



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 042

Date of Decision: 2023-03-08

IN THE MATTER OF AN OPPOSITION

Opponent: David Chapman's Ice Cream Limited/David Chapman's Ice Cream Limitée

Applicant: Lidl Stiftung & Co. KG

Application: 1,899,891 for Little Octo

INTRODUCTION

[1] Lidl Stiftung & Co. KG (the Applicant) has applied to register the trademark Little Octo (the Mark), which is the subject of application No. 1,899,891 (the Application) in association with the following goods:

Ice, ice creams, frozen yogurts and sorbets; Ice confectionery; Frozen confectionery containing ice cream. (the Goods)

[2] David Chapman's Ice Cream Limited/David Chapman's Ice Cream Limitée (the Opponent) opposes the Application based on alleged confusion with its LI'L-formative registered trademarks, which comprise its LI'L family of marks and have been

previously used in Canada by the Opponent in association with a line of frozen confectionery and ice cream products, as well as frozen yogurt confectionery products. The full particulars of the Opponent's registrations are set out in Schedule A hereto.

[3] For the reasons that follow, the opposition succeeds.

THE RECORD

[4] The Application was filed on May 18, 2018 and claims a priority filing date based on a corresponding application filed in Germany on December 4, 2017. The Mark has been applied for registration on the dual bases of proposed use in Canada and registration and use in Germany in association with the same kind of goods. The Application was advertised for opposition purposes in the *Trademarks Journal* on January 8, 2020.

[5] The Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on July 7, 2020, which was later amended by the Opponent, with leave of the Registrar granted on August 13, 2020, in response to the Applicant's request for an interlocutory ruling on the sufficiency of certain paragraphs of the statement of opposition. By way of an interlocutory decision rendered concomitantly, the Registrar struck some of the grounds of opposition pleaded in the amended statement of opposition. The remaining grounds of opposition are based on non-registrability of the Mark under section 12(1)(d) of the Act; non-entitlement of the Applicant under section 16(1)(a) of the Act; and non-distinctiveness of the Mark under section 2 of the Act, and all revolve around the likelihood of confusion between the Mark and the Opponent's LI'L-formative registered trademarks.

[6] On September 9, 2020, the Applicant filed and served a counter statement denying the grounds of opposition.

[7] In support of its opposition, the Opponent filed the affidavit of its Vice President, David Chapman, originally sworn January 8, 2021 and re-sworn on October 5, 2021 (collectively, the Chapman affidavit). The Chapman affidavit speaks to the issue of the

Opponent's use of its above-identified L'L-formative registered trademarks.
Mr. Chapman was not cross-examined on his affidavit.

[8] In support of its Application, the Applicant filed the solemn declaration of Karine Pommier, trademark agent in the Trademarks Department of the Applicant's agent, dated March 23, 2021 (the Pommier Declaration). The Pommier Declaration purports to introduce into evidence the particulars of various trademark applications and registrations printed from the Canadian Intellectual Property Office (CIPO)'s Trademarks Database. Ms. Pommier was cross-examined on her solemn declaration, and the transcript of her cross-examination and replies to undertakings form part of the record, as will be discussed further below.

[9] Only the Opponent filed written representations and was represented at a hearing.

PRELIMINARY REMARKS

[10] As a preliminary matter, I note that both in its written representations and at the hearing, the Opponent has objected to the admissibility of the Pommier Declaration and submitted that it should be struck from the record since the evidence filed by the Applicant "is essentially the evidence of Mr. Laurent Carrière (a partner at [the Applicant's trademarks agent firm]), filed under the guise of a trademark agent."

[11] More particularly, the Opponent submits that "it became clear via cross-examination that much of [Ms. Pommier's evidence] was either inadmissible hearsay and based on information provided to her by Mr. Carrière" in that Ms. Pommier did not:

- prepare the list of trademarks attached to her affidavit;
- know the parameters of how Mr. Carrière developed the list;
- know what searches Mr. Carrière conducted and sources he relied on to develop the list; or
- know whether Mr. Carrière left out any trademarks, etc.

