



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2020 TMOB 56**

**Date of Decision: 2020-03-27**

**IN THE MATTER OF AN OPPOSITION**

**Hershey Chocolate & Confectionery  
Corporation**

**Opponent**

**and**

**Promotion in Motion, Inc.**

**Applicant**

**1,612,723 for SWISSKISS**

**Applications**

**1,612,724 for SWISSKISS & Design**

INTRODUCTION

[1] On February 5, 2013, Promotion in Motion, Inc. (the Applicant) filed applications to register the following two trademarks:

Application No. 1,612,723 for SWISSKISS (the Word Mark)

Application No. 1,612,724 for SWISSKISS & Design (the Design Mark - shown below)



[2] In this decision, I will refer individually to the “Word Mark Application” and the “Design Mark Application”. Collectively, I will refer to the “Marks” and the “Applications”.

[3] The Applications are each based on proposed use in Canada in association with the goods “Chocolate of Swiss origin” (the Goods).

[4] The Word Mark Application was advertised for opposition purposes on March 12, 2014 and the Design Mark Application was advertised on October 23, 2013.

[5] Hershey Chocolate & Confectionery Corporation (the Opponent) filed statements of opposition against the Applications pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). I note that the Act was amended on June 17, 2019. All references in this decision are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act as it read before it was amended (see section 70 of the Act which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised prior to that date).

[6] The statement of opposition against the Word Mark Application was filed on April 28, 2014, and the statement of opposition against the Design Mark Application was filed on December 23, 2013. The grounds of opposition are identical in both matters and are summarized below:

- a) Contrary to section 30(e) and section 30(i) of the Act, the Applicant did not have a *bona fide* intent to use, nor could the Applicant have believed that it was entitled to use the Marks in Canada in association with the Goods, in view of the Opponent’s prior use and making known in Canada of the Opponent’s family of KISS and KISSES trademarks set out in paragraph 3 of the statements of opposition and the accompanying schedules. The Opponent also alleges that the Applicant could not have been satisfied that it was entitled to use the Marks because such use would depreciate the goodwill associated with the Opponent’s family of KISS and KISSES trademarks, contrary to section 22 of the Act;
- b) Contrary to section 12(1)(d) of the Act, the Marks are not registrable because they are confusingly similar with the Opponent’s registered trademarks which include the terms KISS or KISSES. While the Opponent relies on numerous registrations identified in the

statements of opposition, as discussed in further detail, below, this decision focusses primarily on registration Nos. TMA733,263 (KISSES) and TMA833,060 (KISS) identified in Schedules “A” and “J” in the statements of opposition;

- c) Contrary to section 16(3)(a) of the Act, the Applicant is not the person entitled to registration of the Marks because the Marks were confusingly similar to the Opponent’s family of KISS and KISSES trademarks previously used or made known in Canada;
- d) Contrary to section 16(3)(b) of the Act, the Applicant is not the person entitled to registration of the Marks because the Marks were confusingly similar to the Opponent’s family of KISS and KISSES trademarks in respect of which an application for registration had previously been filed in Canada;
- e) Contrary to section 2 of the Act, the Marks are not distinctive in Canada of the Applicant’s Goods, in that the Marks do not distinguish, nor are they adapted to distinguish, the Applicant’s Goods from the goods associated with the Opponent’s family of KISS and KISSES trademarks.

[7] The Applicant filed and served a counter statement in each matter in which it denied the Opponent’s allegations. Both parties filed evidence and written arguments, and were ably represented at an oral hearing.

[8] In view of the fact that the Applications are for similar trademarks and the parties, grounds of opposition, and evidence are identical in both proceedings, I have addressed both matters in a single decision.

[9] For the reasons set out below, I refuse the Applications.

#### EVIDENCE

[10] Both parties filed multiple affidavits and each affiant was cross-examined. The transcripts of the cross-examinations, as well as written answers to undertakings and questions taken under advisement during the cross-examinations, form part of the record. The Opponent also included as part of its evidence-in-chief certified copies of the registrations and applications on which it

relies. A brief summary of the parties' evidence is set out below, and the evidence is discussed in further detail in the analysis of the grounds of opposition.

### **Opponent's evidence-in-chief**

#### Affidavit of Pete Vanslyke sworn July 7, 2014 (the Vanslyke Affidavit)

[11] At the time of swearing his affidavit, Mr. Vanslyke was the Director, Marketing, of Hershey Canada Inc. (Hershey Canada), having held that position since 2008. On cross-examination, it was noted that Mr. Vanslyke subsequently became Senior Director of Marketing at Hershey Canada in October 2014.

