



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 114

Date of Decision: 2020-10-26

IN THE MATTER OF AN OPPOSITION

Damon Industries Canada Ltd.

Opponent

and

Truefruit Inc.

Applicant

**1,728,881 for FRUITFUL MARKET
& DESIGN**

Application

INTRODUCTION

[1] On May 20, 2015, Truefruit Inc. (the Applicant) filed application No. 1,728,881 (the Application) to register the trademark FRUITFUL MARKET & DESIGN, depicted below (the Mark).

The logo for 'fruitful MARKET' is displayed. The word 'fruitful' is written in a bold, lowercase, sans-serif font where the letters 'f', 'i', and 'l' have stylized, rounded shapes that resemble fruit or leaves. Below 'fruitful', the word 'MARKET' is written in a smaller, all-caps, bold, sans-serif font.

[2] The Application is based on proposed use of the Mark in Canada in association with the following goods and services (the Goods and Services):

Goods

(1) Salads; sandwiches; juices, namely fruit juices, vegetable juices, fruit drinks and juices, smoothies, coffee, tea, soda, excluding those for the bar, restaurant and institutional markets; pastries, muffins, bread, preserved fruits and vegetables, pickles, yogurt parfaits and ready to eat meals comprised primarily of meat and vegetables, pasta and vegetables, and rice and vegetables.

Services:

(1) Retail grocery store services.

[3] The Application was advertised for opposition purposes in the *Trademarks Journal* on May 18, 2016. On October 18, 2016, Damon Industries Canada Ltd. (the Opponent) filed a statement of opposition against the Application 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).

[4] The Opponent raises grounds of opposition based on registrability under section 12(1)(d), entitlement under section 16(3)(a), distinctiveness under section 2, and non-compliance with sections 30(e) and 30(i) of the Act. With respect to the registrability, entitlement and distinctiveness grounds, the Opponent relies on its use and registration of the three trademarks set out in Schedule “A” to this decision, each of which include or are comprised of the term “FRUITFUL”.

[5] Both parties filed evidence and written representations. A hearing was held at which both parties were represented.

[6] For the reasons that follow, the Application is refused.

EVIDENCE

[7] The evidence filed by the parties is briefly summarized below and is further discussed in the analysis of the grounds of opposition.

Opponent's Evidence

[8] The Opponent filed the affidavit of John Durkin sworn August 9, 2017 (the Durkin Affidavit), the affidavit of Luciana Da Costa sworn August 9, 2017 (the Da Costa Affidavit), and the affidavit of Rojin Jazayeri sworn August 9, 2017 (the Jazayeri Affidavit). None of these affiants were cross-examined.

The Durkin Affidavit

[9] Mr. Durkin is the President of the Opponent and has held that position for over 25 years. He indicates that the Opponent was incorporated in Ontario on September 24, 1991 and has been carrying on business since that date.

[10] Mr. Durkin states that the Opponent operates in the food and beverage industry, and at paragraph 6, describes that “[m]y Company’s customers span across the food and beverage industry (including cafés, bistros, restaurants, juice bars and bars), the hospitality industry (including hotels and inns) and institutional markets industry (including universities, colleges, military bases, work camps, ministries, retirement residences, etc.).”

[11] At paragraph 8, Mr. Durkin references the Opponent’s ownership of Canadian registration Nos. TMA706,010 (FRUITFUL), TMA706,009 (FRUITFUL Juice Products & Design) and TMA706,526 (FRUITFUL Juice Products & Design). The goods and services covered by these registrations are set out in full in Schedule “A” to this decision. By way of example, TMA706,010 includes the goods “[s]helf stable beverages and beverage concentrates for the bar, restaurant and institutional markets, namely, juice concentrates, [...] juices, [...] smoothies, and sports drinks” and the services “[l]easing of beverage dispensing equipment, namely, the leasing of mechanical juice dispensers for bar, restaurant and institutional markets”.

[12] Mr. Durkin also indicates that the Opponent is the owner of the domains <fruitful-ca.com>, <fruitful.ca>, and <fruitfulca.com>.