[12] However, as further explained in the cross-examination transcript and replies to undertakings, the Pommier Declaration merely purports to introduce into evidence the particulars of a list of trademark applications and registrations she was given by Mr. Carrière (Exhibit KPO-1), and to print these particulars using CIPO Trademarks Database (Exhibit KPO-2). While there may be a subjective element to how the list of trademarks was compiled, the information presented in Exhibit KPO-2 is essentially a reflection of existing Trademark Office records. The Applicant could have chosen to file certified copies of each of these trademark applications and registrations. Instead, the Applicant chose to have the particulars of these trademark applications and registrations introduced into evidence as attachments to the Pommier Declaration.

[13] Based on the foregoing, I refuse to strike the Pommier Declaration from the record. That said, and as will be discussed further below, there are limitations to the weight to be given to the Pommier Declaration.

ANALYSIS OF THE GROUNDS OF OPPOSITION

Non-registrability of the Mark

[14] The Opponent has pleaded that the Mark is not registrable because it is confusing with its LI'L-formative registered trademarks comprising its LI'L family of marks.

[15] I have exercised the Registrar's discretion to confirm whether each of the Opponent's pleaded registrations is in good standing as of today's date, which is the material date for assessing a section 12(1)(d) ground of opposition [*Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)]. In this regard, I note that registration Nos. TMA626762 and TMA627607 for the trademarks LI'L BERRY and LI'L JUICY, respectively, were both expunged on September 24, 2020 and can therefore no longer form the basis of a ground of non-registrability based on section 12(1)(d) of the Act.

[16] As the Opponent has met its evidential burden in respect of its other seven registered trademarks, the Applicant must therefore establish, on a balance of

probabilities, that there is not a reasonable likelihood of confusion between the Mark and any one of the Opponent's remaining pleaded registrations comprising its LI'L family of marks.

[17] In this regard, I stress that the Opponent's registered marks must be reviewed individually and not collectively as a "family of marks" for the purpose of assessing the likelihood of confusion with the Mark. As discussed below, however, evidence of a family of marks is a relevant surrounding circumstance in each case. That said, and unless indicated otherwise, I will focus my analysis on the Opponent's trademark LI'L LOLLY'S of registration No. TMA597848.

The test for confusion

[18] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act 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.

[19] Thus, section 6(2) of the Act does not concern the confusion of the trademarks themselves, but of the goods or services from one source as being from another. In the present case, the question is essentially whether a consumer, with an imperfect recollection of one of the Opponent's LI'L LOLLY'S trademark, who sees the Applicant's Goods in association with the Mark, would think that they are sold or otherwise emanate from or are licensed, approved or sponsored by the Opponent.

[20] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time the trademarks have been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks, including in appearance or sound or in the ideas

suggested by them. This list is not exhaustive, and all relevant factors are to be considered. Further, all factors are not necessarily attributed equal weight as the weight to be given to each depends on the circumstances [see *Mattel, Inc v 3894207 Canada Inc* 2006 SCC 22, 49 CPR (4th) 321; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* 2006 SCC 23, 49 CPR (4th) 401; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 for a thorough discussion of the general principles that govern the test for confusion].

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

[21] The parties' trademarks are inherently distinctive in the context of their associated goods, although arguably less so in the case of the Opponent's trademark given the suggestive connotation or descriptive character of the second element LOLLY'S—suggestive of the word “lollypop”—in the context of the Opponent's frozen confectionery and ice cream products. I will return to this point when assessing the degree of resemblance between the parties' trademarks in the ideas suggested by them.

[22] The degree of distinctiveness of a trademark may be increased by means of it becoming known through promotion or use.

[23] There is no evidence that the Mark has been used or has become known in Canada in association with the Goods to any extent.

