



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

**Citation: 2016 TMOB 15**  
**Date of Decision: 2016-01-27**

**IN THE MATTER OF AN OPPOSITION**

**Imperial Tobacco Products Limited**

**Opponent**

**and**

**Philip Morris Brands Sarl**

**Applicant**

**Application No. 1538723 for the trade-  
mark ICEBALL**

**Application**

Overview

[1] The parties in the present proceeding are not strangers. They are direct competitors in the Canadian cigarette market.

[2] The Applicant has applied to register the trade-mark ICEBALL based on proposed use in Canada in association with raw or manufactured tobacco, tobacco products and smokers' articles.

[3] The Opponent owns a number of registrations for trade-marks in Canada including the trade-marks ICE, KOOL and FROST (and their French language equivalents), each of which has been previously used in association with tobacco products. The principal substantive issue in this proceeding is whether there is a reasonable likelihood of confusion between the Applicant's ICEBALL mark and one or more of the Opponent's registered marks.

[4] For the reasons that follow, I find that this application should be refused.

## The Record

[5] The application for the Mark covers the following goods:

(1) Tobacco, raw or manufactured; tobacco products, namely, cigars, cigarettes, cigarillos, tobacco for roll your own cigarettes, pipe tobacco, chewing tobacco, snuff tobacco, kretek; snus; tobacco substitutes (not for medical purposes); smokers' articles, namely, cigarette paper and tubes, cigarette filters, tobacco tins, cigarette cases and ashtrays, pipes, pocket cigarette rollers, lighters; matches.

[6] The application for the Mark was advertised for opposition purposes in the *Trade-marks Journal* of May 2, 2012, and an opposition was brought by the Opponent under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) on June 28, 2012. The Opponent has raised grounds of opposition based upon sections 2 (non-distinctiveness), 12 (non-registrability), 16 (non-entitlement) and 30 (non-conformity) of the Act.

[7] The Applicant filed a counter statement on September 6, 2012, denying each of the allegations set out in the statement of opposition.

[8] On December 21, 2012, the Opponent requested leave to file an amended statement of opposition and leave was granted on February 27, 2013.

[9] As evidence in support of its opposition, the Opponent filed the affidavit of Richard Fraser and certified copies of the following Canadian trade-mark registrations owned by the Opponent (collectively referred to as the ICE/KOOL/FROST group of marks), the registered goods for which are set out in Schedule A.

TMA755400 for ICE

TMA721602 for GLACÉ

TMA595388 for FROST

TMA595445 for GIVRÉ

TMA743842 for GIVRÉE

UCA1349 for KOOL

TMA592134 for KOOL FROST

TMA592358 for KOOL FROST & Design

TMA592133 for KOOL GIVRÉ

TMA591545 for KOOL GIVRÉ & Design

[10] Mr. Fraser was cross-examined. His cross-examination transcript and replies to undertakings form part of the record.

[11] As evidence in support of its application, the Applicant filed the affidavits of Nicole Zeit, Zdena Nagyova and Mary P. Noonan. None of these affiants was cross-examined.

[12] Both parties filed a written argument. A hearing was held at which both parties attended.

#### Preliminary Issue - Licensing

[13] As a preliminary matter, I will address the issue of whether the use of each of the Opponent's marks in Canada inures to its benefit pursuant to section 50 of the Act.

[14] The only way that third party use of a trade-mark is deemed to be that of the registered trade-mark owner is when section 50 of the Act is satisfied. Sections 50(1) and (2) are reproduced below:

50. (1) For the purposes of this Act, if an entity is licensed by or with the authority of the owner of a trade-mark to use the trade-mark in a country and the owner has, under the licence, direct or indirect control of the character or quality of the wares or services, then the use, advertisement or display of the trade-mark in that country as or in a trade-mark, trade-name or otherwise by that entity has, and is deemed always to have had, the same effect as such a use, advertisement or display of the trade-mark in that country by the owner.

(2) For the purposes of this Act, to the extent that public notice is given of the fact that the use of a trade-mark is a licensed use and of the identity of the owner, it shall be presumed, unless the contrary is proven, that the use is licensed by the owner of the trade-mark and the character or quality of the wares or services is under the control of the owner.

