



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

Citation: 2018 TMOB 57

Date of Decision: 2018-06-06

IN THE MATTER OF AN OPPOSITION

A. Lassonde Inc.

Opponent

and

Niagara Bottling, LLC

Applicant

1,610,964 for NIAGARA

Application

INTRODUCTION

[1] A. Lassonde Inc. (the Opponent) opposes registration of the trade-mark NIAGARA (the Mark), filed by Niagara Bottling, LLC (the Applicant).

[2] For the reasons that follow, I refuse the application.

THE RECORD

[3] On January 23, 2013 the Applicant filed the application bearing serial No. 1,610,964 for the registration of the Mark. The application covers:

Bottled drinking water; bottled water; distilled drinking water; drinking water; drinking water with vitamins; drinking waters; flavored bottled water; flavored enhanced water;

flavored waters; purified bottled drinking water; spring water; still water; table water; water beverages (the Goods).

[4] The application is based on use and registration on January 14, 2014 in the United States of America and was published on August 20, 2014 in the *Trade-marks Journal* for the purposes of opposition.

[5] On April 20, 2015 the Opponent filed a statement of opposition which was forwarded to the Applicant by the Registrar on May 5, 2015. The grounds of opposition pleaded are based on sections 30(a) and (d) (compliance), 16(2)(a) (entitlement) and 2 (distinctiveness) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[6] The Applicant filed a counter statement on December 4, 2015 denying each ground of opposition pleaded.

[7] The Opponent filed as its evidence the affidavit of Mathieu Houle, sworn on March 31, 2016 together with Exhibits MH-1 to MH-4.

[8] The Applicant filed as its evidence the affidavits of Jennifer Leah Stecyk, sworn December 8, 2016 together with Exhibit A and of Janelle Granger sworn on December 14, 2016 to which were attached Exhibits A to F.

[9] Both parties filed written arguments and were represented at the hearing.

EVIDENTIARY BURDEN

[10] The legal onus is on the applicant to show that the application complies with the provisions 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. Once this initial burden is met, the applicant has to prove, on a balance of probabilities, that the particular ground of opposition should not prevent the registration of the Mark [see *Joseph E Seagram & Sons Ltd et al v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB), *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD), and *Wrangler Apparel Corp v The Timberland Company* [2005] FCJ No 899, (FC)].

PRELIMINARY REMARKS

[11] In reaching my decision I have considered all the evidence in the file. However, I shall refer only to those portions of the evidence which are directly relevant to the issues discussed in the body of my decision.

ENTITLEMENT GROUND OF OPPOSITION

[12] I reproduce the ground of opposition as pleaded by the Opponent in its statement of opposition:

L'Opposante fonde également son opposition sur les dispositions de l'article 38(2)(c) en ce que la Requérante n'est pas la personne ayant droit à l'enregistrement de la Marque en vertu des dispositions de l'article 16(2)(a) puisqu'à la date de production de la demande d'enregistrement, soit le 23 janvier 2013, la Marque créait de la confusion avec la marque NIAGARA, antérieurement employée au Canada par l'Opposante ou tout concédant de licence, le cas échéant, et qui n'a pas été abandonnée depuis, en liaison avec les marchandises «fruit juice cocktails packaged and sold in shelf-stable ready-to-drink containers» et avec les marchandises «frozen concentrated citrus fruit juices».

[13] For the ground of opposition based on section 16(2) of the Act, the relevant date is the filing date of the application (January 23, 2013) [see section 16(2) of the Act].

[14] In order to succeed under this ground of opposition, the Opponent must establish first that it has used its trade-mark NIAGARA prior to January 23, 2013 in association with fruit juices-based drinks and frozen concentrated fruit juices, as pleaded in its statement of opposition, and that it had not abandoned such use at the advertisement date of the present application (August 20, 2014) [see section 16(5) of the Act]. I shall therefore review the Opponent's evidence on its use of the trade-mark NIAGARA.

The Opponent's evidence

[15] Mr. Houle is the Opponent's Vice-President Marketing since January 2015. Previously, he occupied various positions for Vins Arista, a division of the Opponent. He states having good knowledge of the Opponent's activities because of his functions with the Opponent. He adds having personal knowledge of the facts alleged in his affidavit or that he consulted personally the Opponent's books and records for the purpose of his affidavit.

