

**IN THE MATTER OF AN
OPPOSITION by U L Canada
Inc. to application No. 754,794
for the trade-mark FUDGE
BOMB filed by Wells= Dairy,
Inc.**

On May 16, 1994, the applicant, Wells= Dairy, Inc., filed an application to register the trade-mark FUDGE BOMB for "frozen confections" based on proposed use as well as on use and registration in the United States. The applicant disclaimed the right to the exclusive use of the word FUDGE apart from the trade-mark. The application was advertised for opposition purposes on May 17, 1995.

The opponent, U L Canada Inc., filed a statement of opposition on October 16, 1995. The applicant filed and served a counterstatement.

The opponent filed as its evidence the affidavits of Robert D. Hepburn and Valerie Miller. The applicant did not file any evidence. It did obtain an order for the cross-examination of the opponent=s affiants but no cross-examinations were ever conducted. Both parties filed a written argument. The applicant requested leave to file an affidavit after the written arguments had been filed but leave was denied. An oral hearing was held at which both parties were represented.

At the oral hearing, the opponent requested leave to amend its statement of

opposition to include reference to its trade-mark KILL=R FUDGE, application No. 743,999. Such mark and application were referred to in the opponent=s evidence. The opponent also sought leave to amend its statement of opposition to refer to Subsection 16(2)(b) of the *Trade-marks Act* in addition to Subsection 16(3)(b) and Subsection 16(2)(a) in addition to Subsection 16(3)(a). As the applicant=s agent indicated that he had no objection to the requested amendments, I granted leave. However, the outcome of these proceedings would have remained the same, with or without the amendments.

In its statement of opposition, the opponent relies on its ownership of thirteen registered trade-marks (BOMB POP; BOMB POP, JR.; BOMBE POP; BOMBE POP, JR.; BOMBSICLE; BOMBSTIK; FUDGE MISSILE; FUDGICLE; FUDGSICLE; FUDGSICLE; FUDGSICLE & Design; FUDGSICLE Design; and FUDGSICLE LIGHT) and four trade-marks said to be the subject of pending trade-mark applications (FUDGESTATICS; FUDGSICLE 1% & Design; FUDGWICH; and KILL=R FUDGE) (hereinafter all 17 marks are referred to collectively as the **Opponent=s Trade-marks**).

The first ground of opposition is that the application does not comply with Subsection 30(i) of the *Trade-marks Act* because the applicant could not have been satisfied that it was, or is, entitled to use the applied-for mark because of the prior rights owned by the opponent. The success of this ground is contingent upon a finding that the applicant=s trade-mark is confusing with one or more of the **Opponent=s Trade-marks**.

The second ground of opposition is that the applied-for trade-mark is not registrable under Subsection 12(1)(d) because it is confusing with the **opponent=s registered trade-marks**, as set out above.

The third ground of opposition is that the applicant is not the person entitled to registration under Section 16 because the applied-for trade-mark is confusing with the opponent=s registered trade-marks, all of which were used prior to the applicant=s filing date.

The fourth ground of opposition is that the applicant is not the person entitled to registration under Section 16 because the applied-for trade-mark is confusing with the opponent=s previously filed trade-mark applications.

The fifth and last ground of opposition is that the applied-for trade-mark is not distinctive of the applicant because it does not distinguish, nor is it adapted to distinguish, the applicant=s frozen confections from the wares provided in association with the Opponent=s Trade-marks.

The grounds are all based on allegations of confusion between the Opponent's Trade-marks and the applicant's trade-mark. The material dates with respect to the grounds of opposition are as follows: Subsection 30(i) B the date of filing of the application; Subsection 12(1)(d) - the date of my decision; Section 16 - the date of filing of the application; non-distinctiveness - the date of filing of the opposition [see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)].

There is a legal burden on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks in issue. This means that if a determinate conclusion cannot be reached, the issue must be decided against the applicant. [*John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293]

I will first address the likelihood of confusion between either the opponent=s BOMB POP, JR. or BOMBE POP, JR. mark and the applicant=s mark.

