



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

**Citation: 2013 TMOB 31
Date of Decision: 2013-02-20**

**IN THE MATTER OF AN OPPOSITION by
PomWonderful LLC to application
No. 1,389,758 for the trade-mark
POMEPURE & Design in the name of Rash
Nagar**

[1] On April 2, 2008, Pomepure Ltd. filed an application to register the trade-mark POMEPURE & Design (shown below) (the Mark) based on proposed use of the Mark in Canada in association with the following wares, as revised:

The logo for 'Pomepure' is written in a bold, italicized, sans-serif font. A thick, dark swoosh underline starts under the 'P' and extends under the 'e'.

Fruit flavoured teas, ices, treacle; Non-alcoholic drinks namely, mineral and aerated waters, fruit drinks and fruit juices, fruit juice concentrate, nectars, energy drinks; Alcoholic beverages namely, cocktails, vodka, gin, champagne, sparkling [sic] and nonsparkling [sic] wine (the Wares).

[2] The application is also based on use and registration of the Mark in the United Kingdom in association with the Wares.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of February 4, 2009.

[4] I shall mention at this point of my decision that by letter dated July 19, 2010, the Registrar recorded an update of ownership of the application for the Mark, which was assigned by Pomepure Ltd. to Rash Nagar. I will refer indiscriminately to both persons as the Applicant.

[5] On June 30, 2009, PomWonderful LLC (the Opponent) filed a statement of opposition against the application. The grounds of opposition can be summarized as follows:

1. The Applicant is not the person entitled to registration of the Mark pursuant to sections 16(2)(a) and (3)(a) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) in that as of the date of filing of the application, the Mark was confusing with the trade-marks POM WONDERFUL and POM WONERFUL & Design, which had been previously used in Canada by the Opponent in association with fresh fruits, namely pomegranate since at least as early as October 2001 and in association with fruit beverages since at least as early as March 2004;
2. The Applicant is not the person entitled to registration of the Mark pursuant to sections 16(2)(b) and (3)(b) of the Act in that as of the date of filing of the application, the Mark was confusing with the trade-marks listed in attached Schedule A, in respect of which applications for registration had been previously filed in Canada by the Opponent (hereinafter sometimes collectively referred to as the POM Pending Marks); and
3. The Mark is not distinctive of the Applicant's Wares having regard to section 2 of the Act in that the Mark is not adapted to distinguish the Wares of the Applicant from the wares of others, including the wares of the Opponent considering the use by the Opponent of its trade-marks POM WONDERFUL and POM WONDERFUL & Design and trade-name PomWonderful LLC and the Opponent's other trade-marks as described hereinabove since as early as October 2001 in association with fresh fruits and as early as March 2004 in association with juices.

[6] The Applicant filed a counter statement in which it denied the Opponent's allegations.

[7] In support of its opposition, the Opponent filed certificates of authenticity of each of the trade-mark applications pleaded in its statement of opposition as well as the affidavit of Sarah Hemmati, Chief Financial Officer of the Opponent, sworn December 14, 2009. In support of its application, the Applicant filed the affidavits of Rash Nagar, who is the named applicant and the Managing Director of the prior listed applicant Pomepure Ltd., sworn April 11, 2010; Simone Ndiaye, paralegal with the firm representing the Applicant in the instant proceeding, sworn April 12, 2010; and Emilie Bureau, also a paralegal with the firm representing the Applicant, sworn April 16, 2010. Mr. Nagar was cross-examined on his affidavit on January 13, 2011 and the transcript of his cross-examination forms part of the record. It is to be noted that by letter to the Registrar dated March 9, 2011, the Applicant informed the Registrar that it would “not provide a response to the undertakings” given during such cross-examination.

[8] Neither of the parties filed written arguments. Only the Opponent requested and was represented by counsel at an oral hearing as the Applicant’s representative advised the Registrar that:

[...] the [A]pplicant has exhausted its resources allocated to this matter, will not file written arguments and will not request an oral hearing [...].

The [A]pplicant still believes that [the Mark] is not confusing with the Opponent’s marks and wishes to rely upon the fair judgment of the Board.

Onus

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidentiary 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); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

Overview of the parties' evidence

The Opponent's evidence

The certificates of authenticity

[10] The certificates of authenticity, dated December 11, 2009, show that the Opponent was the original owner of the POM Pending Marks applications, which were standing under the name of Pom Bakery Limited, as of the date of the certificates. I have exercised the Registrar's discretion to review the trade-marks register to inspect each application [see *Royal Appliance Mfg Co v Iona Appliances Inc* (1990), 32 CPR (3d) 525 (TMOB)]. I note that the applications have further been assigned to Canada Bread Limited. However, these changes of title do not impact the instant opposition proceeding because as of the material dates (discussed below) to assess each of the grounds of opposition, each application was still under the name of the Opponent.

