



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 111

Date of Decision: 2023-06-30

IN THE MATTER OF AN OPPOSITION

Opponent: Sun-Maid Growers of California

Applicant: Long Sun Brewing Co., Ltd.

Application: 1,916,859 for SUNMAI & Design

OVERVIEW

[1] Long Sun Brewing Co. Ltd. (the Applicant) has applied to register the trademark SUNMAI & Design (the Mark), shown below, with various beverages including beer and fruit juices (set out in the attached Schedule A) based on the Applicant's proposed use. The application was filed on August 27, 2018, and was advertised in the *Trademarks Journal* issue dated July 7, 2021.



[2] Sun-Maid Growers of California (the Opponent) alleges that the Mark is confusing with its family of SUN-MAID trademarks, extensively used in Canada and registered around the world in association with a vast array of foods, food ingredients and/or beverages, including fruit-based products and products composed in whole or in part of fruit, all for human consumption.

[3] For the reasons that follow, I refuse the application.

BACKGROUND


[4] The Opponent opposed the application for the Mark pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 as amended June 17, 2019 (the Act), on the basis of the grounds of opposition summarized below:

[5] The application was filed in bad faith contrary to section 38(2)(a.1) of the Act because the Applicant and/or its predecessors in title was or ought to have been fully aware of the SUN-MAID trademark, registrations and trade name. This represents a deliberate and bad faith attempt to take advantage of the reputation developed by Sun-Maid Growers in its SUN-MAID Trademark, SUN-MAID Registrations and Sun-Maid Trade Name, and to deceive consumers into the mistaken belief that the Applicant's Goods are those of Sun-Maid Growers, or are in some way related to, associated with, or endorsed by Sun-Maid Growers, which is not the case. Any use of the Mark by the Applicant would be contrary to Sections 7, 19, 20 and 22 of the Act. In these circumstances, the Application was filed in bad faith, contrary to section 38(2)(a.1).

[6] The Mark is not registrable pursuant to section 12(1)(d) of the Act as it is confusing with at least one of the Opponent's registered trademarks (the SUN-MAID trademarks), set out below:

TRADEMARK	REGISTRATION NO.	Goods/Services

SUN-MAID	TMDA46738	<p>(1) Substances used as foods and ingredients in food, namely raisins, raisin paste, dried fruits, preserved fruits, raisin syrup, bread and juice concentrate. (2) Dried fruits. (3) Non alcoholic, maltless, carbonated beverages sold as soft drinks. (4) Table sirup. (5) Fresh grapes. (6) Raisin bread. (7) Raisins, raisin syrup, raisin bread, raisin jam, raisin jelly, salad oil containing raisin oil, packaged pie fruit containing raisins, and mincemeat containing raisins. (8) Wine. (9) Raisins, chopped raisins, raisin paste; dried fruits, preserved fruits, mincemeat, fruit filling for pies; jam, jelly; processed nuts, grains, seeds, beans, chocolate covered raisins, sugar coated raisins, candy, candy filler of mixed processed fruits and nuts; raisin syrup; processed cereals; bread; carob, fresh fruits, unshelled nuts, grains, edible seeds, raw soybeans, fruit juices, soft drinks (non-alcoholic), syrup for making soft drinks and fruit</p>
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		drinks, juice concentrates, wines, brandy.
SUN-MAID	TMA615730	(1) Non-carbonated fruit juices and non-alcoholic non-carbonated fruit drinks. (2) Cookies.
SUN-MAID	TMDA21563	(1) Raisins
	TMA886841	(1) Raisins. (2) Fruit paste, raisin paste, dried fruits, mixed dried fruits, and snack mixes consisting primarily of dried fruits, syrup made from fruit, bread, and fruit juice concentrates for food purposes. (3) Yogurt covered fruit.

[7] The Applicant is not the person entitled to register the Mark in view of section 16(1)(a) of the Act since the Mark was confusing with at least one of the Opponent's SUN-MAID trademarks which had been previously used and/or made known in Canada by Sun-Maid Growers in association with the SUN-MAID goods.

