



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 179

Date of Decision: 2022-09-12

IN THE MATTER OF AN OPPOSITION

Coca-Cola Limited

Opponent

and

Fujian Panpan Foodstuff Co., Ltd.

Applicant

1,874,390 for Chinese characters

Application




PANPAN & design

OVERVIEW

[1] Fujian Panpan Foodstuff Co., Ltd. (the Applicant) has filed application No. 1,874,390 (the Application) to register the trademark entitled Chinese characters PANPAN & design (the Mark), depicted below, in association with various food and beverage products.



[2] Coca-Cola Limited (the Opponent) has opposed the Application based on an alleged likelihood of confusion with certain registered trademarks identified in Schedule “B” to its statement of opposition, including those identified below.

Reg. No.	Trademark	Goods/Services
TMA416,402		Goods: Non-alcoholic soft drink beverages. Services: Advertising, marketing and promotion of non-alcoholic soft drink beverages of others.
TMA940,047		Soft drinks.
TMA374,143		Non-alcoholic soft drink beverages and syrups used in the preparation of such beverages.

[3] The Opponent filed evidence of extensive use of its trademarks in Canada. The Applicant filed no evidence in support of the Application. For the reasons that follow, the Application is refused in its entirety because the Applicant has failed to demonstrate on a balance of probabilities that there is no reasonable likelihood of confusion.

THE RECORD

[4] The Application was filed on December 21, 2017 and is based on proposed use of the Mark in Canada in association with the following goods:

- (1) Meat; fish fingers; tinned fruits; crystallized fruits; potato flakes; fruit jellies; toasted laver; soya milk; oils for food; roasted nuts
- (2) Coffee; tea; candies; propolis; biscuits; cakes; cereal-based snack food; pies; edible ices; spices; bread
- (3) Beer; preparations for making aerated water; non-alcoholic beverages containing fruit juices; bottled drinking water; non-alcoholic whey based beverages; aerated water; protein-enriched sports beverages; soft drinks; vegetable juices; non-dairy soy beverages

[5] I note that the Applicant included the following foreign character transliteration and translation as part of its Application: “Transliteration of the Chinese characters in the mark is PAN PAN” and “PAN means ‘hope for; long for; expect; look’”.

[6] The Application was advertised for opposition purposes in the *Trademarks Journal* on May 22, 2019. On October 22, 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, 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.

[7] The Opponent raises grounds of opposition based on registrability under section 12(1)(d), entitlement under section 16(3)(a), distinctiveness under section 2, and non-compliance with section 30(i) of the Act.

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

[9] The Opponent filed as its evidence the affidavit of Michael Samoszewski, sworn August 27, 2020 (the Samoszewski Affidavit). Mr. Samoszewski is the Vice President of Marketing and Commercial, CMO, of the Opponent. He attests to the Opponent’s extensive use of its trademark WAVE DESIGN (which is the subject of registration Nos. TMA416,402 and TMA940,047) in Canada for decades in the promotion and sale of the Opponent’s COKE brand soft drinks (the COKE brand is described as including the soft drink beverage brands COCA-COLA, COCA-COLA ZERO SUGAR, COCA-COLA CHERRY and DIET COKE). In addition, he describes how the Opponent’s trademark WAVE DESIGN is often depicted in close association with its trademark COCA-COLA, the latter being written in what is described as “Spencerian Script”. An example of the trademark WAVE DESIGN depicted in conjunction with the trademark COCA-COLA in Spencerian Script is seen in the trademark COCA-COLA DESIGN which is the subject of registration No. TMA374,143, above. Mr. Samoszewski’s evidence is discussed further in the analysis of the grounds of opposition. He was not cross-examined on his affidavit.

[10] As noted above, the Applicant elected not to file any evidence. Only the Opponent filed written representations and attended the hearing.

ONUS

[11] 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

Section 12(1)(d) ground of opposition

[12] The Opponent pleads that the Mark is not registrable because it is confusing with ten registered trademarks listed in Schedule “B” to the statement of opposition, including the three identified in paragraph 2 of this decision, above.

[13] The material date for the section 12(1)(d) 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 all of the registrations relied on by the Opponent remain 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 any of the Opponent’s registered trademarks.

[14] In conducting the confusion analysis, below, I will do so primarily with reference to the Opponent’s trademark WAVE DESIGN (which is the subject of TMA416,402 and TMA940,047) as in my view that is sufficient to resolve the opposition. I will then briefly discuss the Opponent’s other registrations.

Test for confusion

[15] 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.

[16] 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.

[17] 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

[18] This factor involves a consideration of both the inherent and acquired distinctiveness of the parties' respective trademarks. With respect to the Opponent's trademark WAVE DESIGN, given the simplicity of the design, in my view, it has a low degree of inherent distinctiveness; however, what is more significant with respect to the Opponent's trademark is the extent to

which it has become known. In particular, the Samoszewski Affidavit demonstrates the Opponent's extensive use of the trademark WAVE DESIGN in Canada for decades in the promotion and sale of COKE brand soft drinks, including the depiction of the WAVE DESIGN on product packaging and in advertising in a variety of media, including television, print, online, as well as on point of sale materials in restaurants and grocery stores. Since 2011, the Opponent has sold over 1.4 billion litres of COKE brand soft drinks in Canada, in packages bearing the trademark WAVE DESIGN, constituting sales in excess of \$1.25 billion. While the trademark WAVE DESIGN is often depicted in close association with the trademark COKE or COCA-COLA, I note that the Samoszewski Affidavit includes many examples of the WAVE DESIGN being prominently depicted in isolation or separate from other trademarks (e.g. on beverage dispensing machines seen in Exhibits "O" and "P" to the Samoszewski Affidavit and in point of sale materials shown in Exhibits "EE" to "II"), such that I am satisfied that the WAVE DESIGN would be perceived as a separate trademark in its own right. Taking the above into consideration, I am satisfied that the Opponent's trademark WAVE DESIGN is very well known in Canada.

