



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

Citation: 2014 TMOB 8
Date of Decision: 2014-01-17

**IN THE MATTER OF AN OPPOSITION
by Paramount International Export Ltd.
to application No. 1,446,276 for the trade-
mark FIJI BLOND & DESIGN in the
name of Gold Wings Entertainment Ltd.**

[1] On July 15, 2009, Gold Wings Entertainment Ltd. (the Applicant) applied to register the trade-mark FIJI BLOND & DESIGN (the Mark), shown below, on the basis of use in Canada since April of 2008.



[2] The Mark has been applied for in association with the following wares:

- (1) Alcoholic beverages, namely: beers and ales.
- (2) Clothing and uniforms, namely: shirts, tee-shirts, caps, hats, aprons, pants, sweatpants, skirts, ties and scarves, sweatshirts and sweaters.
- (3) Restaurant and public house service items and giftwares, souvenirs and mementoes, namely: place mats, cups, mugs, coasters, knives, napkins, beverage glassware, and vases, metal, ceramic and acrylic wine coolers, pens, sport bags, handbags, aprons, shirts, tee-shirts, caps, hats, aprons, pants, sweatpants, skirts, ties and scarves, sweatshirts and sweaters.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of January 19, 2011.

[4] Paramount International Export Ltd. (the Opponent) has opposed the application under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) on the grounds that: (i) it does not conform to the requirements of sections 30(b), 30(h) and 30(i) of the Act; (ii) the Applicant is not the person entitled to registration of the Mark under section 16(1)(a) of the Act, in view of the Opponent's prior use of the trade-marks FIJI and LIL FIJI in Canada, in association with "drinking water"; (iii) the Applicant is not the person entitled to registration of the Mark under section 16(1)(c) of the Act, in view of the Opponent's prior use in Canada of the trade-name FIJI; (iv) the Mark is not registrable under section 12(1)(d) of the Act, in view of the Opponent's registered FIJI trade-marks as set out in Schedule "A" attached hereto; and (v) the Mark is not distinctive within the meaning of section 2 of the Act.

[5] In support of its grounds of opposition, the Opponent has filed the declaration of David Ricanati, President of Fiji Water Company, sworn December 20, 2011.

[6] In support of its Application, the Applicant has filed the declaration of Bobby Naicker, President, Secretary and sole director of the Applicant, sworn May 18, 2012.

[7] Both of the parties filed written arguments.

[8] No hearing was held.

Onus

[9] The Applicant bears the legal onus of establishing on a balance of probabilities that its application complies with the requirements of the Act. However, there is an initial evidential 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 Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Grounds of Opposition Summarily Dismissed

[10] The Opponent has raised a number of grounds of opposition based upon section 30(b) of the Act. However, no evidence has been filed in support of any of these grounds and the Opponent has not made any submissions in this regard. The Opponent has therefore failed to meet its initial burden in relation to these grounds.

[11] The Opponent has alleged that contrary to section 30(h) of the Act, the trade-mark as used by the Applicant differs from the Mark which is shown in the application. However, no evidence has been filed in support of this ground of opposition and the Opponent has not made any submissions in this regard. Moreover, I note that section 30(h) simply requires an applicant to include a drawing of the trade-mark and such number of accurate representations as may be prescribed, unless the application is for a word or words not depicted in a special form. In view of this, it is doubtful that this ground of opposition has been properly pleaded.

[12] Section 30(i) of the Act requires an applicant to include a statement in the application that the applicant is satisfied that it is entitled to use the trade-mark in Canada. Where an applicant has provided the statement required by section 30(i), such a ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. The Applicant has provided the required statement and this is not an exceptional case.

[13] In view of the foregoing, the grounds of opposition raised under sections 30(b), 30(h) and 30(i) of the Act are summarily dismissed.

Analysis of Remaining Grounds of Opposition

Registrability - Section 12(1)(d) of the Act

[14] The Opponent has pleaded that the Mark is not registrable under section 12(1)(d) of the Act, in view of the Opponent's registered FIJI trade-marks as set out in Schedule "A" attached hereto.

