



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 019

Date of Decision: 2024-01-31

IN THE MATTER OF AN OPPOSITION

Opponent: The Wonderful Company LLC

Applicant: Fresh Trading Limited

Application: 1801724 for DUDE Design

INTRODUCTION

[1] The Wonderful Company LLC (the Opponent) opposes registration of the trademark DUDE Design (the Mark), shown below, which is the subject of application No. 1,801,724, filed by Fresh Trading Limited (the Applicant).



[2] The statement of goods for the Application (the Goods), as last amended, is reproduced below, together with the associated Nice classes (CI) :

32(1) Fruit flavoured non-alcoholic drinks; fruit drinks; fruit juices; mineral water; non-alcoholic aerated beverages

30(2) Fruit sauces

[3] The application claims use and registration in the United Kingdom for all of the Goods.

[4] The opposition is primarily based on an allegation that the Mark is confusing with the Opponent's prior use and registration of the Opponent's registration Nos. TMA918,961 (HALOS Character Design), TMA918,948 (HALOS & Design) and TMA1,052,224 (HALOS BABIES & Design) (collectively the HALOS registrations), in association with "fresh citrus fruit; fresh fruit".

[5] For the reasons that follow the application is refused with respect to the "mineral water" and the opposition is rejected with respect to the remainder of the Goods.

THE RECORD

[6] The Application was filed on September 23, 2016, and was advertised for opposition purposes in the *Trademarks Journal* of May 22, 2019. On July 19, 2019, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The Opponent was subsequently granted leave to file an amended statement of opposition on May 14, 2020, as well as on October 19, 2020.

[7] Numerous amendments to the Act came into force on June 17, 2019. Pursuant to the transitional provisions in section 70 of the Act for applications advertised before June 17, 2019, the grounds of opposition will be assessed based on the Act as it read immediately before amendment, an exception being that the definition of confusion in sections 6(2) to 6(4) of the Act as it currently reads will be applied.

[8] The amended statement of opposition raises grounds of opposition based on non-compliance with sections 30(d) and 30(i) of the Act, registrability under section

12(1)(d), entitlement under sections 16(2)(a) and 16(2)(b), and distinctiveness under section 2 of the Act. For the grounds of opposition based on an alleged likelihood of confusion, the Opponent relies primarily on its registration and use of its HALOS registrations, set out below:

Trademark	Registration No.	Filing Date	Registration Date
	TMA918961	June 13, 2013	October 30, 2015
	TMA918948	June 13, 2013	October 30, 2015
	TMA1052224	September 5, 2014	September 3, 2019

[9] The Applicant filed a counter statement denying the grounds of opposition.

[10] In support of the opposition, the Opponent filed the affidavits of Craig Cooper (sworn March 17, 2020), Pam Sauve and Laura Rowe. Only Mr. Cooper was cross-examined on his affidavit and the transcript forms part of the record. The Opponent also requested and was granted leave to file a certified copy of registration No. TMA918,961, for what the Opponent refers to as “the HALOS Character Mark”.

[11] In support of the Application, the Applicant filed the affidavits of: Jane Buckingham, James Davenport, Kasia Donovan, Melissa Cheng, Richard Du and

Samuel Duval. Only Mr. Davenport was cross-examined on his affidavit and the transcript forms part of the record.

[12] As evidence in reply, the Opponent filed a second affidavit of Craig Cooper, (sworn June 20, 2022). Mr. Cooper was also cross-examined on this affidavit and the transcript forms part of the record.

[13] Both parties filed written representations and both were represented at a hearing.

LEGAL ONUS AND EVIDENTIAL BURDEN

[14] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the Application complies with the requirements of the Act. This means that if a determinate conclusion cannot be reached in favour of the Applicant after a consideration of all of the evidence, then the issue must be decided against the Applicant. However, 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 each ground of opposition exist [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

PRELIMINARY ISSUES

Admissibility of Reply Evidence

[15] As its evidence in chief, the Opponent filed the affidavit of Craig Cooper, Senior Vice President, Chief Legal Officer and Secretary of The Wonderful Company LLC and its wholly owned subsidiary Wonderful Citrus LLC. Mr. Cooper provided evidence in chief regarding the organizational and corporate structure of the Opponent and its related companies. He also provided information regarding the HALOS branded products, including sales, packaging and promotional information.

[16] As part of its evidence in chief, the Applicant submitted the affidavit of Samuel Duval, former articling student with the Applicant's agent. Mr. Duval evidenced the packaging of a purchase in Canada of HALOS branded mandarins on October 30,

2020, which featured the HALOS & Design mark and the HALOS Character Design mark. This packaging was put to Mr. Cooper during his first examination.