The Hemmati affidavit

[11] Ms. Hemmati states that the Opponent, together with its affiliates, is the USA's largest grower and marketer of fresh pomegranates. Ms. Hemmati explains that the fruit is cultivated by the Opponent's affiliates in orchards located in the San Joaquin Valley, California. She further states that the Opponent's affiliate has a large market share of fresh fruit sales for pomegranates in the United States and exports fresh pomegranates worldwide, including Canada.

[12] Ms. Hemmati states that since 2003, the Opponent has marketed fruit beverages under the POM WONDERFUL label and sold in unique bottles resembling two pomegranates stacked one on top of the other.

[13] Ms. Hemmati states that the POM WONDERFUL (application No. 1,118,804) and the POM WONDERFUL & Design (application No. 1,176,267) branded pomegranate fresh fruit and fruit beverages (collectively referred to by Ms. Hemmati as the POM WONDERFUL products) have been sold in Canada since at least as early as September 2003.

[14] More particularly, Ms. Hemmati states that the POM WONDERFUL products are sold throughout Canada in major supermarkets and grocery stores, such as Costco Canada, Overwaitea, Safeway, Sobey's, Western Grocers, Thrifty's, and A & P.

[15] Ms. Hemmati states that since their introduction in 2003, sales of the fruit beverages products in Canada have grown each year. She states that in excess of 750,000 cases of fruit beverage products have been sold in Canada to the time of swearing her affidavit. Gross sales for the POM WONDERFUL fruit beverages products in Canada to the time of swearing her affidavit were in excess of 10 million dollars, and those for the POM WONDERFUL fresh fruit product were in excess of 11 million dollars.

[16] Ms. Hemmati states that the Opponent operates a website accessible by Internet users all around the world, including Canada, at *www.pomwonderful.com* and *www.pomwonderful.ca*. Ms. Hemmati states that among other things, the website presents and explains the Opponent's products and brands. She attaches as Exhibit A extracts from the Opponent's website showing some of the Opponent's products. Upon review of this exhibit, I note that it includes photographs of the Opponent's POM WONDERFUL bottles of 100% pomegranate juice and blend of pomegranate and blueberry juice, which bottles prominently display the POM WONDERFUL & Design trade-mark that is the object of application No. 1,176,267.

[17] Ms. Hemmati further states that since as early as 2003, when the Opponent began selling its products in Canada, all of the Opponent's above mentioned activities (sales promotion, marketing, billing, communications with wholesalers, retailers and others) have been carried in association with the Opponent's corporate name PomWonderful LLC.

[18] She concludes her affidavit stating that based on the significant volume of sales, the extensive advertising and promotion, and the availability and success of the POM WONDERFUL products, she believes that the Opponent's POM WONDERFUL products and the trade-marks POM WONDERFUL and POM WONDERFUL & Design are distinctive in Canada. I am not prepared to accord weight to this latter statement of Ms. Hemmati. First, Ms. Hemmati's bald statement concerning the alleged extensive advertising and promotion of the POM WONDERFUL products is not supported by any corroborating exhibit nor detailed further by Ms. Hemmati. It is impossible to conclude from the mere existence of the Opponent's website

and the web pages described above under Exhibit A that Canadians did access such website. Second, Ms. Hemmati cannot properly be qualified as an expert in this proceeding. Indeed, it seems to me that an expert qualification necessarily includes independence from the parties on the outcome of the case [see *Black Entertainment Television, Inc v CTV Limited* (2008), 66 CPR (4th) 212 (TMOB)]. Third, the issue of distinctiveness involves questions of fact and law to be determined by the Registrar.

The Applicant's evidence

The Nagar affidavit

[19] Mr. Nagar first briefly goes over his qualifications and experience as a corporate branding and packaging designer in the United Kingdom. Mr. Nagar states that because of his background and extensive experience of over 40 years of practising his profession, he fully “understand[s] and object[s] to the Opponent’s opposition to the [Applicant’s application for the Mark], which [he] consider[s] in no way confusing or misleading by consumers in the global market place”. I am not prepared to accord weight to this latter statement of Mr. Nagar. First, as for Ms. Hemmati, Mr. Nagar cannot properly be qualified as an expert in this proceeding. Second, the test for confusion involves questions of fact and law to be determined by the Registrar.

[20] Mr. Nagar then turns to the Applicant’s use of the Mark. He states that the Applicant was one of the first companies to introduce 100% pure pomegranate juice not made from concentrate and free from any additives. He attaches to this effect as Exhibit RN-1 extracts from the Applicant’s website showing a bottle of pure pomegranate juice on which is prominently displayed the Mark. He further attaches as Exhibit RN-2 pictures of two bottles of pure pomegranate juice and of a label displaying the Mark.