[16] Mr. Houle explains that the Opponent is a subsidiary of Industries Lassonde Inc. and manufactures and sells food products, including juices and fruit drinks under various trade-marks, including the trade-mark NIAGARA.

[17] Mr. Houle states that by agreement dated November 2, 2007, McCain Foods Limited (McCain) granted the Opponent an exclusive license to use in Canada the trade-marks NIAGARA and NIAGARA & Design in association with fruit juices and fruit juices with vitamins and/or minerals packaged and sold in shelf-stable ready-to-drink containers as well as in association with additional fruit juices, fruit juice-based drinks and punches made from fruit juices, subject to McCain's written approval. Mr. Houle filed a copy of that license as Exhibit MH-1 to his affidavit.

[18] Mr. Houle states that the trade-mark NIAGARA has been used by the Opponent in Canada since 2007 in association with fruit drinks, manufactured by the Opponent. The Opponent affixes the mark NIAGARA directly on the packaging of the products that it manufactures, being laminated carton containers of one litre sold on shelves. He attached, as Exhibit MH-2, photographs of past and current packaging bearing the trade-mark NIAGARA.

[19] For sake of reference, I reproduce the different packaging used by the Opponent since 2007:



(used until 2009)

(used 2009-2012))

(used since 2012)

[20] Mr. Houle states that the goods manufactured by the Opponent in association with the trade-mark NIAGARA are sold to Canadian consumers at the retail level through supermarkets and drug stores for example. They are either sold directly by the Opponent to those supermarkets and drug stores or to distributors in Canada, who in turn sell them to those retailers.

[21] In order to prove use of the mark NIAGARA in Canada by the Opponent, Mr. Houle attached, as Exhibit MH-3, samples of invoices, issued between 2009 and 2015, for the sale of fruit drinks in association with the trade-mark NIAGARA.

[22] Mr. Houle provides the number of crates sold in Canada by the Opponent of fruit juices bearing the trade-mark NIAGARA for the years 2012, 2013, 2014 and 2015. Each crate contains 12 containers of 1 litre each. From 2007 to 2014 inclusive, the Opponent sold 406,341 crates of fruit drinks in association with the trade-mark NIAGARA.

[23] Mr. Houle states that sales were made to, amongst other, Buy Low Foods, Northwest Company, Pratts Ltd and Safeway.

The Applicant's evidence on the alleged abandonment of the use of the trade-mark NIAGARA by the Opponent

[24] The Applicant argues that the Opponent has abandoned the use of the trade-mark NIAGARA. To support such contention, the Applicant relies on portions of the affidavit of Ms. Granger detailed hereinafter.

[25] Ms. Granger has been the Associate Corporate Counsel of the Applicant and has worked for the Applicant in various positions since June 1, 2010. She annexed as exhibit D to her affidavit, printouts obtained from the Online Canadian Trade-marks database of particulars of the now-expunged registrations, for failure to renew, owned by McCain for the word mark NIAGARA, registration TMA277,381 and NIAGARA & Design mark, registration TMA277,382.

[26] Ms. Granger annexed, as Exhibit F to her affidavit, a printout of the results of a Whois search for the domain name *niagaracocktail.ca*. Industries Lassonde Inc is shown in the search

results as the registrant for that domain name. It also shows that, as of November 17, 2015, the person visiting such domain name was redirected to the website *www.lassonde.com*.

The Applicant's arguments on non-use of the word mark NIAGARA

[27] The Applicant argues that the Opponent relies on a word mark while the evidence in the record shows that the Opponent has been using various NIAGARA & Design trade-marks, all of them having been abandoned except for the last one which has been used only since 2012. The Applicant takes the position that such use would not be sufficient to support a ground of opposition under section 16 of the Act. Moreover, the Applicant submits, in some of the earlier versions of the trade-mark NIAGARA & Design used by the Opponent, the word NIAGARA is written in smaller script than the description of the product (for example "apple juice") and the design portion would be at least as dominant as the word NIAGARA.

[28] The Applicant adds that, if the Opponent has established use of the trade-mark NIAGARA & Design, it would be only in association with fruit juice-based drinks as there is no evidence of sales of frozen concentrated fruit juices.

