

**IN THE MATTER OF AN OPPOSITION
by Seven-Up Canada Co. to application No.
1,095,034 for the trade-mark
TROPIKSPLASH in the name of
Caribbean Ice Cream Company Ltd.**

On March 7, 2001, an application was filed on behalf of Caribbean Ice Cream Co. Ltd. (the “Applicant”) to register the trade-mark TROPIKSPLASH (the “Mark”). The application was based upon use of the Mark in Canada since June 2000 in association with the following wares:

Mineral and aerated waters, non-alcoholic carbonated beverages, non-alcoholic fruit drinks, soft drinks, fruit flavoured soft drinks, aerated fruit juices, fruit juice concentrates, fruit juices, fruit paste, fruit sauces, syrups for making fruit juices, syrups for making soft drinks, nutritional drinks, energy drinks, ice cream, frozen yogurt, kulfi, sorbets, jellies, jams, hot sauces, and peanut brittle.

The application was advertised for opposition purposes in the Trade-marks Journal of October 9, 2002. On January 23, 2003, Seven-Up Canada Co. (the “Opponent”) filed a statement of opposition against the application. The Applicant filed and served a counter statement.

As evidence pursuant to rule 41 of the *Trade-marks Regulations (1996)* (the “Regulations”), the Opponent filed the affidavit of Nino Calabrese, a Private Investigator.

As evidence pursuant to rule 42 of the Regulations, the Applicant filed the affidavit of its President, Rumi Keshavjee. The Opponent obtained an order for the cross-examination of Mr. Keshavjee on his affidavit but a cross-examination was not conducted.

On October 15, 2004, the Applicant sought to file a further affidavit of Mr. Keshavjee but leave to do so was denied by the Office Letter of November 22, 2004.

Each party filed a written argument. An oral hearing was not requested.

Grounds of Opposition

I reproduce below paragraph 2 of the statement of opposition.

2. The grounds of opposition are as follows:

(a) Subsection 38(2)(a)

The application does not conform to the requirements of Section 30 in that:

- (i) contrary to Section 30(a), the wares in association with which the mark has allegedly been used have not been described in ordinary commercial terms;
- (ii) contrary to Section 30(b), the application does not correctly identify the Applicant and/or predecessor in title of the Applicant;
- (iii) contrary to Section 30(b), the Applicant, by itself and/or through a licensee has not used the trade-mark in Canada since the claimed date of first use in association with the wares for which use is alleged in the application;
- (iv) contrary to Section 30(b), the Applicant, by itself and/or through a licensee has not used the trade-mark in Canada in association with the wares for which use is alleged in the application.

Counter Statement

The Applicant has raised a number of matters in its counter statement beyond the usual denials.

With respect to ground (i), the Applicant objects that the Opponent has not specified the ware(s) that the Opponent claims have not been described in ordinary commercial terms. On this basis, the Applicant states that it is unable to properly respond to that ground.

I agree that the Opponent ought to have been more specific with respect to this pleading. I also note that neither the Opponent's evidence or its written argument expands on this ground. This ground is accordingly dismissed, on the basis that it was insufficiently pleaded and, alternatively, that the Opponent did not satisfy its initial evidential burden with respect thereto.

Regarding ground (ii), the Applicant submits that this is not a proper ground of opposition because s. 30(b) does not require that the Applicant be properly identified. The Applicant does however later admit that the Applicant's Articles of Incorporation state that the name of the

corporation is “Caribbean Ice Cream Company Ltd.” and requests leave to file an amended application. The Applicant subsequently provided evidence that the correct legal name of the Applicant is Caribbean Ice Cream Company Ltd. and the records have been amended to reflect this. The word “Company” was not spelled out in full in the original application as a result of an inadvertent error; such an error does not support a s. 30(b) ground of opposition. Ground (ii) is accordingly dismissed.

With regard to ground (iv), the Applicant admitted that it had “not actually commercially used the trade-mark in Canada in association with the following wares: ‘mineral and aerated waters, non-alcoholic carbonated beverages, soft drinks, fruit flavoured soft drinks, aerated fruit juices, fruit juice concentrates, fruit sauces, syrups for making soft drinks, energy drinks, ice cream, frozen yogurt, kulfi, sorbets, jellies, jams, hot sauces, and peanut brittle.’” The Applicant has therefore deleted the following wares from its application: fruit juice concentrates, fruit sauces, energy drinks, ice cream, frozen yogurt, kulfi, sorbets, jellies, jams, hot sauces, and peanut brittle. It has also requested that the application be amended to rely on proposed use in association with the remainder of the wares set out in the first sentence of this paragraph, but such an amendment cannot be made as it is contrary to rule 32(c) of the Regulations.

