



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

Citation: 2014 TMOB 169
Date of Decision: 19/08/2014

TRANSLATION

**IN THE MATTER OF AN OPPOSITION by
Yogen Früz Canada Inc. against application No.
1,456,426 for the trade-mark FLAVÜR in the name
of Industries Lassonde Inc.**

Introduction

[1] On October 22, 2009, Industries Lassonde Inc. (the Applicant) filed registration application No. 1,456,426 for the FLAVÜR trade-mark (the Mark). This application was based on a planned use and covered the following wares:

Fruit juices, vegetable juices, non-alcoholic fruit and vegetable beverages (the Wares).

[2] This registration application was published on April 14, 2010 in the *Trade-Marks Journal* for the purposes of opposition.

[3] On June 14, 2010, Yogen Früz Canada Inc. (the Opponent) filed its statement of opposition. The grounds of opposition raised are based on sections 30(a),(e),(i), 12(1)(d),16(3)(a),(b) and 2 of the *Trade-marks Act*, RSC (1985), c T-13 (the Act). They are

described in greater detail in Appendix A of this decision. The Applicant filed a counter-statement denying each and every ground of opposition.

[4] The evidence on file presented at the hearing comprised:

- an affidavit by Aaron Serruya dated February 11, 2011 (Serruya 1) filed as the Opponent's evidence;
- cross-examination of Mr. Serruya on his affidavit Serruya 1;
- an affidavit by Priscilla Bernier and certified copies of registrations and registration applications including the letter Ü as the Applicant's evidence;
- cross-examination of Ms. Bernier;
- a second affidavit by Aaron Serruya dated May 3, 2012 (Serruya 2) filed by the Opponent as additional evidence, with the registrar's permission.

[5] I must stress that the Opponent also requested permission to file an affidavit by Reneta Sarur, but this permission was refused in the registrar's decision dated June 5, 2012.

[6] Each of the parties filed a written argument and were represented at a hearing.

[7] On June 23, 2014, i.e. 3 weeks before the hearing, the Applicant requested permission to file as additional evidence other certified copies of registration certificates and registration applications concerning trade-marks including the letter Ü.

[8] I must first determine whether I should allow the filing of these additional documents. Subsequently, I will determine whether the Opponent has filed sufficient evidence to meet its initial evidential burden concerning each of the grounds of opposition it raised. If such is the case, I will analyze these grounds of opposition to ultimately determine whether the Applicant is entitled to registration of the Mark.

[9] For the reasons described below in greater detail, I find that the Opponent has not met its initial evidential burden in regard to the grounds of opposition based on sections 30(a), (e) and (i). I conclude that the Mark is registrable and distinctive, and that the Applicant is entitled to register the Mark.

Application for permission to file additional evidence

[10] On June 23, 2014, the Applicant requested permission to file certificates of authenticity for the following marks:

U-SWIRL	TMA851,561
Ü and Drawing	TMA839,600
KÜHNE and Drawing	TMA372,308
GPI Pür TASTE	TMA853,339
ÜBER	TMA852,805
FÜDI	TMA877,856
PÜRBLOOM	TMA864,915
STATION BLÜ	TMA806,579
FRÜH and Drawing 1	1,606,738
HAGESÜD	1,567,353
DAS BRAÜ and Drawing	1,624,104
KÜLT LA CULTURE DU BIEN-ÊTRE and Drawing	1,598,113
NU BÜGEL	1,567,946
Efengübier	1,557,819
YÜM	1,585,826
GÜ and Drawing	1,532,723

[11] The Applicant admits the lateness of this application, but argues that some of these registrations correspond to registration applications that have already been entered into evidence by the Applicant. In regard to other registration applications, the Applicant claims that it was unable to file them earlier, since they had been published, with one exception, after the filing of its evidence, i.e. after August 10, 2011. Accordingly, it was simply trying to complete its evidence on the status of the register. It stressed that the Opponent would not suffer harm, since such evidence does not give rise to a cross-examination, since it is an issue of filing copies certified by the registrar.

[12] The Opponent objected to the filing of these documents, claiming that the Applicant had had the opportunity of reviewing its entire file before filing its written argument, i.e. in March 2013. The application was extremely late and this evidence had been available for quite some time. The Applicant had provided no explanations to justify this delay. Lastly, it claims that allowing this additional evidence would deprive it of the opportunity to file rebuttal evidence concerning use or absence of use of these marks on the market.

[13] In fact, I note that 5 of the registrations correspond to registration applications already disclosed by the Applicant in its evidence. These are the registration certificates for the following marks:

Ü and Drawing	TMA839,600
FÜDI	TMA877,856
PÜRBLOOM	TMA864,915
U-SWIRL	TMA851,561
STATION BLÜ	TMA806,579

[14] I therefore allow filing of these registration certificates since the existence of these marks had already been disclosed by the Applicant at the time of filing its evidence.

[15] The publication dates of the registration applications which gave rise to registration of the GPI Pür TASTE (February 13, 2013) and ÜBER (January 2, 2013) marks, as well as the filing date of the registration application for the NÜ BAGEL mark (January 30, 2013) were after filing of the Applicant's written argument (March 25, 2013). The Applicant has not explained why it did not raise the existence of these registration applications at the time of filing its written argument. I therefore refuse the filing of certificates of authenticity concerning these three citations. For the same reasons, I refuse the filing of a certificate of authenticity for registration of the KÜHNE and Drawing mark registered in August 1990.

[16] The other registration applications, including the one that gave rise to registration of the FRÜH and Drawing mark were all filed after the Applicant's written argument, most of them being in 2014. I am aware of the lateness of the application, but the citations were beyond the

Applicant's knowledge at the time of filing its evidence and its written argument. Regarding the Opponent's argument that it would be harmed, since it would not have had the opportunity of presenting rebuttal evidence, I must point out that it did not feel it necessary to do so after filing of the Applicant's evidence regarding the status of the register in August 2011. It did, nonetheless, present on May 1, 2012 an application to file as additional evidence the affidavit by Ms. Sarur which was in some way rebuttal evidence on the status of the register, but was refused permission on June 5, 2012, since it had given no reason that could justify the delay in filing this evidence.

