



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 209

Date of Decision: 2023-12-08

IN THE MATTER OF AN OPPOSITION

Opponent: Loblaws Inc.

Applicant: Snowcrest Foods Ltd.

Application: 1,878,342 for PERFECTLY IMPERFECT

INTRODUCTION

[1] Snowcrest Foods Ltd. (the Applicant) has applied to register the trademark PERFECTLY IMPERFECT (the Mark) relying on the basis of proposed use in Canada and covering the goods:

(1) Frozen fruits; fruit purees; fruit jams; fruit jellies; fruit fillings; fruit and fruit-based pie fillings; fruit preserves; fruit and fruit-based sauces; fruit and fruit-based spreads; fruit toppings and fruit-based yogurt chips; frozen vegetables; vegetable purees; vegetable fillings; vegetable and vegetable-based pie fillings; vegetable preserves; vegetable and vegetable-based sauces; vegetable and vegetable-based spreads; yogurt products; yogurt chips; frozen yogurt used for baking, cooking and blending; yogurt-covered fruit.

(2) Fresh fruits; fresh vegetables; fresh sliced fruits and fresh sliced vegetables.

(3) Fruit juices; vegetable juices.

[2] Loblaws Inc. (the Opponent) opposes the registration of the Mark. The opposition is based on the allegation that the Mark is confusing with the Opponent's trademarks, including registration No. TMA947,945 for the trademark NATURALLY IMPERFECT NATURELLEMENT IMPARFAITS & Design (Registered Trademark) shown below:



[3] The goods covered by the Opponent's registration are fresh fruit and vegetables. Additionally, the Opponent relies on common law rights associated with its trademarks NATURALLY IMPERFECT and NATURELLEMENT IMPARFAITS used in association with various fruits and vegetable products.

THE RECORD

[4] The application was filed on January 19, 2018, and advertised for opposition purposes in the *Trademarks Journal* dated June 12, 2019. The Opponent opposed the application pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act), on January 2, 2020. The Act was amended on June 17, 2019. All references herein are to the Act as amended, with the exception of references to the grounds of opposition, which refer to the Act before it was amended (see section 70 of the Act which provides that section 38(2) of the Act, as it read prior to June 17, 2019, applies to applications advertised before that date).

[5] In its written representations, the Opponent advised that it was no longer pursuing the section 38(2)(a) and 30(e) ground of opposition alleging the Applicant did not intend to use the Mark in association with the Goods. The remaining grounds of opposition are summarized below:

- non-registrability under sections 38(2)(b) and 12(1)(d) – the Mark is confusing with the Opponent's Registered Trademark

- non-entitlement under sections 38(2)(c) and 16(3)(a) – the Mark is confusing with the Opponent’s alleged family of trademarks (namely, the Registered Trademark and the common law NATURALLY IMPERFECT trademarks)
- non-distinctiveness under sections 38(2)(d) and 2 – the Mark is not distinctive as it does not distinguish the Goods from those of the Opponent or others and is not adapted to so distinguish

[6] On April 29, 2020, the Applicant filed and served its counter statement denying each of the grounds of opposition. Both parties filed evidence, relevant portions of which are discussed below. Both parties also filed written representations and attended a hearing.

OPPONENT’S EVIDENCE

[7] In support of its opposition, the Opponent relies on the affidavits of Ms. Biserka Horvat, a law clerk with the Applicant’s previous agents of record, and Ms. Kathlyne Ross, the Vice President of Product Development with the Opponent.

Horvat Affidavit

[8] Ms. Horvat’s affidavit includes:

- search results taken from the Canadian Intellectual Property Office trademark database of registered trademarks containing the word “imperfect”, including the Opponent’s Registered Trademark [Exhibit 2]
- a copy of the contents of a portion of the Real Canadian Superstore’s website relating to frozen bakery goods and fruit [Exhibit 3]

Ross Affidavit

[9] The Ross affidavit includes:

- statements regarding use of the common law marks NATURALLY IMPERFECT and NATURELLEMENT IMPARFAITS since “well before January 19, 2018” in association with food products, including fruit and vegetable products [para 8]

