



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

Citation: 2014 TMOB 237
Date of Decision: 2014-10-31

**IN THE MATTER OF AN OPPOSITION
by Kruger Products L.P. to application
No. 1,530,217 for the trade-mark
FORMAT AU CHOIX in the name of
Cascades Canada ULC**

[1] Kruger Products L.P. (the Opponent) opposes registration of the trade-mark FORMAT AU CHOIX (the Mark) that is the subject of application No. 1,530,217 by Cascades Canada ULC (the Applicant).

[2] Filed on June 2, 2011, the application is based on use of the Mark in Canada since at least as early as June 1, 2011 in association with “essuie-tout”.

[3] The Opponent alleges that: (i) the application does not conform to section 30(i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act); (ii) the Mark is not registrable under section 12(1)(d) of the Act; (iii) the Applicant is not the person entitled to registration of the Mark; and (iv) the Mark is not distinctive under section 2 of the Act. Aside from the non-conformity ground, the opposition turns on the likelihood of confusion between the Mark and the Opponent’s trade-marks.

[4] For the reasons that follow, the application ought to be refused.

The Record

[5] The Opponent filed its statement of opposition on September 11, 2012. The Applicant then filed and served its counter statement on November 30, 2012, denying all of the grounds of opposition alleged in the statement of opposition.

[6] In support of its opposition, the Opponent filed the affidavit of Wendy Mommersteeg, Director, Paper Towel Category, of the Opponent, the affidavit of David Morrison, a student-at-law employed by the Opponent's trade-marks agent, as well as the affidavit of Mary P. Noonan, a trade-mark searcher employed by the Opponent's trade-marks agent. In support of its application, the Applicant filed the statutory declaration of Steven Bento, an articling student employed by the Applicant's trade-marks agent. None of the affiants, or the declarant, were cross-examined.

[7] Both parties filed written arguments and were represented at a hearing.

The Parties' Respective Burden or Onus

[8] 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 Ltd v Molson Companies Ltd.* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Analysis of the Grounds of Opposition

Is the Mark Confusing with the Opponent's Registered Trade-marks?

[9] In its statement of opposition, the Opponent alleges that the Mark is not registrable pursuant to section 12(1)(d) of the Act, on the ground that it is confusing with each of the Opponent's registered trade-marks, set out in Schedule "A" to this decision, and collectively as a family of marks (the CHOOSE-A-SIZE Marks).

[10] The material date for considering this issue 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)].

[11] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if the registration relied upon is in good standing. The Registrar has the discretion to check the register in order to confirm the existence of the registration relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[12] Having exercised the Registrar's discretion, I confirm that the Opponent's registration Nos. TMA523,150, TMA600,913, TMA602,088, TMA684,154 and TMA782,175 are in good standing.

[13] Since the Opponent has satisfied its initial evidential burden, the issue becomes whether the Applicant has met its legal burden to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and any of the Opponent's CHOOSE-A-SIZE Marks.

[14] For the reasons that follow, I accept this ground of opposition and decide this issue in favour of the Opponent.

The 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.

[16] 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 *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion].

[17] Comparing the Mark and the word mark MESURE-AU-CHOIX (TMA602,088) will effectively decide the section 12(1)(d) ground of opposition. In other words, if confusion is not likely between the Mark and MESURE-AU-CHOIX, then it would not be likely between the Mark and any of the Opponent's other CHOOSE-A-SIZE Marks.

[18] I will now turn to the assessment of the section 6(5) factors.

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

[19] The overall consideration of the section 6(5)(a) factor involves a combination of inherent and acquired distinctiveness of the parties' trade-marks. I assess the inherent distinctiveness of both parties' marks to be equal in that neither is inherently strong, given the suggestive nature of these common words in the French language in the context of the wares with which they are associated. In this regard, both marks suggest that the ability for the consumer to select a particular size of the paper towels.

[20] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. The Applicant did not provide any evidence of promotion or use of the Mark to date. Conversely, the Opponent introduced evidence of promotion and use of the CHOOSE-A-SIZE Marks in Canada, including MESURE-AU-CHOIX, through the Mommersteeg affidavit.

