



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2012 TMOB 129
Date of Decision: 2012-07-17

**IN THE MATTER OF AN OPPOSITION
by Hershey Canada Inc. to application
No. 1,410,631 for the trade-mark OH
FUDGE in the name of Chantelle
Gorham**

[1] On September 15, 2008, Chantelle Gorham (the Applicant) filed an application to register the trade-mark OH FUDGE (the Mark). The application is, at this point of time, based on use of the Mark in Canada since May 20, 2001 in association with the following wares and services: brittle, candy and fudge; sale and manufacture of brittle, candy, and fudge.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of July 15, 2009. On December 15, 2009, Hershey Canada Inc. (the Opponent) filed a statement of opposition against the application. The Opponent has pleaded grounds of opposition pursuant to sections 38(2)(a), (b), (c) and (d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The Applicant filed and served a counter statement.

[3] In support of its opposition, the Opponent filed two affidavits of Barbara Gallagher plus an affidavit of Martha Cecil-Few. In support of its application, the Applicant filed her own affidavit. As reply evidence, the Opponent filed an affidavit of Susan Burkhardt. No cross-examinations were conducted.

[4] Both parties filed a written argument. I note that the Applicant's written argument improperly includes allegations of facts that were not contained in any evidence; I am disregarding those portions of the written argument.

[5] An oral hearing was held, in which only the Opponent participated.

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[6] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. 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 [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Section 38(2)(a)/30(b) Ground of Opposition

[7] The Opponent has pleaded that the application does not comply with section 30(b) of the Act for two reasons: (i) the Applicant has not used the alleged mark since the date claimed in the application, or at all, in association with wares or services and (ii) the Applicant has not used the alleged mark as a trade-mark.

[8] An opponent's evidential burden is lighter respecting the issue of non-conformance with section 30(b) of the Act since the facts are best known to the applicant [*Tune Masters v Mr. P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89] and an opponent's evidential burden can be met by reference to the applicant's own evidence [*Labatt Brewing Co v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD) at 230].

[9] Ms. Gorham's affidavit contains only three paragraphs, which are reproduced below:

1. I am the sole proprietor of Northwest Fudge Factory and as such I have knowledge of the fact hereinafter set forth as the result of personal knowledge or through the records of Northwest Fudge Factory.
2. Northwest Fudge Factory has used the said trademark as shown by their business vehicle licence plate 'OH FUDGE' as of December 2001. See Exhibit A-1. Vehicle Registration listing the Applicant and the Ontario plate 'OHFUDGE' applied as 'OH FUDGE' on the plate.

3. Northwest Fudge Factory has used the said trademark as shown by their business phone number which is 1-866 OH FUDGE. The numerical translation is 1-866-643-8343 as shown on the phone statement (Exhibit A-2) dated January 1, 2009.

[10] It is noted that Ms. Gorham has not made any reference in her affidavit to the date of first use claimed in the application, namely May 20, 2001. She claims to have used the Mark in two ways, through the appearance of the words OH FUDGE on a licence plate and by the ownership of a numerical phone number. However, she has not claimed that such “use” was occurring as of May 20, 2001 [Exhibit A-1 is dated 08/02/19], nor has she explained how such “use” would qualify as use of the Mark in accordance with either wares or services under section 4 of the Act.

[11] I do not see how the facts set out in Ms. Gorham’s affidavit could qualify as use of the Mark in accordance with wares as per section 4 of the Act. I also note that Ms. Gallagher provided a copy of the Trade-marks Office’s file for the present application which reveals that when the application was filed on September 15, 2008 it claimed proposed use of the Mark for the wares, in addition to use since May 20, 2001. Furthermore, the Applicant’s counter statement includes the statement, “The Applicant bases its application on the grounds that they are registering the trademark ‘OH FUDGE’ for future use in conjunction with the applicants registered trade name of ‘NORTHWEST FUDGE FACTORY’.”

[12] If I were to accept that the appearance of the Mark on a licence plate could qualify as use of the Mark in association with the applied for services, there is evidence from Ms. Burkhardt that the OH FUDGE licence plate was not being used by the Applicant as of the claimed date of May 20, 2001. Ms. Burkhardt conducted a Plate History Search for OHFUDGE on the Service Ontario website. The plate history indicated: the first registration date for OHFUDGE was December 1, 2003 to Christopher Paul Cochrane but it was not attached to any vehicle; the first reference to OHFUDGE being attached to any vehicle was on January 21, 2004, to a vehicle owned by Vernell Gorham; on February 15, 2008 OHFUDGE was registered to Chantelle Gorham and on February 19, 2008 it was attached to a 2007 white Dodge pick-up. In addition, I note that the Applicant admitted in its written argument that Ms. Gorham was mistaken when she attested that the plate was purchased in 2001.

[13] I turn now to the evidence of the use of a telephone number that can be interpreted as including OH FUDGE. There is no evidence from Ms. Gorham that 1-866-OH FUDGE ever appeared in writing; the invoice from Bell that she provides dated January 1, 2009 refers to 1-866-643-8343, not to 1-866-OH FUDGE. Oral use of a trade-mark does not satisfy the requirements of section 4 for either wares or services [*Ronald S Ade v Cavern City Tours Ltd*, 2012 TMOB 70]. Ms. Gallagher evidenced that 1-866-OH-FUDGE did appear on the Applicant's website in 2010. However, she also evidenced that the website was only registered in 2002 and that the first reference to the phone number 1-866-OH-FUDGE appeared on the website in 2004. Thus there is no evidence of use of 1-866-OH-FUDGE in print as of the claimed date of first use; moreover, there is the issue of whether the display of 1-866-OH-FUDGE would qualify as use of OH FUDGE *simpliciter* when the words OH-FUDGE appear in the same size and font as 1-866- [see *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)].

