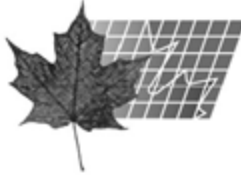


O P I C



C I P O

LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2022 TMOB 058**

**Date of Decision: 2022-03-28**

**IN THE MATTER OF AN OPPOSITION**

**Coca-Cola Ltd.**

**Opponent**

**and**

**ORGY Co. Ltd.**

**Applicant**

**1,837,815 for SUICOKE**

**Application**

INTRODUCTION

[1] Coca-Cola Ltd. (the Opponent) opposes registration of the trademark SUICOKE (the Mark), which is the subject of application No. 1,837,815 by ORGY Co. Ltd. (the Applicant).

[2] The Mark is applied for on the basis of proposed use in Canada in association with the following goods:

(1) All purpose sport bags; backpacks; backpacks, book bags, sports bags, bum bags, wallets and handbags; bags for sports; barrel bags; beach bags; drawstring bags; handbags; hip bags; imitation leather bags; leather bags; messenger bags; pocket wallets; school bags; shopping bags; shoulder bags; small bags for men; sport bags; tote bags; travel bags; umbrellas; waist bags.

(2) Athletic footwear; baseball caps and hats; beach footwear; casual clothing; casual clothing featuring pants, dresses and shorts; casual footwear; exercise footwear; fashion hats; hats; outerwear jackets; rain boots; rain footwear; sandals; sports caps and hats; sports clothing; sports footwear; sports shoes; sun hats.

[3] The opposition is primarily based on an allegation that the Mark is confusing with the Opponent's COKE trademarks, previously registered or used in association with the same or related goods.

#### THE RECORD

[4] The application for the Mark was filed on May 16, 2017. The application was advertised for opposition purposes on July 4, 2018. Numerous amendments to the *Trademarks Act*, RSC 1985, c T-13 (the Act) came into force on June 17, 2019. Pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read immediately before June 17, 2019, an exception being that, with respect to confusion, sections 6(2) to (4) of the Act as it currently reads will be applied.

[5] On December 4, 2018, the Opponent opposed the application by filing a statement of opposition under section 38 of the Act. The grounds of opposition are based on non-compliance with section 30(i) of the Act; non-entitlement under section 16(3) of the Act; non-registrability under section 12(1)(d) of the Act; and non-distinctiveness under section 2 of the Act.

[6] The Applicant filed a counter statement denying the grounds of opposition.

[7] In support of its opposition, the Opponent submitted the following evidence:

- Affidavit of Carolyn Harty, sworn June 6, 2019 in Toronto (the Harty Affidavit);
- Affidavit of Katharine C. Dwyer, sworn June 10, 2019 in Atlanta, Georgia (the Dwyer Affidavit).

[8] In support of his application, the Applicant filed the affidavit of Junbeom Her, sworn October 11, 2019 in Toronto (the Her Affidavit).

[9] None of the affiants were cross-examined. Both parties submitted written representations and were represented at a hearing held on November 15, 2021.

[10] Before assessing the grounds of opposition, I will first provide an overview of the parties' evidence, the evidential burden on the Opponent, and the legal onus on the Applicant.

OVERVIEW OF THE OPPONENT’S EVIDENCE

[11] As pleaded in its statement of opposition, the Opponent is the owner of 41 trademark registrations that consist of or incorporate the word COKE, registered in association with a wide variety of goods and services (collectively, the COKE Trademarks). The oldest of those registrations is UCA16464 for the trademark COKE, registered in association with “Non-alcoholic beverages and syrups to be used in the manufacture of such beverages.”

[12] For purposes of this decision, I note the following registrations, which I consider illustrative of the scope of the Opponent’s registrations and which represent its strongest case(s) in this proceeding. In particular, these registrations include goods overlapping with the applied-for goods [see also Opponent’s written representations at para 46]:

<b>Registration</b>	<b>Goods</b>
COKE TMA356072 Reg’n Date: 1989-05-19	(1) Shirts, sweaters, sweat tops, sweat pants, skirts, shorts, jeans, tops and bottoms, namely, sweat pants, when all of the said bottoms are intended to be sold together with tops; jackets, hosiery, belts, gloves, scarves, sweat bands. (2) Adult and children's night shirts and union suits (i.e., one-piece pyjamas). (3) Sports caps, hats and visors.
COKE TMA377009 1990-12-14	(1) Patio umbrellas, cafe umbrellas, beach umbrellas, golf umbrellas. ...
COKE TMA384429 1991-05-17	(1) Tote bags. (2) Oven mitts, pot holders, place mats. (3) Tea towels, table cloths, napkins, beach towels. (4) Aprons, chef hats.
COKE TMA390734 1991-11-29	(1) Luggage; travel shoulder bags, carry-on bags, sports bags, roll bags, cooler bags, school bags, back packs.
COKE TMA466368 1996-11-26	(1) Clothing namely, pants, blouses, dresses, coats, vests, ties, suspenders, legwarmers, boxer shorts; lunch bags and waist pouches.

DIET COKE TMA821206 2012-04-02	(1) Caps, shirts, sweat shirts, shorts, pants, sweat pants, socks, and pajamas.
CHERRY COKE TMA821238 2012-04-02	(1) Caps, shirts, sweat shirts, shorts, pants, sweat pants, socks, and pajamas.

*The Harty Affidavit*

[13] Ms. Harty is a Director with the Opponent [para 1]. She attests that the Opponent has been using the COKE Trademarks in Canada “for decades” [para 4], having sales in excess of \$5 billion CAD between 2008 and 2018, including selling more than 14 billion litres of COKE brand soft drinks in Canada [paras 6, 8 and 53].

[14] Ms. Harty states that, between 2008 and 2018, the Opponent spent over \$600 million marketing COKE brand soft drinks in Canada [paras 10 and 54]. She confirms that advertising efforts pre-date 2008, but otherwise provides an overview and gives examples regarding such advertisement and promotion, including:

- Notable marketing campaigns “over the past ten years” [para 11, Exhibit 3];
- Television advertising, including in relation to COKE ZERO brand advertising across different geographic regions within Canada [paras 13 to 18, Exhibit 4];
- Print and newspaper advertising [para 19, Exhibit 6];
- Transit advertising [paras 20 and 21, Exhibit 7];
- Billboard displays [para 22, Exhibit 8];
- Advertisements on trucks [paras 23 and 24, Exhibits 9 and 10];
- Sponsorship of sporting events [paras 25 to 31, Exhibits 11 to 14];
- Point-of-purchase advertising [paras 32 to 36, Exhibits 15 to 18];

- Distribution of COKE-branded promotional items [para 37];
- “Experiential promotions”, *e.g.*, the free distribution of COKE-branded soft drinks “to members of the public for them to experience the products for free, increasing brand awareness and loyalty” [paras 38 to 40, Exhibits 19 and 20];
- Direct mail promotions, *e.g.*, the mailing or delivering of coupons for COKE brand soft drinks [para 41];
- Internet presence and advertising, *e.g.*, through the Opponent’s website, *coca-cola.ca*, advertisement on third-party websites, and social media pages [paras 42 to 44, Exhibits 21 and 22];
- Online games, downloadable content and contests [paras 45 to 47, Exhibits 23 and 24];
- Exclusive commercial partner arrangements with, *inter alia*, McDonald’s, Air Canada, Pizza Pizza and Cineplex, *e.g.*, the exclusive sale of COKE brand soft drinks at all McDonald’s restaurants in Canada [paras 48 to 52, Exhibits 25 and 26].

[15] In summation, Ms. Harty attests that “Through these extensive efforts and expenditures on marketing and promotion of the COKE brand over a number of years, [the Opponent] has developed significant goodwill in the COKE Marks to the point where these marks have become famous in the Canadian marketplace.”

[16] In reviewing the exhibits to Ms. Harty’s affidavit, I note that many of the exhibits purporting to display COKE trademarks only display the Coca-Cola trademark, which was not one of the 41 COKE Trademarks pleaded in the statement of opposition and reproduced at Exhibit 2 to the Harty Affidavit. For example, the soft drink bottle depicted in Exhibit 1 only displays the Coca-Cola and Coca-Cola Zero trademarks. However, some of the advertising campaign material at Exhibit 3 displays COKE and “Cherry Coke” trademarks, and I note a COKE trademark is displayed on a flying disc promotional item shown in Exhibit 20.