The Applicant's arguments on the abandonment of the use of the trade-mark NIAGARA

[29] The Applicant argues that the registrations owned by McCain for the trade-marks NIAGARA and NIAGARA & Design have been expunged, as described above.

[30] The Applicant contends that the sales figures provided by Mr. Houle show that there has been a drastic decrease in sales volume when comparing 2012 (approximately 32,000 cases) to the figures for 2015 (just over 3,500 cases).

[31] Finally, the Applicant relies on the portion of the evidence that shows there is no activity at the domain name *niagaracocktails.ca*.

[32] The combination of all these facts, pleads the Applicant, leads to a conclusion that the Opponent has abandoned the use of the trade-mark NIAGARA. Consequently, the Opponent would have failed to meet its initial burden and, as such, the ground of opposition based on section 16(2) of the Act should be dismissed.

Disposal of the Applicant's arguments

Expungement of the McCain's registrations

[33] I will first dispose of the argument regarding the expungement of the registrations for the trade-marks NIAGARA and NIAGARA & Design previously owned by the Opponent's licensor.

[34] The Opponent has not relied on the registrations of its licensor. The fact that McCain's registrations for the trade-marks NIAGARA and NIAGARA & Design have been expunged on October 17, 2013, after the relevant date, for failure to renew them does not have an impact on the ground of opposition based on section 16(2) of the Act. The Opponent alleges and relies on its prior licensed use of the mark NIAGARA under this ground of opposition. In fact, the Opponent's evidence, described previously, does establish use of the trade-mark NIAGARA in association with fruit cocktails.

Use of various NIAGARA & Design trade-marks

[35] It has been held that the owner of the registration of a word mark can rely on its use even with the addition of a particular design portion [see for example *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB); *Jaguar Cars Ltd v Remo Imports Ltd* (1998), 2 CPR 557 (TMOB); and *Body Shop International Plc v Lander Co Canada Ltd*, 1999 CarswellNat 3431 (TMOB)].

[36] Those cases dealt with a registered trade-mark. At the hearing, I asked the agent for the Applicant if he was aware of any case law that would support a contention that such proposition would not be applicable to a common law word mark. He was not aware of any, and neither am I.

[37] The agent for the Opponent pointed out that in *Les Marques Metro/Metro Brands sene v Julia Wine Inc* 2014 TMOB 230, the opponent was relying on common law trade-marks. The evidence showed use by the opponent of variants of the common law word marks relied upon. The Registrar referred to the principle enunciated in *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) and concluded that such

variants did constitute use of the common law word trade-marks relied upon by the opponent. Therefore, it would appear that the concept of use of a common law word mark does not differ from the concept of use of a registered word trade-mark.

[38] On each of the packaging reproduced above, the word NIAGARA is an element of the trade-mark appearing on the packaging, and in most instances, it is a dominant portion of the trade-mark used. The other words appearing on the packaging are descriptive or laudatory of the product (for example “apple beverage”, “Apple Cocktail”, “Superior Taste”, etc.).

[39] Moreover, on the most two recent NIAGARA & citrus designs marks, the word NIAGARA is followed by the symbol «MD», standing for «marque déposée» (translated in English by “registered mark”) suggesting that the word NIAGARA is the mark. The citrus design is above the word portion and the other word element (Mélanges tree house) is written on a third separate line, inside a ribbon. In the latest version, the citrus design is appearing above the word NIAGARA. Such word is also followed by the inscription «MD». The word NIAGARA is written inside a ribbon and the laudatory words are written on a third separate line in a different colour and script.

[40] I do not think the mark NIAGARA has lost its identity with the addition of the citrus designs and descriptive or laudatory terms as illustrated above.

[41] In all, I consider these three packaging to constitute evidence of use of the trade-mark NIAGARA [see *CPSA Sales institute v Groupe Conseil Parisella Vincelli Associés Inc*, 2005 CarswellNat 2788 (TMOB)].

Decrease in the Opponent’s sales figures

[42] The fact that the sales figures have drastically dropped in 2015 does not negate the fact that the Opponent has established use of its mark NIAGARA prior to January 23, 2013 and had not abandoned such use at the advertisement date of the present application (August 20, 2014 [see section 16(5) of the Act]). The decrease in sales volume occurred after the relevant date, and in any event, there is evidence of sales in 2015. Therefore, there was no abandonment in 2015 of the mark NIAGARA by the Opponent.

