



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 54

Date of Decision: 2021-03-26

IN THE MATTER OF AN OPPOSITION

Tops Markets, LLC

Opponent

and

**G. D. Foods Manufacturing (India)
Pvt. Ltd.**

Applicant

1,684,066 for TOPS & Design

Application

OVERVIEW

[1] G. D. Foods Manufacturing (India) Pvt. Ltd. (the Applicant) has filed application No. 1,684,066 (the Application) to register the trademark TOPS & Design (the Mark) based on proposed use in Canada in association with a variety of food products. The Mark is depicted below.



[2] Tops Markets, LLC (the Opponent) has opposed the Application based primarily on an alleged likelihood of confusion with its trademark TOPS in association with grocery store services and numerous food products which it sells in its grocery stores. The Opponent does not operate any grocery stores in Canada or sell its food products in Canada. However, the Opponent has multiple grocery store locations in the United States in close proximity to the Canadian border, and engages in significant advertising activity in Canada to direct customers from Canada to those grocery stores.

[3] Based on the evidence of the Opponent's marketing activities in Canada over many years, particularly in the Niagara region of Ontario, I am satisfied that the Opponent has established a sufficient reputation in Canada to meet the initial evidential burden for its distinctiveness ground of opposition, and the Applicant has not met its legal burden to demonstrate that the Mark is distinctive. The Application is therefore refused.

THE RECORD

[4] The Application was filed on July 7, 2014 and is based on proposed use of the Mark in Canada in association with the following goods (the Goods):

PICKLES, JAMS, FRUIT JELLIES; BISCUITS, COOKIES, RUSKS, MUFFINS, CAKE MIX, CAKES, NOODLES, VERMICELLI, CORN FLAKES, CUSTARD POWDER, TOMATO SAUCE, SAUCES AND CONDIMENTS, SOYA SAUCE, KETCHUP, VINEGAR, INSTANT MIX, CRYSTAL JELLIES; FRUIT JUICES, SYRUPS, READY TO SERVE BEVERAGES, NON ALCOHOLIC BEVERAGES, FRUIT DRINKS, LEMONADES, NON ALCOHOLIC FRUIT EXTRACTS, TOMATO JUICE, VEGETABLE JUICE.

[5] The Application was advertised for opposition purposes in the *Trademarks Journal* on October 21, 2015. On December 20, 2016, the Opponent filed a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). This Act was amended on June 17, 2019. In the present case, the grounds of opposition will be assessed based on 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 before that date).

[6] The Opponent raises grounds of opposition based on non-entitlement under sections 16(3)(a) and (c), non-distinctiveness under section 2, and non-compliance with section 30(i) of

the Act. The Opponent relies primarily on its trademark TOPS and TOPS Design (depicted below) in association with grocery store services and a variety of house brand food products which it sells in its stores.



[7] The Opponent does not operate grocery stores in Canada or sell its food products in Canada. The Opponent is based in the United States and operates multiple grocery stores in cities that are near the Canada / U.S. border. The Opponent has not alleged in this proceeding that it has used its trademark TOPS in Canada in association with any goods or services pursuant to sections 4(1) or (2) of the Act. Instead, the Opponent alleges that it has made its trademark TOPS known in Canada pursuant to section 5 of the Act, and acquired a reputation in Canada in that trademark by way of, *inter alia*, advertising and rewards programs directed at Canadians in Canada, and the volume of cross-border customers it receives from Canada.

[8] I note that the Opponent owns registrations in Canada for the trademarks TOPS (TMA963,338) and TOPS Design (TMA977,299), which matured from applications filed subsequent to the Application in issue in this proceeding. The Opponent does not rely on either of those two registrations in its grounds of opposition in this proceeding.

[9] The Applicant filed a counter statement on May 18, 2017 denying the grounds of opposition. Both parties submitted evidence and written representations and were represented at a hearing.

EVIDENCE

Opponent's Evidence

[10] The Opponent filed the affidavit of Michael J. Biehler sworn September 12, 2017 (the Biehler Affidavit), the affidavit of Joan L. Taulbee sworn September 7, 2017 (the Taulbee Affidavit), and the affidavit of Christoph Heinemann sworn September 14, 2017 (the Heinemann

Affidavit). None of these affiants was cross-examined. Their evidence is summarized below and is discussed further in the analysis of the grounds of opposition.