[8] The Applicant is not the person entitled to register the Mark in view of section 16(1)(c) of the Act since the Mark was confusing with the Opponent's SUN-MAID trade name which had been previously and continuously used in Canada in association with the SUN-MAID goods.

[9] The Mark is not distinctive as it could not distinguish and is not adapted to distinguish the applied-for Goods from the prior use and/or making known of the SUN-MAID Trademark, Sun-Maid Trade Name, and SUN-MAID Registrations in association with the SUN-MAID goods.

[10] The Application contravenes section 38(2)(e) of the Act because, as of the filing date, the Applicant was not using and did not propose to use the Mark in Canada in association with the Applicant's Goods specified in the Application, contrary to the allegation of proposed use made in the Application.

[11] The Application contravenes section 38(2)(f) of the Act, because, as of the filing date, the Applicant was not entitled to use the Mark in Canada in association with the Applicant's Goods, because: (i) the Mark was confusing with the SUN-MAID Registrations and the trademarks that correspond with those Registrations; (ii) the Mark was confusing with the SUN-MAID Trademark and Sun-Maid Trade Name, which were both previously used and/or made known in Canada by Sun-Maid Growers in association with the SUN-MAID goods; and (iii) use of the Mark was/is likely to dilute, tarnish, or otherwise depreciate the goodwill attached to the SUN-MAID Registrations and corresponding trademarks. Any use of the Mark by the Applicant would be contrary to Sections 7, 19, 20 and 22 of the Act.

[12] The Opponent filed as it evidence the affidavit of Chris Rosander, Director of International Market Development of Sun-Maid Growers of California. The Applicant elected not to file any evidence.

[13] Only the Opponent filed written representations and an oral hearing was not held.

EVIDENTIAL BURDEN AND LEGAL ONUS

[14] While there is an initial evidentiary burden on an opponent; the legal burden or onus remains on the applicant, on a balance of probabilities [*John Labatt Ltd v Molson Co*, [1990] FCJ No 533, aff'd [1992] FCJ No 525 (FCA)].

ANALYSIS OF THE GROUNDS OF OPPOSITION

[15] I will now consider the grounds of opposition beginning with the section 12(1)(d) ground of opposition.

Section 12(1)(d) Ground of Opposition

[16] The material date for 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 Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[17] The Opponent has pleaded that the Mark is not registrable because it is confusing with the Opponent's registered SUN-MAID trademarks set out above, all of which are in good standing. The Opponent has therefore met its burden under this ground.

[18] I now have to determine, on a balance of probabilities, if there is a reasonable likelihood of confusion with one or more of the Opponent's registered trademarks.

[19] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated 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 or leased by the same person, whether or not the goods and services are of the same general class or Nice Class. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5).

[20] The criteria in section 6(5) 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, [2006] 1 SCR 772 at para 54; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401].

[21] 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]. Also, where it is likely the public will assume an applicant's goods are approved, licensed, or sponsored by the opponent so that a state of doubt and uncertainty exists in the minds of the purchasing public, it follows that the trademarks are confusing [see *Glen-Warren Productions Ltd v Gertex Hosiery Ltd* (1990), 29 CPR (3d) 7 (FCTD) at para 21].

Analysis of the Section 6(5) Factors

[22] I will first consider the inherent distinctiveness of the trademarks and the degree of resemblance between them before moving on to the remaining section 6(5) factors and other surrounding circumstances.

Inherent Distinctiveness and Extent Known

[23] I consider the Mark to be inherently stronger than each of the Opponent's trademarks. In this regard, the word SUNMAI is a coined word that has no meaning in association with the applied for Goods. The Opponent's evidence, on the other hand, shows that the slogan "made in the sun" was adapted to "Sun Maid" [Rosander, para. 6]. The Opponent itself admits that its SUN-MAID & Girl Design trademark is a clever play on words, suggesting the image of a pretty "maid" gathering the harvest [Rosander, paras. 6 & 18]. The Opponent's trademarks therefore each appear to be suggestive of a character or quality of the Opponent's goods or a condition of their production.

