



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

Citation: 2019 TMOB 53

Date of Decision: 2019-06-12

IN THE MATTER OF AN OPPOSITION

Nimbus Water Systems Inc.

Opponent

and

La Galvanina S.P.A.

Applicant

**1,737,905 for
BLÚ ITALY & DESIGN**

Application

[1] Nimbus Water Systems Inc. (the Opponent) opposes an application for registration of the trade-mark BLÚ ITALY & DESIGN (the Mark) filed by La Galvanina S.P.A (the Applicant). The Mark, reproduced below, consists of the stacked words BLÚ ITALY in capital letters, inside a crescent, against a dark background:



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

THE RECORD

[3] On July 17, 2015, the Applicant filed an application accorded serial No. 1,737,905 for registration of the Mark (the Application). The Application is based on proposed use of the Mark in Canada in association with the following goods:

Tea; beverages made of tea; fruit-based soft drinks flavoured with tea; fruit teas; non-alcoholic tea-based beverages; still waters; carbonated waters; mineral waters; flavoured mineral water; non-alcoholic fruit drinks; non-alcoholic fruit flavoured drinks; fruit juices; vegetables juices. (the Goods)

[4] The Applicant claimed a priority date of July 14, 2015, based on an application filed on that date in Italy under No. 302015000033846, for registration of the same or substantially the same trade-mark for use in association with the same kind of goods.

[5] The Application was advertised on June 15, 2016 in the *Trade-marks Journal* for the purposes of opposition.

[6] On November 14, 2016, the Opponent filed a statement of opposition. The grounds of opposition pleaded are based on sections 30(e) and 30(i) (compliance), 16(3)(a) (entitlement), 2 (distinctiveness) and 12(1)(d) (registrability) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[7] The Applicant filed a counter statement on December 21, 2016, denying each of the grounds of opposition.

[8] The Opponent filed as its evidence the affidavit of Peter Bozzo, dated April 21, 2017. Mr. Bozzo identifies himself as the president of the Opponent and of several of its related companies.

[9] The Applicant filed as its evidence the affidavit of Marianne Crozier, dated December 19, 2017. Ms. Crozier identifies herself as a trademark paralegal employed by Palmer IP Inc.

[10] Neither of the affiants was cross-examined.

[11] Only the Opponent filed written arguments and a hearing was not requested.

EVIDENTIARY BURDEN

[12] 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 must satisfy the Registrar, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the trade-mark at issue [*Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *Christian Dior SA v Dion Neckwear Ltd*, 2002 FCA 29, 20 CPR (4th) 155].

GROUND OF OPPOSITION SUMMARILY DISMISSED

Compliance with section 30(e) of the Act

[13] The Opponent pleads that the Application does not conform to the requirements of section 30(e) of the Act, because the Applicant's statement that it intends to use the Mark in Canada in association with the Goods was false. More specifically, the Opponent pleads that the Applicant did not intend to (i) use the Mark with *all* of the Goods in Canada; (ii) use the Mark *per se* with all of the Goods in Canada; (iii) associate the Mark with all of the Goods in the manner required by section 4 of the Act; or (iv) sufficiently control the character or quality of all the Goods.

[14] However, there is no evidence in the record to support an allegation that the Applicant did not have a *bone fide* intention to use the Mark in Canada. I also note that the Opponent has not addressed this ground of opposition in its written argument.

[15] Accordingly, the ground of opposition based on section 30(e) of the Act is dismissed, as the Opponent has failed to meet its initial evidential burden.

Compliance with section 30(i) of the Act

[16] The Opponent also pleads that the Application does not conform to the requirements of section 30(i) of the Act, because the Applicant could not have been satisfied of its entitlement to

use the Mark in Canada in association with the Goods. Specifically, the Opponent pleads that, at the filing date, the Applicant was aware that its use of the Mark would be likely to cause confusion with the Opponent's trade-mark BLU, which the Opponent had previously used in Canada.