*The Dwyer Affidavit*

[17] Ms. Dwyer is a Director of The Coca-Cola Company, parent company to the Opponent. The Dwyer Affidavit evidences the licensing and sale of COKE brand merchandise in Canada since 2014, broken down by year with examples [paras 6 to 10, Exhibits 1 to 4]. For example, Ms. Dwyer attests that, in 2015, “over 10,000 COKE brand merchandise items were sold into Canada at a wholesale cost of over \$85,000 CAD to retailers including Wal-Mart and Winners” and that the designs of such items are attached as Exhibit 1 to her affidavit. I note that Exhibit 1 depicts four shirts, only one of which displays the COKE trademark. The other shirts display a Coca-Cola logo.

[18] Ms. Dwyer attests that, between 2015 and 2018, the Herschel Supply Company licensed the COKE Trademarks and sold COKE brand backpacks, totes, pouches, caps and hats in Canada through various retailers and online [para 11, Exhibit 5]. However, again, I note that the exhibited promotional materials display the Coca-Cola trademark, rather than the COKE trademark or any of the 41 pleaded COKE Trademarks.

[19] Ms. Dwyer also attests that, in 2018, three retailers (Forever 21, Desigual and Tommy Hilfiger) launched “exclusive COKE brand capsule collections” [para 12]. However, I note that the exhibited press releases do not display the COKE trademark [Exhibit 6].

[20] Nevertheless, Ms. Dwyer attests that nearly 300,000 COKE brand merchandise items, with a wholesale value of over \$1.5 million CAD, were sold to Canadian retailers between 2014 and 2018 [para 13].

[21] I note that the products depicted in the exhibits include various shirts and sweaters, as well as jackets, hats, shorts, backpacks and bags. However, of the depicted products, only three t-shirts, one hat, and one long-sleeve shirt appear to display the COKE trademark.

#### OVERVIEW OF THE APPLICANT’S EVIDENCE

##### *The Her Affidavit*

[22] Mr. Her is the Marketing Manager of SlavinRaphael Distribution Inc. (SRD), a fashion wholesale and distribution company that acts as a Canadian agent for various fashion and footwear brands, including Hunter boots, Ted Baker, and New Balance [para 2]. SRD is the

exclusive Canadian distributor of SUICOKE-branded products manufactured by the Applicant. Since 2017, SRD has bought SUICOKE footwear products from the Applicant and then resold such products in Canada [para 3]. SUICOKE footwear products include flip flops, rain boots, winter boots, shoes, sandals, sneakers and moccasins [para 4, Exhibits A and B].

[23] SRD sells SUICOKE footwear through various large and boutique retailers in various provinces [para 5] as well as through SRD's online store, *suicoke.ca* [para 8]. Wholesale sales through retailers since 2017 have exceeded 3100 pairs and \$380,000 per year [para 6 and 7, Exhibit C], while SRD has sold over 300 pairs of footwear through its website, with a retail value of over \$75,000 [para 8].

[24] Mr. Her provides Google Analytics data regarding SRD's website, indicating that there have been over 27,000 unique visitors to the *suicoke.ca* website since 2017 [para 13].

[25] Mr. Her also indicates that, as Marketing Manager, he is responsible for monitoring social media for SUICOKE in Canada, such as on Facebook, Instagram and Twitter, as well as through the "contact us" page on the *suicoke.ca* website. He states that he is not aware of anyone expressing a view on any of these forums that there was – or asking if there was – any connection between the SUICOKE products and Coca-Cola [para 14]. Similarly, Mr. Her states that he regularly speaks with retailers of the SUICOKE products and confirms that he has "never been advised that any consumer made a statement that they thought there was any connection between the SUICOKE products and Coca-Cola or asked if there was any connection".

[26] Otherwise, the Her Affidavit evidences the purported manner of display of the Mark on SUICOKE footwear products and their packaging [paras 9 to 12]. I note that such display is consistently by way of the following design mark:

SUICOKE

[27] Whether such display constitutes display and use of the Mark as applied for will be discussed below.