[15] I will now summarize the evidence of the Opponent's affiant, Mr. Fraser. Mr. Fraser is Brand Manager of the du Maurier brand which is currently owned by du Maurier Company, Inc.

Both the Opponent and du Maurier Company Inc. are subsidiaries of Imperial Tobacco Canada Limited (ITCan), Canada's leading tobacco company with more than 500 employees across Canada (Fraser, para. 5). Prior to his current position, Mr. Fraser held a variety of sales, marketing, analysis and brand management positions with ITCan, which included the management and oversight of the trade-marks of the Opponent.

[16] Pursuant to a license agreement between the Opponent and ITCan (the ITCan agreement), ITCan has manufactured or has had manufactured for it, marketed and sold in Canada cigarettes in packaging bearing the ICE and GLACÉ marks since 2008 (Fraser, para. 7). The product is sold in bilingual packaging throughout Canada, where one side is in English bearing the ICE mark and the other side is French bearing the GLACÉ mark (Fraser, Exhibit B). ICE and GLACÉ cigarettes are sold in Canada by ITCan to cigarette retailers, through ITCan's distributor and subsidiary Imperial Tobacco Company Limited (ITCo) which in turn sell the cigarettes to adult smokers (Fraser, para. 7 and para. 8). Attached as Exhibit B to Mr. Fraser's affidavit are photographs of all sides of the sample packaging of the ICE and GLACÉ cigarettes, which are representative samples of those used in Canada since 2009 to the present.

[17] Mr. Fraser explains at paragraph 6 of his affidavit that pursuant to the ITCan agreement, the Opponent has direct and indirect control of the character and quality of the tobacco products sold by ITCan under the license. In particular, the license includes terms which compel ITCan to manufacture and package goods under the Opponent's trade-marks strictly in accordance with specifications and standards supplied by the Opponent, to submit production materials used in the manufacture of the relevant goods to the Opponent for approval, to submit samples of final product to the Opponent for approval and to make its premises available for inspection by the Opponent at any time (Fraser, para. 6). The license also grants to ITCan the right to sub-license its rights to others.

[18] A summary of the sales of the ICE/GLACÉ cigarettes as provided by Mr. Fraser at paragraph 9 of his affidavit is below:

## ICE/GLACÉ

<b>YEAR</b>	<b>VOLUME</b>	<b>SALES</b>
2008 – 2010	79,600 cigarettes	\$9,970
2011 – November 2012	39,800 cigarettes	\$3,930

[19] ITCan continues to sell ICE/GLACÉ cigarettes to cigarette retailers through its distributor in Canada. Marked as Exhibit C are copies of sample invoices relating to sales of the ICE and GLACÉ products to cigarette retailers in Canada, representative of those issued since 2008 to the present. Mr. Fraser explains that the products are listed as ICE on invoices to retailers in Canada (excluding the province of Quebec) and as GLACÉ on invoices to retailers in the province of Quebec.

[20] With respect to the KOOL, FROST, and GIVRÉ marks, Mr. Fraser states that KOOL cigarettes have been sold in Canada for decades, and the FROST and GIVRÉ cigarettes have been sold in Canada under the KOOL brand (as KOOL FROST/GIVRÉ) since at least as early as 2002, pursuant to the ITCan agreement (Fraser, para. 11). He explains that the FROST and GIVRÉ product is sold in bilingual packaging throughout Canada, where one side is in English bearing the FROST mark and the other side is in French bearing the GIVRÉ mark. Photographs of all sides of sample packaging of KOOL, KOOL FROST/GIVRÉ cigarettes which are representative examples of those continuously used in Canada since 2002, are attached to his affidavit as Exhibit D.