[12] Mr. Vanslyke attests that the Opponent licenses Hershey Canada and The Hershey Company to use the KISSES trademark, and other trademarks which incorporate KISS or KISSES, in association with chocolates and other goods and services in Canada. Mr. Vanslyke describes Hershey Canada as a wholly owned subsidiary of The Hershey Company and states that Hershey Canada manufactures, distributes and sells confectionery and grocery products in Canada.

[13] Mr. Vanslyke states that the Opponent has direct or indirect control over the character and quality of the goods sold and services rendered by Hershey Canada and The Hershey Company in association with the KISSES trademark and other trademarks which incorporate KISS or KISSES in Canada. I note that the Applicant contests the ability of Mr. Vanslyke to speak to this license agreement, given his lack of first hand knowledge of its terms. However, I am satisfied based on the nature of Mr. Vanslyke's position with the licensee Hershey Canada, the statements in his affidavit relating to the control exercised by the Opponent (see paras 2 to 5 of the Vanslyke Affidavit), and his answers on cross-examination relating to that control (see Q30 to Q58 and Q144 to Q159 of the cross-examination transcript), that Mr. Vanslyke's evidence on this point is admissible.

[14] Mr. Vanslyke states that KISSES brand chocolates have been sold continuously in Canada since at least as early as 1962 - originally by The Hershey Company, and then from the early 1980's by Hershey Canada. KISSES brand chocolates are sold in Canada through a variety of wholesale and retail outlets (including Wal-Mart, Metro, Loblaws and Shoppers Drug Mart),

including bricks and mortar stores and Internet websites. In bricks and mortar retail stores, the KISSES brand chocolates are often displayed for sale in close proximity to other manufacturers' chocolate products, and photographs of such retail displays in Canada are included as Exhibit "E" to the Vanslyke Affidavit.

[15] Representative packaging of the KISSES brand chocolates is included in the Vanslyke Affidavit. In each case, the outer packaging prominently bears the trademark KISSES, and each individual piece of chocolate is wrapped in a conically shaped foil wrapper with a plume at the top that often bears the trademark KISSES.

[16] Wholesale sales figures for KISSES brand chocolates sold in Canada between 1980 and 2014 were in excess of \$350,000,000. Annual sales figures from 1980 to 2014 (with the exception of the years 1993, 1996, 1997 and 2006) are included as Exhibit "G" to the Vanslyke Affidavit. From 2000 to 2013, sales of KISSES brand chocolates in Canada exceeded \$10,000,000 annually.

[17] The KISSES brand chocolates are advertised in a variety of media in Canada, including television, print advertising, online, promotional contests and sponsorships. From 1986 to the date of the Vanslyke Affidavit, in excess of \$10,000,000 was spent in Canada on advertisement and promotion of the KISSES brand chocolates.

### **Applicant's evidence**

#### Affidavit of Michael G. Rosenberg sworn November 30, 2015 (the Rosenberg Affidavit)

[18] Mr. Rosenberg is the founder, President and CEO of the Applicant. He describes the history of the Applicant and its involvement in the confectionery business. The Applicant was founded in 1979 and grew to be the 12th largest confectionery producer in North America and one of the 50 largest in the world.

[19] The Applicant licenses third party brands and also develops its own proprietary brands of candy products. For most of its history, the Applicant purchased the candy products it marketed from third party suppliers which manufactured the products pursuant to the Applicant's formulas

and recipes. However, starting in approximately 2003-2004, the Applicant decided to become a manufacturer itself and to this end opened a factory in New Jersey in 2006.

[20] Mr. Rosenberg describes that the Applicant has been involved in the importation of European chocolate, including from Switzerland. As of the early 2000's the Applicant had been selling a third party Swiss chocolate product for many years and had developed its own label SUISSE in connection with that product. However, Mr. Rosenberg states at paragraph 9 of his affidavit that "[a]lthough I thought that the SUISSE name effectively communicated the origins of our chocolate products, I did not believe that the designation was sufficient to enable [the Applicant] to achieve its strategic goals in the Swiss chocolate category." The Applicant thus set out to develop a new brand for the Swiss chocolate product.

[21] In describing the history of his conception and development of the SWISSKISS brand, Mr. Rosenberg states that he selected the name SWISSKISS for multiple reasons, including the following: that it conveys the product's origin; it connotes romance and the associated notion of a loving gift of chocolate; the rhyming prefix and suffix created an appealing rhythmic flow and made the mark more memorable; the double meaning of "kiss" suggesting a romantic gesture and also being a term with long roots in the candy industry that has been applied to many different types of candy.