- a statement that the Opponent's Registered Trademark and common law trademarks will be grouped together for the purposes of the affidavit [para 9]
- a claim to continuous use of one or more of the Opponent's Registered Trademark and common law trademarks since at least as early as March 2015 in association with goods that include frozen blueberries, frozen strawberries, frozen fruit blend, frozen mixed berries, frozen mango, apples, pears, lemons, limes, onions, carrots, mushrooms, potatoes, cucumbers, peppers and sweet potatoes [paras 10 and 11]
- representative images of a sampling of product labels for the Opponent's fruit and vegetables showing the Registered Trademark [para 12]
- product labelling showing a slightly different stylization of the Registered Trademark, with the French and English on two, rather than three, lines [Exhibits 2]
- the two common law trademarks NATURELLEMENT IMPARFAITS and NATURALLY IMPERFECT appearing alone [Exhibit 2]
- statements that the Opponent's fruit and vegetables, bearing one or more of the Opponent's trademarks, are sold through a variety of distributors, including Loblaws, No Frills, Real Canadian Superstore, Zehrs, Atlantic Superstore and Dominion, having more than 2400 stores across Canada, and are also sold on-line [paras 13 to 17]
- webpages showing the Opponent's PC Express platform through which its goods are sold [Exhibit 3]
- sales figures for goods bearing the Opponent's trademarks ranging from more than eight million dollars in 2015 to more than 100 million dollars in 2020 and in total exceeding 350 million dollars [para 18]
- representative samples of advertising from 2015 and 2016 featuring the Opponent's Trademarks [Exhibit 4]
- screen captures of websites displaying the Opponent's Registered Trademark and common law trademarks dated April 2017, October 2018

and November 2020, along with numbers of visits to the website in April 2017 [Exhibits 5 to 7]

- samples, as well as distribution information, regarding flyers ranging in date from 2017 to 2020 but stated to be representative of those since 2015 and of current flyers [para 24 and Exhibits 8 to 15]
- a sampling of representative third-party publications, including *The Star* and *The Globe and Mail*, featuring or mentioning the Opponents trademarks and ranging in date from March 2015 to June 2020 [para 27 and Exhibit 16]

[10] Cross-examination orders were sought and granted for the Opponent's two affiants, but cross-examination transcripts were not filed.

APPLICANT'S EVIDENCE

Gordon Affidavit

[11] In support of its application, the Applicant relies on the affidavit of Ms. P. Claire Gordon, a law clerk with the Applicant's trademark agents of record. This evidence comprises dictionary definitions of "imperfect" and "perfectly" as well as copies of various websites pertaining to "imperfect" food products.

[12] Ms. Gordon was cross-examined, and the associated transcript was made of record. When questioned, Ms. Gordon confirmed she did not know how many Canadians visited the websites she evidenced [Gordon transcript, for example questions 43 to 46 and 67].

EVIDENTIAL BURDEN AND LEGAL ONUS

[13] There is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist. It is only after this burden is met that the Applicant then bears the legal onus of establishing on a balance of probabilities that the Application complies with the requirements of the Act. If a determinate conclusion cannot be reached in favour of the Applicant after all evidence is considered, then the

issue must be decided against it [*Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); and *John Labatt Ltd v Molson Companies Ltd*, 1990 CanLII 11059, 30 CPR (3d) 293 (FCTD)].

Analysis

Registrability Ground

[14] The material date applicable to the registrability 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)].

[15] The Opponent pleads that the Mark is not registrable in that, contrary to section 12(1)(d) of the Act, it is confusing with the Opponent's Registered Trademark. I have exercised my discretion to check the Register and confirm this registration remains extant [*Quaker Oats Co of Canada Ltd v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent has therefore met its initial evidential burden. Consequently, the Applicant must prove on a balance of probabilities that there is no reasonable likelihood of confusion between the Mark and the Opponent's Registered Trademark.

Are the Trademarks Confusing?

[16] The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion, the Registrar must have regard to all 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 including in appearance, sound or ideas suggested by them. These enumerated factors need not be accorded equal weight [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22; *Veuve Cliquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 (*Masterpiece*)].

