

**IN THE MATTER OF AN OPPOSITION
by Jelly Belly Candy Company to
application No. 1,094,320 for the trade-
mark THE JELLY BEAN FACTORY &
Design filed by Aran Candy Ltd.**

On February 27, 2001, Aran Candy Ltd. (the “Applicant”) filed an application to register the trade-mark THE JELLY BEAN FACTORY & Design (the “Mark”), which is shown below:



The application is based upon

1. use of the Mark in Canada in association with candy; non-medicated confectionery, namely jelly beans since at least as early as May 1999, and
2. proposed use of the Mark in Canada in association with chewing gum, chocolate, cakes and biscuits, ice-cream and frozen confections.

The right to the exclusive use of the words JELLY BEAN has been disclaimed apart from the trade-mark as a whole.

The application was advertised for opposition purposes in the Trade-marks Journal of March 5, 2003.

On August 1, 2003, Jelly Belly Candy Company (the “Opponent”) filed a statement of opposition against the application. The Applicant filed and served a counter statement.

Pursuant to rule 41 of the *Trade-marks Regulations (1996)*, the Opponent filed the affidavits of

Peter D. Healy and Kelly McCarthy.

Pursuant to rule 42, the Applicant filed the affidavits of Angus MacDowell, Peter Cullen and Elenita Anastacio.

Pursuant to rule 43, the Opponent filed the affidavits of David Snyder and Leonard Dempsey.

Both parties filed a written argument, and both parties participated in an oral hearing.

Grounds of Opposition

There are eight grounds of opposition, which I summarize below:

1. The application does not conform to the requirements of s. 30(i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”) because the Applicant could not have been satisfied that it was entitled to use the alleged trade-mark in Canada in association with the Applicant’s wares in view of the prior use and registration of the family of trade-marks of the Opponent, as set out in Schedule A.
2. The application does not conform to the requirements of s. 30(b) of the Act because the Applicant has not used the alleged trade-mark in Canada since at least as early as 1999 in association with each of the general classes of wares described in the application, that is candy and non-medicated confectionery, namely, jelly beans.
3. The alleged trade-mark is not registrable pursuant to s. 12(1)(d) of the Act because the Mark is confusing with the family of registered trade-marks of the Opponent, as set out in Schedule B.
4. The Applicant is not the person entitled to registration of the alleged trade-mark pursuant to s. 16(1)(a) of the Act because, at the date upon which the Applicant has claimed to have so first used its alleged mark, the Mark was confusing with the family of trade-marks that have been previously used in Canada or made known in Canada by the Opponent, as set out in Schedule C.
5. The Applicant is not the person entitled to registration of the alleged trade-mark pursuant to s. 16(1)(c) of the Act because, at the date upon which the Applicant claimed that it first so used its Mark, the Mark was confusing with a trade-name that had been previously used in Canada by the Opponent, namely, JELLY BELLY CANDY COMPANY.
6. The Applicant is not the person entitled to registration of the alleged trade-mark pursuant to s. 16(3)(a) of the Act because, at the date of filing of the application, the Mark was confusing with the family of trade-marks that had been previously used in Canada or made known in Canada by the Opponent, as set out in Schedule C.

7. The Applicant is not the person entitled to registration of the alleged trade-mark pursuant to s. 16(3)(c) of the Act because, at the date of filing of the application, the Mark was confusing with the trade-name that had been previously used in Canada by the Opponent, namely, JELLY BELLY CANDY COMPANY.
8. The alleged trade-mark is not distinctive because the Mark does not actually distinguish the wares in association with which it has been claimed to have been used by the owner and proposed to be used by the owner from the wares of others nor has it been adapted so as to distinguish them from, and more particularly, the wares of the Opponent, as set out in Schedule A.

