



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 046

Date of Decision: 2023-03-10

IN THE MATTER OF AN OPPOSITION

Opponent: Kuok Registrations Limited

Applicant: Kerry Luxembourg S.à.r.l.

Application: 1,724,259 for KERRY DISCOVERY

INTRODUCTION

[1] Kerry Luxembourg S.à.r.l. (the Applicant) has applied to register the trademark KERRY DISCOVERY (the Mark).

[2] The Mark is applied for in association with the following services (the Services):

Advertising the goods and services of others; developing marketing strategies and marketing concepts for others; market research and market analysis; brand planning and development; compilation of statistics and analysis of market research, data and statistics; product research and development; research, development and design services relating to food products and beverages; information, advisory, consultancy, and testing services in the field of food and beverage products, food and beverage ingredients, dietary and nutritional supplements, and new product research and design relating thereto.

[3] Kuok Registrations Limited (the Opponent) opposes registration of the Mark. The opposition is based on allegations that the application does not comply with sections 30(a) and 30(i) of the Act, that the Applicant is not the person entitled to use the Mark, and that the Mark is confusing with the Opponent's trademark KERRY LOGISTICS Design, Registration No. TMA958,144 (the Logistics Mark), and the trademark KERRY, which is the subject of application No. 1,725,738 (collectively, the Opponent's Marks).

[4] For the reasons that follow, the application is refused in part.

THE RECORD

[5] The application was filed on April 17, 2015, based on proposed use in Canada, and claiming a priority filing date of February 16, 2015, based on an application filed in Ireland under application No. 2015/00334.

[6] The application was advertised for opposition purposes in the *Trademarks Journal* on November 2, 2016. On December 19, 2016, the Opponent opposed the application by filing a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). This statement of opposition was amended on January 24, 2017, and on August 18, 2017.

[7] All references are to the Act as amended June 17, 2019, with the exception of references to the grounds of opposition which refer to the Act as it read before it was amended (see section 70 of the Act).

[8] The grounds of opposition are summarized below:

- Contrary to section 30(a) of the Act, the statement of services in the application is not set out in sufficient detail and thus not in ordinary commercial terms.
- Contrary to section 30(i) of the Act, the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Services given that the Applicant should have been aware of the use in Canada of the

Opponent's Marks in association with the Opponent's services prior to the date of filing of the application.

- Contrary to section 12(1)(d) of the Act, the Mark is not registrable as it is confusing with the Opponent's Logistics Mark.
- Contrary to section 16(3) of the Act, the Applicant was not the person entitled to registration of the Mark in association with the Applicant's Services as the Mark was confusing with the Opponent's Marks previously used in Canada.
- Contrary to section 2 of the Act, the Mark is not distinctive.

[9] On May 11, 2017, the Applicant served and filed a counter statement denying each of the grounds of opposition. Both parties filed evidence, which is discussed below. No cross examinations were conducted with respect to any evidence filed in this proceeding.

[10] Both parties also filed written representations; only the Applicant was represented at an oral hearing.

EVIDENCE

Opponent's Evidence

[11] The Opponent filed two affidavits as its evidence in this proceeding. One such affidavit, the affidavit of Lee Pui Nee, Company Secretary of the Opponent, sworn June 11, 2018, does not form part of the record in this proceeding as Ms. Lee was not made available for cross-examination. The Opponent also filed the affidavit of Elena Anastacio, a trademark searcher employed by the Opponent's agent of record, sworn June 8, 2018 (the Anastacio Affidavit). Ms. Anastacio was not cross-examined on her affidavit.

[12] The Anastacio Affidavit attaches the particulars of the Opponent's registration for the Logistics Mark and the Opponent's application for the trademark KERRY which is currently being opposed by the Applicant. The Logistics Mark is registered in association with a large number of services set out in Schedule A to this decision.

Applicant's Evidence

[13] The Applicant submitted three affidavits as its evidence in this proceeding: the affidavit of Denise Ciancone, a legal assistant employed by the Applicant's agent of record, sworn January 21, 2021 (the Ciancone Affidavit); the affidavit of Elizabeth Dingman, a reference librarian employed by the Applicant's agent of record, sworn January 21, 2021 (the Dingman Affidavit); and the affidavit of Matthew Cook, an articling student employed by the Applicant's agent of record, sworn February 1, 2021 (the Cook Affidavit). None of the Applicant's affiants were cross-examined.

