

**IN THE MATTER OF AN OPPOSITION  
by Fletcher Leisure Group Inc. to application  
no. 860,315 for the trade-mark SUN ICE filed  
by Protos International Inc.**

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On October 31, 1997 the applicant Protos International Inc. filed an application to register the trade-mark SUN ICE based on proposed use in Canada. The application was met with several objections at the examination stage including (i) confusion with registered marks and a pending application, covering clothing and accessories, standing in the name of Sun Ice Limited, (ii) the wares were not stated in ordinary commercial terms. The applicant overcame the above objections by restating its wares as shown below,

carbonated and non-carbonated, non-alcoholic beverages, namely  
fruit based drinks and juices and drinking water

and by pointing out the differences between the wares specified for the applied for mark SUN ICE and the wares specified in the cited registrations and application owned by Sun Ice Limited.

The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated December 2, 1998 and was opposed by Sun Ice Limited on February 1, 2000. The Registrar forwarded a copy of the statement of opposition to the applicant on February 22, 2000. The applicant responded by serving and filing a counter statement.

The first ground of opposition alleges that the application does not comply with Section 30(i) of the *Trade-marks Act* in that the applicant could not state that it was satisfied it was entitled to use the mark SUN ICE.

The second ground alleges that the applied for mark is not registrable, pursuant to Section 12(1)(d) of the *Act*, because it is confusing with the opponent's registered marks namely, SUN ICE DESIGN, regn. no. 302,455; SUN ICE & STRIPES DESIGN, regn. no. 302,456; SIARAS SUN ICE ALL REASONS ALL SEASONS & DESIGN, regn. nos. 377,260; SUN ICE SIARAS ALL REASONS ALL SEASONS & DESIGN, regn. no. 417,515; and SUN ICE CLUB, regn. no. 495,594. The aforementioned registrations cover articles of clothing and related wares such as ski goggles, sunglasses, belts, ties, shoes and boots.

The third ground of opposition alleges that the applicant is not entitled to register the applied for mark, pursuant to Section 16 of the *Act*, because it is confusing with (i) the opponent's above-mentioned marks that had been previously used in Canada, (ii) the opponent's mark SUN ICE previously used in Canada in association with clothing, (iii) application no. 774,035 for the mark SUN ICE previously filed in Canada by the opponent for wares which include personal care products, (iv) the marks SUN ICE and SUN ICE LIMITED previously used in Canada by the opponent (presumably in association with items of clothing).

The final ground of opposition alleges that the applied for mark SUN ICE is not distinctive because it cannot actually distinguish the applicant's wares from the wares of the opponent.

The opponent's evidence consists of the affidavit of Angela Grams, an employee of the opponent company. The applicant elected not to submit any evidence. Both parties submitted a written argument and both were represented at an oral hearing. Shortly before the oral hearing,

the original opponent assigned its SUN ICE marks to Fletcher Leisure Group Inc., the present opponent of record.

Ms. Grams' evidence may be summarized as follows. The opponent is the owner of a number of design trade-mark registrations which include the word component SUN ICE (which marks I will refer to collectively as SUN ICE ). The opponent directly and through its licensees has used its mark SUN ICE across Canada in association with clothing, most notably ski and golf clothing, as well as accessory items such as ski goggles, sports bags, visors and backpacks. The representative specimens of tags forming Exhibit B of Ms. Grams' affidavit, two of which are shown below, are affixed "to each of the hundreds of millions of items of clothing that have been sold bearing the SUN ICE trade-marks."

The retail value of the clothing sold in the period 1992 - 1997 inclusive averaged about \$27 million annually. In 1997 the opponent granted licenses to two separate corporate entities to use the SUN ICE marks, with the opponent in full control of the manufacturing and quality specifications. Retail sales for the period 2000 - 2003 inclusive thereafter decreased to about \$6 million annually. The opponent's mark SUN ICE is advertised and promoted in catalogues and

brochures; in posters at retail outlets; in printed publications; at various Internet sites; at various sporting events; and in the 1980's by athletes on the Canadian Olympic Ski team wearing SUN ICE wares.

The determinative issue in this proceeding is whether the applied for mark SUN ICE is confusing with the opponent's word mark SUN ICE. In this regard, I would note that the public would, as a matter of first impression on seeing various of the opponent's design marks, perceive the word component SUN ICE *per se* being used as a trade-mark: see *Nightingale Interloc v. Prodesign Ltd.* (1984), 2 C.P.R.(3d) 535 at 538 (TMOB).

The earliest material date to consider the issue of confusion is the date of filing of the application, that is, October 31, 1997, while the latest material date is the date of my decision: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 C.P.R.(3d) 198 at 206 - 209 (F.C.T.D.). In the circumstances of this case, nothing turns on whether the issue of confusion is assessed at any particular material date.

