



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 021

Date of Decision: 2024-02-01

IN THE MATTER OF AN OPPOSITION

Opponent: Oozex Licensing, LLC

Applicant: Qiwu Technology Co., Ltd.

Application: 1940385 for YOOZ Design

INTRODUCTION

[1] Qiwu Technology Co., Ltd (the Applicant) has applied to register the trademark shown below (the Applied-for Mark):

The logo for YOOZ is centered on the page. It features a large, stylized 'Y' followed by the letters 'OOZ' in a bold, sans-serif font. The 'Y' is composed of three thick, rounded strokes, and the 'OOZ' are also thick and rounded.

[2] The application includes a broad range of goods related to tobacco products and vaping products. A complete list of these goods (the Applied-for Goods) is included in Schedule A to this decision.

[3] Oozex Licensing, LLC (the Opponent) asserts that it owns trademarks consisting of the word OOZE, or stylized versions of that word (the Opponent's Marks). The

Opponent asserts that its trademarks are registered and have been used extensively in association with various products for smoking and vaping, as well as footwear and headwear (the Opponent's Goods). The Opponent's Marks and the Opponent's Goods are listed in Schedule B to this decision.

[4] The Opponent opposes the registration of the Applied-for Mark on several grounds. Most of these ground ultimately turn on the question of whether the Applied-for Mark is confusing with any one of the Opponent's Marks, within the meaning of section 6 of the *Trademarks Act*, RSC 1985, c T-13, as amended (the Act).

[5] For the following reasons, the application is refused.

THE RECORD

[6] The Applicant filed its application on January 11, 2019. In its application, the Applicant claimed to have first used the Applied-for Mark in Canada on August 20, 2018.

[7] The application was advertised for opposition purposes on February 2, 2022. A statement of opposition was filed on April 4, 2022, pursuant to section 38(1) of the Act. A counter statement was filed and served on June 13, 2022.

[8] In support of the opposition, the Opponent relies on the affidavit of Gjergj Sinishtaj, sworn on October 13, 2022 (the Sinishtaj Affidavit). The Applicant did not cross-examine Mr. Sinishtaj, and did not file any evidence in support of the application.

[9] Only the Opponent submitted written representations. No oral hearing was held.

Evidence

[10] Mr. Sinishtaj is Manager of the Opponent, and Corporate Secretary of Ashh, Inc. (Ashh), the Opponent's predecessor in title [Sinishtaj Affidavit, paras 1, 8]. He describes the Opponent as a wholly owned subsidiary of Ashh, and holder of various intellectual property assets, including the Opponent's Marks [para 8]. Ashh, in turn, manufactures and sells a wide range of goods related to smoking and vaping, including the Opponent's Goods [para 7]. According to Mr. Sinishtaj, the Opponent has licenced Ashh

to use the Opponent's Marks in Canada [para 9], and controls the character and quality of the goods sold in association with the Opponent's Marks [para 10].

[11] In his affidavit, Mr. Sinishtaj describes the specific goods Ashh has sold in Canada, in association with the Opponent's Marks, and under licence from the Opponent [paras 20-23]. Mr. Sinishtaj also provides representative images of Ashh's goods sold in Canada, which depict the Opponent's Marks in various ways [para 27, and Exhibit D]. He explains that Ashh's goods do not come pre-filled with substances for smoking such as marijuana, tobacco or nicotine, and can therefore be used to smoke any of these substances [para 21].

[12] The Sinishtaj Affidavit describes the distribution channels through which Ashh's goods are sold in Canada, in association with the Opponent's Marks [paras 12-13, 28-29, and Exhibit E]. It also provides Ashh's sales in Canada over a seven-year period [paras 32-33], and describes the Opponent's advertising and promotional efforts in association with the Opponent's Marks [paras 34-56, and Exhibits G1-Q6].

