

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 108

Date of Decision: 2022-05-31

IN THE MATTER OF AN OPPOSITION

Wildflower Marijuana Inc.

Opponent

and

ICE Holdings Ltd.

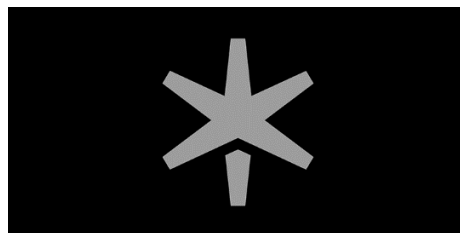
Applicant

1,828,814 for Ice Logo

Application

INTRODUCTION

[1] ICE Holdings Ltd. (the Applicant) has filed application No. 1,828,814 (the Application) for the trademark Ice Logo (the Mark), depicted below.



[2] The Application includes the following colour claim:

Colour is claimed as a feature of the trademark. The colour "blue" is claimed as a feature of the trademark. The trademark consists of a blue snowflake design on a rectangular background. No colour is claimed for the rectangular background.

[3] The Application, as amended, is in association with the following goods and services.

Goods

(1) Baseball caps and hats; casual clothing; hats; athletic apparel; athletic clothing; casual clothing featuring pants, dresses and shorts; jackets; jackets and socks; sports caps and hats; sun hats; toques

(2) Patches for clothing

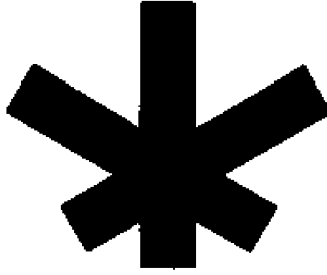
Services

(1) Online sales of clothing

[4] The Application was filed on March 22, 2017 based on use of the Mark in Canada since March 15, 2017 in association with Goods (1) and proposed use of the Mark in Canada in association with Goods (2) and the Services. The Application was advertised for opposition purposes in the *Trademarks Journal* on December 5, 2018. On May 3, 2019, Wildflower Marijuana Inc. (the Opponent) filed a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). Leave was granted by the Registrar to amend the statement of opposition to include an additional ground of opposition on July 2, 2019.

[5] I note that the Act was amended on June 17, 2019, and pursuant to section 70 of the Act, the grounds of opposition in this proceeding will be assessed based on the Act as it read prior to June 17, 2019.

[6] The Opponent raises grounds of opposition based on entitlement under sections 16(1)(a) and 16(3)(a) and distinctiveness under section 2 of the Act. In particular, the Opponent relies on its prior use of the common law trademark Wildflower Design, depicted below (this trademark will be referred to as the "Wildflower Design" or the "Opponent's trademark"):



[7] The Applicant filed a counter statement on May 22, 2019 denying the grounds of opposition.

[8] Only the Opponent filed evidence and written representations. No hearing was held.

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

EVIDENCE

[10] The Opponent's evidence is comprised of the following: (1) the affidavit of Stephen Pearce sworn on February 21, 2020 (the Pearce Affidavit); (2) a certified copy of the Opponent's Canadian copyright registration No. 1,136,754 entitled WILDFLOWER Design; and (3) a certified copy of the Opponent's Canadian trademark application No. 1,859,416 for Wildflower Design. Mr. Pearce was not cross-examined on his affidavit.

The Pearce Affidavit

[11] Mr. Pearce is the Chief Financial Officer and Corporate Counsel of the Opponent. He describes the Opponent as a CBD wellness company based in Vancouver, British Columbia.

[12] Mr. Pearce states that the Opponent had a logo created (the Wildflower Design shown in paragraph 6 of this decision, above) to be used in association with its wellness products, and that the logo was first published in or during about October 2014. In this regard, he references the Opponent's Canadian copyright registration No. 1,136,754. I note that the certified copy of that copyright registration, filed as part of the Opponent's evidence, indicates that it covers an artistic work entitled WILDFLOWER Design, which was registered on January 13, 2017 and has a publication date of October 16, 2014.