Inherent Distinctiveness and Extent to Which the Trademarks Have Become Known

[17] Inherent distinctiveness refers to the originality of a trademark. Trademarks comprising trade vocabulary that is descriptive or suggestive of the associated goods or services possess a limited degree of inherent distinctiveness and are therefore entitled to a narrower ambit of protection. Owners of such marks are expected to accept the inevitable risk of confusion thereby limiting any wholesale appropriation of apt trade language [*Molson Cos v John Labatt Ltd*, 1994 178 NR 20 at paras 5 and 6 (FCA); *Venngo Inc v Concierge Connection Inc* 2017 FCA 96 at para 46; *Prince Edward Island Mutual Insurance Co v Insurance Co of Prince Edward Island* (1999), 86 CPR (3d) 342 (FCTD) at para 34; and *General Motors Corp v Bellows*, [1949] SCR 678, paras 28 and 29].

[18] The Opponent argues that the most prominent feature of its Registered Trademark is the juxtaposition of the terms “naturally” and “imperfect” or their French equivalents. In addition, it argues that this combination of ordinary dictionary words creates a unique commercial impression that is cleverly suggestive of the goods with which it is associated. It submits the Registered Trademark is therefore entitled to a broad scope of protection [Opponent’s written representations, para 54].

[19] The term “naturally” means “by natural character” or in other words “inherently”, while the term “imperfect” means “not perfect” [Gordon affidavit, Exhibits B and F]. Considered together, I find that the words describe that the Opponent’s fresh fruits and vegetables are, by their natural or inherent character, not perfect. I agree with the Applicant’s submission in respect of this issue. I find the combination of words flows logically and describes a particular character or quality of the Opponent’s fresh fruit and vegetables [Applicant’s written submissions, para 39 and 60]. Furthermore, there is nothing particularly unique or creative about this combination of terms. As such, I find the Opponent’s Registered Trademark has a low degree of inherent distinctiveness, entitling it to a limited scope of protection.

[20] The Applicant submits, on the other hand, that its Mark contains “contradictory language”, since “perfectly” describes something as “so as to be perfect” which is

juxtaposed against the term “imperfect,” which follows. Since “Imperfect” means not perfect, the term “perfectly imperfect” is an oxymoron [Applicant’s written representations, para 38 and 58]. I agree that the contradictory, yet somehow accurate, meaning of the combined terms lends distinctiveness to the Mark. The repetition of “perfect” in the combination of “perfectly” and “imperfect” also adds to the unique character of the Mark. I find the Mark is therefore more inherently distinctive than the Opponent’s Registered Trademark.

Extent Known and Length of Time in Use

[21] Distinctiveness and strength of a trademark may be enhanced through use, as well as through activities such as advertising and promotion in Canada [*Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD); and *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD)].

[22] Ms. Ross has deposed that the Opponent has enjoyed significant sales since the products were launched in 2015. Ms. Ross also attests to considerable advertising and promotion, for example, through the display of the Registered Trademark on websites visited by a substantial number of Canadians, or through appearance of the Registered Trademark in flyers distributed throughout Canada.

[23] Considering Ms. Ross’s evidence in its entirety, I find that owing to substantial product sales of fresh fruit and vegetables bearing the Registered Mark since 2015, along with the extent of advertising and promotion, this trademark has acquired reputation and become known to some extent throughout Canada. The Applicant, on the other hand, has not evidenced use, advertising or promotion of the Mark in Canada. On balance, while the inherent distinctiveness factor favours the Applicant, I find these latter factors favour the Opponent.

Nature of the Goods, Services or Business

[24] When considering the nature of the goods, services or businesses in respect of a registrability ground of opposition, it is the statements of goods and services listed in the Application and the Opponent’s registration that govern the analysis [*Mr Submarine Ltd*

v Amandista Investments Ltd (1987), 19 CPR (3d) 3 (FCA) and *Miss Universe Inc. v Bohna* (1994), 58 CPR (3d) 381 (FCA)]. The parties' respective statements of goods must however 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 [*McDonald's Corp v Coffee Hut Stores Ltd* (1994), 55 CPR (3d) 463 (FCTD), aff'd 68 CPR (3d) 168 (FCA) and *Mövenpick Holding AG v Exxon Mobil Corp*, 2013 FCA 6 at paras 6 and 7]. Furthermore, the assessment as to likelihood of confusion is not done in a vacuum, rather the manner in which the trademarks are used in the course of business must be examined [see *McDonald's* supra].

[25] The Opponent argues at paragraph 62, and following, of its written representations, that the goods of the parties are "nearly identical" and that, in any case, goods need not be identical provided there is a connection in their nature. The Opponent categorizes the goods which are not fresh fruit and vegetables as "closely related" and argues that all the Goods are primarily fruit and vegetable derivatives and are ordinary grocery store items that flow through the same channels of trade.