Schedule A sets out particulars of the following marks:

1. application no. 1,148,237 for BEANANZA
2. application No. 1,170,284 for BIGBEAN
3. registration No. TMA339,749 for GOELITZ GUMMI & Design
4. registration No. TMA414,564 for J.B. COOL & Design
5. application No. 1,177,728 for JBZ & Design (yellow)
6. application No. 1,173,003 for JBZ & Design
7. registration No. TMA275,084 for JELLY BELLY
8. registration No. TMA190,918 for JELLY BELLY
9. registration No. TMA303,615 for JELLY BELLY
10. application No. 1,178,181 for JELLY BELLY & Design (#1)
11. registration No. TMA284,214 for JELLY BELLY & Design (#2)
12. registration No. TMA288,526 for JELLY BELLY & Design (#2)
13. registration No. TMA303,614 for JELLY BELLY & Design (#3)
14. registration No. TMA557,602 for JELLY BELLY & Design (#3)
15. registration TMA559,504 for JELLY BELLY & Mascot Design
16. registration No. TMA559,660 for JELLY BELLY & Design (#3 - yellow and red)
17. application No. 1,178,180 for JELLY BELLY & Front Face of Candy Bags Design
18. registration No. TMA346,513 for PET TARANTULA
19. registration No. TMA346,928 for PET TARANTULA & Design
20. application No. 1,111,335 for SHOW YOUR FLAVOUR!
21. application No. 1,145,876 for THE ORIGINAL GOURMET JELLY BEAN
22. application No. 1,094,929 for WHAT'S YOUR FAVOURITE FLAVOUR?
23. application No. 1,094,930 for WHAT'S YOUR FLAVOUR?

Schedule B comprises the thirteen registered marks from Schedule A, namely numbers 3, 4, 7, 8, 9, 11-16, 18 and 19 set out above.

Schedule C comprises a different set of thirteen marks, namely the following numbers from Schedule A: 3, 7, 8, 9, 11-16, 18, 19 and 21.

Some of the Opponent's applications/registrations include colour claims. Some of its applications/registrations are for candy, while others are for non-edible items. Those that cover candy typically disclaim the right to the exclusive use of the words JELLY or JELLY BEANS. Registration No. TMA284,214 for JELLY BELLY & Design (#2) also disclaims the right to the exclusive use of the representation of the jelly bean. I note that registration No. TMA339,749 was expunged on December 11, 2003 and that applications Nos. 1,178,180 and 1,178,181 were filed on May 15, 2003 based on proposed use.

The Opponent's various design marks are shown below:

J.B. COOL & Design:



JBZ & Design:



JELLY BELLY & Design (#1):



JELLY BELLY & Design (#2):



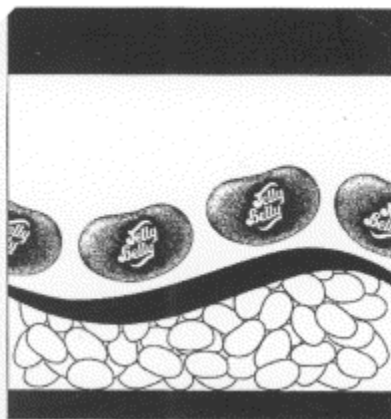
JELLY BELLY & Design (#3):



JELLY BELLY & Mascot Design:



JELLY BELLY & Front Face of Candy Bags Design:



PET TARANTULA & Design:



Material Dates and Onuses

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of 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 material dates with respect to the grounds of opposition are as follows:

- s. 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469, at p. 475];
- s.12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 16(1) - the date of the Applicant's first use;
- s. 16(3) - 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.)].

The Opponent can meet its initial burden under s. 30(b) by reference not only to its evidence but also to the Applicant's evidence [see *Labatt Brewing Company Limited v. Molson Breweries, a*

Partnership (1996), 68 C.P.R. (3d) (F.C.T.D.) 216 at 230]. However, the Opponent's burden can only be satisfied by the Applicant's evidence if such evidence is clearly inconsistent with the Applicant's claims as set forth in its application.

The Opponent's evidential burden with respect to its s. 12(1)(d) ground of opposition is met if its registration(s) are in good standing as of the date of my decision.

Regarding the s. 16 grounds, the Opponent must show that its trade-mark(s) or trade-name had been used or made known in Canada prior to the material date and that it had not abandoned such use or making known as of the advertisement of the Applicant's application [see s. 16].

In order to meet its initial burden with respect to the distinctiveness ground of opposition, the Opponent need only show that, as of the filing of the opposition, its trade-mark(s) had become known sufficiently to negate the distinctiveness of the applied-for mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.)].

