



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

Citation: 2011 TMOB 86
Date of Decision: 2011-05-25

**IN THE MATTER OF AN OPPOSITION
by Canada Dry Mott's Inc. to application
No. 1,319,185 for the trade-mark
CRUSSH and Design in the name of
Krush Global Limited**

[1] On October 6, 2006, Krush Global Limited (the Applicant), filed an application for the trade-mark CRUSSH and Design (the Mark), shown below, based upon proposed use of the Mark in Canada.



[2] The statement of wares and services, as revised, reads as follows:

Wares:

soups; preparations for making soup; canned, fresh or chilled soup; soup mixes; prepared meals, namely meat, fish, egg, pasta, vegetable and salad dishes; fillings for sandwiches; preparations for making sandwiches, namely meat, fish, egg, pasta, vegetables and salad; crisps; snack foods; potato chips; stews; salads; fruit salads; yoghurt; desserts made from yoghurt; beverages made from yoghurt; mineral and aerated and effervescing waters;

fruit juices; syrups for making fruit juice, syrups for making fruit drinks, syrups for making non-alcoholic carbonated beverages; essences and extracts; isotonic beverages

Services:

restaurant, catering, snack bar and cafe services; provision of prepared foods via retail outlets specializing in the provision of food and drink; food and drink preparation and presentation services; bar services; catering services for the provision of food and drink; preparation of food stuffs or meals for consumption off the premises; sandwich and salad bar services; wine bar services

[3] The application is also based upon use and registration of the Mark in the United Kingdom under registration No. 3,998,846.

[4] The application was advertised for opposition purposes in the *Trade-marks Journal* of November 26, 2008.

[5] On January 26, 2009, Canada Dry Mott's Inc. (the Opponent) filed a statement of opposition against the application. The grounds of opposition are that the Applicant's application does not conform to the requirements of s. 30(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) in that the Mark has not been used by the Applicant in the United Kingdom in association with all of the wares and services set out in the application, the Mark is not registrable pursuant to s. 12(1)(d), the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(2) and s. 16(3), and the Mark is not distinctive. Each of the last four grounds is based on confusion with the Opponent's use and registration of the following CRUSH trade-marks: CRUSH, registration No. TMDA042,219; CRUSH, registration No. TMA229,350; CRUSH and Design, registration No. TMA396,076; CRUSH and Design, registration No. TMA531,936; and CRUSH, registration No. TMA586,673. The particulars of these registrations can be found in the attached Schedule A.

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

[7] The Opponent's evidence consists of the affidavit of Wayne Delfino, the affidavit of Dale Penney, and certified copies of the above noted registrations. The Applicant elected not to file any evidence. Neither of the Opponent's affiants was cross-examined.

[8] Only the Opponent filed a written argument. Neither party requested an oral hearing.

Onus and Material Dates

[9] 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.)].

[10] The material dates that apply to the grounds of opposition are as follows:

- s. 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 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* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 16(2) - the filing date of the application [see s. 16(2)];
- s. 16(3) - the filing date of the application [see s. 16(3)];
- non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Section 30(d) Ground of Opposition

[11] The Opponent alleges that the Applicant has not used its Mark in the United Kingdom in association with all of the wares and services covered in the application prior to the filing date of the present application (i.e. October 6, 2006).

[12] While the legal onus is upon an applicant to show that its application complies with s. 30(d) of the Act, there is an initial evidential burden on the opponent in respect of this ground

[see *Joseph E. Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 (T.M.O.B.)]. Also, the amount of evidence required to discharge this evidential burden may be very slight [see *Canadian Council of Professional Engineers v. 407736 Ontario Corp.* (1987), 15 C.P.R. (3d) 551 (T.M.O.B.)].

[13] Section 30(d) provides as follows:

30. An application for the registration of a trade-mark shall file with the Registrar an application containing

(d) in the case of a trade-mark that is the subject in or for another country of the Union of a registration or an application for registration by the applicant or the applicant's named predecessor in title on which the applicant bases the applicant's right to registration, particulars of the application or registration and, if the trade-mark has neither been used in Canada nor made known in Canada, the name of a country in which the trade-mark has been used by the applicant and the applicant's named predecessor in title, if any, in association with each of the general classes of wares or services described in the application.

[14] The affidavit of Mr. Penney, a searcher for the Opponent's agent, contains print-outs from the Applicant's website www.crush.com which were printed on August 7, 2009. These printouts describe some of the Applicant's products and provide information about the location of the Applicant's "smoothie bars" in the United Kingdom.

[15] Relying on the evidence of Mr. Penney, the Opponent submits that while some of the Applicant's wares and services were advertised on the website www.crush.com on the date Mr. Penney reviewed the website (i.e. August 7, 2009), the website did not make any reference to carbonated beverages, essences and extracts, bar services or wine bar services. The Opponent considers such evidence to be sufficient to meet its burden under s. 30(d) of the Act.