[17] Section 30(i) of the Act only requires an applicant to declare itself satisfied that it is entitled to use its trade-mark in Canada in association with the goods and services described in the application. Awareness of an allegedly confusing trade-mark does not preclude an applicant from making the required statement, since the applicant may nevertheless be satisfied of its own entitlement to use the trade-mark it is applying to register in association with the goods and services in its application. Accordingly, where, as here, the required statement is included in the application, an opponent may only rely on section 30(i) in specific cases, such as where bad faith or fraud on the part of the applicant is alleged, or where federal legislation arguably prevents the registration of the mark [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB); and *Interprovincial Lottery Corp v Western Gaming Systems Inc* (2002), 25 CPR (4th) 572 (TMOB)].

[18] In the present case, there is no allegation of that nature in the statement of opposition or evidence in the record to that effect. Again, the Opponent makes no submissions with respect to this ground of opposition in its written argument.

[19] Consequently, this ground of opposition is dismissed as well, as the Opponent has failed to meet its initial burden.

GROUND OF OPPOSITION BASED ON REGISTRABILITY UNDER SECTION 12(1)(D) OF THE ACT

[20] The Opponent pleads that the Mark is not registrable under section 12(1)(d) of the Act, because it is confusing with the Opponent's trade-mark BLU, registered on July 27, 2011 under no. TMA803,063 for use in association with the goods "bottled water, namely, reverse osmosis water and reverse osmosis carbonated water". The Opponent pleads use of this trade-mark in association with such goods since March 2009.

[21] The relevant date for the analysis of this ground of opposition is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[22] I have exercised my discretion to check the register and I confirm that the Opponent's registration no. TMA803,063 for the trade-mark BLU is extant [see *Quaker Oats Co of Canada Ltd v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB) regarding the Registrar's discretion to check the register in the context of section 12(1)(d)]. Thus the Opponent has met its initial burden with respect to this ground of opposition. As a result, in order for me to allow the Application, I must now be convinced on a balance of probabilities that there is no likelihood of confusion between the Mark and the Opponent's trade-mark [*Dior, supra*].

[23] The test for confusion is outlined in section 6(2) of the Act, which stipulates 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 likely lead to the inference that the goods associated with each of those trade-marks are manufactured, sold or leased by the same person.

[24] Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trade-marks are set out in section 6(5) of the Act: (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 goods, services, or businesses; (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 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*, 2006 SCC 23, 49 CPR (4th) 401; *Mattel USA Inc v 3894207 Canada Inc*, 2006 SCC 22, 49 CPR (4th) 321; *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361].

[25] The test for confusion is set out in the following terms by Mr. Justice Binnie in *Veuve Clicquot, supra*, at paragraph 20:

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 [applicant's mark], at a time when he or she has no more than an imperfect recollection of the [opponent's] trade-marks, and does not pause

to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

Degree of resemblance between the trade-marks

[26] As indicated by the Supreme Court of Canada in *Masterpiece, supra*, in most instances, the degree of resemblance between the trade-marks at issue is the most important factor. One must consider the degree of resemblance between the marks from the perspectives of appearance, sound, and ideas suggested. The preferable approach is to begin by determining whether there is an aspect of each trade-mark that is “particularly striking or unique” [*Masterpiece, supra*, at paragraph 64]. In this respect, the first portion of a trade-mark is generally considered to be the most important for the purpose of distinction [see *Conde Nast Publications Inc v Union des Éditions Modernes* (1979), 46 CPR (2d) 183 (FCTD)]. However, it is not the proper approach to set the trade-marks side by side and carefully examine them to find similarities and differences; each trade-mark must be considered as a whole [see *Veuve Clicquot, supra*].