[17] During the cross-examination of Mr. Cooper on his first affidavit, it was suggested that there were licensing issues as well as errors on some product packaging that was provided into evidence. In his evidence in reply, Mr. Cooper provided a written license agreement that was granted by Wonderful Company to Wonderful Citrus Ventures as Exhibit A to his affidavit. He also explained the errors that were included on the packaging that was attached as Exhibit B to the Duval affidavit and what the packaging should have said instead.

[18] The Applicant submits that paras. 5-6, and 13-18 of the Cooper Reply Affidavit, as well as the portions of his cross-examination that address how the various “Wonderful” companies are affiliated and provide information about the HALOS branded products should not be considered by the Registrar because it is not proper evidence in reply. In this regard, the Applicant submits that this evidence ought to have been led as the Opponent’s evidence in chief.

[19] Section 54 of the *Trademarks Regulations* SOR/2018-227 permits the filing of reply evidence. The test for whether evidence is proper reply evidence is whether the evidence introduced by the Opponent is in reply to the Applicant’s evidence and is responsive to unanticipated matters.

[20] I find the second affidavit of Mr. Cooper to be proper reply evidence. In this regard, I am satisfied that it responds to issues that could not reasonably have been foreseen, as well as issues which were raised in cross-examination, and it further responds to evidence presented by the Applicant’s affiant Mr. Duval. I will add that if I am wrong in so finding, this finding would not have any effect on the overall outcome of this case.

Does the Applicant exercise control over the character and quality of the Goods?

[21] As part of its evidence in chief, the Applicant filed the affidavit of Mr. Davenport, Director, Company Secretary and Chief Operating Officer for the Applicant. He is also Director and Company Secretary for Innocent UK, a wholly owned subsidiary of the Applicant, which is responsible for the distribution of the Goods in the U.K., Ireland and other new markets including Canada. In his affidavit, Mr. Davenport discusses, *inter alia*, the Applicant's business, the relationship between the Applicant and Innocent UK, use of the Mark in association with the Goods in Canada and abroad, and how the Mark has been used in the promotion of the Applicant's Goods.

[22] The Opponent claims that while Mr. Davenport asserts that Innocent UK is responsible for the distribution of the Goods in the UK, Ireland, and other markets including Canada, the affidavit is silent with respect to which entity is the source of the Goods. The Opponent also submits that the Davenport affidavit is silent as to when the Applicant provided authorization to Innocent UK and/or exercised the control over the character and quality of the Goods sold in association with the Mark.

[23] In response to the Opponent's submissions identified above, the Applicant submits that the Registrar rejected similar arguments with similar evidence in *The Wonderful Company LLC and Fresh Trading Limited*, 2023 TMOB 8, a section 45 decision, as follows:

Use By The Owner

[23] The Requesting Party submits that use of a trademark in association with goods sold by a distributor is not use of the trademark by the distributor, but rather is use of the trademark that accrues to the benefit of the entity that is the source of the product, citing *Manhattan Industries Inc v Princeton Mfg Ltd* (1971), 4 CPR (2d) 6 at 16-17 (FCTD) [Manhattan Industries], and *Havana House Cigar & Tobacco Merchants Ltd v Skyway Cigar Store*, 1998 CanLII 7773 (FCTD) at para 60. As such, given that the Owner is a holding company, the Requesting Party submits that any use by Innocent UK would not enure to the Owner as it is not the source of the product.

[24] However, I agree with the Owner that given the nature and purpose of section 45 of the Act, it is proper to presume that a registered owner is

the “source” of the goods in question, unless the evidence indicates otherwise, such as in the case of a licensee [see *Marks & Clerk v Tritap Food Broker*, 2017 TMOB 35 and *Gowling Lafleur Henderson LLP v Henry Company, LLC*, 2017 TMOB 51]. In this case, Mr. Davenport clearly states that the Owner “is responsible for overseeing the use, maintenance, management, protection and development of all intellectual property within the Innocent group of companies on a global basis”. Furthermore, Mr. Love states that the Owner, through its subsidiaries, “manages and controls [...] developing, marketing, manufacturing and distributing ‘innocent’ branded beverages” including the “Innocent Goods”.

[25] Accordingly, given that the Davenport and Love Affidavits clearly attest to the manner and means by which the Owner exercises control over the character and quality of its goods, I am satisfied that any evidenced use of the Mark in association with those goods by Innocent UK or the Innocent Group would enure to the Owner [see *Empresa Cubana Del Tobacco Trading v Shapiro Cohen*, 2011 FC 102 at para 84].

[24] I will begin by noting that any findings the Registrar made in a section 45 proceeding are not evidence of use in the subject opposition. Each opposition decision before the Registrar must be decided on its own merits having regard to the evidence submitted in the particular case, which may differ from the evidence adduced in a prior case involving the same parties [see *Purafil Canada Ltd v Purafil, Inc*, 2012 TMOB 105 at para 20; and *Sunny Crunch Foods Ltd v Robin Hood Multifoods Inc* (1982), 70 CPR (2d) 244 (TMOB) at 249]. Further, there is no evidence by Mr. Love, the affiant in the section 45 proceeding, in this case.

