



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 37

Date of Decision: 2025-02-27

[UNREVISED ENGLISH CERTIFIED TRANSLATION]

IN THE MATTER OF OPPOSITIONS

Opponent: Edible Coast Enterprises Inc.

Applicant: Les Chocolats Favoris Inc.

Requests: 2,088,356 for KOOKY CONES, and
2,162,020 for KOOKY CAKE

INTRODUCTION

[1] Edible Coast Enterprises Inc. (the Opponent) opposes registration of the trademarks KOOKY CONES and KOOKY CAKE (collectively referred to at times as the Mark), the subjects of application Nos. 2,088,356 and 2,162,020, respectively, filed by Les Chocolats Favoris Inc. (the Applicant) in association with ice cream and desserts. The oppositions are based on allegations of confusion between the Mark and the Opponent's GONE KOOKY trademark covering cookies.

[2] For the reasons that follow, the oppositions are rejected.

RECORD OVERVIEW

[3] Application No. 2,088,356 for the trademark KOOKY CONES was filed on March 2, 2021, and was advertised in the *Trademarks Journal* on January 11, 2023.

[4] Application No. 2,162,020 for the trademark KOOKY CAKE was filed on January 25, 2022, and was advertised in the *Trademarks Journal* on January 25, 2023.

[5] The statement of goods for each application for registration, including the Nice classes (CI), is reproduced in Schedule A below.

[6] Statements of opposition were filed on March 2, 2023, under section 38 of the *Trademarks Act*, RSC 1985, c. T-13 (the Act). Unless otherwise indicated, all references to the Act in this decision are to the Act as amended on June 17, 2019.

[7] Each statement of objection cites the following reasons:

- in view of the provisions of sections 38(2)(b) and 12(1)(d) of the Act, the Mark is not registrable because it is confusing with the Opponent's registered trademark GONE KOOKY, registered under No. TMA974,127;
- in view of the provisions of sections 38(2)(c) and 16(1)(a) of the Act, the Applicant is not the person entitled to registration of the Mark because it was confusing with the mark GONE KOOKY, previously used by the Opponent in Canada in association with cookies; and
- in view of the provisions of sections 38(2)(d) and 2 of the Act, the Mark is not distinctive because it does not distinguish nor is it adapted

to distinguish the products of the Applicant from those of the Opponent covered by registration No. TMA974,127.

[8] Counter statements were filed by the Applicant on May 4, 2023.

[9] The parties both submitted evidence summarized below, which I will examine in more detail, as applicable, in the analysis of the grounds of opposition.

[10] Only the Applicant filed written representations. Both parties were represented at the hearing held jointly for both cases.

OVERVIEW OF THE EVIDENCE

[11] In support of its oppositions, the Opponent produced the affidavits of Pete Pretorius and Jeannine Summers. In support of its applications, the Applicant produced the solemn declarations of Émilie Jacques-Brisson and Béatrice Dubois. None of the deponents were cross-examined.

[12] The evidence from both parties is very similar in both cases. The Opponent's evidence is almost identical (the Summers affidavit containing two additional exhibits in the record for application No. 2,088,356), while the Applicant's differs only in the content of the Jacques-Brisson declaration specifically related to the Mark.

Opponent's evidence

The Pretorius affidavit

[13] Mr. Pretorius is the Director of the Opponent [para 1]. He provides some information on the Opponent's activities [paras 2 to 4, exhibits A and B], as well as details on the use of its GONE KOOKY trademark [paras 6 to 13, exhibits D to I].

The Summers affidavit

[14] Ms. Summers is a paralegal with the firm representing the Opponent [para 1]. She filed as evidence the result of her research conducted in the CIPO Canadian Trademarks Database for active registered trademarks with product labels that include: cookies, cakes, pies, and cupcakes; and cookies and ice cream; or cookies and ice cream cones, according to the record [paras 3 to 5, exhibits A and B; and paras 6 and 7, exhibits C and D].

[15] Her affidavit serves to support the Opponent's claim that it is common for companies to offer these products under a single brand.

Applicant's evidence

The Jacques-Brisson declaration

[16] Ms. Jacques-Brisson is legal counsel within the Applicant [para 1]. She provides information on the Applicant's origins and activities [paras 4 to 11, exhibits A-1 to A-3], as well as on the creation, use, and promotion of the Mark [paras 11 to 26, exhibits A-4 to A-6].