[13] Mr. Durkin defines the Opponent's "Goods" and "Services" in the same manner as they are described in registration TMA706,010 and states at paragraph 14 that "[m]y Company has been selling and continues to sell its Goods and Services in Canada under its FRUITFUL trademark, which trademark has been registered and used in Canada since at least as early as September, 1991 and continues to be used." He further states at paragraph 15 that, "[o]ver the last 25 years, my Company has had sales in Canada in excess of \$40 million of its FRUITFUL Goods and Services with annual sales ranging from approximately \$1 million to \$4 million."

[14] Included as Exhibit "B" are what Mr. Durkin describes as "representative samples of packaging labels prominently displaying the FRUITFUL Trademark." The labels appear to be for various juice and soft drink concentrates.

[15] Exhibit "C" to the Durkin Affidavit is described as "photographs representative of self-serve FRUITFUL juice dispensers of my Company's FRUITFUL Goods and Services at various customer locations in Canada such as health care homes, comfort inns, etc." The juice dispensers depicted in Exhibit "C" each appear to be counter-top units from which an individual serves themselves from the dispenser with one of multiple of beverage options. Each juice dispenser prominently displays the trademark FRUITFUL in plain sight of the user. A similar example of a self-serve juice dispenser displaying the trademark FRUITFUL is seen in advertising material included in Exhibit "G" to the Durkin Affidavit.

[16] Exhibits "D" through "J" are additional examples of the Opponent's display of its trademark FRUITFUL, including on invoices to customers in Canada (including various juice bars, pubs and retirement homes), as well as on delivery trucks, business cards, advertising brochures and at trade-shows.

The Da Costa Affidavit

[17] Ms. Da Costa is an administrative assistant at the law firm representing the Opponent. Her affidavit includes, *inter alia*, certified copies of the trademark registrations on which the

Opponent relies, and printouts of various websites (and archived versions thereof) and social media accounts.

The Jazayeri Affidavit

[18] Ms. Jazayeri was, at the time of swearing her affidavit, a summer student at the law firm representing the Opponent. Her affidavit includes, *inter alia*, photographs from a visit to the Applicant's business at 327 Carlaw Ave., Toronto, Ontario on August 7, 2017, including images of the display of the Applicant's Mark on signage and on various food and beverage products.

Applicant's Evidence

[19] The Applicant filed the affidavit of Yannis Banks sworn November 27, 2017 [the Banks Affidavit]. Mr. Banks was not cross-examined on his affidavit.

[20] Mr. Banks is the President of the Applicant. He indicates that the Applicant commenced use of the Mark in association with the operation of a kitchen selling prepared foods, as well as a retail grocery store, on October 16, 2015, at a single location in Toronto, and since that date has continuously used the Mark in association with retail grocery store services and the sale of a variety of food and beverage products including salads, sandwiches, fruit juices, vegetable juices, smoothies, coffee, tea, soda, pastries and ready to eat meals.

[21] Photographs of the Applicant's business, including the display of the Mark on signage and the packaging of individual food and beverage items such as soups and smoothies, are included as Exhibit "A" to the Banks Affidavit. In all such examples of the display of the Mark by the Applicant, the "®" symbol is depicted directly beside the term "FRUITFUL".

[22] Mr. Banks indicates that the primary business of the Applicant is the operation of the retail store selling prepared foods, which represents approximately 65% of the Applicant's total sales, with 35% of the sales being derived from the retail grocery store part of the business.

[23] Mr. Banks states that from October 16, 2015 to October 2016, the Applicant had sales of approximately \$675,000 in association with the Mark, and from October 18, 2016 to November 2017, had sales of approximately \$900,000 in association with the Mark.

[24] Mr. Banks states that the Applicant does not sell or distribute any goods or services to the bar, restaurant or institutional markets.

[25] The Banks Affidavit also includes printouts of the particulars of various third party Canadian trademark registrations, as well as printouts of websites displaying third party trademarks which include the term FRUITFUL.

ONUS AND MATERIAL DATES

[26] 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].

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

- Section 38(2)(a) / 30 of the Act – the filing date of the Application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Section 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)];
- Section 38(2)(c) / 16(3)(a) of the Act – the filing date of the Application;
- Sections 38(2)(d) and 2 of the Act - the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317 (FC)].

