



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

Citation: 2011 TMOB 206
Date of Decision: 2011-10-31

IN THE MATTER OF OPPOSITIONS
by International Paper Company to
application No. 1,273,178 for the trade-
mark INTERNATIONAL PAPER
INDUSTRIES and application No.
1,273,979 for the trade-mark
INTERNATIONAL PAPER
INDUSTRIES and Design

[1] On September 23, 2005, Halton Recycling Ltd. (the Applicant), filed an application for the trade-mark INTERNATIONAL PAPER INDUSTRIES, based upon proposed use of the trade-mark in Canada. On September 29, 2005, the same Applicant filed an application for the trade-mark INTERNATIONAL PAPER INDUSTRIES and Design (shown below), also based upon proposed use in Canada. Both of these applications will be referred to together as the Marks where appropriate.



[2] The statement of wares/services for the Marks currently reads:

WARES:

Recycling boxes; Garbage cans; Organic fertilizers.

SERVICES:

Recycling services, namely collecting, sorting, transporting, processing and promoting public awareness of the need for the use of recyclables through the sale of recyclable products; Waste management and disposal services; Design and implementation of recycling programs; Operation of material recovery facilities; Waste management collection, transportation and disposal services; Rental and lease of recycling and waste receptacles; Recycling services namely collecting, sorting, transporting, processing and promoting public awareness of the need for the use of recyclables through the sale of yard waste, rubber and organic products.

[3] The first application was advertised for opposition purposes in the *Trade-marks Journal* of March 26, 2008, and the second application was advertised in the *Trade-marks Journal* on June 11, 2008.

[4] International Paper Company (the Opponent) filed a statement of opposition against the first application on August 25, 2008, and against the second application on October 28, 2008. The grounds of opposition in each case are that the Applicant's applications do not conform to the requirements of s. 30(b) and 30(i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), the Marks are not registrable pursuant to s. 12(1)(d), the Applicant is not the person entitled to registration of the Marks pursuant to s. 16(3)(a) and (c), and the Marks are not distinctive. The third, fourth, and sixth grounds of opposition in each case are based on confusion with the following trade-marks of the Opponent: INTERNATIONAL PAPER, registration No. TMA695,900; INTERNATIONAL PAPER and Design, registration No. TMA695,899 (shown below); INTERNATIONAL PAPER, registration No. TMA135,665; and INTERNATIONAL PAPER and Design, registration No. TMA374,761 (shown below). The s. 16(1)(c) ground in each case is based on confusion with the Opponent's trade-names International Paper Company or International Paper.



registration No. TMA695,899



registration No. TMA374,761

[5] The Applicant filed and served a counter statement in each opposition in which it denied the Opponent's allegations.

[6] As its evidence in each case the Opponent filed the affidavit of Barbara Gallagher, law clerk with the Opponent's firm, attached to which were certified copies of each of the Opponent's above noted registrations. The Applicant's evidence in each case consists of the affidavit of Dulce Campos, trade-mark searcher for the Applicant's agent.

[7] Only the Applicant filed a written argument in each case and an oral hearing was not requested for either case.

Onus and Material Dates

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is, however, an initial 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 Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

[9] The material dates that apply to the grounds of opposition in each case are as follows:

- s. 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- s. 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 16(3) - the filing date of the application [see s. 16(3)];
- non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Section 30(b) Ground

[10] The Opponent pleaded in both of its statements of opposition that each application did not conform to the requirements of s. 30(b) of the Act. The Opponent submits that both marks had been used in Canada in association with the claimed wares and services as of the filing date of the applications but no claimed date of first use was identified in either application.

[11] The Opponent did not file any evidence however, that at the time of filing its applications the Applicant was already using the Marks. Further, the Applicant did not file any evidence which the Opponent could rely on to support its allegation. This ground is therefore dismissed in both cases.

Section 30(i) Ground

[12] Regarding the s. 30(i) grounds of opposition, I note that the Applicant has made the requisite statements in each application and there is no evidence that it did so in bad faith [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. I will add that even if the Applicant was aware of the existence of the Opponent's marks, this would not have precluded the Applicant from being satisfied that it was entitled to use the Marks in

Canada on the basis, *inter alia*, that it did not consider the Marks to be confusing with any of the Opponent's marks. This ground is therefore unsuccessful in both cases.