GROUND OF OPPOSITION

[13] The grounds of opposition raised by the Opponent can be summarized as follows:

- The Non-registrability Ground: the Applied-for Mark is not registrable under section 12(1)(d) of the Act because it is confusing with the Opponent's Marks;
- The Non-entitlement Ground: the Applicant was not entitled to registration of the Applied-for Mark under section 16(1)(a) of the Act, because that trademark was confusing with the Opponent's Marks, which had previously been used in Canada since well prior to the Applicant's claimed date of first use;
- The Non-distinctiveness Ground: the Applied-for Mark is not distinctive of the Applicant, as that term is defined in section 2 of the Act, because it does not distinguish, nor is it adapted to distinguish, the Applicant's goods from the goods and services of others, and more particularly, those of the Opponent;

- The No Use or Proposed Use Ground: pursuant to section 38(2)(e) of the Act, the Applicant was not using and had not used the Applied-for Mark in Canada, and did not propose to use the Applied-for Mark in Canada in association with the goods stated in the application;
- The Non-entitlement to Use Ground: pursuant to section 38(2)(f) of the Act, the Applicant was not and is not entitled to use the Applied-for Mark in Canada in association with the goods stated in the application, because the Applicant was aware, knew or should have known of the Opponent's Marks, the Opponent's rights thereto, and the Opponent's reputation attaching to the Opponent's Marks in Canada. Furthermore, the use of the Applied-for Mark is unlawful as it would contravene sections 7, 20 and 22 of the Act; and
- The Bad Faith Ground: pursuant to section 38(2)(a.1) of the Act, the application was filed in bad faith, since the Applicant had knowledge of the Opponent's Marks, which had been previously used by the Opponent in Canada, and continue to be used in association with the goods stated in the Opponent's trademark registrations.

[14] For each ground of opposition, there is an initial evidential burden on the Opponent to adduce evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition are true. If this initial burden is met, then the Applicant bears the legal onus of satisfying the Registrar that, on a balance of probabilities, the ground of opposition should not prevent registration of the Mark [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)].

NON-REGISTRABILITY GROUND

[15] Since the registration of each of the Opponent's Marks is in good standing, the Opponent meets its initial evidential burden in respect of the Non-registrability Ground. Accordingly, the Applicant bears the legal onus of establishing, on a balance of probabilities, that the Applied-for Mark is not confusing with the Opponent's Marks. The material date for assessing confusion under this ground is the date of this decision [*Simmons Ltd v A to Z Comfort Beddings Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[16] My analysis in respect of this ground will focus on confusion with the Opponent's trademark OOZE (the Opponent's Word Mark), registration No. TMA1100546 (the '546 Registration), which is registered for use in association with "Oral vaporizers for smoking purposes; electronic smoking pipes; tobacco grinders". In my view, this trademark represents the Opponent's best case, since the Opponent's Word Mark does not include design features that differentiate it from the Applied-for Mark, and since the goods stated in this registration partially overlap with the Applied-for Goods.

Test for Confusion

[17] The use of a trademark will cause confusion with another trademark if the use of both in the same area would be likely to lead to the inference that the goods or services associated with the trademarks are manufactured, sold, leased, hired or performed (as the case may be) by the same person [section 6(2) of the Act]. The test for confusion is not about confusion of the trademarks or trade names themselves. Rather, it is about confusion as to the source of goods or services.

[18] The question of confusion is a matter of first impression in the mind of a casual consumer somewhat in a hurry, who sees the applied-for trademark at a time when they have no more than an imperfect recollection of the opponent's trademark. This casual, hurried consumer 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 at para 20].

[19] Applying the test for confusion is an exercise in finding facts and drawing inferences [*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at para 102]. All surrounding circumstances of the case must be considered, including those listed in section 6(5) of the Act, namely:

- the inherent distinctiveness of the trademarks and the extent to which they have become known;
- the length of time the trademarks have been in use;

- the nature of the goods, services or business;
- the nature of the trade; and
- the degree of resemblance between the trademarks, including in appearance or sound or in the ideas suggested by them.

Degree of Resemblance

[20] Despite being the last factor listed in section 6(5) of the Act, the degree of resemblance is the factor that often has the greatest impact on the confusion analysis. Other factors become significant only once the trademarks at issue are found to be identical or very similar [*Masterpiece* at para 49].