[25] Having said that, I am satisfied that the evidence in this case shows that the Applicant exercises control over the character and quality of its goods. In this regard, Mr. Davenport states the following at paragraph 4 of his affidavit:

Fresh Trading is the parent holding company of the Innocent group of companies. Fresh Trading owns all of the intellectual property rights, including trademarks, which are used by the other entities within the Innocent group of companies on a global basis. Fresh Trading is responsible for overseeing the use, maintenance, management, protection and development of all intellectual property within the Innocent group of companies on a global basis. Through its subsidiaries, ...Fresh Trading manages and controls the following activities carried out by the Innocent Group: developing, marketing, manufacturing and distributing “innocent” branded beverages, namely fruit smoothies, dairy-free beverages, fruit juices, juice and vegetable “shots”, sparkling fruit and

water “bubbles” beverages, children’s fruit products, and coconut water to consumers around the world.

[26] As I find that the above statement clearly attests to the manner by which the Applicant exercises control over the character and quality of the Goods, I am satisfied that any evidenced use of the Mark in association with the Goods by Innocent UK would enure to the Applicant.

ANALYSIS OF THE GROUNDS OF OPPOSITION

Section 30(d) ground of opposition

[27] The Opponent pleads that the Applicant has not used the Mark in England as claimed in the application for two reasons:

1. Any use of the Mark should not enure to the benefit of the Applicant due to alleged ambiguities as to whether the source of the Goods, is, or has been licensed by, the Applicant; and
2. The Rowe affidavit, which provides evidence of the website located at www.innocentdrinks.co.uk displaying the Goods, did not include evidence with respect to “fruit sauces” and “mineral water”. The only products displayed on the website were beverage products, namely smoothies, juices, coconut water, bubbles and fruit tubes.

[28] While the legal onus is upon an applicant to show that its application complies with section 30(d) of the Act, there is an initial evidential burden on the opponent in respect of this ground [*Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB)]. To the extent that the applicant has easier access to the facts, the burden of proof on the opponent in regard to the ground of opposition based on the failure to respect section 30(d) is less onerous [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. The material date with respect to a ground of opposition based on section 30(d) of the Act is the filing date of the application [see *Austin Nichols & Co, Inc v Cinnabon, Inc* (2000), 5 CPR (4th) 565 (TMOB)].

[29] In support of its first argument, the Opponent relies on what it describes as “inconsistencies” in the Davenport affidavit. In this regard, Mr. Davenport states that the Applicant is the parent holding company of the Innocent Group of Companies which includes Innocent UK (the “Innocent Group”). While Mr. Davenport asserts that Innocent UK is responsible for the distribution of the Goods in the UK, Ireland and other markets including Canada, the Davenport affidavit is silent as to which entity is the source of the Goods.

[30] The Opponent fails to meet its evidential burden with respect to its first argument because, as discussed above in paragraphs 24-27, the evidence of Mr. Davenport clearly shows how the use of the Mark by Innocent UK enured to the Applicant.

[31] With respect to the Opponent’s second allegation, the Opponent relies on the results of an Internet searches performed by Ms. Laura Rowe, articling student with the Opponent’s firm, on March 17, 2020, and April 2, 2020. Ms. Rowe attended the website located at the domain name *www.archive.org* and conducted searches using the WayBack Machine search function. Using the WayBack Machine, she searched for archived copies of the webpage located at *www.innocentdrinks.co.uk/things-we-make* from the beginning of August to the end of October, 2016. She observed that the only products displayed on the website during the above-noted period were beverage products, namely “smoothies”, “juices”, “coconut water”, “bubbles” and “fruit tubes” [Rowe Affidavit at paras 3-17 and Exhibits B-K]. The Opponent submits that the fact that the goods “mineral water” and “fruit sauces” are not shown in the archived copies of the webpages is sufficient to meet its light burden under this ground.

[32] The Applicant, on the other hand, submits that the Opponent’s evidence of archived screenshots of beverage products that appeared on the Applicant’s website from August 2016 to October, 2016, is insufficient on its own to put into issue whether or not the Applicant had used the Mark with such goods in the UK as of April 18, 2013. The Applicant further submits the wording of section 30(d) refers to a general class of goods and therefore does not require use to be shown with each good. In this regard, it points to the specific wording of section 30(d) of the Act which reads as follows:

An applicant for the registration of a trade-mark shall file with the Registrar an application containing:

(d) in the case of a trade-mark that is the subject in or for another country of the Union of a registration or an application for registration by the applicant or the applicant's named predecessor in title on which the applicant bases the applicant's right to registration, particulars of the application or registration and, if the trade-mark has neither been used in Canada nor made known in Canada, the name of a country in which the trade-mark has been used by the applicant or the applicant's named predecessor in title, if any, in association *with each of the general classes of goods* or services described in the application (emphasis added);

[33] If I find that the Opponent has met its burden, the Applicant submits the following:

1. Exhibit J to the affidavit of Ms. Rowe displays fruit juice and spring water in association with the Mark. The Applicant submits that these products are close enough to be considered as a type of mineral product.
2. Exhibit O to the affidavit of Ms. Rowe shows the Mark in association with a fruit puree. The Applicant submits that the definitions of puree and sauce are close enough that evidence of fruit puree can constitute use of fruit sauce.