[16] I am not satisfied that the Opponent in the present case has provided sufficient evidence to support an allegation that the Applicant has not used the Mark in association with the above noted wares and services in the United Kingdom as of the material date. In this regard, the fact that some of the Applicant's wares and services were not advertised by the Applicant on its website in 2009 is not, by itself, clearly inconsistent with the Applicant's claim to have used the

Mark in association with all of the applied for wares and services in the United Kingdom since the filing date of the application in Canada (i.e. October 6, 2006). This ground of opposition is therefore unsuccessful.

[17] I note that even if the Opponent had met its burden under this ground, the application may still have proceeded on the basis of proposed use of the Mark in Canada, depending on the outcome of the remaining grounds of opposition [see *A.B. Dick Company v. Platsch GmbH & Co.* (June 15, 2007) T.M.O.B. (unreported), application No. 1,053,781].

Section 30(i) Ground of Opposition

[18] 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] As this is not such a case, I am dismissing this ground of opposition.

Section 12(1)(d)

[19] The s. 12(1)(d) ground of opposition turns on the issue of the likelihood of confusion between the Mark and each of the Opponent's marks.

[20] I note that the Opponent's initial burden with respect to the s. 12(1)(d) ground has been satisfied because each of its registrations is in good standing.

[21] I consider the Opponent's case to be strongest with respect to the ground that the Mark is not registrable pursuant to s. 12(1)(d) of the Act due to a likelihood of confusion with the Opponent's CRUSH registration Nos. TMDA042,219, and TMA229,350 and CRUSH and Design, registration No. TMA531,936.

test for confusion

[22] 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 and the extent to which they have become known; b) the length of time each has been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight.

[23] 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 its decisions in *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401. It is with these general principles in mind that I shall now assess all of the surrounding circumstances.

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

[24] I consider each of the Opponent's marks to possess a high degree of inherent distinctiveness because the word CRUSH, although a dictionary word, is not suggestive of their associated wares. The Mark is slightly more inherently distinctive than the Opponent's marks because of its unique spelling and design component.

[25] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. The evidence of the Opponent's affiant, Mr. Delfino, provides the following information:

- the CRUSH marks have been extensively used and advertised in Canada by the Opponent, its predecessors, affiliates, and licensees, in association with soft drinks, syrups, concentrates and related wares for over eighty years;
- the CRUSH marks are used on a variety of beverage products, sold across Canada in restaurants, convenience stores, gas stations, grocery stores, drug stores and other national retailers;

- the CRUSH marks are also used in association with syrups and concentrates used to make CRUSH brand fountain drinks and frozen carbonated beverages known as “slushies” sold to retailers and foodservice providers including restaurants such as Kentucky Fried Chicken, Dairy Queen, Pizza Delight, Boston Pizza, Red Robin, Golden Griddle, Applebee’s, Kelsey’s, Fire Pit, Taco Time, IKEA restaurants, New York Fries, Taco Bell and Pizza Pizza, for example;
- the CRUSH marks are also licensed by the Opponent for use in Canada on a variety of products, such as freezer pops, desserts, sauces, toppings, candy, and clothing;
- for the period between 2005 and 2008, sales of CRUSH branded products in Canada have been in excess of between \$18.7 and \$23.4 million annually and between \$15 and \$18 million annually for the years 2001 – 2005;
- the Opponent has spent over \$7.4 million on advertising expenditures for CRUSH brand products in Canada between 2005 and 2008, and approximately \$2 million per year between the years 2001 and 2004;
- the CRUSH marks have been extensively advertised and marketed in Canada for decades in a variety of mediums including via the Internet, through in-store promotions, shelf-talkers, coupons, in-store displays, print advertising, contests, sponsorships and by licensed bottlers and distributors;
- CRUSH branded products are promoted by the Opponent’s bottlers and distributors who have invested in excess of \$80 million to promote CRUSH products with retailers and food service providers;
- the Opponent’s CRUSH branded products are the number one flavored beverage in Canada and the number four non-cola soda in Canada.

[26] The Applicant, on the other hand, has not provided any evidence of use of the Mark.

[27] Based on the foregoing information, I conclude that the Opponent’s marks have become known to a significant extent in Canada while the Mark has not become known to any extent.

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

[28] The length of time that each mark has been in use favours the Opponent.

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

[29] When considering the wares, services and trades of the parties, it is the statement of wares or services in the applicant’s trade-mark application and those in the opponent’s

registrations that govern in respect of the issue of confusion arising under s. 12(1)(d) [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)].

[30] The Applicant's yoghurt, desserts made from yoghurt; beverages made from yoghurt; mineral and aerated and effervescing waters, fruit juices, syrups for making fruit juice, syrups for making fruit drinks, syrups for making non-alcoholic carbonated beverages, essences and extracts, and isotonic beverages overlap with the Opponent's beverages, syrups for beverage preparations, and dessert wares. The remaining wares and services are related to the extent that they are all broadly associated with the food and beverage industry.

[31] With respect to the parties' channels of trade, the Opponent's evidence shows that its products are sold to wholesalers and retailers and directly to consumers across Canada, including at convenience stores, gas stations, grocery stores, drug stores and other national retailers. The Opponent's CRUSH marks are also used in association with syrups and concentrates, which are sold to retailers and numerous restaurants and foodservices providers, and used to make the CRUSH brand fountain drinks and frozen carbonated beverages (i.e. slushies).