## EVIDENTIAL BURDEN AND LEGAL ONUS

[28] In accordance with the usual rules of evidence, there is an evidential burden on the Opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Ltd v Molson Companies Ltd*, 1990 CarswellNat 1053, 30 CPR (3d) 293 (FCTD)]. The presence of an evidential burden on the Opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

[29] For those allegations for which the Opponent has met its evidential burden, the legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. The presence of a legal onus on an applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, then the issue must be decided against it.

## SECTION 12(1)(D) GROUND – CONFUSING WITH A REGISTERED TRADEMARK

[30] The Opponent pleads that the Mark is not registrable pursuant to section 12(1)(d) of the Act in that it is confusing with the Opponent's COKE Trademarks which are famous in Canada and which are the subject of the 41 trademark registrations set out in Schedule B to the statement of opposition.

[31] The material date with respect to confusion with a registered trademark is the date of this decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd et al*, 1991 CarswellNat 1119 (FCA)].

[32] As the Opponent's COKE Trademarks are extant on the register, the Opponent meets its evidential burden under this ground with respect to each of its 41 registrations.

[33] Accordingly, the Applicant must establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and any of the Opponent's COKE Trademarks.



[34] I will first consider confusion with respect to the Opponent's registration TMA356072 for COKE, registered in association with a variety of clothing goods, and then briefly address the Opponent's remaining registrations.

*Test to determine confusion*

[35] The test to determine the issue of confusion is set out in section 6(2) of the Act which provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[36] The test to be applied is a matter of first impression in the mind of a casual consumer "somewhat in a hurry" who sees the Mark in association with the applied-for goods at a time when they have no more than an imperfect recollection of the Opponent's trademark and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23].

[37] 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, 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.

[38] The criteria or factors in section 6(5) of the Act are not exhaustive and different weight will be given to each one in a context-specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22]. In *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, the Supreme Court of Canada stated that section 6(5)(e), the resemblance between the trademarks, will often have the greatest effect on the confusion analysis [at para 49] and that, while the first word in the trademark may be the most important in some cases, the preferable approach is to consider whether there is an aspect of the trademark that is particularly "striking or unique" [at para 66].

*Degree of Resemblance*

[39] In appearance, the parties' trademarks share the element COKE, albeit this element is at the end of the Mark, SUICOKE.

[40] When sounded, it is not clear what the "correct" pronunciation of the Mark is, but I agree with the Opponent that, at a minimum, it could be sounded as "Swee-Coke" or variations thereof such that the element COKE constitutes a second and distinct syllable.

[41] With respect to the ideas suggested, the Opponent submits that COKE "uniquely refers to the Opponent" [Opponent's written representations at para 57], whereas the Applicant notes that "coke" is an ordinary word referring to the residue of coal or a common short form of the word "cocaine" [Applicant's written representations at para 57]. Notwithstanding the evidentiary issues discussed further below, for purposes of this factor, I am prepared to accept that the idea suggested by the Opponent's COKE trademark is that of its well-known beverage product, which is also known as Coca-Cola. However, I do not agree with the Opponent that the same idea is suggested by the Mark, as it is a coined word with the striking "SUI" element preceding the COKE element. Given that the word COKE has other meanings, I do not consider the idea suggested by the Mark to be some sort of variation of the Opponent's COKE trademark or relating to the Opponent's products. I agree with the Applicant that SUICOKE is "a made-up word, without any meaning or idea suggested at all" [Applicant's written representations at para 58].

[42] Overall, given the Mark's distinctive first element SUI, and considering the trademarks in their totality, I consider there to be a low degree of resemblance in appearance, when sounded, and in ideas suggested.

[43] Accordingly, this important factor favours the Applicant.

*Inherent Distinctiveness and Extent Known*

[44] In its written representations, the Opponent submits that the Mark and the Opponent's COKE Trademarks are inherently distinctive [para 33]. Furthermore, the Opponent submits that it "has submitted evidence demonstrating extensive sales of the COKE Goods and related

promotion, such that one can conclude that [the COKE Trademarks] are famous in Canada in association with the COKE Beverage Goods and the COKE Marks are well-known in Canada in association with the COKE Licensed Goods [para 34]. As noted above, however, the Opponent's evidence is largely with respect to the Opponent's Coca-Cola logo and trademarks, and not the Opponent's COKE Trademarks *per se*. While there are instances of display of COKE Trademarks in the evidence, given that both of the Opponent's affidavits conflate any evidence of sales and promotion with that of the Coca-Cola trademarks, the Opponent's evidence is actually unclear as to the extent to which any of the COKE Trademarks have become known in Canada in association with beverage goods, much less those licensed goods (such as clothing) overlapping with the applied-for goods in this case.