[21] A summary of the sales of the KOOL FROST/GIVRÉ cigarettes as provided by Mr. Fraser at paragraph 13 of his affidavit, is below:

## **KOOL FROST/GIVRÉ**

<b>Year</b>	<b>Volume</b>	<b>Sales</b>
2002 and 2010	69 million cigarettes	\$11.5 million
2011 – December 2012	42,000 cigarettes	\$4,000

[22] At paragraph 14 of his affidavit, Mr. Fraser states that the FROST and GIVRÉE marks have been used in Canada under the CAMEO brand (as CAMEO FROST and CAMEO GIVRÉE) since at least as early as 2007. Pursuant to a license agreement between the Opponent and Cameo Inc. (the Cameo agreement), Cameo Inc. is licensed to use the Opponent's FROST and GIVRÉE trade-marks in association with the manufacture and sale of tobacco products. Similar to the ITCan agreement, Mr. Fraser states that under the Cameo agreement the Opponent has direct and indirect control of the character and quality of the tobacco products manufactured and sold by Cameo Inc. under the license (Fraser, para. 14). In particular, the license includes terms which compel Cameo Inc. to manufacture and package goods under the Opponent's trade-marks strictly in accordance with specifications and standards supplied by the Opponent, to submit production materials used in the manufacture of the relevant goods to the Opponent for approval, to submit samples of final product to the Opponent for approval and to make its premises available for inspection by the Opponent at any time (Fraser, para. 14).

[23] Mr. Fraser explains that the CAMEO FROST/GIVRÉE products are sold to cigarette retailers in Canada in bilingual packaging, where one side is in English bearing the FROST mark and the other side is in French bearing the GIVRÉE mark. Attached as Exhibit G to his affidavit are photographs of all sides of a sample packaging of CAMEO FROST/GIVRÉE cigarettes, which is a representative example of those continuously used in Canada since 2007 to 2011 (Fraser, para. 15).

[24] A summary of the sales of the CAMEO FROST/GIVRÉE cigarettes as provided by Mr. Fraser at paragraph 16 of his affidavit, is below:

## CAMEO FROST/ GIVRÉE

YEAR	VOLUME	SALES
2007 – 2010	120 million cigarettes	\$28 million
2011	12 million cigarettes	\$2.9 million

[25] On cross-examination, Mr. Fraser explained that that under both the ITCan agreement and the Cameo agreement, the control over the character and quality of the marks is manifested and exercised through Christophe Blättler, the President of the Opponent who is also the Vice-President of ITCan and President of Cameo Inc. (Qs. 166-169; Q. 293-295 & p. 83, lines 3-6). Mr Blättler is considered the “ultimate custodian” of the trade-marks and the one individual who fulfills the function of exercising direct control over the manufacture and sale of the tobacco products. He enforces the specifications and standards set out in the license agreements [Qs.168-170].

[26] In response to questions taken under advisement, Mr. Fraser produced copies of the ITCan agreement and the Cameo agreement. I note that the ITCan agreement only addresses the licensing of the KOOL word mark and a KOOL design trade-mark (which is not relied upon by the Opponent in this opposition) and the Cameo agreement only addresses the FROST and GIVRÉE trade-marks. Neither of the license agreements refer to the ICE, GLACÉ, GIVRÉ, KOOL FROST or KOOL GIVRÉ trade-marks.

[27] The Applicant submits that the Opponent’s evidence regarding the licensing of its ICE/KOOL/FROST group of marks is inconsistent and contradictory. In this regard, the Applicant points out the following:

- Mr. Fraser stated in his affidavit that all of the ICE/KOOL/FROST group of trade-marks was licensed by the Opponent to their users “pursuant to a license agreement between the Opponent and ITCan” or “between the Opponent and Cameo Inc.” (para. 6 and para. 14);

- On cross-examination, however, Mr. Fraser admitted that he had not confirmed that all of the brands listed in his affidavit were, in fact, encompassed by the ITCan agreement (Fraser cross-ex Qs. 146-156);
- The ITCan agreement produced refers only to the KOOL word and KOOL design marks and not the ICE or GLACÉ marks;
- The Cameo agreement refers only to the FROST and GIVRÉE marks; and
- None of the photographs of cigarette packages provided by Mr. Fraser that feature any members of the ICE/KOOL/FROST group of trade-marks provide public notice that the use by ITCan is licensed use.