[24] In contrast, the evidence of use of the Opponent's LI'L-formative registered trademarks filed through the Chapman affidavit establishes quite extensive use of the trademark LI'L LOLLY'S, as per my review below of the Chapman affidavit.

The Chapman affidavit

[25] Because the Opponent's evidence of use of its other LI'L-formative registered trademarks will be relevant as an additional surrounding circumstance, I summarize below those portions of the Chapman affidavit that I consider to be the most pertinent regarding the extent of use and promotion of both the Opponent's LI'L LOLLY'S

trademark and the Opponent's other relied-upon trademark registrations comprising its LI'L family of marks.

[26] Mr. Chapman essentially attests to the following:

- the Opponent is a family-run business that was created by Mr. Chapman's parents. The Opponent's business has evolved from a small creamery in Markdale, Ontario, in 1973 to one of Canada's largest independent ice cream manufacturers, known as "CHAPMAN'S" [paras 1 and 3];
- as of July 2007, the Opponent had 85 independent distributors working for it, including 25 distributors disbursed throughout Newfoundland, New Brunswick, Alberta, Saskatchewan, Manitoba, British Columbia, Alberta, Quebec and Labrador, and as of October 2020, the Opponent continued to have over 85 distributors working for it [para 4];
- the Opponent has been offering "quality" ice cream products for over 45 years. Presently, the Opponent is the "top" independent ice cream producer in Ontario, the largest manufacturer of frozen yogurt and sorbet products in Canada and the third largest manufacturer of ice cream and novelty products in Canada (behind Nestlé's and Unilever) [para 5 and Exhibit A: excerpts from the Opponent's website at www.chapmans.ca];
- over the years, the Opponent has made a concerted effort to distinguish itself from other Canadian manufacturers by developing various unique and innovative flavours, packaging, and many specialty products. For example, the Opponent was one of the first Canadian ice cream manufacturers to develop a line of lactose free products and frozen yogurts as well as peanut/nut free, no sugar added and lactose free products, which have been and continue to be recognized by nutritional programs across Canada. In 2004, the Opponent started offering organic products and, in 2005, the Opponent made several of its products "gluten free" to meet the needs of consumers with some form of celiac allergy, or the intolerance of gluten, in their diet. The Opponent is a proponent of increasing awareness about healthier lifestyles and cater to those with special needs, and has earned high praise from the Canadian Diabetes Association and

WeightWatchers for catering to ice cream lovers with special dietary needs [para 6];

- as part of the above efforts, in 2002 the Opponent launched a line of LI'L frozen confectionary and ice cream products, which was later expanded in 2004 to frozen yogurt confectionary products. This line was a lower caloric line of products, to try and promote a healthier lifestyle. Since the launch, the LI'L component has been continuously used in a number of the Opponent's trademarks associated with this line of products, including the Opponent's remaining pleaded registrations. The Opponent has also used other formative LI'L-formative marks in the past (e.g. LI'L SLIDERS, LI'L BERRY, and LI'L JUICY) [para 7, which further includes a chart providing examples of some of the packaging the Opponent has used, the approximate number of packages that have been printed/distributed in Canada, as well as the dates of first use in Canada for each of the Opponent's relied-upon registered trademarks (except LI'L YOGURT DIPS of registration No. TMA681675): LI'L SAMMICH (2004), LI'L LOLLY (2003), LI'L FUDGY (2004), LI'L TREATS (2002), LI'L FROSTY (2004), and LI'L YOGURT N' JUICY (2004); and Exhibit C: excerpts from the Opponent's 2019 product catalogue, which depict some of the Opponent's "more popular LI'L products, including [the Opponent's] ROCKET LI'L LOLLY, LI'L LOLLY, and LI'L SAMMICH products]";
- the products featured each year in the Opponent's product catalogue may differ depending on the demand of the products and the Opponent's marketing strategy. Mr. Chapman explains that although all products may not be included in the catalogue or sold during one season/year, this does not mean that the Opponent no longer sells the product. He further asserts that a selection of the LI'L products have always been included in the Opponent's product catalogues since at least 2004;
- the Opponent's ice cream, frozen confectionery and frozen yogurt confectionery products that depict the LI'L-formative registered trademarks are sold throughout Canada in grocery stores. Some of the Opponent's retailers not only advertise the Opponent's products in their flyers, but also online [para 8, which further