[26] I consider the following Goods to overlap with the Opponent's fresh fruit and vegetables (for ease of reference, I will refer to these Goods as the Group1 Goods):

(1) Frozen fruits; fruit purees; [...]; fruit fillings; fruit and fruit-based pie fillings; [...]; frozen vegetables; vegetable purees; vegetable fillings; vegetable and vegetable-based pie fillings; [...].

(2) Fresh fruits; fresh vegetables; fresh sliced fruits and fresh sliced vegetables.

(3) Fruit juices; vegetable juices.

[27] However, the following Goods, while falling into the same general class and related in that they involve fruit and vegetables, are intrinsically different in nature and do not overlap with the Opponent's fresh fruit and vegetables (Group 2 Goods):

(1) [...]; fruit jams; fruit jellies; [...]; fruit preserves; fruit and fruit-based sauces; fruit and fruit-based spreads; fruit toppings and fruit-based yogurt chips [...]; vegetable and vegetable-based sauces; vegetable and vegetable-based spreads; [...]; yogurt-covered fruit.

(2) [...].

(3) [...].

[28] These products are processed to a greater degree than fresh fruit and vegetables. Additionally, they are used for different purposes, such as flavouring or as condiments, as opposed to being a food staple in the way fresh fruit and vegetables are. They are also likely to be shelf-stable and sold in a different area of grocery stores.

[29] It has been recognized that the mere fact that the goods of the parties qualify a food products is not very useful in the context of a likelihood of confusion analysis as this is a very broad designation [*Van Melle Nederland B.V. v Principal Marques Inc.* (1998), 87 C.P.R. (3d) 368 (TMOB)]. I note that in that case no likelihood of confusion was found between FRUIT-ELLY for “puddings, parfaits and gelatin desserts” and FRUITELLA for “confectionery, viz bonbons, dragees, drops, chewing gum, peppermint toffees, medicated bonbons and dragees and licorice articles, all the stated goods not containing cocoa or chocolate”. Similarly, in *Loblaws Inc. v. Tritap Food Broker, a division of 676166 Ontario Limited* (1999) 3 CPR (4th) 108 no likelihood of confusion was found in respect of TASTEFUL MEMORIES for various snack foods and the MEMORIES OF for “sauces, cream cheese, meat, jelly, pizza”.

[30] Lastly, the Goods which, in the absence of evidence to the contrary, I find to be generally unrelated to the Opponents fresh fruit and vegetables, other than sharing the characteristic of being food are (Group 3 Goods):

(1) [...]; yogurt products; yogurt chips; frozen yogurt used for baking, cooking and blending.

(2) [...].

(3) [...].

[31] Aside from the Group 1 Goods, which overlap with the Opponent's fresh fruit and vegetables and could be sold alongside those of the Opponent, I am not persuaded it is appropriate to attribute much weight to the fact that the goods of the respective parties are all sold through grocery stores. While goods might belong to the same general class and be sold through the same stores, it remains possible for such goods to be of an intrinsically different nature [*Oshawa Holdings Ltd v Fjord Pacific Marine Industries Ltd.* (1981), 55 CPR (2d) 39 at 44 (FCA); *Clorox Co v Sears Canada Inc* (1992), 41 CPR (3d) 483 (FCTD) at 490]. I consider this to be the situation in respect of the Group 2 Goods.

[32] The Group 3 Goods are even more unrelated to the Opponent's fresh fruit and vegetables, owing to the fact they are dairy based. There is no evidence from which I might infer that consumers are likely to think the Group 2 Goods and Group 3 Goods originate from the same source as the Opponent's fresh fruit and vegetables.

[33] I find that the Applicant's Group 1 Goods overlap to some extent with the Opponent's fresh fruit and vegetables and as such, this factor strongly favours the Opponent. In respect of the Group 2 Goods and Group 3 Goods, the tangentially related nature of the Group 2 Goods to fresh fruit and vegetables favours the Opponent slightly, whereas in respect of the Group 3 Goods, the substantially different nature of the respective goods favours the Opponent to a greater degree.