[34] I will begin by saying that I respectfully disagree with the Applicant that compliance with section 30(d) does not require use to be shown in association with each good. In this regard, the application is not for goods of one general class but is for individually named specific goods. I am also unaware of any jurisprudence that states otherwise. Accordingly, I find that compliance with section 30(d) requires that use be shown with each of the applied for goods or services.

[35] Next, while I appreciate that the goods listed on the Applicant's website between August 2016 and October 2016 do not necessarily reflect all of the goods the Applicant was selling during its sixteen years of use of the Mark in the United Kingdom (Davenport, para 19), in considering this issue I have had regard to the following comments of former member Bradbury in *Canadian Medical Association v Dr. C. Soldan GmbH*, 2004 CanLII 71751:

“I appreciate that the wares listed on the applicant’s website as of July 30, 2002 do not necessarily reflect the wares that the applicant was selling in association with its mark in Germany prior to the filing of the present application. However, it is trite to say that it is not an easy matter for a third party to evidence the absence of sales by an applicant in a foreign country at any time, let alone several years ago. I therefore believe that the opponent’s evidence satisfies its light evidential burden. It should have been a relatively easy matter for the applicant to respond by filing evidence showing use of its mark in Germany as of the relevant date with respect to the contested wares. ”

[36] In the present case, the Mark is clearly present on the Applicant's website in association with some, but not all of the Goods. In my view this evidence is sufficient to suggest, at a minimum, that the missing goods were not offered by the Applicant as of the material date. I am therefore satisfied that the Opponent has met its evidential burden. The next issue to be decided therefore is whether the Applicant’s spring water qualifies as mineral water and whether the Applicant’s fruit puree qualifies as fruit sauces.

[37] With respect to the Applicant’s mineral water, exhibit J to Ms. Rowe’s affidavit shows a product referred to as BUBBLES, which is defined in the advertisement as “a lightly sparkling blend of fruit juices and spring water”. While spring water may be an ingredient of the product, the Opponent submits that this does not mean that the trademark is being used with spring or mineral water itself [see *Ziaja Ltd v Jamieson Laboratories Ltd* (2005), 50 CPR (4th) 237 (TMOB) at para 10; *McMillan LLP v Orange Brand Services Ltd*, 2016 TMOB 111 at paras 72-73]. I agree. Accordingly, I do not find that evidence of use of the Mark with the blend of fruit juices and spring water establishes use of the Mark with mineral water.

[38] As for fruit sauces, Exhibit O to Ms. Rowe’s affidavit shows the display of “fruit tubes” which are described in the advertisement as “No bits. No rubbish. Just a tube full of pure fruit puree to keep your little ones (and their lunch boxes) nice and healthy.” The Applicant submits that sauces and purees are synonyms and that its evidence shows use of the Mark with a “fruit sauce”. In support of this position, the Applicant notes that the Merriam Webster online dictionary (<https://www.merriam-webster.com>) provides the following definitions

“sauce” - ... “stewed fruit eaten with other food or as a dessert”; “Sauce”.

“puree” - ...“a paste or thick liquid suspension usually made from cooked food ground finely”; “Puree”.

[39] I am able to conclude from these definitions that a reasonable interpretation of the goods “fruit sauces” would encompass a fruit puree product. For example, in my view apple sauce could be reasonably considered as a synonym for apple puree and vice versa.

[40] In view of the above, as the Applicant has not shown use of the Mark as if the material date in association with mineral water, this ground of opposition succeeds with respect to mineral water only.

Section 12(1)(d) ground of opposition

[41] The Opponent has pleaded that the Mark is not registrable because, contrary to section 12(1)(d), the Mark is confusing with the HALOS registrations of the Opponent.

[42] The material date for this ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[43] I have exercised my discretion to check the Register and confirm that these registrations remain extant [*Quaker Oats Co Ltd of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent has therefore met its initial evidential burden with respect to this ground of opposition. As a result, the Applicant bears the legal burden of demonstrating on a balance of probabilities that there is no likelihood of confusion between the Mark and any one of the Opponent’s registered trademarks.