includes a chart outlining a more current selection of these stores; and Exhibit D: screenshots from the websites of various online retailers, such as *Walmart.ca*, *Loblaws.ca*, and *GroceryGateway.com*];

- the Opponent's products are also sold through mass merchandising and convenience channels and among others, national restaurant chains, catering companies, hotels and casinos [para 8];
- the LI'L-formative registered trademarks have been extensively promoted with the Opponent's ice cream and frozen confectionery products in, among other things, print, radio, television and online advertisements, various social media sites, coupons, flyers, shelf talkers, etc. In fact, in 2004, the Opponent spent over \$850,000 advertising its products, and from 2004 to the first date of signature of Mr. Chapman's affidavit, the advertising spent associated with the LI'L products exceeded over 1.5 million dollars [paras 9 to 12; Exhibit E: representative sample of promotional materials that depict the Opponent's LI'L-formative registered trademarks, together with a chart providing the dates and means of advertising; Exhibit F: examples of advertising done via social media; and Exhibit G: examples of advertising done via third party websites]; and
- as a result of the Opponent's extensive marketing/merchandising campaigns and the quality of its products, the LI'L branded products have become some of the Opponent's leading products. Between January 2010 and September 30, 2020 alone, Canadian sales of the Opponent's LI'L branded products exceeded \$66 million.

[27] I note that in all of the various examples of use and promotion of the LI'L-formative registered trademarks, the marks are always displayed in combination with the separate and distinct trademark CHAPMAN'S. However, it is well established that more than one trademark can be used together on the same product [*AW Allen Ltd v Warner Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD) at 272]. I further note that in most, if not all, of these examples, the first element LI'L comprising the LI'L-formative trademarks is written in smaller font than the second element, as illustrated in the examples below:



[28] In the same vein, I note that in many of these examples, the trademark LI'L LOLLY'S is reproduced without the apostrophe "S". Nevertheless, I am satisfied that the use of all of the exhibited stylized forms of each of the LI'L-formative trademarks as depicted in the evidence are valid for the use of each corresponding LI'L-formative registered word mark, which in my view preserves its identity and overall remains recognizable in the context of its use [according to *Registrar of Trade Marks v Compagnie Internationale pour l'informatique CII Honeywell Bull*, 1985 CanLII 5537, 4

CPR (3d) 523 (FCA); and *Nightingale Interloc v Prodesign* (1984), 2 CPR (3d) 535 (TMOB)]. In this regard, it is worth reminding that each of the registrations for the LI'L-formative word marks allows the Opponent to use it in "in any size and with any style of lettering, color or design", it being understood, however, that "one should be careful not to give the principle set out at paragraph 55 of *Masterpiece* too great a scope for there would no longer be any need to register a design mark when one has a word mark" [*Pizzaiolo Restaurants inc v Les Restaurants La Pizzaiolle inc*, 2016 FCA 265 at para 33].

Conclusion on this first factor

[29] Based on my review above of the Chapman affidavit as a whole, I find reasonable to conclude that each of the LI'L-formative remaining pleaded registrations (except the trademark LI'L YOGURT DIPS of registration No. TMA681675 for which no data with respect to the date of first use and approximate number of packages sold has been provided in the detailed chart at paragraph 7 of the affidavit) has become known at least to some extent in Canada, especially the Opponent's most popular LI'L SAMMICH and LI'L LOLLY'S products.

[30] Accordingly, the overall assessment of the section 6(5)(a) factor, which is a combination of inherent and acquired distinctiveness, ultimately favours the Opponent.