GROUND OF OPPOSITION SUMMARILY DISMISSED

Non-compliance with section 30(e) of the Act

[28] The Opponent pleads that the Application does not conform to the requirements of section 30(e) of the Act because the Applicant did not intend to use the Mark in Canada in association with the Goods and Services.

[29] Specifically, the Opponent takes the position that the trademark the Applicant intended to use when it filed the Application was not the Mark applied for (i.e. FRUITFUL MARKET & DESIGN), but instead the trademark FRUITFUL on its own. In this regard, the Opponent relies on the evidence that the Applicant displays the Mark with the “®” symbol directly beside the word “FRUITFUL” in a manner that would suggest to consumers that “FRUITFUL” is the term being claimed as a trademark. As an aside, I note that the Applicant’s inclusion of the “®” symbol in its display of the Mark is misleading, as it did not have a registered trademark.

[30] In my view, the Opponent has not met its initial evidential burden for the section 30(e) ground. Both parties’ evidence demonstrates that the Applicant has displayed the Mark as applied for in its entirety, and in my view the Applicant’s inclusion of the “®” symbol beside the word FRUITFUL does not demonstrate that the Applicant did not intend to use the Mark.

[31] In any event, if I am wrong on the question of whether the Opponent has met its initial evidential burden, then the Applicant has satisfied me on a balance of the probabilities that its Application complies with section 30(e). The evidence demonstrates that the Applicant has displayed the Mark in its entirety, including the word “MARKET” and the design elements on the word “FRUITFUL”, and in my view this is sufficient to demonstrate that the Applicant intended to use the Mark at the time of filing the Application.

[32] Accordingly, the section 30(e) ground of opposition is dismissed.

Non-compliance with section 30(i) of the Act

[33] The Opponent pleads that, 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 and Services,

because at the date of filing the Application, the Applicant was aware or should have been aware that the Mark was confusing with the Opponent's registered trademarks.

[34] Section 30(i) of the Act requires an applicant to include a statement in the application that the applicant is satisfied that it is entitled to use the trademark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant's statement untrue, such as evidence of bad faith or non-compliance with a federal statute [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155; and *Canada Post Corporation v Registrar of Trade-marks* (1991), 40 CPR (3d) 221 (FCTD)]. Mere knowledge of the existence of an opponent's trademark is not sufficient to support a section 30(i) ground of opposition [see *Woot Inc v WootRestaurants Inc*, 2012 TMOB 197].

[35] In the present case, the Application contains the requisite statement and there is no evidence that this is an exceptional case involving bad faith or the violation of a federal statute. Accordingly, the section 30(i) ground of opposition as pleaded in the Opponent's statement of opposition is dismissed.

[36] I note that in paragraphs 69 to 71 of its written representations, the Opponent also raised an allegation that the Application did not comply with section 30(i) because the Applicant's use of the Mark would depreciate the value of the goodwill associated with the Opponent's registered trademarks pursuant to section 22 of the Act. However, the Opponent did not plead section 30(i) in conjunction with section 22 in its statement of opposition (or any language that could be considered to encompass such an allegation), and so I dismiss that allegation on the basis that an opponent cannot rely on a ground of opposition which it has not pleaded [see *Imperial Developments Ltd v Imperial Oil Ltd* (1984), 79 CPR (2d) 12 (FCTD)].

SECTION 12(1)(D) GROUND OF OPPOSITION

[37] The Opponent pleads that the Mark is not registrable because it is confusing with the Opponent's registered trademarks FRUITFUL (TMA706,010), Fruitful Juice Products & Design (TMA706,009), and Fruitful Juice Products & Design (TMA706,526). I have exercised my

discretion to check the Register and confirm that each of those registrations remains extant [see *Quaker Oats Co Ltd of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[38] In considering this ground of opposition, I will focus on the Opponent's registered word trademark FRUITFUL (TMA706,010) as in my view it represents the Opponent's strongest case.

Test for confusion

[39] 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, leased, hired or performed 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) of the Act: 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.

[40] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *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.

[41] 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].

