



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

Citation: 2019 TMOB 32

Date of Decision: 2019-03-29

IN THE MATTER OF AN OPPOSITION

Unilever Canada Inc.

Opponent

and

Rain Shields

Applicant

1,569,356 for STARSICLES

Application

INTRODUCTION

[1] Unilever Canada Inc. (the Opponent) opposes registration of the trade-mark STARSICLES (the Mark), which is the subject of application No. 1,569,356 by Rain Shields (the Applicant).

[2] The application is based on proposed use in Canada in association with “frozen confectionery and frozen desserts” and the “retail sale of frozen confectionery and frozen desserts” (the Goods and Services, respectively).

[3] A key issue in this proceeding is the likelihood of confusion with the Opponent’s SICLE trade-marks, which include the trade-marks POPSICLE, CREAMSICLE, and FUDGSICLE in association with frozen confectionery products. For the reasons set out below, I find that the application ought to be refused.

THE RECORD

[4] The application for the Mark was filed on March 19, 2012 and was advertised for opposition purposes in the *Trade-marks Journal* of July 23, 2014.

[5] On September 16, 2014, the Opponent filed a statement of opposition under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition pleaded by the Opponent are summarized below:

- a) Contrary to section 30(i) of the Act, the Applicant could not have been satisfied of its entitlement to use the Mark in association with the Goods having regard to its knowledge of the Opponent's SICLE trade-marks and registrations listed in Schedule A (collectively the SICLE Marks and SICLE Registrations).
- b) The Mark is not registrable because it is confusing with the Opponent's SICLE Registrations listed in Schedule A.
- c) The Applicant is not the person entitled to registration of the Mark in view of section 16(3)(a) of the Act, since at the filing date, the Mark was confusing with the SICLE Marks which have been previously used by the Opponent and which have not been abandoned.
- d) The Mark is not distinctive nor is it adapted as to distinguish the Applicant's goods and services from the goods and services associated with the Opponent's SICLE Marks.

[6] The Applicant filed a counter statement on January 19, 2015.

[7] In support of its opposition, the Opponent filed the affidavits of Maura Cowan (sworn May 29, 2015), Ginger Dorval (sworn May 19, 2015), and Sanojika Jesurajah (sworn May 13, 2015). None of the affiants were cross-examined.

[8] In support of its application, the Applicant filed the affidavit of Joseph Richard Elmer French (sworn September 2, 2015) and Rain Marie Shields. In view of Ms. Shield's failure to attend cross-examination, her affidavit was struck from the record pursuant to section 44(5) of the *Trade-marks Regulations*, SOR/96-195. Mr. French was not cross-examined.

[9] Only the Opponent filed a written argument, and attended a hearing.

ONUS AND MATERIAL DATES

[10] 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 [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[11] The material dates that apply to the grounds of opposition pleaded are:

- Sections 38(2)(a)/30 – the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984) 3 CPR (3d) 469 (TMOB) at 475];
- Sections 38(2)(b)/12(1)(d) - the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade-marks* (1991), 37 CPR (3d) 413 (FCA)];
- Sections 38(2)(c)/16(3) – the date of filing of the application [section 16(3) of the Act]; and
- Sections 38(2)(d)/2 – the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 2004 FC 1185 (CanLII), 34 CPR (4th) 317 (FC)].

ANALYSIS OF THE GROUNDS OF OPPOSITION

Ground of opposition summarily dismissed – Section 30(i)

[12] Where an applicant has provided the statement required by section 30(i) of the Act, a section 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 CPR (2d) 152 (TMOB) at 155].

[13] At the hearing, the Opponent submitted that the Applicant could not have not been satisfied of its entitlement to use the Mark having regard to the renown of the Opponent's POPSICLE marks, and asserts that the very fact that the Applicant had initially applied for the Mark in association with the goods "popsicles" drives home this point. However, as the application's file history (which contains this information) is not of record, I will have no regard to this assertion [*Generation Nouveau Monde Inc v Teddy SPA* (2006), 51 CPR (4th) 385 (TMOB)].

[14] Even assuming the Applicant had been aware of the Opponent's SICLE Marks, including the trade-mark POPSICLE, the mere knowledge of the existence of the Opponent's trade-marks does not in and of itself support an allegation that the Applicant could not have been satisfied of its entitlement to use the Mark [*Woot, Inc v WootRestaurants Inc/ Les Restaurants Woot Inc* 2012 TMOB 197 (CanLII)]. Knowledge of these trade-marks would not preclude the Applicant from truthfully making the statement required by section 30(i) *inter alia* on the basis that it believed its Mark was not confusing with them.