The Biehler Affidavit

[11] Mr. Biehler is the Vice President, Chief Legal Officer and Secretary of the Opponent. The Opponent is headquartered in the Greater Buffalo region of New York and operates 172 supermarkets (along with 5 locations operated by franchisees) in association with the trademark and trade name TOPS. The Opponent has locations in New York, Pennsylvania, Vermont and Massachusetts. The first TOPS grocery store opened in 1962 in Niagara Falls, New York.

[12] The Opponent uses a design version of the trademark TOPS, shown in paragraph 6, above, and has continuously used this design mark since 1973.

[13] TOPS supermarkets offer customary grocery store products, including produce, dairy, meat, seafood, prepared foods and bakery goods. Many of the Opponent's locations also offer pharmacy services and fuel stations.

[14] In addition to third party grocery products, the Opponent sells a wide range of house brand TOPS food products in all of its stores. There are over 2300 of these house brand TOPS food products, including pickles, jams, fruit jellies, cookies, muffins, sauces, pasta, cereals and juices. Each of these products prominently bears the trademark TOPS on its packaging. The TOPS house brand is the highest selling brand at TOPS stores.

[15] The Opponent promotes its TOPS grocery stores and TOPS branded food products in a variety of ways, including on its website at *www.topsmarkets.com*, store signage, television and radio ads, social media, loyalty cards, billboards, and weekly ad circulars in newspapers.

[16] From 2010 to 2016, the Opponent's annual revenue in association with the trademark TOPS exceeded \$2 billion.

[17] Mr. Biehler attests that cross-border shoppers from Canada form an important customer focus for the Opponent, since the Opponent has approximately 60 supermarket locations along

the Canada / U.S. border. In this regard, the Opponent actively advertises its goods and services in Canada to Canadians. Examples of such advertising include the following:

- The Opponent advertised in both the *Niagara Falls Review* and *St. Catharines Standard* newspapers from 2011 to 2016. Multiple examples of such advertisements from that period, each prominently bearing the trademark TOPS, are included as Exhibit “H”. Mr. Biehler states that over 1 million such advertisements were distributed in Canada from 2011 to 2016.
- The Opponent advertises in the Fort Erie region via direct mailers. Examples of such direct mailers, which prominently bear the trademark TOPS, are included as Exhibit “I”.
- The Opponent advertises directly to Canadians through email newsletters that are circulated multiple times per week. There are 12,493 customers in Canada who receive these email newsletters from the Opponent. An example of an email newsletter from 2015 bearing the trademark TOPS is included as Exhibit “K”.
- Approximately 8500 Canadian households in Fort Erie and Niagara Falls hold loyalty cards to TOPS grocery stores.

[18] It is apparent from the specific content of the above-referenced advertising material, that the advertising is specifically directed at Canadians, as evidenced by the repeated presence of Canadian flags and references such as “Just across the border”, “Just minutes from the Peace Bridge!”, “We accept Canadian currency” and “Special Canadian Thanksgiving Savings Supplement”.

[19] The Biehler Affidavit also includes as Exhibit “J” examples of in-store signage at TOPS grocery store locations which is specifically directed at Canadian shoppers, particularly in the lead-up to Canadian Thanksgiving. Such signage bears the trademark TOPS and the phrase “Welcome Canadian Shoppers!”.

[20] Mr. Biehler indicates that TOPS grocery stores accept Canadian currency at prevailing exchange rates without any additional fees, and that TOPS service stations include the price of gas in the Canadian per litre format for Canadian customers. Both of these features are highlighted in some of the above-referenced advertising material.

[21] Mr. Biehler notes that the Opponent's website received approximately 1,420,320 page views by Canadians during the period from January 1, 2012 to August 2017.

The Taulbee Affidavit

[22] Ms. Taulbee is a library manager with Hodgson Russ LLP. Her affidavit includes the results of online searches for media articles regarding Canadian shoppers visiting the United States to shop at Tops Markets and similar establishments.

The Heinemann Affidavit

[23] Mr. Heinemann is a law clerk employed by the Opponent's agent. His affidavit includes various printouts from the Opponent's website and printouts of pages from the Statistics Canada website relating to cross-border shopping.

Applicant's Evidence

[24] The Applicant filed the affidavit of Brij Mohan Seth sworn April 10, 2018 (the Brij Mohan Seth Affidavit) and the affidavit of Nitin Seth sworn April 10, 2018 (the Nitin Seth Affidavit). Neither affiant was cross-examined on his affidavit.

