

IN THE MATTER OF AN OPPOSITION
by Leaf, Inc. to application
No. 556,530 for the trade-mark
ICE 'N FRUITY filed by 329985
Ontario Ltd., doing business
as Kisco Products

On January 31, 1986, the applicant, 329985 Ontario Ltd., doing business as Kisco Products, filed an application to register the trade-mark ICE 'N FRUITY based on proposed use in Canada for the following wares:

carbonated and non-carbonated beverages
containing fruit juice; desserts, namely,
freezable confections.

The application was amended to include a disclaimer to the word FRUITY and was subsequently advertised for opposition purposes on October 8, 1986.

The opponent, Leaf, Inc., filed a statement of opposition on May 25, 1987, a copy of which was forwarded to the applicant on July 6, 1987. The first ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16 of the Trade-marks Act because, as of the applicant's filing date, the applied for trade-mark was confusing with the trade-mark ICE 'N CREAMY previously used in Canada by the opponent for "confectionery products." The second ground is that the applicant's mark is not distinctive because it is confusing with the opponent's mark.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavit of Allister Scorgie. The applicant filed the affidavit of Darra May. Both parties filed written arguments and an oral hearing was conducted at which both parties were represented.

As for the opponent's first ground of opposition, there was an evidential burden on the opponent to establish use of its trade-mark prior to the applicant's filing date. Although the Scorgie affidavit makes reference to sales of ICE 'N CREAMY freeze pops in Canada in 1986, he does not establish when in 1986 such sales commenced. Thus, the opponent has failed to evidence prior use of its trade-mark and the first ground of opposition is therefore unsuccessful.

As for the second ground, the material time for considering the circumstances respecting the issue of non-distinctiveness is as of the filing of the opposition. Furthermore, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada. There is, however, a burden on the opponent to evidence the allegations of fact underlying its ground.

The opponent has alleged that the applicant's mark is not distinctive because it is confusing with the opponent's mark. In applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

The applicant's mark ICE 'N FRUITY is inherently distinctive although it is inherently weak. The applicant has partially acknowledged this by entering a disclaimer to the word FRUITY. The word ICE is arguably suggestive of the nature of "freezable

confections" and also suggests a manner of serving the "beverages" listed in the application. Thus, the applicant's mark, as a whole, is highly suggestive of the character of the applied for wares. There being no evidence of use or advertising of the applicant's mark, I must conclude that it had not become known at all in Canada as of the material time.

The opponent's mark ICE 'N CREAMY is also inherently distinctive although it, too, is inherently weak. The word ICE is disclaimed in the opponent's registration No. 332,419 for its mark (see Exhibit A to the Scorgie affidavit) and the word CREAMY is at least suggestive of the character or quality of the opponent's wares. The Scorgie affidavit evidences fairly significant sales by the opponent's eventual registered user Leaf Confections Limited throughout Canada for both 1986 and 1987. Since the use of the mark by Leaf Confections Limited was prior to its registration as a registered user, it does not constitute use of the mark by the opponent. Thus, such use did not result in the trade-mark ICE 'N CREAMY acquiring any reputation in the hands of the opponent as of the material time.

The wares of the parties are similar and in respect of the applicant's wares "freezable confections" they would appear to be virtually identical. Paragraph 14. of the applicant's written argument reads, in part, as follows:

...there is little if any significant
difference in the general class of good
sold by the applicant and the opponent.

Presumably the trades of the parties would also be similar and the applicant has also acknowledged this in paragraph 16. of its written argument.

At the oral hearing, the agent for the applicant submitted that the exhibits to the Scorgie affidavit show use of the trade-mark ICE 'N CREAMY in association with a product called a "pudding bar" and that such a product is different from the wares set forth in the opponent's registration, namely "freeze pops." However, I agree with the opponent's agent's submission that Mr. Scorgie has identified the product as a "freeze pop" and it would appear that "pudding bar" is merely a description of a particular type of "freeze pop." The distinction submitted by the applicant's agent is irrelevant, in any event, since the opponent's ground of non-distinctiveness refers to use of the mark ICE 'N CREAMY in association with "confectionary products" which is a broader description.

As for Section 6(5) (e) of the Act, there is a fair degree of resemblance between the marks visually, phonetically and in the ideas suggested. Both marks commence with the word ICE followed by the contraction 'N. In both cases, the phrase ICE 'N is followed by a two syllable word ending in the letter "y" which describes or strongly suggests a character or quality of an edible product.

The applicant submits that the state of the trade-marks register as evidenced by the May affidavit mitigates the effect of any similarity between the marks. I do not agree. For example, apart from the opponent's registration, Ms. May was only able to locate two trade-marks incorporating the word CREAMY (or its phonetic equivalent) registered for frozen confections or the like. Apart from the opponent's registration, she was only able to locate six trade-marks incorporating the word ICE registered for similar wares. In the absence of evidence of use of these third party marks, I am unable

to make any meaningful inferences about the possible common adoption of such marks by other traders in the marketplace.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the similarities between the wares, trades and marks of the parties, I find that the two marks are confusing. The applicant has therefore failed to satisfy its onus of showing that its mark is distinctive. The second ground of opposition is therefore successful.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 31st DAY OF December, 1990.

David J. Martin,
Member,
Trade Marks Opposition Board.