[28] The Opponent submits that a license agreement need not be in writing and that any marks not covered by the written license agreements are covered by an oral or implied license between the Opponent and ITCan or between the Opponent and Cameo Inc. In this regard, the Opponent submits that the requirements of section 50 may be satisfied if the president or director of a corporate owner is also the president or director of the user of the trade-mark [see *Petro-Canada v 2946661 Canada Inc* (1998), 83 CPR (3d) 129 (FCTD) and *Automobility Distribution Inc v Jiangsu Electronics Industries Ltd* (2005), 43 CPR (4th) 157 (TMOB)]. In this case, the evidence as a whole shows that the control under both license agreements is manifested by Christophe Blättler, who is the President of the Opponent, the President of Cameo Inc. and the Vice-President of ITCan. The Opponent therefore argues that it can be inferred from the evidence that the Opponent has the requisite control over the character and quality of the goods sold in association with each of its marks.

[29] In my view, this is not a case where I can infer that the Opponent has the requisite control over the character or quality of the goods manufactured or sold under all of its marks. While Mr. Fraser did state in his affidavit that the Opponent had the requisite control over the character or quality of the goods sold in association with its trade-marks, Mr. Fraser's evidence was tested on cross-examination and deficiencies in his testimony were revealed. In addition to admitting that he had not confirmed that all of the brands listed in his affidavit were, in fact, encompassed by the ITCan agreement or the Cameo agreement, copies of both of the license agreements produced as answers to undertakings were clear on their face. The Cameo agreement covered the FROST and GIVRÉE applications, and the definition of "trade-mark" in that agreement included "such other new trade-mark applications and or registrations relating to these marks".



The definition of “trade-mark” in the ITCan agreement, however, was limited to the applications and registrations identified in Schedule 1 of the agreement which only included the Opponent’s registered KOOL mark and the older KOOL and Design mark (which, as previously noted, is not relied upon by the Opponent in this proceeding).

[30] In view of the above, while I am satisfied that the use shown of the Opponent’s KOOL, FROST, and GIVRÉE trade-mark registrations accrues to the benefit of the Opponent, I am not satisfied that the use of the ICE, GLACÉ, GIVRÉ, KOOL FROST or KOOL GIVRÉ marks by ITCan accrues to the benefit of the Opponent pursuant to section 50(1) of the Act. This finding will affect my conclusions regarding the acquired distinctiveness of some of the Opponent’s marks in the hands of the Opponent, as well as whether the Opponent has met its evidential burden for certain marks under certain grounds of opposition, which will be discussed further below.

#### Material Dates and Onus

[31] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial 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 [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; and *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

[32] The material dates that apply to the grounds of opposition are as follows:

- Section 38(2)(a)/Section 30 - the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Section 38(2)(b)/Section 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- Section 38(2)(c)/Section 16(3)(a) – the Applicant’s filing date; and

- Section 38(2)(d)/non-distinctiveness - the filing date of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

### Grounds of Opposition Summarily Dismissed

#### Non-compliance – Section 30(i)

[33] The Opponent pleads that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada because the Applicant was aware that the Opponent had previously used and registered in Canada the ICE/GLACÉ and KOOL/FROST/GIVRÉ trade-marks.

[34] Section 30(i) of the Act merely requires that an applicant declare in its application that it is satisfied that it is entitled to registration of its trade-mark. Where an applicant has provided the requisite statement, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. Mere knowledge of the existence of an opponent's trade-mark does not in and of itself support an allegation that an applicant could not have been satisfied of its entitlement to use the mark [see *Woot, Inc v WootRestaurants Inc Les Restaurants Woot Inc* 2012 TMOB 197 (CanLII)].

[35] In the present case, the Applicant has provided the necessary statement and this is not an exceptional case. This ground is accordingly dismissed.

#### Non-compliance – Section 30(e)

[36] The Opponent pleads that the application does not conform to the requirements of section 30(e) of the Act because the Applicant had no intention to use the Mark with the applied for goods for the following reasons:

- it did not intend to use the Mark with all of the goods described in the application in Canada;
- it did not intend to use the Mark *per se* with all of the goods described in the application in Canada; and/or

- it did not intend to associate the Mark with all of the goods described in the application in a manner that would constitute use under section 4 of the Act.