The length of time the trademarks have been in use

[31] As there is no evidence of use of the Mark in Canada and as the Opponent's trademark LI'L LOLLY'S has been used since 2003, this factor also favours the Opponent.

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

[32] The Goods and the Opponent's products are the same or clearly overlapping. In the absence of evidence to the contrary, I agree with the Opponent that the Goods would potentially be sold in the same retail stores, and possibly side by side, should the Applicant commence selling the Goods in Canada. Accordingly, these factors also favour the Opponent.

The degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them

[33] 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 trademarks [*Veuve Clicquot, supra* at para 20].

[34] In *Masterpiece, supra* at paragraph 64, the Court further advised that, while in some cases, the first word or syllable of a trademark will be the more important for the purpose of distinction, the preferable approach to considering resemblance “is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique”.

[35] With respect to the Mark, I do not consider either LITTLE or OCTO to necessarily be more striking or dominant, as the trademark would be perceived as the unitary phrase LITTLE OCTO. In comparison, in view of the descriptive connotation of the second element LOLLY’S comprising the Opponent’s trademark LI’L LOLLY’S, I find the element LI’L, appearing in the first position of the mark, is the more striking or dominant element thereof.

[36] That said, I agree with the Opponent that the Mark bears at least some degree of similarity with the Opponent’s trademark LI’L LOLLY’S. The parties’ trademarks each have the word LITTLE or its phonetic equivalent LI’L appearing in the first position of the mark, combined with a second element to create a “catchy phrase” where LITTLE (LI’L) qualifies the word that follows. The meaning to be ascribed to the word OCTO in the full context of the Mark in association with the Goods is unclear. Given the dictionary definition of that word, and without the benefit of any submissions on the particular idea(s) suggested by the Mark, I find the phrase LITTLE OCTO could arguably evoke the idea of a little something having eight components or ingredients. As such, the Mark, like the Opponent’s trademark LI’L LOLLY’S, could possibly be perceived as suggesting a characteristic of the products.

Additional surrounding circumstances

Family of marks

[37] As a surrounding circumstance with respect to the issue of confusion, the Opponent has relied upon the adoption and use of its LI'L family of trademarks. The Opponent submits that since it has established the existence of a family of LI'L-formative marks for similar goods, it follows that consumers would be more likely to assume that a new trademark with virtually the same first element and same "architecture" or "construction" for similar goods belongs to the Opponent as opposed to the Applicant. Stated differently, the Mark would be interpreted, at first sight, as another member of the Opponent's LI'L family of trademarks.

[38] It is true that when trademarks that have a common component or characteristic are all registered in the name of one owner, this gives rise to the presumption that these marks form a family of marks used by the one owner [see *McDonald's Corp v Alberto-Culver Co* (1995), 61 CPR (3d) 382 (TMOB); *McDonald's Corp v Yogi Yogurt Ltd* (1982), 66 CPR (2d) 101 (FCTD)]. In the present case, I am satisfied from the evidence furnished that the Applicant does have a family of LI'L-formative marks, and has used and advertised such trademarks in Canada. Thus, I consider this to be a relevant surrounding circumstance that favours the Opponent.

State of the register evidence

[39] While not expressly described as such, the Pommier Declaration appears to introduce state of the register evidence with respect to LITTLE-formative trademarks (or phonetic equivalents).

[40] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [*Ports International Ltd v Dunlop Ltd*, 1992 CarswellNat 1431 (TMOB); and *Welch Foods Inc v Del Monte Corp*, 1992 CarswellNat 178 (FCTD)]. Inferences regarding the state of the marketplace may be drawn from such evidence only if a large number of relevant trademarks are located [*Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 1992 CanLII 14792 (FCA), 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].