[14] Considering the evidence as a whole, I find that the Opponent has raised sufficient doubt concerning the veracity of the Applicant's claimed date of first use to meet its light initial burden. The Applicant has not filed evidence that satisfies its legal burden. Therefore the section 30(b) ground succeeds.

Section 38(2)(b)/12(1)(d) Ground of Opposition

[15] The Opponent has pleaded that the Mark is not registrable pursuant to section 12(1)(d) of the Act because it is confusing with one or more of the following trade-marks that have been registered by the Opponent primarily for candy and related advertising services:

1. OH HENRY! - registration No. TMDA038,673
2. OH HUNGRY? OH HENRY! - registration No. TMA483,528
3. OH! J'AI FAIM - registration No. TMA483,664
4. OH HUNGRY? - registration No. TMA501,487
5. OH! J'AI FAIM - registration No. TMA447,453

6. OH! J'AI FAIM & Design - registration No. TMA447,827
7. OH HUNGRY? & Design – registration No. TMA466,130
8. OH! Design – registration No. TMA479,669.

[16] The material date for assessing a section 12(1)(d) ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)]. As each of the above registrations is extant, the Opponent has met its initial burden under section 12(1)(d).

[17] I will focus my analysis on the likelihood of confusion between OH FUDGE and OH HENRY!, since OH HENRY! is the oldest of the marks from which the Opponent's other OH marks appear to have evolved.

[18] Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class. The test for confusion is one of first impression and imperfect recollection.

[19] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC), *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC).]

[20] The OH HENRY! mark is inherently distinctive, as nothing about it suggests candy. The Mark is less inherently distinctive as it includes the name of one of the Applicant's wares.

[21] A mark's distinctiveness can be enhanced through use and promotion. The extent to which the Mark may have become known has not been evidenced. In contrast, there is evidence that the Opponent has spent millions of dollars advertising its OH HENRY! line of products and has sold hundreds of millions of dollars worth of such products in Canada.

[22] Registration No. TMDA038,673 is dated October 10, 1925 and it is clear from the evidence that the OH HENRY! mark was in use long before the Applicant's claimed date of first use.

[23] Both parties sell candy in association with their wares and there is no reason to assume that their channels of trade could not be the same or similar.

[24] Clearly there are differences between OH HENRY! and OH FUDGE. However, it is the first component of a mark that is typically considered more important for the purpose of distinction and here both marks begin with OH. Moreover, it is noted that there is no evidence that others use marks in the candy/confectionery industry that start with OH. Instead there is evidence that the Opponent has adopted, used and registered a number of marks in association with candy that begin with OH.

[25] I note that at paragraph 3, Ms. Cecil-Few, the Opponent's Vice-President, states:

The original formula for the OH HENRY! candy bar, a formulation that is still being sold, is a combination of peanuts, caramel and fudge in a chocolate coating. This formulation has been extensively sold across Canada. The OH HENRY! bar has also been made in other formulations, including a white chocolate formulation, a peanuts, caramel and peanut butter formulation, and an OH HENRY! Chocolate Fudge formulation, among others. For an example of the OH HENRY! Chocolate Fudge packaging, please see Exhibits A-3 and A-4 attached.

[26] The packaging in Exhibits A-3 and A-4 prominently display the words CHOCOLATE FUDGE immediately below OH HENRY! The fact that fudge is a key component of the Opponent's wares reinforces the position that the appearance of the descriptive word "fudge" in the Mark is not a strong basis on which to distinguish the parties' products.

[27] I note that in its written argument, the Applicant states that she "believes that the said trademark [OH FUDGE] is in reference to a commonly used English colloquialism referring to a

slang term.” However, there is no evidence of any such slang term. Moreover, I have exercised the Registrar’s discretion to check *The Canadian Oxford Dictionary* and found no entry for such a term. Therefore, I do not accept that the idea suggested by the Mark is other than that created by a combination of the ordinary meanings of the words “oh” and “fudge”.

[28] The fact that the second portion of the Mark is a descriptive word means that its distinctiveness derives largely from its first word, which of course is what it has in common with the Opponent’s mark.

[29] As a further surrounding circumstance, I note that Exhibit G-1 of the Cecil-Few affidavit shows how the Opponent uses its OH & Design mark in association with its confectionery separate and apart from its OH HENRY! mark (see also Exhibits A-12 and A-17 of the Cecil-Few affidavit and Exhibits I-3 and I-4 of the Gallagher No. 2 affidavit re the Opponent’s use of other OH design marks).

[30] Having considered all of the surrounding circumstances, I have concluded that the Applicant has not met its legal onus with respect to the issue of the likelihood of confusion. I find that there is a reasonable probability of confusion between the marks as a result of the substantial reputation that the Opponent has acquired in association with OH HENRY!, as well as a series of other OH prefix marks in the confectionery industry. The Applicant is seeking to register a mark that begins with OH in association with confectionery and related services. If there is doubt whether the registration of a trade-mark would cause confusion with a prior mark, the doubt must be resolved against the newcomer.

[31] For the foregoing reasons, the section 12(1)(d) ground of opposition succeeds based on registration No. TMDA038,673.

Remaining Grounds of Opposition

[32] As I have already maintained the opposition under two grounds of opposition, I see no need to address the outstanding grounds. I note however that the remaining grounds of opposition all turn on the issue of confusion between the parties’ marks and the Applicant’s position is no stronger under those grounds than it is under the section 12(1)(d) ground.

Disposition

[33] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Jill W. Bradbury
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office