Onus

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (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 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.).]

The evidential burden on the Opponent is lighter respecting the issue of non-conformance with s. 30(b) [*Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.) at 89; *John Labatt Ltd. v. Molson Companies Ltd., supra*]. Furthermore, s. 30(b)

requires that there be continuous use of the applied for trade-mark in the normal course of trade since the date claimed, *i.e.* up to the material date, namely the filing of the application [*Labatt Brewing Co. v. Benson & Hedges (Canada) Ltd.* (1996), 67 C.P.R. (3d) 258 (F.C.T.D.) at 262; *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475].

The Opponent's Evidence

The Opponent relies upon Mr. Calabrese's affidavit to satisfy its evidential burden. The most salient points of Mr. Calabrese's evidence, all of which relate to 2003, are as follow:

- In January 2003, he attended at the Applicant's business address and was unable to locate any wares for sale in association with the Mark.
- Three individuals who were part of the "Marketing/Sales Team" at that location were unfamiliar with the Mark.
- Mr. Calabrese obtained a business card from that location, which identified Tropical Treetts Ice Cream as a division of the Applicant (Exhibit "A"). He was also provided with a 2002/2003 fall/winter product catalogue which he was told contained all products currently manufactured and/or distributed by Tropical Treetts Ice Cream (Exhibit "B"); the catalogue contains no reference to the Mark.
- Enquiries were made of two third party Ontario retailers of Caribbean food, which revealed that they were not familiar with the Mark
- A telephone enquiry to Tropical Treetts Ice Cream for beverages under the name TROPIKSPLASH or one similar thereto received a response that the only product under a similar sounding name is a beverage sold under the name TROPIKFRESH.
- On a return visit to the Applicant's place of business about nine month's later (September 2003), Mr. Calabrese located four different bottled beverages under the name TROPIKSPLASH (Exhibit "C"). Their labels read "manufactured in Canada for Tropiksplash, Toronto, Ontario M4A 1X5" and provided a phone number which referred the caller to the Applicant's phone number. The postal code is also that of the Applicant. The sales clerk told Mr. Calabrese that the TROPIKSPLASH beverages were new and had only been on the market for one to one-and-a-half months. A 2003 Product Catalogue was obtained (Exhibit "D"), but it did not list the TROPIKSPLASH product. Mr.

Calabrese was informed by an individual in the Sales Department that the product was new, had only been available for approximately one month, was manufactured on their premises, and was so new that no else had it in their stores at that time, it only being sold out of their own store at that time.

I find that the foregoing evidence does meet the Opponent's light evidential burden. I appreciate that all of Mr. Calabrese's evidence postdates the material date and that some of his evidence has hearsay flaws. Nevertheless, it is difficult for a third party to produce evidence to show that there was no use of another party's mark at any date, let alone at a date several years ago, and it is for this reason that the evidential burden in cases like this is lighter. The Applicant has the opportunity to rebut such evidence and, as discussed below, the Applicant has seized the opportunity to do so.

The Applicant's Evidence

Mr. Keshavjee states that he has read Mr. Calabrese's affidavit. His response thereto can be summarized as follows:

- The Mark has "been in development by the Applicant prior to the filing" of the application on March 7, 2001.
- The Applicant carries and distributes hundreds of products from a number of principal brand names and also manufactures, or has manufactured for it, certain lines of products. Not all of the Applicant's employees are knowledgeable about each and every product line.
- On occasion, certain of the Applicant's product lines are unavailable at its retail store and may not be listed in the product catalogue. "The listing of a product in the catalogue is not determinative of whether or not the product is part of the product lines distributed by the Applicant."
- Mr. Keshavjee is the only person employed by the Applicant who has intimate knowledge of each and every product. None of the individuals referred to in Mr. Calabrese's affidavit would have had knowledge of the TROPIKSPLASH product line.
- From May 2000 up to July 2003, the Applicant was test marketing the TROPIKSPLASH

line of products through Tropical Food King, a store owned by Sultan Kasmani, which in turn sold and distributed the TROPIKSPLASH products. As Exhibit “B”, Mr. Keshavjee provides copies of four invoices dating from May 2000 to August 2000 from the Applicant to Tropical Food King, which list cases of TROPIKSPLASH products, among other things. The shipments were to the same location as invoiced, C.O.D., and the invoices are stamped “paid”.