[15] The material date to assess the section 12(1)(d) ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[16] Having exercised the Registrar's discretion, I confirm that each of the alleged registrations is extant in the name of Paramount International Export, Ltd. and so the Opponent has met its evidentiary burden. The issue is therefore whether the Applicant has satisfied its legal onus to show that the Mark is not reasonably likely to cause confusion with any of the Opponent's registered trade-marks.

[17] 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.

[18] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 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 the trade-marks have 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. [See *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion.]

[19] In its written submissions, the Opponent focused on the likelihood of confusion between the Mark and the trade-mark FIJI (registration No. TMA575,968). I shall do the same. If confusion is not likely between the Mark and the Opponent's registered trade-mark FIJI, then confusion would not be likely between the Mark and any of the Opponent's other registered trade-marks, as there is less of a resemblance between those trade-marks and the Mark. Thus,

comparing the Mark with the trade-mark FIJI will effectively decide the outcome of this ground of opposition.

Section 6(5)(a): the inherent distinctiveness of the trade-marks and the extent to which they have become known

[20] In its written submissions, the Opponent asserts that its trade-mark FIJI and the Mark are equally inherently distinctive. I disagree.

[21] The Opponent's trade-mark consists solely of the word FIJI, which is clearly a reference to the geographical origin of the Opponent's wares. Mr. Ricanati confirms this in his Affidavit and indicates that the front label of the Opponent's bottled drinking water states that the water is "from the islands of Fiji" [see paras 8-12, 20-21 and Exhibit "J"].

[22] Although the Mark also contains the word FIJI, it possesses further features, which in my view add some inherent distinctiveness to the Mark. In particular, it features a prominent banner and crest design with a large representation of what appears to be a rugby player or other large athletic figure carrying a ball. In addition to these more distinctive elements, the Mark also features the word "BLOND", which Mr. Naiker states in his affidavit is intended to convey that the Applicant's beer is a lighter tasting beer [see para 25]. Overall, I find that the Mark possesses a higher degree of inherent distinctiveness than the Opponent's trade-mark.

[23] A trade-mark may also acquire distinctiveness by means of it becoming known through promotion or use. In this case, the Applicant does not seem to dispute the acquired distinctiveness of the Opponent's trade-mark FIJI [see paras 25 and 26 of the Applicant's written submissions]. Mr. Ricanati's affidavit provides the following information regarding the Opponent and its use of its FIJI trade-mark in Canada:

- Mr. Ricanati is the President of Fiji Water Company LLC ("FIJI"), a company which markets, sells and distributes the Opponent's FIJI brand water in the United States [see para 1]. In Canada, the Opponent's FIJI brand water is distributed and sold by Fiji Water of Canada Ltd [see para 23]. The Opponent, as the owner of the FIJI trade-marks attached as Exhibit "F" to the Ricanati affidavit and referred to in Schedule "A" attached

hereto, exercises full control over the quality of the bottled water associated with its FIJI trade-marks.

- FIJI brand water is sold and continues to be sold through a number of stores in Canada, including, Wal-Mart, Overwaitea, Safeway, Sobey's, Western Grocers, A & P, Loblaws and others.
- Since 2004, in excess of 1.6 million cases of FIJI brand water have been sold in Canada to date (more than 520,000 cases had been sold as of the end of 2007).
- FIJI brand water is sold and continues to be sold throughout Canada. Gross sales in Canada for FIJI brand water since 2004 are in excess of \$26.9 million (between 2004 and the end of 2007, such revenues exceeded \$7 million).
- Since 2004, in excess of \$3 million dollars has been spent on the marketing and promotion of FIJI brand water in Canada (more than \$850,000 as of the end of 2007).

[24] In addition to the above information, Mr. Ricanati has provided a photograph of a bottle of water showing use of the Opponent's FIJI trade-mark, as well as invoices issued by Fiji Water of Canada Ltd to Canadian customers between January 2007 and September 2011 for the sale of FIJI brand water. Mr. Ricanati has also provided an extensive list of events which he indicates have been sponsored by FIJI in Canada. Although it isn't entirely clear from Mr. Ricanati's affidavit, the events appear to have been sponsored by Fiji Water Company LLC, the Opponent's distributor of FIJI brand products in the United States.