[27] In the present case, the Opponent submits that there is a high degree of resemblance between the trade-marks at issue, because the Mark incorporates the entirety of the Opponent’s trade-mark as its “first and most striking feature”. In the Opponent’s submission, the Applicant has “merely added a word presumably descriptive of the geographic origin of the Applicant’s goods (‘Italy’) and a minor design element”. In this respect, the Opponent submits that trade-marks can be said to resemble each other to at least some extent when one mark incorporates the other in its entirety [citing *Joseph Limited v XES – NY LTD* (2005), 44 CPR (4th) 314 (TMOB) and *Giorgio Beverly Hills, Inc v 136329 Canada Inc* (1996), 67 CPR (3d) 546 (TMOB)].

[28] In my view, the striking aspect of the Opponent’s trade-mark is the fact that it consists of only the three-letter word BLU. As for the Mark, I find that it has two striking aspects: the primary one being the word BLÚ and a secondary one being the particular combination of elements, namely the juxtaposition of the words BLÚ and ITALY on the circular shape suggested by the crescent element.

[29] In *Nimbus Water Systems Inc v La Galvanina SPA*, 2019 TMOB 14, 2019 CarswellNat 675, an opposition between the same parties, I considered the Applicant’s trade-mark GALVANINA BLÚ & Design. In that case, I found that the particular combination of the word

BLÚ followed by a raised crescent design conveyed the idea of a “blue moon”. However, I do not find the Mark in the present case to convey the same impression. In the present case, the word BLÚ is not followed by a design reminiscent of a moon, but rather by the word ITALY. Moreover, the crescent in the present case is not positioned like the moon above, but rather encircles the word elements from the lower left.

[30] With respect to degree of resemblance between the trade-marks, I note that the Bozzo affidavit shows the Opponent’s trade-mark displayed in lower case lettering, whereas the word elements in the Mark are in upper case. However, the opponent’s registration is for a word mark and thus covers use of the trade-mark in any style of lettering [see *Stikeman, Elliott v Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393 (TMOB)]. The Mark is longer and more elaborate than the Opponent’s mark; however, I consider the qualifier ITALY and relatively simple background to detract only slightly from the impact of the more striking first element of the Mark, being the coined word BLÚ.

[31] It has often been held that, when the dominant portion of a trade-mark is a common descriptive or suggestive word, its importance diminishes [see *Park Avenue, supra*, and *Vancouver Sushiman Ltd v Sushiboy Foods Co* (2002), 22 CPR (4th) 107 (TMOB)]. There may thus be a tendency to discount the importance of the word BLÚ, to the extent that it suggests an alternate spelling of the common descriptive word “blue”. However, the non-traditional spelling makes this element stand out from the word ITALY and the simple crescent design. In my view, these last two elements do little to decrease the likelihood that consumers would consider both parties’ trade-marks to indicate the same source.

[32] When the Opponent’s trade-mark is considered as a whole, it suggests either an acronym or a minimalist spelling of the word “blue”. I consider the Mark to convey a similar meaning, with the added impression of BLÚ being written in a foreign language, likely Italian, and ITALY suggesting the geographical source of the goods. Indeed, in my view, the Mark may well give the impression of being an Italian version of the brand BLU.

[33] Overall, this factor favours the Opponent.

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

[34] The Opponent submits that its trade-mark and the Mark do not differ significantly in inherent distinctiveness, since the word BLU is the sole element of the former and the dominant element of the latter.

[35] To the extent that the Opponent's trade-mark would be perceived as a coined term in the nature of an acronym, I note that trade-marks consisting mainly of one or more letters of the alphabet are generally considered to possess a low degree of inherent distinctiveness [see *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD)]. Furthermore, to the extent that BLU would be perceived as a misspelling of the word "blue", and would be sounded accordingly, I find that the Opponent's trade-mark could create an association with the Opponent's goods, being bottled water. In this respect, I am prepared to take judicial notice of the fact that water is often portrayed using the colour blue.

[36] I reach similar conclusions with respect to the Mark. However, in this case, the addition of the word ITALY would likely also create in the mind of the Canadian consumer an association with the geographical source of the Applicant's goods.