[21] As a preliminary matter, I am of the view that any evidence of use of the Opponent's composite mark CHOOSE-A-SIZE / MESURE-AU-CHOIX & Roll Design (TMA782,175), would also qualify as use of the word marks as the public would perceive the English written

component, as well as the French written component, as use of separate trade-marks *per se* [see *Registrar of Trade-marks v Compagnie Internationale pour l'Informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltee v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

[22] In her affidavit, Ms. Mommersteeg explains that the Opponent is Canada's leading manufacturer and distributor of tissue and paper towels for consumer, in-home use. It is also a leading provider of paper products for wholesale away from home use. According to Ms. Mommersteeg, the Opponent or its predecessors-in-title has used the CHOOSE-A-SIZE Marks, or "highly similar" ones, in association with paper products, including paper towels, since at least as early as 1997, under the ScotTowels and SpongeTowels brands.

[23] As sample evidence of use, Ms. Mommersteeg attaches the following exhibits:

- Exhibits 2 and 4 – Photos of paper towel products in various packaging bearing the composite mark CHOOSE-A-SIZE / MESURE-AU-CHOIX & Roll Design (TMA782,175), and minor variations thereof, said to be representative of products sold in Canada by the Opponent from 2000 to 2013; and
- Exhibit 3 – Packaging design templates for paper towel products bearing the composite mark CHOOSE-A-SIZE / MESURE-AU-CHOIX & Roll Design (TMA782,175), and minor variations thereof, said to be representative of those sold in Canada by the Opponent from 2001 to 2012.

[24] In each case, the trade-marks SCOTTOWELS (up to 2005) and/or SPONGETOWELS (from 2005 and on) also appear on the packaging, separate from the composite mark, in a more prominent display.

[25] In terms of sales figures, Ms. Mommersteeg states that revenues from sales of paper towel products with the CHOOSE-A-SIZE Marks in Canada total over \$654 million from 1997 to 2013, representing over 103 million packages sold.

[26] In terms of promotion, Ms. Mommersteeg states that the Opponent has spent a significant amount of money advertising the CHOOSE-A-SIZE Marks in Canada in various media including television, in print and online. In this regard, the affiant attaches the following exhibits:

- Exhibits 5 and 6 – screen captures and a copy of a 30-second television commercial in English for SPONGETOWELS paper towels featuring the trade-mark CHOOSE-A-SIZE on the packaging. According to Ms. Mommersteeg, the commercial was broadcast in Canada in 2010 and 2011, representing approximately \$2.4 million in television advertising expenditures;
- Exhibit 7 – representative sample of promotional materials of paper towel products in the form of coupons, sell sheets, mock-ups of in-store displays, and other printed or online advertisements and contests, said to have been circulated in Canada between 2004 and 2012. Photos of paper towel products in packaging bearing the composite mark CHOOSE-A-SIZE / MESURE-AU-CHOIX & Roll Design (TMA782,175), and minor variations thereof, in conjunction with the trade-marks SCOTTOWELS and SPONGETOWELS can be seen; and
- Exhibits 9 and 10 – representative screen captures of the Opponent’s product-specific website *www.spongetowels.ca* as they appear in 2013, and printouts from *archive.org* showing archived versions of the website from 2007 to 2010. Photos of paper towel products in packaging bearing the composite mark CHOOSE-A-SIZE / MESURE-AU-CHOIX & Roll Design (TMA782,175), and minor variations thereof, in conjunction with the trade-mark SPONGETOWELS can be seen.

[27] When the Mommersteeg affidavit is read as a whole, I am satisfied that the word marks CHOOSE-A-SIZE and MESURE-AU-CHOIX, as well as the composite mark CHOOSE-A-SIZE / MESURE-AU-CHOIX & Roll Design, have, in conjunction with the trade-marks SCOTTOWELS (up to 2005) and/or SPONGETOWELS (from 2005 and on), acquired some measure of distinctiveness, in association with paper towel products, as evidenced by the Opponent’s significant sales figures for over 15 years as well as the many exhibits demonstrating sample use and promotion of these trade-marks in various combinations since 2000.

[28] Accordingly, the section 6(5)(a) factor favours the Opponent.

Section 6(5)(b) – the length of time the trade-marks have been in use

[29] The Opponent's registration No. TMA602,088 claims use of the trade-mark MESURE-AU-CHOIX in Canada in association with paper towels since at least as early as February 1996. Further, as discussed above, the Opponent has provided evidence of use of the trade-mark MESURE-AU-CHOIX in association with paper towel products dating as far back as 2000. In comparison, the application for the Mark is based on use in Canada since at least as early as June 1, 2011, although the Applicant did not file any evidence of use.

[30] Accordingly, the section 6(5)(b) factor favours the Opponent.

Sections 6(5)(c) and (d) – the nature of the wares, trade and business

[31] The sections 6(5)(c) and (d) factors, which involve the nature of the wares, trade and business, also favour the Opponent.