[15] In the present case, the Applicant has provided the necessary statement and this is not an exceptional case. Accordingly, the section 30(i) ground is dismissed.

Section 12(1)(d) ground of opposition

[16] The Opponent has pleaded that the Mark is not registrable because it is confusing with the registrations for the SICLE Marks set out in Schedule A.

[17] Through the Jesurajah affidavit, the Opponent filed copies of all these registrations except for two registrations for the trade-mark BI SICLE that have been expunged (Nos. 164,815 and 293,548) (para 2, Exhibit A). I have exercised my discretion to check the Register and confirm that the following registrations have also been expunged: TMDA52753 for POPSICLE DESIGN; TMA296,609 for POPSICLE & DESIGN; TMA296,610 for POPSICLE & DESIGN; TMA296,612 for POPSICLE & DESIGN; TMA296,613 for FUDGSICLE & DESIGN; TMA298,400 for JUSICLE; TMA187,639 for SICLE & DESIGN; TMA296,611 for SICLE DESIGN; and TMA293,548 for SNAXSICLE. All of the remaining registrations cited in the

statement of opposition are extant [*Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[18] As the Opponent has satisfied its initial burden, I now have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with the Opponent's SICLE Marks.

[19] In assessing this ground of opposition, I will focus on the Opponent's registration Nos. TMDA50854 and TMDA33876 for the trade-mark POPSICLE, registration No. UCA10578 for the trade-mark CREAMSICLE, and registration No. UCA29251 for the trade-mark FUDGSICLE, as I consider that they represent the Opponent's best chance of success.

Test to determine confusion

[20] 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 goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[21] Thus, the issue is not confusion between the trade-marks themselves, but confusion of goods and services from one source as being from another source. In the instant case, the question posed by section 6(2) of the Act is whether purchasers of the Goods and Services sold in association with the trade-mark STARSICLES would believe that those items and services were produced, provided, authorized or licensed by the Opponent.

[22] 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 each has been in use; (c) the nature of the goods, 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.

[23] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc* (2006), 2006 SCC 22 (CanLII),

49 CPR (4th) 321 (SCC); 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece v Alavida Lifestyles Inc* (2011), 2011 SCC 27 (CanLII), 92 CPR (4th) 361 (SCC) (*Masterpiece*) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

Summary of the Opponent's evidence

[24] The Opponent's evidence summarized below, leads to the conclusion that the POPSICLE brand is extremely well-known in Canada for frozen confectionery products, and that the CREAMSICLE and FUDGSICLE brands are fairly well-known in Canada for frozen confectionery products.

Affidavit of Maura Cowan

[25] Ms. Cowan is the Marketing Manager for ice cream, tea and home care categories with the Opponent (para 1). Pertinent portions of Ms. Cowan's affidavit are summarized below:

- In 1993, UL Canada Inc, the predecessor of the Opponent, acquired the SICLE and various *SICLE suffixed trade-marks, including POPSICLE, CREAMSICLE, FUDGSICLE and YO-SICLE in Canada. In 2003, the Opponent was recorded as the owner of those trade-marks (para 4).
- The Opponent and/or its predecessor in title have sold frozen confectionery products under the trade-marks POPSICLE, CREAMSICLE, FUDGSIDCLE, SICLE and YO-SICLE in Canada since at least as early as 1923, 1937, 1948, 1960 and 1981 respectively (para 7).
- Since at least as early as 1993, the Opponent and/or its predecessor in title have sold significant amounts of frozen confectionery products throughout Canada under the SICLE, POPSICLE and other *SICLE suffixed trade-marks. In the last three years, retail sales in Canada of frozen confectionery products under the trade-mark POPSICLE have totalled over \$100 million and retail sales of frozen confectionery products under the other *SICLE suffixed trade-marks have totalled over \$30 million (para 8).
- The total market share of the frozen confectionery products associated with the Opponent's family of *SICLE brands including SICLE, POPSICLE, CREAMSICLE, FUDGSICLE and YOSICLE/YO-SICLE is close to 10% of the frozen novelty products category in Canada in the last 12 months. On each product packaging, the Opponent is identified as the trade-mark owner (para 9).