[22] Mr. Rosenberg states as follows at paragraph 11 of his affidavit: "At the time I selected the SWISSKISS name, I had absolutely no intention of drawing any connection with HERSHEY'S KISSES. Indeed, any such association would actually have been inconsistent with [the Applicant's] marketing plan, which aimed to position the product as a premium Swiss chocolate and not the more inexpensive American product with which Hershey is identified." Mr. Rosenberg states at paragraph 8 of his affidavit that, "Swiss chocolate is distinguished in the marketplace as a premium product that typically commands a higher price and enjoys a more upscale image than more familiar chocolate candy like the products manufactured by Hershey."

[23] Under the heading, "The Common Use of the Term 'KISS' in the Candy and Food Industries", Mr. Rosenberg describes, and includes as exhibits, various confectionery conference directories and buyers guides wherein the term "kiss" is used descriptively to identify a confectionery product category. Mr. Rosenberg also identifies multiple third party candy

products which he indicates are available in Canada and include the term “kiss” in the product name, including the following:

- Kerr brand “Maple Kisses”, “Molasses Kisses”, and “Candy Cane Kisses”;
- Hagensborg “Kiss Me” Chocolate Frog;
- Peanut Butter Kisses;
- Valentine’s Day chocolates sold in Nando’s restaurants in 2014 in association with the phrase “Nando’s Kisses”; and
- BACI brand candy [“baci” means “kisses” in Italian].

[24] The Rosenberg Affidavit also includes as Exhibit 10 an extract from the *Canadian Oxford Dictionary, 2<sup>nd</sup> Ed.*, which includes the following definition for the word “kiss”: “bite-sized baked meringue or esp. chocolate candy”.

[25] Mr. Rosenberg describes legal disputes in the United States involving the Opponent and the trademark KISSES, including an action by the Opponent against the Applicant in the United States District Court for the District of New Jersey for, *inter alia*, infringement and dilution of the Opponent’s registered trademark KISSES in the United States (the U.S. Infringement Action). A copy of the U.S. Court’s decision from the U.S. Infringement Action is included as Exhibit 9 to the Rosenberg Affidavit and is discussed in further detail, below.

[26] Mr. Rosenberg attests that based on years of running a candy company that services both the United States and Canadian markets, he has acquired considerable knowledge about the operation of both those markets in the candy industry. He states that in his experience, the United States and Canadian markets share many of the same features, including most of the same popular candy brands; overlapping customer bases, preference and purchasing habits; and common marketing and sales channels and materials.

[27] Mr. Rosenberg describes and attaches as exhibits images of the Applicant’s product packaging that was in issue in the U.S. Infringement Action (see Exhibits 26 and 29 to the

Rosenberg Affidavit). However, there is no evidence that the Applicant has ever sold goods in any of these packaging formats in Canada.

[28] Mr. Rosenberg provides his views, based on testimony and documents exchanged during the U.S. Infringement Action, as to what elements define the HERSHEY'S KISSES brand identity. Mr. Rosenberg gives particular attention to the consistent presence of the HERSHEY house mark, the product's conical shape, and the plume (sometimes referred to as a ribbon or flag) that protrudes from the top of the candy.

Affidavit of Anastasia Trifonova sworn December 2, 2015 (the Trifonova Affidavit)

[29] Ms. Trifonova, at the time of swearing her affidavit, was a law student employed by the agents for the Applicant. Her affidavit includes the results of numerous Internet searches for candy products which include the word "KISSES" or "KISS" in the product name, as well as evidence regarding the purchase of some of those products from Canadian retailers, including the following:

- Purity "Peanut Butter Kisses", "Rum and Butter Kisses", and "Assorted Kisses";
- Kerr "Molasses Kisses", and "Maple Kisses";
- Original Foods "Halloween Kisses";
- Hagensborg "Kiss Me Truffle Frog Milk Chocolate";
- Baci Perugina product, wherein the packaging states that "Bacio" is the Italian word for "Kiss";
- "Maple Kisses Caramels" by Heart Industries Ltd. and "Maple Kisses from Canada" by Niagara River Trading Company.

[30] The Trifonova Affidavit also includes multiple online dictionary entries for the word "KISS". Examples include the following:

*Merriam-Webster*



**a:** a small drop cookie made of meringue **b:** a bite-size piece of candy often wrapped in paper or foil

*Oxford Dictionaries*

2 *North American* A small cake or cookie, typically a meringue.

2.1 A small candy, especially one made of chocolate.

### **Opponent's reply evidence**

Affidavit of Laurence Virtue-Deshaies sworn March 24, 2017 (the Virtue-Deshaies Affidavit)

[31] Ms. Virtue-Deshaies is a lawyer with the agent of the Opponent. Her affidavit includes printouts from multiple websites (including many of those identified in the Trifonova Affidavit), as well as printouts of particulars of applications and registrations on the Canadian Intellectual Property Office trademark register.