[37] The Opponent did not file any supporting evidence or make any submissions with respect to this ground of opposition. The section 30(e) ground of opposition can therefore be summarily dismissed on the basis that the Opponent has not met its initial evidentiary burden in respect thereof.

#### Remaining Grounds of Opposition

[38] The Opponent's case regarding confusion is strongest under the section 12(1)(d) ground of opposition because its later material date allows all of the Opponent's evidence concerning its reputation to be considered.

#### Non-registrability - Section 12(1)(d)

[39] The Opponent has pleaded that the Mark is not registrable pursuant to section 12(1)(d) of the Act because it is confusing with one or more of the Opponent's registered trade-marks.

[40] The Opponent has filed copies of its registrations as part of its evidence and I have exercised my discretion to check the register to confirm that they are extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent has therefore met its initial burden with respect to this ground. As the Opponent's evidentiary burden has been satisfied, the Applicant must establish on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and any of the Opponent's registered trade-marks.

#### *Test for confusion*

[41] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[42] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has 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 trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [*Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)].

*Section 6(5)(a) – the inherent distinctiveness and the extent to which the marks have become known*

[43] Although each member of the Opponent’s ICE/KOOL/FROST group of marks possesses some degree of inherent distinctiveness, I do not consider any one of them to be particularly inherently strong as they are all somewhat suggestive in connotation. Mr. Fraser admitted on cross-examination that all of the products bearing one of the ICE/KOOL/FROST group of trade-marks are tailor-made mentholated cigarettes and that mentholated cigarettes have a different taste profile as compared to non-mentholated cigarettes (Q.125 and Qs. 129-130). As the Applicant’s evidence shows, the word “menthol” is defined in the New Shorter Oxford English Dictionary as an optically active crystalline alcohol with the cooling odor and properties of peppermint (Nagyova Affidavit, Exhibit B). The Opponent’s marks are therefore at least somewhat suggestive of a cooling feature or trait of the associated mentholated cigarettes.

[44] Although the Mark is also comprised of elements that are ordinary dictionary words, namely ICE and BALL, there is no evidence to suggest that, when combined, these words form some sort of meaning with respect to the associated goods. Rather, these words appear to form a coined term that has no clear or obvious meaning with respect to the character, feature or trait of the Applicant’s associated goods. I therefore find that the Mark possesses a slightly higher degree of inherent distinctiveness than each of the Opponent’s marks.

[45] With respect to the acquired distinctiveness of the parties’ marks, the Opponent’s evidence does show that several of its marks have become known in Canada. In this regard, the Opponent’s evidence of use of its marks may be summarized as follows:

- from 2008 – November 2012, ITCan sold in excess of 119,400 individual ICE/GLACÉ cigarettes to retailers in Canada representing sales of approximately \$13,800 (CDN);
- between 2002 and 2010, over 248 million KOOL cigarettes were sold in Canada, representing sales of approximately \$42 million (CDN);
- between 2002 and 2010, over 69 million KOOL FROST/KOOL GIVRÉ cigarettes were sold in Canada, representing sales of approximately \$11.5 million (CDN);
- from 2011 – December 9, 2012, about 42,000 KOOL FROST/KOOL GIVRÉ cigarettes were sold in Canada, representing estimated sales of approximately \$4,000 (CDN);
- between 2007 and 2010, over 120 million CAMEO FROST/GIVRÉE cigarettes were sold in Canada, representing estimated sales of approximately \$28 million (CDN); and
- in 2011, about 12 million CAMEO FROST/GIVRÉE cigarettes were sold in Canada, representing sales of about \$2.9 million.

[46] From the Opponent's evidence, I am satisfied that its KOOL and FROST/GIVRÉE cigarettes sold under the CAMEO brand have become known to a significant extent in Canada by the Opponent. The same cannot be said, however, with respect to the Opponent's ICE, GLACÉ, FROST, GIVRÉ, KOOL FROST and KOOL GIVRÉ cigarettes because I cannot determine the extent to which these marks have become known in Canada in the hands of the present Opponent. Even if I could consider the Opponent's sales of these particular marks, I would not have found the sales of the ICE and GLACÉ cigarettes to be sufficient to show that these particular marks had become known to any notable extent in Canada.