[14] The Ciancone Affidavit attaches the file history for the Opponent's application for the trademark KERRY. In particular, the file history shows that in the course of this application, the Applicant's application for the Mark was cited by the Registrar as confusingly similar and the Opponent's application was objected to on the basis that the Opponent was not the party entitled to registration of the KERRY trademark. The Opponent then filed written submissions on November 30, 2016, taking the position that there was no likelihood of confusion between the Mark and the KERRY trademark. A copy of these submissions are attached as Exhibit B to the Ciancone Affidavit. The file history shows that the citation of the application for the Mark as confusingly similar was withdrawn by the Registrar, and the Opponent's application for the KERRY trademark was approved through an Approval Notice dated February 22, 2017.

[15] The Dingman Affidavit attaches dictionary definitions for the terms "Kerry", "logistics", and "discovery".

[16] The Cook Affidavit includes screenshots from the websites of the Opponent and Applicant providing details regarding their channels of trade.

Opponent's Reply Evidence

[17] As its reply evidence pursuant to section 54 of the Regulations, the Opponent submitted the affidavit of Dian Thompson, a lawyer at the Opponent's agent of record, sworn April 30, 2021 (the Thompson Affidavit). The exhibits attached to Ms. Thompson's affidavit include the following:

- Screenshots of the Opponent’s website referring to the Opponent “catering to the specific needs” of industries including “food & beverage” [Thompson Affidavit, Exhibit A, page 25];
- Screenshots of the Opponent’s website showing the Opponent distributing imported food and beverage products in Hong Kong, Macau, and Mainland China [Exhibit B, page 33] to an entity called “KerryFlex” as well as offering food and beverage solutions [Exhibit B, pages 35-36, 40]. With respect to the latter, it appears from the webpage that several such services are offered only in Hong Kong; there is no reference to Canada with respect to the food and beverage services outlined in the screenshots.
- Screenshots of the Opponent’s website outlining the Opponent’s operations in Canada, Mexico, and the United States. While “Food & Beverage” are listed under an “Industry Solutions” heading on the page relating to Mexico, only “Automotive” and “Fashion & Lifestyle” are listed under “Industry Solutions” on the page relating to Canada.
- Screenshots from the Opponent’s website showing a press release showing the acquisition of two Canadian freight forwarding companies [Exhibit D].
- A copy of the affidavit of Sandy Singh, sworn November 13, 2019, in respect of the opposition proceeding against the application for the Opponent’s KERRY trademark [Exhibit E].

PRELIMINARY ISSUE – ADMISSIBILITY OF THOMPSON AFFIDAVIT AS PROPER REPLY EVIDENCE

[18] The Applicant submits that the Thompson Affidavit is inadmissible or given no weight as it is not confined to matters in reply, but instead contains materials that ought to have been submitted as part of the Opponent’s evidence in chief. I agree with the Applicant’s objections in part.

[19] Proper reply evidence responds directly to points raised in an applicant's evidence which are unanticipated. It should not include evidence which could have been filed as part of the opponent's evidence in chief [see *Lemon Hart Rum Co v Bacardi & Co*, 2015 TMOB 75 at para 22; and *Halford v Seed Hawk Inc*, 2003 FCT 141 (FCTD) (*Seed Hawk*) at paras 14-15].

[20] I will begin by finding that Exhibits A through C of the Thompson affidavit are acceptable as proper evidence in reply. In this regard, I accept that these screenshots from the Opponent's website may be understood to have been filed in response to the screenshots in the Cook Affidavit, perhaps to provide a fuller picture of the Opponent's operations globally. In any event, nothing in this decision will turn on these screenshots, since while they show that the Opponent provides services relating to the food and beverage industry in jurisdictions such as Hong Kong and Mexico, they do not show that the Opponent provides services relating to the food and beverage industry in Canada.