- Sales of product under the POPSICLE brand in Canada from April 2012 – April 2015 total \$105,000,000 CAD (para 10).
- Sales of product under the CREAMSICLE brand in Canada from April 2012 – April 2015 total \$12,000,000 CAD (para 11).
- Sales of product under the FUDGSICLE brand in Canada from April 2012 – April 2015 total \$16,000,000 (para 12).
- Frozen confectionery products acquired from the Opponent under the SICLE, POPSICLE, CREAMSICLE, FUDGSICLE and YOSICLE/YO-SICLE brands are sold throughout Canada in most locations in supermarkets and grocery stores (eg. Wal-Mart, Loblaws, Metro, and other retail chains), as well as in many convenience stores (para 13).
- Exhibit B consists of true copies of images of the POPSICLE, CREAMSICLE, FUDGSICLE, and YOSICLE/YO-SICLE branded products that are sold in Canada. I note these trade-marks appear prominently on the product packaging. Exhibit C is described as a representative product label from product sold in Canada on which the mark SICLE appears prominently on the product packaging (para 13).
- Exhibit D is described as true representative images of product packaging used in Canada as well as a sales invoice (para 14). I note that the product packaging bears the trade-marks POPSICLE, CREAMSICLE, FUDGSICLE, and YOSICLE/YO-SICLE, and each package bears a trade-mark notice attributing ownership to the Opponent (para 14). With respect to the sales invoice, I note that the prices for the products have been redacted. However, the total transaction record for the purchase of three packages of products has not been redacted and totals \$10.19. This supports the Opponent's contention that the Goods are inexpensive.
- The POPSICLE marks and/or other *SICLE suffixed trade-marks appear on company websites, product packaging, sales invoices, and promotional materials, all of which are used and circulated in Canada in the ordinary course of the Opponent's business (para 15). Exhibit E consists of copies of pages (which appear to have been printed on 5/15/2015) from the Opponent's website *www.popsicle.ca*, bearing marks including POPSICLE, CREAMSICLE, FUDGSICLE and YOSICLE (para 16). Exhibit F includes representative pictures of point of sale materials for POPSICLE, CREAMSICLE and FUDGSICLE frozen confectionery products sold in the Atlantic Provinces and POPSICLE frozen confectionery products sold in the city of Montreal (para 17). Exhibit F also contains representative images of shelf talkers and copies of coupons for POPSICLE frozen confectionery products distributed in Canada in the period 2014-2015 (para 17).

Affidavit of Sanojika Jesurajah

[26] Ms. Jesurajah is a legal assistant employed with counsel for the Opponent (para 1). On May 13, 2015, Ms. Jesurajah conducted searches of the Canadian Trade-marks Register to obtain the official records of all *SICLE suffixed marks owned by the Opponent listed in the Statement of Opposition (para 2). Attached as Exhibit A to her affidavit are copies of the trade-mark registrations listed in the Statement of Opposition, with the exception of the mark BISICLE under registration Nos. 164,815 and 293,548, which have been expunged for failure to renew.

[27] From my review, I note that the Opponent's registration No. TMDA33876 for POPSICLE was registered on July 20, 1923, based on use in association with "frozen confections on a stick", since at least July 20, 1903. The Opponent's registration No. UCA10578 for CREAMSICLE was registered on August 18, 1937, based on use in association with goods including "frozen confections on sticks", since January 15, 1937. The Opponent's registration No. UCA29251 for FUDGSICLE was registered on May 28, 1948, based on use in association with goods including "frozen confections", since April 5, 1948.

Affidavit of Ginger Dorval

[28] Ms. Dorval is a registered trade-mark agent with the counsel for the Opponent (para 1). On May 19, 2015, Ms. Dorval conducted a search of SICLE suffixed marks on the Canadian Trade-marks Register. The search found that the Opponent owns all the SICLE suffixed marks of record in association with frozen confectionery products except the subject application for STARSICLES (para 2). Attached as Exhibit A to her affidavit are the search results which indicate that the Opponent owns 76 marks that contain the SICLE suffix (para 3).

Summary of the Applicant's evidence

Affidavit of Joseph Richard Elmer French

[29] Mr. French identifies himself as an investor in the 'Starsicles' company, and also holds the position of vice president of sales and marketing (para 1). Further, Mr. French "takes part in the direct hand to hand sales of 'Starsicles' when attending various events" (para 1). The below paragraphs are reproduced from Mr. French's affidavit:

2. To my knowledge, 'Starsicles' has been in business since 2010. During this time and up into the present 'Starsicles' have been available to the consumer through direct sales in booths and retail sales in freezers in local grocery stores. A partial list of events that 'Starsicles' has participated in includes: The Nakusp Music Festival, Disney's Club Penguin's 7th Birthday Party, Shambhala Music Festival, The Kootenay Country Store Cooperative and several private events including weddings.