[44] Unless otherwise indicated, I will focus on the Opponent’s registration No. TMA918961, for the Opponent’s HALOS Character Design mark, as in my view this trademark represents the Opponent’s best case. The goods associated with this registration are “fresh citrus fruit; fresh fruit”.

Test for confusion

[45] Two trademarks will be considered confusing if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or in the same class of the international Nice Classification system [section 6(2) of the Act].

Thus, the test for confusion does not concern confusion of the trademarks themselves but rather confusion as to whether the goods and services associated with each party's trademark come from the same source. Where it is likely to be assumed that the Applicant's Goods either come from the Opponent or are approved, licensed, or sponsored by the Opponent, it follows that the trademarks are confusing [*Glen-Warren Productions Ltd v Gertex Hosiery Ltd* (1990), 29 CPR (3d) 7 (FCTD)].

[46] The test is to be applied as a matter of first impression in the mind of a casual consumer somewhat in a hurry, who sees the applicant's trademark at a time when he or she has no more than an imperfect recollection of the opponent's trademark and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the trademarks [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23]. Regard must be had to all the surrounding circumstances, including those set out in section 6(5)(a) to (e) of the Act, but these criteria are not exhaustive and the weight given to each factor will vary in a context-specific analysis [*Mattel USA Inc v 3894207 Canada Inc*, 2006 SCC 22]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 where the Supreme Court of Canada states at para 49 that section 6(5)(e), the resemblance between the trademarks, will often have the greatest effect on the confusion analysis.

Section 6(5)(a) – the inherent distinctiveness of the trademarks and the extent to which they have become known

[47] Both parties marks are unique designs and therefore have some degree of inherent distinctiveness. However, the Opponent's own evidence is that the HALOS Character Design mark "was created to represent a mandarin with a face and a halo over it". In other words, a key element of the HALOS Design Character Mark depicts the

actual product it is designed to sell – mandarins. As such, while the HALOS Design Character Mark is a unique design, that design is quite suggestive of the associated goods.

[48] The Mark, on the other hand, is not suggestive or descriptive of the Goods. I therefore find that the Mark is inherently stronger than the Opponent’s mark.

[49] Section 6(5)(a) also considers the extent to which a mark is known, referred to often as its acquired distinctiveness. Through promotion or use, the strength of a trademark may be increased.

[50] In this case, Mr. Cooper states that companies within the Wonderful Group of Companies have been selling mandarins in association with the trademark HALOS, including the HALOS & Design mark and the HALOS Character Design mark to customers in Canada since at least as early as November 2013. While evidence of sales of the Opponent’s products sold in association with any of these marks were not available prior to 2016, Mr. Cooper does state that since the beginning of 2016, the Opponent has sold in excess of 7.3 million cases in Canada.

[51] Further, in addition to being sold in bags, the HALOS branded products are contained in boxes that also prominently display the HALOS & Design mark. Mr. Cooper explains that the packaging shown in the images below is representative of how the HALOS & Design mark, including the HALOS Character Design mark, has been displayed in association with all of the HALOS branded products sold by the Opponent since at least as early as November 2013.



Mr. Cooper also confirmed on cross-examination that the HALOS Character Design mark only appeared on its own in various point of sale materials between January 1, 2016, and March 17, 2020, for which the amount spent was “in excess of \$175,000” [Cooper cross-ex. Qs. 61-63). Therefore, while the Opponent has shown that its HALOS & Design mark has become known to a considerable extent in Canada, the extent known of the HALOS Character Design mark, on its own, is not as extensive.

[52] With respect to the evidence of the use and extent known of the Applicant’s Mark, the Opponent points out the following inconsistencies in the Davenport affidavit regarding use of the Mark in Canada:

- While Mr. Davenport provides at paragraph 20 of his affidavit sales figures of the Goods “around the world” from 2011 to 2020, his affidavit is silent as to where those sales took place and/or what goods were sold;
- While Mr. Davenport states at paragraphs 22-24 of his affidavit that the Goods have been sold in the normal course of trade by third party distributors, including without limitation, through e-commerce retailers such as *Amazon.ca*, he does not provide details such as when those sales took place or the extent of such sales;
- While screenshots from *Amazon.ca* are claimed to be representative of the way in which the Goods have been offered for sale and continue to be offered for sale in Canada, on cross-examination, Mr. Davenport acknowledged that he did not personally take the screenshots, he did not attend at *Amazon.ca* when executing his affidavit to make sure the screen shots were accurate and he has never been on the *Amazon.ca* website and as such could not confirm what information is typically available on such website;
- While Mr. Davenport states that the Applicant’s Goods have been sold and continue to be sold at a café in Edmonton, Alberta, and provides as Exhibit O “photos of the innocent bubbles product being offered for sale in Canada”, on cross-examination he admitted that he did not know what café was being referred

to and he had not taken the picture shown at Exhibit O and he did not know who did; and

- While Mr. Davenport submits evidence of how the Mark is displayed on social media pages to promote the Goods, there is no evidence as to how long it has been displayed on any of the social medial pages, and other than information from his social media team that over 2500 followers are from Canada, there is no evidence with respect to exposure of those social media pages to Canadians or otherwise.