[21] Mr. Nagar states that products used in association with the Mark were launched in 2006 in the United Kingdom and have been “stocked since then in the countries’ major supermarkets, namely, MORRISON, CO-OP, WAITROSE and SAINSBURY’S”. More particularly, he states that POMEPURE products used in association with the Mark are currently distributed in the following countries: Brunei, Greece, Hong Kong, Indonesia, Italy, Japan, Malaysia, Philippines,

Singapore, Sweden, Switzerland, Thailand, the U.K., the U.S.A., and Vietnam. He further states that currently, products used in association with the Mark are also available online via the Applicant's website *www.pomepure.com* and have catered for delivery in the U.K., Europe, U.S.A. and Asia. He attaches as Exhibit RN-4 extracts of the Applicant's website showing the countries and areas from which consumers can order products in association with the Mark. Upon review of this exhibit, I note that it apparently refers to the Applicant's pomegranate juice and fruit beverages only. I further note that Mr. Nagar has conceded during his cross-examination that the only products that would have been sold by the Applicant in association with the Mark are fruit juices and fruit drinks. In other words, none of the remaining Wares have been sold by the Applicant, be it in the U.K., or elsewhere [see answers to Q. 238 to 259, at pp. 54-56]. As for the Applicant's fruit juices and drinks that have allegedly been sold in association with the Mark in the above-mentioned countries, Mr. Nagar has failed to provide answers to the various undertakings given during his cross-examination aimed at determining the extent of use of the Mark in those countries.

[22] Mr. Nagar states that the Opponent's products have been sold side by side with products used in association with the Mark with none of the consumers getting confused in any way, as shown by Exhibit RN-3. He further states that in fact, the three most popular brands of 100% pure pomegranate juice not made from concentrate over the world, namely POME GREAT, POM WONDERFUL, and POME PURE are being sold side by side in many countries and that he is not aware of any confusion events. Upon review of Exhibit RN-3, which consists of a picture that Mr. Nagar apparently took at a Sainsbury supermarket in the U.K [see answers to Q. 275-279 at p. 58], I note that it indeed shows bottles of the Applicant's pure pomegranate juice as depicted in Exhibit RN-2 alongside the Opponent's pure pomegranate juice as depicted in Exhibit A attached to the Hemmati affidavit. However, the picture does not show any POME GREAT product, nor for that matter does any of the other exhibits provided by Mr. Nagar. More importantly, such picture by itself does not provide any information on to the extent to which the parties' marks would have coexisted in the U.K.

[23] Mr. Nagar provides a list of the countries of the world in which the Mark is registered as well as a list of the countries in which applications for registration of the Mark have been filed. However, the fact that the Mark is registered in foreign jurisdictions is not relevant in the

circumstances of this case. Suffice it to say that such evidence does not establish that the parties' marks coexist on foreign trade-marks registers.

[24] Mr. Nagar concludes his affidavit stating that “[p]roducts used in association with [the Mark] are aimed at consumers looking for premium high quality products and personal services” and that “[t]he POMEPURE brand is distinctive and our consumers as well as potential consumers are able to differentiate easily those products especially when compared with different products. Based on the significant global awareness of the [Mark], [he] believe[s] that [the Mark] is distinctive and should be entitled to registration in Canada”. Again, I am not prepared to accord weight to these latter statements of opinion of Mr. Nagar.

The Ndiaye affidavit

[25] The Ndiaye affidavit apparently purports to file a portion of the file history of an opposition proceeding brought by Multi-Marques Inc. and Pom Bakery Limited against trade-mark application No. 1,118,804 for POM WONDERFUL filed by the Opponent. Ms. Ndiaye attaches to her affidavit as part of Exhibit SN-1 a copy of an affidavit (excluding the exhibits) of Mr. Matthew Tupper, President and Chief Operating Officer of the Opponent, sworn November 22, 2006.

[26] I fail to see the relevancy of the Ndiaye affidavit in the instant proceeding. Hearsay issues aside, suffice it to say that neither party made any representations with respect to that portion of the Applicant's evidence.

The Bureau affidavit

[27] The Bureau affidavit purports to file the results of a state of the register search that Ms. Bureau conducted on April 15, 2010. I will return to this affidavit when assessing the additional surrounding circumstances under the test for confusion.

Analysis of the grounds of opposition

Sections 16(2)(a) and (3)(a) grounds of opposition

[28] An opponent meets its evidentiary burden with respect to a section 16(2)(a) or (3)(a) ground if it shows that as of the date of filing of the applicant's application, its trade-mark had been previously used in Canada and had not been abandoned as of the date of advertisement of the applicant's application [section 16(5) of the Act]. As per my review of the Hemmati affidavit above, the Opponent has met its evidentiary burden with respect to use of the word mark POM WONDERFUL and the POM WONDERFUL & Design mark as this latter mark is depicted in application No. 1,176,267, in association with fruit beverages, namely pomegranate juice. However, it has not with respect to fresh fruits, namely pomegranate.