Section 16 and s. 38(2)(d) Grounds of Opposition

[13] The Opponent has not met its initial burden with respect to the s. 16(3) grounds and s. 38(2)(d) grounds in both oppositions, because it has not evidenced that any of its marks or names were used or made known in Canada prior to the filing dates of the applications or the filing dates of the statements of opposition. As noted above, the only evidence of the Opponent is the affidavit of Ms. Gallagher which introduces as exhibits particulars of the Opponent's registered marks. It has been previously held that, where the only evidence consists of certified copies of the opponent's registrations, the Registrar will assume only *de minimus* use of the opponent's trade-marks [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.)]. Therefore the filing of certified copies of the Opponent's registrations in the present cases will not support the Opponent's evidential burden with respect to its grounds of opposition based on allegations of non-entitlement or non-distinctiveness. These grounds are therefore dismissed in both cases.

Section 12(1)(d) Ground

[14] The s. 12(1)(d) grounds of opposition turn on the issue of the likelihood of confusion between the Marks and each of the Opponent's registered marks. The Opponent's initial burden with respect to the s. 12(1)(d) grounds has been satisfied because all of its registrations are in good standing.

Trade-mark	Registration No.	Wares
INTERNATIONAL PAPER	TMA695,900	Paper for printing, publication, reproduction, copying, faxing, writing and drawing; paperboard, linerboard, cardboard, corrugated cardboard, containerboard and packaging materials and products made therefrom namely boxes, containers, blanks and cartons.

INTERNATIONAL PAPER & Design	TMA695,899	Paper for printing, publication, reproduction, copying, faxing, writing and drawing; paperboard, linerboard, cardboard, corrugated cardboard, containerboard and packaging materials and products made therefrom namely boxes, containers, blanks and cartons.
INTERNATIONAL PAPER	TMA135,665	Paper, paper board, and articles made therefrom namely treated, reinforced and impregnated paper and paper board; cellulose pulp.
INTERNATIONAL PAPER & Design	TMA374,761	Pulp, namely cellulose pulp, wood pulp, paper pulp and regenerated pulp, and egg cartons, and sheet and formed material made of raw pulp; paper, paperboard, and articles made therefrom namely packaging and wrapping materials, treated, reinforced and impregnated paper and paperboard, stationery, corrugated products, newsprint, plastic coated paper containers; lumber and plywood for building purposes non-woven fabrics for use as a cloth substitute in institutional, commercial, industrial, domestic, general and special applications.

test for confusion

[15] The test for confusion is one of first impression and imperfect recollection. 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. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks or trade-names 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 or trade-names 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 C.P.R. (4th) 321 (S.C.C.) and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401].

[16] Recently, in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 96 C.P.R. (4th) 361 (S.C.C.), the Supreme Court of Canada discussed the importance of the s. 6(5)(e) factor in conducting an analysis of the likelihood of confusion between the parties' marks in accordance with s. 6 of the Act:

...the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis ... if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar... As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start...

[17] In view that the Court stated that the most significant factor for the confusion analysis is often the degree of resemblance between the marks, my confusion analyses shall begin with this factor.

s. 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[18] It is a well-accepted principle that the first portion of a trade-mark is the most relevant for the purposes of distinction [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)]. It has also been held, however, that when the first or dominant portion of a mark is a common descriptive word, its importance diminishes [see *Conde Nast Publications, supra*, at 188; *Vancouver Sushiman Ltd. v. Sushiboy Foods Co.* (2002), 22 C.P.R. (4th) 107 (T.M.O.B.)].

[19] In the present case, the Applicant has incorporated both word portions of the Opponent's marks in their entirety as the beginning portion of both of its marks. While both the words "international" and "paper" may be common, descriptive words, so is the word "industries". I therefore do not consider the addition of the non-distinctive word INDUSTRIES at the end of the word portions of the Applicant's marks, sufficient to distinguish the Applicant's marks from

those of the Opponent. Nor do I consider the Applicant's design sufficient to distinguish its design marks from those marks of the Opponent. I therefore find a high degree of resemblance between the Marks and the Opponent's marks in all respects.

s. 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

[20] All of the parties' marks are inherently weak in relation to their wares and services. The Applicant's design mark is slightly more inherently distinctive than the Opponent's marks, however, because of its design component. In this regard, the Applicant's design mark consists of the stylized design of the acronym IPI encircled with two chasing arrows with the letter "W" shown in the background of the design (all of which is depicted on the left of the words INTERNATIONAL PAPER INDUSTRIES). This is different from the Opponent's design marks wherein an encircled triangular design possibly representing a tree appears in between the words INTERNATIONAL and PAPER.