[53] I agree with the Opponent that much of the evidence presented by Mr. Davenport regarding the extent known of the Mark in Canada in association with the Applicant's Goods is either hearsay or insufficient to show that the Mark has become known in Canada to any significant extent.

[54] Therefore, overall, considering both the acquired and inherent distinctiveness of the marks, I do not find that this factor favours either party.

Section 6(5)(b) – length of time the trademarks have been in use

[55] The Applicant concedes that this factor favours the Opponent, as the HALOS Character Design mark has been used in Canada since 2013.

Section 6(5)(c) & (d) – the nature of the goods, services or business and nature of the trade

[56] With respect to the nature of the goods and the channels of trade, the Opponent makes the following submissions at paragraphs 83-84 of its written submissions (the “Remaining Goods” referring to the Goods as amended):

83. The Remaining Goods listed in the Application overlap with and/or are closely related to the fresh citrus fruit and fresh fruit of the Opponent sold in association with the Halos Character Mark and HALOS Design Marks, in particular the fruit sauce and fruit beverages products.

84. In view of the fact that the goods are closely related, it is reasonable to infer that there is also overlap in the channels of trade. Indeed, the evidence in this case demonstrates that both the Innocent Goods and the

HALOS Branded Goods are sold to wholesalers, retailers, distributors and grocery stores that sell the products to the public.

[57] The Applicant, on the other hand, submits that although both parties' goods are food products, they are intrinsically different and do not overlap. In this regard, the Applicant submits that the Mark is applied for in association with "fruit sauces" in class 30 and "fruit flavoured non-alcoholic drinks; fruit drinks; fruit juices; mineral water; nonalcoholic aerated beverages" in class 32, while the Halos Design Marks are registered for "fresh fruit" and "fresh citrus fruit" in class 31. Relying on the decision in *Edelweiss Food Products Inc v World's Finest Chocolate Canada Ltd*, 2000 CanLII 28672 (TMOB), the Applicant further submits that because the goods are intrinsically different, they would be sold in entirely different sections of the grocery store.

[58] I will begin by noting that the fact that the parties' goods are grouped in different classes of the Nice Classification is not determinative. In this regard, the Act expressly excludes the Nice Classification from the confusion analysis in section 6(2) of the Act, [*Stryker Corporation v Aphria Inc.*, 2023 TMOB 193]. Further, the present case can be distinguished from the decision in *Edelweiss Food Products* because the goods in this case are not as different as the chocolate and meat products in that case.

[59] Having said that, although the goods in this case are not necessarily intrinsically different, I do find that there are differences between the Opponent's fresh fruit and the Applicant's fruit flavoured non-alcoholic drinks; fruit drinks; fruit juices; mineral water; nonalcoholic aerated beverages and fruit sauces. In this regard, beverages and fruit sauces are processed goods whereas fresh fruit are not. Having said that, I still find the parties' goods to be related to the extent that they comprise either actual fruit, fruit flavours or fruit ingredients.

[60] With respect to the parties' channels of trade, the Opponent's agent submitted at the hearing that there is no evidence that the goods would be sold in entirely different sections of the grocery store. I agree. Having said that, I am prepared to take judicial notice of the fact that in a typical grocery store, fresh fruit items are not located in the same section as processed fruit flavoured and other beverages.

[61] In view of the above, I find that, overall, this factor favours the Opponent.

Section 6(5)(e) – degree of resemblance between the trademarks

[62] In most instances, the degree of resemblance between the trademarks at issue is likely to have the greatest effect on the confusion analysis [*Masterpiece, supra* at para 49]. One must consider the degree of resemblance between the marks in appearance, sound and ideas suggested. However, it is not the proper approach to set the trademarks side by side and carefully examine them to find similarities and differences; each trademark must be considered as a whole [*Veuve Clicquot, supra*].

[63] In this case, the similarity in appearance between the parties' marks arises from the fact that both parties' marks feature a halo design above either a precisely drawn or imperfectly drawn circle type shape. Even so, when the parties' marks are considered as a whole and as a matter of first impression to a consumer somewhat in a hurry, the overall visual impression of the marks is more different than alike. The striking feature of the Opponent's mark is the mark as a whole which is comprised of a three dimensional mandarin with a happy face with a halo that was intentionally designed to "represent a mandarin". The Mark, on the other hand, does not on its own even resemble a face given that it is not round like a head nor does it contain a nose or a mouth.