Degree of resemblance

[42] It is preferable to start the analysis by determining whether there is an aspect of each trademark that is “particularly striking or unique” [*Masterpiece, supra*, at paragraph 64].

[43] The striking element of the Opponent’s registered word trademark – indeed its only element – is the word “FRUITFUL”.

[44] The striking element of the Applicant’s Mark is also the word “FRUITFUL”. With the Applicant’s Mark, the word “FRUITFUL” is depicted above, and in a noticeably larger font than, the word “MARKET”, and is the first component of the mark when read. The word “MARKET” is also rendered less striking or unique by virtue of it being descriptive in relation to the Applicant’s Goods and Services. In addition, in my view, the evidence of the Applicant’s use of the Mark suggests that the Applicant itself considers “FRUITFUL” to be the most important element of the Mark, given that it chose to place the “®” symbol directly next to that word when depicting the Mark.

[45] With the above in mind, the degree of resemblance between the parties’ trademarks is very high, as the most striking element of both parties’ trademarks is identical. The Applicant’s Mark incorporates the entirety of the Opponent’s registered trademark FRUITFUL, and adds the descriptive term “MARKET” in a smaller font below. I do not consider the design elements of the Applicant’s Mark to assist in reducing the degree of resemblance, given that the Opponent’s registration No. TMA706,010 is for the word trademark FRUITFUL, which entitles the Opponent to use the trademark in any font, style or colour [see *Pizzaiolo Restaurants Inc v Restaurants La Pizzaiolle Inc*, 2016 FCA 265, 142 CPR (4th) 329 at paras 24-25].

[46] Therefore, the degree of resemblance factor strongly favours the Opponent.

Inherent distinctiveness of the trademarks and the extent they have become known

[47] In my view, both parties’ trademarks possess a low degree of inherent distinctiveness in association with their respective goods and services. The term “FRUITFUL” is a common English adjective that is suggestive of the production of good results and abundance [see *Canadian Oxford Dictionary*, 2nd Ed.]. While the Applicant’s Mark includes some leaf design

elements as part of the lettering, I do not consider these design elements to add significantly to the inherent distinctiveness of the Mark as a whole, nor in my view does the inclusion of the descriptive term “MARKET”.

[48] Trademarks that have a low inherent distinctiveness can nevertheless acquire distinctiveness through extensive use and advertising. The Opponent’s evidence indicates that the Opponent has used its trademark FRUITFUL in Canada in association with the goods and services listed in registration TMA706,010 since at least as early as 1991. The Opponent sells its goods and services in association with its trademark FRUITFUL to multiple different types of customers, including restaurants, juice bars, hotels and retirement residences, and has had sales in excess of \$40 million over 25 years. Thus, I am satisfied that the Opponent’s trademark FRUITFUL is known to a considerable extent in its channels of trade.

[49] The Applicant has been using its Mark in association with the Goods and Services since October 2015 at its single retail location. Thus, while the Applicant’s Mark has likely also become known to some extent, given the scale and duration of the Opponent’s use of its trademark, in my view, the evidence suggests that the Opponent’s trademark is likely known to a greater extent than the Applicant’s Mark.

[50] Consequently, taking into account both the inherent distinctiveness of the parties’ trademarks and the extent to which they have become known, on balance, this factor favours the Opponent.

Length of time the trademarks have been in use

[51] The Opponent’s evidence demonstrates that it has used the trademark FRUITFUL in Canada since at least as early as 1991. The Applicant’s evidence demonstrates that the Applicant has used its Mark since October, 2015. Accordingly, this factor favors the Opponent.

Nature of the goods, services or business; and nature of the trade

[52] When considering the goods and services of the parties, it is the statement of goods and services in the parties’ trademark application and registration that govern the issue of confusion arising under section 12(1)(d) [*Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR

(3d) 3 (FCA); and *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)]. However, those 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. In this regard, evidence of the actual trades of the parties can be useful, particularly where there is an ambiguity as to the goods or services covered in the application or registration at issue [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB)].

[53] In this case, both parties filed evidence regarding the nature of their businesses and the use of their respective trademarks, and in my view that evidence is generally consistent with the respective descriptions of goods and services contained in the Application and the Opponent's registration No. TMA706,010.