The Dubois declaration

[17] Ms. Dubois is a paralegal with the firm representing the Applicant [para 1]. She filed as evidence the results of her online research to determine the meaning of the word "kooky" in various dictionaries [paras 3 to 5, exhibits BD-1 to BD-7].

BURDEN OF PROOF

[18] It is initially up to the Opponent to establish that each of its oppositions is well-founded. Its grounds of opposition must be duly pleaded and it must meet the initial evidentiary burden by adducing sufficient evidence from which it could reasonably be concluded that the facts alleged to support each of these grounds exist. Once that initial burden is met, it is

up to the Applicant to establish on a balance of probabilities that no grounds of opposition prevent the registration of the Mark [see *John Labatt Ltd v Molson Companies Ltd.* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al.* (2002), 20 CPR (4th) 155 (FCA)].

ANALYSIS OF THE GROUNDS OF OPPOSITION

Lack of registrability of the Mark under section 12(1)(d)

[19] I note that registration No. TMA974,127 alleged by the Opponent is still in effect in the Trademark Registry as of my decision. The Opponent has therefore discharged its initial evidentiary burden in each of the cases. Consequently, it is now up to the Applicant to establish on a balance of probabilities that there is no risk of confusion between the Mark and the Opponent's registered mark GONE KOOKY.

Test for confusion

[20] The test for confusion is one of first impression and imperfect recollection. According to section 6(2) of the Act, the use of a trademark causes confusion with another trademark 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 appear in the same class of the Nice Classification.

[21] Section 6(2) of the Act therefore does not deal with confusion between the marks themselves but with the likelihood that the goods or services from one source may be perceived as coming from another.

[22] In determining whether trademarks cause confusion, I must have regard to all the surrounding circumstances, including those listed at 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 they have been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them. This list is not exhaustive and different weight may be assigned to each of these factors depending on the circumstances [*Mattel, Inc v 3894207 Canada, Inc.*, 2006 SCC 22; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al*, 2006 SCC 23; *Masterpiece Inc. v Alavida Lifestyles Inc.*, 2011 SCC 27].

Inherent distinctiveness of the marks and the extent to which they have become known

[23] The trademarks in question have a similar inherent distinctiveness, as they all consist of words from the dictionary and are at least suggestive of the products with which they are associated.

[24] Indeed, the word “cake” refers to cake in both English and French (notably according to the definitions of this term in the *Larousse* and *Collins* online dictionaries), while the English word “cones” (also very similar to its French equivalent) can likely be perceived in a food context as a reference to an ice cream cone.

[25] For its part, although “kooky” is an English word from the dictionary meaning quirky, strange, eccentric, foolish or interesting [Dubois declaration, exhibits BD-1 to BD-7], when pronounced, it is nearly identical to the word “cookie”, which refers to a small cake or biscuit [see the definitions of this term in the *Larousse* and *Collins* online dictionaries; see also *Borden Ladner Gervais v CIBC Mellon Global Securities Services Co.* (2004), 34 CPR (4th) 571 (TMOB) and *Tradall SA v Devil’s Martini Inc.*, 2011 TMOB 65 for the Registrar’s authority to take judicial notice of

dictionary definitions and to consult other dictionaries than those referred to by the parties].

[26] It is also interesting to note in this respect that the Opponent itself sometimes uses the word “*kooky*” descriptively to refer to its cookies (on its website for example in word plays such as “*coconut oat kooky*” and “*cinnamon and spice kooky*” which can also be found near generic descriptions of its crackers such as “*olive oil & cracked pepper cracker*” and “*roasted shallot & herb cracker*”) [Pretorius affidavit, exhibits B and E].

[27] Concerning the extent to which the marks have become known, the evidence presented by the parties should be reviewed. For the Opponent, the Pretorius affidavit essentially states:

- The Opponent produces, sells, and distributes gourmet crackers, cookies, jellies, and antipasti [para 2 to 4, exhibits A and B].
- Since at least June 2017, the Opponent has been using the trademark GONE KOOKY in Canada in association with cookies [para 6] that are, among other things, offered for sale in certain grocery stores and specialty shops including butchers, cheese shops, cafes, wine retailers and vineyards in Alberta, British Columbia, Ontario, Manitoba, and Yukon [para 9, Exhibit F].
- Approximate sales of the Opponent’s GONE KOOKY brand cookies between 2018 and 2023 total, at best, just over one hundred thousand dollars [para 13].