[21] I do not, however, find that the remainder of the Thompson Affidavit constitutes proper reply evidence. In this regard, the screenshots from the Opponent's website showing a press release with respect to the acquisition of two Canadian freight forwarding companies does not respond directly to anything raised by the Applicant in its evidence, and the affiant provides no explanation as to how it might do so. Instead, it appears to be evidence that should have been filed as part of the Opponent's evidence in chief. Therefore, to admit Exhibit D now would run contrary to the principle that an opponent ought not to be able to split its case [see *Seed Hawk, supra*].

[22] Similarly, the Singh affidavit attached as Exhibit E to the Thompson Affidavit includes material that ought to have been included as the Opponent's evidence in chief, and in any event, this affidavit amounts to hearsay that cannot be relied upon for the truth of its contents.

[23] In view of the above, I find that Exhibits A through C to the Thompson Affidavit are admissible, while Exhibits D and E do not amount to proper reply evidence and are therefore inadmissible.

ANALYSIS

Ground of Opposition: Section 30(a)

[24] The Opponent alleges that the Applicant's application does not conform to the requirements of section 30(a) of the Act, in that the statement of services in the application is not set out in sufficient detail and thus not in ordinary commercial terms.

[25] The material date for this ground is the priority filing date of February 16, 2015 [*Georgia-Pacific Corp v Scott Paper Ltd* (1984) 3 CPR (3d) 469 (TMOB) (*Georgia-Pacific*) at 475].

[26] As the Opponent did not file any evidence in support of this ground of opposition, nor make any submissions, this ground of opposition is rejected for the Opponent's failure to meet its evidential burden.

Ground of Opposition: Section 30(i)

[27] The Opponent alleges that contrary to section 30(i) of the Act, the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Applicant's Services given that at the date of filing of the application, a common-law use search would have located the Opponent's Marks. The Opponent submits that the Applicant therefore should have been aware of the use in Canada of the Opponent's Marks in association with the Opponent's services prior to the date of filing of the application.

[28] The material date for this ground of opposition is the priority filing date of February 16, 2015 [*Georgia-Pacific, supra*].

[29] Where an applicant has provided the required statement, the jurisprudence states that non-conformance with section 30(i) of the Act can be found only where there are exceptional circumstances that render an applicant's statement untrue [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. It has previously been held that mere knowledge of the existence of an opponent's trademark does not in and of itself support an allegation that the applicant could not have been satisfied of its

entitlement to use its mark [*Woot, Inc v WootRestaurants Inc Les Restaurants Woot Inc*, 2012 TMOB 197].

[30] Again, as the Opponent did not file any evidence in support of this ground of opposition, nor make any submissions, this ground of opposition is rejected for the Opponent's failure to meet its evidential burden.

Ground of Opposition: Section 12(1)(d)

[31] The Opponent alleges that contrary to section 12(1)(d) of the Act, the Mark is not registrable due to the Opponent's registration for the Logistics Mark. I have exercised my discretion to check the register and confirm that this registration remains extant [see *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.

[32] The material date with respect to confusion with a registered trademark is the date of this decision [*Simmons Ltd v A to Z Comfort Beddings Ltd*, 1991 CarswellNat 1119 (FCA)].

[33] Since the Opponent has discharged its evidentiary burden regarding this ground of opposition, I must assess whether the Applicant has discharged its legal onus to prove, on balance of probabilities, that there is no confusion between the Applicant's Mark and the Logistics Mark.

[34] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in 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 each has 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 in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [see, in general, *Mattel USA Inc v 3894207 Canada Inc*, 2006 SCC 22, and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 (*Masterpiece*)]. Moreover, in *Masterpiece*, the

Supreme Court stated that the degree of resemblance between the trademarks is often likely to have the greatest effect on the confusion analysis.

[35] Finally, section 6(2) of the Act does not concern confusion of the trademarks themselves, but confusion regarding goods or services from one source as being from another source. In this case, the question posed by section 6(2) is whether there would be confusion regarding the services sold under the Mark such that they would be thought to have emanated from the Opponent.

Inherent & acquired distinctiveness

[36] A trademark is not inherently distinctive if it is suggestive of a characteristic of the associated goods or services, whether through descriptive language or laudatory epithets. By contrast, a coined or invented word will possess greater inherent distinctiveness [*Boston Pizza International Inc v Boston Chicken Inc*, 2003 FCA 120 at para 6].

