as the distinctiveness ground of opposition is concerned.

[45] Mr. Wong affirms that reference to the Mark in association with the Services has been made in various Canadian publications and he filed as exhibits K1 to K11 samples of some of these articles. None of the articles filed are relevant as they were all published after October 17, 2012.

[46] Finally, Mr. Wong states that he is not aware, nor has he been made aware by anyone from the Applicant, or its clients, of any cases of confusion of the Services with the services of the Opponent, or any other entity.

[47] I consider the following statements made by Mr. Wong during his cross-examination to be the more relevant parts:

- 'mobile advertising' are advertisements that appears on the screen of a mobile phone, or a tablet;

- The advertisers provide the content to the Applicant. The Applicant reconfigures the ad so that it can be shown on a mobile device;
- Some ads would have animation for a movie coming out for example;
- Some branded owners come to the Applicant directly, but most of the Applicant's business is done through agencies;
- 'Collection and analysis of mobile advertising metrics' is the measurement of the number of people who clicked on the ad;
- The invoice filed as exhibit C and dated May 5, 2011 was the first invoice depicting the Mark. Before that date, the Applicant used a different design mark;
- Between November 2010 and August 2011 the Applicant's website had a different look than the pages filed as exhibit D1;
- There is a distinction between media companies, namely newspapers or television companies and advertising companies.

The Opponent's reply evidence

The Second Buck Affidavit

[48] The content of Mr. Buck reply's affidavit is aimed at commenting on some of the answers provided by Mr. Wong during his cross-examination. Essentially, Mr. Buck is referring to some of the answers provided by Mr. Wong wherein the latter was asked to furnish details on some of the Services. Mr. Buck, after paraphrasing the answers given, then goes on to allege that the Opponent is providing the same type of service referred to in the answers given by Mr. Wong, without substantiating such allegation with documentary evidence.

[49] I agree with the Applicant's position with respect to the Opponent's reply evidence. Mr. Buck provides no dates or supporting documentation to substantiate his allegations that the Opponent performs 'identical' activities. In fact, most of his affidavit is written in the present tense with no reference to dates. As such, it is impossible to determine if the activities described by Mr. Buck in his affidavit took place prior to any of the relevant dates mentioned earlier. Any ambiguities in Mr. Buck's reply affidavit must be resolved against the Opponent.

[50] Moreover, much of the content of Mr. Buck's reply affidavit relates to subject matter that could have, and ought to have been included in Mr. Buck's rule 41 evidence. In fact, the answers commented by Mr. Buck concerned the Services and the wording of the questions asked uses the description of the Services. For example, question 50 is one of the follow up questions concerning 'mobile advertising services provided to advertising companies, brand managers and branded companies' (see question 40). The fact that the Opponent may perform the same type of services through different media should have been included in Mr. Buck affidavit in chief.

[51] To sum up, if the Opponent wanted to further substantiate the fact that it was offering and/or provided similar services to those described in the application, it could and should have done so in its evidence under Rule 41.

[52] I will now analyze each ground of opposition raised by the Opponent by taking into consideration only the evidence that I had determined to be relevant for each one of them.

Grounds of opposition based on section 30 (a) and (e) of the Act

[53] Nowhere in its written argument has the Opponent discussed these grounds of opposition. Without the benefit of arguments at an oral hearing or in a written argument, it is difficult to determine the merit of those grounds of opposition.

[54] As for the ground of opposition based on section 30(e) of the Act, the Opponent has not filed any evidence to support such ground. In fact, Mr. Wong, in his affidavit and during his cross-examination, has established that the Applicant has been using the Mark in association with the Services since at least May 5, 2011.

[55] Consequently, I dismiss this ground of opposition.

[56] In so far the ground of opposition based on section 30(a) is concerned, the Opponent did file some extracts of the Online Wares and Services Manual concerning the terms 'delivery' and 'electronic' under 'Services'. However, in the absence of argumentation on the part of the Opponent, I failed to see how these extracts would support the Opponent's contention.

[57] For these reasons, I dismiss the ground of opposition based on section 30(a) of the Act.

Ground of opposition based on section 16(3)(a) of the Act

[58] Under this ground of opposition the Opponent has the initial burden to prove that it has used its mark JUICE in Canada or that it was known in Canada prior to the relevant date (May 2, 2011) and that it had not abandoned such use at the date of advertisement of the present application (August 29, 2012) [see section 16(5) of the Act]. Despite the fact that the majority of the exhibits filed by Mr. Buck postdate the relevant date, still there is some evidence of use of the Opponent's trade-mark JUICE prior to May 2, 2011. Firstly, I refer to the following exhibit:

- Letterhead and stationary filed as exhibit C.