No evidence of use of the word mark NIAGARA in association with frozen concentrated fruit juices

[43] At the hearing, the agent for the Opponent admitted that there is no evidence in the record of use of the mark NIAGARA in association with frozen concentrated fruit juices. However, as concluded previously, there is evidence of use of that mark in association with fruit juice-based drinks.

[44] The fact that the Opponent may not have established use of its mark in connection with all of the alleged goods, does not preclude it from succeeding in this opposition. It can meet its burden by relying upon rights arising out of its use in association with some of its goods.

No activity at the domain name niagaracocktails.ca

[45] The evidence shows that any person who visits this address is redirected to another address. Firstly, the information about the redirection to another address is dated November 17, 2015, which is after the relevant date. There is no evidence that the redirection to another address occurred prior to the relevant date. Moreover, there is no evidence in the record that there is no reference to the trade-mark NIAGARA in association with fruit drinks at this redirected address. Finally, I do not consider evidence of redirection to another address in and of itself to be sufficient to establish abandonment of use of the trade-mark NIAGARA by the Opponent.

The Opponent's initial burden met

[46] The Opponent has met its initial burden to establish use of its trade-mark NIAGARA in association with fruit juice-based drinks since at least 2009. I am referring to 2009 as there is no evidence of transfer of property of fruit-based drinks in association with the mark NIAGARA prior to that year. There is a bald statement of use of the mark NIAGARA since 2007 made by Mr. Houle, but it does not constitute evidence of use of such mark since that date, within the meaning of section 4(1) of the Act.

[47] The Opponent has pointed out that Mr. Houle provided the sales figures for the period of 2007 to 2014 inclusive and the yearly sales figures from 2012 to 2014 of fruit-based drinks of the Opponent in association with the mark NIAGARA. The Opponent suggested that I could

subtract, from the total sales figures, the yearly sales figures for the years 2012, 2013, 2014 and 2015. The difference would represent the total sales for the period of 2007 to 2011 inclusive. However, even in doing so, all of those sales could have been made in 2011, for example.

[48] In any event, the Opponent had to establish use of its mark NIAGARA prior to the relevant date namely, January 23, 2013, which it did.

The analysis of the likelihood of confusion between the parties' marks

[49] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trade-marks are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks or trade names have been in use; the nature of the goods, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC), *Mattel Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 96 CPR (4th) 361 (SCC)].

[50] The test under section 6(2) of the Act does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether a consumer, with an imperfect recollection of the Opponent's trade-mark NIAGARA, who sees the Applicant's Goods in association with the Mark, would think they emanate from, or are sponsored by, or approved by the Opponent.

Degree of resemblance

[51] As indicated by the Supreme Court of Canada in *Masterpiece*, in most instances, the degree of resemblance between the marks in issue is the most important relevant factor. Therefore, I shall start my analysis of the relevant criteria with this one.

[52] In the present case, the marks in issue are identical.

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

[53] The Applicant argues that the Mark has a high degree of inherent distinctiveness because the word “Niagara” has no meaning in relation to, or inherent connection with, any of the Goods. However, it could be considered as suggestive of the origin of the Goods, namely coming from the Niagara region.

[54] The Applicant further argues that the fruit design portion of the trade-mark NIAGARA & Design makes such mark suggestive of fruit cocktails.

[55] Again, the Applicant is focusing on the design portion of the marks used by the Opponent. However, the Opponent relies on the use of its mark NIAGARA which is identical to the Mark. I already determined that the three packaging illustrated above constitute evidence of use of the mark NIAGARA.

[56] Consequently, the parties’ marks have the same degree of inherent distinctiveness.

[57] The degree of distinctiveness of a trade-mark can be enhanced through use and promotion in Canada. I have already described the evidence of use of the Opponent’s mark NIAGARA in Canada since at least 2009.

[58] The evidence of alleged use of the Mark is contained in Ms. Granger’s affidavit. She states that she has personal knowledge of the Applicant’s activities with respect to the manufacture, sale, distribution and marketing of its bottled water products. She first provides some historical facts concerning the Applicant which are less relevant for these proceedings.

