



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

**Citation: 2012 TMOB 152**  
**Date of Decision: 2012-08-01**

**IN THE MATTER OF AN OPPOSITION by  
Saputo Boulangerie Inc./Saputo Bakery Inc. to  
Application No. 1,395,512 for the trade-mark  
UP & GO filed by Healthier Creations LLC.**

The file record

[1] On May 14, 2008 The Healthier Creations Co. LLC (which subsequently changed its name to Healthier Creations LLC) (the Applicant) filed application No. 1,395,512 to register the trade-mark UP & GO (the Mark), on the basis of proposed use in Canada.

[2] The application was advertised on September 23, 2009 in the Trade-marks Journal for opposition purposes. It was amended on May 19, 2010 such that it now covers: Soy-based food beverages used as a milk substitute; soy based non-carbonated non-alcoholic beverages not being milk substitutes; soy based non-carbonated non-alcoholic beverages containing macadamia nut oil extracts not being milk substitutes (the Wares).

[3] Saputo Boulangerie Inc./Saputo Bakery Inc. (the Opponent) filed on October 19, 2009 a statement of opposition forwarded on November 17, 2009 by the Registrar to the Applicant.

[4] In a counter statement filed on January 14, 2010 the Applicant denied all grounds of opposition.

[5] The Opponent filed as its evidence the statutory declaration of Lionel Etedgui while the Applicant filed the affidavit of Jim Richards and two affidavits of Lisa Saltzman. Both parties filed written arguments and were represented at a hearing held by way of conference call.

#### The statement of opposition

[6] The grounds of opposition pleaded can be summarized as follow:

1 The application does not conform to the requirements of section 30(i) of the *Trade-marks Act* RSC 1985, c T-13, (the Act) in that it is falsely that the Applicant has claimed to be satisfied to use the Mark in Canada in association with the Wares in view of the content of what is stated hereinafter;

2 The Mark is not registrable pursuant to the provisions of sections 38(2)(b) and 12(1)(d) of the Act in that the Mark is confusing with the following trade-marks:

HOP & GO! & Design, registration number TMA507,197 registered in association with various food products;

HOP! & Design registration number TMA507,179 registered in association with various food products;

HOP & GO!, registration number TMA579,492 registered in association with snack food and desserts;

HOP & GO! & design, registration number TMA652,257 registered in association with snack food and desserts.

3 The Applicant is not the person entitled to registration of the Mark pursuant to the provisions of sections 38(2)(c) and 16(3)(a) of the Act as the Mark is confusing with the abovementioned trade-marks previously used in Canada by the Opponent in association with the wares identified above since at least as early as January 8, 1999 with respect to the first three trade-marks mentioned in the preceding paragraph and since at least as early as January 2005 in so far as the last trade-mark is concerned;

4 Pursuant to sections 38(2)(d) and section 2 of the Act, the Applicant's Mark is not distinctive, and is not capable of distinguishing or adapted to distinguish the Applicant's Wares in view of the use and registration by the Opponent of the trade-marks mentioned above.

#### Burden of proof and relevant dates

[7] The legal onus is upon the Applicant to show that its application complies with the provisions of the Act, but there is however an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts

alleged to support each ground of opposition exist. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E Seagram & Sons Ltd et al v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) and *Wrangler Apparel Corp v The Timberland Company* [2005] FC 722].

[8] The relevant date for the analysis of each ground of opposition varies depending on the ground of opposition to be assessed:

- Non-compliance with the requirements of section 30 of the Act: the filing date of the application (May 14, 2008);
- Registrability of the Mark under section 12(1)(d) of the Act: the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 at 424 (FCA)]
- Entitlement to the registration of the Mark, where the application is based on proposed use: the filing date of the application (May 14, 2008) [see section 16(3) of the Act];
- Distinctiveness of the Mark: the filing date of the statement of opposition (October 19, 2009) [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)].