[64] Further, there is no similarity between the parties' marks when sounded. Finally, in terms of idea suggested, as a matter of first impression to a consumer somewhat in a hurry, the Opponent's registered trademark suggests a happy mandarin character. The Mark is not suggestive of a mandarin orange in any way.

Surrounding circumstance – actual use of the Mark

[65] The Opponent further submits that the similarities between the parties' marks are further emphasized when one considers the manner in which the Applicant purportedly uses the Mark. In this regard, the Opponent notes that the Applicant changes its design to comprise various fruits including an orange, as shown below.



[66] Below is an image of the Mark shown in association with a clear image of an apples and raspberries:



[67] In my view, the degree of resemblance between the marks would be low even if the Mark is presented in association with a clear image of a fruit like an orange as shown above, or an apple with raspberries. In this regard, I find that this presentation of the Mark would actually further differentiate the Mark from the Opponent's mark as the consumer would see the fruit being shown with the Mark as representing the flavour of the product as opposed to being part of the trademark itself.

[68] Accordingly, I do not find that this surrounding circumstance assists the Opponent.

State of the register evidence and state of the marketplace evidence

[69] The Applicant has furnished evidence on the state of the register and the state of the marketplace to establish that trademarks including a HALO or ANGEL element, face design, or fruit character design, are either on the Register or being used in association with goods in classes 29-32. The Applicant submits that its evidence shows that fruit character marks are quite common such that the HALOS Character Mark must be given a very narrow scope of protection.



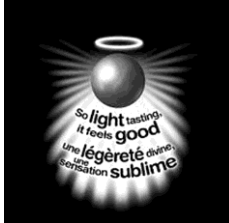
[70] State of the register evidence favours an applicant when it can be shown that the presence of a common element in marks would cause consumers to pay more attention to the other features of the marks, and to distinguish between them by those other features, therefore decreasing the likelihood of confusion [*McDowell v Laverana GmbH & Co KG*, 2017 FC 327 at para 42 (*McDowell*)]. Relevant trademarks include those that (i) are registered or are allowed and based on use; (ii) are for similar goods and services as the trademarks at issue, and (iii) include the element at issue in a material way [*Sobeys West Inc v Schwan's IP, LLC*, 2015 TMOB 197, aff'd 2017 FC 38].

[71] Where a large number of relevant trademarks are identified on the register, at least some use of the common element may be inferred [see, for example, *Kellogg Salada Canada Inc v Maximum Nutrition Ltd*, 1992 CanLii 14792 (FCA)]. Where the number of relevant trademarks identified is not large, evidence of such use needs to be furnished [see *McDowell, supra*, and *Canada Bread Company, Limited v Dr Smood APS*, 2019 FC 306].

[72] In this case, the Applicant provided state of the register evidence through the affidavit of Ms. Jane Buckingham, trademark searcher with the Applicant. She was instructed by a lawyer at the Applicant's agent to conduct a search of the Canadian Trademarks database to retrieve the trademark details for all active trademark applications and registrations in International Classes 29-32 for the following:

- marks that include the words HALO and/or HALOS;
- marks that include the words ANGEL and/or ANGELS; and
- marks classified with Design Code 26.1.25 (circles or ellipses representing a halo).

The Applicant submits that there are many HALO and ANGEL marks on the Register for use with goods in Classes 29-32, a few of which are set out below:

Mark	Reg. No.	Goods	Owner
	TMA1081179	<i>Fresh fruit, vegetables and herbs; fruit and vegetable salads [...]</i>	TruLeaf Sustainable Agriculture Limited
	TMA971518 (Cancelled 2023-04-25)	<i>Fruit flavoured nonalcoholic drinks; fruit juices; mineral waters; yogurt drinks; fruit drinks; non-alcoholic aerated beverages; syrups and powders for making beverages; beers</i>	Fresh Trading Limited
	TMA792561	<i>Chocolate confectionery</i>	Mars Canada Inc.

[73] The Applicant also tried to submit further state of the register evidence of various face design trademarks registered in association with fruit through its written representations at paragraph 74. As noted by the Opponent's agent at the hearing, however, state of the register evidence cannot be considered where it is adduced through written representations and without filing certified copies of the registrations or at least an affidavit affixing particulars of the relevant registrations [*John Labatt Ltd/John Labatt Ltee v WCW Western Canada Water Enterprises Inc* (1991), 39 CPR (3d) 442

(TMOB)]. I will therefore not have regard to the state of the register evidence adduced through the Applicant's written representations.