[29] Indeed, while Ms. Hemmati states that the Opponent has been selling such fresh fruit product in Canada since at least as early as 2003, her affidavit fails to show how the POM WONDERFUL and POM WONDERFUL & Design trade-marks have in fact been used in association with such product pursuant to section 4 of the Act. No specimen of label or packaging has been provided by Ms. Hemmati.

[30] I will therefore focus my analysis on the Opponent's fruit beverages products only. Furthermore, unless indicated otherwise, I will focus my analysis on the Opponent's word mark POM WONDERFUL, which presents the Opponent's strongest case. If the Opponent is not successful with this cited trade-mark, it would not achieve a more favourable result with the POM WONDERFUL & Design trade-mark.

[31] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's word mark POM WONDERFUL.

[32] 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 wares or

services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[33] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at 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 the trade-marks have been in use; (c) the nature of the wares, 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. This list is not exhaustive; all relevant factors are to be considered, and are not necessarily attributed equal weight [see *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion].

Section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[34] The inherent distinctiveness of each of the Applicant’s Mark and the Opponent’s word mark POM WONDERFUL is relatively weak and about the same. In the context of the Wares, especially the Applicant’s fruit juices and beverages, the Mark can fairly be considered evocative of beverages made from pure pomegranate or apple (which translates into French as “pomme”) juice. The design feature of the Mark does little to increase its inherent distinctiveness since the fanciful script and the font employed are intrinsic with the word portion forming the essential part of the Mark [see *Canadian Jewish Review Ltd v The Registrar of Trade Marks* (1961), 37 CPR 89 (Ex C)]. Likewise, the Opponent’s trade-mark POM WONDERFUL, in the context of the Opponent’s fruit beverages, can fairly be considered evocative of beverages made from pomegranate or apple juice having a great or extraordinary taste.

[35] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. However, there is no evidence that the Applicant’s proposed use Mark has been used in Canada pursuant to section 4 of the Act or that it has become known to any extent whatsoever in Canada as per my review above of the Nagar affidavit.

[36] By comparison, the Opponent has evidenced that its mark has been used in Canada in association with fruit beverages since 2003 as per my review above of the Hemmati affidavit. While the Hemmati affidavit fails to provide conclusive evidence with respect to the advertising and promotion of the POM WONDERFUL fruit beverages in Canada, it can fairly be concluded from the gross sales figures provided by Ms. Hemmati that the POM WONDERFUL fruit beverages have become known to some extent in Canada.

[37] Thus, the first factor, which is a combination of inherent and acquired distinctiveness, favours the Opponent.

Section 6(5)(b) – the length of time the trade-marks have been in use

[38] In view of my comments above, this factor also favours the Opponent.

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

[39] Except for the Applicant's Wares falling under the category of alcoholic beverages, the parties' wares are either identical or overlapping. There is no evidence directed to the Applicant's channels of trade in Canada. However, I find it reasonable to infer that they would be similar to the channels of trade in the U.K. Therefore, I conclude that the parties' associated channels of trade would be either identical or overlapping.

Section 6(5)(e) – the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[40] The Opponent contends that there is a high degree of resemblance between the parties' marks owing to the fact that both marks include the component POM that constitutes the dominant element of each of the parties' marks. I disagree. While the Mark puts emphasis on the element POME, such element is spelled differently from the element POM in the Opponent's mark and is further combined with the element PURE. The marks, when considered in their entirety, do differ in appearance and sound and in the ideas suggested by them. As mentioned before, the Mark can fairly be considered evocative of beverages made from pure pomegranate or apple (which translates into French as "pomme") juice. By comparison, while the Opponent's

mark, in the context of the Opponent's fruit beverages, can also fairly be considered evocative of beverages made from pomegranate or apple juice, the mark, as a whole, suggests the idea of beverages having a great or extraordinary taste owing to the laudatory word WONDERFUL.

[41] This brings me to consider as an additional surrounding circumstance, the state of the register evidence submitted by the Applicant through the Bureau affidavit.

State of the register evidence

[42] State of the register evidence is introduced to show the commonality or distinctiveness of a mark or portion of a mark in relation to the register as a whole. Evidence of the state of the register is only relevant insofar as inferences may be made on it concerning 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 [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); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

[43] Ms. Bureau states that she personally accessed the website *www.trademark.com* and conducted a search using the Nice classes 5, 29, 30, 31, 32 and 33 in association with the active Canadian trade-marks containing the term "POM". She attaches as Exhibit EB-2 to her affidavit, the report produced by *www.trademark.com* listing the details of some 197 trade-mark applications or registrations, without any further explanation. I have no intention of undertaking a thorough review of this report in order to try to find, somewhere among the 147 pages or so which make up this report, the supposed relevant trade-marks. For instance, I note that many of the trade-marks revealed by the search report include the English word "pomegranate" or the French word "pomme" standing for apple or potato ("pomme de terre") as an element of the mark or a descriptive word featured on the label for the wares associated thereto, as opposed to the prefix "POM" *per se*. Also included in the search report are the Opponent's POM Pending Marks, which no more assist the Applicant's case. The onus is on the Applicant to substantiate its contentions in this regard [see *Novalab Inc v Lidl Stiftung & Co Kg* (2008), 73 CPR (4th) 470 (TMOB)].