[45] Nevertheless, the Registrar may take judicial notice of dictionary terms [*Tradall SA v Devil's Martini Inc*, 2011 TMOB 65]. In this case, I note the following definitions of "coke":

*coke*: 1) (noun) the solid product resulting from the destructive distillation of coal in an oven or closed chamber or by imperfect combustion, consisting principally of carbon: used chiefly as a fuel in metallurgy to reduce metallic oxides to metals; 2) (verb) to convert into or become coke [*dictionary.com*]

*coke*: 1) (noun) the residue of coal left after destructive distillation and used as fuel; also: a similar residue left by other materials (such as petroleum) distilled to dryness; 2) to change into coke; to become coke or like coke; 3) (noun) cocaine; 4) (trademark) [Coke] used for a cola drink; 5) (biographical name) Sir Edward [Coke] 1552-1634 *Lord Coke* English jurist [*Merriam-Webster Dictionary*]

[46] The inclusion of the Opponent's trademark in the *Merriam-Website Dictionary* would appear to support the Opponent's argument that its COKE trademark is well-known, if not famous, at least in relation to cola drinks. Indeed, this inference was not seriously disputed by the Applicant.

[47] With respect to the Mark, as indicated in the Applicant's evidence and conceded by the Opponent, SUICOKE is a coined term, with no descriptive or suggestive meaning relative to the applied-for goods. With respect to the extent the Mark has become known in Canada, although the Mark is applied for on the basis of proposed use, the Her Affidavit provides some subsequent evidence of use [for example, Her Affidavit at paras 6 to 8]. However, I agree with the Opponent that some of the evidence of use is for a design mark (reproduced above) that would

not necessarily be perceived as displaying the Mark as registered. Per the images at paragraphs 9 and 10 of the Her Affidavit, the Opponent's footwear goods and packaging display a design mark whereby the K in SUICOKE could be perceived as an I and an apostrophe (in other words, SUICOI'E instead of SUICOKE). As noted by the Opponent at the hearing, if this design mark was the applied-for trademark, there would likely be no opposition by the Opponent in this case. In any event, there is at least some evidence of use and display of the word Mark SUICOKE, such as in the Opponent's invoices to retailers [Her Affidavit at para 7 and Exhibit C] and the Opponent's website and social media accounts [Her Affidavit at paras 13 and 14].

[48] In view of the foregoing, while I accept that the COKE trademark has become well known in Canada, I find that this is balanced by the inherent distinctiveness of the Mark. Accordingly, on balance, I do not find this factor to significantly favour either party.

*Length of Time in Use*

[49] With respect to the length of time in use of the parties' trademarks, per the Her Affidavit's evidence of sales of SUICOKE footwear to retailers, the Applicant has used the Mark since 2017 [para 7 and Exhibit C].

[50] Noting the aforementioned conflation of the Opponent's use of the COKE Trademarks with use of its Coca-Cola trademarks, the Applicant submits that there "is no credible and particularized evidence as to when any of [the COKE Trademarks] was first used in Canada, in association with any goods" [Applicant's written representations at para 71]. However, at a minimum, I am prepared to accept that there was at least some use of the Opponent's COKE trademark in association with clothing goods since 2015 in Canada. While the total sales figures of COKE-branded merchandise are conflated with those of Coca-Cola-branded merchandise in the Dwyer Affidavit, I note that Ms. Dwyer states that Coke-branded merchandise was sold to Canadian retailers such as Wal-Mart since 2015, and examples of such merchandise include a shirt displaying the COKE trademark [para 7 and Exhibit 1].

[51] Furthermore, while not clearly particularized, it would be disingenuous to conclude that *none* of the Opponent's COKE Trademarks were associated at least to some extent with the

Opponent's evidenced sales or promotional efforts since 2008 in Canada as set out in the Harty Affidavit.

[52] Accordingly, this factor favours the Opponent.