[28] In support of his assertions and his claim that the mark GONE KOOKY is well known in association with cookies, Mr. Pretorius provided, among other things, excerpts from the Opponent’s website (including archived excerpts, the oldest being from 2019) [paras 3, 4, 7 and 9, exhibits A, B, E

and F], excerpts from third-party websites offering the Opponent's cookies for sale [para 10, Exhibit G], images of cookie packaging [para 6, Exhibit D], a summary of deliveries of GONE KOOKY cookies in Canada between 2018 and 2023 [para 11, Exhibit H], and copies of invoices covering that same period [para 12, Exhibit I].

[29] With respect to the extent to which the Mark has become known, the Jacques-Brisson statement essentially states:

- The Applicant operates more than 59 ice cream and chocolate shops located in 3 Canadian provinces, directly or through a network of franchisees; some of its products are also sold to national retailers such as IGA, Costco, Walmart, Maxi, Provigo and Metro, as well as online through its transactional website [para 7].
- Since 2017, the Applicant has developed a series of sweet food products called "kooky", available in various forms in order to distinguish them from its "classic" products. As part of that project, the Applicant began marketing frozen products under the KOOKY CONES brand in June 2017 in the form of ice cream cones dipped in a coating and sprinkled with pieces of cake, candy, or other decorative elements and, beginning in September 2017, desserts under the KOOKY CAKE brand in the form of refrigerated cakes sprinkled with pieces of cake, candy, or other decorative elements [paras 12, 13, 15 and 19, Exhibit A-6].
- These products are sold in the Applicant's ice cream shops, those of its franchisees and through third-party delivery services such as *Uber Eats* and *Door Dash*. The KOOKY CAKE brand cakes are also sold in third-party superstores such as IGA and Metro [para 21].
- Sales of products bearing the Mark have been steadily growing since 2017. In the Applicant's last fiscal year, the sale of ice cream

products associated with the KOOKY CONES mark generated sales of \$5.4 million and the sale of pastry products associated with the KOOKY CAKE mark generated sales of \$3.8 million [para 23].

- The products sold under the Mark have also been the subject of an ongoing promotional campaign since 2017, including through social media [para 25].

[30] In support of her assertions, Ms. Jacques-Brisson supplied, among other things: screen captures from the Applicant's website and promotional material [para 9, Exhibit A-1]; advertising documents explaining the concept of "kooky" products showing, among other things, cakes, pies and/or ice creams [para 14, Exhibit A-4]; screen captures from the menus used by the Applicant showing ice cream cones and the mark KOOKY CONES (projected onto screens in the ice cream and chocolate shops) [para 24, Exhibit A-5]; photographs representative of packaging used for cakes sold for delivery with the mark KOOKY CAKE [para 24, Exhibit A-5], and the inside of the Applicant's ice cream and chocolate shops, including the positioning of the digital menus in the environment of a typical ice cream shop [paras 10 and 24, exhibits A-2 and A-5]; various excerpts from postings on Instagram and Facebook mentioning the Mark and/or cones and cakes respectively associated with it, and the number of followers of the Applicant's Instagram, Facebook and YouTube accounts [paras 25 and 26, Exhibit A-6].

[31] At the hearing, the Opponent raised deficiencies in Ms. Jacques-Brisson's evidence, including mostly undated documents, the absence of tangible elements illustrating the alleged sales (such as invoices), as well as the absence of sales figures broken down by year. The Applicant, for its part, criticized the Opponent's claim of previous use, rightly arguing that it is not supported by the evidence in the record.

[32] In my opinion, the evidence from both parties summarized above is deficient. For example, the parties do not indicate advertising or promotional expenses or statistics related to their websites, and do not provide a breakdown of their respective sales by the various provinces in which they offer their products. Moreover, with respect to the Applicant specifically, Ms. Jacques-Brisson does not provide information on the frequency or extent of promotion carried out on social media, nor on the circulation, exposure, and/or consultation of the promotional material and advertising documents submitted. Her evidence (primarily focused on ice cream cones and cakes) also does not establish use in association with all the goods listed in the application to register the Mark. With respect to the Opponent more specifically, its evidence contains no details on how the GONE KOOKY trademark is promoted, nor any documentary evidence supporting Mr. Pretorius's claim that the Opponent has been using its trademark since 2017. On this last point, I cannot accept the argument put forward by the Opponent at the hearing that *de minimis* use should be recognized since the date of filing of its declaration of use recorded in the trademark register (i.e. June 21, 2017), as such an inference would have required the production of a certificate of authenticity for registration No. TMA974,127 [see *Tokai of Canada v Kingsford Products Company, LLC*, 2018 FC 951, at para 37]. Regardless, the impact of such an inference on my analysis would have been, to say the least, limited.