[44] That being said, I note that the Applicant has listed in its counter statement examples of marks “currently pending or registered at the Canadian Trade-mark Office” that include the word “POM”, which it considers pertinent and which have further been revealed by Ms. Bureau’s search. More particularly, I note that the following trade-marks incorporating the prefix “POM” have been registered or allowed for registration in association with either alcoholic or non-alcoholic beverages:

- POM DE VIE (TMA572,346) for “*eau-de-vie distillée, eau-de-vie de pomme*”, which further includes a disclaimer of the right to the exclusive use of the word “POM” apart from the trade-mark;
- POMAGNE (TMA177,560) for cider;
- POME GRANDE (TMA691,908) for pomegranate juice;
- POMITO (TMA173,678) for fruit juices and other food products;
- POMMALEFUN & Design (TMA574,423) for fruit juices and other food products;
- POMMERY (TMA281,357), POMMERY & Design (TMA302,581) and POMMERY & GRENO Design (TMA130,197) for wines;
- POMMUM (allowed application No. 1,318,373) for spirits and ciders;
- POMONA (TMA761,102) for cider;
- POM’OR TRADITION (TMA556,557) for cider;
- POMTINI (TMA693,310) for alcoholic fruit drinks; etc.

[45] While the Bureau affidavit is dated after the material date to be considered under the sections 16(2)(a) and 16(3)(a) grounds of opposition, the ten or so registrations and the allowed application in association with alcoholic and non-alcoholic beverages described above were all issued prior to the date of filing of the Applicant’s application, except for POMONA.

[46] At the oral hearing, the Opponent has submitted that the number of registrations revealed by the search is insufficient to draw inferences about the state of the marketplace. More particularly, the Opponent submits that a distinction must be made between the registrations covering non-alcoholic beverages and the ones covering alcoholic beverages. The Opponent submits that of the three registrations covering fruit juices described above, only the one for POME GRANDE is relevant as the Opponent is of the view that the POMMALEFUN & Design

and POMITO trade-marks significantly differ from the trade-marks in issue. With respect to the registrations covering alcoholic beverages, the Opponent submits that only the ones that are not associated with cider or other beverages made from apple juice ought to be considered given the evocative or descriptive character of the prefix POM in the context of such wares.

[47] With respect, I find the Opponent's approach arguable. While I acknowledge that alcoholic beverages and non-alcoholic beverages are not part of the same industry, such wares are somewhat related in that they can be said to both belong to the same general class of wares, namely beverages. Also, I fail to understand how the Opponent's argument with respect to the descriptive character of the prefix POM in the context of ciders and other alcoholic beverages made from apple juice is of any assistance to its case. Such argument goes to the inherent distinctiveness of the marks as opposed to state of the register evidence. I further fail to understand why the Opponent's argument cannot hold true with respect to non-alcoholic fruit beverages, including the Opponent's pomegranate juice associated with the POM WONDERFUL mark. In my view, the Opponent's argument supports my previous finding as to the parties' marks being evocative of beverages made from apple or pomegranate juice. Furthermore, as noted by Mr. Justice de Montigny in *Hawke & Company Outfitters LLC v Retail Royalty Company and American Eagle Outfitters, Inc* 2012 FC 1539 at paragraph 44: "The exact number of similar marks needed to establish that an element of a mark was commonly adopted as a component of trade-marks used in association with the relevant wares or services at the material date is not clear and likely depends on the facts of a given case". In this case, I am satisfied that it can fairly be inferred from the number of registered marks and the allowed application located by Ms. Bureau, that at least some of these marks are in use. It can therefore also be concluded that consumers would be accustomed to some extent to seeing marks made up of the prefix "POM" in the marketplace for alcoholic and/or non-alcoholic beverages. Accordingly, those consumers would be likely to distinguish such marks by focusing on their other components.

Conclusion re likelihood of confusion

[48] As indicated above, the issue is whether a consumer, who has a general and not precise recollection of the Opponent's trade-mark POM WONDERFUL, will, upon seeing the Mark be likely to believe that their associated wares share a common source. Section 6(2) of the Act is not concerned with confusion between the marks themselves, but rather confusion as to the source of the wares.