### **Applicant's additional evidence**

Supplemental Affidavit of Anastasia Trifonova sworn September 20, 2017 (the Supplemental Trifonova Affidavit)

[32] The Applicant was granted leave by the Registrar to file the Supplemental Trifonova Affidavit on November 28, 2017.

[33] The Supplemental Trifonova Affidavit includes information and printouts regarding the website *www.purity.nf.ca* and candy products identified on that website which included the term "KISSES". The contents of the Supplemental Trifonova Affidavit appear to be directed primarily in response to the content of the Opponent's reply evidence and the cross-examination thereon. In my view, the Virtue-Deshaies Affidavit filed by the Opponent in reply did not assist the Opponent in any way, and so I will refrain from discussing it, or the responding Supplemental Trifonova Affidavit, in detail.

### ONUS AND MATERIAL DATES

[34] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the Application complies with the requirements of the Act. This means that if a determinate

conclusion cannot be reached in favour of the Applicant after a consideration of all of the evidence, then the issue must be decided against the Applicant. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[35] The material dates with respect to the grounds of opposition are as follows:

- Sections 38(2)(a)/30 of the Act - the filing date of the Applications, namely, February 5, 2013 [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Sections 38(2)(b)/12(1)(d) of the Act - 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) of the Act – the filing date of the Applications, namely, February 5, 2013; and
- Sections 38(2)(d)/2 of the Act - the filing date of the oppositions, namely April 28, 2014 for the Word Mark Application and December 23, 2013 for the Design Mark Application [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 2004 FC 1185, 34 CPR (4th) 317 (FC)].

#### ANALYSIS OF THE GROUNDS OF OPPOSITION

##### **Preliminary Issues**

##### Ownership of the Registrations/Applications relied on by Opponent

[36] The named Opponent in these proceedings is Hershey Chocolate & Confectionery Corporation. From the inception of these proceedings and until March 8, 2019, the Opponent was the owner of the trademark registrations and applications on which it relies. In this regard, as part of its evidence-in-chief, the Opponent filed certified copies of those registrations and applications which identify the Opponent as the owner.

[37] However, on March 8, 2019, those registrations and applications were assigned from the Opponent to Hershey Canada and that transfer was recorded with the Registrar. Hershey Canada and its relationship with the Opponent is set out above in the discussion of the Vanslyke Affidavit; however, Hershey Canada is not named as an opponent in these proceedings.

[38] This change of ownership of the registrations and applications on which the Opponent relies took place relatively late in the proceeding, after all of the parties' evidence and written arguments had been submitted, but prior to the oral hearing. In my view, this change in ownership does not impact the assessment of the grounds of opposition for the reasons set out below.

[39] With a ground of opposition based on section 12(1)(d), an opponent is permitted to rely on the registration of another party [see *USV Pharmaceuticals of Canada Ltd v Sherman and Ulster Ltd* (1974), 15 CPR (2d) 79 (TMOB)]. Thus, in this case, for the purpose of the section 12(1)(d) ground, the Opponent is permitted to rely on registrations which, as of the date of this decision, are owned by Hershey Canada.

[40] With a ground of opposition based on non-entitlement under section 16(3)(a), an opponent is not permitted to rely on another party's trademark use; the use relied on must be the opponent's own use (or licensed use which accrues to the opponent) [see section 17(1) of the Act]. In this case, since the material date for the section 16(3)(a) ground of opposition is the filing date of the Applications (February 5, 2013), all use of the trademarks prior to the material date was indeed use by the Opponent (specifically licensed use which accrued to the Opponent), since the assignment of the registrations and applications from the Opponent to Hershey Canada did not take place until well after the material date. Thus, the assignment does not impact the section 16(3)(a) ground.

[41] Similarly, since the assignment of the registrations and applications did not take place until after the material dates for the section 16(3)(b), sections 30(e) and 30(i) and section 2 grounds of opposition, in my view, the assignment does not impact those grounds.

## Is KISS a Generic Term?

[42] An important element of the Applicant's case in these proceedings is the evidence it has provided of the use of the term "kiss(es)" as a generic description for a small piece of candy. The volume of evidence the Applicant has included on this point is substantial, and includes the following:

- Dictionary definitions. For example, the *Canadian Oxford Dictionary, 2<sup>nd</sup> Ed.*, published in 2004, includes the following definition for "kiss": "bite-sized baked meringue or esp. chocolate candy".
- Third party use of the term "kiss(es)" in association with candy; and
- Disclaimers in the Opponent's own registrations (as identified in certified copies thereof). In particular, some of the older registrations relied on by the Opponent, including registration nos. TMA265,743 (HERSHEY'S KISSES), TMA332,690 (A BIG KISS FOR YOU), and TMA325,066 (THE ULTIMATE KISS), each include a disclaimer to exclusive use of the word KISS (or KISSES) apart from the trademark as a whole.