To the extent that the opponent is relying on its previous use of its trade-marks, subsections 16(5) and 17(1) of the *Trade-marks Act* place a burden on the opponent to establish its use of its trade-marks prior to May 16, 1994 and non-abandonment of such marks as of the date of advertisement of the present application, May 17, 1995. The evidence, as discussed below, supports a conclusion that the opponent, its predecessors-in-title, or their licensees used the trade-marks BOMB POP, JR. and BOMBE POP, JR. prior to May 16, 1994 and that such trade-marks had not been abandoned as of May 17, 1995.

Mr. Hepburn, Manager, Sales and Marketing of the Popsicle Industries Division of the opponent, attests that use of the Opponent=s Trade-marks began at least as early as the dates of first use claimed in the applications or the dates of filing of the declarations of use and that such use has been continuous since those dates. He provides packaging for some of his company=s products including the BOMB POP, JR. and BOMBE POP, JR. product. He also provides sales figures and invoices for some of the products.

Mr. Hepburn attests that sales of the components of the BOMB POP, JR./BOMBE POP, JR. products amounted to more than \$600,000 prior to 1994. Gross retail sales of the finished products for that same time period exceeded 19 million units, or \$4,500,000. In 1995, sales of such components exceeded \$140,000 while gross retail sales of the finished products exceeded four million units or \$980,000. Sample cartons provided show that BOMBE POP, JR. is used as the French version of BOMB POP, JR. and Mr. Hepburn attests at paragraph 29 that Aall of the cartons so sold would have borne the trade-marks BOMB POP, JR. and BOMBE-POP, JR.@

One of the cartons provided by Mr. Hepburn (exhibit @M@) identifies BOMB POP, JR. and BOMBE POP, JR. as registered trademarks/manufactured by Good Humor-Breyers@. Mr. Hepburn has evidenced that Good Humor-Breyers is a trading style of the opponent. The opponent acquired the BOMB POP, JR./BOMBE POP, JR. marks February 1, 1993 (according to the trade-mark registrations) and the business name registration for Good Humor-Breyers (exhibit AA-3@) indicates that the opponent first used this trading style July 29, 1994. A second sample BOMB POP, JR./BOMBE POP, JR. carton (exhibit AU@) indicates that the marks are registered trade-marks of Popsicle Industries Ltd. and that the product is mfd. in Canada under licence from Popsicle Industries Ltd. y for/pour Popsicle Industries Ltd.@ Popsicle Industries Ltd. is a predecessor-in-title to the opponent, as stated in Mr. Hepburn=s affidavit and evidenced in the opponent=s trade-mark registrations (Popsicle Industries Ltd. being listed as the registered owner from May 7, 1987 to February 1, 1993). With respect to both cartons, Mr. Hepburn says: ACartons of this sort, bearing the BOMB POP, JR. and BOMBE POP, JR. trade-marks, have been used in association with the sale of frozen confections in Canada since at least as early as 1976.@ In paragraph 6 of his affidavit, Mr. Hepburn says AWhen I use the words >of this sort= in this and other paragraphs of this affidavit, I acknowledge that the names on the packages/cartons/wraps in question changed from time to time depending upon the then current ownership and licensees.@

Mr. Hepburn states that the opponent licenses major dairies to produce frozen confections in association with its trade-marks. He goes on to say that the opponent exercises strict quality control over such products, which are produced in accordance with the opponent's specifications for product size, shape, taste, ingredients, production, packaging, handling and promotion. Furthermore, the licensees are provided with concentrates, flavourings, wraps, bags, handle sticks

and the basic flavour ingredients by the opponent.

I am satisfied that the details attested to by Mr. Hepburn would suffice to make the licensee's use of the trade-marks enure to the benefit of the trade-mark owner pursuant to Subsection 50(1) in the absence of evidence to the contrary. Mr. Hepburn has not merely parodied the wording of subsection 50(1) but has set out certain details that lead me to believe that the opponent is actually controlling the character and quality of the licensed products. With respect to the packaging introduced as exhibit AU@ to the Hepburn affidavit, the form of public notice provided is in my view sufficient to invoke the presumption in Subsection 50(2) of the *Act*.