[49] The number of factors favouring one party should not dictate the outcome of my decision, but rather the weight to be given to the different factors. While I acknowledge that the Opponent's POM WONDERFUL mark has been used to some extent in Canada since 2003, and that such use may have helped to increase the distinctiveness of the mark, I find that the differences existing between the parties' marks in appearance and sound as well as in the ideas suggested by them are sufficient to preclude a likelihood of confusion, and more so if I am to factor in the state of the register evidence discussed above. Indeed, as noted by the Supreme Court in *Masterpiece, supra*, at paragraph 49, "the degree of resemblance, although the last factor listed in [section] 6(5) [of the Act], is the statutory factor that is often likely to have the greatest effect on the confusion analysis [...] if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion". Also, as stated by Mr. Justice Décarie in *Dion, supra*:

The Registrar must therefore be reasonably satisfied that, on a balance of probabilities, the registration is unlikely to create confusion; he need not be satisfied beyond doubt that confusion is unlikely. Should the "beyond doubt" standard be applied, applicants would, in most cases, face an insurmountable burden because certainty in matters of likelihood of confusion is a rare commodity. At best, it is only where the probabilities are equal that a form of doubt may be said to arise, which is to be resolved in favor of the opponent. But the concept of doubt is a treacherous and confusing one in civil proceedings and a Registrar should avoid resorting to it.

[50] In view of the above, the sections 16(2)(a) and (3)(a) grounds of opposition are dismissed.

Sections 16(2)(b) and 16(3)(b) grounds of opposition

[51] An opponent meets its evidentiary burden with respect to a section 16(2)(b) or (3)(b) ground if it shows that its application was filed prior to the date of filing of the applicant's application and was pending when the applicant's application was advertised [section 16(4) of the Act]. The Applicant has met its evidentiary burden with respect to all of the POM Pending Marks. The grounds of opposition therefore remain to be decided on the issue of confusion between the marks as of the filing date of the Applicant's application.

[52] Unless indicated otherwise, I will focus my analysis on application No. 1,278,747 for the POM Design mark (shown below), which presents the Opponent's strongest case. If the Opponent is not successful with this cited application, it would not achieve a more favourable result with the other applications:



[53] As per the particulars attached in Schedule A, application No. 1,278,747 is based on proposed use and covers a lengthy list of wares. I will focus my analysis on the most pertinent wares identified as:

Nutritionally fortified beverages, namely, energy drinks containing vitamin and mineral supplements; topping syrup, namely, pomegranate syrup; iced tea and non-alcoholic tea-based beverages with fruit flavoring; non-alcoholic fruit extracts used in the preparation of beverages; preparation for making fruit drinks; non-alcoholic fruit flavored beverages; non-alcoholic beverages containing fruit juices; smoothies; bottled water; non-alcoholic tea flavored fruit juice beverages; non-alcoholic low calorie fruit flavored beverages; non-alcoholic low calorie fruit juice drinks; non-alcoholic low calories tea flavored beverages.

[54] As per my review of the Hemmati affidavit above, the Opponent's evidence is directed only to the Opponent's word mark POM WONDERFUL and POM WONDERFUL & Design mark as this latter mark is depicted in application No. 1,176,267. In other words, and as acknowledged by the Opponent at the oral hearing, the Opponent's evidence is silent as to the

use of each of the remaining POM Pending Marks. However, the Opponent submits that this ought not to be held against the Opponent in my assessment of the test for confusion as this would create a double standard with regard to a proposed use trade-mark application versus a trade-mark application based on use. I disagree. First, the Opponent could not refer me to any particular case law supporting its position. Second, and as I indicated to the Opponent at the oral hearing, I see no basis on which not to consider all of the factors listed at section 6(5) of the Act in my assessment of the test for confusion under a section 16(2)(b) or (3)(b) ground of opposition. The fact that the Opponent has met its initial evidentiary burden under such grounds of opposition by evidencing that its application for the POM Design mark was filed prior to the Applicant's application and was pending when the Applicant's application was advertised is the underlying condition for assessing the test for confusion. However, it does not command a different test for confusion.

[55] As there is no evidence of use of the POM Design mark as of the material date to assess the sections 16(2)(b) and (3)(b) grounds of opposition, my analysis above under the section 6(5)(a) and (b) factors differs in that neither party is favoured over the other. Indeed, I assess the inherent distinctiveness of each of the parties' marks as relatively weak and about the same. My analysis above under the section 6(5)(c) and (d) factors also differs in that I must consider the entirety of the Opponent's statement of wares covered by application No. 1,278,747, as opposed to only part of the Opponent's wares for which evidence of use had been provided as of the material date for considering the Opponent's sections 16(2)(a) and (3)(a) grounds of opposition. That said, my ultimate finding under the section 6(5)(c) and (d) factors remains the same. My analysis above under the section 6(e) factor also differs in that I must consider the Opponent's POM Design mark. While such mark is more similar in sound to the Applicant's Mark than is the Opponent's POM WONDERFUL mark, the parties' marks do significantly differ in appearance. I consider the heart design forming the letter "O" in the Opponent's POM Design mark to be as dominant as the word POM. Such design further conveys a different idea than that of the Mark, in that the Opponent's mark in the context of the Opponent's fruit beverages and the like, suggests the idea of beverages made from apple or pomegranate that one will love.