3. From my direct experience with consumers in my capacity in sales I have concluded that the brand 'Starsicles' is easily and readily identifiable as unique and separate from 'Popsicle Ice Pops'.

4. Another key and distinguishing factor that eliminates any possible confusion is that the brand 'Starsicles' is a performing frozen confectionery company. I have been a professional entertainer since I was eight years old. I have participated in twenty two productions. I currently perform as three different characters within the 'Starsicles' brand.

[30] In its written argument and at the hearing, the Opponent submitted that the French affidavit is deficient in a number of respects. I agree. As noted by the Opponent, Mr. French does not clearly identify, describe or discuss the products being sold in association with the STARSICLES Mark. He does not provide any information regarding advertising or sales, though he does briefly discuss the channels of trade (local grocery stores and direct sales in booths, presumably at the events cited by Mr. French). With respect to the services offered under the Starsicles brand, reference is made to 'Starsicles' as a "performing frozen confectionery company" with Mr. French performing as "different characters within the Starsicles brand". Without more, it is difficult to understand the nature of the services performed or available to be performed, and moreover, this information does not correspond with the Services listed in the application. Notably absent from the affidavit is any information on or examples of how the Mark is used.

[31] I have disregarded the assertions made in paragraph 3 of the French affidavit on the basis of hearsay and as personal opinion on an issue going to the merit of the opposition.

Analysis of the 6(5) factors

Inherent distinctiveness of the trade-marks and the extent to which they have become known

[32] I consider the Applicant's Mark STARSICLES to be inherently distinctive as the Mark does not describe any inherent characteristic or quality of the Goods or Services.

[33] The Opponent's trade-marks POPSICLE, CREAMSICLE and FUDGSICLE are also inherently distinctive in relation to the Opponent's frozen confectionery products, however their respective prefixes POP, CREAM, and FUDG- are descriptive [see *Popsicle Industries Ltd v Ault Foods/Aliments Ault Ltee* (1993), 48 CPR (3d) 245 (TMOB) at 250 in respect of comments made on the inherent distinctiveness of the Opponent's trade-mark POPSICLE].

[34] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. As discussed above, I am satisfied from the evidence of Ms. Cowan that the POPSICLE trade-mark has been used extensively in Canada and is extremely well-known. I am also satisfied from the Cowan affidavit that the CREAMSICLE and FUDGSICLE trade-marks are fairly well-known in Canada.

[35] With respect to the applied for Mark, as the Applicant has filed no relevant evidence of use within the meaning of section 4 of the Act or reputation in Canada, there is no evidence that the Mark (for which the application is based on proposed use) has become known. Accordingly, this factor strongly favours the Opponent.

Length of time in use

[36] In view of the above, it follows that the length of time the trade-marks have been in use also favours the Opponent.

The nature of the goods, services or business; the nature of the trade

[37] It is the Applicant's statement of goods and services as defined in its application versus the Opponent's registered goods and services that governs my determination of this factor [Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc (1986), 12 CPR (3d) 110 (FCA); Mr. Submarine Ltd v Amandista Investments Ltd (1987), 19 CPR (3d) 3 (FCA); Miss Universe Inc v Bohna (1994), 1994 CanLII 3534 (FCA), 58 CPR (3d) 381 (FCA)].

[38] The Opponent's registration No. TMDA33876 for POPSICLE is based on use in association with "frozen confections on a stick". The Opponent's registration No. UCA10578 for CREAMSICLE covers goods including "frozen confections on sticks". The Opponent's registration No. UCA29251 for FUDGSICLE is based on use in association with goods including

“frozen confections”. The Opponent’s evidence indicates that these goods are inexpensive (Cowan affidavit, Exhibit D).

[39] The Applicant’s application is listed for use in association with “frozen confectionery and frozen desserts” and the “retail sale of frozen confectionery and frozen desserts”.

[40] I do not consider there to be any substantive difference between frozen confectionery on a stick and not on a stick, and therefore find the nature of the parties’ goods to be directly overlapping. I also consider there to be overlap in respect of the services given the proposed services are defined as retail sale of frozen confectionery and frozen desserts.

