



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

Citation: 2012 TMOB 29
Date of Decision: 2012-02-07

**IN THE MATTER OF AN OPPOSITION
by SSP Financing UK Limited to
application No. 1,334,151 for the trade-
mark UPPER CRUST & Design in the
name of 2168587 Ontario Ltd.**

[1] On February 6, 2007, Upper Crust Ltd. filed an application to register the trade-mark UPPER CRUST & Design (the Mark) based on use of the Mark in Canada since at least as early as 1982 in association with the following wares:

fully baked, par-baked, proof-and-bake and frozen bakery products, namely: bread; baguettes; puff pastry, namely, turnovers, strudel, puff pastry squares, puff pastry slabs, puff pastry sticks, french fans, palm leaves, sausage rolls, and beef rolls; danish pastry, namely, twisted danish pastry, rolled danish butter horns, cheese and fruit filled danish pastry, danish dough slabs, and coffee cake; cinnamon rolls; and croissants.

[2] The Mark is shown below:



[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of August 29, 2007.

[4] On March 28, 2008, SSP Financing UK Limited (the Opponent) filed a statement of opposition against the application.

[5] On April 9, 2008, the application was assigned to 2168587 Ontario Ltd. I shall use the term Applicant to refer to both 2168587 Ontario Ltd. and Upper Crust Ltd. as the case may be.

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

[7] In support of its opposition, the Opponent filed affidavits of Chris Andreoff and Sandeep Dhupar.

[8] In support of its application, the Applicant filed an affidavit of Dhanmattie Hiranman.

[9] No cross-examinations were conducted.

[10] Both parties filed a written argument and participated in an oral hearing.

Onus and Material Dates

[11] 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 evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably

be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Section 30 Ground of Opposition

[12] The Opponent has pleaded that the application does not comply with s. 30 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act). In particular, the Opponent has pleaded that the application does not comply in that it does not contain an accurate and true statement as to the date from which the Applicant commenced use of the Mark in Canada because the Applicant has not used the Mark in Canada with the applied-for wares since as early as 1982.

[13] As indicated in the Opponent's written argument, the above pleading falls under s. 30(b) of the Act. An opponent's burden can be met with respect to s. 30(b) by reference not only to the opponent's evidence but also to the applicant's evidence [see *Labatt Brewing Company Limited v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.) at 230]. However, while an opponent may rely upon the applicant's evidence to meet its evidential burden in relation to this ground, the opponent must show that the applicant's evidence is clearly inconsistent with the applicant's claims as set forth in its application.

[14] The Opponent's own evidence does not satisfy its evidential burden. The Opponent has made various submissions concerning the fact that the Applicant's evidence does not show use of the Mark as early as 1982, but the Applicant was not obliged to do so. The Applicant's evidence is not clearly inconsistent with respect to its claimed date of first use and so the Applicant's evidence does not serve to satisfy the Opponent's evidential burden. The s. 30 ground of opposition is accordingly dismissed.

Section 12(1)(d) Ground of Opposition

[15] The Opponent has also pleaded that the Mark is not registrable pursuant to s. 12(1)(d) of the Act as it is confusing with the trade-mark UPPER CRUST & Design registered by the Opponent under No. TMA691,826 for:

wares

(1) cups, mugs, bowls and drinking vessels; beverage glassware; lunchboxes; insulated containers for beverages and foods; portable cool boxes; picnic baskets and picnic bags; clothing, namely jackets, pants, shirts and caps; footwear, namely boots and shoes; uniforms; overalls; work clothing; aprons; t-shirts; meat and meat products, namely chicken legs, roast beef, ham and bacon, fish, namely fish sandwiches and fish filets; seafood; poultry; preparations for making meals, namely cooked chicken strips, cooked sausages, cooked chicken tikka, omelettes, carrot cakes, roasted vegetables, cooked pieces of spicy pork meat, tuna in brine, tomato and onion chutney, oregano, peppers, pepperoni, prawns, aubergines, courgettes, breads, bagels, ciabatta, rolls, onions, mozzarella cheese, roast beef, lettuce, eggs, cucumber, whipped cream, chives, tomatoes, cheddar cheese, brie cheese, bananas, bacon, apples, coleslaw, feta chese and ham; sausages; burgers; hot dogs; preserved, dried, canned and cooked fruits and vegetables and preparations made therefrom; vegetarian foods, namely vegetable juice, vegetable oils and vegetables; prepared vegetables; potatoes and foods made predominantly from potatoes; salads; soups; pastes; pates; fillings and spreads; dairy products, namely cheese, yoghurt, milk, and dairy based beverages; soya milk; desserts, namely carrot cakes, brownies, croissants, danish pastries, muffins and fruit sauce; puddings; eggs; edible oils and fats; nuts; fresh fruits and vegetables; flowers and nuts; preparations for making non-alcoholic drinks, drinks, namely chocolate powder, tea bags, coffee beans and coffee extracts; fruit juices and vegetable juices; fruit flavoured beverages; mineral and aerated waters; water; spring water; flavoured water; soft drinks; sparkling drinks; concentrates for making such drinks.

(2) prepared meals, namely hot and cold baquettes, with meat fillings, sausages, chicken tikka, roasted vegetables and cooked pork meat; hot and cold snacks, namely hot and cold filled baquettes, cakes, pastries, brownies, muffins, croissants and scones; pizzas; filled rolls, sandwiches, filled baguettes; none being frozen food and all for consumption away from home; sauces, namely balsamic and olive oil dressings, barbecue sauce, cajun sauce, cranberry sauce, mayonnaise, ketchup, mustard, horseraddish sauce, virgin olive oil and pizza sauce; condiments; bread, rolls, cakes, buns, pastries, biscuits, confectionery, namely chocolate, nuts, truffles, chocolate bars and cereal bars; ices, ice cream, ice cream cones, and ice milk; cereals; breakfast cereals; whole and ground coffee, coffee beans, coffee extracts, coffee essences, tea and chocolate beverages, beverages, namely non-alcoholic beverages, namely fruit juice, sparkling water, bottled drinking water, chocolate beverages, chocolate milk, hot chocolate beverages, tea, coffee, and carbonated soft drinks.

services

(1) catering services; restaurant, café, cafeteria, snack bar and coffee shop services; preparation of foodstuffs or meals or beverages for consumption on or off the premises; advice relating to food and drink.

(2) the bringing together, for the benefit of others, a variety of foods and beverages enabling customers to conveniently view and purchase these goods in takeaway food outlets, grocery and convenience stores and motorway service stations.

(3) catering, restaurant, cafeteria and snack-bar services.

[16] The Opponent's mark is shown below:



[17] The Opponent has met its initial burden with respect to its s. 12(1)(d) ground of opposition because the pleaded registration is extant.

[18] 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. The test for confusion is one of first impression and imperfect recollection.

[19] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 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 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. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.) and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.).]

inherent distinctiveness of the marks

[20] Both marks are inherently distinctive. However, neither mark is inherently strong since the dominant words UPPER CRUST are suggestive of bakery products. While both marks include some design features, the design features of each mark are weak and their differences seem unlikely to serve to distinguish the one mark from the other.

the extent to which each mark has become known

[21] A mark's distinctiveness can be enhanced through use and promotion and I will therefore now summarize the evidence regarding use and promotion.

[22] The Opponent's affiants attest that the Opponent's mark has been used in Canada by licensees and that the Opponent has controlled the character and quality of the wares and services with which the mark is used. The evidence shows that the Opponent's mark has been used with some of the registered services by being displayed on signage in restaurants, cafés, cafeterias, snack bars and coffee shops owned and operated by the Opponent's licensees [Exhibit B2 of the Andreoff affidavit]; specific reference has been made to seven snack bars/cafés operated at universities across Canada plus one snack bar/cafés operated at Toronto International Airport. The Opponent's mark is used with bakery products by selling such wares wrapped in packaging that displays the mark [as shown in Exhibits C1 and D1 of the Andreoff affidavit and Exhibits C and D of the Dhupar affidavit]. While the Opponent has evidenced use of its mark, it has not provided sales figures or advertising expenditures.