[37] To the extent that the word BLÚ in the Mark suggests a foreign connotation, it has been held that words in a foreign language have a measure of inherent distinctiveness, unless the evidence shows that the meaning of the foreign word is known to the Canadian consumer [see *Thai Agri Foods Public Co v Choy Foong Int'l Trading Co Inc*, 2012 TMOB 61, 2012 CarswellNat 1368]. There is no such evidence here.

[38] In view of the foregoing, I find the Mark to possess a slightly higher degree of inherent distinctiveness than the Opponent's trade-mark.

[39] However, the degree of distinctiveness of a trade-mark can be enhanced through use and promotion in Canada [see *Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD); *GSW, supra*].

[40] In this respect, the Opponent submits that its own trade-mark has acquired distinctiveness through use and promotion in Canada since 2009, whereas the Mark cannot be said to have acquired any distinctiveness, given the absence of evidence of its use in Canada.

[41] Indeed, there is no evidence that the Mark has been used in Canada, nor is there any evidence that it has otherwise been promoted or brought to the attention of Canadian consumers in a way that might enhance its distinctiveness.

[42] The only attempt to provide evidence in this regard is Exhibit H to the affidavit of Ms. Crozier. The exhibit consists of an image of a bottle of water branded with the Mark and labelled “SPARKLING NATURAL MINERAL WATER *Acqua Minerale Naturale*”, which Ms. Crozier alleges shows “use of the Opposed Mark”. Ms. Crozier does not indicate whether the depicted bottled water was ever sold in Canada or elsewhere, or whether it was even advertised to the public or otherwise distributed. In the end, it is not possible to determine the extent to which the Mark has become known in Canada from Ms. Crozier’s evidence.

[43] The Opponent’s evidence with respect to use and promotion in Canada consists of the affidavit of its president, Peter Bozzo, who also attests to being the president of several of the Opponent’s related companies. In his affidavit, Mr. Bozzo confirms that he personally oversees the character and quality of all goods and services offered by the Opponent and related companies in association with the trade-mark BLU in Canada and that all use of this trade-mark in Canada by the related companies is pursuant to a licence granted by the Opponent.

[44] In particular, Mr. Bozzo states that the Opponent has used the trade-mark BLU in Canada since 2009 in association with bottled water. As Exhibit A to his affidavit, he attaches representative photographs of how the BLU trade-mark has been displayed on bottles of water sold by the Opponent in Canada since 2009. The photographs depict both “Sparkling” reverse osmosis water and “Natural” water.

[45] Mr. Bozzo states that the Opponent has sold such bottled water since 2009 in retail stores owned and operated by the Opponent and its related companies, as well as in other Toronto-area stores, and names a bakery and a health food store where such water has been sold. He further states that the Opponent has sold such bottled water to restaurants and banquet halls. He attaches,

as Exhibit B2 to his affidavit, a November 2, 2011 photograph of such bottles displayed at a salon-and-spa that he states purchased the water to serve to its customers. He also names a banquet and convention centre to which such water has been sold.

[46] Mr. Bozzo further states that the Opponent has, since August 2011, used the trade-mark BLU in association with the sale of water refills through water-refilling stations and with the business of selling bottled water and water filtration equipment.

[47] More specifically, he states that the Opponent used the trade-mark BLU in association with a Toronto retail store called “BLU” between July 2011 and May 2015. He states that the store sold BLU-branded bottled water as well as “drinking water systems”, water filters, and water softener systems, and also provided water refilling stations where customers could refill water bottles of various sizes. He notes that the water refilling stations were moved to another store owned and operated by the Opponent, called “Nimbus Water Systems”, when the BLU store closed in May 2015. Mr. Bozzo adds that the Opponent has also used the trade-mark BLU in association with retail sale of the aforementioned goods at this Nimbus Water Systems store, as well as other stores “owned and/or operated” by the Opponent, including at another Nimbus Water Systems location in Toronto and at Kinetico of Caledon (closed March 31, 2016).

