

OPIC



CIPO

LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2022 TMOB 125**

**Date of Decision: 2022-06-29**

**IN THE MATTER OF AN OPPOSITION**

**Eggsmith Ltd.**

**Opponent**

**and**

**10X Innovation GmbH & Co. KG**

**Applicant**

**1,886,330 for WKUP**

**Application**

OVERVIEW

[1] 10X Innovation GmbH & Co. KG (the Applicant) has applied to register the trademark WKUP (the Mark) in association with the following goods:

Coffee; Flavoured coffee; Decaffeinated coffee; Instant coffee; Ground coffee; Mixtures of coffee; Malt coffee; Chocolate coffee; Coffee extracts; Coffee concentrates; Artificial coffee; Coffee capsules; Coffee essences; Iced coffee; Cocoa; Tea; Espresso; non alcoholic beverages based on coffee; non alcoholic beverages based on espresso; non alcoholic beverages based on tea. (the Goods)

[2] Eggsmith Ltd. (the Opponent) opposes the application based on alleged confusion with its registered trademark WKAE UP which covers coffee and tea, among other goods and services.

[3] For the reasons that follow, the application is refused as the Applicant has not satisfied its legal burden to demonstrate that there is no likelihood of confusion between the Mark and the Opponent's registered trademark.

#### THE RECORD

[4] Application No. 1,886,330 (the Application) was filed on March 6, 2018 and claims priority to a corresponding application filed in Germany on December 12, 2017. The Application is based on proposed use of the Mark in Canada in association with the Goods.

[5] The Application was advertised for opposition purposes in the *Trademarks Journal* on July 24, 2019. On September 24, 2019, 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. As the Application in this case was advertised after June 17, 2019, the Act as amended applies (see section 69.1 of the Act).

[6] The Opponent raises grounds of opposition based on registrability under section 12(1)(d), entitlement under sections 16(1)(a) and (b), distinctiveness under section 2, and non-compliance with section 38(2)(f) of the Act. Each of the grounds of opposition turns on an alleged likelihood of confusion with the Opponent's registered trademark WKAE UP (TMA1024301). The Opponent's registration was issued on June 10, 2019 and covers the following goods and services:

#### Goods:

(1) Mugs; tumblers; cups; saucers

(2) Coffee; tea

#### Services:

(1) Restaurant services; Sandwich shop services; Catering services; Take-out food services

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

[8] Only the Applicant filed evidence in the proceeding, namely, the affidavit of Abbas Ali Kassam sworn on July 21, 2020 (the Kassam Affidavit). The Kassam Affidavit is comprised of the particulars of registrations and applications obtained from the Canadian Intellectual Property

Office trademark database. This state of the Register evidence is discussed in the analysis of the grounds of opposition, below.

[9] Neither party filed written representations and no hearing was held.

#### ONUS

[10] 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

##### **Grounds of opposition summarily rejected - sections 2, 16(1)(a) and 16(1)(b)**

[11] The Opponent did not file any evidence of use of its trademark WKAE UP. Therefore, there is no evidence of record with which the Opponent could meet its initial evidential burden for the section 2 and 16(1)(a) grounds of opposition. Accordingly, the section 2 and section 16(1)(a) grounds of opposition are rejected.

[12] With respect to the section 16(1)(b) ground of opposition, the Opponent in its statement of opposition relies on its previously filed application for the trademark WKAE UP which eventually matured to registration No. TMA1024301. However, that application matured to registration on June 10, 2019 and thus was no longer pending on July 24, 2019 when the Applicant's Application was advertised. Consequently, pursuant to section 16(2) of the Act, the Opponent is not permitted to rely on its previously filed application for a ground of opposition under section 16(1)(b). The section 16(1)(b) ground of opposition is therefore rejected. The Opponent's confusion allegation will instead be considered under its section 12(1)(d) ground of opposition, discussed below.

## **Section 12(1)(d) ground of opposition**

[13] The Opponent pleads that the Mark is not registrable because it is confusing with the Opponent's registered trademark WKAE UP (TMA1024301). The material date for this ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)]. I have exercised my discretion to check the Register and confirm that the Opponent's registration remains extant [see *Quaker Oats Co Ltd of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent has therefore met its initial evidential burden with respect to this ground of opposition. As a result, the Applicant bears the legal burden of demonstrating on a balance of probabilities that there is no likelihood of confusion between the Mark and the Opponent's registered trademark.

### Test for confusion

[14] 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, services or business; the nature of the trade; and the degree of resemblance between the trademarks, including in appearance, or sound or in the ideas suggested by them.

[15] 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.

[16] 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*

[17] The Opponent's trademark WKAE UP has a reasonable degree of inherent distinctiveness. While suggestive of the expression "wake up", the misspelling of the first word obliges a certain amount of mental gymnastics on the part of the reader, which provides the trademark with some inherent distinctiveness. The Applicant's Mark has a similar degree of inherent distinctiveness for essentially the same reason.

[18] Neither party filed evidence to suggest that their trademarks have become known at all in Canada.

