

**IN THE MATTER OF AN OPPOSITION
by Boy Scouts of Canada to application
No. 1,121,302 for the trade-mark BENNY
THE BEAVER filed by Leslie Gagné**

On November 6, 2001, the applicant, Leslie Gagné, filed an application to register the trade-mark BENNY THE BEAVER based on proposed use in Canada for the following wares:

merchandise sales namely t-shirts, hats and sweaters; music CD's and recordings (not software related) featuring Canadian themed stories and music produced by Benny The Beaver for the sole purposes of sales and distribution to the children and the general public; story books for kids, board games

and for the following services:

entertainment and education namely story telling, theatrical productions, musical performances, and Benny the Beaver club memberships.

The application was advertised for opposition purposes on July 9, 2003.

The opponent, Boy Scouts of Canada, filed a statement of opposition on August 20, 2003, a copy of which was forwarded to the applicant on September 16, 2003. The first ground of opposition is that the applicant's trade-mark does not conform to the requirements of Section 30 of the Trade-marks Act because the applied for mark is not a trade-mark and is not distinctive. The second ground is that the applied for trade-mark is not registrable pursuant to Sections 9(1)(n)(iii) and 12(1)(e) of the Act in view of the opponent's official mark BEAVERS.

The third ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3) of the Act because, as of the applicant's filing date, the

applied for mark was confusing with the trade-marks BEAVER and BEAVERS, used alone or in combination with a design or other words, previously used in Canada by the opponent in association with various youth programs and with related wares such as videos, tapes, books, games, uniforms, sweaters, t-shirts, hats, jackets, bags, patches, etc. The fourth ground is that the applicant's trade-mark is not distinctive because it is confusing with the BEAVER and BEAVERS trade-marks used by the opponent.

The applicant filed and served a counter statement. As its evidence, the opponent submitted an affidavit of John Robert Stewart. As its evidence, the applicant submitted an affidavit of Leslie Gagné. Both parties filed a written argument and an oral hearing was conducted at which only the opponent was represented.

THE OPPONENT'S EVIDENCE

In his affidavit, Mr. Stewart identifies himself as Executive Commissioner and CEO of the opponent and provides a brief history of the organization. Boy Scouts of Canada provides programs and training for young boys. It has been in existence in Canada since 1914 when it was incorporated pursuant to a special Act of Parliament. Since that time, it has been active throughout Canada. It carries on its operations through a number of sections, one of those sections being called Beavers. The Beavers section was started in 1971 and is for the opponent's youngest members.

Mr. Stewart goes on to describe the structure of the opponent's organization and its

manner of operation. In particular, he describes the manner in which the opponent acquires and sells goods to its membership. For many years, the opponent has had a dealer network across Canada comprising various retailers who typically set aside a section of their stores to sell the opponent's wares. Those wares include uniforms, badges, emblems and camping supplies including flashlights. The opponent also operates its own retail outlets under the trade-name Scout Shop. More recently, the number of dealers has declined (from 106 in 1976 to 25 in 1991 to one in 2004) while the number of Scout Shops has increased. According to Mr. Stewart, there were 35 such shops in Canada as of 2004.

Appended as exhibits to Mr. Stewart's affidavit are photocopies of various catalogues issued by the opponent from 1977 to 2002. A review of those catalogues reveals that the opponent has been selling various wares in association with different forms of its trade-marks BEAVER and BEAVERS including jackets, caps, pouches, toques, scarves, t-shirts, packs, emblems, stuffed toys, sweatpants, emblems, buttons and pins. Although Mr. Stewart did not provide sales figures for these particular wares, it is reasonable to assume that since they have been available for many years that the sales have been significant. The opponent has also offered for sale books for its younger members with titles such as "A Book For Eager Beavers" and "A Book For Growing Beavers." More recently, the opponent has also offered for sale videos in association with the trade-marks BEAVER and BEAVER JUMPSTART.

THE APPLICANT'S EVIDENCE

In his affidavit, Mr. Gagné identifies himself as the applicant and the sole director of

The Big Beaver Theme Park Inc. (“BBTP”). Mr. Gagné states that BBTP owns and operates The Big Beaver Outpost in a beaver-themed park that he plans to open soon. BENNY THE BEAVER is a fictional character to be used in association with The Big Beaver Outpost. As part of his endeavor, Mr. Gagné plans to sell items through the outpost and only through the outpost.