[33] In short, in the end, I accept that the Opponent's trademark has been in use since 2018 in association with cookies. With respect to the Mark, notwithstanding the submissions made at the hearing, I am also prepared to accept — considering each Jacques-Brisson declaration as a whole — that the Applicant's KOOKY CONES trademark has been in use since June 2017 in association with ice cream cones and that its KOOKY CAKE trademark has been in use since September 2017 in association with cakes. That said, due

to the deficiencies noted above in the evidence from the parties, I am at most prepared to conclude that the marks in question have become minimally known in Canada.

[34] I am therefore of the view that the factor set out in section 6(5)(a) of the Act, which covers both the inherent and acquired distinctiveness of trademarks, does not clearly favour either party.

Length of time in use

[35] In light of the discussion above, the factor set out in section 6(5)(b) of the Act tends to favour the Applicant, as its evidence shows use of the Mark since 2017, as opposed to 2018 in the case of the Opponent.

Nature of the goods and trade

[36] In the record for application No. 2,162,020, to the extent that the wording of the trademarks in question both cover pastries – cakes and cupcakes vs. cookies – there is an overlap between the parties' goods. As both parties sell in grocery stores, there is also an overlap in their channels of trade.

[37] In application No. 2,088,356, the goods at issue differ more and the evidence shows that the Applicant only sells its cones in its ice cream shops and those of its franchisees, and through delivery services. That said, the parties' goods remain connected (I note, for example, that the Applicant decorates some of its ice cream cones with cookies in addition to offering ice cream cookies [Jacques-Brisson declaration, exhibits A-4 and A-5]) and the Applicant's application for registration and the Opponent's registration do not contain any restrictions.

[38] I am therefore of the view that, overall, the factors set out in sections 6(5)(c) and (d) of the Act favour the Opponent.

Degree of resemblance

[39] The degree of resemblance between trademarks is often likely to have the greatest effect on the confusion analysis [see *Masterpiece*, supra, at para 49].

[40] Moreover, as previously mentioned, it is well established in the case law that likelihood of confusion is a matter of first impression and imperfect recollection. In this regard, while the marks must be assessed in their entirety (and not dissected), it is still possible to focus on particular features of the mark that may have a determinative influence on the public's perception [see *Pink Panther Beauty Corp v United Artists Corp* (1998), 80 CPR (3d) 247 (FCA), at para 34]. While the first word may, for purposes of distinctiveness, be the most important in some cases, the preferable approach when examining the degree of resemblance is to first consider whether there is an aspect of the trademarks that is particularly striking or unique [see *Masterpiece*, supra, at para 64].

[41] The Opponent argues that the marks at issue are very similar, the main and most striking element of each being the word "kooky" given the eccentricity or extravagance it evokes and its uniqueness in relation to the products.

[42] In my opinion, the most striking aspect of the Opponent's brand is GONE KOOKY, namely the trademark as a whole, including the ideas it suggests. For the Mark, I consider that it is also the trademark as a whole that constitutes the most striking aspect, namely the combination of the words KOOKY and CONES/CAKE, a combination that stands out even more due to the alliteration it creates, the successive repetition of the "k" sound.

[43] I come back to the fact that, phonetically, the word "kooky" can be perceived as referring to cookies. It is not excluded that, visually, consumers

would perceive it in this way (i.e. as a reference or a nod to the word “cookie” for the French-speaking consumer and as a play on words inspired by the word “cookie” for the English-speaking or bilingual consumer). That assumption could at least to some extent be supported by the fact that the Applicant uses cookies to decorate some of its cones, as well as the fact that the Opponent uses “*kooky*” descriptively in its evidence to refer to its cookies (as described in paragraph 26 above). In this sense, the word “*kooky*” would therefore have nothing unique in association with the parties’ goods. Moreover, although it helps to contextualize the ideas conveyed by the marks in question, these ideas remain distinct. For example, although the Mark may suggest strange/eccentric cones or cakes, it could also be perceived as referring to cones or cookie cakes. The Opponent’s GONE KOOKY brand, on the other hand, suggests a person who has become strange/eccentric or the act of becoming strange/eccentric, but could just as easily be perceived as referring to a person who has opted for or gone toward a cookie (by choice or against their will) or the fact that this has occurred.