*Nature of the Goods or Business / Nature of the Trade*

[53] When considering the nature of the goods of the parties in respect of the issue of confusion, it is the statements in the subject application and registration(s) that govern [*Mr Submarine Ltd v Amandista Investments Ltd*, 1987 CarswellNat 749 (FCA); *Miss Universe Inc v Bohna*, 1994 CarswellNat 1443 (FCA)].

[54] Although none of the Opponent's COKE Trademarks are registered in association with footwear, there is otherwise overlap in the nature of the applied-for clothing and headwear goods with the clothing and headwear goods set out in the Opponent's registration TMA356072. I would also note at this point that there is direct overlap of the applied-for umbrella, luggage, bag and accessory goods with certain other of the Opponent's COKE Trademark registrations, including those highlighted above.

[55] I also agree with the Opponent that the nature of the Opponent's business is such that it uses its COKE trademark on a wide variety of consumer goods, as reflected in its evidence and numerous registrations. Furthermore, given the nature of the goods, the parties' products would be sold at the same or similar retail stores. Indeed, the parties' evidence indicates that the Applicant's footwear goods have been sold in Winners stores in Canada [Her Affidavit at para 5], as have the Opponent's clothing goods [Dwyer Affidavit at para 7].

[56] Accordingly, these factors favour the Opponent.

*Additional Surrounding Circumstance – Opponent's Family of COKE Trademarks*

[57] Where there exists a family of trademarks, there may be a greater likelihood that the public would consider a similar trademark to be another trademark in the family and, consequently, assume that the good or service that is associated with that trademark is manufactured or performed by the owner of the family of trademarks. There is, however, no

presumption of the existence of a family of trademarks in opposition proceedings. A party seeking to establish a family of trademarks must establish that it is using more than one or two trademarks within the alleged family [*Techniquip Ltd v Canadian Olympic Assn*, 1998 CarswellNat 323 (FCTD), aff'd 1999 CarswellNat 2511 (FCA); and *Now Communications Inc v CHUM Ltd*, 2003 CarswellNat 5017 (TMOB) at para 35].

[58] In its written representations, the Opponent submits that it has led evidence to demonstrate that its ownership of a family of COKE trademarks is a surrounding circumstance in its favour [paras 60 to 62].

[59] However, it is not clear that the Opponent has properly evidenced a relevant family of COKE Trademarks in this case. While the Opponent has 41 registrations, the actual evidence with respect to such COKE Trademarks is thin including, surprisingly, in association with cola drinks. Again, this is because the Opponent's affidavits overwhelmingly conflate its use of the Coca-Cola logo and trademark with purported use of its COKE Trademarks. The Applicant submits that evidence such as this should be considered "sketchy", as it does not particularize which trademarks cited by the Opponent had been used and it does not provide a breakdown of sales by trademark [citing *The Clorox Company of Canada Ltd v Chloretec*, 2020 FCA 76].

[60] Even if the Opponent had more clearly evidenced its family of COKE Trademarks, such trademarks are limited to COKE and descriptive or suggestive elements with COKE, such as DIET COKE and CHERRY COKE. Even if only descriptive or suggestive in association with beverage-related goods, such words are nonetheless common dictionary words. However, the Mark differs in that SUICOKE is one word with the SUI element – and thus, the Mark as a whole – having no clear meaning and being inherently distinctive. In my view, the average consumer would not perceive the Mark as belonging to any family of the Opponent's COKE trademarks.

[61] Accordingly, even if I were to find that this is a relevant surrounding circumstance in favour of the Opponent, it would only be nominally so.

*Additional Surrounding Circumstance – Famous and Well-Known Trademarks*

[62] While the purported fame of the Opponent’s COKE Trademarks was addressed above, the Opponent submits that this is an additional surrounding circumstance in its favour [paras 53 and 64]. In this respect, the Opponent submits that the fame of its COKE Trademarks broadens the scope of protection and that such fame “is even capable of transcending marks across different categories of goods” [citing *Mattel USA Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 63 (*Mattel USA*)].

[63] However, I agree with the Applicant’s submissions that the evidence of fame of the COKE Trademarks in this case is problematic or “sketchy” at best [paras 22 and 88]. In any event, I also agree with the Applicant that any “fame” is not determinative – each situation must be judged in its full context [Applicant’s written representations at para 87, citing *Mattel USA* at paras 72 and 73].