[41] The Applicant did not make any submissions, nor does the Pommier Declaration comment on the particulars of the trademark applications and registrations attached as Exhibit KPO-2. Accordingly, it is not clear what inferences favourable to the Applicant, if any, can be made from this evidence. In any event, admissibility issues aside, the Opponent submitted at the hearing that a number of the references outlined in the Pommier Declaration have either been subsequently expunged, abandoned or their specifications have been amended to remove ice cream related goods, i.e.:

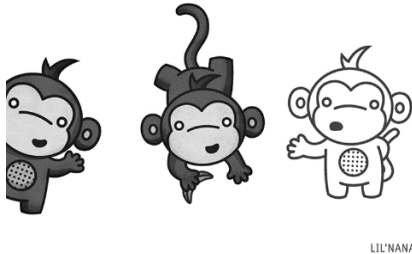
- LITTLE MAN (TMA596727)—this registration was owned by the Applicant and was expunged based on non-use;
- LITTLE DISH (TMA784594)—cancellation proceedings were successfully launched and the goods “pastry, ices, ice” were removed from the specification of goods;
- LITTLE MIRACLES (TMA838196)—cancellation proceedings were successfully launched and the goods “pastry, ices, ice” were removed from the specification of goods;
- LITTLE BELLIES (TMA937417)—cancellation proceedings were successfully launched and the various frozen confectionary products, including ice cream, ice cream products, non-dairy frozen dessert products and frozen confectionary were removed from the specification of goods; and
- LIL TOTS (Appl. No. 1,919,610)—this application was abandoned.

[42] Commenting on each of the remaining third-party trademark applications and registrations included under Exhibit KPO-2, the Opponent submitted at the hearing that none of these trademarks is as close to the Opponent’s LI’L-formative registered trademarks as is the Applicant’s Mark or, alternatively, their associated statements of goods do not cover ice cream-related goods, but dissimilar goods.

[43] First, I note that many of the trademark applications as listed under Exhibit KPO-2 are to be disregarded as their particulars do not show that they are allowed and based on use. I shall add that the Registrar is under no obligation to verify the status of each of the numerous applications and registrations listed in the Pommier Declaration in order to affirm their accuracy as of the material date to assess the present ground of opposition, not to mention that the Applicant elected not to make any representations in this regard.

[44] Second, except for the trademarks discussed in more detail below, I agree with the Opponent that all of the remaining third-party trademark applications and registrations attached under Exhibit KPO-2 appear to be quite different as they either do not include the component LITTLE/LI'L *per se* (e.g. registration No. 944739 for LILISE, and registration No. 839861 for LILLIPOPS), or the component LITTLE/LI'L is not the dominant element of the trademarks or is not used in a similar "construction" as in the parties' trademarks (e.g. registration No. 1543653 for LITTLES IDEAS HAPPY MOMENTS & Design).

[45] This leaves the following trademark registrations that I consider to be the most pertinent:

Trademark	Reg. Number	Goods/Services
<p data-bbox="201 1276 526 1314">LI'L NANA and Design</p> 	<p data-bbox="683 1276 808 1314">1014455</p>	<p data-bbox="937 1276 1416 1696">1) Cold and frozen desserts, namely frozen confectionery, soft serve, sundaes, smoothies, milkshakes and ice-cream; promotional materials, namely [...] ;1) Restaurant services; sales of cold and frozen desserts and promotional materials, [...].</p>
<p data-bbox="201 1724 574 1761">LITTLE BEAN and Design</p>	<p data-bbox="683 1724 792 1761">935181</p>	<p data-bbox="937 1724 1382 1871">Various food products and services, including: "beverages containing ice-cream".</p>

		
<p>LITTLE SHEEP and LITTLE SHEEP Design</p> 	<p>1073997; and 1074083</p>	<p>Various food products and services, including: “ice creams” and “edible ices”.</p>

[46] Even if I were to accept that the existence of these three registrations amounted to a surrounding circumstance in the Applicant’s favour, I am not prepared to give it significant weight in this case. Indeed, given the low number of relevant registrations and in the absence of state of the marketplace evidence with respect to any of these third-party trademarks, I am not prepared to make any inferences favourable to the Applicant based on the Pommier Declaration. It is worth mentioning in this regard that Mr. Chapman states at paragraph 14 of his affidavit that, by virtue of his extensive experience and involvement in the ice cream industry, he is familiar with the marketing efforts and brands of the Opponent’s competitors in Canada and that he is not aware of any other ice cream products sold in Canada that use the LI’L component (or a phonetically similar component) as part of their brand.