[59] Ms. Granger states that the Applicant manufactures and sells bottled water products under both private labels for third parties as well as under its NIAGARA brand. They are all produced at production facilities operated by the Applicant located throughout the United States.

[60] Ms. Granger alleges that the Applicant began selling and distributing bottled water products under NIAGARA brand in the United States since 1963. It includes flat and carbonated bottled water and carbonated flavoured water.

[61] Ms. Granger alleges that, since 1963, the Mark has been displayed on the labels of, and packaging of, the Applicant's various bottled water products. Depending on the bottle size, the products have been sold and distributed to customers in various pack sizes.

[62] Ms. Granger attached, as Exhibit A to her affidavit, representative examples of how the Mark has appeared on product labels and packaging.

[63] Ms. Granger attached, as Exhibit B to her affidavit, a copy of the Applicant's US registration for the Mark, obtained on January 14, 2014.

[64] Ms. Granger alleges that, in the United States, the Applicant has been selling and distributing its various bottled water products in association with the Mark to a variety of retailers, both directly and through food and beverage brokers.

[65] I note that nowhere in her affidavit did Ms. Granger describe any activities that would constitute use or promotion of the Mark in Canada in association with the Goods within the meaning of section 4 of the Act.

[66] From the evidence described above, I conclude that this factor also favours the Opponent.

Length of time the marks have been in use

[67] The Applicant argues that the last NIAGARA & Design mark has been used by the Opponent since 2012 and therefore there would be only a period of one year of use of that mark. As discussed earlier, the use of any of the NIAGARA & Design marks appearing on the Opponent's packaging constitutes use of the mark NIAGARA. There is evidence of such use going back to at least 2009. On the other hand, there is no evidence of use of the Mark in Canada in association with any of the Goods.

[68] This factor favours again the Opponent.

Nature of the goods and the parties' channels of trade

[69] The Applicant argues that, on one hand the Applicant's Goods are generally flat/still water and carbonated water that are colourless in appearance and sold in bottles, while the Opponent's goods are fruit cocktails sold in 1-litre laminated cardboard shelf-stable containers. The Applicant contends that those distinctions in the nature of the parties' goods and their containers would be sufficient to conclude in favour of the Applicant.

[70] With all due respect, I disagree. The parties' respective goods are beverages aimed to quench one's thirst. Moreover, the Goods include "flavored bottled water, flavored enhanced water and flavored water". Exhibit A to Ms. Granger's affidavit is a grouping of pictures of the containers of some of the Applicant's Goods. On one of them, we can see a bottle with a fruit design as well as the mention "mixed berry". Also, each party is not limited to the containers presently used. They could very well be sold in similar containers.

[71] Mr. Houle made an allegation that, from his experience in the food industry, one will find in general, including in supermarkets, convenient stores and drug stores, juices, juice drinks and bottled water side by side in the same alleys, being in refrigerated spaces or not.

[72] The Applicant argues that it constitutes a bald statement as there is no picture in the record to support Mr. Houle's statement. The Opponent argues that I can take judicial notice of that fact. I disagree with both parties' contentions.

[73] On one hand, I can take judicial notice of clear and uncontested facts [see Sopinka and Lederman, *The Law of Evidence in Canada*, 2d ed. at p.1055 ff]. I do not think that the location of the parties' products on the shelves of a supermarket falls in that category. On the other hand, Mr. Houle has provided his professional background. He states that he has a vast experience in the food industry and in the field of retail sale of foodstuff. He has been involved in putting in place and supervising the Opponent's marketing strategies. He also states that he has been involved in the development and commercialisation of products as well as the preparation of its promotional campaigns.

[74] As such, I am satisfied that Mr. Houle was qualified to make such a statement. If the Applicant wanted to contest or challenge it, it could have filed reply evidence that would have

contradicted that allegation or it could have cross-examined Mr. Houle, but decided not to do so. Therefore, Mr. Houle's statement is in the record and unchallenged. Given his expertise and notwithstanding the fact that he is a representative of the Opponent, I am giving some weight to his allegation.

[75] Both parties, goods are non-alcoholic beverages that could be sold through the same channels of trade namely, supermarkets, convenient stores, etc.

[76] In all, I conclude that the factors described in sections 6(5)(c) and (d) of the Act favour the Opponent.