[64] In my view, the Opponent is essentially claiming a monopoly on the word or syllable COKE. However, the Mark has inherent distinctiveness that differentiates it from the Opponent’s COKE Trademarks.

[65] Accordingly, even if I were to consider this to be a surrounding circumstance that favours the Opponent, it would only be nominally so.

*Additional Surrounding Circumstance – No Evidence of Actual Confusion*

[66] In its written representations, the Applicant submits that – while not determinative – the lack of actual confusion in this case is a relevant surrounding circumstance [para 85]. In this respect, the Applicant questions why there have been no instances of confusion reported, despite the alleged fame of the Opponent’s COKE Trademarks and the availability of the Applicant’s SUICOKE products in stores and online since 2017 [para 86].

[67] In its written representations, the Opponent correctly notes that there can still be confusion between trademarks, even if there has not been any instances of confusion [para 66]. It submits that the absence of actual confusion appears to be explained by the fact that the parties do not sell their goods through the same stores [para 67]. As indicated above, the evidence

actually indicates that the parties have both sold their products through Winners retail stores. In any event, as also indicated above, the trademark displayed on the Applicant's footwear products and packaging at the retail store consumer level is a design variant of the Mark, which may be perceived as SUICOI'E rather than SUICOKE. This perception difference may account for the absence of reported instances of confusion by consumers, notwithstanding the appearance of the Mark on the Opponent's website and social media accounts since 2017.

[68] Accordingly, I do not consider this to be a significant surrounding circumstance favouring either party.

*Conclusion – Confusion with the Opponent's COKE Trademark*

[69] As mentioned above, the degree of resemblance between the parties' trademarks is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

[70] Having considered all of the surrounding circumstances, I find that the Applicant has met its legal burden with respect to the likelihood of confusion between the parties' trademarks. I reach this conclusion due to the low degree of resemblance between the trademarks and the inherent distinctiveness of the Applicant's Mark, and notwithstanding the overlap in the nature of the parties' goods, businesses and trades or the purported fame of the Opponent's COKE trademark.

[71] In view of the foregoing, the section 12(1)(d) ground of opposition based on confusion with the Opponent's registration No. TMA356072 for COKE is rejected.

[72] As this registration represented one of the stronger cases if not the strongest case for the Opponent, I reach the same conclusion with respect to the issue of confusion with the Opponent's remaining COKE Trademarks.

[73] Accordingly, the section 12(1)(d) ground of opposition based on confusion is rejected.

SECTION 16(3)(A) GROUND – NON-ENTITLEMENT – PRIOR USE

[74] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark pursuant to section 16(3)(a) of the Act because, as of the filing date of the application, the



Mark was confusing with the Opponent's COKE Trademarks previously used in Canada by the Opponent in association with the COKE goods which are famous in Canada.

[75] As the Mark is applied for on the basis of proposed use, the material date for this ground is the filing date of the application for the Mark, namely May 16, 2017.

[76] In its written representations, the Applicant submits that the Opponent has failed to meet its initial burden under this ground, in that the evidence does not show any clear and particular evidence of prior use in Canada with respect to any of the COKE Trademarks [paras 39 and 41].

[77] While the Opponent's failure to particularize its evidence with respect to each of its COKE Trademarks is problematic, as indicated above, I accept the Dwyer Affidavit as demonstrating prior use of the Opponent's COKE trademark in association with clothing goods, at a minimum [Dwyer Affidavit at para 7 and Exhibit 1].

[78] Accordingly, the onus is on the Applicant to demonstrate that there is no likelihood of confusion between the parties' trademarks.

[79] In this case, given the earlier material date, some of the surrounding circumstances shift somewhat in favour of the Opponent in that the application is based on proposed use and there is otherwise no evidence regarding the extent to which the Mark had become known as of the filing date of the application. However, even giving the Opponent's problematic evidence a generous interpretation, I do not consider this shift to significantly alter the analysis and conclusion with respect to the issue of confusion in this case.

[80] Having considered all of the surrounding circumstances, I find that the Applicant has met its legal burden with respect to the likelihood of confusion between the parties' trademarks. I reach this conclusion due to the low degree of resemblance between the trademarks and the inherent distinctiveness of the Applicant's Mark, and notwithstanding the overlap in the nature of the parties' goods, businesses and trades or the purported fame of the Opponent's Coke trademark.