[19] In these circumstances, the inherent and acquired distinctiveness factor does not have much impact on the confusion analysis.

*Length of time the trademarks have been in use*

[20] Neither party filed evidence that their trademarks are in use. Consequently, this factor also favours neither party.

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

[21] The Opponent's registration covers coffee and tea, among other goods and services. The Application is in association with various coffee and tea products. It is apparent that there is direct overlap in the nature of the goods and in the absence of any evidence to the contrary I expect that the channels of trade would be similar. These factors favour the Opponent.

*Degree of resemblance*

[22] I consider there to be a reasonably high degree of resemblance between the parties' trademarks. With respect to appearance, both start with the same two letters (WK) and end with the same two letters (UP). While there may be a slight difference in how the trademarks are sounded, I expect that both would be sounded similarly to the expression "wake up", and that expression would likely be the idea conveyed by both. The degree of resemblance factor favours the Opponent.

*Surrounding circumstance – state of the Register*

[23] The third-party applications and registrations included in the Kassam Affidavit are set out in the tables below. While the Applicant did not file any written representations relating to this evidence, presumably it was included to seek to demonstrate that the terms "wake" and/or "wake up" are commonly used in Canada in association with relevant goods, such that consumers will be able to distinguish between the parties' trademarks WKAE UP and WKUP. The Applicant did not file any evidence of the use of these third-party trademarks in the marketplace.

<b>Trademark</b>	<b>App. No.</b>
WAKE UP & KICK ASS	1911873
WAKE AND BAKE COFFEE	1913657
WAKE AND BAKE	1913659
WAKE AND BAKE COFFEE CO.	1913662
WAKE-UP Logo	1989928
WAKE UP WITH US	1965726

<b>Trademark</b>	<b>Reg. No.</b>
WAKE N BAKE	TMA1075685
WAKE UP YOUR MOUTH!	TMA746286
WAKE UP ON A ROLL	TMA783619
WAKE UP TO BREAKFAST	TMA796422
WAKE	TMA1060514
WAKE UP A WINNER	TMA725301

[24] 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 at para 38, aff'd 2017 FC 38; *Allergan Inc v Lancôme Parfums & Beauté & Cie, société en nom collectif* (2007), 64 CPR (4th) 147 (TMOB) at 169].

[25] For the following reasons, I do not consider the state of the Register evidence to assist the Applicant to any meaningful degree in this case.

[26] First, of the pending applications listed in the Kassam Affidavit, only one - application No. 1911873 – was ultimately allowed and proceeded to registration, with the remainder having not been approved (either as of the date of the affidavit or the date of this decision). In any event, with respect to application No. 1911873, I consider the trademark WAKE UP & KICK ASS to convey a different overall impression to the parties' trademarks in this case.

[27] Second, of the registrations listed in the Kassam Affidavit, many do not cover goods similar to those in issue in this proceeding (or at least the goods do not have nearly the degree of overlap as between the Application and the Opponent's registration). For example, TMA746286 for WAKE UP YOUR MOUTH! covers "Corn-based snack foods, namely, tortilla chips", TMA783619 for WAKE UP ON A ROLL covers "Prepared meals", and TMA1060514 for WAKE covers various fruit based foods and beverages but not tea or coffee.

[28] Taking the above into account, and keeping in mind that the Applicant did not file any evidence of actual use of the third-party trademarks, I do not consider the Applicant's state of the Register evidence to be sufficient to infer that the terms "wake" and/or "wake up" are so commonly used in the Canadian marketplace in association with relevant goods that consumers would readily be able to distinguish between the parties' trademarks in this case.

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

[29] Having considered all of the surrounding circumstances, I conclude that the Applicant has not satisfied its legal burden to show that there is no reasonable likelihood of confusion

between the parties' trademarks. I reach this conclusion particularly in view of the degree of resemblance between the parties' trademarks and the overlap in the parties' goods and services.

[30] The section 12(1)(d) ground of opposition is therefore successful.

### **Section 38(2)(f) ground of opposition**

[31] With this ground of opposition, the Opponent pleads that the Applicant was not entitled to use the Mark in Canada because it was or ought to have been aware of the Opponent's prior rights in the trademark WKAE UP.

[32] As noted above, because the Application was advertised after June 17, 2019, the Act as amended applies. However, in my view, jurisprudence applying the Act as it read prior to June 17, 2019 (the Old Act) can in some circumstances still inform the analysis of certain grounds of opposition. For example, with a ground of opposition under section 30(i) of the Old Act, it was well established that an allegation that an applicant was or should have been aware of the opponent's trademark did not by itself support a ground of opposition under that provision [see *Woot Inc v WootRestaurants Inc Les Restaurants Woot Inc*, 2012 TMOB 197]. In my view, that jurisprudence under section 30(i) of the Old Act is instructive and should apply to section 38(2)(f) of the Act. Consequently, the section 38(2)(f) ground of opposition is rejected.

### DISPOSITION

[33] 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**

Gowling WLG (Canada) LLP

For the Opponent

Ridout & Maybee LLP

For the Applicant