Channels of Trade

[34] The Applicant argues that in the context of considering the channels of trade, it is relevant that the Opponent's goods are sold only through its own grocery stores and platform [Applicant's written representations, para 72]. I do not agree. It is not necessary to prove that the parties' goods are actually sold through the same channels of trade, as long as the parties are entitled to do so [*Eminence, SA v Registrar of Trade Marks* (1977) 39 CPR (2d) 40 (FC) at para 43]. Neither the Applicant's nor the Opponent's statement of goods contains any sort of restriction involving channels of trade. I therefore consider there to be, minimally, scope for overlap in the Applicant's

channels of trade versus those of the Opponent. This factor therefore favours the Opponent in respect of the Group 1 Goods. It does not favour the Opponent meaningfully in respect of the Group 2 or 3 Goods however, owing to the difference in the intrinsic nature of these Goods and because they are likely to be sold in a different retail section.

Degree of Resemblance in Appearance or Sound or Ideas Suggested

[35] The Supreme Court of Canada instructs in *Masterpiece* that the factor, amongst those listed under section 6(5) of the Act, which often has the greatest effect on the confusion analysis is the degree of resemblance between the parties' trademarks.

[36] Jurisprudence involving the analysis of the degree of resemblance is clear in that 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. While the first portion of a mark which is often most important for the purpose of distinction [*Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD) and *Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd*, 1991 CanLII 11769 (FCA)], 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 [*Masterpiece*, at para 64].

[37] The Opponent argues that it is the combination of words rather than any single word that renders its Registered Trademark striking and unique [Opponent's written representations para 49]. However, I consider that the more striking and unique portion is IMPERFECT, or the French equivalent. NATURALLY, and its French equivalent, simply modify the word "imperfect".

[38] The Applicant argues that the only commonality between the Mark and the Opponent's Registered Trademark is the word element "imperfect". The Applicant also argues that since the term "imperfect" is deserving of limited protection on the basis it is commonly used and descriptive, the similarity owing to the shared use of this term is insufficient to give rise to a likelihood of confusion [Applicant's written representations, para 44].

[39] The evidentiary support for the Applicant's claim that "imperfect" is commonly used is somewhat limited. In this regard, I note that the Gordon affidavit includes several websites showing use of the term "imperfect" to describe foods including fruits and vegetables. While some of the sites originate in Canada, others appear to be US based. Additionally, there is no indication of the number of visits by Canadians to the sites. The Opponent argues that this evidence is of little probative value [Opponent's written representations, para 33]. I agree. I am not satisfied that the evidence establishes that the word "imperfect" was used by others generically, at least to any great extent, to describe food that did not meet certain standards. However, I do not believe anything turns on this, as I nonetheless consider the term to be descriptive by virtue of its meaning when considered in association with food products.

[40] The Applicant also points to the fact that the first portion of the Mark differs from the Opponent's Registered Trademark to support its argument that the trademarks do not resemble each other visually, phonetically or in respect of the ideas suggested [Applicant's written representations, paras 34 to 39]. The Applicant also submits that the visual appearance of the trademarks differ, noting the different number of elements comprising the Opponent's Registered Trademark [Applicant's written representations, paras 40 and 41]. I agree with these characterizations.

[41] I cannot however agree with the Applicant's submissions that it is significant that the Opponent's Registered Trademark appears in black font on a bright yellow background, or that it is associated with the trademark NO NAME. I note that the Opponent's Registration shows the trademark in black and white and as such the Opponent is entitled to use its trademark in any colour [*British Drug Houses Ltd v Battle Pharmaceuticals*, (1944), 4 CPR 48 at 247 (ExCt), aff'd [1946] S.C.R. 50]. Similarly, it is of no significance that the packaging shows the Registered Trademark appearing in conjunction with the trademark NO NAME. There is no restriction against multiple trademarks being used together in association with the same product [*AW Allen Ltd v Warner Lambert Canada Inc* (1985), 6 CPR (3d) 270 at 272 (FCTD)], or indeed any requirement that the Opponent combine its trademarks in any particular manner.

[42] As noted by the Opponent, the most striking and or unique feature of a trademark may be the distinctive combination of terms [*Jacques Vert Group Limited v YM Inc*, 2014 FC 1242 at para 48]. While I am unable to find this principle applies to the Opponent's Registered Trademark as I was invited to do, I am satisfied the principle applies to the Mark. It is the combination of "perfectly" and "imperfect" that is the striking and unique feature of the Mark. This is due to the fact the phrase is an oxymoron. In order to convey the intended meaning, both terms must be considered together. Unlike the Opponent's Registered Trademark, it is not a case of one word modifying another, but of two words, conveying two concepts, that must be considered together as a unitary phrase to derive a meaning.