[21] I agree with the Opponent's submission (at paragraph 105 of its written representations) that the Opponent's Word Mark and the Applied-for Mark are highly similar in appearance. Both trademarks are single-syllable, four-letter words. Three of the trademarks' four letters are the same, and appear in the same order, namely, 'ooz'. In my view this gives the two trademarks, when viewed as a whole, a fairly high degree of visual similarity. As well, I find that the stylized font used in the Mark does not materially differentiate the overall impression of the Mark from the Opponent's Word Mark. Furthermore, in the absence of evidence to the contrary, I agree with the Opponent that the trademarks would sound nearly identical when sounded.

[22] As for the ideas suggested by the trademarks, there does not appear to be any resemblance. Since there is no evidence that the Applied-for Mark has any meaning in either English or French, or would suggest any particular idea, there can be no similarity with any idea suggested by the Opponent's Mark.

[23] Overall, considering the high degree of resemblance in appearance and sound, and despite the absence of similarity in terms of the ideas suggested, I consider this factor to favour the Opponent.

Inherent Distinctiveness, and Extent Known

[24] Trademarks are inherently distinctive when nothing about them refers the consumer to a multitude of sources. Where a trademark may refer to many things, or is only descriptive of the goods or services at issue, less protection will be afforded the mark [*United Artists Pictures Inc v Pink Panther Beauty Corp*, 1998 CanLII 9052 (FCA), [1998] 3 FC 534, at para 23]. That being said, a trademark that is not inherently distinctive can acquire distinctiveness when it becomes known to the consuming public, for example, through use or promotion of the trademark in the marketplace [see, e.g., *Mondo Foods Co Ltd v TorreMondo Industries Inc*, 2022 FC 926, at para 24].

[25] The Opponent argues that the parties' trademarks are of equal inherent distinctiveness [Opponent's written representations, para 74]. I do not necessarily agree that the trademarks are of *equal* inherent distinctiveness, since the Opponent's Word Mark is a word that is known in the English language, whereas the Applied-for Mark appears to be a coined term. Nonetheless, the parties' trademarks both have a fairly high degree of distinctiveness in association with their respective goods, since neither of the trademarks are descriptive or suggestive of those goods in any way.

[26] Despite having similar degrees of inherent distinctiveness, the Opponent's Marks (including the Opponent's Word Mark) have also acquired a fair degree of distinctiveness by becoming known in the Canadian marketplace to a fair extent, whereas the Applied-for Mark has not. Based on the following portions of the Sinishtaj Affidavit, I am satisfied that the Opponent's Marks have been encountered by, and become known to, a fair number of consumers in the Canadian marketplace:

- in Canada, Ashh sells several types of goods, including the Opponent's Goods, in association with the Opponent's Marks, and under license from the Opponent [paras 9, 10, 20, and 27, and Ex D];
- sales of the Opponent's Goods in Canada have grown from \$27,500 in 2016, to over \$1.3 million in 2021. Total sales of the Opponent's Goods in Canada, from 2016 to the date of the Sinishtaj affidavit, exceed \$4 million [para 33];

- the Opponent's Goods are advertised in Canada in various ways, including by way of websites [paras 37-41, and Exhibits G1-G2, and H1-H2], and by direct personal communication with retailers, providing instructions on how best to sell the Opponent's Goods [paras 42-43];
- the Opponent has spent in excess of \$50,000 on advertising efforts in Canada since 2016 [para 36]. Its websites have been viewed by Canadians over 100,000 times since 2017 [paras 38, 41];
- the Opponent's Goods are also advertised and promoted in association with the Opponent's Marks by way of paid press releases [paras 45-46 and Exhibit J], sponsorship of a music festival in Detroit, Michigan, which is close to the Canadian border [paras 49-50 and Exhibits L-O], attendance at trade shows [para 51], newsletters and email mailing lists [para 52], catalogues, brochures, and in-store displays [paras 53-55 and Exhibit P], and social media content [para 56 and Exhibits Q1-Q6]. I find it likely that at least some Canadian consumers would have encountered the Opponent's Marks through these forms of advertising and promotion. However, since the Sinishtaj Affidavit is either silent with respect to the extent of this advertising, or relies on information from third parties, which is hearsay [paras 50, 56], I am not prepared to draw any meaningful conclusions as to the number of Canadian consumers reached by this advertising and promotion; and
- the Opponent's Goods and the Opponent's Marks have been featured in reviews by the third party Canadian website www.torontovaporizer.ca [para 47-48, and Exhibit K]. Again, I find it likely that at least some Canadian consumers would have encountered these reviews featuring the Opponent's Marks. However, since Mr. Sinishtaj's evidence of the numbers of the third party's Facebook followers, Google reviews and YouTube views is obtained from statements on their website, and is therefore hearsay, I am not prepared to draw any meaningful conclusions as to the number of Canadians who saw these reviews.