#### Section 30(i) ground of opposition

[9] All that is required from an applicant under section 30(i) of the Act is to provide a statement that it is satisfied that it is entitled to use the trade-mark applied for in Canada in association with the wares and services described in the application. The application filed does contain such statement. A section 30(i) ground of opposition should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 at 155]. There is no evidence to that effect in the record. Therefore the first ground of opposition is dismissed for failure by the Opponent to meet its initial burden.

Registrability under Section 12(1)(d) of the Act

[10] Mr. Ettedgui has been working for the Opponent since February 2009 and has been the President of Saputo Boulangerie Inc (Canada). I wish to point out that nowhere in his affidavit Mr. Ettedgui does provide information as to the relationship between Saputo Boulangerie Inc (Canada) and the Opponent. Any ambiguities caused by such anomaly shall be interpreted against the Opponent.

[11] He filed a copy of the certificates of registration for the following registered trade-marks:  
HOP & GO!, certificate of registration TMA579,492 issued on April 14, 2003;  
HOP & GO! & Design as illustrated hereinafter, certificate of registration TMA507,197 issued on January 27, 1999:



**HOP & GO!**

HOP! & Design as illustrated hereinafter, certificate of registration TMA507,179 issued on January 27, 1999:



**HOP!**

HOP & GO! & design as illustrated hereinafter, certificate of registration TMA652,257, registered on November 4, 2005:



**HOP & GO!**

[12] I checked the register and all these registrations are extant. They cover snack food such as muffin bars, galetttes bars and granola bars, mini bites, multigrain snacks and high end snacks, as well as cakes, pastries, soup base and dehydrated sauces. Consequently the Opponent has met its initial burden.

[13] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks or trade-names 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 wares, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks or trade-names 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 *Clorox Co v Sears Canada Inc* (1992), 41 CPR (3d) 483 (FCTD) and *Gainers Inc v Marchildon* (1996), 66 CPR (3d) 308 (FCTD)]. I also refer to the judgments of the Supreme Court of Canada in *Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée et al* (2006), 49 CPR (4th) 401 and *Mattel Inc v 3894207 Canada inc* (2006), 49 CPR (4th) 321 where Mr. Justice Binnie commented on the assessment of the criteria enumerated under section 6(5) to determine if there is a likelihood of confusion between two trade-marks.

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

[14] The Mark is composed of two common words in the English language. Moreover the combination of the two words in the Mark used in association with the Wares suggests that they are for people in a hurry. Overall I conclude that the Mark is not an inherently strong mark.

[15] The Opponent's registered trade-marks HOP & GO!, HOP & GO! & Design and HOP & GO! & design (the HOP & GO! trade-marks) are also composed of two common English words. The combination of the two words "hop" and "go" suggests the idea of movement or people on the move and suggest that they are for people in a hurry. The design element of the trade-marks HOP & GO! & Design and HOP & GO! & design adds to the distinctiveness of those marks.

[16] The distinctiveness of a trade-mark can be enhanced through its use or promotion. Mr. Etedgui states that the Opponent is in the business of offering for sale food products such as pastries, cakes, muffin, muffin bars, granola bars, cookies, tarts, brownies and the like. The Opponent has been selling in Canada since at least May 1998 muffin bars, galettes bars and granola bars in association with the trade-mark HOP & GO!.

[17] He provides the sales figures of products bearing the trade-mark HOP & GO! We have no indication if those figures include the sale of products in association with the design trade-marks. However I consider the use of the trade marks HOP & GO! and Design and HOP & GO!

and design to be use of the trade-mark HOP & GO!. Those sales vary from over \$5 million in 1998 to in excess of \$11 million in 2002. For the years 2003 to 2009 he provides not only the annual total sales figures, but also a breakdown by Canadian region. The annual sales during that period are not less than \$7.3 million.