[43] In short, the Applicant's position is that because "kiss" is a generic term for a small piece of candy, and that is the only element shared by both parties' marks, there is no likelihood of confusion. I sympathize to a degree with the Applicant on this point because its evidence demonstrates that, at least at one point in time, the word "kiss" did indeed have this generic connotation.

[44] However, in my view, this evidence does not answer the more specific and relevant question of whether the term "kiss" is generic in Canada in association with chocolate specifically as of the material dates in these proceedings. On this issue, as a starting point, the registrations relied on by the Opponent for the trademarks KISS (TMA833,060) and KISSES (TMA733,263) are a presumptive indication that these terms are *not* generic in Canada in association with chocolate.

[45] In particular, Canadian registration No. TMA833,060 (registered September 27, 2012) is for the trademark KISS in association with "Chocolate candy" and Canadian registration No.

TMA733,263 (registered January 27, 2009) is for the trademark KISSES in association with “Solid chocolate candy with or without ingredients such as nuts.” These registrations are presumed valid, and in the context of an opposition proceeding under section 38 of the Act, the Registrar does not have the jurisdiction to expunge or otherwise declare these registrations invalid [see *La Céleste Levure Inc v Selección de Torres, SL*, 2012 TMOB 196, 105 CPR (4th) 186 at para 19; see also *Magill v Taco Bell Corp* (1990), 31 CPR (3d) 221 (TMOB) at para 22]. To the extent that the Applicant wishes to contest the validity of these registrations on the basis that the terms KISS and KISSES are not distinctive of the Opponent in association with chocolate because they are generic terms, a mechanism exists by which to do so in the Federal Court via sections 18 and 57 of the Act.

[46] Consequently, I must accept the registrations relied on by the Opponent as presumptively valid. Moreover, in my view, the evidence of third party use of the term “KISS(ES)” in Canada in association with chocolate specifically appears to be very limited, namely, the Hagensborg “Kiss Me Truffle Frog Milk Chocolate” product, and an advertisement for a Valentine’s Day chocolate product sold in Nando’s restaurants in 2014 in connection with the phrase “Nando’s Kisses”, and for neither of these products do I have evidence of the volume of sales in Canada. With respect to the candy product sold in association with the trademark BACI (which the evidence indicates includes chocolate as an ingredient), while I can take judicial notice that there are Canadians that speak Italian, I am not permitted to take judicial notice that a substantial portion of the likely Canadian consumers of the parties’ goods speak Italian such that they would understand BACI to mean “kisses” [see *Polaris Industries Inc v Vittoria Industries Ltd*, 2019 TMOB 44, 167 CPR (4th) 345, at paras 57-58; see also *Krazy Glue Inc v Grupo Cyanomex SA de CV* (1992), 45 CPR (3d) 161 (FC)]. In any event, I similarly do not have evidence of the volume of sales in Canada for this product. In my view, the above does not constitute sufficient evidence to render the trademarks KISSES and KISS generic or otherwise devoid of distinctiveness in Canada in association with chocolate.

[47] The existence of the other third party products identified by the Applicant with names which include the term “KISS(ES)” in association with other types of (non-chocolate) candy can certainly narrow the scope of protection afforded to the registrations relied on by the Opponent.

However, I do not consider this evidence sufficient to render the trademarks KISSES and KISS devoid of protection in Canada in association with chocolate specifically.

#### Relevance of the U.S. Infringement Action

[48] The parties to these opposition proceedings have also been involved in legal disputes in the United States involving some of the same trademarks. Most notable among these was an action brought by the Opponent against the Applicant, alleging that the Applicant's SWISSKISS chocolate product infringed and diluted the Opponent's registered trademark KISSES in the United States. In this U.S. Infringement Action, the Applicant's SWISSKISS product was found not to infringe or dilute the Opponent's registered trademark KISSES in the United States.

[49] It is well established that the Registrar is not bound in an opposition proceeding by the finding of a foreign court or tribunal [see *Waterford Wedgwood PLC v Forma-Kutzscher GmbH* (2006), 50 CPR (4th) 358 (TMOB) at paras 25-26; see also *Spirits International NV v SC Prodal 94 SRL* (2005), 50 CPR (4th) 199 (TMOB)]. That said, given that the U.S. Infringement Action involved the same parties, and subject matter which overlaps to a significant degree with the present proceedings, in my view, it is appropriate to explain why I do not find the decision in the U.S. Infringement Action to be persuasive in the present case.