Mr. Gagné also states that he publishes a magazine entitled “Benny’s Beaver Tales” three times a year. According to Mr. Gagné, the magazine deals with Canadian history and is geared to children aged seven to eleven.

THE GROUNDS OF OPPOSITION

The opponent’s third ground of opposition is one of prior entitlement based on the provisions of Section 16(3) of the Act. In this regard, the opponent has evidenced use of its BEAVER and BEAVERS trade-marks prior to the applicant’s filing date and non-abandonment of those marks as of the applicant’s advertisement date.

In view of the above, the third ground remains to be decided on the issue of confusion between the applicant’s mark and the opponent’s marks. As set out in Section 16(3) of the Act, the material time for considering the circumstances respecting this issue is as of the applicant’s filing date. Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the

surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

As for Section 6(5)(a) of the Act, the marks of both parties are inherently distinctive. The opponent's evidence allows me to conclude that, as of the material time, its trade-marks BEAVER and BEAVERS had acquired a reputation in Canada in association with the section it operates for its youngest members. To a lesser extent, and notwithstanding the deficiencies in the Stewart affidavit, I am able to conclude that the opponent's BEAVER marks had become known to some extent in Canada with wares such as uniforms, t-shirts, scarves, toques, badges, pins, books, videos, etc. Given the absence of use of the applicant's mark, I must conclude that it had not become known at all in Canada as of the filing of the present application.

The length of time the marks have been in use favors the opponent. As for Sections 6(5)(c) and 6(5)(d) of the Act, it is the applicant's statements of wares and services that govern, not the more restricted area of intended use attested to by Mr. Gagné: see Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.), Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.) and Miss Universe, Inc. v. Dale Bohna (1994), 58 C.P.R.(3d) 381 at 390-392 (F.C.A.). However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful: see the decision in McDonald's Corporation v. Coffee Hut Stores Ltd. (1996), 68 C.P.R.(3d) 168 at 169 (F.C.A.).

There is a significant overlap in both the wares and services of the parties. The applicant's statement of wares includes t-shirts, hats, sweaters and books for kids, these being identical to some of the wares sold by the opponent in association with its BEAVER marks. The remaining wares of the applicant are similar in nature to the opponent's wares such as videotapes. The services are also similar in that the opponent also performs what could be characterized as entertainment and educational services for its most junior members and, of course, offers club memberships.

Presumably there could be an overlap in the trades of the parties. The fact that Mr. Gagné only intends to sell items and perform services through one particular location in his proposed theme park is immaterial since his statements of wares and services include no such restriction.

As for Section 6(5)(e) of the Act, there is a fairly high degree of resemblance in all respects between the marks at issue. The opponent's marks comprise or include the word BEAVERS or BEAVER which is a dominant component of the applicant's proposed mark.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the resemblance between the wares, services and marks of the parties, I find on a balance of probabilities that the applicant has failed to show that his mark is not confusing

with the opponent's marks. As noted in the opposition decision in Boy Scouts of Canada v. Moehring (1993), 48 C.P.R.(3d) 557 at 560 concerning the applied for mark EAGER BEAVER for similar wares, the general public might well have assumed that the present applicant's wares and services were approved, licensed or sponsored by the opponent. Thus, the third ground of opposition is successful.

As for the fourth ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares and services from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - August 20, 2003): see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.). Finally, there is an evidential burden on the opponent to prove the allegations of fact in support of its ground of non-distinctiveness.

The fourth ground essentially turns on the issue of confusion between the marks of the parties. Notwithstanding the later material time, my conclusions respecting the issue of confusion respecting the prior entitlement ground are equally applicable to the fourth ground. Thus, I find that the applicant has failed to show that its proposed mark was not confusing with the applicant's BEAVER marks as of the filing of the opposition. The fourth ground is therefore also successful.

In view of the above, it is unnecessary to consider the remaining grounds of opposition.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.

DATED AT GATINEAU, QUEBEC, THIS 21st DAY OF MARCH, 2007.

**David J. Martin,
Member,
Trade Marks Opposition Board.**