[27] As for the Applied-for Mark, in the absence of evidence of use, or any other evidence that would suggest that this trademark has become known in Canada to any

extent, there is no basis for me to conclude that the Applied-for Mark has acquired any distinctiveness in Canada.

[28] Considering all of the foregoing, I am satisfied that this factor favours the Opponent.

Length of Time in Use

[29] In the application, the Applicant claims to have used the Applied-for Mark in Canada since at least August 20, 2018. However, the Applicant has not filed evidence to substantiate this claim. In the absence of evidence, I am not prepared to accept that the Applied-for Mark has been used in Canada since August 20, 2018, or at all. Even if I did, as discussed above the evidence establishes use of the Opponent's Word Mark in Canada since at least 2016. Accordingly, this factor favours the Opponent.

Nature of the Goods and Nature of the Trade

[30] With regard to the nature of the parties' goods, I am in substantial agreement with the Opponent's submissions at paragraphs 91-92 of its written representations. There is partial overlap between the parties' goods, at least in respect of "oral vaporizers for smokers" in the Applied-for Goods, and "oral vaporizers for smoking purposes" stated in the '546 Registration. For those goods that do not directly overlap, the goods are related in that they are for use in smoking or vaping.

[31] As for the nature of the trade, I agree with the Opponent's submissions at paragraphs 96 and 97 of its written representations. In the absence of evidence as to the Applicant's channels of trade, it is reasonable to infer that the parties' overlapping and related goods would likely travel through the same channels of trade.

[32] In view of the foregoing, these factors both favour the Opponent.

Surrounding Circumstance – Family of Marks

[33] In its written submissions, the Opponent asserts that it is the owner of a family of three OOZE Registrations featuring the word "OOZE" as a common element, and that this entitles the Opponent to an expanded scope of trademark protection. The Opponent

asserts that this expanded scope of protection favours the Opponent in the confusion analysis [Opponent's written representations, paras 112-128]. However, it has been held that a family of trademarks consists of several different trademarks that are variations on a theme, such as MACSUNDAY, MCCHEESE and MCFEAST [see *British Columbia Hydro & Power Authority v Union Gas Ltd* (1998), 85 CPR (3d) 231 at para 12 (TMOB)]. A single word or phrase presented in different ways, for example, as a word mark and as a stylized design mark, does not constitute a "family" of trademarks [see *Now Communications Inc v CHUM Ltd* (2003), 32 CPR (4th) 168 at para 35 (TMOB)]. The Opponent's trademark registrations are for trademarks consisting only of the word OOZE, or a stylized version of that word. These trademarks do not constitute a "family" of trademarks, as alleged by the Opponent, such that the Opponent is entitled to a broader scope of protection. Accordingly, I do not consider this to be a factor that favours the Opponent.

Conclusion regarding confusion

[34] Having considered all of the surrounding circumstances of this case, I find that the likelihood of confusion between the Applied-for Mark and the Opponent's Word Mark is, at best for the Applicant, evenly balanced. I make this finding based primarily on the degree of resemblance between the trademarks, the partially overlapping and related goods and channels of trade, and the fair degree of distinctiveness acquired by the Opponent's Marks (including the Opponent's Word Mark) through use. Since the Applicant has not established, on a balance of probabilities, that the Applied-for Mark is not confusing, the Non-registrability Ground is successful.