Family of Trade-marks

A family of marks may exist when trade-marks that have a common component or characteristic are all in the name of one owner. Moreover, the registration of such marks may be tantamount to a single registration combined of those several marks. However, in order to assert a family, an opponent must prove use of each member of the family. [See *Techniquip Ltd. v. C.O.A.* (1998), 80 C.P.R. (3d) 25 (F.C.T.D.) at 232, affirmed 3 C.P.R. (4th) 298 (F.C.A.); *MacDonald's Corporation v. Yogi Yogurt Ltd.* (1982), 66 C.P.R. (2d) 101; *Fox on Canadian Law of Trade-marks and Unfair Competition.*]

In the present case, it is not clear from the pleadings what the common component or characteristic of the Opponent's alleged family is meant to be. In any event, as shown in my discussion of the evidence below, the Opponent has not shown use of each member of its alleged family or even of a sufficient number to qualify as a family. I therefore reject the Opponent's allegation that it owns a family of marks.

Relevancy of Pleaded Marks

A number of the marks relied upon by the Opponent do not resemble the Applicant's Mark in any significant way, in particular the following marks: GOELITZ GUMMI & Design; J.B. COOL & Design; JBZ & Design; PET TARANTULA; PET TARANTULA & Design; SHOW YOUR FLAVOUR!; WHAT'S YOUR FAVOURITE FLAVOUR?; and WHAT'S YOUR FLAVOUR?. Since the resemblance between the marks is the most significant factor in determining the issue of confusion [*Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.) at 149, affirmed 60 C.P.R. (2d) 70], I dismiss the grounds of opposition to the extent that they rely on the foregoing eight marks.

Affidavit of Peter Healy

Mr. Healy, the Opponent's Vice-President of Marketing and International Sales, provides information about the Opponent's activities in Canada. I shall set out those portions of this information that I find to be relevant to the issues at hand. However, as a preliminary matter, I must point out that Mr. Healy has elected to use the term "JELLY BELLY Marks" to refer collectively to the following marks of the Opponent: JELLY BELLY; JELLY BELLY & Design; JELLY BELLY & Front Face of Candy Bags Design, J.B. COOL & Design; THE ORIGINAL GOURMET JELLY BEAN; BIG BEAN; and JBZ & Design. I also note that I am disregarding paragraphs 26-31 of Mr. Healy's affidavit, because those paragraphs either contain unsubstantiated statements or express opinions on the very issues that are to be decided by the Registrar in these proceedings.

Mr. Healy attests that the Opponent has distributed and sold the following products in Canada marked with the JELLY BELLY Marks:

- candy, namely, jelly beans, candy and gel candy (collectively the "JELLY BELLY Jelly Beans")
- container in the shape of a jelly bean that will be used for packaging candy; toys, namely, hand thrown flying discs; clothing items for men, women and children; jewellery, namely, pins; seat shirts, golf hats, fanny packs, inflatable toy dolls, aprons, sports caps, baseball caps, mugs, disposable cameras, sports bottles, collapsible umbrellas, tote bags, wall clocks, wrist watches, water-proof sports watches, balloons, polo shirts, pencils,

magnets, key rings, lapel pins, removable tattoo stickers, candy dispensers and post cards (collectively the “JELLY BELLY Products”).

The Opponent distributes its JELLY BELLY Jelly Beans and JELLY BELLY Products in Canada through supermarkets such as Sobey’s, IGA and Foodtown; wholesale outlets such as Costco; in video stores such as Blockbuster; in retail stores such as Wal-Mart and Zellers; in drugstore chains such as Shopper’s Drug Mart; card stores such as Carlton Cards and confectionery stores. Mr. Healy provides “a provincial breakdown of the number of locations selling the Opponent’s JELLY BELLY Products.”

Mr. Healy states that the Opponent “has distributed and sold JELLY BELLY Jelly Beans in Canada since August 1977” and that between August 1977 and March 1992, sales by the Opponent of the JELLY BELLY Jelly Beans in Canada were \$2.84 million U.S. He provides an annual breakdown of Canadian sales of JELLY BELLY Jelly Beans in association with the JELLY BELLY Marks for the years 1993 through 2004 and indicates that total sales have exceeded \$19 million U.S. since introduction into Canada.