[24] Regarding the extent known of the parties' trademarks, it has been well established that the strength of a trademark may be increased by means of it becoming known through promotion or use.

[25] In this case, there is no evidence that the Mark has been used in Canada or that it has become known to any extent whatsoever in Canada.

[26] In contrast, the Opponent submits that its trademarks have been used and become known to a significant extent in Canada. In this regard, in addition to the

evidence setting out a timeline of selected events beginning in 1916 when the SUN MAID trademark was first developed, up until 2018 and the development of SUN-MAID croissants, the Opponent notes the following points in the Rosander affidavit illustrating the renown of the SUN-MAID Brand:

- Canadian sales of SUN-MAID branded food and ingredient products ranging between \$7,600,000 and \$10,700,000 US between 2018 and 2021 [para. 70];
- In excess of \$1,400,000 and \$2,800,000 U.S. spent between 2018 and 2021 to promote the sale of SUN-MAID branded food and ingredient products marketed to retail and industrial consumers [para. 60];
- Examples of the channels the Opponent markets its brand in including:
 - Television advertising [paras. 52-54];
 - A website targeting Canadian consumers (www.sunmaid.ca), which the Opponent has operated since at least 2006 [para. 55, Exhibit R];
 - Distribution in Canada of a book celebrating Sun-Maid's 100th anniversary [paras. 16-17, Exhibits D, E];
 - Canadian grocery store flyers, excerpts of which are provided below [para. 58, Exhibit V (pp. 11, 23, 32)]: Longo's (2017) 16 Sharpe's Food Market (Ontario 2021) Harry's Fine Foods (Manitoba 2021);
 - Third-party recognition - The Opponent and its SUN-MAID Brand are often referenced or featured in third-party sources, including Canadian newspapers such as the *Toronto Star*, *the National Post*, and *the Globe and Mail* [paras. 61-63, 65-67; Exhibits W, X].

It is clear from this evidence that the Opponent's SUN-MAID trademarks have been significantly used and become well known in Canada, mostly in association with raisins.

[27] In view of the above, I do not find that this factor favours either party. In this regard, while the Mark is more inherently distinctive, the evidence shows that the Opponent's trademarks have become known to a much greater extent in Canada.

Length of Time in Use

[28] The Opponent's SUN-MAID trademarks have been used in Canada for many years, whereas the Applicant has not shown any use Mark. This factor therefore favours the Opponent.

Nature of Goods and Channels of Trade

[29] When considering sections 6(5)(c) and (d) of the Act, it is the statement of goods as defined in the registrations relied upon by the Opponent and the statement of goods 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, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[30] The Applicant's Goods include beer and other beverages related to beer as well as non-alcoholic beverages including fruit beverages and juices.

[31] The Opponent's goods comprise a variety of food and beverage products, including raisins, dried fruits and fruit juices. The Opponent submits that there is either direct overlap, or a close relationship, between every one of the Applicant's Goods and those of the Opponent.

[32] Beginning with the Applicant's non-alcoholic beverages, the Opponent submits that there is either a direct or indirect overlap between these goods and the following goods of the Opponent:

SUN-MAID (TMDA46738) - Non alcoholic, maltless, carbonated beverages sold as soft drinks; fruit juices, soft drinks (non-alcoholic), syrup for making soft drinks and fruit drinks, juice concentrates.

SUN-MAID (TMA615730) - Non-carbonated fruit juices and non-alcoholic non-carbonated fruit drinks

[33] The Opponent has also shown that some of its beverage products (e.g., SUN-MAID branded fruit juices and fruit drinks) have been sold on the Canadian market [Rosander, para. 34].

[34] I agree with the Opponent that there is overlap between these goods. Further, in the absence of evidence to the contrary, I can assume that the channels of trade for these goods would also overlap.

[35] The Opponent then submits that the Applicant's beer related goods are related to the wines and brandy, registered in association with the Opponent's SUN-MAID trademark, registration No. TMDA46738. Further, relying on the decision in *Molson Cos v Gustav Adolf Schmitt'sches Weingut* (1991), 35 CPR (3d) 371 (TMOB), the Opponent submits that both brewed alcoholic beverages and wines are products of the alcohol industry and might well be sold through the same establishments or retail outlets.