NON-ENTITLEMENT GROUND

[35] In order to meet its initial burden in respect of this ground, the Opponent must show that the Opponent's Marks were used in Canada prior to the material date for this ground of opposition, and that these trademarks had not been abandoned as of the date of advertisement of the application (February 2, 2022). The material date for this ground is the filing date of the application, namely January 11, 2019, because there is no

evidence that the Applied-for Mark has been used in Canada [sections 16(1)(a) and 16(1)(c) of the Act].

[36] For the reasons stated above in respect of the extent to which the Opponent's Marks have become known, I find that the Opponent has met its initial burden. The evidence demonstrates that the Opponent's Marks were in use prior to January 11, 2019, in association with the Opponent's Goods. The evidence also establishes that the Opponent's Marks were not abandoned as of February 2, 2022, since sales in association with the Opponent's Marks continued past this date, until at least the date of the Sinishtaj Affidavit [para 30].

[37] I also find that the Applicant has failed to meet its legal onus in respect of this ground. As of the material date for this ground of opposition, the likelihood of confusion is at best for the Applicant, evenly balanced. I reach this conclusion for substantially the same reasons that were stated above in respect of the Non-registrability Ground, despite the Opponent's somewhat reduced evidence of acquired distinctiveness as of the material date for this ground. Since the Applicant has not established that the Applied-for Mark is not confusing as of the material date for the Non-entitlement Ground, this ground is successful.

REMAINING GROUNDS OF OPPOSITION

[38] Since two of the Opponent's grounds of opposition have been found to be successful, the remaining grounds need not be addressed.

DISPOSITION

[39] 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.

Jaimie Bordman
Member
Trademarks Opposition Board
Canadian Intellectual Property Office


SCHEDULE A

The Applied-for Goods

Tobacco; Cigarettes containing tobacco substitutes, not for medical purposes; Snuff; Tobacco pouches; Cigarette tips; Tobacco pipes; Cigar cases; Cigarette cases; Pocket-size cigarette rolling machines; Cigarette holders of precious metal; Mouthpieces for cigarette holders; Tobacco jars; Snuff boxes; Ashtrays for smokers of precious metal; Spittoons for tobacco users; Humidors; Matches; Matchboxes; Lighters for smokers; Cigarette filters; Books of cigarette papers; Absorbent paper for tobacco pipes; Cigarette paper; Oral vaporizers for smokers; Cigars; Cigar cutters; Cigar holders; Liquid solutions for use in electronic cigarettes; Electronic cigarettes; Cigarettes; Electronic cigarette cases.

SCHEDULE B

The Opponent's Marks

Trademark	Status App. and Reg. No./ Dates	Goods
	Registered App 30-AUG-2019 App 1995699 Reg 01-SEP-2021 Reg TMA1108200	(1) Batteries, namely, batteries for electronic cigarettes, oral vaporizers for smoking purposes and tobacco and cannabis grinders; battery chargers for electronic cigarettes, oral vaporizers for smoking purposes and tobacco and cannabis grinders (2) Footwear, namely, shoes, boots, sandals and slippers; headwear, namely, hats, beanies visors, and caps; hoodies; shirts (3) Oral vaporizers for smoking purposes; smokers' rolling trays; smoking pipes; tobacco grinders
OOZE	Registered App 30-AUG-2019 App 1988611 Reg 01-SEP-2021 Reg TMA1108110	(1) Batteries, namely, batteries for electronic cigarettes, oral vaporizers for smoking purposes and tobacco and cannabis grinders; battery chargers for electronic cigarettes, oral vaporizers for smoking purposes and tobacco and cannabis grinders
OOZE	Registered App 12-JUL-2018 App 1909166 Reg 20-MAY-2021 Reg TMA1100546	(1) Oral vaporizers for smoking purposes; electronic smoking pipes; tobacco grinders.

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Opponent: Borden Ladner Gervais LLP

For the Applicant: Neomark Ltd.