[18] He filed sample invoices to illustrate the sale of products bearing the trade-mark HOP & GO!. However the invoices are issued by Saputo Bakery Division. We have no information in Mr. Ettedgui's affidavit as to the relationship between Saputo Bakery Division and the Opponent. I raised this issue at the hearing and the agent for the Opponent took the position that I have to assume or infer that, if it is not one and the same, it is a subsidiary and/or licensee of the Opponent. It could also be the Opponent's predecessor-in-title or simply a trade-name used by the Opponent. However none of these scenarios are explained by Mr. Ettedgui. As a consequence I cannot assume that those invoices were issued by the Opponent.

[19] The Opponent has been promoting the trade-mark HOP & GO!. Mr. Ettedgui provides the sums of money spent between 1998 and 2008 by the Opponent which have been in excess of \$700,000 on a yearly basis save and except for the year 2000. He filed as exhibit LE-4 to LE-12 samples of marketing material (flyers, sales sheets, videotapes of television commercials, transcript of samples of radio commercials, etc.) and articles published in newspapers and magazines on which appears the trade-mark HOP & GO!.

[20] Despite the fact that I cannot associate the invoices filed by Mr. Ettedgui to the Opponent, still some of the promotional material makes reference to the Opponent and some to Saputo Bakery Group Inc., identified on the certificates of registration filed by Mr. Ettedgui as the Opponent's predecessor in title. Moreover the packaging of the various products bearing the trade-mark HOP & GO!, filed by Mr. Ettedgui as exhibit LE-13 to his affidavit, does make reference to the Opponent. For these reasons I consider the Opponent's trade-mark HOP & GO! to be known to some extent in Canada in association with snack food.

[21] Mr. Richards has been the Applicant's Vice President Sales and Marketing since February 2010. He discusses the use of the Mark in association with the Wares in Australia. However there is no allegation of use of the Mark in Canada.

[22] From all this evidence I conclude that the first factor mentioned in section 6(5) of the Act favours the Opponent.

*The length of time the trade-marks or trade-names have been in use*

[23] As for the length of time the trade-marks have been in use, as mentioned earlier, I cannot assume that the invoices filed by Mr. Ettedgui were issued by the Opponent or its predecessor in title. However the various packaging (exhibit LE-13 to Mr. Ettedgui's affidavit) makes reference to the Opponent. The latter is identified on the certificate of registrations as the owner of the HOP & GO! trade-marks since April 1, 2008. Consequently I conclude that the Opponent has been using the trade-mark HOP & GO! since at least as early as April 1, 2008. Accordingly this factor does favour the Opponent.

*The nature of the wares, services, or business; the nature of the trade*

[24] The Applicant argues that the Wares are non-dairy meal replacement beverages while the Opponent's trade-mark HOP & GO! is used in association with a variety of baked, dry food. On the other hand the Opponent argues that the wares do not need to be identical to have a likelihood of confusion as stipulated in section 6(2) of the Act [see also *Mattel, supra*].

[25] I agree with the Opponent. Both parties' products are alimentary products and could be consumed to achieve the same purpose, namely as a meal replacement, when one compares the Wares with a muffin bar for example. There is therefore an overlap in the nature of the parties' wares.

[26] As for the channels of trade, Mr. Ettedgui does state in his affidavit that the Opponent's products are offered for sale at the retail level in convenience stores, grocery stores and mass

merchandisers as well as to institutions such as restaurants and hotels. Mr. Richards alleges that the Wares would be sold in grocery, gas and convenience stores. As such there is clearly an overlap in the parties' channels of trade. Consequently these factors also favour the Opponent.

*The degree of resemblance*

[27] In its judgment in *Masterpiece Inc v Alavida Lifestyles Inc et al* 2011 SCC 27, the Supreme Court of Canada has clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks.

[28] The Applicant argued at the hearing that the marks in issue are pronounced differently. It may very well be that an average English speaking person may pronounce differently the words "HOP" and "UP". However there still exists some resemblance in sound. There is also a similarity in the ideas suggested by the marks in issue, namely food products for people on the run and easy to carry.