[50] In particular, there is an important difference between the context of the U.S. Infringement Action and the current opposition proceedings – in the U.S. Infringement Action the analysis was with respect to an actual product already distributed by the Applicant in the United States bearing the SWISSKISS trademark, that product having a particular style, colour and packaging configuration. It is apparent that the U.S. Judge relied at least in part on the different overall get-up of the Applicant's product in the United States when considering whether the Applicant's product infringed the Opponent's U.S. trademark. By way of example, at pages 17 and 18 of the U.S. decision, the Judge stated as follows:

In the instant matter, clearly the word "kiss" is part of SWISSKISS. However, there are several other distinguishing elements. For example, even Wege, Hershey's Chief Commercial Officer and Senior Vice President, recognized the product shape, packaging design, color, font and graphics of KISSES and SWISSKISS are significantly different. [...] Differences in presentation such as logos, graphics, packaging, and trade dress can eliminate the likelihood of confusion, even where marks share similar words or elements.

[...]

PIM has used, and claims it intends to continue using, a different color scheme, shape, and Swiss theme for its SWISSKISS product. PIM has incorporated the red and white cross symbol of a Swiss flag, a mountain setting against a blue background, with the brand name presented in red lettering outlined in white, and will not use the iconic conical shape. [...] These distinctions between the parties' products significantly reduce any potential for confusion.

[51] The context of the above analysis is very different from these opposition proceedings, where the Registrar is obliged to consider the registrability of the Word Mark and the Design Mark in isolation, with no limitations as to colour or manner of packaging or presentation of the Marks. This difference between the current proceedings and the U.S. Infringement Action is particularly acute when it comes to the Word Mark Application, given that a word mark registration entitles an owner to depict the mark in whatever font, style or colour it may choose [see *Cheah v McDonald's Corp*, 2013 FC 774, 114 CPR (4th) 241, at paras 3-4]. Similar consideration must be given to the Design Mark, as the Design Mark Application does not include any form of colour claim and omits additional design elements discussed in the above passage from the U.S. decision. In the present opposition proceedings, I am obliged to consider the possibility that the Applicant might well choose to depict its Marks in a colour and packaging get-up that more closely resembles that of the Opponent, as compared to the specific packaging that was before the Court in the U.S. Infringement Action.

[52] There is no evidence of any use of the Marks by the Applicant in Canada. While the Rosenberg Affidavit indicates that the Applicant intends to proceed with packaging similar to that identified in the U.S. proceeding, such a statement in this proceeding is in no way binding and consequently carries little, if any, weight in the confusion analysis.

[53] For the above reasons, I do not consider the decision in the U.S. Infringement Action to be persuasive in the context of these opposition proceedings.

### **Section 12(1)(d) Ground of Opposition**

[54] In considering this ground of opposition, I will assess the likelihood of confusion between the Marks and the registered trademarks KISSES (TMA733,263) and KISS (TMA833,060), as I consider these two registered trademarks to represent the Opponent's

strongest case in terms of the degree of resemblance and the degree of overlap in goods when compared to the Applicant's Applications. I have exercised my discretion to check the register and confirm that these two registrations remain extant [see *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

#### Test for confusion

[55] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold or leased by the same person, whether or not the goods and services are of the same general class or appear in the same class of the Nice Classification. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them.

[56] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 (SCC) 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.

[57] The test for confusion is assessed as 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 trademark, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot, supra*, at para 20]. Also, where it is likely the public will assume the applicant's goods are approved, licensed, or sponsored by the opponent so that a state of doubt and uncertainty exists in the minds of the purchasing public, it follows that



the trademarks are confusing [see *Glen-Warren Productions Ltd v Gertex Hosiery Ltd* (1990), 29 CPR (3d) 7 (FCTD) at para 21].

***Inherent distinctiveness of the trademarks and extent to which they have become known***

[58] The trademarks KISSES and KISS relied on by the Opponent have a relatively low degree of inherent distinctiveness, in view of the evidence put forward by the Applicant of the historical descriptive use of the term “kiss” in the candy industry to describe a small piece of candy.

[59] However, in my view, the Opponent’s evidence demonstrates that with respect to chocolate specifically, the trademark KISSES has acquired a fairly substantial degree of distinctiveness in Canada through extensive sales and advertising over decades. The Opponent’s evidence suggests that the trademark KISS (singular) has been used to a much lesser extent than KISSES, and so I attribute less acquired distinctiveness to the trademark KISS than to the trademark KISSES.

[60] I note that the Applicant takes the position that any distinctiveness in the trademarks KISSES/KISS resides in their combination with the trademark HERSHEY’S. I disagree with that submission for two reasons. First, it is well established that two trademarks can be used together on a single product [*AW Allen Ltd v Canada (Registrar of Trade Marks)* (1985), 6 CPR (3d) 270 (Fed TD), at 272]. Second, in the present case, based on the evidence submitted by the Opponent, it is apparent that the trademarks KISSES/KISS are depicted in a manner that conveys to the purchaser that KISSES/KISS are separate trademarks in their own right (for example, Exhibit “D” to the Vanslyke Affidavit includes multiple packaging samples in which the trademark KISSES is depicted on a different line and much larger font than the trademark HERSHEY’S).