[44] In short, I agree that there is a resemblance between the marks at issue insofar as the word “*kooky*” appears in each one. Despite that, and notwithstanding the Opponent’s claims at the hearing, it seems to me that there are just as many differences between them given the differences between the words “cones” [“*cônes*” in French], “cake” and “gone” [“*allé*,” “*passé*” or “*devenu*” in French] that they respectively incorporate, differences in their structure, and the alliteration only present in the Mark. In other words, I am not satisfied that any of the Applicant’s marks are very similar to the Opponent’s trademark.

Conclusion on the likelihood of confusion

[45] As stated in *Dion Neckwear*, supra, at page 163, the Registrar does not need to be satisfied beyond doubt that confusion is unlikely. Indeed, “should the ‘beyond doubt’ standard be applied, applicants would, in most cases, face an unsurmountable burden because certainty in matters of likelihood of confusion is a rare commodity.” [See also *John Labatt Ltd v Molson Companies Ltd.*, supra].

[46] Following my assessment of all the factors set out in section 6(5) of the Act, I am of the view that the Applicant has discharged its legal onus of establishing on a balance of probabilities that there is no likelihood of confusion between the Mark and the Opponent’s GONE KOOKY trademark (No. 974,127).

[47] In this respect, the fact that none of the marks at issue is particularly strong combined with the differences between them visually, phonetically, and in terms of ideas suggested appears to me to be sufficient to offset the factors that favour the Opponent in this case.

[48] I therefore reject the ground of opposition based on section 12(1)(d) of the Act in each case.

Remaining grounds summarily rejected

[49] With respect to the ground based on the lack of registrability, the Opponent has only partially discharged its burden with respect to the goods covered by the Applicant’s applications for registration other than ice cream cones and cakes). Regardless, even if, for the purposes of discussion, I were to accept that the Opponent had fully discharged its initial evidentiary burden, I would nonetheless conclude in each case that the Applicant had discharged its legal onus of establishing that there was no reasonable likelihood of confusion between the Mark and the Opponent’s GONE KOOKY

trademark (both in the dates of first use for the Applicant's ice cream cones and cakes, and the dates on which its applications for registration were filed for the rest of the goods covered in them). In other words, I am of the view that the various relevant dates here would not significantly and decisively affect my analysis of the ground based on the Mark's lack of registrability. I therefore reject the ground of opposition based on section 16(1)(a) of the Act in each case.

[50] With respect to the non-distinctiveness ground, the Opponent did not discharge its initial evidentiary burden. As is clear from my discussion above of the Pretorious affidavit, although I concluded that there was use of the GONE KOOKY trademark, the Opponent's evidence contains deficiencies that prevent me from concluding that that mark had become known at the date when the statement of opposition was filed to the extent required by jurisprudence to affect the distinctiveness of the Mark [see *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657, at paras 25 to 34 for discussion of the Opponent's evidentiary burden]. I also reject the ground of opposition based on section 2 of the Act in each case.

DISPOSITION

[51] In the exercise of the powers delegated to me under the provisions of section 63(3) of the Act, I reject the opposition to each of the applications for registration Nos. 2,088,356 and 2,162,020 pursuant to section 38(12) of the Act.

Iana Alexova
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Certified translation
Gerald Woodard

SCHEDULE A

Statement of goods for application No. 2,088,356

CI 30 (1) *Ice cream cones; ices and ice creams.*

Statement of goods for application No. 2,162,020

CI 30 (1) *Desserts, namely cakes, pies, cupcakes and yule log cakes in individual portions or for sharing.*

Appearances and Agents of Record

HEARING DATE: 2024-10-08

APPEARANCES

For the Opponent: Mihaela Hutanu

For the Applicant: Caroline Henrie

AGENTS OF RECORD

For the Opponent: Oyen Wiggs Green & Mutala LLP

For the Applicant: Norton Rose Fulbright Canada LLP / S.E.N.C.R.L., S.R.L.