[32] When considering sections 6(5)(c) and (d) of the Act, it is the statements of wares as defined in the application for the Mark and in the Opponent's registration No. TMA602,088 that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[33] The parties' wares are identical; both parties' trade-marks are associated with paper towels.

[34] Neither the Opponent's registration nor the subject application contains any restriction on the parties' channels of trade. According to Ms. Mommersteeg, the Opponent's paper towel products bearing the CHOOSE-A-SIZE Marks are offered for sale in many major Canadian retail chains across Canada, including national retailers such as Loblaws, Walmart, Sobeys, and Canadian Tire. The names of these retailers, along with many others, also appear in the 2013 printouts of the Opponent's product-specific website at www.spongetowels.ca attached as Exhibit 9 to the Mommersteeg affidavit.

[35] In the absence of evidence from the Applicant, since the parties' wares are identical, for the purpose of assessing confusion, I conclude that there is potential for overlap between the parties' channels of trade.

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

[36] When considering the degree of resemblance, the law is clear that the trade-marks must be considered in their totality. While it is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trade-marks, it is nevertheless possible to focus on particular features of a mark that may have a determinative influence on the public's perception of it [see *United Artists Corp v Pink Panther Beauty Corp* (1998), 80 CPR (3d) 247 at 263 (FCA)]. The preferable approach when comparing trade-marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique [see *Masterpiece* at para 64].

[37] There are both similarities and differences between the parties' trade-marks in appearance and sound, with significant similarities in ideas suggested. According to *Le Petit Robert*, the term "mesure" can be defined as "grandeur déterminée par la mesure"; the term "format" can be defined as "dimension, taille"; and the term "choix" can be defined as "pouvoir, liberté de choisir".

[38] The Opponent's trade-mark consists of two components, the first being a reference to the size of the paper towels, "MESURE", followed by the idea that the consumer can make a selection, "AU-CHOIX". I am of the view that neither component is particularly striking or unique given that the expression in its entirety evokes the idea that the consumer can select a particular size of the paper towels. In comparison, the Applicant's Mark follows a similar layout. It also consists of two components, the first being a reference to the size of the paper towels, "FORMAT", followed by the idea that the consumer can make a selection, "AU CHOIX". Again, I am of the view that neither component is particularly striking or unique given that the expression in its entirety evokes the idea that the consumer can select a particular size of the paper towels.

[39] While the first components of both parties' trade-marks are indeed different in appearance and sound, the idea remains the same for the terms "MESURE" and "FORMAT" are interchangeable in the context of paper towels. In the end, when the parties' trade-marks are viewed in their entirety, the visual and phonetic differences in the first portions of the trade-marks are not significant enough to outweigh the nearly identical latter portions as well as the significant degree of resemblance in the overall ideas suggested by them.

[40] Accordingly, the section 6(5)(e) factor favours the Opponent.

Additional surrounding circumstance – Family of marks

[41] The Opponent advances its ownership of a family of CHOOSE-A-SIZE Marks as an additional surrounding circumstance supporting its case.

[42] In order to rely on a family of marks, the party must evidence use of those trade-marks in the marketplace [see *McDonald's Corp v Yogi Yogurt* (1982), 66 CPR (3d) 101 (FCTD)]. At the outset of the discussion, I note that there is no evidence showing the manner in which the trade-marks ESCOJE EL TAMAÑO (TMA684,154) has been used in Canada. Moreover, as pointed out by the Applicant, the trade-mark CHOOSE-A-SIZE / MESURE-AU-CHOIX & Design (TMA523,150) appears in a single instance in the Mommersteeg affidavit, as part of the Opponent's packaging designs overview identified as "Scottowels 2000" (Exhibit 2). Thus, it is unclear the extent to which the trade-mark CHOOSE-A-SIZE / MESURE-AU-CHOIX & Design (TMA523,150) has been used in Canada.

[43] As for the remaining trade-marks, while I accept evidence of use of the composite mark CHOOSE-A-SIZE / MESURE-AU-CHOIX & Roll Design (TMA782,175) as evidence of use of the words marks CHOOSE-A-SIZE and MESURE-AU-CHOIX, I am not prepared to accept that the Opponent has established the use of a family of marks based solely on evidence of use of the composite mark in the marketplace, without showing any instance of use of the word marks separate from that of the composite mark.