[25] Based upon the Opponent's evidence, I conclude that the Opponent's trade-mark FIJI has become quite well known in Canada, in association with drinking water.

[26] I note that Mr. Ricanati has also provided similar information regarding the Opponent's sales of its products and the use and promotion of its trade-mark in the United States. However, in view of my finding that the Opponent's FIJI trade-mark is quite well known in Canada, I do not consider it necessary to discuss this evidence in detail.

[27] The Mark has also become known in Canada, but to a much lesser extent than the Opponent's trade-mark. Mr. Naicker provides the following information regarding the Applicant and its use of the Mark in his affidavit:

- Mr. Naicker is the President, Secretary and sole director of the Applicant.
- The Applicant was incorporated on January 24, 2005 in the Province of British Columbia.
- The Applicant currently operates seven restaurants and public houses, all of which are located in the Province of British Columbia. The Applicant's establishments are promoted as establishments that combine elements of a sports bar with a family friendly atmosphere.
- The Applicant began selling its FIJI BLOND beer in April of 2008. Since the Applicant began selling its beer in 2008, in pints, jugs and glasses, the total number of kegs which have been consumed in its establishments have steadily increased each year, from 250 kegs in 2008 to 900 kegs in 2011. Total sales of the Applicant's FIJI BLOND beer in 2011 were in excess of \$125,000.
- The Applicant's FIJI BLOND beer is advertised in its establishments on its menus and on neon signs. The Applicant also advertises its FIJI BLOND beer through the support of rugby teams, tournaments and events, on its website and on FACEBOOK® and TWITTER®.

[28] Based upon the Applicant's evidence, I can conclude that the Mark has become known in Canada to some extent, particularly within the Province of British Columbia. However, overall, the evidence suggests that the Mark is not as well known as the Opponent's trade-mark in Canada.

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

[29] The Mark has been in use in Canada since April of 2008. The Opponent's registration No. TMA575,968 for its trade-mark FIJI, claims a July 1997 date of first use in Canada. While

the Opponent has not provided any evidence of use in Canada dating as far back as July of 1997, it has provided evidence of use dating back to 2004. Thus, I can conclude that the Opponent has used its trade-mark since at least 2004, if not longer. Accordingly, this factor favours the Opponent.

Sections 6(5)(c) and (d): the nature of the wares, services or business and the nature of the trade

[30] When considering sections 6(5)(c) and (d) of the Act, it is the statement of wares in the application for the Mark and the statement of wares in the Opponent's registration No. TMA575,968 for FIJI that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA) and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[31] The statement of wares in the Opponent's registration covers "drinking water". By contrast, the application for the Mark covers: alcoholic beverages, namely beers and ales; clothing and uniforms; and a variety of restaurant and public house service items, giftware, souvenirs and mementoes.

[32] The Opponent submits that the Applicant's beers and ales are "beverages" and that its remaining wares are all associated with the "beverages" which it sells. Since the Opponent's wares (drinking water) are also beverages, the Opponent submits that the parties' wares are quite similar. Although the Applicant doesn't disagree that both of the parties' wares are "beverages", it takes the position that there is a clear distinction between them.

[33] While it is true that the parties are both engaged in the sale of "beverages", I do not consider alcoholic beverages such as "beer" and the Opponent's "drinking water" to be in the same category or from the same industry. That being said, I am mindful of the fact that subsection 6(2) of the Act states that "the 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". [underlining added]

[34] With respect to the parties' channels of trade, the Applicant argues that there is no overlap. In this regard, the Applicant notes that the Applicant's beer is only sold through its own restaurants and that it can only be purchased in draft form and not in bottles or cans [see Naicker declaration, paras 9 and 10]. The Applicant asserts that its beer cannot be found in any markets, restaurants or public houses other than establishments owned and operated by the Applicant and that it has never sold bottled water in its establishments [see Naicker affidavit, para 11]. The Applicant further asserts that there is no evidence that the Opponent's water is sold at any public houses like those of the Applicant. The Applicant therefore contends that there is no overlap in the sale of the parties' wares in any retail outlets, restaurants, markets or public houses.