The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2), between the applied for mark SUN ICE, covering fruit based drinks and juices and drinking water, and opponent's mark SUN ICE used in association with clothing and accessory items. The presence of an onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30

C.P.R.(3d) 293 at 297-298 (F.C.T.D.). The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in Section 6(5) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

The opponent's mark SUN ICE possesses a fair degree of inherent distinctiveness even though the mark is a combination of two common words. It is the juxtaposition of the ideas suggested by the two word components that is unique. The applied for mark SUN ICE similarly possesses a fair degree of inherent distinctiveness. Ms. Gram's affidavit evidence might have provided greater detail concerning sales and advertising of the opponent's wares under its mark SUN ICE, however, in the absence of cross-examination I am prepared to find that the opponent's mark SUN ICE had acquired a significant reputation in Canada at all material times. The applied for mark SUN ICE is based on proposed use in Canada and there is no evidence to show that it acquired any reputation at any material time.

The length of time that the marks in issue have been in use favours the opponent as it has been using its mark SUN ICE in Canada since the early 1980's. The nature of the opponent's

wares and the applicant's wares are quite different. In this regard, the opponent has established that its mark has acquired a significant reputation in Canada, in association with sports clothing and accessories, at all material times. The applicant proposes to use the mark SUN ICE in association with beverages. As the parties' wares are very different, I assume that the parties' channels of trade would also differ. Of course, the marks are the same visually, aurally and in ideas suggested.

In the *Pink Panther* case, the applicant therein applied to register the trade-mark PINK PANTHER for use in association with beauty supplies: see *United Artists v. Pink Panther Beauty Corp.* 80 C.P.R.(3d) 247 (F.C.A.). The opponent alleged that the trade-mark was confusing with its trade-mark THE PINK PANTHER, famous for a series of Hollywood films. In finding that the marks were not confusing, the Court noted as follows, at pp. 267-268:

No matter how famous a mark is, it cannot be used to create a connection that does not exist.

.....  
In *Playboy Enterprises Inc. v. Germain* (1978), 39 C.P.R. (2d) 32 (F.C.T.D.), the applicant Germain wanted to register PLAYBOY MEN'S HAIR STYLIST for services defined as "un salon de coiffure pour hommes". Marceau J. upheld the decision of the Registrar that this proposed mark was not confusing with the opponent's mark PLAYBOY, used in relation to magazines. He stated:

In dealing with these facts and the evidence as a whole, the Registrar found nothing therein that could be taken as establishing any reputation or involvement on the part of the appellant with services similar or related to those of the respondent. There was no proof whatever of any use, or making known, of the opponent's trade mark PLAYBOY in association with barbering or hairdressing services in Canada at any time prior to the applicant's adoption of his trade mark.

The fact that the opponent's mark was world-renowned could not be a factor so important as to make the differences in wares and services irrelevant. In another case involving Playboy Enterprises, *Playboy Enterprises Inc. v. Astro Tire & Rubber Co. of Canada Ltd.* (1978), C.P.R. (2d) 87 (T.M.O.B.), that company was also unsuccessful in preventing the registration of the trade-mark PLAYBOY for use in association with automobile tires. Fame

is not everything, apparently. It is possible to use a famous mark for a different product in a different context without infringing

Similarly, in *Lexus Foods Inc. v. Toyota Jidosha Kabushiki Kaisha* 9 C.P.R. (4th) 297 (F.C.A.), the Federal Court of Appeal observed that while the notoriety of a mark may well be a significant factor to consider in assessing the issue of confusion, it is not controlling (at p. 301):

Famousness alone does not protect a trade-mark absolutely. It is merely a factor that must be weighed in connection with all the rest of the factors. If the fame of a name could prevent any other use of it, the fundamental concept of a trade-mark being granted in relation to certain wares would be rendered meaningless.

At the oral hearing, counsel for the opponent placed much reliance on paragraph 15 of the Grams affidavit, shown below:

Counsel relied on the opponent's distribution of water bottles, presumably bearing the SUN ICE mark, to establish a nexus between the applicant's beverages and the opponent's wares. I do not accept that a tangible connection exists. It appears to me that the distribution of water bottles falls into the same category as the distribution of lip balm, that is, to establish goodwill for the opponent's

mark SUN ICE for clothing. The applicant is in the business of manufacturing and selling clothing, not any types of beverages. The uses of its mark SUN ICE for items other than clothing and sports equipment are incidental uses for the purposes of promotion.

In the instant case the evidence is not sufficient to establish that the opponent's mark SUN ICE may be considered a "famous" mark for clothing nor does the evidence establish any meaningful reputation for the opponent's mark in association with bottled water. Further, as I have indicated above, I do not believe that the evidence establishes any connection between the opponent's wares and the applicant's wares. In the absence of a connection between the parties' wares, I find that the parties' marks are not confusing at any material date, in accordance with the principles for assessing confusion between marks set out in *Pink Panther* and *Lexus*, above .

Accordingly, the opponent's opposition is rejected.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 28th DAY OF APRIL, 2004.

Myer Herzig,  
Member,  
Trade-marks Opposition Board