[17] In summary, I am allowing the filing of certificates of authenticity for following marks:

U-SWIRL	TMA851,561
Ü and Drawing	TMA839,600
FÜDI	TMA877,856
PÜRBLOOM	TMA864,915
STATION BLÜ	TMA806,579
FRÜH and Drawing	1,606,738
HAGESÜD	1,567,353
DAS BRAÜ and Drawing	1,624,104
KÜLT LA CULTURE DU BIEN-ÊTRE	1,598,113
Efengübier	1,557,819
YÜM	1,585,826
GÜ and Drawing	1,532,723

Evidential burden

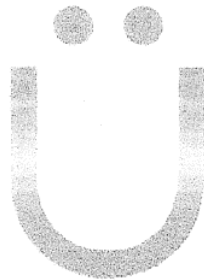
[18] Under the procedure in the matter of an opposition against the registration of a trade-mark, the Opponent must present sufficient elements of evidence concerning the grounds of opposition that it raises for it to be apparent that facts exist that can support these grounds of opposition. Should the Opponent meet this requirement, the Applicant would then have to persuade the Registrar, according to the balance of evidence, that the trade-mark is registrable

[see *Joseph Seagram & Sons Ltd v. Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB) and *John Labatt Ltd v. Molson Companies Limited* (1990), 30 CPR (3d) 293 (FC 1st inst)].

Preliminary comments

[19] As I will explain later in greater detail, the parties had a business relationship which regrettably terminated on an acrimonious note, hence the particularly litigious tangent taken by this file. Accordingly, several points of law were raised in the proceedings which appear to me more or less relevant in regard to the actual questions that must be answered in the following paragraphs. I will therefore restrict myself to the issues of law which must be discussed in order to rule on this opposition.

[20] The Opponent's premise is that its Ü and/or smiling Ü Drawing mark as illustrated below:



is the equivalent, in the field of frozen yogurts to Nike's 'Swoosh' in the field of sports items. Accordingly, its Ü and/or smiling Ü Drawing mark would be well known. However, the evidence must support such a claim.

[21] The Opponent sustains, with supporting evidence, that the Applicant knew about the use of the letter Ü either alone or as an letter in the word forming a component of one of the Opponent's trade-marks. Accordingly, the Applicant would have been acting in bad faith by filing the registration application for the Mark for the Wares. Since it would have been acting in bad faith, the ground under section 30(i) of the Act should therefore be maintained.

[22] Section 30(i) of the Act requires a statement by the Applicant that it was convinced at the time of filing the registration application that it had the right to use the Mark in Canada in association with the Wares. It is therefore an issue of determining whether the Applicant could have made such a statement at the time of filing its registration application.

[23] I will examine this ground of opposition in greater detail after having discussed the grounds of opposition related to the likelihood of confusion between the parties' marks.

[24] The Opponent's evidence, which will be described in greater detail below, shows use of the Ü and/or smiling Ü Drawing marks and YOGEN FRÜZ. The Opponent admitted at the hearing that there was no resemblance between any one of its marks and the Mark, except for the presence of the letter Ü, which is the Opponent's corporate symbol.

[25] I will address all of the issues underlying this position taken by the Opponent while being fully aware that the legal onus remains on the Applicant to show that there was no confusion between the Mark and the Opponent's marks.

[26] I must first of all stress that use of the smiling Ü Drawing mark is a use of the Ü mark [see *Nightingale Interloc Ltd v. Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB) and *Registrar of Trade Marks v. Compagnie L'informatique CII Honeywell Bull, Société Anonyme et al* (1985), 4 CPR (3d) 523 (FCA)].

Grounds of opposition that can be subject to a summary ruling

[27] No evidence, no comments, either in the written argument or at the hearing; address the grounds of opposition based on sections 30(a) and (e) of the Act. that the registration application contains a statement to the effect that the Applicant planned to use the Mark in Canada in association with the Wares and there is no evidence on file to suggest this statement might be false.

[28] Since the Opponent has not met its initial evidential burden, these grounds of opposition are therefore rejected.

Description and comments on the Opponent's major evidence (Serruya 1)

[29] Mr. Serruya is president of the Opponent and has held this position since 1986. He describes the Opponent as being the largest domestic and international company operating points-of-sale for frozen yogurt and smoothies. Accordingly, the Opponent operates, directly or by way of licensees and franchisees, over 1,200 points-of-sale in 25 countries, including 200 in Canada. Its main product is frozen yogurt. It also sells beverages and other alternative health food products. Mr. Serruya filed a list of points-of-sale in Canada.

[30] I note that this list refers to 175 points-of-sale, most of which are located inside other business establishments, primarily movie theatres. I note that this list includes no references in the Maritimes, except for one counter in Nova Scotia, and none in Manitoba. 114 of these points-of-sale are located in Ontario, 26 in Quebec (including 23 in Pizza Hut restaurants), 10 in British Columbia, 19 in Alberta and 4 in Saskatchewan. However, during his cross-examination, Mr. Serruya said that the Opponent had places of business in all provinces, except Newfoundland, which contradicts the content of exhibit A in his affidavit. The only way to reconcile these two versions is to consider that exhibit A. is dated January 20, 2011, whereas Mr. Serruya was cross examined on February 7, 2012, i.e. one year later.

[31] Mr. Serruya states that today the Opponent's primarily offers frozen yogurt served with fruits or smoothies, as well as non-alcoholic beverages, i.e. juices and carbonated beverages.

[32] Mr. Serruya gives a brief history of the expansion of the company he founded with his brother. He states that the Opponent had been successful thanks to its unique manner of presenting its products, its points-of-sale and the originality of the locations where it operates its points-of-sale.

[33] At this stage, I would like to focus on the Applicant's objection regarding the eligibility of opinions given by Mr. Serruya concerning his company, the frozen yogurt and smoothie industry and the confusion between the parties' marks. The Applicant argues that Mr. Serruya is a representative of the Opponent and consequently cannot act in the capacity of expert. He cannot therefore give opinions.

[34] A representative of one party who has expertise in a given field can clearly give an opinion within the bounds of his expertise. However, the probative value of the latter would have to be assessed in light of his interest in the file. Although Mr. Serruya claims to be an expert due to his experience in the food, restaurant and beverage domain in Canada, I will limit the scope of opinions given to the sole domain of frozen yogurt and smoothies. Any opinion extending beyond the bounds of this expertise will quite simply be ignored.