The Brij Mohan Seth Affidavit

[25] Mr. Brij Mohan Seth is the Chairman of the Applicant. The Applicant is based in New Delhi, India, and is a manufacturer of a wide range of food articles for human consumption which it has been selling under the trademark TOPS for several decades. The Brij Mohan Seth Affidavit includes numerous examples of products bearing the trademark TOPS sold and advertised in India, as well as sales figures for such products.

[26] The Applicant has numerous registrations for the trademark TOPS in India, as well as a CTM registration for the Mark in the European Union. The Applicant also owns copyright registrations in India for various artistic works related to TOPS.

[27] The Brij Mohan Seth Affidavit includes as Exhibit BMS-16 email communications between the Applicant's legal counsel in India and the Applicant relating to discussions between

the Canadian counsel for the two parties in this proceeding. The Opponent argues that these materials are inadmissible as they pertain to without prejudice settlement discussions. I agree with the Opponent that this material is the subject of settlement privilege. I note that it is also hearsay. I thus give no weight to Exhibit BMS-16 and will not discuss it further.

The Nitin Seth Affidavit

[28] Mr. Nitin Seth is the Managing Director of the Applicant. He attests to, *inter alia*, the Applicant's activities in Canada in association with the Mark. In particular, he describes that the Applicant has an exclusive distributor in Canada, namely, Ontario Impex of Canada (OIC Foods) in Mississauga, through which the Applicant sells its products in Canada in association with the Mark, including pickles, jams, sauces, and instant mixes.

[29] The Nitin Seth Affidavit includes as Exhibit NS-4 invoices from 2016 and 2017 from the sale of various food products from the Applicant to OIC Foods. The earliest of these invoices appears to be dated March 9, 2016. The products are identified in the body of these invoices with the trademark TOPS, and many of the invoices also bear the Mark at the top of the invoice. A list of retail stores in Canada in which the Applicant's products under the Mark are sold is included as Exhibit NS-5. While Exhibit NS-5 does not identify the addresses of these retail stores, it is apparent from the description of the stores in Exhibit NS-5 that many are located in the Greater Toronto Area. Examples of the display of the Applicant's products bearing the Mark on grocery store shelves in Canada are included as Exhibit NS-6. At paragraph 9 of his affidavit, Mr. Nitin Seth indicates that "in the last two years" the Opponent's export sales to Canada of products in association with the Mark was INR 7 million.

ONUS AND MATERIAL DATES

[30] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the Application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[31] The material dates for the grounds of opposition are as follows:

- Sections 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];
- Sections 38(2)(c)/16(3)(a) and (c) of the Act – the filing date of the Application; and
- Sections 38(2)(d)/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].

GROUND OF OPPOSITION SUMMARILY DISMISSED

Section 16(3)(c) Ground of Opposition

[32] With this ground of opposition, the Opponent alleges that the Applicant is not the person entitled to register the Mark because it is confusing with the trade names TOPS and TOPS MARKETS, LLC that have been previously made known in Canada.

[33] Section 16(3)(c) of the Act refers to a trade name that has been previously *used* in Canada, not one that has been previously made known [see *Habib Bank Ltd v Habib Bank AG Zurich*, 2011 CarswellNat 4526 (TMOB) at paras 20-21; and *Ace Cafe London Ltd v Ace Cafe Toronto Ltd*, 2012 TMOB 219 at para 16 (*Ace Cafe*)]. There is no evidence, nor has the Opponent argued, that it has used its trade name in Canada. Accordingly, this ground of opposition is rejected.

Section 30(i) Ground of Opposition

[34] The Opponent pleads that the Applicant could not have been satisfied of its entitlement to use the Mark in Canada in view of the Opponent's extensive use and advertising of its trademark TOPS in the United States and that this was likely to cause confusion in Canada.

[35] 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].

[36] 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 is dismissed.

REMAINING GROUNDS OF OPPOSITION – SECTIONS 2 AND SECTION 16(3)(A)

Non-distinctiveness ground of opposition – Section 2

[37] The Opponent pleads that the Mark is not distinctive of the Applicant pursuant to section 2 of the Act, in view of the reputation in Canada of the Opponent's trademark TOPS in association with grocery store goods and services.