[29] The Applicant argues that the first word of the parties' trade-marks is different and thus the marks are distinguishable. It may be so. However as mentioned previously, phonetically they are similar. One must remember that it is always the first impression that matters (see *Masterpiece, supra*).

*Additional surrounding circumstances*

[30] The Applicant asserts that the state of the register evidence shows that "HOP" and "UP" are words commonly used for similar wares as demonstrated by the content of Ms. Saltzman's affidavits.

[31] Ms. Saltzman has been employed as director of the trade-mark searching department with Onscope™, a division of Onscope Group Inc. She states that part of her employment responsibilities is to review and search the files and records of CIPO.

[32] She states that on July 10, 2010 the Applicant's agent requested a trade-mark search for the commonality of the expression UP on the trade-mark register in Canada in association with food products. She filed the results of such search as Exhibit 1 to her affidavit.

[33] She filed another affidavit with respect to another search requested by the Applicant's agent for the commonality of the expression HOP on the trade-mark register in Canada in association with food products. She filed the results of such search as Exhibit 2 to her affidavit.

[34] Except for references to UP & GLO (application No. 1,401,848) and UP & GLOW (application No. 1,401,849) no detailed analysis of the state of the register evidence has been provided by the Applicant either in its written argument or at the hearing. I do not consider it the duty of the Registrar to look at the state of the register evidence and try to determine which of the 56 citations in one affidavit and of the 236 citations in the other affidavit the Applicant is relying on. A party may present an argument based on the evidence filed but there is no obligation on the Registrar to independently ascertain if an argument could be made in favour of one party from the results of a search of the register.

[35] It might be that the words "UP", "HOP" and "GO" are components of several trade-marks; it remains that the Opponent's combination of the words "HOP" and "GO" is unique when used in association with food products.

### *Conclusion*

[36] I conclude that, on a balance of probabilities, a consumer with an imperfect recollection of the Opponent's registered trade-marks HOP & GO! would think that the Wares sold in association with the Mark originate from the Opponent. The wares of the respective parties are in the same general category of goods, namely food products that could be eaten at the same time or used for the same purpose, namely as a meal substitute or snack. There exists some resemblance visually, in sound and in the ideas suggested by the marks in issue.

[37] Consequently I maintain the second ground of opposition.

### Distinctiveness ground of opposition

[38] Under this ground of opposition the Opponent has the initial evidential burden to prove that the HOP & GO! trade-mark had become sufficiently known in Canada on October 19, 2009, the filing date of the statement of opposition, so as to negate any distinctiveness of the Mark [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 and *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FCTD)].

[39] Despite the fact that the invoices filed in the record cannot be associated with the Opponent for the reasons detailed above, there remain allegations in Mr. Ettegui's affidavit about the Opponent's and its predecessor-in-title's yearly sales. Moreover the samples of packaging filed as exhibit LE-13 to Mr. Ettegui's affidavit bearing the trade-mark HOP & GO! make reference to the Opponent which is the registered owner of the HOP & GO! trade-marks since April 1, 2008. Therefore I am satisfied that such evidence is sufficient for the Opponent to meet its initial evidential burden. As such the Applicant has to prove, on a balance of probabilities, that the use of the Mark in association with the Wares would not likely cause confusion with the Opponent's trade-mark UP & GO!.

[40] The difference in the relevant dates, when assessing the registrability and distinctiveness grounds of opposition, would not alter the results of my analysis of the relevant factors detailed above. Consequently I also maintain the distinctiveness ground of opposition.

### Entitlement ground of opposition

[41] The Opponent having been successful under two separate grounds of opposition, it is not necessary for me to analyze the third ground of opposition.

Disposition

[42] Having been delegated authority by the Registrar of Trade-marks by virtue of section 63(3) of the Act, I refuse the Applicant's application, the whole pursuant to section 38(8) of the Act.

---

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