[36] Indeed, the Opponent has shown that producing non-alcoholic and alcoholic beverages is not outside the scope of the Opponent's field of trade, as the Opponent has produced or licensed the production of both and provided examples of labels for such products [Rosander, para. 35; Exhibit R]. Further, the Opponent currently operates a distillery in the U.S. that produces high-proof alcohol which the Opponent's industrial consumers use to make brandy and wine [Rosander, para. 42].

[37] The Opponent has also shown that it may produce (or license the production of) the same goods as those applied for. In addition to providing evidence that some beers in Canada and the U.S. are produced using raisins [Rosander, paras. 37-39, Exhibits M, N], the Opponent's evidence of the Applicant's website at *SUNMAI.com*, which provides a link to a SUNMAI branded Facebook account, prominently displays the following ad for SUNMAI branded "grape beer" [paras. 40-41, Exhibit O]:



[38] I acknowledge that this evidence from the Applicant's website is hearsay. However, in this case I find this evidence admissible since it was necessary for the Opponent to file it in support of its opposition and reliable since the Applicant, being a party, had the opportunity to refute the evidence [*Reliant Web Hostings Inc v Tensing Holding BV*, 2012 TMOB 48 at para 35]. I also consider this evidence to be relevant insofar as it shows how the Applicant has been using its Mark with fruit flavoured beer in other countries.

[39] While the Opponent's evidence does not show any use of any of its trademarks in association with alcoholic beverages in Canada, as noted above, it is the statement of goods as defined in the registrations relied upon by the Opponent and the statement of goods in the application for the Mark that governs the assessment of the likelihood of confusion under section 12(1)(d) of the Act. As the Opponent's SUN-MAID trademark, registered under No. TMDA46738, is registered in association with, wine and brandy, among other things, I find that there is overlap between these products and the beer

related products of the Applicant. I also find from the Opponent's evidence as a whole that the Applicant's Goods could be considered a natural extension of the Opponent's business [*Emilio Pucci International BV v El Corte Ingles, S.A.*, 2011 TMOB 31]. Accordingly I consider this factor to be a further surrounding circumstance that favours the Opponent.

Degree of Resemblance

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

[41] There is a fair resemblance between the trademarks at issue in sound as the Mark consists of the word SUNMAI which only differs from the Opponent's SUN-MAID trademark by a hyphen found in the middle of the Opponent's trademarks and the final letter D. The resemblance is less with respect to appearance, as the Opponent's SUN-MAID trademarks are each comprised of the words SUN and MAID, separated by a hyphen, one of which includes the design of a woman wearing a bonnet, while the Mark is the coined word SUNMAI with a rectangular design. Similarly the degree of resemblance with respect to idea suggested is also limited since the Mark has no obvious meaning whereas the Opponent's trademarks, as noted above, clearly emphasize the words SUN and MAID, which can mean "made by the sun" or also connote the idea of the "maid" in the garden gathering the harvest of grapes. The idea suggested by the Opponent's trademarks is also emphasized throughout its marketing materials as shown in the affidavit of Mr. Rosander [Rosander, para. 18].

Surrounding Circumstances

Are Beer and Raisins Commonly Consumed Together?

[42] The Opponent also submits that the fact that raisins and beer can be consumed together encourages consumers to perceive a relationship between them, which

increases the likelihood of confusion in the present case. In this regard, the Opponent notes the following evidence from the Rosander Affidavit:

- The Opponent's raisins are marketed and purchased as snack foods [para. 24, Exhibit G];
- Raisin snacks and beer pair naturally. For example, a third-party gift basket on the market in Canada pairs beer and chocolate-covered raisins [paras. 25-28, Exhibits H-K];
- In Canada, SUN-MAID branded raisins are sometimes sold in combination with other snack products commonly consumed with beer, such as pretzels [para. 24, Exhibit G];
- Beer and raisins can also be used together in recipes, such as a recipe from Penguin Random House Canada that involves creating a "beer-raisin glaze" [para. 29, Exhibit L].