[35] Accordingly, in paragraph 6 of his affidavit, he gives an opinion on the originality of the Opponent's marks and that the continued use of these marks was such that the Opponent stood out from its competitors. I will not take this opinion into account. It is ultimately the registrar's task to rule on these issues, based on the evidence on file.

[36] Mr. Serruya states that the Opponent is the largest domestic and international company that operates points-of-sale for frozen yogurt and smoothies. I note that this statement has not been contradicted. He explains the Opponent's success through the judicious selection of the Opponent's main trade-marks, including YOGEN FRÜZ and Ü and the smiling Ü Drawing mark used in association with the Opponent's wares and services. Mr. Serruya filed a certificate of authenticity for each of the marks filed and cited in the statement of opposition, i.e.:

YOGEN FRÜZ	TMA33,4270	November 13, 1987
FRÜZ COOL	TMA56,7079	September 10, 2002
FRÜZER	TMA567,080	September 10, 2002
SMOOTHY FRÜZ	TMA567,081	September 10, 2002
FRÜZ	TMA577,145	March 7, 2003
YOGEN FRÜZ and Drawing	TMA725,046	October 2, 2008
IT'S ALL ABOUT Ü	TMA734,846	February 19, 2009
FRÜZ TEA	TMA766,944	May 17, 2010
Ü	TMA773,730	August 4, 2010
YOGEN FRÜZ	TMA775,786	August 30, 2010

However, only use of the YOGEN FRÜZ and Ü marks has been proven in association with frozen yogurt and smoothies. At the hearing, the Opponent also referred to the IT'S ALL ABOUT Ü mark and I will take this into account in my decision.

[37] I note that the registrations for the FRÜZ COOL, FRÜZER, SMOOTHY FRÜZ and FRÜZ marks have been expunged from the register following a decision by the registrar dated September 20, 2013, pursuant to a proceeding under section 45 of the Act.

[38] Mr. Serruya states that the Opponent had obtained a worldwide registration for the YOGEN FRÜZ, smiling Ü Drawing and other vocal marks incorporating the letter Ü. However, the list filed (exhibit L in his affidavit) shows that most of the registrations obtained concerned the YOGEN FRUZ mark and not the YOGEN FRÜZ mark. The Ü mark has only been registered in 5 jurisdictions, excluding Canada.

[39] Mr. Serruya provided us with the annual sales figures for products displaying the Opponent's YOGEN FRÜZ and Ü marks worldwide and in Canada for the period 2005 to 2010. The sales in Canada vary between over \$10 million and over \$20 million.

[40] Mr. Serruya filed 3 bills from the Opponent showing the sale of containers (cardboard cups), table napkins and chocolate or vanilla bars in association with the YOGEN FRÜZ mark. However these bills make no reference to the Ü mark or the smiling Ü Drawing mark. These bills date back to 2000 and 2001. Mr. Serruya admitted during his cross-examination that the Opponent had begun using a new corporate image associated with the letter Ü in

2007. I therefore do not see how these bills support Mr. Serruya's statements concerning use of the letter Ü as the Opponent's corporate symbol. The same comment applies to sales figures prior to 2007.

[41] Mr. Serruya explains that this emphasis on the letter Ü was achieved by using this letter in each of the Opponent's marks and, in most cases, by using a different colour and font for the other letters making up the Opponent's trade-marks. I must recall that most of the registrations obtained outside of Canada are for trade-marks that do not include a dieresis over the letter U.

[42] Mr. Serruya filed two photos (exhibit N in his affidavit) of the front of one of the Opponent's establishments and of a cardboard cup to show use of the smiling Ü Drawing and the YOGEN FRÜZ mark in association with the operation of its business and the sale of frozen yogurt. I note that the letter Ü in the YOGEN FRÜZ mark is pink whereas the other letters in this mark are blue. However, Mr. Serruya cannot say when the photo was taken or whereabouts in Canada this business is located.

[43] The Applicant argues that the smiling Ü Drawing mark cannot be dissociated from the YOGEN FRÜZ mark due to their proximity. With respect for the opposite opinion, I do not agree. I note first of all use of the smiling Ü Drawing mark on the business entrance doors, whereas the YOGEN FRÜZ trade-mark is found on the awning over the entrance doors into the Opponent's business. With regard to the round container illustrated in exhibit O, the smiling Ü Drawing appears in two places, opposite each other, whereas YOGEN FRÜZ is also found in two places face-to-face. Due to the configuration of the container, it is practically impossible to see in a glance both trade-marks, the smiling Ü Drawing and YOGEN FRÜZ. Although the marks in question are located close to one another, I do not find they cannot be dissociated from each other.

[44] I must also stress that I do not consider use of the OGEN FRÜZ mark, where the Ü is in a different colour and/or font as use of the Ü mark or the smiling Ü Drawing [see *CII Honeywell Bull, op.cit.*].

[45] I note that Mr. Serruya says in his affidavit that the containers illustrated in exhibit O represent examples of use of the smiling Ü Drawing mark in association with beverages. However, it is clear from the shape and format of this container that it is used only for the sale of frozen yogurt and not for beverages. Moreover, the beverage containers appear mostly on the illustrations of ads filed as exhibit P in his affidavit. Despite the statement that exhibit P contains examples of use of the smiling Ü drawing mark, none of containers illustrated in these ads display this mark. They all display the YOGEN FRÜZ mark. Except for one of these ads, the letter Ü is the same colour and same font as the other letters that make up the words YOGEN and FRÜZ.

[46] I must also stress that I have no date associated with use of the containers illustrated in exhibits O and P, and the front of the business illustrated in exhibit N., except for Mr. Serruya's testimony in his cross-examination that states that the Opponent had changed its corporate image in 2007 (see page 40 of the transcript of his cross-examination). He does not recall exactly when the Opponent began transformation of the corporate image by adding the smiling Ü Drawing mark to the YOGEN FRÜZ mark, nor the location where this transformation was first used.