[19] With respect to the Applicant's Mark, in my view, it possesses a higher degree of inherent distinctiveness than the Opponent's trademark WAVE DESIGN, in part because the characters in the Mark positioned above the wave element would not be understood by a unilingual English, unilingual French, or bilingual English/French consumer, nor is there any evidence before me that the characters are the name in any language of any of the goods. However, the Applicant has filed no evidence that the Mark has been used or become known at all in Canada.

[20] In these circumstances, while the Applicant's Mark may possess a greater degree of inherent distinctiveness, given the significant degree to which the Opponent's trademark has become known in Canada, on balance, this factor favours the Opponent.

Length of time the trademarks have been in use

[21] As noted above, the Opponent's evidence indicates that it has used its trademark WAVE DESIGN continuously in Canada for decades in association with the promotion and sale of soft drinks. There is no evidence before me that the Applicant has commenced use of the Mark in Canada. Consequently, this factor favours the Opponent.

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

[22] The Application includes “soft drinks” and in that respect there is direct overlap with the Opponent’s goods. The Application also includes a variety of other food and beverage items. While these other food and beverage items may not overlap as directly with the Opponent’s goods, nevertheless, given that the Applicant has filed no evidence to shed light on the nature of its business and likely channels of trade, and given the evidence of the numerous channels of trade in which the Opponent’s goods are sold (including grocery stores, restaurants and entertainment venues), I am satisfied that on balance the nature of the goods and trade factors favour the Opponent.

Degree of resemblance

[23] There is a meaningful degree of resemblance between the parties’ trademarks. In particular, the Applicant’s Mark incorporates a wave element which is essentially identical in appearance to the Opponent’s trademark WAVE DESIGN. In short, the Applicant’s Mark incorporates the Opponent’s trademark in its entirety.

[24] While the Mark also includes additional characters above the wave element, in my view, this does not assist the Applicant in this case. Instead, the characters in the Mark above the wave element reinforce the potential for confusion. Recall that the Opponent’s trademark WAVE DESIGN is often depicted in close association with its trademark COCA-COLA written in a fanciful script described by the Opponent as the “Spencerian Script”. The Applicant’s Mark depicts characters in a script which is noticeably similar in appearance to the Spencerian Script used by the Opponent to depict its trademark COCA-COLA. While the characters in the Applicant’s Mark would not be recognizable to a unilingual English, unilingual French or bilingual English/French consumer, I agree with the Opponent that, given the composition of the Mark as a whole, a Canadian consumer may think that the Mark is simply one of the Opponent’s trademarks depicted in another language.

[25] On balance, the degree of resemblance factor favours the Opponent.

Conclusion regarding the section 12(1)(d) ground

[26] 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 considering that each of the statutory factors favour the Opponent, including the degree of resemblance between the parties' trademarks, the extensive and long-standing use of the Opponent's trademark WAVE DESIGN in Canada and the extent to which it has become known, and the overlap in the parties' goods.

[27] Consequently, the section 12(1)(d) ground of opposition succeeds in respect of the Opponent's registration Nos. TMA416,402 and TMA940,047.

[28] In addition, the outcome of the confusion analysis is the same when considering the Opponent's registration No. TMA374,143 (COCA-COLA DESIGN), for essentially the same reasons as discussed above, including the fact that the characters in the Applicant's Mark are depicted in a font that bears a noticeable resemblance to the Spencerian Script adopted by the Opponent as part of its trademark COCA-COLA DESIGN. Therefore, the Opponent's section 12(1)(d) ground of opposition also succeeds based on registration No. TMA374,143.

[29] As the Opponent has succeeded under section 12(1)(d) with respect to three of its registrations, I will refrain from considering the remaining seven registrations identified in its statement of opposition.

Section 16(3)(a) ground of opposition

[30] With this ground of opposition, the Opponent pleads that the Applicant is not the person entitled to register the Mark because, as of the Application filing date, it was confusing with the Opponent's registered trademarks which had been previously used in Canada.

[31] The Opponent has readily met its initial evidential burden for this ground of opposition, as it has demonstrated use of its trademarks WAVE DESIGN and COCA-COLA DESIGN since prior to the Application filing date. The legal burden is therefore on the Applicant to demonstrate that there was no likelihood of confusion as of the Application filing date, namely, December 21, 2017.

[32] In my view, the earlier material date for the non-entitlement ground of opposition does not alter the confusion analysis set out above for the section 12(1)(d) ground of opposition. Thus, the Applicant has not met its legal burden to demonstrate no likelihood of confusion as of the material date for the non-entitlement ground, and the section 16(3)(a) ground of opposition is also successful.

Remaining grounds of opposition

[33] As I have already found in the Opponent's favour in respect of the section 12(1)(d) and section 16(3)(a) grounds of opposition, I will refrain from addressing the section 2 and 30(i) grounds of opposition.

DISPOSITION

[34] 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 2022-09-06

APPEARANCES

Melissa Binns For the Opponent

No one appearing For the Applicant

AGENTS OF RECORD

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Neomark Ltd. For the Applicant