[59] As for the invoices filed as exhibit A4, I consider the use of 'Juice Productions' on the top left had corner to be use of the Opponent's mark JUICE. The word 'juice' is written in much larger letters and in a different script than the word 'productions' [see 88766 *Canada Inc v Phillips*, 2008 Carswell Nat 2206 (TMOB)].

[60] Consequently the Opponent has met its initial burden. Therefore, the Applicant must show, on a balance of probabilities, that the Mark is not likely to cause confusion with the Opponent's trade-mark JUICE when used in association with the Services.

[61] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trade-marks are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the services, or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC), *Mattel Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 96 CPR (4th) 361 (SCC)].

[62] The test under section 6(2) of the Act does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether a consumer, who sees the Applicant's Services in association with the Mark, would think they emanate from, or are sponsored by, or approved, by the Opponent.

Inherent distinctiveness of the trade-marks and the extent to which they have become known

[63] I do not consider one mark to be significantly more inherently distinctive than the other. The Opponent's trade-mark, despite being a common English word, has no relationship to the Opponent's JUICE Services. Likewise, the word JUICE in the Mark has no relationship to the Applicant's Services. Although the Mark has a design component, it also features the word 'mobile' which is suggestive of the type of devices which the Services are aimed at, and I find the slogan 'putting brands in hands' simply puts emphasis on 'JUICE MOBILE'.

[64] The degree of distinctiveness of a trade-mark may be enhanced through its use or promotion in Canada. The application is based on proposed use. At the relevant date, there was no use of the Mark.

[65] The Opponent's evidence described above does establish some use of the Mark at the relevant date. The Opponent's revenues for the Opponent's Juice Services totaled nearly 12 million dollars prior to the relevant date and it spent over \$90,000 in advertising during the same period. The Opponent has been offering its JUICE Services to various clients across Canada. For all these reasons I conclude that the Mark was known in Canada.

[66] This factor favours the Opponent.

Length of time the marks have been in use

[67] The application is based on proposed use while the Opponent has been using its trade-mark JUICE since June 2004. This factor favours the Opponent.

The nature of the goods and services and their channels of trade

[68] A great deal of the parties' argumentation relates to these factors. I have already described above, when summarizing the affidavits filed by both parties, their respective businesses and the nature of their trade.

[69] The Applicant argues it provides mobile advertising and marketing services to companies. It goes on to state in its written argument that the Applicant helps companies and advertising agencies prepare and distribute advertisement and marketing campaigns that are to be displayed on mobile devices such as phones and tablets, while the Opponent would provide post-production, voice-over, and trailer services to the entertainment, film, television, and music industry.

[70] I am of the opinion that this is a somewhat narrow interpretation of the nature of the Opponent's JUICE Services. As stated by Mr. Buck, the Opponent is in the business of, amongst others, creating, writing and producing marketing material for others, as does the Applicant. Consequently, there is an overlap in the nature of the parties' services. Where it differs, it is in the distribution platform: the Applicant's Services are aimed for mobile devices, such as phones and tablets, while the Opponent's distribution platforms are iTunes, Netflix, Rogers VOD. In all, the nature of some of the parties' services is the same, namely to provide marketing material for others.

[71] In fact during his cross-examination Mr. Wong admitted that the Applicant has done ads in the form of little banners for movies for mobile devices in static form but also with animation (see answers to questions 56 and following).

[72] There is also an overlap in the parties' clients. Both parties provide their services to Alliance, CBC, Sony Pictures and Universal Music when comparing the list of the Applicant's clients filed as exhibit B to Mr. Wong's affidavit with the Opponent's clients listed in paragraph 11 to Mr. Buck's affidavit. Therefore, there is also an overlap in the parties' channels of trade.

[73] In all, I consider those two factors favour the Opponent.

Degree of resemblance

[74] As stated by the Supreme Court of Canada in *Masterpiece*, in the majority of cases, the degree of resemblance between the marks in issue is the most important factor.

[75] The Mark is a composite mark comprising the components 'JUICE' and 'MOBILE' together with the slogan 'putting brands in hands', written in a much smaller font. There is also a design component. It consists of three overlapping small circles. I do not consider such design to be a dominant portion of the Mark. As such the main components of the Mark are 'JUICE' and 'MOBILE'. However, the latter clearly describes the type of electronic equipment to which the advertising services provided by the Applicant are aimed for, namely advertising services for mobile electronic equipment, such as phones and tablets.

[76] The fact remains that the Applicant has still incorporated the Opponent's trade-mark in its entirety into the Mark and it has done so in a way that the additional elements, such as the slogan portion at the end of the Mark, put emphasis on JUICE MOBILE.