Additional surrounding circumstance – State of the register

[44] The Applicant submits the Bento declaration which details eight registrations extracted from the Canadian Intellectual Property Office's trade-marks database for trade-marks registered in association with similar or identical wares, namely MULTI-SIZE (TMA670,161), PICK-A-SIZE (TMA675,897), SELECT-A-SIZE (TMA612,548), SELECT-A-SIZE / A SU MEDIDA & Design (TMA613,309), VARI-A-SIZE (TMA715,278), SPLIT TO SIZE (TMA809,449), TEAR TO SIZE & Design (TMA721,504), and CUSTOM SIZE-IT (TMA828,971).

[45] State of the register evidence is purported to show the commonality or distinctiveness of a mark or portion of a mark in relation to the register as a whole. It is only relevant insofar as inferences may be made with respect to the state of the marketplace, and inferences about the state of the marketplace can only be drawn when a significant number of pertinent registrations are located [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

[46] Having reviewed the particulars of these registrations, I note that the above-mentioned trade-marks are registered in the name of six owners, two of which belong to the Applicant. Given the small number of registrations, I am unable to draw any inferences concerning the state of the marketplace from the state of the register evidence filed.

Additional surrounding circumstance – Secondary marks

[47] The Applicant submits that the evidence shows that the Opponent's CHOOSE-A-SIZE Marks merely appear as secondary marks on the paper towel packaging, in conjunction with SCOTTOWELS and/or SPONGETOWELS, making it unlikely for the average consumer to infer that the parties' paper towels are manufactured or sold by the same person. The Act does not distinguish between primary and secondary marks [see *Groupe Procycle Inc v Chrysler Group LLC* (2010) 87 CPR (4th) 123 (FC)]. In any case, the Opponent's registration does not restrict the use of the trade-mark MESURE-AU-CHOIX in association with a house mark. Thus, I do not consider this to be a significant surrounding circumstance.

Additional surrounding circumstances – Related registrations and no evidence of actual confusion

[48] The Applicant further submits that it is the owner of two registered trade-marks MULTI-SIZE (TMA670,161) and CUSTOM SIZE-IT (TMA828,971) for use in association with paper towels, which coexist on the register and in the marketplace with the Opponent's CHOOSE-A-SIZE Marks, as well as third party trade-marks, with no evidence of instances of actual confusion. The Applicant also points out that CUSTOM SIZE-IT (TMA828,971) is the English equivalent of the Mark and that the application was not opposed by the Opponent despite being filed at the same time as the subject application.

[49] I have already addressed the Applicant's state of the register submissions earlier. Moreover, I note that the Applicant did not file any evidence of use of its registered trade-marks in the marketplace. In any case, it is well established that while section 19 of the Act gives the owner of a registration the exclusive right to the use of a trade-mark with respect to the wares and services covered by the registration, it does not necessarily follow that the registered owner is given an automatic right to obtain any further registrations no matter how closely related they may be to earlier registrations [see *Coronet-Werke Heinrich Schlerf GmbH v Produits Ménagers Coronet Inc* (1984), 4 CPR (3d) 108 (TMOB) at 115]. Thus, I do not consider this to be a significant surrounding circumstance.

[50] As for the absence of evidence of actual confusion between the Opponent's CHOOSE-A-SIZE Marks and the Applicant's registered trade-marks, suffice it to say that this is not a factor that is relevant in determining the likelihood of confusion between the Mark and the Opponent's trade-marks, nor is the fact that the Applicant's other trade-mark application has not been opposed by the Opponent.

Conclusion in the likelihood of confusion

[51] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, despite the low inherent distinctiveness of both parties' trade-marks, in view of similarities between the parties' trade-marks in appearance and sound, as well as the high degree of resemblance in ideas

suggested, evidence of the Opponent's trade-mark having been used extensively in Canada, the identical wares, and the potential for overlap between of the channels of trade, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between Mark and the trade-mark MESURE-AU-CHOIX of registration No. TMA602,088.

[52] Since I accept the section 12(1)(d) ground of opposition based on registration No. TMA602,088, I am not considering the ground of opposition based on the other registered CHOOSE-A-SIZE Marks alleged by the Opponent. Accordingly, I accept the ground of opposition based on section 12(1)(d) of the Act to the extent that it is based on registration No. TMA602,088.

Was the Applicant the person entitled to registration of the Mark at the alleged date of first use?

[53] In its statement of opposition, the Opponent alleges that the Applicant is not the person entitled to registration of the Mark on the ground that it is confusing with each of the Opponent's CHOOSE-A-SIZE Marks, and collectively as a family of marks, which have been used in Canada in association with "paper towels".