[32] In view that both parties' wares and services are broadly associated with the food and beverage industry, in the absence of evidence to the contrary from the Applicant, I find that the parties' channels of trade for such wares and services could potentially overlap. The only exception would be the Applicant's wine bar services as such services are, in my view, of a specialized nature and would likely be offered in a different establishment than those listed above.

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

[33] When considering the degree of resemblance between the marks, the marks must be considered in their totality; it is not correct to lay the trade-marks side by side and compare and observe similarities or differences among the elements or components of the marks [see *Chamberlain Group, Inc., v. Lynx Industries Inc.* (2010), 89 C.P.R. (4th) 122, reversing 79

C.P.R. (4th) 465]. Further, the most crucial or dominant factor in determining the issue of confusion is the degree of resemblance between the trade-marks [see *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145(F.C.T.D.) at 149, affirmed 60 C.P.R. (2d) 70] and the following quote from page 188 of *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) applies well to the present situation:

[The applicant] has appropriated the [opponent's] mark in its entirety and added thereto ... a suffix ... It is axiomatic that the first word or the first syllable in a trade mark is far the more important for the purpose of distinction. Here the first and most important word in the mark which the [applicant] seeks to register is identical to the mark registered by the [opponent]. If there is doubt whether the registration of a trade mark would cause confusion with a prior mark the doubt must be resolved against the newcomer. In this instance the result is that the doubt must be resolved in favour of the [opponent].

[34] In the present case, the Applicant has appropriated the Opponent's word marks in their entirety and added thereto an additional letter "s" and an ink blot design. The Mark also features a very similar style of font as the Opponent's CRUSH and Design mark. There is therefore a high degree of resemblance between all of the marks in appearance. When sounded, the marks are virtually identical, although the Mark may be pronounced with a slightly elongated "s" sound. I also consider the ideas suggested by the marks to be the same.

conclusion re likelihood of confusion

[35] As indicated earlier, confusion exists when 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 or performed by the same person, whether or not the wares or services are of the same general class. In the present case, the marks are almost identical. Further, the Opponent has established a strong reputation in its CRUSH marks and I am concerned that the Applicant has not chosen a mark that is sufficiently different from the Opponent's well known marks to make confusion unlikely, despite the fact that some of its wares and services may not overlap with the wares of the Opponent.

[36] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Applying this test to the present case, one must consider the mind of a

casual consumer somewhat in a hurry who sees CRUSSH and Design on the Applicant's wares and services at a time when he or she has no more than an imperfect recollection of the Opponent's CRUSH trade-marks, and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot*].

[37] At best, I find that the balance of probabilities is evenly balanced between a finding of confusion between the marks in issue and a finding of no confusion. As the onus is on the Applicant to establish on a balance of probabilities that the Mark is not confusing with the Opponent's marks, I must decide against the Applicant.

[38] In view of the above, the s. 12(1)(d) ground of opposition is successful.

[39] Remaining Grounds of Opposition

[40] The material dates for assessing the likelihood of confusion in respect of the non-entitlement and non-distinctiveness grounds are, respectively, the Applicant's filing date and the date of opposition. In my view, the differences in material dates do not have any significant impact on the determination of the issue of confusion between the trade-marks of the parties. Thus, my finding above that the trade-marks are likely to be confused applies to these grounds of opposition which also succeed.

Disposition

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

Cindy R. Folz
Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Trade-mark	Registration No.	Wares
CRUSH	TMDA042,219	<p>Beverages, flavors and compounds for making beverages, and food flavors.</p> <p>Concentrates, syrups and other ingredients for use in preparing carbonated and non-carbonated non-alcoholic beverages; vending machines; canned non-alcoholic beverages, non-alcoholic beverages in bulk, and bottled non-alcoholic beverages;</p> <p>Fountain bulk, and bottled non-alcoholic beverages; (2) Fountain syrups, syrups, pre-mixes and beverage preparations for use in soda fountain dispensing equipment.</p>
CRUSH	TMA 229,350	<p>Syrups, concentrates, flavoring preparations and other preparations and ingredients for making frozen confections; frozen confections, particularly ice cream, ice milk, sherbets, water ices.</p> <p>Dehydrated fruit snacks.</p>
CRUSH and Design 	TMA 531,936	Carbonated and non-carbonated soft drinks, soda and cream soda, fruit or fruit-flavoured non-alcoholic beverages (both carbonated and non-carbonated), flavour concentrates, essences and syrups for the production of soft drinks.

<p>CRUSH and Design</p> 	<p>TMA 396,076</p>	<p>Soft drinks, namely carbonated and non-carbonated, juice or juice-flavoured non-alcoholic beverages, flavour concentrates, essences and syrups for the production of soft drinks.</p>
<p>CRUSH</p>	<p>TMA 586,673</p>	<p>Candy and sugar confectionery.</p>