

**IN THE MATTER OF AN OPPOSITION by
Classical Remedia Ltd. against application No.
1,299,303 for the trade-mark TOCHA TEA in
the name of 1404568 Ontario Limited**

[1] On April 26, 2006, 1404568 Ontario Limited (the Applicant), filed an application to register the trade-mark TOCHA TEA (the Mark). The application is based upon proposed use in Canada in association with the following wares, as revised: “teas, herbal teas and non-alcoholic tea beverages.” The right to the exclusive use of the word TEA was disclaimed apart from the trade-mark.

[2] The application was advertised for opposition purposes in the Trade-marks Journal of August 15, 2007. On October 15, 2007, Classical Remedia Ltd. (the “Opponent”) filed a statement of opposition. The Opponent pleaded grounds of opposition under s. 38(2)(a), s. 38(2)(b), s. 38(2)(c) and s. 38(2)(d) of the Act. The Applicant filed and served a counter statement.

[3] In support of its opposition, the Opponent filed a certified copy of registration No. TMA 490,988 for the trade-mark THÉ TUOCHA TEA & Design (shown below). In support of its application, the Applicant filed the affidavit of Richard Ottenhoff.



[4] Mr. Ottenhoff is the President of the Applicant, which operates as Multatuli Coffee Merchants. His company started selling TOCHA TEA about February 9, 2007, and sales since that time have been in excess of \$23,000. Invoices have been provided to evidence the sales

from the Applicant to its customers. The Applicant's TOCHA TEA wares are sold in Canada through various retail outlets such as grocery stores, department stores, bakeries and tea rooms and by schools as fundraisers.

[5] Attached as Exhibit A to Mr. Ottenhoff's affidavit is an envelope showing how the Mark appears on the product in Canada. Attached as Exhibit B to his affidavit is an envelope containing specimens of promotional items, including postcards, which have been given to prospective customers and retailers since February, 2007. He notes that over 250 postcards have been mailed to prospective customers in Canada since February, 2007. An advertisement for the Applicant's TOCHA TEA that appeared in www.IndependentVoice.ca, a newspaper distributed in the Kingston area, was attached to his affidavit as Exhibit E.

[6] Only the Opponent filed a written argument. An oral hearing was not held.

Onus and Material Dates

[7] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (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 C.P.R. (3d) 293 (F.C.T.D.) at 298].

[8] 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(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.T.D.)].

Section 30(e) Ground

[9] The Opponent asserted that the Applicant does not intend to use the Mark, nor license its use, in association with the wares set out in the application. No evidence or argument has been furnished by the Opponent to show that the Applicant, as of the filing date of the present application, did not intend to use the Mark in association with the wares set out in the application. Further, there is nothing in the Applicant's evidence which is clearly inconsistent with its claim that it intended to use the Mark in association with the applied for wares. The s. 30(e) ground is therefore unsuccessful.

Section 30(i) Ground

[10] The requirement under s. 30(i) of the Act is to include, in the application, a statement that the Applicant is satisfied that it is entitled to use the mark in Canada in association with the wares. Such a statement has been provided in the applicant's application. 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.

Remaining Grounds of Opposition

[11] Each of the remaining grounds of opposition is premised on the allegation that the Mark is likely to cause confusion with the Opponent's THÉ TUOCHA TEA & Design mark, registered

for “tea”. With respect to the s. 12(1)(d) ground, the Opponent’s initial burden has been met by proof of the existence of the pleaded registration.

[12] With respect to the entitlement ground, there is an initial burden on the Opponent to show use of its trade-mark in Canada prior to the filing date of the application. With respect to distinctiveness ground, the Opponent has an initial evidential burden to show that, as of the filing of its statement of opposition, its trade-mark had become known sufficiently to negate the distinctiveness of the applied for mark see [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.) at 58]. Where an opponent only files a certified copy of its registration, the Registrar will assume only *de minimus* use of the opponent’s trade-mark [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.)]. Therefore, the mere filing of a certified copy of an Opponent’s registration does not support the Opponent’s evidential burden with respect to the grounds of opposition based on allegations of non-entitlement or non-distinctiveness. Accordingly, both the entitlement and distinctiveness grounds of opposition fail.

[13] I need therefore only address the likelihood of confusion with respect to the registrability ground of opposition.

the test for confusion

[14] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; b) the length of time each has been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks or

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

[15] 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.

[16] Although both the Opponent's mark and the Mark have some degree of inherent distinctiveness, neither mark is inherently strong given that both marks describe the wares in association with which they are used.

[17] The extent to which each mark has become known in Canada slightly favours the Applicant. In this regard, the Opponent's registration indicates that the Opponent filed a declaration of use with respect to its trade-mark on February 20, 1998, but there is no evidence that use of the Opponent's mark has continued since that date. The Applicant, on the other hand, has shown some use and advertising of the Mark since February 9, 2007.

[18] With respect to the nature of the wares, the Opponent's mark is registered for tea and the applied for wares are teas, herbal teas and non-alcoholic tea beverages. The Mark is therefore intended for use in association with wares which are identical to those of the Opponent. The channels of trade would therefore also be the same.

[19] There is a quite a bit of resemblance between the marks in appearance and ideas suggested. In this regard, the first component of the Mark is the word TOCHA, which is almost identical to the dominant component of the Opponent's mark which is the word TOUCHA. Since both parties' marks also include the word "tea" and or its French equivalent "thé", both marks suggest a type of tea.

[20] The issue is whether a consumer who has a general and not precise recollection of the Opponent's mark, will, upon seeing the Applicant's mark, be likely to think that the related wares share a common source. Having considered all of the surrounding circumstances, I am not satisfied that the Applicant has met its burden to show that there would not be a reasonable likelihood of confusion between the marks as of today's date. I reach this conclusion based on the fact that the parties' wares are identical and the marks are very similar. The s. 12(1)(d) ground of opposition is therefore successful.

Disposition

[21] 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.

DATED AT Gatineau, Quebec, THIS 28th DAY OF January, 2010.

C.R. Folz
Member,
Trade-marks Opposition Board