[48] To illustrate how the Mark was displayed in this context, Mr. Bozzo attaches the following as exhibits to his affidavit:

- Exhibit B1: an August 27, 2011 photograph of BLU-branded bottled water displayed at the BLU store;
- Exhibit D1: a photograph of the BLU store storefront as it appeared between July 2011 and May 2015;
- Exhibit D2: copies of an invitation to the August 27, 2011 grand opening of the BLU store;
- Exhibit D3: a photograph of the BLU store’s interior signage displaying the trade-mark BLU; and
- Exhibit D4: a photograph of a water refilling station at the BLU store in close proximity to a sign displaying the trade-mark BLU (Mr. Bozzo attests that the BLU trade-mark

continued to be displayed in substantially the same manner at the water refilling stations' new location).

[49] Mr. Bozzo attests that, in each of the years since 2009, annual sales of BLU-branded bottled water and water refills from BLU-branded water refilling stations exceeded CAN\$40,000. He does not provide any invoices in support, although he does provide an April 9, 2009 invoice sent to the Opponent by a private labelling company for the custom manufacture of 750 cases of BLU-branded bottles of reverse osmosis still and sparkling water (Exhibit C). However, it is not clear whether these bottles were intended for sale or as giveaways, for example, at the 2009 tradeshow booth depicted at Exhibit E6, discussed below.

[50] I note that the CAN\$40,000 sales figure does not differentiate between bottled water and water refills. The statement of opposition does not plead use of the Opponent's trade-mark in association with water refills, and the Opponent has made no arguments as to whether selling water in customers' own bottles falls within the scope of "the business of selling bottled water". However, given the Opponent's evidence of use of the trade-mark BLU in association with the other aspects of its business, this point is not determinative.

[51] Additionally, Mr. Bozzo states that the Opponent has "actively and extensively promoted in Canada" its BLU-branded bottled water since 2009; its retail sale of drinking water systems, water filters, and water softener systems in association with the trade-mark BLU since 2011; and its BLU retail store between 2011 and 2015. He notes that such promotions included running advertisements in "various publications" in Canada, as well as free distribution and donations of BLU bottled water to individuals at "trade shows, book launches and festivals", to politicians and political parties, and to charitable organizations, with "well over 5000" bottles donated and given away since 2009. To illustrate the Opponent's promotional activities, Mr. Bozzo attaches the following as exhibits to his affidavit:

- Exhibit E1: a photograph of a car displaying the trade-mark BLU on its rear window, which Mr. Bozzo states has been driven "extensively" in the Toronto area since August 2011;

- Exhibit E2: a photograph of a stainless steel water flask displaying the trade-mark BLU, which Mr. Bozzo attests is representative of flasks given to customers for promotion of the BLU brand, with over 10,000 having been distributed since 2011;
- Exhibit E3: a December 6, 2011 invoice for the Opponent’s purchase of 2500 such BLU-branded flasks;
- Exhibit E4: an advertisement titled “Water treatment” displaying the trade-mark BLU and referencing Kinetico “home water systems”, which Mr. Bozzo states ran in a magazine distributed to Costco members in Canada in June 2012;
- Exhibit E5: an advertisement titled “Complete Water Treatment Solutions For Your Home & Office” displaying the trade-mark BLU, which Mr. Bozzo states ran in a publication of the Toronto District School Board in June 2014;
- Exhibit E6: a photograph of the Opponent’s booth taken at a Toronto tradeshow in October 2009, showing models holding BLU-branded bottled water as giveaways; and
- Exhibit E7: undated printouts from the website at *www.bluwatstore.com* and *www.bluwatstore.ca*, showing how the trade-mark BLU “is” displayed on the site. The depicted webpages promote water treatment products and services, specifically drinking water systems, specialty water filters, and water softener systems.

[52] Overall, in the absence of any evidence of use or promotion of the Mark in Canada, this factor favours the Opponent.