[47] Mr. Serruya also admitted during his cross-examination that the containers illustrated in exhibit O date back to 2007. I note that the registration certificate for the smiling Ü Drawing mark (TMA773730) filed by Mr. Serruya stems from a registration application filed on August 7, 2007 and that the statement of use was filed on August 4, 2010. This appears to confirm that the Opponent had not begun using this mark before a date after August 7, 2007.

[48] Mr. Serruya claims that the smiling Ü Drawing and YOGEN FRÜZ marks were the subject of newspaper articles and he filed a sample of these articles. I note that none of these articles referred to the smiling Ü Drawing mark. This is not surprising considering that the excerpts filed date back to 1995, 1998, 1999 and 2000. However, at this time, the Opponent had still not changed its corporate image to place emphasis on the smiling Ü Drawing.

[49] Mr. Serruya explains that in 2008, the Applicant had approached the Opponent for the latter to distribute the Applicant's OASIS juice and JONES sodas. Accordingly, in 2008, the Opponent distributed these products of the Applicant by offering them for sale inside its businesses in Canada. He provided the sales figures for these juices.

[50] Mr. Serruya says that in January 2010, the Applicant presented him with juices and frozen tea to be marketed under the FLAVÜR mark and he filed a sample of an advertising pamphlet proposed by the Applicant. He claims that it is clear that the Applicant had decided to adopt the smiling Ü Drawing whereas it was aware of the Opponent's use of this symbol. The latter notified the Applicant that he was objecting to the Applicant's use of the smiling Ü Drawing.

[51] Mr. Serruya claims that subsequently the Applicant unilaterally decided to file a registration application for the Mark. However, this version of the facts is somewhat inaccurate, since the registration application was filed on October 22, 2009, i.e. before the Mark had been presented to Mr. Serruya.

[52] The last paragraph of his affidavit is an opinion on the likelihood of confusion between the Mark and the Opponent's marks, an issue that I must rule on.

[53] I also note the following additional elements that stem from his cross-examination:

- 70% of the Opponent's sales are associated with frozen yogurt and 30% with beverages (including smoothies). The smoothie sales represent, depending on the store, 10-25% of total sales and the juice and bottled water sales represent approximately 2-9% of total sales (page 21 *et seq.*).
- The Applicant was the only company supplying juice to the Opponent. The smoothies were made with the Applicant's juices
- The Opponent conducted no studies to determine whether consumers associate the letter Ü with the Opponent's smiling Ü Drawing mark.
- Under the former YOGEN FRÜZ Drawing, the Ü had the same colour and font as the other letters;
- The Opponent's sales figures cover sales in association with the YOGEN FRÜZ and Ü marks, since these marks appear in all the establishments.

Conclusions concerning evidence on use of the YOGEN FRÜZ and Ü marks

[54] Based on this evidence, I conclude that:

- The YOGEN FRÜZ mark has been used in Canada since at least 1987;
- The Ü mark and/or the smiling Ü Drawing mark has been used in Canada since a date after August 2007 in association with the operation of businesses offering frozen yogurts and smoothies and in association with frozen yogurts.

[55] I am fully aware that this opposition is not aimed at the validity of the registration of the Opponent's marks as the Opponent pointed out to me at the hearing. The legal onus rests in fact on the Applicant's shoulders, which must show that it was entitled to registration of the Mark and that it is registrable.

[56] However, considering the position taken by the Opponent concerning recognition of its Ü Mark, I must rule on whether in fact I am dealing with a recognized trade-mark. If such is the case, the Opponent claims to be able to benefit from a certain monopoly on the letter Ü when used as a component of a trade-mark used in association with frozen yogurt and smoothies or any other similar product.

[57] Despite the Opponent's valiant efforts, I cannot agree with it on this point. Clearly, the evidence on file, and more specifically the Opponent's sales figures for 2008 and subsequent years show that the Ü and/or smiling Ü Drawing mark was known in Canada in association with frozen yogurts and smoothies, but I cannot qualify it as well known for the following reasons:

[58] First, the Ü and/or smiling Ü Drawing mark has been used in Canada since August 2007 at the earliest. However, the grounds of opposition under sections 16(3)(a) (right to registration) and 2 (distinctiveness) are based on the prior use of this trade-mark. The first ground is analyzed as at the filing date of the registration application (October 22, 2009), therefore barely two years later and that of the absence of distinctiveness of the mark is analyzed as at the filing date of the statement of opposition (June 14, 2010), i.e. less than 3 years after the start of use of the Ü and/or smiling Ü Drawing mark in Canada. Even though

under the ground of opposition based on section 12(1)(d) of the Act I can take into account the Opponent's sales in 2010, the sales figures alone are not an adequate element to conclude that the Ü and/or smiling Ü Drawing mark is sufficiently well known that no third-party could incorporate this element into its own trade-mark.

[59] The Opponent did not file any advertising in which the Opponent tries to promote this mark in Canada or elsewhere.

[60] It must not be forgotten that this trade-mark is a letter of the alphabet to which has been added a simple dieresis. It is well established that letters of the alphabet have a poor inherent distinctiveness [see *GSW Ltd v. Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FC 1st inst.) at pages 162-164]. To benefit from the broader field of protection would clearly require more evidence than has been placed on file, i.e. photos of the front of a business, the date of the photos or location of the business being unknown; photos of containers and sales figures for a period of no longer than three years.

[61] Lastly, it would be remiss of me not to stress the absence of evidence of studies to prove that the average Canadian consumer associates the Opponent's Ü and/or smiling Ü Drawing mark such that any mark including this element used in association with frozen yogurts, smoothies or any other similar product would be associated with the Opponent. I am aware that in *Masterpiece Inc v. Alavida Lifestyles Inc et al* 2011 SCC 27 the Supreme Court of Canada gave an opinion that it was preferable not to base itself on surveys to prove the absence or presence of a likelihood of confusion between two trade-marks. However, I find that the current situation could be conducive to the exercise. In fact, if the Opponent claims that its Ü and/or smiling Ü Drawing mark had become recognized to the extent that it constituted a distinctive corporate symbol in the same vein as Nike's 'swoosh,' a market study could have enlightened us on this point.

[62] I now begin analysis of the various grounds of opposition raised by the Opponent while taking into account the conclusion I have just made regarding the absence of recognition of the Opponent's Ü and/or smiling Ü Drawing mark.