[77] I agree with the Opponent that the idea suggested by the Mark, for a Canadian consumer, who is vaguely familiar with the Opponent's trade-mark JUICE, is that the Applicant's Services in association with the Mark are an offshoot of those offered by the Opponent in that they are targeting a particular segment, namely the 'mobile' segment.

[78] In all, I consider that there is a fair degree of resemblance between the marks in issue and consequently this factor favours the Opponent.

Additional surrounding circumstances

The state of the register and the marketplace

[79] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD)]. Inferences about the state of the marketplace can only be drawn from state of the register evidence where a

large number of relevant registrations have been located [see *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

[80] Even though Ms. McElwee performed the searches after the relevant date, the results could be relevant as long as the pertinent citations were on the register prior to the relevant date.

[81] Out of the 201 citations attached to Ms. McElwee's affidavit, some of them being duplication, the Applicant is relying on seven of them, listed in paragraph 29 of its written argument. Out of those seven citations, only five were registered at the relevant date. Application 1,544,811 for the trade-mark JUICEBOX and application 1,564,376 for JUICEBOX. MUSIC FOR KIDS were filed after the relevant date and were based on proposed use. Consequently, I do not consider them to be relevant.

[82] In all, there are therefore only five citations on the register that include the word JUICE as part of a trade-mark in association with what has been considered by the Applicant to be related services. This number is not sufficient to draw an inference that the word 'juice' was widely used at the relevant date as part of a trade-mark in association with the type of services offered by the parties.

[83] I wish to add that I am fully aware of the content of Ms. Shomody's affidavit. However Ms. Shomody performed searches on various websites after the relevant date. There is no evidence in the record that such extracts appeared on those websites, as filed, prior to the relevant date. Moreover, being third parties' websites, the filing of those extracts do not amount to proof of their content.

[84] Consequently, the evidence of the state of the register and of the marketplace does not assist the Applicant's case.

Absence of instances of confusion

[85] Mr. Wong alleges, in his affidavit, that he is not aware, nor that he has been made aware, of any instances of confusion. Again, under this ground of opposition, the relevant date is the filing date of the application. At such date, there was no use of the Mark, which explains the absence of instances of confusion. Even if I were to consider such factor at any later date, the

burden is on the Applicant to prove, on a balance of probabilities, that there is no likelihood of confusion with the Opponent's trade-mark. The burden is not on the Opponent to prove instances of confusion. Since the test is the likelihood of confusion, the absence of evidence of instances of confusion is not fatal to the Opponent.

Conclusion

[86] From this analysis, I conclude that the Applicant has not discharged its burden to prove, on a balance of probabilities, that the use of the Mark in association with the Services at the relevant date was not likely to cause confusion with the Opponent's trade-mark JUICE, when used in association with the Opponent's JUICE Services. I reach this conclusion on the basis that there is some resemblance between the marks in issue and there is some overlap in the parties' services and their channels of trade. The addition of MOBILE and a slogan put emphasis on the element JUICE.

[87] I, therefore, maintain the ground of opposition based on section 16(3)(a) of the Act.

Distinctiveness ground of opposition

[88] Under this ground of opposition the Opponent has the initial evidential burden to prove that its trade-mark JUICE had become sufficiently known in Canada as of October 7, 2012, the filing date of the statement of opposition (the relevant date under this ground of opposition), so as to negate any distinctiveness of the Mark [*Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FCTD)].

[89] In view of this later relevant date, some of the evidence filed by both parties, disregarded under the previous ground of opposition, needs to be considered under this ground of opposition. However, for the reasons detailed hereinafter, those additional elements of proof do not have an effect on the conclusion reached under the previous ground of opposition on the likelihood of confusion between the Mark when used in association with the Services and the Opponent's trade-mark JUICE.

[90] With respect to the Opponent's initial burden, the Opponent may rely on the following additional evidence of use of the Mark, namely:

- The TIFF pamphlet filed as exhibit E to Mr. Buck's affidavit;
- Additional sales of more than 1.5 million dollars;
- Additional advertising expenditures of more than \$11,000.

[91] From the evidence referred to under the previous ground of opposition, as well as the evidence described under the preceding paragraph, I conclude that the Opponent has met its initial burden to prove that its trade-mark JUICE was known to some extent in Canada as of October 17, 2012 so as to negate any distinctiveness of the Mark. Consequently the burden shifts on the Applicant which has to prove, despite such evidence, that the Mark distinguished or was apt to distinguish, at the relevant date, the Services from the Opponent's JUICE Services.

[92] I will now proceed to the analysis of the relevant criteria at the relevant date and will only describe the relevant additional evidence to be taken into consideration in view of the later relevant date. What has been considered under the previous ground of opposition remains relevant under this ground of opposition.