[54] Both parties operate in the food and beverage industry; however, it is apparent from the evidence that there are differences in the specific nature of parties' businesses. In particular, the Opponent is a business to business operation, which sells its juices, juice concentrates and beverage dispensers to institutions such as restaurants, hotels, and retirement homes. In contrast, the Applicant sells food and beverage products to individual consumers at the retail level. Indeed, in the description of goods in the Application, the Applicant has specified "excluding those for the bar, restaurant and institutional markets" in its description of beverage items.

[55] However, despite these differences, in my view, the parties' goods and services are nevertheless sufficiently related that this factor weighs slightly in the Opponent's favour. For example, included in the description of services for the Opponent's registration No. TMA706,010 is the service "Leasing of beverage dispensing equipment, namely, the leasing of mechanical juice dispensers for bar, restaurant and institutional markets; [...]". While the Opponent does not appear to market or sell its beverage products directly to consumers, the Opponent's evidence indicates that the Opponent's trademark FRUITFUL is nevertheless displayed to end consumers of those beverages, by virtue of the display of that trademark on the Opponent's beverage dispensing machines, in a way that identifies to end consumers that FRUITFUL is the source of the beverage product [for example, see Exhibit "C" to the Durkin Affidavit]. With respect to the Applicant's activities, the evidence demonstrates that as part of

the Applicant's business, it is serving food and beverage products (including smoothies and coffee/tea) to customers in containers labelled with the Mark.

[56] I note that in its written representations, and at the hearing, the Applicant alleged various ambiguities in the Durkin Affidavit relating to the Opponent's use of its trademarks. For example, as it relates to Exhibit "C" and the display of the Opponent's trademark FRUITFUL on juice dispensers, the Applicant at paragraph 31 of its written representations argues "[i]t is also unclear as to whether the dispensers were provided in furtherance of the Opponent's services, or whether they were provided for promotional purposes to publicize the Opponent's beverage products." However, to the extent the Applicant considered any aspect of the Durkin Affidavit to be misleading or inconsistent with the description of goods and services in the Opponent's registration, the Applicant had the opportunity to cross-examine Mr. Durkin on his affidavit, and the Applicant elected not to do so. In my view, on a fair reading of the Durkin Affidavit (and in particular paragraph 19 and the related Exhibit "C"), the Opponent has demonstrated that in at least some instances the Opponent's trademark FRUITFUL has been used to identify the source of its beverages to end consumers, and in the absence of evidence to the contrary I am not inclined to read the Durkin Affidavit as aggressively against the interests of the Opponent in the manner contended by the Applicant.

[57] Taking the above into account, in my view, this factor favours the Opponent, albeit only to a slight degree.

Additional surrounding circumstances

State of the Register and marketplace

[58] Evidence concerning the state of the Register is relevant to the extent that inferences may be drawn regarding the state of the marketplace [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Del Monte Corporation v Welch Foods Inc* (1992), 44 CPR (3d) 205 (FC)]. Inferences regarding the state of the market may be drawn from such evidence only if a large number of relevant registrations are located [*Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA); *McDowell v Laverana GmbH & Co KG*, 2017 FC 327 at paras 41-46]. Relevant trademarks include those that (i) are registered or are allowed and

based on use; (ii) are for similar goods and services as the marks at issue, and (iii) include the component at issue in a material way [*Sobeys West Inc v Schwan's IP, LLC*, 2015 TMOB 197].

[59] In the present case, in Exhibits “D” through “J” of the Banks Affidavit, the Applicant has identified various third party trademark registrations which include the term “FRUITFUL”, and evidence of the use of one of those registered trademarks, as well as other unregistered trademarks, in the marketplace. By way of example, I have included in the table below the third party registered trademarks on which the Applicant relies.