Length of time the trade-marks have been in use

[53] The Opponent submits that the evidence shows continuous use of its trade-mark BLU in Canada since at least as early as 2009. I would note that the evidence focusses on the Opponent’s retail services and promotional activities, rather than use of the Mark in association with bottled water per se. Although Mr. Bozzo attests to sales of BLU-branded bottled water since 2009, the documentary evidence is limited and only indirect, consisting of photographs of bottled water on display (for example, at the salon-and-spa that Mr. Bozzo attests purchased such water) and a supplier invoice. Moreover, Mr. Bozzo does not clearly differentiate between bottled water and

water refills, and admits that some bottled water is distributed free of charge for promotional purposes. It has been held that free distribution of a good merely to promote one's own brand does not constitute trade-mark use as defined under the Act [see, for example, *Smart & Biggar v Sutter Hill Corp*, 2012 TMOB 121, 103 CPR (4th) 128; and *Riches, McKenzie & Herbert LLP v Park Pontiac Buick GMC Ltd* (2005), 50 CPR (4th) 391 (TMOB)].

[54] However, there is no evidence whatsoever of the Mark ever having been used in Canada.

[55] Accordingly, this factor favours the Opponent.

Nature of the parties' goods and trades

[56] When considering the nature of the goods and the nature of the parties' trades under section 12(1)(d) of the Act, it is the statement of goods as defined in the applicant's application and the statement of goods in the opponent's registration that must be assessed, having regard to the channels of trade that would normally be associated with such goods [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); and *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export* (1986), 12 CPR (3d) 110 (FCA)]. The statements must be read with a view to determining the probable type of business or trade intended by the parties, rather than all possible trades that might be encompassed by the wording; evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA)].

[57] The Opponent's trade-mark is registered for use in association with the goods "bottled water, namely, reverse osmosis water and reverse osmosis carbonated water".

[58] The Goods covered by the Application are the following:

Tea; beverages made of tea; fruit-based soft drinks flavoured with tea; fruit teas; non-alcoholic tea-based beverages; still waters; carbonated waters; mineral waters; flavoured mineral water; non-alcoholic fruit drinks; non-alcoholic fruit flavoured drinks; fruit juices; vegetables juices.

[59] From a plain reading of the statements of goods in the Application and the Opponent's registration, it appears that the nature of the parties' goods is largely the same as regards the Applicant's waters goods and closely related as regards the Applicant's fruit and vegetable

beverage goods, as well as “tea” to the extent that that product might be in the nature of a bottled beverage.

[60] The Bozzo affidavit provides evidence that the Opponent’s channels of trade include the sale of bottled water through retail stores and to other establishments. There is no evidence of the Applicant’s type of business or of its channels of trade whatsoever. Nevertheless, given the nature of the goods at issue, and the absence of evidence to the contrary, I am prepared to infer that the channels of trade for the parties’ waters would be the same or similar, and that there would be at least some overlap with respect to the Applicant’s remaining beverage goods.

[61] Therefore, these factors favour the Opponent.

Additional surrounding circumstances: state of the register and state of the marketplace

[62] The affidavit of Ms. Crozier introduces into evidence, by way of exhibit materials, the results of various searches she conducted online on December 19, 2017.

[63] Exhibits A and B consist of printouts of computer searches of the Canadian trade-marks register for active trade-marks consisting of or including the word BLU for use with goods in International Class 32, which covers beer and non-alcoholic beverages. The search returned four registrations and three pending applications for such trade-marks owned by entities other than the parties, namely registrations for the trade-marks GOCCIA BLU & Design, ACAI-BLU, “blu-dot all natural protein tea” and BLU DESIGN; an allowed application for the trade-mark BLUBOOST; and formalized applications for the trade-marks BLU FROG and COCOBLU. Ms. Crozier provides printouts of the application or registration particulars for six of these trade-marks (excluding the application for COCOBLU on the basis that it appears to be a newly filed application based on proposed use).

