

**IN THE MATTER OF AN OPPOSITION  
by Lotte Confectionery Co. to application no.  
1,002,706 for the trade-mark CHOCOPIE  
& Red Rectangle Design filed by Tong  
Yong Confectionary Corporation**

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On January 22, 1999, the applicant Tong Yong Confectionary Corporation filed an application to register the trade-mark CHOCOPIE & Red Rectangle Design, shown below, for the wares listed below:

trade-mark



Colour is claimed as a feature of the mark. The rectangle surrounding the word CHOCOPIE is red. The word CHOCOPIE is white.

wares

- (1) sandwich cookie biscuits,
- (2) chocolates, ice-creams, biscuits, wafers, caramels, candies, breads, cakes, chewing gums, chocolate beverages with milk, chocolate-based beverages, cocoa-based beverages, puddings and pastry.

The subject application is based on use of the mark in association with the wares (1) since at least as early as 1998, and is based on proposed use of the mark in association with the wares (2). The applicant disclaimed the word PIE apart from the mark as a whole in response to an objection raised by the Examination Section of the Trade-marks Office.

The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated July 19, 2000 and was opposed by Lotte Confectionery Co. on September 12, 2000. The Registrar forwarded a copy of the statement of opposition to the applicant on October 10, 2000. The applicant responded by filing and serving a counter statement.

The statement of opposition alleges that:

- (a) the application does not comply with section 30(i) of the *Trade-marks Act* because, at the date of filing the application, the applicant knew that the term CHOCOPIE was either clearly descriptive or deceptively misdescriptive of the nature or quality of the applicant's wares,
- (b) the application does not comply with section 38(b) [sic] because at the date of filing the application the applicant was not using the subject mark,
- (c) the applied for mark is not registrable pursuant to section 12(1)(b) because the term CHOCOPIE is either clearly descriptive or deceptively misdescriptive of the character or quality of the applicant's wares,
- (d) the applied for mark is not distinctive of the applicant wares because it does not distinguish and is neither adapted to distinguish nor capable of distinguishing the applicant's wares from the wares of others.

The opponent's evidence consists of the affidavits of Sang-Hoon Huh, the attorney for the opponent in Seoul, Republic of Korea, and of H  l  ne Parent, secretary. Mr. Huh's affidavit serves to introduce into evidence, among other things, translations of trade-mark office reports of various

jurisdictions which have considered applications to register the mark CHOCOPIE for wares similar to the wares of the present application. The applicant's evidence consists of the affidavit of Susan McRae, trade-marks searcher. Her affidavit serves to introduce state of the trade-marks register evidence concerning marks prefixed by the component CHOCO covering confectionery items. Only the opponent submitted a written argument, however, only the applicant attended at an oral hearing.

As mentioned above, Mr. Huh's affidavit collates the responses of trade-mark offices in various jurisdictions to trade-mark applications for the term CHOCOPIE, or variations thereof.

Those responses are summarised below:

#### Hong Kong

The mark CHOCOPIE was refused because it was considered to be "both descriptive and indistinctive of the goods . . . which have chocolate flavour and in pie form."

#### Singapore

The mark CHOCOPIE was refused because ". . . the word 'Choco' is colloquially known as 'Chocolate.' Further, as it is common to find this word in this class, we are of the view that the reference of 'Choco' is non other than 'Chocolate.' . . . the mark is effectively telling the purchasing public that this is a chocolate flavoured or coated confectionery."

#### Korea

The mark CHOCOPIE GOLD was refused because ". . . 'CHOCOPIE' is considered as usual name of goods and have no distinctiveness of its own and 'GOLD' is used for meaning 'good quality of goods.' Therefore the trademark in totality is descriptive of quality of good and cannot be registered."

The mark CHOCO - PIE was refused because the trade-mark ". . . is considered as directly indicating the raw materials of the product and thus if it is used with its designated goods except pie, it will cause confusions among the consumers."

The marks LOTTE CHOCOPIE and CROWN CHOCO are registered trade-marks.

#### Taiwan

The registered trade-mark CHOCOPIE was declared invalid because the mark was considered to

be "descriptive of the goods," that is to say, the mark " . . . according to general social concept explains the goods per se or closely relates to the descriptiveness of the goods per se . . .

Russia

LOTTE CHOCOPIE is a registered trade-mark.

Guatemala

The mark CHOCOPIE was refused because it is "a word that has passed to general use and serves to indicate the nature of the products that are claimed to be covered, and also corresponds to the common name of the product that claims to cover."

Mr. Huh's affidavit also serves to introduce into evidence an extract from *Abbreviations Dictionary*, Ninth Edition, CRC Press which lists "choco" as an abbreviation for the word "chocolate."