[81] Accordingly, the non-entitlement ground of opposition is rejected.

SECTION 2 GROUND – NON-DISTINCTIVENESS

[82] The Opponent pleads that the Mark is not distinctive of the Applicant within the meaning of section 2 of the Act because the Mark does not and cannot actually distinguish the goods with which it is proposed to be used by the Applicant from the goods of the Opponent, nor is it adapted so to distinguish them given that the Mark is confusing with the COKE Trademarks used and promoted in Canada by the Opponent in association with the COKE goods and which are famous in Canada.

[83] The material date for this ground is the filing date of the opposition, December 4, 2018 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185].

[84] Section 2 of the Act, as it then was, defined “distinctive” as follows:

*distinctive*, in relation to a trademark, means a trademark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or is adapted so to distinguish them.

[85] A trademark “actually distinguishes” by acquiring distinctiveness through use, resulting in distinctiveness in fact. On the other hand, a trademark that is “adapted so to distinguish” is one that does not depend upon use for its distinctiveness because it is inherently distinctive [see *Astrazeneca AB v Novopharm Ltd*, 2003 FCA 57 at para 16].

[86] The initial burden is on the Opponent to prove that, as of the material date, its trademark was known to some extent in Canada in association with the relevant goods and had a reputation in Canada that was “substantial, significant or sufficient” so as to negate the distinctiveness of the Mark [see *Bojangles’ International, LLC v Bojangles Café Ltd*, 2006 FC 657 at paras 33 and 34; and *Ontario Dental Assistants Association v Canadian Dental Association*, 2013 FC 266 at para 42, *aff’d* 2013 FCA 279]. In *Suzanne’s Inc v Auld Phillips Ltd*, 2005 FCA 429, in the context of an expungement proceeding under section 57 of the Act, the Federal Court of Appeal stated that “Obviously, it will be a rare occurrence when one party is in a position to cause a mark to lose its distinctiveness, but nothing in principle prevents this result” [at para 7].

[87] In this case, given the issues with the evidence described above, I agree with the Applicant that the Opponent fails to meet its initial burden under this ground.

[88] In any event, to the extent that this ground would ultimately turn on the issue of confusion, I would reach the same conclusion regarding the likelihood of confusion as above. In particular, having considered all of the surrounding circumstances, I would find that the Applicant had met its legal burden with respect to the likelihood of confusion between the parties' trademarks. I would reach this conclusion due to the low degree of resemblance between the trademarks and the inherent distinctiveness of the Mark, and notwithstanding the overlap in the nature of the parties' goods, businesses and trades, or the purported fame of the Opponent's COKE Trademarks.

[89] Accordingly, the non-distinctiveness ground of opposition is rejected.

#### SECTION 30 GROUND – NON-COMPLIANCE

[90] The Opponent pleads that the application does not comply with section 30(i) of the Act because, as of the filing date of the application, the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the applied-for goods, given that the Mark is confusing with the Opponent's COKE Trademarks which are famous in Canada.

[91] Section 30(i) of the Act merely required that an applicant include a statement in its application that it is satisfied that it is entitled to use its trademark in Canada in association with the goods or services described in the application. Where this statement has been provided, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co Ltd v Bristol Myers Co*, (1974) CarswellNat 476 (TMOB)]. Even if an applicant had knowledge of the existence of an opponent's trademark – whether or not ultimately found to be confusing with the applied-for trademark – this is insufficient to support an allegation that an applicant could not have been satisfied of its entitlement to use its trademark [see *Woot, Inc v WootRestaurants Inc*, 2012 TMOB 197].

[92] In this case, the requisite statement was provided, and there is no evidence that this is an exceptional case.

[93] Accordingly, the ground based on non-compliance with section 30 of the Act is rejected.

DISPOSITION

[94] In view of all of the foregoing and pursuant to section 38(12) of the Act and the authority delegated to me under section 63(3) of the Act, I reject the opposition.

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Andrew Bene  
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:** 2021-11-15

**APPEARANCES**

Monique Couture	For the Opponent
David Reive	For the Applicant

**AGENTS OF RECORD**

Gowling WLG (Canada) LLP	For the Opponent
Miller Thomson LLP	For the Applicant