Reg. No.	Trademark		Goods/Services
TMA454,712	FRUITFULL	GANONG BROS., LIMITED	Food products namely chewy fruit snacks.
TMA918,606	FRUITFULL AU CHOCOLAT	GANONG BROS. LIMITED	Confectionery, namely, fruit pectin jellies; confectionery, namely, fruit pectin jellies coated with chocolate; chocolate confectionery.
TMA621,812	FRUITFUL ISLAND	Yao-She Hung	Sesame oil, chilli oil, textured soy protein for use as a food additive and, fish feed.
TMA585,898	YOURS FRUITFULLY	Lassonde Industries Inc.	Goods (1) Non-alcoholic beverages, namely fruit juices, fruit drinks, fruit punches, vegetable juices, ice teas, soft drinks. Services (1) Promoting the sale of non-alcoholic beverages through the distribution of printed materials and/or broadcast media, namely by means of print, radio and television broadcasts, posters or via electronic and internet sources; advertising and promotional services with respect to non-alcoholic beverages through the conducting of contests and sweepstakes activities, in-store displays, distribution of coupons and promotional items.
TMA372,340	FRUITFUL BRAN	Kellogg Company	Food products, namely breakfast cereals, and snack food cereals.

[60] I do not consider any of the third party trademarks located by the Applicant to be as close, taking into account the degree of resemblance and the associated goods and services, as are the Applicant's Mark and the Opponent's trademark in this case. In addition, I do not consider that the Applicant has identified a sufficient number of third party marks to suggest that the term "FRUITFUL" is so common in the marketplace as to preclude a finding of confusion in the present case. Consequently, in my view, the state of the register and state of the marketplace evidence does not significantly assist the Applicant.

Concurrent use

[61] The Applicant argues that the co-existence of the parties' trademarks is a surrounding circumstance which weighs in its favour.

[62] Evidence of instances of actual confusion is not required in order to demonstrate a likelihood of confusion. However, concurrent use of two trademarks without such instances of actual confusion is a surrounding circumstance which can suggest an absence of a likelihood of confusion, depending on the specific nature and duration of that concurrent use [see *Christian Dior SA v Dion Neckwear Ltd*, 2002 FCA 29, 20 CPR (4th) 155 (FCA) at para 19; see also *Maple Leaf Consumer Foods Inc v Kelbro Enterprises Inc*, 2012 TMOB 28, 99 CPR (4th) 424].

[63] In the present case, neither party filed any evidence speaking to the presence or absence of incidences of actual confusion. While the absence of evidence of actual confusion weighs in the Applicant's favour, I do not attribute much weight to this factor in this case, given the limited scope of the Applicant's use of its Mark [see *Alpha Sportswear Ltd v Alpha Industries Inc* 2004, 39 CPR (4th) 87 (TMOB) at para 31].

Conclusion regarding confusion

[64] Having considered all of the surrounding circumstances, and in particular the high degree of resemblance between the trademarks, the extent to which the Opponent's trademark has become known, and the fact that the parties' goods and services are related, I find that at best for the Applicant, the probability of confusion between the Mark and the Opponent's trademark FRUITFUL is evenly balanced between a finding of confusion and no confusion. As the onus is

on the Applicant to demonstrate on a balance of probabilities that there is no reasonable likelihood of confusion between the trademarks, I must therefore find against the Applicant.

[65] Consequently, the section 12(1)(d) ground of opposition succeeds.

SECTION 16(3)(A) GROUND OF OPPOSITION

[66] With this ground of opposition, the Opponent pleads that the Applicant is not the person entitled to registration of the Mark because as of the filing date of the Application (i.e. May 20, 2015) the Mark was confusing with the Opponent's trademarks set out in Schedule "A" to this decision, all of which are alleged to have been previously used in Canada. I will again focus my analysis on the Opponent's registered word trademark FRUITFUL, as this represents the Opponent's best case.

[67] In my view, the Opponent's evidence of its use of the trademark FRUITFUL since 1991 in association with the goods and services listed in registration TMA706,010 is sufficient to satisfy the Opponent's initial evidential burden.

[68] The Opponent having met its initial evidential burden, the Applicant then has a legal burden to demonstrate that there was no likelihood of confusion as of the filing date of the Application. In my view, the confusion analysis for the non-entitlement ground of opposition is effectively identical to that set out above for the section 12(1)(d) ground of opposition, with the exception that the earlier material date for the section 16(3)(a) ground further favours the Opponent, since the factor of concurrent use no longer weighs in the Applicant's favour when the material date is May 20, 2015.