Mr. Healy also provides some annual Canadian sales figures relating to sales of JELLY BELLY Jelly Beans in association with the trade-mark THE ORIGINAL GOURMET JELLY BEAN.

Mr. Healy states that the Opponent has had a website since 1997 that is accessible to all Canadians with Internet access. He provides printouts of various pages from the website, dated July 2004. These show that the Opponent’s jelly beans are available in various packaging formats. It also appears that one can buy the Opponent’s wares through the website, but no evidence has been provided of any Canadian doing so.

Mr. Healy has provided some materials to show the resemblance between the parties’ flavours and mascots. While the flavours might be considered to be tangentially relevant with respect to the nature of the parties’ wares, their mascots are not relevant to the issues in the present proceedings.

As Exhibit G, Mr. Healy has provided “a sample of the packaging showing some of the various JELLY BELLY Marks as they pertain to JELLY BELLY Jelly Beans”, which he says “shows the manner in which the JELLY BELLY Marks are and have been used in association with the JELLY BELLY Jelly Beans since their introduction into the Canadian marketplace.” Exhibit G is a box that displays the following marks of the Opponent: JELLY BELLY; JELLY BELLY & Design (#1); and THE ORIGINAL GOURMET JELLY BEAN.

Although Mr. Healy states that the JELLY BELLY Marks have enjoyed extensive exposure for more than ten years in various promotional materials, print media and store displays, he has not backed this claim up with evidence. Exhibit H is “a menu and recipe booklet in which some of the JELLY BELLY Marks are displayed in association with jelly beans”, but there is no evidence as to how, when, or to what extent this item may have been distributed in Canada.

Overall, Mr. Healy’s evidence is lacking in specificity. In particular, his use of the collective term “JELLY BELLY Marks” makes it impossible to know which of the Opponent’s marks the Canadian sales relate to. If, for example, some of the sales relate to wares sold only in association with the trade-mark JBZ & Design (one of the JELLY BELLY Marks), then these sales would not be particularly relevant to the issue of the likelihood of confusion given the considerable differences between the Applicant’s Mark and JBZ & Design.

The certified copies of registrations that Mr. Healy has provided satisfy the Opponent’s initial burden under s. 12(1)(d).

Although I may treat the certified copies as evidence of *de minimus* use of the subject marks, that is insufficient to meet the Opponent’s evidential burden under the entitlement or distinctiveness grounds of opposition. [See *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.).] Nevertheless, based on Exhibit G, I find that Mr. Healy’s evidence meets the Opponent’s initial burden under its distinctiveness and s. 16(1)(a) and 16(3)(a) grounds of opposition, but only to the extent that those grounds are based on the trade-marks JELLY BELLY, JELLY BELLY & Design (#1) or THE ORIGINAL GOURMET JELLY BEAN.

I note that Mr. Healy has not provided any evidence that shows use of the Opponent's trade-name in Canada as of the material dates relevant to the s. 16(1)(c) and 16(3)(c) grounds. The trade-name does appear on the back of the box provided as Exhibit G, but Mr. Healy has not attested that such packaging shows the manner in which the trade-name has been used in Canada since before the material date. As there is no other evidence in the record concerning use of the Opponent's trade-name, grounds 5 and 7 are dismissed on the basis that the Opponent has not meet its initial burden.

Affidavit of Kelly McCarthy

Ms. McCarthy is an employee of the Opponent's law firm. On August 16, 2004, she telephoned the Applicant's East Coast distributor, Exclusive Consumer Brands. She enquired as to where she could purchase THE JELLY BEAN FACTORY candy and jelly beans in Toronto and asked about the length of time that THE JELLY BEAN FACTORY candy and jelly beans had been available for sale in Canada. She was told that she could purchase these wares in any Toys 'R' Us or Sugar Mountain Confectionery stores in the greater Toronto area and that Exclusive Consumer Brands had only been selling these wares for "about four-to-five months". Ms. McCarthy then telephoned six locations of the aforementioned stores and was told that they did not offer for sale candy and jelly beans marked with the trade-mark THE JELLY BEAN FACTORY, nor had they ever heard of such candy or jelly beans. On this basis, Ms. McCarthy made the broad conclusion that "the Applicant has never sold THE JELLY BEAN FACTORY candy and jelly beans; not now, and not since May, 1999."