Ground of opposition based on section 12(1)d) of the Act

[63] The Relevant date for analyzing this ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413, on page 424 (FCA)].

[64] The Opponent has based its ground of opposition on the following registrations:

YOGEN FRÜZ	TMA334,270
FRÜZ COOL	TMA567,079
FRÜZER	TMA567,080
SMOOTHY FRÜZ	TMA567,081
FRÜZ	TMA577,145
YOGEN FRÜZ and Drawing	TMA725,046
IT'S ALL ABOUT Ü	TMA734,846
FRÜZ TEA	TMA766,944

[65] I must stress that despite Mr. Serruya filing a registration certificate for the Ü mark, the Opponent has not amended its statement of opposition to add this registration to the list of registrations presented above. Therefore, I will not consider this mark under this ground of opposition.

[66] I have checked the status of the register and only the YOGEN FRÜZ, YOGEN FRÜZ and Drawing, IT'S ALL ABOUT Ü and FRÜZ TEA are still listed. I find that the Opponent has a better chance of success with the YOGEN FRÜZ mark (due to the proof of use of this mark) registered in association with frozen yogurt, yogurt, fruit cups, tofu, milk shakes and ice milk; and IT'S ALL ABOUT Ü mark registered in association with ice cream, frozen yogurt, frozen yogurt tarts and cakes, as well as frozen confectionery and restaurant and take-away services. I will therefore analyze this ground on the basis of these two marks only.

[67] It is incumbent on the Applicant to prove, according to the balance of probabilities, that use of the Mark in association with the Wares does not risk creating confusion with one of the Opponent's marks. The test to be applied to rule on this issue is stated in section 6(2) of the Act. This test does not address confusion between the marks themselves, but rather

confusion regarding the source of the Wares. Accordingly, I have to determine whether a consumer who sees the Wares in association with the Mark would believe they originate from the Opponent or are authorized by the latter.

[68] I must take into account all relevant circumstances, including those listed in section 6(5) of the Act, i.e. the inherent distinctiveness of the trade-marks and the extent to which they have become known; the period during which the trade-marks have been in use; the type of wares, services or enterprises; the type of business; the degree of similarity between the trade-marks in their presentation or sound, or in the ideas they suggest. This list is not exhaustive, and it is not necessary to grant the same weight to each of these factors.

[69] In its ruling on *Masterpiece, op.cit.*, the Supreme Court of Canada interpreted section 6(2) of the Act and enlightened us on the scope of the various criteria listed under section 6(5) of the Act. It is clearly indicated that, in the majority of cases, the extent of similarity between the marks is the most significant factor. I will therefore begin my analysis with this criterion.

The degree of similarity between the trade-marks

[70] At the hearing, the Opponent admitted that the Mark, taken as a whole, did not resemble its registered marks, i.e. YOGEN FRÜZ and IT'S ALL ABOUT Ü. This would be sufficient to conclude that this factor favours the Applicant.

[71] Aside from the presence of the letter Ü in the Mark, there is no similarity, visual, vocal or in the ideas suggested by the marks in question. On this latter point, I must stress that the Mark is phonetically and visually similar to the English word "flavour" which is translated by "saveur," whereas the YOGEN FRÜZ mark comprises two invented words which can suggest yogurt and fresh frozen fruit as mentioned in the articles filed in support of Mr. Serruyav's affidavit. Regarding the IT'S ALL ABOUT Ü mark, this suggests that

everything is about you or everything is about Ü. Regardless of the meaning given to it, the idea suggested by this mark differs from the idea suggested by the Mark.

[72] Accordingly this factor favours the Applicant.

[73] In *Masterpiece*, the honourable Judge Rothstein said:

As Professor Vaver points out, if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar (Vaver, at p. 532). As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start (Vaver, p. 532).

[74] Accordingly, as there is no similarity between the parties' marks, I find this would be sufficient to rule on the file. However, I will begin a summary analysis of the other factors listed in section 6(5) of the Act.

The inherent distinctiveness of trade-marks and the extent to which they have become known

[75] Although the Mark is an invented word, it is phonetically and visually similar to the word "flavour" which translates into French as 'saveur.' Therefore, when the Mark is used in association with the Wares, it suggests that the juice sold in association with a Mark is of a given flavour.

[76] Regarding the YOGEN FRÜZ mark, this comprises two invented words that have no specific meaning. It therefore has a strongly inherent distinctiveness.

[77] In regard to the IT'S ALL ABOUT Ü mark, this is a slogan where the letter Ü is pronounced like the English word 'you.' Accordingly, I do not find this mark to have greater inherent distinctiveness than the Mark.

[78] I have already reviewed the evidence on use of the YOGEN FRÜZ mark. This mark is known in Canada. However; I have no evidence on use of the IT'S ALL ABOUT Ü mark.

[79] The only evidence on use of the Mark comes from the affidavit by Ms. Bernier, an intern at the Applicant's firm of agents. On June 21, 2011, she went to a Montreal supermarket operating under the IGA banner where she purchased, among others, a juice displaying the Mark. This fact aside, we have no other information concerning the scale of use of the Mark.

[80] This factor therefore favours the Opponent, but only in regard to its YOGEN FRÜZ mark.

The period during which the trade-marks have been in use

[81] The evidence described above shows that the YOGEN FRÜZ mark has been used in Canada since 1987. Regarding the IT'S ALL ABOUT Ü mark, there is no evidence of its use in Canada. Although the registration certificate shows the filing of a statement of use dated February 19, 2009, I can only infer minimal use of this mark which will have no impact on the weight granted to this factor [see *Entre Computer Centers, Inc v. Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)].

[82] As for the Mark, its use only dates back to June 21, 2011.

[83] In the circumstances, this factor favours the Opponent in regard to the YOGEN FRÜZ mark.

The type of wares and the nature of the business

[84] There is a difference between juices on the one hand and frozen yogurt, yogurt fruit cups, milk shakes and ice milk on the other. However, I find there to be an overlap between

milk shakes and juices, since these products are non-alcoholic beverages. In addition, the registration certificate for the YOGEN FRÜZ mark covers restaurant, take-away and snack bar services. However, the evidence, as described above, shows that the Applicant's juices have already been sold in establishments operating under the YOGEN FRÜZ mark.