[61] With respect to the Applicant’s Word Mark, in my view, it also has a low degree of inherent distinctiveness. It is comprised of the word “SWISS”, which is descriptive of the geographic origin of the Goods and thus not inherently distinctive [see *London Drugs Ltd v International Clothiers Inc*, 2014 FC 223, 120 CPR (4th) 1, at para 49], and “KISS”, which has a relatively low degree of inherent distinctiveness for the reasons discussed above.

[62] The Applicant's Design Mark has a slightly higher degree of inherent distinctiveness than the Word Mark in view of the mountain design element; however, I do not consider this design element to be a dominant feature or to lend much inherent distinctiveness to the Design Mark as a whole. Similarly, I do not consider the descriptive tag line "FINEST SWISS CHOCOLATES" to add any inherent distinctiveness to the Design Mark. Overall, I consider the Design Mark to have a low degree of inherent distinctiveness for the same reasons as the Word Mark.

[63] There is no evidence that either of the Applicant's Marks have been used or become known to any extent in Canada.

***Length of time the trademarks have been in use***

[64] The Opponent has provided evidence of extensive use in Canada for decades of the trademark KISSES in association with chocolate. The Opponent's evidence suggests that the trademark KISS is used to a much lesser extent than KISSES; nevertheless, the Opponent's evidence includes a limited number of examples of its use of the trademark KISS [see Exhibits "E", "F" and "P" to the Vanslyke Affidavit].

[65] There is no evidence that the Applicant has ever used its Marks in Canada.

[66] Therefore, this factor favours the Opponent.

***Nature of the goods and services; nature of the trade***

[67] In my view, the nature of the parties' goods, namely, chocolate, overlap directly, as do the likely channels of trade.

[68] The Applicant suggested that its product, because it derives from Switzerland, would be a premium product and thus cater to a different market segment than the Opponent's products. However, given that the Applicant has not used the Marks in Canada, and the Applicant's evidence provides no specific pricing information, that position strikes me as entirely speculative at this point and I see no reason to place any weight on that purported distinction. Indeed, I note that Exhibit "E" to the Vanslyke Affidavit includes images of KISSES brand chocolates in close

proximity on retail store shelves to numerous other chocolate brands, including imported brands such as GODIVA identified at paragraph 7 of the Rosenberg Affidavit.

[69] Consequently, this factor favours the Opponent.

### ***Degree of resemblance***

[70] As indicated by the Supreme Court of Canada in *Masterpiece, supra*, in most instances, the degree of resemblance between the trademarks 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 trademark that is “particularly striking or unique” [*Masterpiece, supra*, at paragraph 64].

[71] With respect to the trademarks KISSES and KISS relied on by the Opponent, it is apparent that the most striking element is the word “KISS”.

[72] With respect to the Applicant’s Marks, while the first portion of a mark is often the most significant [see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 at 188 (FCTD)], in this case, I do not consider the first portion of the Marks (i.e. “SWISS”) to be particularly striking or unique, given that word describes the geographic origin of the Goods [see *Caterpillar Inc v Supacat Ltd*, 2011 TMOB 161 at paras 21-23, where this Board held that “CAT” was the most striking or unique aspect of the mark SUPACAT, given that the prefix “SUPA” was non-distinctive].

[73] In my view, the word “KISS” is the most striking aspect of the Applicant’s Marks. I am reinforced in this view by the Applicant’s evidence regarding the development of the name SWISSKISS. In particular, at paragraph 9 of the Rosenberg Affidavit, Mr. Rosenberg describes how the Applicant originally sold its Swiss chocolate product under the trademark SUISSE (i.e. “Swiss” in French). However, Mr. Rosenberg states that “[a]lthough I thought that the SUISSE name effectively communicated the origins of our chocolate products, I did not believe that the designation was sufficient to enable [the Applicant] to achieve its strategic goals in the Swiss chocolate category.” The Applicant then developed the name SWISSKISS. In my view, this

evidence highlights the importance of the “KISS” component to the Applicant’s Marks as a whole, and suggests that it is the “KISS” component that is particularly striking.

[74] The presence of the word “SWISS” in the Applicant’s Marks of course leads to a visual and auditory difference with the trademarks relied on by the Opponent, and conveys an idea that is absent from trademarks relied on by the Opponent. However, for the reasons set out above, I do not think this weighs strongly in the Applicant’s favour, given that “SWISS” is descriptive of the geographic origin of the Goods.