- In or around June/July 2003, Mr. Kasmani was no longer able to operate his store due to failing health. At this time, Mr. Keshavjee was satisfied that the TROPIKSPLASH line could be successful due to favourable customer response and feedback provided by Mr. Kasmani and his customers. As a result, the Applicant commenced sales of the TROPIKSPLASH line through its retail store as of September 2003.
- Many other stores have sold the Applicant’s TROPIKSPLASH products in both 2003 and 2004 (see list and representative invoices in Exhibits “C” and “D”). However, the third party stores visited by Mr. Calabrese have never sold the Applicant’s TROPIKSPLASH products.

As noted earlier, the Opponent elected to not cross-examine Mr. Keshavjee.

Conclusions Regarding Use of Mark

Based on the foregoing, I find that the Applicant has satisfied its legal burden to show that its Mark was in use as of the date claimed in association with the following flavours of beverages: fruit punch, papaya/orange/carrot, mango/carrot, and pineapple/coconut. This conclusion is based on the invoices to Tropical Food King that predate June 30, 2000. Mr. Keshavjee has satisfied me that there were sales by the Applicant of TROPIKSPLASH beverages in the normal course of trade in accordance with s. 4(1) prior to June 2000 in Canada. Not only has the Applicant provided sample labels of the product but he has also provided invoices that would qualify as use of the mark in accordance with s. 4(1). (When a trade-mark appears in the body of the invoice and there is evidence that the invoice accompanied the wares, this is evidence of use of the trade-mark in accordance with s. 4(1) [*Riches, McKenzie & Herbert v. Pepper King Ltd.* (2000), 8 C.P.R. (4th) 471 (F.C.T.D.)].) In addition, Mr. Keshavjee has provided evidence of the continued

use of the Mark in association with such beverages. In other words, there is evidence that the test marketing was followed by regular marketing and thus was the beginning of use of the Mark in the normal course of trade.

The Applicant has submitted in its written argument that it used its Mark before June 2000 in association with “non-alcoholic fruit drinks, fruit juices, fruit paste, fruit juice concentrates and syrups for making fruit juices”. However, even if the products sold in association with the Mark prior to the claimed date of first use could be so classified, the use made in association with one specific ware cannot serve to maintain multiple wares within the statement of wares. [See *Sharp Kabushiki Kaisha v. 88766 Canada Inc.* (1997), 72 C.P.R. (3d) 195 (F.C.T.D.) at 200-201.] I note that in its 2004 catalogue, the Applicant lists its TROPIKSPLASH products under the heading “tropical juices and non-carbonated beverages”. The product labels read “50% juice” but do not refer to the product as any of the aforementioned categories. In his affidavit, Mr. Keshavjee never refers to the TROPIKSPLASH products by any of these categories, choosing instead to refer simply to the TROPIKSPLASH product line. The closest he gets to naming their category is when he says at paragraph 16, “We currently market different beverage flavours under the TROPIKSPLASH brand...” In the absence of evidence to the contrary, it therefore seems appropriate to me to classify the wares sold as broadly as possible, namely as “non-alcoholic fruit drinks”.

As I am satisfied that the Applicant used the Mark in Canada in association with non-alcoholic fruit drinks since the claimed date of first use, grounds (iii) and (iv) fail with respect to such wares. However, as the Applicant has either not lead any evidence in respect of the remainder of the wares or admitted that it did not use the Mark in association with them, grounds (iii) and (iv) succeed with respect to the wares other than non-alcoholic fruit drinks.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, pursuant to s. 38(8) I reject the opposition with respect to “non-alcoholic fruit drinks” and refuse the application with respect to the remaining wares. Authority for a split decision is set out in

Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH (1986), 10 C.P.R.
(3d) 492 (F.C.T.D.).

DATED AT TORONTO, ONTARIO, THIS 9th DAY OF MARCH 2007.

Jill W. Bradbury
Member
Trade-marks Opposition Board