In applying the test for confusion set forth in Subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Subsection 6(5) of the *Act*. Those factors specifically set out in Subsection 6(5) are: 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; and the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. The weight to be given to each relevant factor may vary, depending on the circumstances [see *Clorox Co. v. Sears Canada Inc.* 41 C.P.R. (3d) 483 (F.C.T.D.); *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 trade-marks, BOMB POP, JR. and BOMBE POP, JR., are inherently distinctive marks. The applicant's trade-mark FUDGE BOMB has a slightly lesser degree of inherent distinctiveness because the word Afudge@ is descriptive of the wares, as conceded by the disclaimer.

There is no evidence of advertisement of any of the marks, BOMB POP, JR., BOMBE POP, JR., or FUDGE BOMB. However, the length of time the trade-marks have been in use clearly favours the opponent.

The wares of the parties (frozen confections vs. frozen confections on a stick) are, if not identical, overlapping. The clientele of both parties likely are the same.

The opponent=s frozen confections on a stick are sold through grocery and convenience stores. The applicant=s channels of trade are not known but given the similarity between the parties= products I will assume that their channels of trade are similar if not identical.

The trade-marks in issue resemble each other visually and aurally in so far as they both contain the word BOMB. The common use of the word BOMB might suggest that the frozen confections are members of the same product line, given the lack of evidence of the common adoption in the trade of the word BOMB. Ms Miller, a trade-mark searcher, has introduced evidence of the state of the register in an effort to prove that the components of the opponent=s trade-marks are unique. Her evidence must be given reduced weight because she has not provided full registration pages for the marks that she introduces. Nevertheless her evidence does show that only one third party registration was located for frozen confections which includes the word BOMB or BOMBE standing alone: SCHWEDEN BOMBE registered by an Austrian company in 1994 for, *inter alia*, ice cream and ices. Whether or not such mark has been used in Canada is not known.

The ideas suggested by BOMB POP, JR./BOMBE POP, JR. and FUDGE BOMB share the concept of something that might explode, presumably flavour-

wise.

As a surrounding circumstance, the opponent says that it relies on its ΔFUDGE and BOMB@ family of marks. In order to rely on a family, the opponent must prove use of each mark in its family [*McDonald=s Corp. v. Alberto-Culver Co.* (1995), 61 C.P.R. (3d) 382 (TMOB)]. Here, the opponent has evidenced use of the majority of its FUDGE marks but only of two of its BOMB marks. I do not see how it can claim to have a family of ΔFUDGE and BOMB@ marks. At most, it could attempt to claim a family of FUDGE marks and a family of BOMB marks. However, two BOMB marks do not a family make. Nor do I find there to be a family of FUDGE marks. In order to find a family, one must consider whether there is evidence of third parties using the family's common characteristic in the same field. Here we have the opponent=s own evidence, in the form of Ms Miller=s affidavit, that there are at least six third party registrations for trade-marks for frozen confections or similar goods which incorporate the word FUDG/FUDGE. This is not surprising given the descriptive nature of the word FUDGE.

I find that the applicant has not met the onus on it to show that there is no reasonable likelihood of confusion between its mark and either of the opponent=s marks BOMB POP, JR. or BOMBE POP, JR. as of any of the material dates. In applying the test for confusion, I have born in mind that it is a matter of first impression and imperfect recollection.

The grounds of opposition based on the prior use and registration of BOMB POP, JR. and BOMBE POP, JR. therefore succeed. In addition, the ground of non-distinctiveness succeeds, at least with respect to the claim that the applicant=s mark does not distinguish nor is adapted to distinguish the wares of the applicant from either the opponent=s BOMB POP, JR. or BOMBE POP, JR. wares. In the circumstances, I see no need to consider the remaining grounds of

opposition.

Having been delegated by the Registrar of Trade-marks by virtue of Subsection 63(3) of the *Trade-marks Act*, I refuse the application in view of the provisions of Subsection 38(8) of the *Act*.

DATED AT TORONTO, ONTARIO, THIS 4th DAY OF MARCH, 1999.

**Jill W. Bradbury
Hearing Officer
Trade-marks Opposition Board**