[75] While the Applicant argues that I should consider SWISSKISS as a single, coined term, and recognizing that I must consider each of the Applicant’s Marks as a whole, it nevertheless is apparent that each of the Applicant’s Marks will be read and sounded as two separate words – i.e. “Swiss Kiss”. The combination of upper and lower case letters in the Design Mark (i.e. SwissKiss) reinforces that view.

[76] Ultimately, in my view, the word “KISS” is the most striking or unique aspect of both the Applicant’s Marks and the trademarks relied on by the Opponent, and therefore there is a meaningful degree of resemblance.

### ***Surrounding circumstances***

#### **Family of trademarks**

[77] The Opponent in its statements of opposition asserts that it owns a “family” of trademarks. However, in order to benefit from the wider scope of protection that may be afforded to a “family” of trademarks, an opponent must prove use of each of the marks in the family [see *McDonald’s Corp v Alberto-Culver Co* (1995), 61 CPR (3d) 382 (TMOB)]. In the present case, while the Opponent’s evidence demonstrates extensive evidence of use of the trademark KISSES, and limited use of the trademark KISS, in my view, the evidence does not demonstrate the use of other trademarks sufficient to constitute a family of marks that would assist the Opponent in this case. Thus, in my view, this is not a surrounding circumstance which assists the Opponent.

### Conclusion regarding the section 12(1)(d) ground

[78] Ultimately, the question in this case is whether the average Canadian consumer, with an imperfect recollection of the trademark KISSES and/or KISS in association with chocolate, when they see a Swiss chocolate product bearing the trademark SWISSKISS (or SWISSKISS & Design), would think that the products come from the same source. In my view, if I am to afford any scope of protection to registrations TMA733,263 and TMA833,060, I must answer that question in the affirmative.

[79] The Applicant's Marks are comprised of a descriptive term "SWISS" preceding the term "KISS" for which there are already registered rights in Canada in association with chocolate. I find it reasonable to assume that consumers familiar with the trademark KISSES and/or KISS in association with chocolate would think that Swiss chocolate bearing the trademarks SWISSKISS and SWISSKISS & Design comes from the same entity as the owner of the registered marks, or has been, at the very least, approved, licensed or sponsored by the owner of those registered marks.

[80] In considering this issue, I must take into account that the Applicant's Word Mark Application and Design Mark Application are not circumscribed by any particular colour or packaging style that might help to reduce the likelihood of confusion in the marketplace. To the contrary, registration of the Applicant's Word Mark and Design Mark would entitle the Applicant to depict the Marks in any colour or get-up the Applicant might choose.

[81] Thus, I find that the Applicant has not satisfied its onus on a balance of probabilities to demonstrate no reasonable likelihood of confusion between the Marks and the registered trademarks KISSES (TMA733,263) and KISS (TMA833,060). Consequently, the section 12(1)(d) ground of opposition succeeds with respect to both the Word Mark Application and the Design Mark Application.

### **Section 16(3)(a) Ground of Opposition**

[82] With respect to this ground of opposition, the Opponent has an initial evidential burden to demonstrate use of the trademark KISSES and/or KISS in Canada prior to the filing date of the

Applications, namely, February 5, 2013, and that those trademarks were not abandoned as of the dates of advertisement of the Applications.

[83] As noted above, the Opponent's evidence indicates that it has used the trademark KISSES in Canada in association with chocolate continuously since 1962. The extent of the Opponent's use of the trademark KISS appears to be much less than the trademark KISSES; nevertheless, the Vanslyke Affidavit includes examples of the Opponent's use of the trademark KISS from prior to the material date for this ground [see Exhibit "F" to the Vanslyke Affidavit which includes examples of the use of the trademark KISS prior to December 31, 2008]. There is no evidence to suggest that the Opponent has abandoned the trademarks KISSES or KISS as of the dates of advertisement of the Applications. Consequently, the Opponent has met its initial evidential burden with respect to the section 16(3)(a) ground of opposition.

[84] The Opponent having met its initial burden, in my view, the analysis of the issue of a likelihood of confusion under the section 16(3)(a) ground of opposition is effectively identical to that for the section 12(1)(d) ground. That is to say, the earlier material date for the section 16(3)(a) ground does not materially change the analysis.

[85] Therefore, for the same reasons as set out above with respect to the section 12(1)(d) ground of opposition, I find the Opponent's section 16(3)(a) ground of opposition is successful with respect to both Applications.

### **Remaining Grounds of Opposition**

[86] As I have found in favour of the Opponent with respect to the section 12(1)(d) and section 16(3)(a) grounds of opposition, I do not consider it necessary to address the remaining grounds of opposition.

DISPOSITION

[87] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the Applications pursuant to section 38(12) of the Act.

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Timothy Stevenson  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE** 2019-11-19

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