[43] The Opponent's Registered Trademark describes that its fresh fruit and vegetables are inherently not perfect. The Mark, however, connotes that imperfections in the Goods are perfect, and perhaps by extension calls into question what is traditionally understood as perfection. As such, the idea suggested by the Mark differs from that of the Registered Trademark.

[44] To the extent both trademarks contain the element IMPERFECT, there is a degree of resemblance. However, given the differences in appearance, sound and ideas suggested, I find that overall, this factor favours the Applicant.

Surrounding Circumstances

[45] The Applicant argues that the impact of the NO NAME brand on the Opponent's packaging is a relevant surrounding circumstance that should be considered. While the Applicant accepts that an owner may use multiple trademarks on the same packaging, it argues that care must be taken to assess whether consumers are capable of recognizing and differentiating between the trademarks as source identifiers, particularly when one or more of the trademarks is descriptive. The Applicant goes on to suggest that the brand would be perceived as NO NAME, with the Opponent's Registered Trademark being perceived as descriptive language [Applicant's written representations, paragraphs 47 to 51]. In support, the Applicant relies on the decision *Molson Breweries, A Partnership v John Labatt Ltd*, 2000 3 FCA 145 at para 57].

[46] I find that, minimally, this argument ignores the fact that the Opponent's Registered Trademark is identified using various symbols to denote that it is a trademark. Additionally, on packaging the term NO NAME is separate from the Registered Trademark and appears in a different font, size and colour. These factors help distinguish the case at hand from the *Molson* decision. To the extent the Opponent's Registered Trademark might be considered to be descriptive or suggestive of fresh fruit and vegetables, I note that this fact has been taken into consideration as part of the assessment of inherent distinctiveness.

[47] I therefore find that the use of the Registered Mark in conjunction with NO NAME is not a relevant surrounding circumstance.

Conclusion – Confusion Analysis

Group 1 Goods

[48] Having considered all of the surrounding circumstances, in particular, the overlap in respect of the parties' goods or potential channels of trade, the length of time the Registered Trademark has been in use as well as the distinctiveness it has acquired over that time, and the fact that while there is a limited degree of resemblance, the parties' marks do share the portion "imperfect", I find that the Applicant has failed to meet its legal onus of proving on a balance of probabilities that there is no reasonable likelihood of confusion. This ground of opposition therefore succeeds in respect of the Group 1 Goods.

Groups 2 and 3 Goods

[49] In respect of the Groups 2 and 3 Goods, having considered all surrounding circumstances, noting in particular the differences in the nature of the Goods and, as well, the limited degree of resemblance between the Registered Trademark and the Mark, I conclude that, on a balance of probabilities, the Applicant has met its legal burden of proving that there is no reasonable likelihood of confusion in respect of the Goods 2 and Goods 3. This ground of opposition is therefore rejected in respect of the Groups 2 and 3 Goods.

SECTION 2 GROUND OF OPPOSITION

[50] The Opponent has pleaded that the Mark is not distinctive in that it does not distinguish, nor is it adapted to distinguish, the Applicant's Goods from the goods of the Opponent sold in association with its Registered Trademark and common law trademarks.

[51] The material date for the section 2 ground of opposition is the filing date of the opposition, namely, January 2, 2020 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, (2004), 34 CPR (4th) 317 (FC)].

[52] To meet its evidential burden, the Opponent must show that at least one of its trademarks has become sufficiently known to negate the distinctiveness of the Mark [*Bojangles' International, LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427 (FCTD)]. This may be achieved through evidence sales of goods bearing the trademark, but also through evidence of knowledge or reputation of the Opponent's trademark, for example, achieved through newspapers or magazines [*Motel 6, Inc v No 6 Motel Ltd*, (1981), 56 CPR (2d) 44 (FCTD) at 58-59].