[54] As a preliminary matter, I note that there is a typographical error in of the statement of opposition which set outs the section 38(2)(c) ground of opposition. Specifically, the statement of opposition pleads non-entitlement pursuant to section 16(1)(c) rather than section 16(1)(a) of the Act in view of confusion with each of the Opponent's five trade-marks, and collectively as a family of marks. When the statement of opposition is read as a whole, it is clear that the Opponent is relying on the use of the CHOOSE-A-SIZE Marks, not on the use of trade-names.

[55] The material date for considering this ground of opposition is the alleged date of first of the Mark, namely June 1, 2011. For the reasons that follow, I accept the ground of opposition and decide this issue in favour of the Opponent.

[56] The Opponent has the initial burden of proving that one or more of the trade-marks alleged in support of this ground of opposition was used in Canada prior to the material date and

had not been abandoned at the date of advertisement of the application for the Mark [section 16(5) of the Act].

[57] Once again, I find that comparing the Mark and the trade-mark MESURE-AU-CHOIX will effectively decide the section 16(1)(a) ground of opposition. In other words, if confusion is not likely between the Mark and MESURE-AU-CHOIX, then it would not be likely between the Mark and any of the Opponent's other CHOOSE-A-SIZE Marks.

[58] As per my review of the Mommersteeg affidavit under the section 12(1)(d) analysis, I am satisfied that the Opponent has discharged its evidentiary burden to show prior use and non-abandonment of its trade-mark MESURE-AU-CHOIX. Further, assessing each of the section 6(5) factors as of June 1, 2011 rather than as of today's date does not significantly impact my previous analysis of the surrounding circumstances of this case.

[59] I conclude that the Applicant has not discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-mark MESURE-AU-CHOIX in association with paper towels as of June 1, 2011.

[60] Since I accept the section 16(1)(a) ground of opposition based on the Opponent's trade-mark MESURE-AU-CHOIX, I am not considering the ground of opposition based on the other CHOOSE-A-SIZE Marks alleged by the Opponent. Accordingly, I accept the ground of opposition based on section 16(1)(a) of the Act to the extent that it is based on the trade-mark MESURE-AU-CHOIX.

Was the Mark distinctive of the Applicant's wares at the filing date of the statement of opposition?

[61] The Opponent has pleaded that the Mark does not distinguish the wares of the Applicant from those of the Opponent, in view of the Opponent's prior use of each of the CHOOSE-A-SIZE Marks, as well as its family of marks, within the meaning of section 2 of the Act.

[62] The material date to assess the ground of opposition is the filing date of the statement of opposition, namely September 11, 2012 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)]. For the reasons that follow, I accept the ground of opposition and decide this issue in favour of the Opponent.

[63] As I find that comparing the Mark with the trade-mark MESURE-AU-CHOIX will effectively decide the outcome of this ground of opposition, it is not necessary to consider whether the Opponent has discharged its evidentiary burden for the remaining trade-marks alleged in the statement of opposition.

[64] I am satisfied that the Opponent has met its evidentiary burden to establish that the trade-mark MESURE-AU-CHOIX had become known sufficiently in Canada, as of September 11, 2012, to negate the distinctiveness of Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd* 2006 FC 657 (CanLII), (2006), 48 CPR (4th) 427 (FC)]. In this regard, while the evidence shows that the trade-mark MESURE-AU-CHOIX always appears in conjunction with the trade-marks SCOTTOWELS and/or SPONGETOWELS, I find this to be of no consequence as the Opponent clearly uses MESURE-AU-CHOIX as a trade-mark *per se*, albeit in a subsidiary role to the Opponent's product trade-marks which receive greater emphasis.

[65] Assessing each of the section 6(5) factors as of September 11, 2012 does not significantly impact my previous analysis of the surrounding circumstances of this case. For reasons similar to those expressed previously, I conclude that the Applicant has not discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between its Mark and the Opponent's trade-mark MESURE-AU-CHOIX in association with paper towels as of September 11, 2012.

[66] Accordingly, I accept the non-distinctiveness ground of opposition.

Section 30(i) Ground of Opposition



[67] As I have found the Opponent successful under three grounds of opposition, I do not find it necessary to consider the section 30(i) ground of opposition.

Disposition

[68] 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.

Pik-Ki Fung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule "A"

Opponent's Registered Trade-mark	Reg. No.	Wares
CHOOSE-A-SIZE	TMA600,913	Paper towels.
MESURE-AU-CHOIX	TMA602,088	Paper towels.
	TMA782,175	Paper towels.
	TMA523,150	Paper products, namely paper towels.
ESCOJE EL TAMAÑO	TMA684,154	Paper towels.