If I ignore the hearsay aspects of Ms. Kelly's evidence and the fact that the mark at issue here is THE JELLY BEAN FACTORY & Design, not the word mark THE JELLY BEAN FACTORY, Ms. McCarthy's evidence may be interpreted as raising some doubt about the Applicant's claim of use. However, as will be discussed below, the Applicant's evidence has adequately addressed any such doubts.

Affidavit of Peter Cullen

Mr. Cullen is the Applicant's Joint Managing Director. He states that the Applicant has sold jelly beans in Canada under its Mark through its distributor Scott Bathgate Ltd. since May 1999. The

Applicant has also had a distributor in the Toronto area. From October 2000, for approximately two years, the Toronto distributor was D.S. Sainthill and Co. Ltd. The Applicant was then represented in the Toronto area by Exclusive Consumer Brands, Inc., who took only a single shipment of product on or about June 30, 2004. Mr. Cullen states, “it is not clear that [Exclusive Consumer Brands] will be continuing as a distributor for the Applicant in the Toronto area.”

Mr. Cullen has provided the annual sales revenues from the sale of the Applicant’s jelly beans in Canada from May 1999 to 2004.

Mr. Cullen has also provided information concerning the Applicant’s activities in foreign countries and its worldwide advertising expenses. He indicates that no instances of confusion have been reported to him, but does not explain whether there is any reporting mechanism in place. His paragraphs 15 and 16 are disregarded on the basis that they simply consist of bald opinions on the issues to be decided by the Registrar in these proceedings.

Affidavit of Angus MacDowell

Mr. MacDowell is the Vice-President of Scott-Bathgate Ltd. (“SBL”), the Applicant’s Canadian distributor. SBL sells food and confectionery products to retailers throughout Western Canada.

Mr. MacDowell explains how SBL became the Applicant’s distributor and sets out that he first received samples of the Applicant’s jelly beans in approximately early 1999. He ordered two full pallets of the Applicant’s jelly beans in approximately April 1999. Attached as Exhibit A is a copy of an invoice from the Applicant to SBL regarding jelly beans dated May 6, 1999. Mr. MacDowell attests that samples of this first order of the Applicant’s jelly beans were distributed to SBL’s sales agents and offered for sale to its B.C. customers in June 1999. He attaches, as Exhibit B, pages from SBL’s 2005 catalogue advertising the Applicant’s jelly beans. Exhibit B shows the Applicant’s Mark displayed on packaging containing jelly beans. Mr. MacDowell goes on to state that SBL’s catalogues would have contained similar pages for the Applicant’s jelly beans every year back to 1999.

Mr. MacDowell attests that he has recovered records of sales of the Applicant's jelly beans to Canadian customers for each of the years 1999, 2001, 2002, 2003, 2004 and 2005. As Exhibit C, he provides a computer printout for sales from January 1, 2001 to March 4, 2005. He was unable to locate any computer records prior to January 1, 2001 but he has provided as Exhibit D a sales report for 1999, which shows sales of the Applicant's jelly beans by SBL in each of the months June through December 1999.

Mr. MacDowell states that SBL's sales agents sell to all sorts of retail outlets from mom and pop convenience stores to large grocery chains. Exhibit C shows sales to, among other places, gas bars, candy stores, pharmacies and supermarkets.

Mr. MacDowell states that the Applicant's line of jelly beans has been a competitor to the Opponent's jelly beans since sales commenced but that no instances of confusion have been reported to him.

Affidavit of Elenita Anastacio

Ms. Anastacio is a trade-mark searcher employed by the Applicant's trade-mark agents. She provides the results of various searches that she conducted of foreign trade-mark registers. It appears that her aim was to show that the parties' marks co-exist on other registers.

Affidavit of David Snyder

Mr. Snyder is the Midwest Regional Business Manager of the Opponent in the U.S. He states that his affidavit is in response to Mr. Cullen's statement that no instances of confusion have been brought to his attention.

Mr. Snyder attests to what he considers to have been an instance of confusion in the United States between jelly beans sold by the Applicant under the trade-mark THE JELLY BEAN PLANET & Design and the Opponent's JELLY BELLY jelly beans.