[47] The Applicant's Mark, on the other hand, is based on proposed use in Canada and the Applicant has not provided any evidence of use or making known of its Mark in Canada since it filed its application. I am therefore unable to find that the Mark has become known to any extent in Canada.

[48] In view of the foregoing, I find that this factor, which is a combination of the inherent distinctiveness of the marks and the extent to which they have become known, favours the Opponent with respect to its KOOL, FROST and GIVRÉE cigarettes. However, when the Opponent's ICE, GLACÉ, FROST, GIVRÉ, KOOL FROST or KOOL GIVRÉ marks are considered, I do not find that this factor favours either party.

*Section 6(5)(b) – the length of time each has been in use*

[49] In view of the Opponent's evidence summarized above and the fact that the Applicant has not provided any evidence that its Mark has been used in Canada, I find that this factor favours the Opponent with respect to its KOOL, FROST and GIVRÉE marks. However, when the Opponent's ICE, GLACÉ, FROST, GIVRÉ, KOOL FROST and KOOL GIVRÉ marks are considered, I do not find that this factor favours either party.

*Sections 6(5)(c) and (d) – the nature of wares, services or business and trade*

[50] When considering sections 6(5)(c) and (d) of the Act, it is the statement of goods in the application for the Mark and the statement of goods in the Opponent's registrations that governs the assessment of the likelihood of confusion under section 12(1)(d) of the Act [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA) and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[51] There is a clear overlap between the Applicant's goods and those covered by the Opponent's registrations. The Applicant and the Opponent are direct competitors in the Canadian cigarette market. The nature of their trade and their respective channels of trade are therefore identical.

*Section 6(5)(e) – the degree of resemblance between the trade-marks*

[52] In *Masterpiece, supra*, the Supreme Court stated that the degree of resemblance between the marks is often likely to have the greatest effect on the confusion analysis [see also *Beverley Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2d) 145 (FCTD) at 149, affirmed 60 CPR (2d) 70]. While the Supreme Court observed that for the purpose of distinctiveness, the first word of a trade-mark may be the most important [see *Conde Nast Publications Inc v Union des éditions modernes* (1979), 46 CPR (2d) 183 (FCTD)], it opined that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique.

[53] In order to assess whether an aspect of a mark is particularly striking or unique, it seems appropriate to consider again the inherent distinctiveness of the marks' components. Out of all of

the marks relied upon by the Opponent, I will begin this part of my analysis on the Opponent's ICE mark as I consider that mark to be more similar to the Mark in appearance and sound than any of the Opponent's other marks.

[54] As noted above, the Mark is comprised of elements that are ordinary dictionary words. When combined, the words form a coined term that possesses some degree of inherent distinctiveness because it has no clear or obvious meaning with respect to the associated goods. As I find that neither aspect of the Applicant's Mark is particularly striking or unique on its own, however, I consider the first portion of the Mark, namely the word ICE, to be the most important for assessing the likelihood of confusion.

[55] Turning to the Opponent's ICE mark, it is clear that its sole feature, the word ICE, must be its dominant feature, even though it is not inherently strong. In this regard, as noted above, the Opponent's mark ICE mark is somewhat suggestive of a cooling feature or trait of the Opponent's cigarettes.

[56] I conclude that, although there are differences between the parties' marks in appearance, sound and ideas suggested, there is still a fair degree of resemblance between the marks as a whole.

[57] With respect to the other registered marks of the Opponent (i.e. GLACÉ, FROST, KOOL, GIVRÉ, GIVRÉE, KOOL FROST, and KOOL GIVRÉ), I do not find there to be as much resemblance in appearance, sound or ideas suggested between these marks and the Applicant's Mark.

#### *Other Surrounding Circumstances*

#### *State of the Register and State of the Marketplace Evidence*

[58] As an additional surrounding circumstance, the Applicant has submitted that the word ICE is a common everyday word that is widely adopted as a trade-mark for numerous consumer goods to signify a flavor or sensation often associated with mentholated or peppermint flavoured or scented products. To corroborate this assertion, the Applicant relies on the state of the register evidence of Ms. Noonan and the state of the marketplace evidence of Ms. Zeit.