[37] In this case, the Applicant submits that the word “Kerry” has significance as a name, surname, and geographic place name, as set out in the dictionary definitions attached to the Dingman Affidavit. The Applicant submits that none of these categories of words are particularly inherently distinctive.

[38] With respect to the word “logistics”, the Applicant submits that this is different from the Mark and suggestive or descriptive of the Opponent’s services, and therefore does not add inherent distinctiveness to the Logistics Mark. By contrast, the Applicant submits that the word “discovery” has no descriptive or suggestive meaning in association with the Applicant’s services, and that the overall combination of “KERRY DISCOVERY” is unique and striking given the unusual and ungrammatical combination of these elements.

[39] Finally, the Applicant notes that the Opponent’s trademark is a design mark, and that the Opponent’s registered rights relate to that particular stylization and presentation of the term “KERRY LOGISTICS” and not any exclusive right to use the terms “KERRY” or “KERRY LOGISTICS” apart from that design.

[40] Given that “Kerry” is a given name, surname, and geographic place name, I agree with the Applicant that it has a low degree of inherent distinctiveness on its own [see *Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD); *Boutique Jacob Inc v Joseph Limited*, 2015 TMOB 121]. I also agree that while both trademarks include common dictionary words, the word “logistics” in the Opponent’s trademark is suggestive of the Opponent’s services, while “discovery” in the case of the Applicant’s trademark has no such connotation. Finally, I do not find that the design elements of the Logistics Mark add to its inherent distinctiveness, as the design essentially consists of the words being placed one above the other in a stylized font. I therefore find that the Applicant’s Mark possesses a greater degree of inherent distinctiveness than the Opponent’s trademark.

[41] As there is no evidence of use of either trademark that would contribute to the acquired distinctiveness of the trademarks, I find that overall this factor favours the Applicant.

Length of time in use

[42] The Opponent submits that since the Mark is based on proposed use and the Applicant has not filed any evidence to establish that the Mark has become known in Canada, it must be assumed that the Mark has not been used or become known to any extent in Canada in association with the Services. By contrast, the Opponent submits that since its trademark has been registered in Canada since 2016, it can be assumed that there has been some use of the Mark in Canada since that time. Accordingly, the Opponent submits that on balance, this factor weighs in its favour.

[43] The Applicant submits that in the absence of evidence regarding the Logistics Mark, it can only be assumed that there has been *de minimis* use in Canada based on the registration alone. I agree. Further, I note that the Federal Court has cautioned against giving even *de minimis* weight to such dates; moreover, a registration in itself is not evidence that the registered trademark has been used continuously since the claimed date [see *Tokai of Canada v Kingsford Products Company, LLC*, 2018 FC 951;

and *Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)].

[44] Accordingly, this factor favours neither party.

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

[45] When considering sections 6(5)(c) and (d) of the Act, it is the statement of goods and services as defined in the registration relied upon by the Opponent and the statement of Services in the application for the Mark that governs the assessment of the likelihood of confusion under section 12(1)(d) of the Act [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. However, as noted by the Applicant, as each statement must be read with a view to determining the probable type of business intended, evidence of the parties' actual trades is useful, [see *Triangle Tyre Co, Ltd v Gestion André Touchette inc*, 2019 FC 220; *McDonald's Corp v Coffee Hut Stores Ltd*, 1996 CanLII 3963 (FCA); *McDonald's Corp v Silcorp Ltd* (1989), 55 CPR (2d) 207 (FCTD), aff'd (1992), 41 CPR (3d) 67 (FCA)].

[46] The Opponent submits that the services of the Applicant and Opponent are substantially similar. The services registered in association with the Opponent's Logistics Mark include the following:

Retail merchandising and marketing services, namely, advice in the field of business management and marketing; [...] marketing research; [...] sales promotion for others, namely, sales promotions for others by means of website information and public relations campaigns and sales promotions for others by promoting the sale of goods and services through promotional contests and the distribution of related printed and digital material

[47] The Opponent submits that these services are closely related to all of the Applicant's Services and overlap directly with the following services:

Advertising the goods and services of others; developing marketing strategies and marketing concepts for others; market research and market analysis; brand planning and development; compilation of statistics and analysis of market research, data and statistics

[48] I concur with the Opponent that there is direct overlap between these specific applied for services and the Opponent's registered services. In this regard, the applied-for services relating to advertising and marketing clearly overlap with the Opponent's registered services relating to marketing and promotion, notwithstanding the fact that the Opponent's services in Canada do not appear to relate to the food and beverage industry. Accordingly, with respect to the Applicant's advertising and marketing services, I find that this factor favours the Opponent.