Conclusion re: likelihood of confusion

[47] Considering the extent of use and length of time the Opponent's trademark LI'L LOLLY'S has been in use, the fact that the parties' goods and channels of trade are the same or potentially overlapping, and the fact that the Opponent has established that it owns a family of LI'L-formative trademarks, I conclude that the Applicant has not satisfied its legal burden of demonstrating, on a balance of probabilities, no likelihood of confusion. Accordingly, the section 12(1)(d) ground of opposition is successful.

[48] As the Opponent has succeeded with its trademark LI'L LOLLY'S, it is unnecessary to consider the remaining trademarks pleaded under this ground.

Non-entitlement of the Applicant

[49] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark because at the date of filing of the Application, the Mark was confusing with the Opponent's LI'L-formative registered trademarks comprising its LI'L family of marks.

[50] In order to meet its initial burden under section 16(1)(a) of the Act, the Opponent must show that as of the date of filing of the Application, one or more of its relied-upon trademarks had been previously used in Canada and had not been abandoned as of the date of advertisement of the Application [section 16(3) of the Act]. As with the section 12(1)(d) ground of opposition, I will focus my analysis on the Opponent's trademark LI'L LOLLY'S.

[51] As per my review above of the Chapman affidavit, I am satisfied that the Opponent has met its initial burden with respect to this mark. Given that the difference in material dates does not substantially affect my conclusion under the section 12(1)(d) ground of opposition discussed above, I reach the same conclusion regarding the likelihood of confusion as under the 12(1)(d) ground of opposition.

[52] Accordingly, the section 16 ground of opposition is successful.

[53] As the Opponent has succeeded with its trademark LI'L LOLLY'S, it is unnecessary to consider the remaining trademarks pleaded under this ground.

Remaining ground of opposition

[54] As the Opponent has succeeded under two grounds of opposition, it is not necessary to address the remaining ground of opposition based on non-distinctiveness of the Mark.

DISPOSITION

[55] 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.

Annie Robitaille
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

I am reproducing below the full particulars of the Opponent's registrations *as set out in its statement of opposition*. In this regard, I note the typographical error in the spelling of the trademark LI'L LOLLY'S (registration No. TMA597848).

Trademark	Registration No.	Goods
LIL TREATS	TMA709642	Frozen confectionery and ice cream. Frozen yogurt confections.
LIL SAMMICH	TMA626677	Frozen confectionery and ice cream.
LIL JUICY	TMA627607	Frozen confectionery and ice cream.
LIL FROSTY	TMA626617	Frozen confectionery and ice cream, namely chocolate-coated ice cream on a stick sold in boxes containing multiple units of individually wrapped single serve product.
LIL BERRY	TMA626762	Frozen confectionery and ice cream.
LIL FUDGY	TMA626717	Frozen confectionery and ice cream.
LI'LOLLY'S	TMA597848	Frozen confectionery and ice cream.
LIL YOGURT 'N JUICY	TMA689428	Frozen yogurt confections.
LIL YOGURT DIPS	TMA681675	Frozen yogurt confections.

Appearances and Agents of Record

HEARING DATE: 2023-02-07

APPEARANCES

For the Opponent: Stephanie N. Vaccari

For the Applicant: No one appearing

AGENTS OF RECORD

For the Opponent: Baker & McKenzie LLP

For the Applicant: Robic