Inherent distinctiveness of the marks and the extent to which they have become known

[93] The analysis of the inherent distinctiveness of the marks remains the same. However, under this ground of opposition, I must take into consideration the evidence of use of the Mark as described above, and contained in Mr. Wong's affidavit, as long as such use is dated prior to October 17, 2012.

[94] The Applicant has filed some evidence of use of the Mark, namely:

- Pages of the Applicant's website filed as exhibit D1 to the Wong affidavit that go back to August 2011;
- Advertisement of the Mark published in September 2012 edition of Strategy Magazine filed as exhibit F2 to the Wong affidavit;
- Proposals provided to prospective clients filed by Mr. Wong as exhibit G1 to G6;
- Invoices filed as exhibits H1 and H2 to the Wong Affidavit relating to Services;
- Electronic communications (emails) on which appear the Mark filed as exhibit I to Mr. Wong's affidavit; and

- Press releases filed as exhibits J1 to J3 to Mr. Wong's affidavit wherein reference is made to the Mark.

[95] From this evidence, I conclude that the Mark was also used in Canada during the relevant period. As for the extent to which it was known, it is difficult to assess. The Applicant has not provided the revenues generated by the Services provided in association with the Mark during the relevant period. Mr. Wong does allege sales in excess of 5 million dollars for the period from July 2011 to June 2013. However, there is no breakdown per year and as such it is impossible to determine what portion of those sales took place before the relevant date. The same applies to the advertising expenditures.

[96] As for the Opponent's use of the JUICE trade-mark, I can add more than 1.5 million dollars in total sales (period of July 2, 2011 to July 2, 2012 as mentioned in paragraph 14 to Mr. Buck's affidavit) and an additional sum of \$11,000 in advertising expenditures during the same period (paragraph 18 to Mr. Buck's affidavit).

[97] Consequently, I determine that the Opponent's mark JUICE was more known than the Mark on October, 17, 2012.

Length of time the marks have been in use

[98] The Applicant has been using the mark since May 5, 2011 while the Opponent has been using its trade-mark Juice since June 2004. This factor favours the Opponent.

The nature of the goods and services and their channels of trade

[99] The additional evidence relevant under this ground of opposition, especially the evidence of use of the Mark by the Applicant described above, supports the prior finding that there is an overlap between the parties' services and their channels of trade. This factor also favours the Opponent.

Degree of resemblance

[100] The additional evidence relevant under this ground of opposition would not have any impact on the analysis of this factor. Consequently this factor also favours the Opponent.

The state of the register and the marketplace

[101] Even though the searches performed by Ms. McElwee and Ms. Shomody were performed after the relevant date, the references might be pertinent as long as there is evidence that the relevant citations were on the register or that there was some use in the marketplace of the trade-marks or trade names searched prior to the relevant date.

[102] With respect to the state of the register evidence, despite the fact that application 1,544,811 for the trade-mark JUICEBOX and application 1,564,376 for JUICEBOX. MUSIC FOR KIDS were filed before the relevant date, they were based on proposed use and they were not yet approved by the Registrar at the relevant date. Consequently, I do not consider them to be relevant.

[103] As for the searches performed by Ms. Shomody on the Internet, they were performed on July 25, 2013, after the relevant date. There is no evidence in the record that such extracts are representative of what appeared on those websites on or before the relevant date. Moreover, as mentioned before, being third parties' websites, the filing of those extracts do not amount to proof of their content.

[104] In all, I conclude that the evidence of the state of the register and of the marketplace does not assist the Applicant.

Absence of instances of confusion

[105] I have to consider the fact that there has been co-existence of the parties' marks during a period of time (May 5, 2011 and October 17, 2012). Mr. Wong alleges, as mentioned before, that he is not aware, nor that he has been made aware, of any instances of confusion. As explained previously, we do not know the extent of the Applicant's sales during that short period of time.

In any event as stated earlier, the burden is not on the Opponent to prove instances of confusion. The test is still the likelihood of confusion.

[106] In any event, I consider the period of coexistence to be too short to take into consideration this fact as a relevant factor.

Conclusion

[107] From this analysis, I conclude that the Applicant has not discharged its burden to prove, on a balance of probabilities, that the Mark, when used in association with the Services, was distinctive or apt to distinguish the Services from those of others, including the Opponent's JUICE Services. I reach this conclusion for similar reasons outlined under the previous ground of opposition.

[108] I, therefore, maintain the ground of opposition based on lack of distinctiveness of the Mark.

Ground of opposition based on section 16(3)(c) of the Act

[109] Given that the Opponent has been successful under two separate grounds of opposition, I do not need to rule on this last ground of opposition.

Disposition

[110] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application, pursuant to section 38(8) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

No hearing held.

Agents of Record

Riches, McKenzie & Herbert LLP

For the Opponent

Norton Rose Fulbright Canada LLP

For the Applicant