



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

Citation: 2013 TMOB 127
Date of Decision: 2013-07-25

**IN THE MATTER OF AN OPPOSITION
by Arbor Memorial Services Inc. to
application No. 1,338,668 for the trade-
mark ARBOR, in the name of NewPage
Wisconsin System Inc.**

[1] On March 9, 2007, the Applicant, NewPage Wisconsin System Inc. (under its former name Stora Enso North America Corporation), filed an application to register the trade-mark ARBOR (the Mark). The application is based on the dual basis of proposed use in Canada and use in the United States of America under U.S. Reg. No. 3,683,488 in association with the following wares, as amended (the Wares):

Publication grade magazine paper; coated printing paper; printing paper, namely, press and catalogue papers; fine papers, namely, printing papers, all the foregoing for the commercial printing trade and excluding the direct sale of all the foregoing to funeral homes and crematoriums.

[2] The application, which also claimed a priority filing date of September 20, 2006, was advertised for opposition purposes in the *Trade-marks Journal* of February 16, 2011.

[3] On July 18, 2011, Arbor Memorial Services Inc. (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- Pursuant to sections 38(2)(a) and 30(b) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), the Applicant had used the Mark in association with the Wares prior to the filing

date of the application and failed to declare this use in the application; the application is therefore invalid on its face.

- Pursuant to sections 38(2)(a) and 30(i) of the Act, at the filing date the Applicant should have been fully aware of the existing rights of the Opponent in its ARBOR trade-marks and trade name. If the Applicant conducted a search prior to filing for registration, the Applicant would have been aware of the Opponent's ARBOR component registrations previously used in Canada. If no such prior rights search was conducted at the date of filing, the Applicant could not properly make the statement of entitlement absent knowledge of possibly conflicting third party rights. Where such a statement is made without regard to the known and conflicting rights of another, or in the absence of knowledge of possibly conflicting rights, the true meaning of section 30(i) is subverted.
- Pursuant to sections 38(2)(b) and 12(1)(d) of the Act, the Mark is not registrable as it is confusing with the following marks of the Opponent, both registered in association with "funeral and funeral home services, cremation services, cemetery services":
 - ARBOR MEMORIAL SERVICES, registration No. TMA553,551
 - ARBORCARE, registration No. TMA552,535
- Pursuant to sections 38(2)(c) and 16(3)(a) and (c) of the Act, the Applicant is not the person entitled to registration of the Mark because, as of the date of filing of the application and at all relevant dates, the Mark was confusing with the Opponent's ARBOR trade-mark and its Arbor, Arbor Memorial and Arbor Memorial Services Inc. trade-names that had been previously used in Canada by the Opponent in conjunction with the provision of memorial and funeral services and associated merchandise including printed publications, trade brochures, flyers, stationary and albums.
- Pursuant to sections 38(2)(d) and 2 of the Act, the Mark is not distinctive of the Applicant for all of the reasons above and cannot function as a trade-mark to distinguish the Wares from the wares and services of the Opponent, nor is it adapted to distinguish them.

[4] The Applicant served and filed a counter statement in which it denied the Opponent's allegations and put the Opponent to the strict proof thereof.

[5] In support of its opposition, the Opponent filed the affidavits of Gary Carmichael, VP of Government and Corporate Affairs and Chief Privacy Officer of the Opponent; David Lipson, a private investigator retained by the Opponent's agent; and Joanne Berent, a Reference Librarian employed by the Opponent's agent. None of the affiants was cross-examined on their affidavits. The Applicant did not file any evidence.

[6] Both parties filed written arguments; an oral hearing was not conducted.

Onus and Material Dates

[7] 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 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; *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

[8] The material dates that apply to the grounds of opposition are as follows :

- sections 38(2)(a)/30 – the filing date of the application [see *Georgia-Pacific Corp. v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)];
- sections 38(2)(b)/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 CPR (3d) 413 (FCA)];
- sections 38(2)(c)/16(3) – the filing date of the application [see section 16(3)]; and
- sections 38(2)(d)/2 – the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Section 30 Grounds of Opposition

Non-compliance with section 30(b) of the Act

[9] The initial burden on the Opponent is light respecting the issue of non-conformance with section 30(b) of the Act, because the facts regarding the Applicant's first use are particularly within the knowledge of the Applicant [see *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1996), 10 CPR (3d) 84 (TMOB) at 89].