[53] I consider that the Opponent has met its burden through the sales, promotion and publications corresponding to the Opponent's fresh fruit and vegetables sold under the Registered Trademark as discussed above in respect of the section 12(1)(d) ground. The Applicant is therefore required to show that its Mark is adapted to distinguish or actually distinguishes the Goods from the goods of the Opponent [*Muffin Houses Incorporated v The Muffin House Bakery Ltd*. (1985), 4 CPR (3d) 272 (TMOB)].

[54] I find the difference in material dates does not materially affect my conclusion reached under the section 12(1)(d) ground of opposition discussed above. Accordingly, for reasons similar to those expressed in the above analysis, I again conclude, this ground of opposition is successful in respect of the Group 1 Goods and rejected in respect of the Groups 2 and 3 Goods.

SECTION 16 - NON-ENTITLEMENT GROUND

[55] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark pursuant to section 16(3)(a) of the Act because it was, at the material date, confusing with the Opponent's Registered Trademark and common law trademarks, previously used and made known in Canada in association with the Opponent's goods and not abandoned as of the date of advertisement of the Application.

[56] With respect to this ground of opposition, there is an initial burden on the Opponent to evidence use of at least one of its trademarks prior to the Applicant's filing date, namely January 19, 2018, and non-abandonment of its trademark(s) as of the date of advertisement of the Application, namely June 12, 2019. I am satisfied the Opponent has met its initial burden in respect of the Registered Trademark. While the Opponent is not restricted to its Registered Trademark in respect of this ground, I nonetheless consider the Registered Trademark affords the Opponent at least as strong a case as any other of the Opponent's trademarks.

[57] As the Opponent has satisfied its initial burden, the Applicant must establish on a balance of probabilities that, as of the filing date, there was not a reasonable likelihood of confusion between its Mark and the Opponent's Registered Trademark.

[58] While the earlier material date favours the Applicant to some extent, it does not ultimately alter the outcome of the confusion analysis. At best for the Applicant, the probability of confusion is evenly balanced in respect of the Group 1 Goods and as such it has not met its burden of proving on a balance of probabilities that there is no reasonable likelihood of confusion between the Opponent's Registered Trademark and the Mark. I reach this finding primarily owing to the overlap in the nature of the respective goods and associated channels of trade and because even if there is a limited degree of resemblance, the parties' marks do share the portion "imperfect." I am also mindful of the length of time the Registered Trademark has been in use, along with the distinctiveness acquired over that time, even if the timespan is less than in respect

of the Registrability and non-distinctiveness grounds discussed above. The non-entitlement ground therefore succeeds in respect of the Group 1 Goods.

[59] In respect of Goods 2 and Goods 3, as in the registrability and distinctiveness grounds, I find the Applicant has met its burden of proving on a balance of probabilities that there is no reasonable likelihood of confusion. I reach this conclusion primarily owing to the difference in the nature of the goods as well as the differences in the appearance, sound and ideas suggested by the parties' trademarks. This ground of opposition is therefore rejected in respect of Groups 2 and 3 Goods.

DISPOSITION

[60] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to Group 1 Goods and I reject the opposition with respect to Groups 2 and 3 Goods, pursuant to section 38(8) of the Act [*Coronet-Werke Heinrich Schlerf GmbH v Produits Ménagers Coronet Inc* (1986), 10 CPR (3d) 482 (FCTD) as authority for a split decision].

[61] Thus, the application is refused with respect to:

- (1) Frozen fruits; fruit purees; [...]; fruit fillings; fruit and fruit-based pie fillings; [...]; frozen vegetables; vegetable purees; vegetable fillings; vegetable and vegetable-based pie fillings; [...].
- (2) Fresh fruits; fresh vegetables; fresh sliced fruits and fresh sliced vegetables.
- (3) Fruit juices; vegetable juices.

However, the opposition is rejected with respect to:

- (1) [...]; fruit jams; fruit jellies; [...]; fruit preserves; fruit and fruit-based sauces; fruit and fruit-based spreads; fruit toppings and fruit-based yogurt chips [...]; vegetable and vegetable-based sauces; vegetable and vegetable-based spreads; yogurt products; yogurt chips; frozen yogurt used for baking, cooking and blending; yogurt-covered fruit.
- (2) [...].

(3) [...].

Coleen Morrison
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-07-14

APPEARANCES

For the Opponent: John Simpson

For the Applicant: Kwan T. Loh

AGENTS OF RECORD

For the Opponent: Shift Law Professional Corporation

For the Applicant: Smart & Biggar LP