[13] Mr. Pearce also states that the Opponent is the owner of the common law trademark Wildflower Design, which is the subject of Canadian trademark application No. 1,859,416. That application is in association with the following goods and services:

Goods

(1) Skin soap; Bar soap; Scented soap; Skin and body lotion; Topical creams; Topical gels

(2) Nutritional supplements, namely, hemp capsules; Medicated topical bars for pain relief

(3) Vaporizers; Vaporizer pipes

Services

(1) Retail sales of skin soap, bar soap, scented soap, skin and body lotions, topical creams, topical gels, nutritional supplements, namely hemp capsules, medicated topical bars for pain relief, vaporizers, and vaporizer pipes

[14] I note that the filing date of the Opponent's application No. 1,859,416 (i.e. September 26, 2017) post-dates the filing of the Applicant's Application, and therefore the Opponent's application itself cannot be relied on for any ground of opposition in this case (see the Registrar's letter of July 2, 2019 granting leave to the Opponent to include a ground of opposition under section 16(1)(a) of the Act, but denying leave to include grounds of opposition under sections 16(1)(b) and 16(3)(b)).

[15] Mr. Pearce states that the Opponent launched its branded vaporizer bearing the Opponent's trademark in about December 2015 in Vancity Weed, which he describes as a leading medical dispensary in Vancouver. A copy of an invoice bearing the Opponent's trademark for the sale of branded vaporizers from the Opponent to Vancity Weed is attached as Exhibit "A" to the Pearce Affidavit. That invoice is dated March 22, 2016 and includes in the body of the invoice the dates "December 2015" and "January 2016" in respect of certain quantities of vaporizers. He states that since or about December 2015, the Opponent has continuously used the Opponent's trademark to identify its goods at the point of sale.

[16] Mr. Pearce states that the Opponent launched its vaporizer product online in February 2016, and Exhibit "B" to his affidavit is described as an image of the Opponent's archived website from about September 3, 2016 where the Opponent's vaporizer products are shown, bearing the Opponent's trademark.

[17] The Opponent's products, including vaporizers and CBD capsules, have been covered in a variety of magazine and website articles, including Esquire magazine, High Times magazine, and New York Magazine – The Strategist. Examples of these articles are included in the Pearce Affidavit as Exhibits "D", "E", "F", "H" and "J". These articles include images of the Opponent's product and/or packaging bearing the Opponent's trademark. The Pearce Affidavit also includes as Exhibits "G" and "I" media kits for Esquire magazine and New York Magazine – The Strategist, which include circulation and website page view figures for those publications.

[18] Mr. Pearce describes that the Opponent began distributing a "media kit" around approximately 2018 and that it was later expanded to a "starter kit" containing various goods sold by the Opponent bearing the Opponent's trademark. He states that now two different kits are sold, with approximately 5000 kits having been distributed. Exhibit "C" is a photo of a media kit including packaged product bearing the Opponent's trademark. Some of the product packaging in Exhibit "C" depicts the Opponent's trademark in blue on a white background.

[19] Mr. Pearce states that the Opponent has, since or about 2016, expended significant time, effort and money in Canada in its retail operations and promoting and building awareness of its goods in association with the Opponent's trademark.

[20] Mr. Pearce states that the Opponent has five retail outlet stores, all of which prominently display the Opponent's trademark. Three of these stores are located in Vancouver, British Columbia, one is located in Comox, British Columbia, and the fifth store is located in Los Angeles, California.

[21] Mr. Pearce includes sales figures in association with the Opponent's trademark for 2017, each quarter of 2018, and monthly for the year 2019. The Opponent's sales in 2017 were approximately \$50,000, and then increased to in excess of \$2 million annually in each of 2018 and 2019. I note that these sales figures are not broken down in such a way as to identify where the sales took place; for example, from the four Canadian store locations as compared to the one U.S. store location.

[22] Mr. Pearce also includes approximate annual marketing expenditures in association with the Opponent's trademark, which increased from \$50,000 in 2016 to \$350,000 in 2019. As with

the sales figures, the Pearce Affidavit does not break down the marketing expenditures as between Canada and the U.S.

ONUS

[23] The legal onus is on the Applicant to show that the application complies with the provisions of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once this initial burden is met, the Applicant must satisfy the Registrar, on a balance of probabilities, that the grounds of opposition pleaded should not prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

ANALYSIS

Sections 16(1)(a) and 16(3)(a) grounds of opposition

Preliminary remarks

[24] With these grounds of opposition, the Opponent pleads that the Applicant is not the party entitled to register the Mark because it is confusing with the Opponent's trademark that was previously used or made known in Canada. The section 16(1)(a) ground is necessarily restricted to Goods (1) and the section 16(3)(a) ground to Goods (2) and the Services. The material date for considering the section 16(1)(a) ground of opposition is the claimed date of use of the Mark in association with Goods (1), namely, March 15, 2017. The material date for considering the section 16(3)(a) ground of opposition is the filing date of the Application, namely, March 22, 2017. Nothing turns on the one week difference between those two material dates, and so I will consider the section 16(1)(a) and 16(3)(a) grounds of opposition together.