[38] As noted above, the Opponent has not alleged that it has used its trademark TOPS in Canada in association with any goods or services pursuant to sections 4(1) or (2) of the Act. Instead, the Opponent alleges that through its advertising in Canada of its food products and grocery stores located in the United States, and as a result of the volume of cross-border shoppers from Canada that regularly attend its grocery stores, it has acquired a sufficient reputation in its trademark TOPS in Canada to negate the distinctiveness of the Applicant's Mark.

[39] The material date for considering this ground of opposition is the date of filing the statement of opposition, namely, December 20, 2016.

Opponent's Initial Evidential Burden

[40] In order to meet the initial evidential burden for a distinctiveness ground of opposition, an opponent must show that its trademark had a substantial, significant or sufficient reputation in Canada in association with relevant goods and services [see *Bojangles' International LLC v.*

Bojangles Café Ltd., 2006 FC 657, 48 CPR (4th) 427 (FC) at paras 33 and 34]. Whether an opponent has met that threshold is invariably a case by case assessment, and I find the following considerations included in paragraph 33 of *Bojangles* to be instructive in the present proceeding:

- A mark should be known in Canada to some extent at least to negate another mark's distinctiveness;
- Alternatively, a mark could negate another mark's distinctiveness if it is well known in a specific area of Canada;
- A foreign trade-mark owner cannot simply assert that its trade-mark is known in Canada, rather, it should present clear evidence to that effect;
- The reputation of the mark can be proven by any means, and is not restricted to the specific means listed in section 5 of the Act, and it is for the decision-maker to weigh the evidence on a case-by-case basis.

[41] In my view, the Opponent has demonstrated a sufficient reputation in its trademark TOPS in Canada to satisfy its initial evidential burden for the distinctiveness ground of opposition. In particular, I am satisfied based on the evidence that the Opponent's trademark is sufficiently well-known in at least the Niagara region of Ontario, including St. Catharines, Niagara Falls and Niagara on the Lake. The Opponent has demonstrated extensive advertising of its trademark in Canada to Canadians, prior to the material date, including advertisements in Canadian newspapers, direct mail advertisements circulated in Canada, and email newsletters circulated to Canadian residents. The Opponent's in-store signage also directly targets and welcomes customers from Canada.

[42] The Opponent has also provided evidence suggestive of the impact of its advertising in Canada. For example, Exhibit "B" to the Taulbee Affidavit includes an article from the *Toronto Star* newspaper entitled "Rounding all the bases on our way to Buffalo" dated June 4, 2016, wherein the author describes "[...] This left us time for those most Canadian of cross-border pastimes, a stroll through a Tops supermarket to ogle at all the junk foods we don't get at home – there was even a Tim Horton's inside with a 'Welcome Canadians' sign – and a stop at the pumps to fill up our tank on the cheap."

[43] Ultimately, based on the evidence of the Opponent's targeted marketing efforts in Canada over many years prior to the material date, I am satisfied that the Opponent has demonstrated a

sufficient reputation in Canada in its trademark TOPS such that the Opponent meets its initial evidential burden for the distinctiveness ground of opposition.

Likelihood of Confusion

[44] The legal burden then shifts to the Applicant to demonstrate that the Mark is distinctive in Canada. In considering whether a trademark is distinctive, one may consider whether it is likely to cause confusion with another party's trademark [see *Bensusan Restaurant Corp v Blue Note Restaurant Inc* (2000), 10 CPR (4th) 550 (TMOB) at para 30]. The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set out in section 6(2) of the Act, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act. The weight to be given to each factor may vary, depending on the circumstances [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; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361]. These factors are considered below.

[45] With respect to the degree of resemblance, the parties' trademarks are effectively identical. The most striking element of both parties' trademarks is the word "TOPS". I do not consider the design elements of the Applicant's Mark to be sufficiently different from those of the Opponent to avoid a finding of confusion.

[46] While the word "TOPS" might be considered somewhat laudatory, it does not clearly describe the parties' goods or services and thus possesses at least some inherent distinctiveness. As the trademarks are effectively identical, the inherent distinctiveness factor does not favour either party.

[47] As of December 20, 2016, I am satisfied that the Opponent's trademark TOPS was known in at least the Niagara region of Ontario in view of the Opponent's sustained marketing efforts in that area over many years. Between March 2016 and December 20, 2016, the Applicant has demonstrated sales of its products bearing the Mark in Canada in the Greater Toronto Area and thus may be known to some extent in that area.