Additional surrounding circumstances

State of the register evidence

[77] It has been held that state of the register evidence is relevant only insofar as one can make inferences from it about the state of the marketplace, and that inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

[78] The Applicant filed state of the register evidence through the affidavit of Ms. Jennifer Leah Stecyk, a trade-mark searcher employed by the Applicant's agent.

[79] Ms. Stecyk states that on December 16, 2016 she conducted a search of the Canadian register to identify active applications and registrations for word and design trade-marks that contain the word NIAGARA, which list non-alcoholic beverages in the statement of goods. She filed the results of her search as Exhibit A to her affidavit, which includes 16 citations.

[80] At the hearing, I asked the Applicant's agent to identify the most relevant citations as there was no analysis of that portion of the evidence in the Applicant's written argument and clearly some of the citations were not pertinent. The Applicant identified eight of them, namely

citations number 5, 6, 11, 12, 13, 14, 15 and 16 in Ms. Stecyk's report. I do not need to provide the details of each one of them to dispose of this argument.

[81] Citation numbers 5, 6 and 16 to Ms. Stecyk's report are applications that are only at the searched stage. Citation numbers 12 (Niagara Oast House Brewers) and 15 (NIAGARA BEST LAGER & DESIGN) are easily distinguishable from NIAGARA alone. Therefore, only three (3) relevant citations remain, which is an insufficient number of citations to draw an inference from the register of the state of the marketplace [see *Hawke & Company Outfitters LLC v Retail Royalty Company and American Eagle Outfitters, Inc* 2012 FC 1539].

Expungement of registrations

[82] The Applicant would like me to consider, as a relevant surrounding circumstance, the fact that McCain's registrations for the trade-marks NIAGARA and NIAGARA & Design (marks that have been licensed by McCain to the Opponent as mentioned previously) have been expunged from the register.

[83] I do not see that fact as a relevant surrounding circumstance. Firstly, as stated earlier, the Opponent is not relying on these registrations but solely on its prior use of the mark NIAGARA under license with McCain. Moreover, the fact that these registrations were expunged for failure by the registrant to renew them does not necessarily imply that there has been no use of any of them. In fact, the evidence described above is to the contrary.

Conclusion

[84] From this analysis, I conclude that the Applicant has failed to demonstrate, on a balance of probabilities, the Mark, when used in association with the Goods, was not confusing with the trade-mark NIAGARA previously used in Canada by the Opponent in association with fruit drinks.

[85] Consequently, the ground of opposition based on section 16(2) of the Act is maintained.

DISTINCTIVENESS GROUND OF OPPOSITION

[86] As for the ground of opposition based on lack of distinctiveness of the Mark, the Opponent had to establish that the mark NIAGARA was known in Canada to some extent as of April 20, 2015 so as to negate the distinctiveness of the Mark [see *Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed 2006 FC 657].

[87] The Applicant argues that the Opponent's sales were modest at best. Mr. Houle states that the Opponent sold between 2007 and 2014 over 400,000 cases of fruit cocktails in association with the mark NIAGARA. They were sold in the provinces of British Columbia, Alberta, Manitoba, Saskatchewan and Quebec. Despite the decrease in the volume of sales in 2015 (over 3,500 cases), the figures for the three previous years were still non-negligible such that the Opponent's mark NIAGARA was still known to some extent in Canada as of the relevant date.

[88] Consequently, the evidence establishes that the Opponent has used the mark NIAGARA, as of the relevant date, in association with fruit cocktails such that it was known in Canada to some extent. Therefore, it negated the distinctiveness of the Mark, as of April 20, 2015. Accordingly, the Opponent has met its initial burden under that ground of opposition.

[89] The later relevant date associated with this ground would not alter significantly the results of the analysis of each of the relevant factors discussed under the previous ground of opposition. Accordingly, the Applicant failed to prove, on a balance of probabilities, that the Mark, at the relevant date, was distinctive within the meaning of section 2 of the Act.

[90] As a result, this ground of opposition is maintained as well.

OTHER GROUNDS OF OPPOSITION

[91] Given that the Opponent has been successful under two separate grounds of opposition, I do not need to discuss the remaining grounds of opposition.

DISPOSITION

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

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

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE 2018-05-10

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