[23] The Applicant's affiant attests that the Mark is prominently displayed on boxes in which the Applicant's wares are sold; Exhibit F to the Hiranman affidavit is a large cardboard box that displays the Mark. Ms. Hiranman attests that the Applicant's wares are manufactured in Ontario and sold throughout Canada, as well as in the United States, Venezuela, Japan and Israel. The Applicant sells its wares to various distributors, as well as to large grocery chains; its Canadian clients include Sobey's, Ready Bake, Snow Cap Enterprises Ltd. and GFS Ontario. Ms. Hiranman has provided two sample invoices (Exhibit G is a 2008 invoice to Winn Dixie in the U.S. and Exhibit H is a 2009 invoice to Dillon Stores Frozen DC in the U.S.), as well as a sample order sheet from 2005 and a price list from April 1, 2004. In addition, the Applicant has informed us that its total sales revenues were over 30 million dollars in 2008 and over 29 million dollars in 2009, with its sales revenues for Canada in particular being over 11 million dollars in 2008 and over 20 million dollars in 2009. I note that sales from the Applicant's Canadian office to foreign buyers qualify as use of the Mark under s. 4(3) of the Act, but such foreign sales cannot be said to necessarily add to the reputation of the Applicant's Mark within Canada. I further note that the Applicant has not provided any information concerning promotion of its Mark.

[24] Based on the foregoing summary, I find that, due to the Canadian sales in 2008/2009, the Applicant's Mark has become known to a significant extent in Canada; I am unable to make a similar finding with respect to the Opponent's mark. Therefore, based on the evidence, the Applicant's Mark has become known to a greater extent than the Opponent's mark.

the length of time the marks have been in use

[25] According to the Opponent's registration, it has used its mark since at least as early as 2002, whereas the Applicant's application claims use of the Mark since at least as early as 1982. However, as neither party has evidenced continuous use since such alleged dates, the length of time the marks have been in use is not a material circumstance in this case.

the nature of the wares, services, business and trade

[26] When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark application and registration that govern in respect of the issue of confusion arising under s. 12(1)(d) [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe, Inc. v. Dale Bohna* (1984), 58 C.P.R. (3d) 381 (F.C.A.)].

[27] The wares listed in the application overlap with or are related to some of the wares in the Opponent's registration. In particular, both parties' marks are associated with bakery products, such as bread, danish pastries and croissants.

[28] From the evidence, it appears that the Opponent currently sells its wares only through its UPPER CRUST snack bars/cafés while the Applicant sells its wares primarily to grocery chains. However, neither the application nor the registration include any restriction on the channels of trade through which the parties' wares may travel. Therefore, one must consider if confusion might be likely if both parties' wares were sold through the same channels of trade. The Opponent's registration gives it the exclusive right to sell its bakery wares through any channels of trade that are typically associated with wares of that nature, for example, through grocery stores. Moreover, it is noted that the Opponent's registered services specifically refer to grocery stores in "the bringing together, for the benefit of others, a variety of foods and beverages

enabling customers to conveniently view and purchase these goods in takeaway food outlets, grocery and convenience stores”.

degree of resemblance between the marks

[29] The marks are identical when sounded and in idea suggested. Visually, there are some differences between the marks due to their different design features, but it is the words, not the design, that dominate each mark. As submitted by the Opponent, the differences between the design features do not outweigh the similarities between the word portions.

other surrounding circumstances

[30] As a further surrounding circumstance, the Applicant points out that there is no evidence of actual confusion having occurred despite many years of alleged co-existence. However, it is not necessary for an opponent to evidence actual confusion in order to succeed. Moreover, as conceded by the Applicant, in the present case it is possible that confusion has simply not occurred due to the different channels of trade currently employed by the parties.