Although THE JELLY BEAN PLANET & Design mark resembles the Mark in issue in these proceedings, the Applicant correctly points out that the incident in the United States did not

involve the Mark that is the subject of the present proceedings.

Affidavit of Leonard Dempsey

Mr. Dempsey owns a business in the United Kingdom that has a contract to sell JELLY BELLY products in parts of the U.K. He attests to two incidents that he considers to have been instances of confusion between THE JELLY BEAN FACTORY & Design jelly beans and JELLY BELLY jelly beans between 2002 and 2004.

Likelihood of Confusion

Of the outstanding grounds of opposition, all but one turn on the issue of the likelihood of confusion between the Applicant's Mark and various marks of the Opponent. As set out earlier, the different grounds have different material dates but, in the circumstances of this case, nothing turns on whether the issue of confusion is determined at a particular date.

the test for confusion

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. 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 or trade-names 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 or trade-names in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight.

The Supreme Court of Canada has discussed the appropriate process for assessing all the surrounding circumstances to be considered in determining whether two trade-marks are confusing in the decisions in *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321, [2006] 1 S.C.R. 772, and *Veuve Clicquot Ponsardin v. Boutiques Clicquot Ltée et al* (2006), 49

C.P.R. (4th) 401, [2006] 1 S.C.R. 824. It is with these general principles in mind that I shall now assess all of the surrounding circumstances, focussing on the Opponent's JELLY BELLY & Design (#1) mark as applied to jelly beans, as I consider that mark to present the Opponent's best case.

s. 6(5)(a) - inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

The Opponent's JELLY BELLY & Design (#1) mark has some inherent distinctiveness, arising primarily from the use of the word BELLY. The Applicant's Mark also has some inherent distinctiveness but overall I find that the Opponent's mark has a higher degree of inherent distinctiveness.

Both marks have acquired some distinctiveness in Canada through use. However, for the reasons discussed above concerning the provision of lump sum sales figures for a number of different marks owned by the Opponent, I cannot assess the extent to which the JELLY BELLY & Design (#1) mark has acquired a reputation in Canada at any particular point of time.

s. 6(5)(b) - the length of time each trade-mark has been in use

I accept that the Opponent began using its mark in Canada prior to the Applicant's first use.

s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

Both parties use their marks in association with jelly beans and both sell their wares through various forms of retailers.

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

"Realistically appraised it is the degree of resemblance between trade marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a subservient role in the over-all surrounding circumstances." [*Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.) at 149, affirmed 60 C.P.R. (2d) 70]

In its written argument, the Opponent made the following submissions concerning the degree of resemblance between the parties' marks:

8.45 In the context of the case at hand, both the applicant's trade mark and many of the opponent's trade marks contain the component "JELLY". Both the applicant's trade mark and several of the opponent's marks contain the component "BEAN".

8.46 Accordingly, from the vantage point of the average purchaser having an imperfect recollection of the trade marks, these circumstances increase the degree of resemblance between the respective marks.

While it is true that the common use of the words that are the name of the wares increases the resemblance between the marks, the fact that these shared words are the name of the wares necessarily supports a conclusion that consumers will use other features of the marks in order to distinguish between them. The Opponent's evidence would have to be overwhelmingly strong in order to support a conclusion that it could monopolize either the word JELLY or BEAN in association with jelly beans.

The Applicant's Mark suggests a location or place of business whereas the Opponent's mark suggests a soft stomach. The Applicant's Mark is four words when spoken, the Opponent's mark two. The scripts employed for the word portions are not the same and the Applicant's design comprises a large oval whereas the Opponent's design comprises the shape of a jelly bean.

Overall, I find that when considering the two marks as a whole, the degree of resemblance between them is not great in appearance, sound or idea suggested.

further surrounding circumstances

I agree with the Opponent that the Applicant's evidence of the parties' marks co-existing on foreign registers is not pertinent [see *Vivat Holdings Ltd. v. Levi Strauss & Co.* (2005), 41 C.P.R. (4th) 8 (F.C.T.D.)]. Moreover, the statements of the Applicant's affiants to the effect that they are not aware of any instances of confusion cannot be accorded any significant weight. That

leaves the question of the weight to be accorded to the alleged instances of confusion abroad, as presented in the Opponent's reply evidence.