[21] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. Neither party has provided evidence of use of any of its marks. I therefore cannot conclude that any of the marks have become known to any extent in Canada.

s. 6(5)(b) - the length of time each trade-mark has been in use

[22] The Applicant has not filed any evidence of use of either of its marks. As for the Opponent, as previously noted, the filing of certified copies of registrations can only support an assumption of *de minimus* use of the registered trade-marks [see *Entre Computer Centers, Inc. v. Global Upholstery Co., supra*]. This factor therefore does not support either party.

s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

[23] It is the Applicant's statement of wares as defined in its applications versus the Opponent's registered wares and services that govern my determination of this factor [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)].

[24] The Opponent's wares include, *inter alia*, paper, cardboard, pulp, packaging and forestry products including building materials, containerboard and packaging materials and products made therefrom namely boxes, containers, blanks and cartons. The applied for wares include recycling boxes, garbage cans and organic fertilizers and the applied for services include, *inter alia*, recycling and waste management services. While the Opponent claims in both of its statements of opposition that its business is fibre recycling with recovered fibre forming an integral part of many of the Opponent's products sold in association with its marks, I cannot consider this claim as it has not been supported by the evidence.

[25] In my view, the Opponent's containerboard and packaging materials and products made therefore namely boxes, containers, blanks and cartons are related to the Applicant's recycling boxes and garbage cans as all of these items are types of receptacles. The channels of trades for these wares would therefore presumably overlap.

[26] With respect to the Applicant's services, however, I agree with the Applicant that the Opponent's wares are not related to the recycling and waste management services of the Applicant. It follows that the channels of trades for these services would not overlap. I will add that had the Opponent provided evidence that recycled fibre forms an integral part of many of the Opponent's products sold in association with its marks, my conclusion under s. 6(5)(c) and (d) with respect to the Applicant's services may have been different since the Applicant's recycling services include promoting the use of recyclables through the sale of recyclable products.

Surrounding Circumstances

[27] As a surrounding circumstance, I have considered the Applicant's state of the register evidence.

[28] State of the register evidence is usually introduced to show the commonality of a mark or a portion of a mark in relation to the register as a whole. Since it is only relevant insofar as one can make inferences from it about the state of the marketplace, it should be comprised of marks which include both the applied for mark or portion of the applied for mark and that are used with wares or services similar to those at issue [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41

C.P.R. (3d) 432; *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.).

[29] In her affidavit, Ms. Campos states that she conducted searches on the Canadian trade-marks database for trade-marks containing the term “international” and “paper” incorporated in a mark. She also searched for trade-marks containing the word “international” in association with pulp, paper, cardboard, carton and/or boxes related wares or services.

[30] The first search conducted by Ms. Campos only revealed two third party registered marks which incorporate the words “paper” and “international” in the same mark. In the absence of evidence of use, the existence of two relevant registrations is insufficient to allow me to make any conclusions about the marketplace.

[31] The second search conducted by Ms. Campos did locate a sufficient number of trade-marks which incorporated the term “international” in association with the wares “pulp”, “paper”, “cardboard”, “carton” and/or “boxes” to enable me to infer that the word INTERNATIONAL is broadly used in the marketplace in association with wares similar to those at issue.

[32] The Applicant’s evidence establishes to some extent that the Opponent is not entitled to a wide ambit of protection for its registered trade-marks. However, I consider the degree of resemblance between the marks at issue in both cases to be so high that the commonality of marks beginning with the component INTERNATIONAL in the marketplace does not necessarily reduce the likelihood of confusion.

conclusion re likelihood of confusion

[33] 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 Applicant’s INTERNATIONAL PAPER INDUSTRIES or INTERNATIONAL PAPER INDUSTRIES and Design trade-marks on the applied for wares and services at a time when he or she has no more than an imperfect recollection of the Opponent’s INTERNATIONAL PAPER and INTERNATIONAL PAPER and Design trade-marks, and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot*].

[34] In view of my findings above, and in particular the resemblance between the parties' marks and wares, and notwithstanding the common use of INTERNATIONAL prefixed marks in the relevant marketplace, it seems to me that such a consumer would, as a matter of first impression, assume that the INTERNATIONAL PAPER INDUSTRIES and INTERNATIONAL PAPER INDUSTRIES and Design wares and services share the same source as the INTERNATIONAL PAPER and INTERNATIONAL PAPER and Design wares. I therefore find that the ground of opposition based upon s. 12(1)(d) of the Act succeeds in both cases.

Disposition

[35] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the Applicant's applications pursuant to s. 38(8) of the Act.

Cindy R. Folz
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office