[10] As indicated in the above-noted summary of the grounds of opposition, the Opponent's assertion of non-compliance with sections 38(2)(a) and 30(b) of the Act centres around the allegation that the Applicant had used the Mark in Canada in association with the Wares *prior* to the filing date of the application and failed to declare this use in the application. The Opponent submits that the application is therefore invalid on its face and ought to be refused

[*Frisco-Findus SA v Diners Delight Foods Ltd* (1989), 26 CPR (3d) 556 at 557-8 (TMOB); and *Rebel Slacks Co v Couture Dom Rebel SENC*, 2012 TMOB 106 at para 14]. I note that this ground of opposition only relates to the proposed use claim in the application for the Mark.

[11] In support of its allegation, the Opponent filed the affidavit of David Lipson, a private investigator retained by the Opponent's agent and employed by Mitchell Partners Investigation Services.

[12] In his affidavit, Mr. Lipson indicates that on January 30, 2012, he made two telephone calls: one of which was to the Applicant's head office in Miamisburg, Ohio, and the other to Unisource Canada Inc. (Unisource), a supplier of printing paper in Canada. With respect to the first phone call, he states that he spoke with product specialist Dane Zimmerman who works in customer service for the Applicant. He states that Mr. Zimmerman advised him that the Applicant's ARBOR brand paper products were being sold in Canada in 2006 through the Applicant's Canadian distributor, Unisource. Mr. Lipson indicates that he then placed a call with Unisource and spoke with Tyler Pearson, an Account Manager at Unisource. He states that Mr. Pearson advised that Unisource was selling the ARBOR brand paper of the Applicant in Canada in 2006.

[13] The Applicant submits that this evidence constitutes hearsay and does not meet the test of necessity and reliability [*PS Partsource Inc v Canadian Tire Corp* (2001), 11 CPR (4th) 386 (FCA); *Labatt Brewing Co v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. Specifically, the Applicant submits that the information relayed to Mr. Lipson by the third parties is not reliable, as there is no description as to the individuals' duties and the individuals Mr. Lipson spoke to may have been mistaken or may not have had complete knowledge of the facts [see *BlackIce by Design Inc v Molson Canada* 2005, 2010 TMOB 211]. Given that the veracity of this information cannot be tested, the Applicant submits, this evidence is unreliable hearsay which should be afforded no weight [as per *The Law of Evidence in Canada*, 2nd ed. Sopinka, Lederman, Bryant (Toronto: Butterworths, 1999) at page 175].

[14] Mr. Lipson also attaches the results of a Google search for "NEWPAGE ARBOR 2006". Exhibit A is a print-out of the first page of the results from this search. Exhibit B

consists of printouts of two articles located during the search discussing the availability of the Applicant's ARBOR branded products in 2006.

[15] The Applicant submits that these articles refer to NewPage Corporation, not the Applicant (NewPage Wisconsin System Inc.). The Applicant submits that even if there was a connection between it and NewPage Corporation, the Opponent has not filed any evidence supporting such a connection. The Applicant further submits that in any event the articles in Exhibit B largely reference U.S. customers. While Exhibit B does reference the launch of the ARBOR product line in 2006, nothing in the exhibit supports use of the ARBOR product line *in Canada* in 2006.

[16] The Opponent argues that this evidence is sufficient to meet its initial evidential burden with respect to this ground. Furthermore, the Opponent submits that as the Applicant failed to file any evidence, it cannot possibly satisfy its legal burden of showing compliance with section 30(b); thus, the application ought to be refused.