[25] The Opponent has demonstrated use of its trademark Wildflower Design in Canada prior to the material dates discussed above. In particular, the Opponent's evidence indicates that it has been using its trademark in Canada, at least in association with vaporizers, since as early as March 22, 2016 (I reference this date out of an abundance of caution because it is the date of the

invoice included as Exhibit “A” to the Pearce Affidavit, though the invoice suggests that the branded vaporizers may have been received by the customer prior to that date). Thus, the Opponent has met its initial evidential burden for the section 16(1)(a) and 16(3)(a) grounds of opposition. The legal burden is therefore on the Applicant to demonstrate on a balance of probabilities that there was no likelihood of confusion between the parties’ trademarks at the material date.

[26] I note that the Opponent’s pending application No. 1,859,416 for the trademark Wildflower Design was filed on September 26, 2017 based on proposed use of the trademark in Canada. While that appears somewhat incongruous with the Opponent’s evidence in this proceeding of its use of the trademark Wildflower Design since at least March 22, 2016, ultimately, I must consider the evidence of use that has been provided to me in this case. The basis for the Opponent’s application No. 1,859,416 is not in issue in this proceeding.

[27] As a final preliminary remark, I note that the Opponent’s section 16(1)(a) ground of opposition was added to the statement of opposition by way of amendment for which the Opponent was granted leave by the Registrar on July 2, 2019. In its written representations, the Opponent argues that this ground necessarily succeeds because the Applicant did not amend its counter statement (filed on May 22, 2019) to specifically deny the section 16(1)(a) ground. This particular argument by the Opponent has no merit. Unlike the circumstances in *Garbo Group Inc v Harriet Brown & Co* (2009), 74 CPR (4th) 391 (TMOB), in the present case the Applicant’s counter statement includes a general denial of all of the Opponent’s allegations and grounds of opposition, which can be taken to also apply to the section 16(1)(a) ground for which leave to amend was subsequently granted. The section 16(1)(a) ground, along with the section 16(3)(a) ground, will turn on the issue of a likelihood of confusion, rather than the above-referenced pleadings argument.

Test for confusion

[28] The test for 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 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.

[29] 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 at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 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.

[30] 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 they have no more than an imperfect recollection of the opponent's trademark, and do 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].

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

[31] The Opponent's trademark has a reasonable degree of inherent distinctiveness. While perhaps vaguely suggestive of a plant leaf, the Opponent's trademark is a design mark with no immediate descriptive connotation and it is devoid of any word elements. The Applicant's Mark is similarly inherently distinctive for the same reasons.

[32] With respect to the extent to which the parties' trademarks have become known, this weighs in favour of the Opponent, as the Opponent has provided evidence of use and advertising of its trademark in Canada since 2016. The Applicant has provided no evidence to suggest that its Mark has been used or become known at all in Canada.

[33] In view of the above, when considering both the inherent distinctiveness of the 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

[34] The Opponent's evidence indicates that it has been using its trademark in Canada since 2016. There is no evidence of record showing use of the Mark at any time. Consequently, this factor also favours the Opponent.

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

[35] The clothing related goods and services which remain in the Application, as amended, are different in nature from the Opponent's vaporizers. Therefore, the nature of the goods and services factor favours the Applicant.

[36] The Opponent in its written representations notes that the Application when advertised included the goods "vaporizers for medical purposes" and "E-cigarettes; oral vaporizers for smokers; smokeless cigarette vaporizer pipes; smoking pipe scourers; smoking pipes" which overlap or are closely related to the Opponent's goods. However, after the Opponent filed its evidence in this proceeding, the Applicant amended the Application to remove those goods, and so I have not considered them in assessing the nature of the goods and services factor.

[37] With respect to the nature of the trade, the Opponent argues in its written representations that companies that manufacture and sell cannabis products also typically sell items such as casual clothing and athletic clothing bearing the cannabis seller's trademark; however, no evidence has been provided in this case from which I could make that finding. The Opponent in its written representations also refers to certain clothing products which it sells, and products which it claims the Applicant sells, but again no evidence was filed to this effect and so those allegations cannot be considered. Indeed, neither party filed evidence speaking to the nature of the Applicant's business or channels of trade which could be compared to those of the Opponent.