[35] I note that the application for the Mark does not contain any restrictions with respect to the markets for the distribution of the Applicant's wares. In the present state of affairs, it appears unlikely that the Applicant's wares would be carried in any of the same outlets as those of the Opponent. However, in attempting to establish confusion, it is not necessary to prove that the parties' wares are sold in the same outlets, as long as the parties are entitled to do so [see *Cartier Men's Shops Ltd v Cartier Inc* (1981), 58 CPR (2d) 68 (FCTD)].

Section 6(5)(e): the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them

[36] When considering the degree of resemblance between two trade-marks, the law is clear that they must be considered in their totality. Furthermore, it is not correct to lay the trade-marks side by side to compare and observe the similarities or differences between them. The test for confusion is one of first impression and imperfect recollection.

[37] In *Masterpiece, supra*, the Supreme Court of Canada discusses the importance of the degree of resemblance between trade-marks in conducting an analysis of the likelihood of confusion. In the reasons for judgment, Mr. Justice Rothstein states at paragraph 49:

[...] the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis [...] 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 [...].

[38] In his discussion of the approach to take in assessing the degree of resemblance between trade-marks, Mr. Justice Rothstein states, at paragraph 64: “While the first word may, for the purposes of distinctiveness, be the most important in some cases, I think the preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique.”

[39] I am of the view that the words FIJI and BLOND in the Mark are not particularly striking or unique. Rather, I find that the banner and crest design featuring a large representation of a rugby player forms the more dominant or unique part of the Mark. In my view, the combination of the words FIJI BLOND and the design features of the Mark create an overall visual impression which serves to distinguish the Mark from the Opponent’s trade- mark FIJI.

[40] The marks also differ in terms of sound. In this regard, I note that the word FIJI in the Mark does not stand alone. It is followed by the word BLOND. Thus, consumers would be likely to pronounce these words in combination upon seeing the Mark.

[41] In my view, the ideas suggested by the marks in question also differ. The presence of the word BLOND, which may be considered to be a descriptive reference to a type of beer and the representation of the rugby player make the Mark suggestive of “beer” and “sports”, whereas the idea suggested by the Opponent’s trade-mark FIJI can only be that of the geographic origin of the Opponent’s wares.

Conclusion on the likelihood of confusion

[42] In applying the test for confusion, I have considered the parties’ marks as a matter of first impression and imperfect recollection. Even though my assessment of the circumstances of this case leads me to conclude that more of the section 6(5) factors favour the Opponent, in my opinion the differences between the Mark and the Opponent’s trade-mark FIJI in appearance, sound and in the ideas suggested by them are significant enough to shift the balance of probabilities in favour of the Applicant. Hence, I conclude that the Applicant has discharged the legal onus resting upon it to show that confusion between the Mark and the Opponent’s trade-mark FIJI, which is the subject of registration No. TMA575,968 is not likely. Further, as I

previously indicated, I find that comparing the Mark with the Opponent's trade-mark FIJI of registration No. TMA575,968 effectively decides the outcome of this ground of opposition.

[43] The section 12(1)(d) ground of opposition is therefore dismissed.

Non-entitlement under Section 16(1)(a) of the Act

[44] The Opponent has pleaded that the Mark is confusing with its trade-marks FIJI and LIL FIJI, which had been previously used in Canada in association with "drinking water".

[45] There is an initial burden upon the Opponent to prove that one or both of these trade-marks were used in Canada prior to the Applicant's claimed date of first use and had not been abandoned at the date of advertisement of the application for the Mark [section 16(5) of the Act].

[46] Once again, I find that comparing the Mark with the trade-mark FIJI will effectively decide this ground of opposition. Thus, I find it unnecessary to consider whether the Opponent has discharged its evidentiary burden to establish prior use of its alleged trade-mark LIL FIJI.

[47] I am satisfied that the Opponent has discharged its evidentiary burden to show prior use and non-abandonment of its trade-mark FIJI. However, assessing each of the section 6(5) factors as of April 30, 2008, rather than as of today's date, does not significantly impact my previous analysis of the surrounding circumstances of this case.