[41] The Opponent has submitted that the goods at issue are less expensive, therefore subject to less scrutiny as would be expected from more expensive goods [*United States Polo Assn v Polo Ralph Lauren Corp* 1999 CanLII 7639 (FC)]. Considering the evidence, I accept this submission, and note that the Registrar made similar findings regarding the inexpensive nature of the goods in earlier decisions involving the Opponent’s predecessor in title and the trade-mark POPSICLE [see *U L Canada Inc v Ault Foods Ltd/Les Aliments Ault Ltee* (1994), 58 CPR (3d) 282 (TMOB) at 287; *Popsicle Industries Ltd v Ault Foods/Aliments Ault Ltee* (1993), 48 CPR (3d) 245 (TMOB) at 251].

[42] With respect to the channels of trade, I find there is direct overlap as both parties’ goods would be available in grocery stores. Notwithstanding that it is unlikely that the Opponent’s frozen confections would be made available for retail sale by the Applicant, neither the Opponent’s registrations nor the Applicant’s application contains restrictions confirming as much.

Degree of Resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[43] When considering the degree of resemblance, the trade-marks must be considered in their totality. The appropriate test is not a side by side comparison but a matter of first impression of a consumer with an imperfect recollection of an opponent’s trade-mark [*Veuve Cliquot Ponsardin v Boutiques Cliquot Ltee* (2006), 2006 SCC 23 (CanLII), 49 CPR (4th) 401 at para 20].

[44] Notwithstanding that each has a prefix which creates some differences between them, I find that there is fair degree of resemblance between each of the Opponent's trade-marks POPSICLE, CREAMSICLE, and FUDGSICLE and the applied for trade-mark STARSICLES given that they are all comprised of a prefix followed by the suffix SICLE. This structural similarity makes them visually and phonetically similar. There is also some similarity in the ideas suggested by the parties' marks to the extent that the shared suffix SICLE evokes the word 'icicle'.

Additional surrounding circumstance – Opponent's family of SICLE trade-marks

[45] The Opponent submits that the Registrar should have regard to the Opponent's family of marks. In its written argument, it states that this family includes "POPSICLE, TWIN POPSICLE, POPSICLE PETE, POPSICLE WILD BUNCH, POPSICLE MINI-POPS, POPSICLE CARNAVAL, POPSICLE CARNIVAL, POPSICLE SUPER STIX, POPSICLE TINGLE TWIRL, POPSICLE SHOTS, DIET POPSICLE, CREAMSICLE, CREMESICLE, DIET CREAMSICLE, FUDGSICLE, DIET FUDGSICLE, FUDGSICLE LIGHT, FUDGSICLE JR, FUDGSICLE SHAKERS, BOMBSICLE, BUBBLE-SICLE, DREAM-SICLE, FRUIT-SICLE, JUICESICLE, JUSICLE, PY-SICLE, SICLE, SLUSHSICLE, SUNDAE-SICLE, SUPERSICLE, TRI-SICLE, YOSICLE, and various related design marks".

[46] Where there is a family of trade-marks, there may be a greater likelihood that the public would consider a trade-mark that is similar to be another trade-mark in the family and consequently, assume that the product or service that is associated with that trade-mark is manufactured or performed by the same person [*Everex Systems Inc v Everdata Computer Inc*, (1992), 44 CPR (3d) 175 at 183 (FCTD)]. There is, however, no presumption of the existence of a family of marks in opposition proceedings. A party seeking to establish a family of marks must establish that it is using more than one or two trade-marks within the alleged family [*Techniquip Ltd v Canadian Olympic Assn* (1998), 145 FTR 59 (FCTD), *aff'd* 250 NR 302 (FCA); *Now Communications Inc v CHUM Ltd* (2003), 32 CPR (4th) 168 (TMOB)].

[47] As discussed above, the Opponent has evidenced use of some of its SICLE Marks in the marketplace, including extensive use of the trade-mark POPSICLE, and use of the trade-marks CREAMSICLE and FUDGSICLE. In particular, the Opponent has provided annual sales

information regarding sales of products under these three brands in Canada from April 2012 – 2015. I am therefore satisfied that the Opponent has established the existence of a family of trade-marks that include the suffix SICLE for use in association with frozen confectionery products. Accordingly, I find that consumers familiar with the Opponent’s SICLE Marks - including POPSICLE, CREAMSICLE and FUDGSICLE – may be more likely to assume that the Applicant’s STARSICLES Mark, which is intended for use with frozen confections, is part of the Opponent’s family of marks because it shares the same distinctive suffix SICLE. The Opponent’s family of SICLE trade-marks therefore increases the likelihood of confusion in this case.