[49] The Applicant's remaining services relate to product research and development, and to services either related to or in the field of food and beverage products. Neither category appears to directly overlap with the services listed in the Opponent's registration.

[50] While the Opponent submits that the Opponent's services span various industries including the food and beverage industries, there is no admissible evidence before me to support this contention. As there is nothing in the Opponent's registered services that appears on its face to relate to these industries or to product research and development, I find that this factor favours the Applicant with respect to the following services:

product research and development; research, development and design services relating to food products and beverages; information, advisory, consultancy, and testing services in the field of food and beverage products, food and beverage ingredients, dietary and nutritional supplements, and new product research and design relating thereto;

Degree of resemblance

[51] When considering the degree of resemblance, the law is clear that the trademarks 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. Furthermore, while the first portion of the trademark is usually the most important for the purpose of distinguishing [see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d), 183 (FCTD)], when the first portion of a trademark is fairly non-distinctive, its importance diminishes [see *Vancouver Sushiman Ltd v Sushiboy Foods Co* (2002), 22 CPR (4th) 107

(TMOB)]. Moreover, the Supreme Court of Canada in *Masterpiece* has advised that the preferable approach when comparing trademarks is to begin by determining whether there is an aspect of the trademark that is particularly striking or unique.

[52] The Opponent submits that the most striking or unique part of both trademarks is the first, shared element, KERRY, which militates strongly in favour of a likelihood of confusion. Further, the Opponent submits that “LOGISTICS” is subordinate to the word “KERRY” in its trademark and is suggestive of the Opponent’s services. Similarly, the Opponent submits that there is nothing striking or unique about the word “DISCOVERY” in the Mark as it is also subordinate to “KERRY” and is a weak element because it is a dictionary term with a commonly understood meaning. As such, the Opponent submits that “LOGISTICS” and “DISCOVERY” are each a common dictionary term that imparts no distinctiveness to the trademarks of either party from a visual perspective. Finally, the Opponent submits that due to the shared first element, the trademarks are similar from a phonetic and notional perspective in that the first two syllables are identical aurally and would leave the same impression upon a consumer.

[53] The Applicant submits that resemblance is not to be assessed on a syllable-by-syllable analysis; instead, the proper approach is to identify and compare the dominant elements of the trademarks. As “KERRY” itself possesses low inherent distinctiveness, the Applicant submits that the importance of this shared element is diminished, following *Ferring, Inc v Apotex Technologies, Inc*, 2013 TMOB 225. Instead, the Applicant submits that it is the combined effect of the elements of the Mark that is unique, rather than any individual element, citing *Jacques Vert Group Limited v YM Inc (Sales)*, 2014 FC 1242. As such, the Applicant submits that the overall degree of resemblance between the trademarks is low.

[54] In my view, given that “LOGISTICS” is suggestive of the Opponent’s services, “KERRY” is the most striking feature of the Logistics Mark. However, I agree that it is the combination of the words “KERRY” and “DISCOVERY” in the Applicant’s Mark which give it its distinctiveness.

[55] There is therefore a fair degree of resemblance between the marks in appearance and sound owing to the fact that they both begin with the same first component. The marks are different in idea suggested, however, because the Opponent's mark suggests a logistics company owned or run by a person named KERRY whereas the Mark suggests something found or located by an individual named KERRY.

[56] I therefore only find that this factor favours the Opponent to some extent.

