



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 029

Date of Decision: 2023-02-17

IN THE MATTER OF AN OPPOSITION

Opponent: Tree Top, Inc.

Applicant: Zhen Ding Ji Tea Co., Ltd

Application: 1,914,258 for tea top logo

INTRODUCTION

[1] Zhen Ding Ji Tea Co., Ltd (the Applicant) has applied to register the trademark tea top logo (the Mark), shown below:



[2] Colour is claimed as a feature of the trademark. The trademark uses orange color as its background, with the words 'Tea Top' and a graphic design on the left side in white color.

[3] The Mark is associated with the following goods and services (the Goods and Services):

Goods

(1) Beverages made of tea; black tea; bread; cakes; coffee beverages with milk; cookies; Earl Grey tea; edible ices; English tea; flowers or leaves for use as tea substitutes; fruit teas; ginger tea; green tea; honey; iced tea; Japanese green tea; jasmine tea; lime tea; non-alcoholic chocolate-based beverages; non-alcoholic tea-based beverages; oolong tea; pastries; puddings; sago; sorbets; sugar; tapioca; tea (Nice class 30)

(2) Beverages consisting of a blend of fruit and vegetable juices; frozen fruit drinks; fruit beverages and juices; fruit-based soft drinks flavored with tea; fruit-based soft drinks flavoured with tea; fruit-flavored beverages; fruit-flavoured beverages; fruit-flavoured beverages; iced fruit drinks; non-alcoholic beverages flavored with tea; non-alcoholic fruit drinks; non-alcoholic fruit juice drinks; sherbet beverages; soda water; soft drinks flavoured with tea; vegetable-based drinks (Nice class 32)

Services

(1) Advertising agencies; advertising the goods and services of others via electronic media and specifically the internet; import-export agency services; offering technical assistance in the establishment and operation of restaurant franchises; on-line advertising for others on computer networks; retail sale of food; retail services in relation to non-alcoholic drinks; sample distribution; wholesale store services featuring baked goods; wholesale store services featuring desserts; wholesale store services featuring teas (Nice class 35)

(2) Boarding houses; catering for the provision of food and beverages; coffee and tea bars; providing campground facilities; providing information in the nature of recipes for drinks; rental of drink dispensing machines; restaurant services featuring take-out services; restaurants; self-service restaurants; snack-bars; tea bar services; tea rooms; teahouse services (Nice class 43)

[4] Tree Top, Inc. (the Opponent) asserts several grounds of opposition including that the Mark is confusing with its registered word trademark TREE TOP, registered for use in association with: apple juice, frozen apple juice concentrate, apple cider, apple sauce, apple pie mix and dried apples.

[5] For the following reasons, the opposition is rejected. On the evidence of record, I find on a balance of probabilities that Mark is not confusing with the registered trademark TREE TOP. As for the other grounds of opposition, the Opponent did not submit any evidence and has failed to meet the initial evidential burden required to support these grounds.

THE RECORD

[6] The application was filed on August 10, 2018, advertised for opposition on November 25, 2020 and opposed on May 25, 2021. I note that the Trademarks Act, RSC 1985, c T-13 (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).

[7] Neither party submitted evidence and only the Opponent submitted written representations. No hearing was held.

GROUND OF OPPOSITION SUMMARILY DISMISSED

[8] The Opponent recognizes in its written representations that given it did not file any evidence that it will only rely on its ground of opposition based on Sections 38(2)(b) and 12(1)(d). Given the absence of evidence from the Opponent, there is no basis on which I could find that the Opponent has met its evidential burden with respect to the following grounds of opposition:

- (a) Sect. 38(2)(a.1), the application was filed in bad faith.
- (b) Sect. 38(2)(a.1), (I presume that what was intended to be referenced was Sect. 38(2)(e)) at the time of filing of the application, the Applicant was not using and did not truly propose to use the Mark in Canada in association with its Goods and Services.
- (c) Sect. 38(2)(c), the Applicant is not the person entitled to registration of the Mark having regard to Sect. 16(1)(a) and 16(1)(c) of the Act.

(d) Sect. 38(2)(d), the Mark is not and cannot be distinctive of the Applicant's Goods and the Applicant's Food and Beverage related Services within the meaning of Sect. 2 and 6 of the Act.

[9] Consequently, I dismiss each of these grounds of opposition as the Opponent has failed to meet its initial evidential burden.

SECTION 12(1)(D) GROUND OF OPPOSITION

[10] The material date to assess a section 12(1)(d) ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trademarks* (1991), 37 CPR (3d) 413 (FCA)].

[11] With regard to the registrability ground, the Opponent's initial evidential burden is met if the registration upon which it relies is in good standing at the date of this decision. I have exercised my discretion to check the Register to confirm that the registration of TREE TOP (TMA249,092) for use in association with apple juice, frozen apple juice concentrate, apple cider, apple sauce, apple pie mix and dried apples is in good standing [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent has therefore met its initial evidential burden for the section 12(1)(d) ground of opposition.

[12] The Applicant must now satisfy the Registrar, on a balance of probabilities, that the registrability ground should not prevent registration of the Mark [see *Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd*, 1990 CanLII 11059, 30 CPR (3d) 293 (FCTD)]. The question is whether, on a balance of probabilities, there is a reasonable likelihood of confusion between the Mark and the registered trademark TREE TOP. For the following reasons, I find there is no confusion.

Test for confusion

[13] Trademarks are confusing when there is a reasonable likelihood of confusion within the meaning of section 6(2) of the Act:

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 ... associated with those trademarks are manufactured ... by the same person...