[59] Ms. Noonan is a trade-mark searcher employed by the Applicant's agents. She conducted a search of the Canadian trade-marks register for registrations including the word ICE in various classes. Her affidavit has been submitted to show that ICE is a common component of various trade-marks which currently co-exist on the register for many varied consumer goods. The types of registrations located by Ms. Noonan include the following:

- 10 registrations in class 3 for "cleaning preparations and toilet preparations";
- 11 registrations in class 5 for "pharmaceutical and other preparations for medical or veterinary purposes";
- 27 registrations in class 30 for "foodstuffs of plant origin prepared for consumption or conservation as well as auxiliaries intended for the improvement of the flavor of the food";
- 70 registrations in class 32 for "non-alcoholic beverages, as well as beer; and
- 54 registrations in class 33 for "alcoholic beverages (except beers)".

[60] The Applicant points out that over 70 of these registrations feature the term ICE in the first position. The Applicant's position is that the word ICE as a trade-mark element is commonly adopted and is evidently used to refer either directly or implicitly to a feature, trait or characteristic of the associated goods.

[61] While state of the register evidence can be useful to assess the commonality or distinctiveness of a trade-mark or portion of a trade-mark in relation to the register as a whole, it is only relevant insofar as inferences may be made with respect to the state of the marketplace, and inferences about the state of the marketplace can only be drawn when a significant number of pertinent registrations are located [*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); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)]. The Applicant in this case has located a relatively large number of trade-marks on the Register. However, the relevance of many of them is questionable because they are not registered in association with similar goods as those of the parties in the present case.

[62] Ms. Zeit, an articling student employed by the Applicant's agents, attended at Shoppers Drug Mart and Rexall Pharma Plus store locations in Toronto, Ontario in or around October,



2013 to locate and purchase menthol products with packaging using the words ICE or COOL or variations thereof. She also purchased products with menthol as an ingredient that had packaging or labelling featuring the words ICE, ICY, KOOL or COOL. The types of mentholated products purchased by Ms. Zeit including analgesic gel for pain relief, after shave, skin cleanser and gum. Photographs of the products purchased, along with the photographs of the packaging and labelling are attached to her affidavit as Exhibits NZ- 1 -NZ -23.

[63] The Applicant points out that the word ICE or ICY is used on these goods to describe the cooling or odor characteristic associated with the mentholated consumer products. However, of the products located by Ms. Zeit, only one of these products is for a product related to tobacco products (i.e. Nicorette Ice Mint Gum).

[64] In my view, the Applicant's evidence shows that the word ICE has been widely adopted as a trade-mark for numerous consumer goods to signify a cooling flavor or sensation often associated with mentholated or peppermint flavoured or scented products. This is not surprising given how suggestive the word ICE is with respect to the characteristics of the products located by Ms. Zeit. I do not find the evidence sufficient, however, to allow me to make the inference that the Opponent does not have a monopoly over the use of the component ICE in the tobacco field. As such, I do not find that this evidence assists the Applicant's case.

*Opponent's alleged "family" of trade-marks*

[65] I will begin by addressing the Opponent's claim to a family of marks.

[66] The Opponent submits that a cluster of marks containing common elements and owned by a single owner are presumed to form a series of related marks, which increases the likelihood of confusion when registration is sought for another mark containing similar common elements by a different owner [*Consumers Distributing Co v United Consumers Club Inc* (1991), 35 CPR (3d) 259 at 272 (FCTD); *McDonald's Corp v Yogi Yogurt Ltd* (1982), 66 CPR (2d) 101 at 112 (FCTD)]. The Opponent submits that it is the owner of a family of marks comprising or consisting of the following marks ICE, GLACÉ, FROST, GIVRÉ, GIVRÉE, KOOL FROST and KOOL GIVRÉ, as well as its KOOL FROST and KOOL GIVRÉ design marks.