[69] Consequently, I find that the Applicant has not met its legal burden to demonstrate no likelihood of confusion as of the Application filing date, and the section 16(3)(a) ground of opposition succeeds.

SECTION 2 GROUND OF OPPOSITION

[70] As I have already found in the Opponent's favour in respect of the section 12(1)(d) and section 16(3)(a) grounds, I will refrain from addressing the section 2 ground of opposition.

DISPOSITION

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

Timothy Stevenson
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Trademarks relied on by the Opponent

Trademark	Registration Number	Goods/Services
FRUITFUL	TMA706,010	<p>Goods (1) Shelf stable beverages and beverage concentrates for the bar, restaurant and institutional markets, namely, juice concentrates, non-alcoholic fruit based beverages used in mixed drinks, non-alcoholic fruit based carbonated beverages, frozen carbonated beverages, fruit based frosted cocktail mixes, juices, non-carbonated beverages namely, iced teas, lemonades and fruit punches, smoothies, and sports drinks.</p> <p>Services (1) Leasing of beverage dispensing equipment, namely, the leasing of mechanical juice dispensers for bar, restaurant and institutional markets; the leasing of juice carts for skilled nursing facilities; the leasing of countertop refrigeration units for cafeterias, buffet service, fast-food chains, and counter service; the leasing of drink towers for dispensing beverages in convenience stores. (2) Operation of a business comprising the sale and distribution of shelf stable beverages and beverage concentrates and dispensing equipment for the bar, restaurant and institutional markets. (3) Operation of a business comprising the sale, distribution, and turnkey delivery to bar, restaurant and institutional premises of shelf stable beverages and beverage concentrates.</p>
	TMA706,009	<p>Goods (1) Shelf stable beverages and beverage concentrates for the bar, restaurant and institutional markets, namely, juice concentrates, non-alcoholic fruit based beverages used in mixed drinks, non-alcoholic fruit based carbonated beverages, frozen carbonated beverages, fruit based frosted cocktail mixes, juices, non-carbonated beverages namely, iced teas, lemonades and fruit punches, smoothies, and sports drinks.</p> <p>Services (1) Leasing of beverage dispensing equipment, namely, the leasing of mechanical juice dispensers for</p>

		<p>bar, restaurant and institutional markets; the leasing of juice carts for skilled nursing facilities; the leasing of countertop refrigeration units for cafeterias, buffet service, fast-food chains, and counter service; the leasing of drink towers for dispensing beverages in convenience stores.</p> <p>(2) Operation of a business comprising the sale and distribution of shelf stable beverages and beverage concentrates and dispensing equipment for the bar, restaurant and institutional markets.</p> <p>(3) Operation of a business comprising the sale, distribution, and turnkey delivery to bar, restaurant and institutional premises of shelf stable beverages and beverage concentrates.</p>
 <p>Fruitful JUICE PRODUCTS</p>	<p>TMA706,526</p>	<p>Goods</p> <p>(1) Shelf stable beverages and beverage concentrates for the bar, restaurant and institutional markets, namely, juice concentrates, non-alcoholic fruit based beverages used in mixed drinks, non-alcoholic fruit based carbonated beverages, frozen carbonated beverages, fruit based frosted cocktail mixes, juices, non-carbonated beverages namely, iced teas, lemonades and fruit punches, smoothies, and sports drinks.</p> <p>Services</p> <p>(1) Leasing of beverage dispensing equipment, namely, the leasing of mechanical juice dispensers for bar, restaurant and institutional markets; the leasing of juice carts for skilled nursing facilities; the leasing of countertop refrigeration units for cafeterias, buffet service, fast-food chains, and counter service; the leasing of drink towers for dispensing beverages in convenience stores.</p> <p>(2) Operation of a business comprising the sale and distribution of shelf stable beverages and beverage concentrates and dispensing equipment for the bar, restaurant and institutional markets.</p> <p>(3) Operation of a business comprising the sale, distribution, and turnkey delivery to bar, restaurant and institutional premises of shelf stable beverages and beverage concentrates.</p>

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CANADIAN INTELLECTUAL PROPERTY OFFICE
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