[74] State of the marketplace evidence was introduced by the Applicant by way of the Donovan Affidavit, the Cheng Affidavit and the Du Affidavit, which each submitted evidence of food/beverage products that feature animated fruit characters. In its written representations, the Applicant requested that the Registrar take note of the following evidence of fruit character marks being used in association with fresh mandarins and citrus fruit in Canada:





- Ms. Melissa Chang, an articling student with the Applicant’s agent, purchased the RASCALS mandarins and COPAG DELIGHT clementines at a McEwan Fine Foods grocery store in North York, Ontario, on January 20, 2021.
- Mr. Richard Du, a law student employed by the Applicant’s agent, purchased the OUTSPAN GEMS oranges at a Whole Foods Market store in Toronto, Ontario, on July 15, 2020. While conducting a Google search for oranges and clementines, he also found a product called CLEM’N’TINA’S which depicted animated oranges. A screenshot of the website showing this product was taken on August 3, 2020.
- Ms. Kasia Donovan, a summer student employed by the Applicant’s agent, conducted a Google search on August 4, 2020, using the key words “animated”, “fruit”, “snacks” and located the webpage <https://cutiescitrus.com/about/> which indicates that CUTIES mandarins are only available for purchase in Canada at Walmart between November and April. This is why she was unable to locate this product when she conducted her investigation of various grocery stores in Uxbridge, Ontario and London, Ontario in July, 2020.

[75] The Applicant also provided evidence which shows other fruit character marks being used in association with other fresh fruit and vegetables.

[76] Taken together, the Applicant submits that its evidence demonstrates that there is “a plethora of marks depicting animated fruit characters, angels, and halos, in association with fruit and food products, both on the Trademark Register and in the

Canadian marketplace”. The Opponent, on the other hand, submits that the applications and registrations located in the Applicant’s searches are irrelevant to the confusion analysis because the applications or registrations located in the searches: have been abandoned or are otherwise inactive, relate to trademarks that do not resemble any of the trademarks at issue, and/or are for unrelated goods or services. The Opponent also adds that the Applicant’s state of the marketplace evidence did not relate to any of the trademarks that were the subject of the applications or registrations identified in the CIPO searches.

[77] I agree with the Opponent that the Applicant’s state of the register evidence, on its own, does not assist the Applicant. In this regard, the state of the register searches only revealed trademarks including the words ANGEL, HALOS and/or the design of a halo, and not face or character designs which are the dominant elements shared by the parties’ marks.

[78] However, there is also evidence of at least three third party uses of trademarks with face or character designs in association with citrus fruits in the Canadian marketplace. Further, setting aside the fact that the appearance of trademarks on websites is not by itself evidence that Canadians are aware of these trademarks to any significant extent [*Symantec Corporation and Veritas Technologies LLC v Det Norske Veritas AS*, 2021 TMOB 143 at para 24], there is also evidence of an additional two trademarks with face or character designs used in association with citrus fruits. While I agree with the Applicant that, taken together, its evidence suggests that consumers are somewhat accustomed to seeing face or character designs in the related trades and may therefore pay more attention to the other components of these marks, the Applicant’s evidence falls short of establishing that the purchasers of fresh or processed fruit products in Canada are used to distinguishing trademarks comprising both a character design and a halo design. I therefore do not find that this factor favours the Applicant to any meaningful extent.

Conclusion – confusion analysis

[79] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the Mark in association with the Goods when he or she has no more than an imperfect recollection of the Opponent's HALOS Character Design trademark, and does not pause to give the matter any detailed consideration or scrutiny [*Veuve Clicquot, supra* at para 20].

[80] While the Opponent has established that its HALOS & Design trademark is known to a significant extent in Canada, its HALOS Character Design mark, on its own, is known to some extent, and that the parties' goods are related and their channels of trade could overlap, the Opponent's HALOS Character Design is an inherently weak mark. Further, I have found the parties' marks to be more different than alike. I therefore conclude that the balance of probabilities between finding that there is no reasonable likelihood of confusion, and finding that there is a reasonable likelihood of confusion, falls slightly in favour of the Applicant. This ground is therefore unsuccessful.

Non-Entitlement and Distinctiveness Grounds

[81] The Opponent's evidence described in paragraphs 51-52 of this decision is sufficient to meet its evidential burden. While I acknowledge that the state of the marketplace evidence would not be considered (for being post the material dates for non-entitlement and distinctiveness), I nonetheless find that the Applicant has met its legal onus as consumers would be able to distinguish between the Mark and the Opponent's weak trademark by virtue of the differences in the parties' trademarks including in appearance, sound and idea suggested.

Section 30(i) ground of opposition

[82] The Opponent did not file any evidence nor provide any representations with respect to this ground. It is accordingly dismissed.

DISPOSITION

[83] Having regard to the above, and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to the “mineral water” and I reject the opposition with respect to the remainder of the goods pursuant to section 38(12) of the Act.

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

Appearances and Agents of Record

HEARING DATE: 2023-11-02

APPEARANCES

For the Opponent: Stikeman Elliott

For the Applicant: Gowling WLG

AGENTS OF RECORD

For the Opponent: Kevin Graham

For the Applicant: Nathan Piche