[67] Unlike in the *Consumers Distributing* or *McDonald's* decisions, however, the Opponent in the present case is not claiming a family of marks for marks which contain a common feature but instead is claiming a family of marks based on the similar ideas suggested by each of its marks. I am therefore not sure that the Opponent's registered marks successfully form a family. Even if they did, however, in view that I do not find the idea suggested by the Mark to be the same as the ideas suggested by the Opponent's marks, I do not find that the Opponent's use of marks which each connote a similar idea in association with the same goods increases the likelihood of confusion in the present case.

#### *Conclusion on the Likelihood of Confusion*

[68] I have found that the Opponent's ICE mark presents the Opponent's strongest chance of success under this ground. This means that if confusion were not likely with this mark, then it would not be likely with the Opponent's other registered marks.

[69] Having considered all of the surrounding circumstances, I find that the probability of confusion between the Applicant's Mark and the Opponent's ICE mark to be evenly balanced between a finding of confusion and a finding of no confusion.

[70] I acknowledge that it is difficult for a trader to monopolize weak words such as ICE. In this case, however, the Applicant has not shown that ICE is a common component of tobacco products in the marketplace. The Opponent's ICE mark is therefore entitled to more than a narrow ambit of protection.

[71] While I acknowledge that the Opponent's ICE mark may not have acquired any distinctiveness in Canada in the hands of the Opponent to date, there is direct overlap in the goods which are associated with the parties' trade-marks and nothing would prohibit the Applicant from targeting the same consumers as those which are targeted by the Opponent. There is also some degree of resemblance between the parties' trade-marks given that the Applicant has incorporated the whole of the Opponent's trade-mark into the Mark. In view of this, it is reasonable to conclude that a consumer, upon seeing the Mark in association with the Applicant's goods would be likely to infer that those goods share a common source or are in some way associated with the Opponent's goods.

[72] As the legal burden is on the Applicant to establish, on a balance of probabilities, that the Mark is not confusing with the Opponent's ICE trade-mark and it has not done so, the section 12(1)(d) ground of opposition is successful.

#### Non-entitlement and Non-distinctiveness Grounds of Opposition

[73] The remaining grounds of opposition also turn on a determination of the issue of the likelihood of confusion between the Mark and any member of the Opponent's group of ICE/KOOL/FROST marks.

[74] Given the deficiencies in the Opponent's evidence, however, and the finding that the use of the ICE, GLACÉ, GIVRÉ, KOOL FROST and KOOL GIVRÉ marks didn't inure to the benefit of the Opponent under section 50, I am not satisfied that the Opponent has met its evidential burden under either of these grounds of opposition with respect to these marks. Both of these grounds of opposition therefore fail with respect to these marks.

[75] I am satisfied, however, that the Opponent has met its burden under both of these grounds with respect to its KOOL, FROST and GIVRÉE trade-marks. For the most part, my conclusions above under the section 12(1)(d) ground can also be applied to both of these grounds with one important exception. In this regard, I find that the low degree of resemblance in appearance and sound between these marks and the Applicant's Mark is sufficient to tip the balance of probabilities under both of these grounds in the Applicant's favour. As I am satisfied that the Applicant has shown on a balance of probabilities that the Mark is not reasonably likely to cause confusion with the Opponent's KOOL, FROST or GIVRÉE trade-marks, both of these grounds fail with respect to these marks.

Disposition

[76] In view of the foregoing, 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.

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Cindy R. Folz  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE:** 2015-10-29

**APPEARANCES**

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## Schedule A

### Opponent's Registered Trade-marks

Trade-mark	Registration No.	Goods/Services
ICE	TMA755400	Manufactured tobacco products
GLACÉ	TMA721602	Manufactured tobacco products
FROST	TMA595388	Manufactured tobacco products
GIVRÉ	TMA595445	Manufactured tobacco products
GIVRÉE	TMA743842	Manufactured tobacco products
KOOL	UCA1349	(1) Cigarettes (2) Manufactured tobacco products
KOOL FROST	TMA592134	Manufactured tobacco products
KOOL FROST & Design	TMA592358	Manufactured tobacco products
KOOL GIVRÉ	TMA592133	Manufactured tobacco products
KOOL GIVRÉ & Design	TMA591545	Manufactured tobacco products