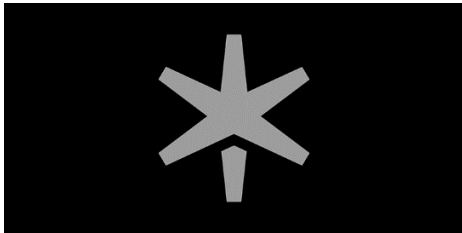

[38] Based on the evidence of record, the only potential overlap in the nature of the parties' trade is that the Opponent's products have been featured in general lifestyle publications such as

Esquire Magazine which also cover topics such as clothing and fashion, suggesting that the parties could target the same consumers. In this regard, the online Esquire article that is Exhibit “F” to the Pearce Affidavit includes an image of the Opponent’s vaporizer product bearing the Opponent’s trademark, together with pricing information next to a “SHOP” icon and a link to the Opponent’s website. In the online article from New York Magazine – The Strategist featuring the Opponent’s vaporizer bearing the Opponent’s trademark (Exhibit “H” to the Pearce Affidavit), the publication is described as follows “The Strategist is designed to surface the most useful, expert recommendations for things to buy across the vast e-commerce landscape. Some of our latest conquests include the best women’s jeans, rolling luggage, pillows for side sleepers, ultra-flattering pants, and bath towels.”

[39] In these circumstances, and in view of the absence of any evidence or argument from the Applicant on this issue, I do not consider the nature of the trade factor to favour the Applicant to a significant degree.

Degree of resemblance

[40] As noted above, the degree of resemblance factor often has the greatest effect on the confusion analysis. I consider that to be the case here. While the trademarks are not identical, there is a substantial degree of resemblance. For reference, the two trademarks are reproduced below:

| Applicant’s Mark | Opponent’s Trademark |
|---|--|
|  |  |

[41] I note that the Application specifically claims the colour blue for the design element of the Mark. The Opponent’s evidence includes examples in which its trademark is depicted in the colour blue.

[42] The degree of resemblance factor favours the Opponent.

Conclusion regarding confusion

[43] Despite the different nature of the goods and services listed in the Application, in view of the substantial degree of resemblance between the parties' trademarks, the fact that the Opponent is the senior user whose trademark has become known to a greater extent, and in the absence of any evidence or argument from the Applicant, I find that at best for the Applicant, the probability of confusion between the Mark and the Opponent's trademark 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 was no reasonable likelihood of confusion between the trademarks at the material date, I therefore find against the Applicant.

[44] Consequently, the grounds of opposition under sections 16(1)(a) and 16(3)(a) of the Act are successful.

Section 2 ground of opposition

[45] The material date for assessing the section 2 ground of opposition is the filing date of the opposition, namely, May 3, 2019 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317 (FC)].

[46] The Opponent alleges that the Mark is not distinctive because it is confusing with the Opponent's trademark. In order to meet its initial evidential burden for the distinctiveness ground of opposition, the Opponent must show that its trademark had a substantial, significant or sufficient reputation in Canada in association with relevant goods and services as of the material date [see *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427 (FC) at paras 33-34]. In my view, the Opponent's evidence of its use and advertising of its trademark prior to May 3, 2019 meets this standard. While the Opponent's evidence does not provide a breakdown of its sales and advertising figures between its four Canadian retail locations and one retail location in the United States, in the context of the Pearce Affidavit as a whole, and in the absence of any cross-examination, I am satisfied that a meaningful proportion

of the sales and advertising took place in Canada. The Opponent has met its initial evidential burden for the section 2 ground of opposition.

[47] The legal burden then shifts to the Applicant to demonstrate that its Mark was distinctive in Canada as of May 3, 2019. 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]. For essentially identical reasons to the analysis of confusion for the grounds of opposition under sections 16(1)(a) and 16(3)(a), I conclude that the Applicant has not satisfied its legal burden under section 2. Indeed, the Opponent's case is even stronger under section 2 considering the later material date, which permits consideration of more of the Opponent's sales and advertising. Therefore, the section 2 ground of opposition also succeeds.

DISPOSITION

[48] 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: No Hearing Held

AGENTS OF RECORD

Palmer IP Inc.

For the Opponent

MBM Intellectual Property Law LLP

For the Applicant