[85] The Applicant argues that, according to Mr. Serruya's testimony, the sales of products bottled inside businesses operating under the YOGEN FRÜZ mark represented only 2-9% of total sales. Accordingly, these are very low sales figures. However, under section 12(1)(d), I must compare the Wares with the wares and services covered by the Opponent's registration certificates. Whether the sales are significant or not is of little importance. The overlap exists and the evidence shows that juices were sold in the Opponent's businesses.

[86] The Serruya 2 affidavit contains information on use of the YOGEN FRÜZ trade-mark in association with prepared mixtures for smoothies sold in Sobeys and IGA supermarkets and in Costco. However, these wares are not covered by the registration certificate for this trade-mark.

[87] I find that ultimately these factors favour the Opponent.

Families of trade-marks including the letter Ü

[88] The Opponent claims to have shown that it owns a family of trade-marks including the letter Ü by the filing of registration certificates for trade-marks cited in support of this ground of opposition. It is well-established that to argue the existence of a family of trade-marks it is necessary not only to prove ownership of these marks but also their use in Canada [see *McDonald's Corp v. Yogi Yogurt Ltd* (1983), 66 CPR (2d) 101 (FC 1st inst)]. However, aside from the YOGEN FRÜZ mark, I have no evidence on file regarding use of the marks cited by the Opponent under this ground of opposition.

[89] Even considering use of the smiling Ü Drawing mark, the evidence would be insufficient to conclude a family of marks, since it covers only two trade-marks: YOGEN FRÜZ and smiling Ü Drawing.

Evidence on the status of the market

[90] The Applicant filed evidence on the status of the market and the status of the register to establish the presence on the market of several trade-marks including the letter Ü such that the average Canadian consumer would be accustomed to distinguishing marks that include the letter Ü. Accordingly, it first filed certified copies of registrations and registration applications for the following marks:

BLÜ BOTOL and Drawing	TMA508,557	mineral water
BLÜ BOTOL	TMA489,455	mineral water
7-ELEVEN FRÜT COOLER	TMA550,914	fruit-flavoured carbonated beverages
SUSHI YU MI and Drawing	TMA765,471	restaurant services
STATION BLÜ	1,313,108	cosmetics and skincare products
Ü and Drawing	1,464,730	energy drinks
ÜBERSHOT	1,464,728	energy drinks
PÜRBLOOM	1,479,943	non-alcoholic fruit juices and fruit beverages
SUSHI YÜ MI and Drawing	1,479,186	restaurant services
U-SWIRL	1,460,141	retail sales service for frozen yogurt
IÜNI and Drawing	1,451,654	Candies and gum
SCHÜETZLI	1,450,653	yogurt and non-alcoholic beverages
FÜDI	1,437,505	appetizers and spices
PÜR GUM and Drawing	1,492,706	chewing gum

[91] Furthermore, Ms. Bernier states:

- Having purchased online, on June 20, 2011, a box of Belgian chocolates sold by Humeur Groupe Conseil inc. and displaying the HÜMEUR mark. She filed photos of the box and an individual bar displaying this mark;
- Have gone, on June 21, 2011, to the NÜVÜ restaurant located on Sainte-Catherine Street in Montreal, photographed the front of this restaurant and picked up a business card; She filed the photos and business card.
- Having purchased from an IGA supermarket juices displaying the INÜ and FLAVÜR marks. She filed photos as well as the bottles displaying these marks;
- Having visited the SUSHI YÜ MI restaurant located on Sherbrooke Street in Montreal, taken photos of the restaurant and picked up a business card, and then filed these items as evidence;
- Having purchased from Marché Tau in Laval a pack of PÜR GUM mark chewing gum. She filed photos and the pack of chewing gum;

- Having conducted the following Internet searches:
 Flickr website showing Marie-Claude Bergevin holding a bottle of juice displaying the INÜ mark;
 Pur-gum website for the PÜR GUM gum;
 HÜMEUR fund-raising campaign website;
 Fruitti & Confetti website for its PÜR BLOOM section;
 Catamaran-Lounge BELVÜ website.

[92] In considering the additional evidence placed on file pursuant to the decision I made earlier on this subject, the following marks are also on the register:

U-SWIRL	TMA851,561	retail sales service for frozen yogurt
Ü	TMA839,600	distribution of products for fundraising campaigns, including chocolate.
FÜDI	TMA877,856	appetizers and spices
PÜR BLOOM	TMA864,915	non-alcoholic fruit juices and fruit beverages
STATION BLÜ	TMA806,579	spa services
FRÜH and Drawing	1,606,738	beer
HAGESÜD	1,567,353	spices and condiments
DAS BRAÜ and Drawing	1,624,104	beer
KÜLT LA CULTURE DU BIEN-ÊTRE	1,598,113	non-alcoholic beverages made from coffee and beverages made from tea
Efengübier	1,557,819	beer
YÜM	1,585,826	granola bars
GÜ and Drawing	1,532,723	yogurts

[93] Given the evidence regarding the register and the status of the market, I am retaining only the marks that cover non-alcoholic beverages and yogurt. Accordingly, I find the following citations to be most relevant.

PÜRBLOOM	TMA864,915	fruit juices and fruit beverages;
KÜLT LA CULTURE DU BIEN-ÊTRE	1,598,113	non-alcoholic beverages made from coffee and beverages made from tea;
GÜ and Drawing	1,532,723	yogurts;
SCHÜETZLI	1,450,653	yogurt and non-alcoholic beverages;
Ü and Drawing	1,464,730	energy drinks;
ÜBERSHOT	1,464,728	energy drinks;
BLÜ BOTOL and Drawing	TMA508,557	mineral water;
BLÜ BOTOL	TMA489,455	mineral water;
7-ELEVEN FRÜT COOLER	TMA550,914	fruit-flavoured carbonated beverages;

[94] In addition to the parties' marks in this case, there are 9 marks on the register that include the Ü component, which are held by 7 different entities in the field of non-alcoholic beverages and yogurts. This number is insufficient to draw a conclusion that could be favourable to the Applicant, i.e. that there are numerous trade-marks on the market that include this characteristic such that the average Canadian consumer is accustomed to distinguish between these marks [See *Welch Foods Inc v. Del Monte Corp* (1993), 44 CPR (3d) 205 and *Ports International Ltd v. Dunlop Ltd* (1992), 41 CPR (3d) 432].