[43] While I agree that the Opponent's evidence shows that its raisins are marketed and purchased as snack foods, and that certain snack products are often consumed with beer, I do not find the evidence sufficient to show that beer and raisins are commonly consumed together. In this regard, gift baskets often include a wide variety of items that are not generally designed to be consumed together at the same time (e.g., beer and chocolate). Further, the fact that the Opponent's raisins are sometimes *sold* in combination with other snack products (like pretzels) is not sufficient, in my view, to show that beer and raisins are commonly *served* together (as was the case in *Cheung's Bakery Products Ltd v Saint Honore Cake Shop Ltd*, 2011 TMOB 94 at paras 114, 128-129, where the parties' goods were coffee and baked goods). Finally, in my view, the fact that beer and raisins appear together as ingredients in several recipes does not persuade me that the nature of these particular goods overlap. In considering this issue I had regard to the following comments in *Tritap Food Broker v Billy Bob's Jerky Inc*, 2012 TMOB 40:

Even if I had accepted the recipes as admissible, it would not have persuaded me that the nature of the parties' wares overlaps since all it shows is that a few such recipes exist. This evidence does not prove nor result in the inference that consumers understand beef jerky, rice and ketchup to be of a similar nature.

[44] Similarly, in this case, I do not find that the existence of a few recipes which use both raisins and beer as ingredients results in the inference that consumers understand raisins and beer to be related. This factor therefore does not assist the Opponent.

Conclusion

[45] As noted above, the onus is not on the Opponent to show that confusion is likely but rather on the Applicant to satisfy the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion. The presence of a legal onus on the applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, then the issue must be decided against the applicant.

[46] Having considered all the surrounding circumstances, I find that, at best for the Applicant, the probabilities are evenly balanced between a finding of confusion with the trademark SUNMAI & Design and a finding of no confusion. I reach this conclusion owing primarily to the importance of the degree of resemblance between the parties' trademarks, the extensive acquired distinctiveness of the Opponent's trademarks, and the overlap or potential for overlap between the parties' goods.

[47] As the Applicant has failed to demonstrate, on a balance of probabilities, that an average consumer seeing the Mark in association with the Applicant's Goods, would not, as a matter of first impression, infer that those Goods are sold or otherwise emanate from or are licensed, approved or sponsored by the Opponent, the section 12(1)(d) ground of opposition is successful.

Section 16(1)(a) Ground of Opposition

[48] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark since at the filing date of the application or the date of first use of the Mark, whichever is earlier, the Mark was confusing with the Opponent's SUN-

MAID trademarks, previously used and/or made known in Canada in association with the SUN-MAID goods.

[49] As the Applicant has not filed any evidence of use, the material date for this ground is the filing date of the application. The Opponent has met its initial evidential burden through its evidence demonstrating the use and making known of its SUN-MAID trademarks since prior to this date.

[50] In my view, the earlier material date for this ground of opposition does not alter to any meaningful degree the confusion analysis for the section 12(1)(d) ground of opposition set out above. Accordingly, 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(1)(a) ground of opposition is also successful.

Remaining Grounds of Opposition

[51] As the Opponent has already succeeded under two grounds of opposition, it is not necessary to address the remaining grounds of opposition.

DISPOSITION

[52] 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.

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

SCHEDULE A

Application No. 1916859 – SUNMAI & Design

Goods (Nice Class and Statement)

32 (1) Beer, namely ale, lager, stout, porter and shandy beer; malt beer; ginger beer; beer-based cocktails; malt wort for making beer; extracts of hops for making beer; malt wort; low-alcohol beer; alcohol-free beers; non-alcoholic beer-flavoured beverages; non-alcoholic honey-based beverages; fruit beverages and juices; fruit-flavoured beverages; soda water; carbonated mineral water; flavoured mineral water (the Goods).

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Opponent: GOWLING WLG

For the Applicant: BENOÎT & CÔTÉ INC.