Additional surrounding circumstance – state of the Register

[48] State of the register evidence is often introduced by a party to show the commonality or distinctiveness of a mark or portion of a mark in relation to the register as a whole. It has been established that state of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and 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); *Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)].

[49] Where there is a large number of trade-marks consisting of or incorporating the same element or feature on the register, the inference drawn is that at least some are likely in use in the marketplace. It then follows that consumers would likely already be accustomed to seeing and distinguishing between them, such that small differences would suffice to enable them to do so. For this reason, such marks are sometimes said to be entitled to a narrower scope of protection.

[50] In this case, the Opponent’s state of the register evidence appears to have been introduced to enable me to draw an opposite inference. More specifically, at the hearing, the Opponent submitted that the Opponent’s rights with respect to the element SICLE have not been diluted via third party registrations, with the result that the protection to be afforded to this family of marks ought to be robust.

[51] The Opponent's state of the register evidence has been introduced through the Dorval affidavit. Ms. Dorval's search for SICLE suffixed marks on the Canadian Trade-marks Register disclosed that with the exception of the applied for Mark STARSICLES, all of the SICLE suffixed marks of record in association with frozen confectionery products stand in the name of the Opponent; the Opponent owns 76 SICLE marks, including a registration for the trade-mark SICLE (TMA120,876).

[52] In the absence of any state of the register evidence or marketplace evidence from the Applicant showing otherwise, I am prepared to give the lack of third party "SICLE" marks on the register some weight as a relevant surrounding circumstance favouring the Opponent.

Additional surrounding circumstance – Applicant's lack of engagement in the proceeding

[53] In its written argument, the Opponent references the following excerpt from *McCain Foods Limited v Aromatic Foods Limited* 1999 CanLI 19629 (CA Registrar):

...Apart from the above, I would note that the applicant has not taken any active steps in this proceeding subsequent to filing its counter statement even though the legal burden is on it to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue...

The Opponent submits that while the Applicant did file some evidence in this case (the French affidavit), its quality is such that the above excerpt should provide guidance to the disposition of this matter. Moreover, the Applicant herself failed to attend her cross-examination, such that her evidence was rejected and returned.

[54] While it may be that the deficiencies in the French affidavit render it of little benefit to the Applicant, given the circumstances of this case, including the fact that the Applicant is self-represented, I do not find the filing of an affidavit with significant substantive deficiencies to be analogous to "not taking any active steps in the proceeding subsequent to the filing of the counter statement". In reaching this conclusion, I acknowledge that the Opponent also made repeated attempts to cross-examine Ms. French on her affidavit, which was subsequently struck from the record from failure to attend at cross-examination.

Conclusion

[55] The test to be applied is a matter of first impression in the mind of a casual consumer “somewhat in a hurry” who sees the trade-mark STARSICLES in association with frozen confections and the retail sale thereof at a time when he or she has no more than an imperfect recollection of the Opponent’s trade-marks, including POPSICLE, FUDGSICLE, and CREAMSICLE, and does not pause to give the matter any detailed consideration or scrutiny [*Veuve Clicquot, supra* at para 20].

[56] Having considered all of the surrounding circumstances, and in particular: that the Opponent has evidenced extensive use of its POPSICLE trade-mark and that the Opponent’s POPSICLE trade-mark is extremely well-known in Canada for frozen confectionery products; the Opponent has evidenced significant use of the CREAMSICLE and FUDGSICLE trade-marks and these marks are fairly well-known in Canada; the overlap in the parties’ goods and the Applicant’s services and the corresponding channels of trade; the considerable degree of resemblance between the Opponent’s POPSICLE, CREAMSICLE, and FUDGSICLE trade-marks and the applied for trade-mark STARSICLES, and the increased ambit of protection to be afforded to the Opponent’s family of SICLE Marks, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent’s trade-marks POPSICLE, CREAMSICLE and FUDGSICLE.

[57] Accordingly, the ground of opposition based on section 12(1)(d) is successful.