Mr. Snyder's evidence is that an instance of confusion in Texas came to his attention in the week of March 28, 2005. At that time, he visited a confection store where he informed the manager that some of the packages of JELLY BELLY jelly beans being offered for sale were past their "best before" date. Apparently the manager then asked Mr. Snyder about the jelly beans being offered for sale in bulk, whereupon Mr. Snyder informed her that those jelly beans were not JELLY BELLY jelly beans since they did not display the Opponent's mark. The manager then pulled out a case of the Applicant's jelly beans bearing the mark THE JELLY BEAN PLANET & Design and asked "this is not yours?"

Mr. Dempsey attests to two instances of confusion that he says occurred between 2002 and 2004 in the United Kingdom. First, he says that a customer informed him that it could get the JELLY BELLY products from another distributor more cheaply than he was offering. He informed her that the other distributor's product were THE JELLY BEAN FACTORY & Design products, not JELLY BELLY product. Second, a customer was displaying THE JELLY BEAN FACTORY & Design jelly beans on a JELLY BELLY display unit. When asked to remove the "offending product", the client told Mr. Dempsey that she had not been aware that they were a different product.

I am not inclined to give any of the above instances of alleged confusion much weight for a number of reasons. As pointed out by the Applicant, the mark involved in Texas is not the mark that is the subject of these proceedings. Also, as pointed out by the Opponent in its argument, there are a number of similarities in the Applicant's packaging, apart from the Mark, that the Opponent is concerned about, *e.g.* colour schemes, mascots and flavour names. It may very well be that these sorts of "passing off" factors might have played an important role in the instances relayed, but they are not relevant in the present proceedings. Moreover, there is no evidence that gourmet jelly beans are common in the industry and therefore it may be that these individuals thought that all gourmet jelly beans were the same. There may also be differences in the state of the marketplaces between Canada and Texas or the United Kingdom that would preclude any

such instances from occurring here. Last but not least, the evidence being presented is not the evidence of the individuals who allegedly were confused, making it impossible to conduct meaningful cross-examinations.

conclusion re likelihood of confusion

Having considered all of the surrounding circumstances, I find that, on a balance of probabilities, confusion between the marks is unlikely. As my conclusion is independent of the date upon which I assess the likelihood of confusion, this means that the following grounds cannot succeed: 1, 3, 4, 6 and 8.

Section 30(i) Ground

Although I have already held that this, the first ground of opposition, cannot succeed, I will add that where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant. [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]

Section 30(b) Ground

As I understand it, the Opponent's position with respect to its second ground of opposition is both that the Applicant has not used its Mark since the date claimed and that it has not used it in association with each of the two general classes claimed, namely candy and non-medicated confectionery. Although the Opponent made lengthy written submissions with respect to this ground, its agent declined to clarify its submissions further at the oral hearing. The Applicant's agent advised at the oral hearing that the Applicant's only concern with respect to this ground is that "jelly beans" remain in the application.

In its written argument, the Opponent has submitted that it has met its initial burden with respect to s. 30(b) through the Applicant's own evidence. However, it can only claim to have done so if the Applicant's evidence is clearly inconsistent with the claims made in its application. I find that this is not the case. Although the Opponent argues that the Applicant should have filed better evidence in order to show use under s. 4 of the Act, there was no onus on the Applicant to do so.

Moreover, the Opponent had the opportunity to conduct a cross-examination of the Applicant's affiants if it wished to try to demonstrate that the Applicant's allegations were not in fact true.

The Opponent also seems to be arguing that the Applicant's evidence only relates to "jelly beans" and that their sale can only support the claim re non-medicated confectionery, not candy, because candy and non-medicated confectionery are two different general classes. However, given that the *Oxford Canadian Dictionary* defines "confectionery" as "candy and other sweets", it is not clear to me that this application covers more than one general class under its use claim.

In the circumstances, I dismiss the s. 30(b) ground.

In the event that I am wrong concerning the classification issue, then the application would still be maintained for the wares "non-medicated confectionery, namely jelly beans".

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8).

DATED AT TORONTO, ONTARIO, THIS 21st DAY OF JUNE 2007.

Jill W. Bradbury
Member
Trade-marks Opposition Board