Surrounding Circumstance: Contradictory Prior Testimony

[57] The Applicant submits that the fact that the Opponent took the position that the Mark was not confusing with the Opponent's applied-for KERRY trademark during the examination of that application is a relevant surrounding circumstance which ought to be given weight. It submits that the Registrar and courts have held that an opponent's statements in obtaining its prior registrations can be given weight in assessing confusion where the opponent later takes the opposite position. In support of this position, the Applicant cites *Domtar Inc v Commercial Plastics & Supply Corp* (1990), 30 CPR (3d) 122 (TMOB) (*Domtar*); *McDonald's Corp v Silverwood Industries Ltd* (1989), 24 CPR (3d) 207 (FCTD) (*Silverwood*); *Times Mirror Co v Transcontinental Distribution Inc* (2004), 42 CPR (4th) 1 (TMOB); and *Pharmacia AB v Braintree Laboratories Inc*, 2004 TMOB 5078.

[58] The cases cited by the Applicant establish that although an opponent's prior statements in obtaining its registrations do not "constitute some form of estoppel" [*Domtar, supra* at para 9], they can be given some weight in assessing the issue of confusion [*Silverwood, supra* at para 10]. Accordingly, I am prepared to give these submissions some weight in this confusion analysis; however, I note that I would reach the same conclusion even if I did not do so.

Conclusion

[59] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. In most instances it is the degree of resemblance

between the trademarks that is the most crucial factor in determining the issue of confusion [*Masterpiece; Beverley Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2d) 145 (FCTD) at 149, aff'd 60 CPR (2d) 70]. Here, the resemblance between the marks is primarily a result of the fact that both begin with the non-distinctive word KERRY.

[60] Having considered all of the surrounding circumstances, I conclude that, on a balance of probabilities, the Applicant has not discharged its burden to show that there is not a reasonable likelihood of confusion between the parties' trademarks with respect to the following applied-for services:

Advertising the goods and services of others; developing marketing strategies and marketing concepts for others; market research and market analysis; brand planning and development; compilation of statistics and analysis of market research, data and statistics

[61] I reach this conclusion based on the similarities between the trademarks and the overlap in the parties' services. In this regard, the services noted above are sufficiently similar to services registered in association with the Logistics Mark that the average consumer may believe that they emanate from the same source. Accordingly, this ground of opposition succeeds with respect to those services.

[62] With respect to the remaining services, I find that the differences between the nature of the services and channels of trade shift the balance of probabilities in the Applicant's favour. The Applicant has therefore discharged its burden to show that there is not a reasonable likelihood of confusion between the parties' trademarks with respect to the following applied-for services:

product research and development; research, development and design services relating to food products and beverages; information, advisory, consultancy, and testing services in the field of food and beverage products, food and beverage ingredients, dietary and nutritional supplements, and new product research and design relating thereto.

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

Ground of Opposition: Section 16(3)

[64] The Opponent alleges that contrary to section 16(3), the Applicant is not the person entitled to registration of the Mark in association with the Services, as of the date of filing of the application and at all times thereafter, the Mark was confusing with the Opponent's Marks, which had previously been used and made known in Canada in association with the Opponent's services.

[65] In order to meet its initial burden under a ground of opposition based on section 16(3) of the Act, the Opponent must show that the trademarks alleged in support of this ground of opposition was used or made known prior to the priority filing date of February 16, 2015, and were not abandoned at the date of advertisement of that application (November 2, 2016) (section 16(5) of the Act). As the Opponent has not furnished any evidence demonstrating that the Opponent's Marks were used or made known in Canada prior to the material date, the Opponent has not met its initial burden with respect to this ground.

[66] Accordingly, this ground is dismissed.

Ground of Opposition: Section 2

[67] The Opponent has also pleaded that contrary to section 2 of the Act, the Mark does not actually serve to distinguish and is not adapted to distinguish the Applicant's Services from the services associated with the Opponent's Marks.

[68] The material date for a ground of opposition based on non-distinctiveness is the filing date of the opposition (December 19, 2016) [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185 at para 25].

[69] There is an initial burden on the Opponent to establish that, as of the material date, the Opponent's Marks were known to a sufficient extent that could negate the distinctiveness of the applied-for Mark [see *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657]. As the Opponent has filed no evidence demonstrating the extent to which the Opponent's Marks have become known in Canada at the material date, the Opponent has not met its initial burden with respect to this ground.

[70] Accordingly, this ground is dismissed.