[56] Keeping in mind the principle that when marks are weak marks, small differences may suffice to distinguish one mark from the other [see *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD)], I find that the differences existing between the Applicant's Mark and the Opponent's POM Design mark should be sufficient to preclude a likelihood of confusion. I would add that the state of the register evidence introduced through the Bureau affidavit lends support to my finding.

[57] Accordingly, the sections 16(2)(b) and 16(3)(b) grounds of opposition are dismissed.

Non-distinctiveness ground of opposition

[58] An opponent meets its initial onus with respect to a non-distinctiveness ground if it shows that as of the filing date of the statement of opposition its trade-mark had a substantial, significant or sufficient reputation in Canada so as to negate the distinctiveness of the applied-for mark [see *Bojangles' International LLC v Bojangles Café Ltd*, (2006), 48 CPR (4th) 427 (FC)]. As per my review of the Hemmati affidavit above, the Opponent has met this burden only with respect to use of the POM WONDERFUL and POM WONDERFUL & Design marks in association with fruit beverages, namely pomegranate juice. It has not with respect to the remaining POM Pending Marks.

[59] The Applicant must therefore show on a balance of probabilities that there is no likelihood of confusion between the Mark and the Opponent's POM WONDERFUL and POM WONDERFUL & Design trade-marks.


[60] The ground therefore remains to be decided on the issue of confusion between the marks as of the filing date of the statement of opposition. The difference in relevant dates does not materially affect my analysis above under the sections 16(2)(a) and (3)(a) grounds of opposition. As a result, I find that the Applicant has met its legal onus to show that there is not a reasonable likelihood of confusion between the parties' marks. The non-distinctiveness ground of opposition is accordingly dismissed.



Disposition


[61] In view of the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule A

Trade-mark	Appl. No.	Wares (all applications being based on proposed use of the trade-mark in Canada)
POM WONDERFUL	1,118,804	(1) Fresh fruits, except apples.
	1,176,267	(1) Fruit juices and fruit juice concentrates, except apple juice and apple concentrate.
POM SPORT	1,261,684	(1) Fruit juices; alcoholic fruit drinks and non-alcoholic fruit drinks for use as mixers for alcoholic drinks; fruit juice concentrate; fruit smoothies; fruit-flavored drinking water; sports drinks; energy drinks; non-carbonated soft drinks
POMx	1,275,312	(1) Botanical extracts, namely pomegranate extracts, for use in the preparation of pharmaceutical products and preparations; botanical extracts, namely pomegranate extracts, for use in the preparation of cosmetic and skin care products; food, dietary and nutritional supplements, namely [...]; nutraceuticals for use as a dietary supplement, derived from and containing pomegranate extracts and plant extracts, namely [...]; nutritional additives for use in foods, namely antioxidant additives and additives derived from and containing pomegranate extracts and plant extracts, namely [...]; nutritionally fortified non-alcoholic beverages derived from and containing pomegranate extracts and plant extracts, for the treatment of cancer and anti-infectives; nutritionally enhanced water; vitamin enhanced water; pomegranate extracts for use as an ingredient in food products; non-alcoholic fruit extracts used in the preparation of beverages; preparations for making fruit drinks; fruit flavored beverages; non-alcoholic beverages containing fruit juices; smoothies; bottled water; tea-based non-alcoholic beverages; low calorie fruit flavored beverages; low calorie fruit juice drinks; low calorie tea flavored beverages; sports drinks; energy drinks; pomegranate extracts for use as an

	<p>1,275,319</p>	<p>ingredient in beverages.</p> <p>(1) Botanical extracts, namely pomegranate extracts, for use in the preparation of pharmaceutical products and preparations; botanical extracts, namely pomegranate extracts, for use in the preparation of cosmetic and skin care products; food, dietary and nutritional supplements, namely antioxidant supplements and supplements derived from and containing pomegranate extracts and plant extracts, namely [...]; nutraceuticals for use as a dietary supplement, derived from and containing pomegranate extracts and plant extracts, namely [...]; nutritional additives for use in foods, namely antioxidant additives and additives derived from and containing pomegranate extracts and plant extracts, namely [...]; nutritionally fortified non-alcoholic beverages derived from and containing pomegranate extracts and plant extracts; pharmaceutical products and preparations, namely preparations derived from and containing pomegranate extracts and plant extracts, for the treatment of cancer and anti-infectives; nutritionally enhanced water; vitamin enhanced water; pomegranate extracts for use as an ingredient in food products; non-alcoholic fruit extracts used in the preparation of beverages; preparations for making fruit drinks; fruit flavored beverages; non-alcoholic beverages containing fruit juices; smoothies; bottled water; tea-based non-alcoholic beverages; low calorie fruit flavored beverages; low calorie fruit juice drinks; low calorie tea flavored beverages; sports drinks; energy drinks; pomegranate extracts for use as an ingredient in beverages.</p>
	<p>1,278,747</p>	<p>(1) Botanical extracts, namely, pomegranate extracts, for use in the preparation of pharmaceutical products and preparations; food, dietary and nutritional supplements, namely, supplements derived from and containing pomegranate extracts and plant extracts; nutraceuticals, namely, vitamin, mineral and herbal food supplements nutritional additives for use in foods containing pomegranate extracts and plant extracts; nutritionally fortified beverages, namely, energy drinks containing vitamin and mineral supplements; anti-cancer pharmaceutical preparations; pharmaceutical preparations derived from and containing pomegranate extracts and plant extracts, for</p>