[14] Thus, the issue is confusion of goods from one source as being from another source. In the present case, the question posed by section 6(2) of the Act is whether the average consumer of the Applicant's goods and services, sold in association with the Mark, would believe that these goods and services were sold/provided or authorized or licensed by the Opponent who sells its registered goods under the TREE TOP trademark.

[15] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two trademarks are confusing, are "all the surrounding circumstances" including those specifically mentioned 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 each has been in use; the nature of the goods, services or business; the nature of the trade; the degree of resemblance including in appearance or sound or in the ideas suggested by them. These criteria 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 (CanLII), [2006] 1 SCR 772 (SCC) at para 54].

[16] Taking into consideration *Masterpiece Inc v Alavida Lifestyles Inc*, (2011), 2011 SCC 27 (CanLII), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the trademarks, will often have the greatest effect on the confusion analysis, I will start my analysis with this factor.

Degree of resemblance

[17] When considering the degree of resemblance between trademarks, they must be considered in their totality; it is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the marks [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, para 20]. The

preferable approach when assessing the degree of resemblance between two trademarks is to consider whether there is an aspect of each trademark that is particularly striking or unique [see *Masterpiece*, *supra*, at para 64].

[18] In my view, the dominant features of the Opponent's trademark are the words TREE TOP and those of the Applicant's trademark are the words TEA TOP and the claimed orange circle design.

[19] While both trademarks have a common element "TOP", I find that, when they are considered in their totality, the parties' trademarks differ in appearance (the design element of the Applicant's Mark helps to distinguish between the parties' trademarks) and in idea suggested (tea which suggests a beverage vs. tree which suggests a plant). On the other hand, as alleged by the Opponent, the trademarks do sound similar to a certain extent given the common element "TOP" and the two-letter difference between the words TEA and TREE.

[20] Accordingly, given the differences in appearance and idea suggested, I find this factor favours the Applicant.

Inherent distinctiveness and the extent to which they have become known

[21] Both trademarks are made of common English words. The Opponent's mark suggests the highest point of a plant/tree which is neither descriptive nor suggestive of the Opponent's goods, giving some degree of distinctiveness to its mark. On the other hand, the Applicant's Mark suggests a beverage, namely tea, which is related to several Goods and some Services in its application but its design, including the orange background circle, gives it some degree of inherent distinctiveness.

[22] As for the extent to which the trademarks have become known in Canada, neither party has submitted any evidence of use or promotion of their respective trademarks, or other evidence suggesting that their trademarks have become known in Canada to any extent.

[23] Therefore, given that both trademarks have some degree of inherent distinctiveness and the absence of evidence to assess their respective acquired distinctiveness, as a whole, this factor favours neither party.

Length of time they have been used

[24] As discussed above, there is no evidence of use for either trademark, therefore this factor favours neither party.

Nature of goods, services or businesses; and nature of trade

[25] It is the Applicant's statement of Goods and Services as defined in its application versus the Opponent's registered goods that govern my determination of this factor [*Esprit International v Alcohol Countermeasure Systems Corp.* (1997), 84 CPR (3d) 89 (TMOB)]. While the Opponent's registered goods are food and drinks related items specifically made with apples (juice, cider, sauce, pie mix), the Applicant's statement covers a variety of food and beverage products (including fruit juice and drinks) and a wide range of services varying from sale of food and beverages to campground and online advertising.

[26] There is overlap in the nature of goods between the Opponent registered goods and the "fruit and vegetable juices; frozen fruit drinks; fruit beverages and juices; fruit-flavored beverages; iced fruit drinks; non-alcoholic fruit drinks; non-alcoholic fruit juice drinks" (Overlapping Goods) of the application. The remaining goods in the application are related to tea, ready to eat desserts, soft drinks, and are not overlapping with the Opponent's registered goods.

[27] As the Opponent's registration covers goods related to food and drinks, I do see potential overlap with the Applicant's Services in the area of sale, specifically: "retail sale of food; retail services in relation to non-alcoholic drinks" (Overlapping Services).

[28] For the channels of trade, both parties are involved in the food and beverage industry. As suggested by the Opponent, it is possible that the Overlapping Goods could be available in the same grocery stores, specialty food stores or restaurant. The Applicant's Overlapping Services also fall within the description of the Opponent's

registered goods, as the Opponent needs to sell its food and drink products. Without any evidence on file from either party, I can only conclude that there is a potential overlap between the parties' channels of trade for the Overlapping Goods and Overlapping Services.

[29] Therefore, these factors favour the Applicant, except for the Overlapping Goods and Overlapping Services where they favour the Opponent.

Conclusion regarding confusion

[30] Ultimately, the test to be applied is whether a casual Canadian consumer, having an imperfect recollection of the Opponent's trademark TREE TOP in association with the Opponent's registered goods, when he or she sees the Mark in association with the Goods and Services, who does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks, would think that the Goods and Services come from the same source.

[31] Having considered all of the surrounding circumstances contemplated by section 6(5) of the Act, I conclude that the Applicant has met its legal onus of establishing on a balance of probabilities that there is not a reasonable likelihood of confusion between the Mark and the Opponent's TREE TOP trademark registration. I reach this conclusion mainly as I find that the lack of resemblance between the trademarks at hand outweighs the factors which favour the Opponent. As was confirmed by the Supreme Court in the *Masterpiece* decision, *supra*, at para 49, "[...] if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion".

[32] Consequently, this ground of opposition is dismissed.

DISPOSITION

[33] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

Martin Béliveau
Chairperson
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Opponent: BCF S.E.N.C.R.L./BCF LLP

For the Applicant: No agent appointed