DISPOSITION

[71] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to the following services:

Advertising the goods and services of others; developing marketing strategies and marketing concepts for others; market research and market analysis; brand planning and development; compilation of statistics and analysis of market research, data and statistics

[72] I reject the opposition with respect to the remainder of the Services pursuant to section 38(12) of the Act.

[73] The amended application will be as follows:

product research and development; research, development and design services relating to food products and beverages; information, advisory, consultancy, and testing services in the field of food and beverage products, food and beverage ingredients, dietary and nutritional supplements, and new product research and design relating thereto

Cindy R. Folz
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-02-21

APPEARANCES

For the Opponent: No one appearing

For the Applicant: James Green

AGENTS OF RECORD

For the Opponent: Marks & Clerk

For the Applicant: Gowling WLG (Canada) LLP

SCHEDULE A

KERRY LOGISTICS Design, Registration No. TMA958,144



SERVICES

(1) Agencies for contract relating to transportation, namely, air charter services and aircraft chartering; Messages or merchandise courier services, namely, courier services for messages and merchandise; computerised distribution planning relating to transportation, namely, computerized cargo management, provision of data relating to methods of products transportation; delivery of goods, namely, delivery of goods by air, sea carriers, mail order, train, truck; delivery of goods by mail order; freight forwarding; freight brokerage; air transport, namely, air transportation of goods; boat transport, namely, barge transport and cargo ship transport; railway transport, namely, freight transportation by train; road transport, namely, freight transportation by truck; providing transportation and storage warehousing information via global computer networks, namely, providing administrative and logistical information in the field of transportation and storage warehousing via global computer networks and providing information on transportation supply chains, transportation systems and issues in transportation via global computer networks; packaging and storage of goods, namely, packaging of articles for transportation and warehouse storage services; transport reservation, namely, reservation and booking of transportation of goods by air, rail, truck, and sea carriers; rental of storage containers; storage information, namely, storage information about products provided via website; transportation information, namely, providing information in the fields of transportation supply chains, transportation systems and issues in transportation; vehicle rental; warehousing; wrapping of goods, namely, gift wrapping of goods for others for delivery to customers; in-store transport, namely, dispatch and loading of goods and for inventory management and logistics; placing goods on shelves in-store, namely, inventory stocking services; advisory, information and consultancy services in the fields of all of the foregoing; location of freight-cars by computer, namely, tracking and tracing of packages in transit and tracking and tracing of freight cars in transit; warehouse management services.

(2) Retail merchandising and marketing services, namely, advice in the field of business management and marketing; market price monitoring for others, namely, market price monitoring for third party logistics, freight services, warehouse operations and supply chain solutions; compilation of information into computer databases, namely, management and compilation of computerised databases; accounting; drawing of statements of accounts; business management assistance; professional business consultancy, namely, business administration consultancy, business management consultancy services, and business management consultancy in the field of transport and delivery, logistics, freight services warehouse operations and supply chain solutions; business information, namely, providing business information in the field of transport and delivery, logistics, freight services warehouse operations and supply chain solutions; business management and organization consultancy; cost price analysis; computerised

compilation of order lists; distribution of samples; efficiency experts, namely, efficiency expert services in the field of transport and delivery, logistics, freight services warehouse operations and supply chain solutions; import-export agencies; marketing research; public relations; commercial or industrial management assistance, namely, management assistance for commercial or industrial businesses in the field of transport and delivery, logistics, freight services warehouse operations and supply chain solutions; inventory management, namely, inventory management in the field of transport and delivery, logistics, freight services warehouse operations and supply chain solutions; order processing, namely, administrative processing of purchase orders and order fulfillment services; the bringing together of the goods of others and compiling the goods in a general merchandise catalogue enabling customers to conveniently view and purchase these goods by mail order, by means of telecommunications, namely via the Internet, and through a discount store, the foregoing service being for the benefit of others; warehouse management services; sales promotion for others, namely, sales promotions for others by means of website information and public relations campaigns and sales promotions for others by promoting the sale of goods and services through promotional contests and the distribution of related printed and digital material; business management relating to logistics services; advisory, information and consultancy services in the fields of all of the foregoing