		the treatment of viral and infectious diseases, namely, for the treatment of cancer, heart disease, prostate cancer, high blood pressure, erectile dysfunction; drug delivery agents consisting of enhanced water; frozen fruits; topping syrup, namely, pomegranate syrup; iced tea and non-alcoholic tea-based beverages with fruit flavoring; salad dressing; non-alcoholic fruit extracts used in the preparation of beverages; preparation for making fruit drinks; non-alcoholic fruit flavored beverages; non-alcoholic beverages containing fruit juices; smoothies; bottled water; non-alcoholic tea flavored fruit juice beverages; non-alcoholic low calorie fruit flavored beverages; non-alcoholic low calorie fruit juice drinks; non-alcoholic low calories tea flavored beverages.
	1,278,745	(1) Iced teas and non-alcoholic tea-based beverages with pomegranate flavoring; non-alcoholic fruit extracts used in the preparation of beverages, preparations for making fruit drinks, non-alcoholic fruit flavored beverages, non-alcoholic beverages containing fruit juices, smoothies, non-alcoholic beverages with tea flavor, non-alcoholic low calorie fruit flavored beverages, non-alcoholic low calorie fruit juice drinks, non-alcoholic low calorie tea flavored beverages, sports drinks, energy drinks, all made in whole or significant part of pomegranate juice.
POMx SHOTS	1,306,695	(1) Nutraceuticals, namely, nutraceutical beverages in liquid and powder form for use as a dietary supplement, namely, non-alcoholic energy drinks and fruit juices made from pomegranate extracts and plant extracts, used to promote heart and cardiovascular health, prostate health and to treat erectile dysfunction; nutritionally fortified beverages, namely, fruit based soft drinks, tea, coffee and juice; nutritionally fortified water; vitamin enriched water; non-alcoholic fruit extracts used in the preparation of beverages, namely, fruit based soft drinks, tea, coffee and juice; non-alcoholic beverages, namely, fruit based soft drinks, tea, coffee and juice; drinking water, flavored water; sports drinks; non-alcoholic beverages, namely, energy drinks; pomegranate extracts for use as an ingredient in making non-alcoholic beverages, namely, soft drinks, tea, coffee and juice

POM SHOTS	1,306,694	(1) Nutraceuticals for use as a dietary supplement, namely, powders, liquids, capsules and pills, made from fruit extracts and plant extracts; vitamin and mineral fortified non-alcoholic fruit-based beverages; nutritionally fortified water; vitamin enriched water; preparations for making fruit drinks, namely fruit extracts and syrups for making non-alcoholic fruit drinks, non-alcoholic fruit flavored beverages and non-alcoholic fruit flavored beverages non-alcoholic fruit extracts used in the preparation of beverages; fruit flavored non-alcoholic beverages and non-alcoholic fruit flavored beverages non-alcoholic beverages containing fruit juices; drinking water, flavored water; sports drinks; non-alcoholic energy drinks; pomegranate extracts for making non-alcoholic fruit drinks, non-alcoholic fruit flavored beverages and non-alcoholic fruit flavored beverages.
POM COFFEE	1,320,701	(1) Coffee; prepared ready-to-drink coffee; coffee-based preparation for making beverages; iced coffee; espresso; coffee-based beverages with fruit flavoring and beverages made of coffee; coffee-flavored soft drinks, energy drinks; low calorie non-alcoholic beverages with coffee flavor; non-alcoholic beverages containing coffee; and smoothies containing coffee.
POM BREW	1,320,700	(1) Coffee; prepared ready-to-drink coffee; coffee-based preparation for making beverages; iced coffee; espresso; coffee-based beverages with fruit flavoring and beverages made of coffee; coffee-flavored soft drinks, energy drinks; low calorie non-alcoholic beverages with coffee flavor; non-alcoholic beverages containing coffee; and smoothies containing coffee.