Section 2 ground of opposition

[58] To meet its evidentiary burden under this ground of opposition, the Opponent has to show that as of the filing of the statement of opposition (September 16, 2014) one or more of the Opponent’s trade-marks had become sufficiently known to negate the distinctiveness of the Mark and its reputation in Canada is substantial, significant or sufficient [*Bojangles’ International, LLC v Bojangles Café Ltd* 2006 FC 657 (CanLII) at para 34]. I find that the evidence summarized in paragraph 25 of this decision is sufficient to meet the Opponent’s burden. The Applicant is therefore required to show that its Mark is adapted to distinguish or actually

distinguishes its Goods and Services from the goods of the Opponent [*Muffin Houses Incorporated v The Muffin House Bakery Ltd.* (1985), 4 CPR (3d) 272 (TMOB)].

[59] I consider that the Applicant's position is not stronger as of the date of filing of the statement of opposition than it is as of today's date. Accordingly, I reach the same conclusion regarding the likelihood of confusion as under the section 12(1)(d) ground of opposition and this ground of opposition is successful.

Remaining ground of opposition

[60] Having already refused the application under two grounds, I will not discuss the remaining ground of opposition with respect to this application.

DISPOSITION

[61] 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.

Jennifer Galeano
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2018-11-29

APPEARANCES

Jim Holloway

FOR THE OPPONENT

No one appearing

FOR THE APPLICANT

AGENT OF RECORD

Baker & McKenzie LLP

FOR THE OPPONENT

No agent of record

FOR THE APPLICANT

SCHEDULE A

Trade-mark	Registration No.
POPSICLE	TMDA050,854
POPSICLE	TMDA033,876
POPSICLE	133,562
POPSICLE	287,973
POPSICLE	561,020
POPSICLE DESIGN	TMDA052753
POPSICLE & DESIGN	296,609
POPSICLE & DESIGN	296,610
POPSICLE & DESIGN	296,612
POPSICLE & DESIGN	367,690
TWIN POPSICLE	UCA005529
POPSICLE PETE	UCA012342
POPSICLE LA MARQUE ORIGINALE & DESIGN	650,733
POPSICLE INDUSTRIES	325,101
POPSICLE WILD BUNCH	627,151
NO SUGAR ADDED POPSICLE	372,692
POPSICLE MINI-POPS & DESIGN	390,823
POPSICLE CARNAVAL	630,692
PETE & POPSICLE DESIGN	369,729
POPSICLE PETE'S & DESIGN	375,768
DIET POPSICLE	346,145
POPSICLE CARNIVAL	630,977
POPSICLE PETE	287,974
POPSICLE SUPER STIX & DESIGN	393,804
POPSICLE TINGLE TWIRL	627,152
POPSICLE SHOTS	628,206
POPSICLE THE ORIGINAL BRAND & DESIGN	651,255
BI SICLE	164,815
BOMBSICLE	208,030

BUBBLE-SICLE	296,117
CREAMSICLE	UCA010578
CREAMSICLE	635,545
CREAMSICLE & DESIGN	368,469
CREAMSICLE FLOATS	598,229
CREAMSICLE LA MARQUE ORIGINALE & DESIGN	650,868
CREAMSICLE LIGHT	372,408
CREAMSICLE SUPER STIX & DESIGN	394,657
CREAMSICLE THE ORIGINAL BRAND & DESIGN	650,497
CREMESICLE	189,762
DIET CREAMSICLE	344,823
DIET FUDGSICLE	344,822
DREAMSICLE	106,828
FRUIT-SICLE	UCA7468
FUDGSICLE LA MARQUE ORIGINALE & DESIGN	650,734
FUDGSICLE	UCA029251
FUDGSICLE	287,972
FUDGSICLE & DESIGN	296,613
FUDGSICLE & DESIGN	362,650
FUDGSICLE FOUETTE	636,269
FUDGSICLE JR. & DESIGN	490,394
FUDGSICLE LIGHT	369,772
FUDGSICLE SHAKERS	603,082
FUDGSICLE THE ORIGINAL BRAND & DESIGN	650,609
JUICESICLE	301,857
JUSICLE	298,400
PY-SICLE	107,821
SICLE	287,717
SICLE	120,876
SICLE & DESIGN	187,639
SICLE DESIGN	296,611

SLUSHSICLE	236,630
SNAXSICLE	293,548
SUNDAE-SICLE	UCA6696
SUPERSICLE	808,255
SUPERSICLE & DESIGN	563,666
TRI-SICLE	210,038
YOSICLE	829,568
YO-SICLE	261,033