[64] Exhibits C through G respectively consist of printouts from various websites displaying beverages branded with five of these six trade-marks:

- Exhibit C contains printouts from *amazon.ca* listing GOCCIA BLU mineral water for sale by “hikarido” in quantities of “500mlx24” (for CAN\$422.34) and “1000mlx12” (for

CAN\$381.57). The website depicts bottles branded with a variation of the GOCCIA BLU & Design registered trade-mark and indicates that the product was first available October 16, 2016.

- Exhibit D is a printout from *limujuice.net* featuring The Limu Company's BLU FROG energy drinks. The text of the website indicates that the product is "sometimes referred to as 'blue frog energy drink'". There is no indication of the product being available in Canada.
- Exhibit E contains printouts from *amazon.ca* and *walmart.ca* listing the ACAI-BLU variety of Red Rain energy drink. The Amazon website indicates that the product was first available July 21, 2017 and contains one review from a customer who made a "Verified Purchase" dated September 12, 2017.
- Exhibit F contains printouts from *well.ca* and *buycanadianfirst.ca* listing "blu-dot All Natural Protein Tea" beverages.
- Exhibit G contains (i) printouts from *blu4life.ca* featuring the "BLU Energy Drink" and (ii) a printout from *lovethiscitytv.com* for a November 26, 2016 article with the title "Blu Energy Drink Is NOW In Canada". Both websites depict cans of energy drink branded with a variation of the BLU DESIGN registered trade-mark.

[65] In three recent decisions [see *McDowell v Laverana GmbH & Co. KG*, 2017 FC 327, 154 CPR (4th) 128, *McDowell v The Body Shop International PLC*, 2017 FC 581, 148 CPR (4th) 195, and *Canada Bread Company, Limited v Dr. Smood APS*, 2019 FC 306, 2019 CarswellNat 694], the Federal Court ruled that, in the absence of a large quantity of marks identified in the state of the register evidence, use of the marks cited must be established. Where there is a large quantity of marks identified in the state of the register evidence, the Registrar can infer that a common word, part of the marks cited, is used in the marketplace such that consumers are able to distinguish these marks by their additional features.

[66] I am not prepared to make any inferences regarding the state of the marketplace on the basis of the webpages furnished as Exhibits C to G to the Crozier affidavit. The webpages constitute hearsay evidence and, at best, show that the webpages existed at the time her searches

were performed. They do not establish that the depicted goods were sold in Canada at any relevant time or the extent to which any of the webpages may have been visited by any Canadians other than Ms. Crozier [for a similar conclusion, see *Génération Nouveau Monde Inc v Teddy SPA* (2006), 51 CPR (4th) 385 (TMOB)]. Even if the “Verified Purchase” of ACAI-BLU Red Rain energy drink occurred in Canada as indicated, this small number of websites provides an insufficient basis from which to draw conclusions about public perception in Canada.

[67] Given the low number of relevant citations and the absence of evidence of use of any of the four registered marks cited by the Applicant, I cannot draw, from the state of the register evidence, an inference on the state of the marketplace.

Conclusion with respect to confusion

[68] Given that the analysis of each relevant factor listed in section 6(5) of the Act and the surrounding circumstances favours the Opponent, the Applicant has failed to demonstrate, on a balance of probabilities, that the Mark is not confusing with the Opponent’s registered trademark BLU.

[69] Consequently, this ground of opposition is maintained.

REMAINING GROUNDS OF OPPOSITION

[70] Given that the Opponent has been successful under the section 12(1)(d) ground, and that the Applicant has not filed a written argument and did not request a hearing, there is no need to rule on the remaining grounds of opposition.

DISPOSITION:

[71] In view of all the foregoing and 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**

No Hearing Held

AGENTS OF RECORD

Bereskin & Parr LLP/S.E.N.C.R.L., s.r.l.

FOR THE OPPONENT

Vanguard Intellectual Property LLP

FOR THE APPLICANT