[48] Accordingly, the section 16(1)(a) ground of opposition is dismissed for reasons similar to those expressed in relation to the section 12(1)(d) ground of opposition.

Non-entitlement under Section 16(1)(c) of the Act

[49] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark in view of its trade-name FIJI, which had been previously used in Canada by the Opponent or a predecessor.

[50] There is an initial burden on the Opponent to evidence use of its trade-name prior to the Applicant's claimed date of first use and to demonstrate that it had not abandoned its trade-name as of the date of advertisement of the Applicant's application [section 16(5)]. I note that the

Ricanati affidavit makes reference to the Opponent (Paramount International Export Ltd.) and two other entities, namely, Fiji Water Company LLC and Fiji Water of Canada Ltd, which are identified as being distributors of the FIJI brand water in the United States and Canada, respectively. Any references to use of FIJI, *per se*, in the Ricanati affidavit appear to be references to use of FIJI as a trade-mark, rather than a trade-name.

[51] In any event, even if the evidence, as introduced by Mr. Ricanati was sufficient to enable the Opponent to discharge its evidentiary burden under the section 16(1)(c) ground of opposition, this ground of opposition can be dismissed for reasons similar to those expressed under the previous grounds of opposition based upon confusion with the Mark and the Opponent's trade-mark FIJI.

Non-distinctiveness

[52] The Opponent has pleaded that the Mark does not distinguish and is not adapted to distinguish the wares of the Applicant from the wares or services of others, including those of the Opponent. In addition, the Opponent has alleged that the Mark has been used outside the scope of section 50 of the Act by other entities, including, Lighthouse Brewing Company and that the Mark is solely functional or merely decorative.

[53] The material date to assess this ground of opposition is the filing date of the statement of opposition, namely, June 16, 2011 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[54] I am satisfied that the Opponent has met its evidentiary burden to establish that its mark FIJI had become known sufficiently in Canada as of June 16, 2011, to negate the distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)]. As I find that comparing the Mark with the mark FIJI will effectively decide the outcome of this ground of opposition, it is not necessary to consider whether the Opponent has discharged its evidentiary burden for any of its other alleged trade-marks or its alleged trade-name.

[55] However, assessing each of the section 6(5) factors as of June 16, 2011 does not significantly impact my analysis of the surrounding circumstances of this case. For reasons similar to those previously expressed, I am satisfied that the Applicant has discharged the legal onus resting upon it to show that, as of June 16, 2011, the Mark was not reasonably likely to cause confusion with the Opponent's mark FIJI. In view of this, I am satisfied that as of the material date, the Mark distinguished or was adapted to distinguish the wares of the Applicant from those of the Opponent.

[56] With respect to the remaining pleadings which have been made by the Opponent under the non-distinctiveness ground in the statement of opposition, I note that no evidence has been filed in support of these pleadings and the Opponent has not made any submissions in relation to these pleadings. I therefore do not find it necessary to provide any further analysis in this regard.




[57] In view of the foregoing, the non-distinctiveness ground of opposition is dismissed.



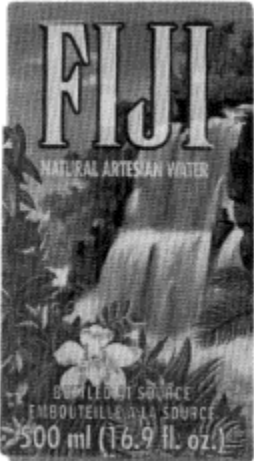
Disposition


[58] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Lisa Reynolds
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule "A"

Trade-mark	Registration No.	Wares
	TMA574,651	DRINKING WATER
FIJI	TMA575,968	DRINKING WATER
	TMA684,399	DRINKING WATER
	TMA686,221	DRINKING WATER

	<p>TMA685,472</p>	<p>DRINKING WATER</p>
	<p>TMA686,220</p>	<p>DRINKING WATER</p>
	<p>TMA574,435</p>	<p>DRINKING WATER</p>

LIL FIJI	TMA751,691	DRINKING WATER
	TMA751,692	DRINKING WATER