Recognition of the Ü and or smiling Ü Drawing mark

[95] The Opponent argues that the Applicant has incorporated the letter Ü and/or the smiling Ü Drawing into the Mark. I have already exhaustively addressed this argument and have come to the conclusion that the letter Ü and/or the smiling Ü Drawing is not a recognized trade-mark and that accordingly the Opponent cannot claim exclusivity to the letter Ü and/or the smiling Ü Drawing.

Conclusion

[96] From this analysis of relevant criteria, I conclude that the Applicant has not met its burden of proving, according to the balance of probabilities, the absence of confusion between the Mark and the Opponent's registered marks. The absence of similarity between the marks in this case is the determinant factor in this file.

[97] I therefore reject this ground of opposition.

The other grounds of opposition based on confusion

[98] The Opponent raises the grounds of opposition based on sections 16(3)(a) and (b) (right to registration of the Mark) and 2 of the Act (absence of distinctiveness of the Mark). It should be recalled that these grounds of opposition are analyzed based on the same factors taken into consideration in the analysis of the ground of opposition based on section 12(1)(d) of the Act but on different dates, i.e.:

- right to registration of the Mark: filing date of the registration application (October 22, 2009) [see section 16(3) of the Act];
- Absence of distinctiveness of the Mark: filing date of the statement of opposition (June 14, 2010) [see *Andres Wines Ltd v. E&J Gallo Winery* (1975), 25 CPR (2d) 126 (FCA)].

[99] This difference in the relevant dates indicates that the elements of evidence taken into consideration under the ground of opposition based on section 12(1)(d) must be excluded from my analysis of relevant factors. Furthermore, the Opponent bases itself on use of the Ü mark and the registration applications for marks which have not been considered under the ground of opposition previously analyzed. The following analysis will be limited to these variants. However, the same conclusion, i.e. the absence of confusion between the parties' marks, also applies to these grounds of opposition.

Grounds of opposition based on sections 16(3)(a) and 2 of the Act

[100] The evidence described above shows that the Opponent had used the Ü (since late 2007) and YOGEN FRUZ marks (since 1987) in association with frozen yogurts and smoothies as well as the operation of businesses offering these products for sale and that these marks were sufficiently known in Canada to deny any distinctiveness of the Mark. Furthermore, the Opponent showed that it had not abandoned use of its marks in Canada as of the publication date of the current registration application [see section 16(5) of the Act].

[101] In the circumstances, I find that the Opponent has met the initial evidential burden incumbent on it under the grounds of opposition based on sections 16(3)(a) and 2 of the Act.

[102] The Ü mark has weak inherent distinctiveness since it is the letter U of the alphabet to which a dieresis has been added. I do not find that the addition of this diacritic to a letter of the alphabet gives strong overall distinctiveness to this mark.

[103] During his cross-examination, Mr. Serruya indicated that it was impossible to dissociate the sales figures for products displaying the YOGEN FRÜZ mark from sales of products displaying the Ü mark, since these marks are intimately linked. In effect, as previously mentioned, these two marks appear on the cups used for serving the frozen yogurt and on the front of the Opponent's businesses. However, I must take into account the sales figures for 2008 and 2009 for the ground based on section 16(3)(a) and add to these sales those from 2010 for the ground of opposition based on section 2 of the Act.

[104] I am aware that I would have to limit the sales in 2009 to the period ending October 22, 2009 but Mr. Serruya has not provided this precise information. However, even in assuming that the figures provided for 2009 are limited to this period, I do not find this assumption, favourable to the Opponent, would have a marked impact on the outcome reserved for the ground of opposition based on section 16(3)(a) of the Act. The same remark applies to sales in 2010 which should be limited to the period ending June 14, 2010 in regard to the ground of opposition based on the absence of distinctiveness of the Mark.

[105] As previously mentioned, these sales figures prove that the smiling Ü Drawing and YOGEN FRÜZ marks were known in Canada on the relevant dates.

[106] With regard to the nature of the wares and the parties' businesses, the same conclusions as those described above under the ground of opposition concerning registrability of the Mark apply in this case.

[107] Regarding the evidence on the status of the register and the market, due to the prior relevant dates under the current ground of opposition, certain elements of evidence described under the previous ground of opposition could be taken into consideration, which would have the effect of reducing the number of citations deemed relevant.

[108] Regarding the degree of similarity between the Mark and the Ü mark, aside from the presence of this letter in the Mark, when the marks are taken as a whole, there exists no similarity, be it visual, phonetic or in the ideas they suggest.

[109] The absence of a degree of similarity between the Ü mark and the Mark is the determining factor in concluding the absence of confusion between these marks. Moreover, I have already ruled in favour of the Applicant in concluding the absence of confusion between the Mark and the Opponent's YOGEN FRÜZ mark.

[110] Accordingly, the grounds of opposition based on sections 16(3)(a) and 2 of the Act are rejected.

Ground of opposition based on section 16(3)(b) of the Act

[111] The registration applications on which the Opponent is basing itself [see Appendix B to this decision] must have been filed before the current registration application and still be pending at the time of publication of the latter (April 14, 2010) [see sections 16(3) and 16(4) of the Act]. On this latter point, the following applications were no longer pending as at April 14, 2010, such as it appears from the registration certificates for these marks filed by the Opponent.

YOGEN FRÜZ and Drawing	1358415
IT'S ALL ABOUT Ü	1366211

[112] The Opponent filed no certified copies of the registration applications on which it bases this ground of opposition. However, the registrar has the discretionary power to consult

the register to check whether in fact these registration applications exist and if they were still pending at the time of publication of this registration application [see *Royal Appliance Mfg Co v. Iona Appliances Inc* (1990), 32 CPR (3d) 525 (TMOB)].

[113] I conducted the necessary checks and I confirm, aside from those mentioned above, that some registration applications were still pending as at April 14, 2010.