Ms. Parent's affidavit serves to introduce into evidence copies of pages from *The Merriam-Webster Collegiate Dictionary*, Tenth Edition and *The Concise Oxford Dictionary*, Ninth Edition which list the following words: pie, chocoholic, chocolate, chocolatier and chocolaty. I note that the term "choco" is not listed in the above dictionaries.

Ms. McRae's evidence, filed on behalf of the applicant, shows that there are about 28 registered trade-marks, and about 13 trade-mark applications, for marks comprised of the term CHOCO for use in association with confectionary, or confectionary-like products, owned by a variety of traders. For example, cited in her evidence are the design marks CHOCOPIE (regn. nos. 556,615 and 555,211 owned by the present applicant); CHOC-O-CRUNCH (regn. no. 194,459 owned by Cadbury Trebor Allan Inc.); CHOCO BUDS (regn. no. 356,525 owned by

Foley's Candies Ltd.); CHOCO FIZZ (regn. no. 463,643 owned by Zeta Espacial S.A.); CHOCO POP (regn. no. 427,142 owned by Les Produits Déli-Bon Inc.); CHOCO SQUARES (regn. no. 375,584 owned by 3651410 Canada Inc.); CHOCO-FUDGE (regn. no. 325,698 owned by Les Aliments Tradition Inc) and CHOCO-LAIT (regn. no. 477,827 owned by Parmalat Food Inc.).

The opponent has not submitted any evidence to support the second ground of opposition denoted by (b) above. The second ground is therefore rejected because the opponent has failed to put the second ground into issue. The remaining grounds of opposition turn on the issue of whether the applied for mark CHOCOPIE & Design is either clearly descriptive or deceptively misdescriptive of the nature or quality of the applicant's wares. This Board had occasion to consider an almost identical issue in a case involving the present parties: see *Lotte Confectionery Co. v. Tong Yang Confectionery Corp.* (2001), 13 C.P.R. (4th) 182. In the above mentioned case, the mark at issue was the design mark **CHOCOPIE** for proposed use in association with a number of confectionery items and baked goods including pies. The "design" element of the mark consists of the letters C and P appearing in a larger font than the remaining letters. The Board accepted the opponent's argument that the term "chocopie" would be understood by consumers as clearly describing a chocolate pie, however, the Board did not accept that the term clearly describes or deceptively misdescribes any of the other confectionary items:

at pg 187

However, with respect to the remaining wares, the word CHOCOPIE is clearly not descriptive since the wares are not "pies". The question therefore becomes whether or not the mark is deceptively misdescriptive of the applicant's non-pie wares.

at pg 188

I conclude that the present applicant's mark is not deceptively descriptive of the character or quality of chocolates, ice-creams, wafers, caramels, candies, breads, cakes, chewing gums, cookies, puddings, or pastries for the simple reason that an average user or dealer of such wares will not be deceived into thinking that they are "chocolate pies" simply because they bear the CHOCOPIE Design trade-mark. At most, they might conclude that the trade-mark suggests that the wares in question have a flavour reminiscent of "chocolate pie". They might also respond to the trade-mark merely as a fanciful, nonsense word given that CHOCOPIE per se is not a word in the English or French language and the recognition of it as a combination of the two words CHOCO and PIE might not be readily apparent when it is associated with wares other than pies.

The opponent has also pleaded that the applicant's mark is not distinctive. The legal onus is on the applicant to show that its mark was adapted to distinguish or actually distinguished its wares from the wares of others as of the filing of the opposition. As discussed above, I have found that the applied for mark is clearly descriptive of "pies" and therefore the mark is not distinctive with respect to such wares. However, given my conclusion that the mark is not clearly descriptive of the remaining wares, the distinctiveness ground of opposition does not succeed with respect to the wares other than "pies".

Mr. Huh's evidence of trade-mark application outcomes in other jurisdictions is not helpful in the instant case because the legal principles governing those decisions are not in evidence. In any event, from my perusal of the cases presented by Mr. Huh, it would seem that Canadian jurisprudence has taken a more lenient approach to categorizing marks by introducing the concept of "suggestive" marks. That is, marks which may be considered clearly descriptive or descriptive and therefore not registrable in other jurisdictions may be considered merely suggestive in Canada and therefore registrable. Certainly Ms. McRae's state of the register evidence, and the reasoning

in the *Lotte* case, above, supports this perspective.

Considering the above, I apply the same reasoning in the instant case as the Board applied in the *Lotte* case, above, and I find that at all material times the applied for mark was not clearly descriptive nor deceptively misdescriptive of the character or quality of the applicant's wares. Accordingly, the opponent's opposition is rejected.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 23rd DAY OF JANUARY, 2006.

Myer Herzig,  
Member,  
Trade-marks Opposition Board