[31] As yet another surrounding circumstance, the Opponent’s evidence indicates that prior to adopting the UPPER CRUST & Design mark that is the subject of its registration, it used the word mark UPPER CRUST, starting at least as early as September 1998. However, this is not a decisive factor in an analysis of the likelihood of confusion under this ground of opposition.

conclusion re s. 12(1)(d) ground

[32] Applying the test of first impression, I have to decide whether a casual consumer who has an imperfect recollection of the Opponent’s UPPER CRUST & Design mark as associated with bakery products would infer that the Applicant’s UPPER CRUST & Design bakery products share a common source. Having considered all of the surrounding circumstances, I arrive at the conclusion that the probabilities of confusion between the marks at issue are evenly balanced between a finding of confusion and of no confusion. I reach this conclusion because on the one hand there is a high degree of resemblance between the marks and an overlap between both the associated wares and potential channels of trade, while on the other hand neither mark is inherently strong and the evidence shows that the Applicant’s Mark has become known to a

greater extent than the Opponent's mark. 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 trade-mark, I must find against the Applicant. The s. 12(1)(d) ground of opposition therefore succeeds.

Distinctiveness Ground of Opposition

[33] As its final ground of opposition, the Opponent has pleaded that the Mark is not distinctive because it does not actually distinguish and is not adapted to distinguish the Applicant's wares from the wares and services which the Opponent and its predecessors have sold and advertised in Canada in association with the trade-mark UPPER CRUST & Design and UPPER CRUST since prior to the filing of the Applicant's application.

[34] The material date for assessing distinctiveness is the date of filing of the opposition, March 28, 2008 [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

[35] As indicated above, the Opponent's distinctiveness ground of opposition relies upon the Opponent's use of both UPPER CRUST & Design and UPPER CRUST. The Opponent claims use of UPPER CRUST since at least as early as September 1998 and use of its UPPER CRUST & Design registered trade-mark since at least as early as April 30, 2002.

[36] In respect of this ground of opposition, the Opponent has the initial evidential burden to prove that its trade-marks had become sufficiently known as of March 28, 2008 to negate the distinctiveness of the Mark [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.) and *Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)]. Once this burden is met, the Applicant has a legal onus to show, on a balance of probabilities, that the Mark was not likely to create confusion with the Opponent's trade-marks [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (T.M.O.B.)].

[37] The Opponent has not provided any evidence that shows how its UPPER CRUST & Design mark was being used as of March 28, 2008. Mere allegations of use are insufficient to

meet the Opponent's initial burden and so the distinctiveness ground fails insofar as it is based on the UPPER CRUST & Design mark.

[38] Regarding the Opponent's UPPER CRUST word mark, we have Mr. Dhupar's sworn statement that a snack bar/café selling UPPER CRUST bakery products and performing UPPER CRUST services in association with the UPPER CRUST trade-mark has operated at Durham College/University in Oshawa, Ontario continuously since September 1, 2004. A photograph of that snack bar/café, as operated as of April 9, 2009, is provided as part of his Exhibit B; it shows UPPER CRUST displayed above the menu boards behind a counter. The question is whether this evidence is sufficient to satisfy the Opponent's initial burden. I do not think that it is, for the reasons discussed below.

[39] If it is fair to accept that the April 9, 2009 photograph is representative of what appeared prior to March 28, 2008, then we are still lacking evidence of the extent to which the Opponent's UPPER CRUST mark was known as of March 28, 2008, given that no sales or advertising figures have been provided. I note that in paragraph 33 of *Bojangles' International LLC*, the Court commented that "a mark could negate another mark's distinctiveness if it is well known in a specific area of Canada", but it is not evident that the Opponent's mark was well known in a specific area of Canada as of March 28, 2008. The distinctiveness ground of opposition is accordingly dismissed in its entirety.

[40] Even if the Opponent had met its initial burden, it is possible that the distinctiveness ground would not have succeeded. I say this because there are differences in the analysis of confusion under this ground as opposed to under the s. 12(1)(d) ground that could favour the Applicant. For example, under this ground one would consider the actual channels of trade being employed by the parties rather than all those generally applicable to the types of wares and services listed in the parties' application and registration.

[41] Before closing, I note that the Opponent made submissions to the effect that the Applicant's Mark is not distinctive as a result of unlicensed use. However, I will not discuss those submissions further as that basis for non-distinctiveness was not set out in the statement of opposition and so the Applicant did not know that it had to meet such a case [see *Imperial Developments Ltd. v. Imperial Oil Ltd.* (1984), 79 C.P.R. (2d) 12 (F.C.T.D.) at 21].

Disposition

[42] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

Jill W. Bradbury
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office