[114] The Applicant, at the hearing, argued that to meet its initial evidential burden, the Opponent had to show use of the marks covered by these registration applications. It bases itself on the registrar's decision in *2028274 Ontario Limited v. B Store Limited* 2011 TMOB 183. However, in this decision, the registrar raised the absence of evidence of use of the marks cited in support of the grounds of opposition based on sections 16(3)(a) and (c) and not section 16(3)(b) of the Act. The wording in these sections is very clear: whereas sections 16(3)(a) and (c) refer to prior use of a trade-mark, the wording in section 16(3)(b) requires it to be filed prior to the registration application. This is not an issue of use of the mark covered by the registration application cited in support of the ground of opposition based on section 16(3)(b) of the Act.

[115] In the circumstances, I conclude that the Opponent has met the initial evidential burden incumbent upon it pursuant to section 16(3)(b) of the Act.

[116] None of the citations listed in Appendix B hereto and which could be considered under this ground of opposition, when considered as a whole, resembles the Mark.

[117] Accordingly, I reject this ground of opposition for same reasons as those formulated under the ground of opposition based on section 12(1)(d) while making the necessary adaptations.

Ground of opposition based on section 30(i) of the Act

[118] The Applicant argues that bad faith was not claimed in support of this ground of opposition and that the simple claim of knowledge of the Opponent's marks is not sufficient to maintain this ground of opposition.

[119] Case law has recognized and that there must have been evidence of bad faith to maintain this ground of opposition. Also, case law has concluded that simple knowledge of the Opponent's marks is not sufficient to conclude that the Opponent has met its initial evidential burden under this ground of opposition [see *Sapodilla Co Ltd v. Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB) and *WOOT, Inc v. WootRestaurants Inc* 2012 TMOB 197].

[120] A parallel can be made with the situation that prevailed in *Pélican International Inc v. GSC IP Technologies LLC Corp* 2011 TMOB 42 where an official notice had been served on the Applicant before the filing of its registration application. Accordingly, the Opponent argued that the Applicant had knowledge of its trade-mark. This knowledge was deemed irrelevant in the absence of confusion between the marks in dispute and so the Applicant could declare itself satisfied of having the right to use the mark.

[121] There was also the registrar's decision in *Pharmacyclics Inc v. McKesson Canada Corporation* 2008 CanLII 88145 where the Applicant had approached the Opponent to negotiate an agreement of coexistence before filing its registration application. The registrar concluded that, despite this fact, the Applicant could declare itself satisfied of having the right to use the mark in Canada.

[122] I must recall that, contrary to Mr. Serruya's claims, the Applicant's registration application had been filed before the latter had made known his disagreement to the Applicant.

[123] In the circumstances, I reject this ground of opposition.

Disposal

[124] Given the powers delegated to me by the Registrar of Trade-marks pursuant to the provisions of Section 63(3) of the Act, I reject the opposition, the whole as per the provisions of Section 38(8) of the Act.

Jean Carrière
Member of the Trade-marks Opposition Board
Canadian Intellectual Property Office

Traduction certifiée conforme

Appendix A

The grounds of opposition can be summarized as follows:

1. The reregistration application does not comply with the provisions of section 30(a) of the *Trade-marks Act*, R.S.C. 1985, ch. T-13 (the Act) in that the wares are not described in regular business terms;
2. The registration application is not in compliance with the provisions of section 30(e) of the Act in that the registration application does not contain a statement to the effect that the Applicant planned to use the Mark in Canada nor that it could be satisfied of making such a statement, given that it knew the importance of the Opponent's marks on which the Opponent was basing its grounds of opposition and, more specifically, the opponent's Ü marks.
3. The registration application is not in compliance with the provisions of section 30(i) of the Act in that the registration application can does not contain a statement to the effect that the Applicant was convinced that it had the right to use the Mark in Canada in association with the Wares, since on the filing date of the application the Applicant had knowledge of the Opponent's marks described below and their continuous use by the Opponent;
4. The Mark is not registrable pursuant to section 12(1)(d) of the Act, since it creates confusion with the following marks registered by the Opponent:

YOGEN FRÜZ	TMA334,270
FRÜZ COOL	TMA567,079
FRÜZER	TMA567,080
SMOOTHY FRÜZ	TMA567,081
FRÜZ	TMA577,145
YOGEN FRÜZ Drawing	TMA725,046
IT'S ALL ABOUT Ü	TMA734,846
FRÜZ TEA	TMA766,944

5. The Applicant is not the person entitled to registration of the Mark pursuant to the provisions of section 16(3)(a) of the Act since on the filing date of the application, the Mark created confusion with the Ü and YOGEN FRÜZ trade-marks used by the Opponent in Canada in association with food, confectionery, desserts and beverages including frozen yogurt and fruit juice, as well as the operation of stores selling food products that included frozen yogurt and fruits;
6. The Applicant is not the person entitled to registration of the Mark pursuant to the provisions of section 16(3)(b) of the Act, since on the filing date of the application, the Mark created confusion with one of the Opponent's trade-marks which was covered by the registration applications listed below:

1,403,739	FROYORSSEÜR
1,397,388	FRÜZ TEA
1,366,211	IT'S ALL ABOUT Ü
1,449,685	JUST BE Ü
1,359,816	LÜV LIFE
1,358,880	LÜV LIFE and Drawing
1,358,878	Ü and Drawing
1,454,193	YOGEN FRÜZ
1,358,415	YOGEN FRÜZ and Drawing
1,358,418	YOGEN FRÜZ BE GOOD TO YOURSELF and Drawing
1,403,740	YOGÜRSSEÜR

7. The Mark does not distinguish the Wares from those of the Opponent, nor is it adapted to distinguish them within the meaning of section 2 of the Act from the Opponent's wares and services in association with the Opponent's Ü and YOGEN FRÜZ marks used by the latter in Canada.

Appendix B

1,403,739	FROYORSSEÜR
1,397,388	FRÜZ TEA
1,366,211	IT'S ALL ABOUT Ü
1,449,685	JUST BE Ü
1,359,816	LÜV LIFE
1,358,880	LÜV LIFE and Drawing
1,358,878	Ü and Drawing
1,454,193	YOGEN FRÜZ
1,358,415	YOGEN FRÜZ and Drawing
1,358,418	YOGEN FRÜZ BE GOOD TO YOURSELF and Drawing
1,403,740	YOGÜRSSEÜR