[48] The parties' goods and services are closely related, if not identical. The Opponent operates grocery stores in association with the trademark TOPS, and sells house-brand packaged food products bearing the trademark TOPS. The Applicant uses its Mark in association with packaged food products sold in grocery stores.

[49] Considering all of the above factors, and in particular given the high degree of resemblance between the trademarks and the similarity in the parties' goods and services, I find that the Applicant has failed to meet its burden of showing that its Mark is distinctive or capable of distinguishing its goods throughout Canada as of December 20, 2016. Thus, the section 2 ground of opposition succeeds.

Non-entitlement ground of opposition – Section 16(3)(a)

[50] The Opponent pleads that the Applicant is not the party entitled to register the Mark in view of the Opponent's trademark TOPS which was previously made known in Canada. The material date for this ground of opposition is the filing date of the Application, namely, July 7, 2014.

[51] The test to determine whether a trademark has been "made known in Canada" is set out in section 5 of the Act, which reads as follows:

5 A trade-mark is deemed to be made known in Canada by a person only if it is used by that person in a country of the Union, other than Canada, in association with goods or services, and

(a) the goods are distributed in association with it in Canada, or

(b) the goods or services are advertised in association with it in

(i) any printed publication circulated in Canada in the ordinary course of commerce among potential dealers in or users of the goods or services, or

(ii) radio broadcasts ordinarily received in Canada by potential dealers in or users of the goods or services,

and it has become well known in Canada by reason of the distribution or advertising.

[52] Thus, the Opponent must demonstrate that:

1. its trademark TOPS was used in another country of the Union;

2. its goods and/or services were advertised in Canada in association with the trademark TOPS in either of the two manners set out in section 5(b) of the Act; and

3. the trademark had become well known in Canada by reason of such advertising (which requires that a substantial area of Canada must know the mark) [see *Marineland Inc v Marine Wonderland & Animal Park Ltd* (1974), 16 CPR (2d) 97 (FCTD); see also *Ace Cafe, supra*, at para 18].

[53] In the present case, the Opponent has satisfied items 1 and 2, above. In particular, the Opponent has demonstrated that for decades it has used its trademark TOPS in another country of the Union, namely, the United States, and that it advertised its trademark TOPS in printed publications circulated in Canada in the ordinary course of commerce prior to the material date (for example, Exhibit “H” to the Biehler Affidavit includes examples of the Opponent’s advertisements in Canadian newspapers from 2010, 2012 and 2013).

[54] However, I am not satisfied based on the evidence of record that the trademark TOPS had become well known in Canada by reason of the print advertising alone prior to the material date of July 7, 2014. Specifically, I am not satisfied that I have sufficient circulation data regarding the Opponent’s print advertisements in Canada prior to the material date. For example, paragraph 18 of the Biehler Affidavit describes that over 1 million Canadian flyer inserts advertising the Opponent’s goods and services in association with the trademark TOPS were circulated in the *Niagara Falls Review* and *St. Catharines Standard* newspapers from 2011 to 2016. However, those circulation figures were not provided on an annual basis and did not permit me to gauge with any confidence the scope of circulation prior to the material date of July 7, 2014. In addition, the Biehler Affidavit describes that the Opponent advertises on radio stations that have coverage in the Canadian market, but I have no evidence to confirm whether those radio advertisements took place prior to the material date or the scope of their reach in Canada.

[55] While the Opponent’s evidence as a whole did permit me to conclude that the Opponent’s trademark TOPS had a sufficient reputation in Canada as of the material date for the distinctiveness ground of opposition (i.e. December 20, 2016), the evidence was not delineated in sufficient detail to permit me to conclude that the Opponent’s trademark was well known in

accordance with the requirements of section 5 of the Act as of the earlier material date of July 7, 2014.

[56] Thus, I am not satisfied that the Opponent has met its initial evidential burden for the section 16(3)(a) ground of opposition, and this ground is dismissed.

DISPOSITION

[57] 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

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

HEARING DATE 2020-12-09

APPEARANCES

Melissa Binns	For the Opponent
Vigyan Deep Sharma	For the Applicant

AGENTS OF RECORD

Gowling WLG (Canada) LLP	For the Opponent
No Agent Appointed	For the Applicant