[17] Though much of the evidence provided by Mr. Lipson is hearsay, I am willing to place some weight on it for the following reasons. To begin with, as previously noted, the facts surrounding the Applicant's first use are particularly within the knowledge of the Applicant, which speaks to the necessity of the evidence. Furthermore, I note that the statements made to Mr. Lipson were made by an employee of the Applicant, and an employee of the Applicant's Canadian distributor. Unlike the situation in *BlackIce by Design, supra*, these employees were specifically identified with their associated job titles; both of which imply duties which would involve knowledge of the Applicant's products. Furthermore, the two individuals' statements are not inconsistent with each other. Lastly, I note that Mr. Lipson was not cross-examined on his affidavit, and the Applicant has not adduced any evidence that contradicts or refutes Mr. Lipson's evidence.

[18] In the absence of cross-examination, and where it is not contradicted by the Applicant's evidence, I am prepared to afford some degree of weight to the statements made to Mr. Lipson regarding sales the Applicant's ARBOR brand paper products in Canada, and find that the evidence is sufficient to cast doubt on the veracity of the Applicant's proposed use claim. As

such, it is immaterial whether the articles in Exhibit B relate to the Applicant or to another entity.

[19] As the Opponent has satisfied its initial burden with respect to this ground of opposition, I must now assess whether the Applicant has satisfied its onus of establishing that at the time of filing, its application complied with section 30(b) of the Act. The Applicant has not filed any evidence in this regard; thus, the Applicant has failed to satisfy its legal onus. The ground of opposition based on section 30(b) of the Act is therefore successful which invalidates the Applicant's proposed use claim.

[20] Before turning to the other grounds of opposition, I wish to add that the Opponent has not pleaded that the application does not comply with the requirements of section 30(d) of the Act, and thus it has not challenged the Applicant's section 16(2) claim based on use in the United States of America under U.S. Reg. No. 3,683,488. Thus, the application may still proceed on the basis of the section 16(2) claim, depending upon the outcome of the remaining grounds of opposition.

Non-compliance with section 30(i) of the Act

[21] Where an applicant has provided the statement required by section 30(i) of the Act, a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant (see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155). In the present case, the Applicant has provided the necessary statement and this is not an exceptional case; the section 30(i) ground is accordingly dismissed.

Section 12(1)(d) Ground

[22] 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)]. I have exercised that discretion and

confirm that the Opponent's registrations relied upon in support of this ground of opposition remain in good standing. The Opponent has therefore satisfied its evidential burden.

[23] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that the 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.

[24] In applying the test for confusion, the Registrar must have regard to all surrounding circumstances, including those specifically enumerated in section 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. The above-noted criteria are not exhaustive and it is not necessary to give each one of them equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 96 CPR (4th) 361 (SCC)].

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

[25] The Mark is the phonetic equivalent of the dictionary word “arbour”, defined by the *Canadian Oxford Dictionary*, 2nd edition, as “a shady garden alcove with the sides and roof formed by trees or climbing plants; a bower.” The Mark does not have any particular meaning with respect to the Wares, and thus it possesses some inherent distinctiveness.

[26] The Opponent's marks consist of the same element, ARBOR, combined with elements that are descriptive of the Opponent's services. Similar to the Mark, given the definition of the word “arbour” above, this word does not appear to have any particular meaning with respect to the Opponent's services; thus, the Opponent's marks also possess some inherent distinctiveness by virtue of the inclusion of the inherently distinctive word ARBOR. However,

the remaining words are descriptive and thus the Opponent's marks possess a somewhat lower degree of inherent distinctiveness than the Mark.

[27] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use.

[28] I have not been provided with any evidence of promotion or use of the Opponent's ARBORCARE trade-mark. While it is true that the Opponent's registration No. TMA552,535 claims use in Canada since at least as early as January 1993, at most this entitles me to assume *de minimis* use thereof [see *Entre Computer Centers, Inc v Global Upholstery Co* (1992), 40 CPR (3d) 427 (TMOB)]. *De minimis* use does not support a conclusion that the Opponent's ARBORCARE trade-mark has become known to any significant extent.

[29] Mr. Carmichael provides evidence of the use and promotion of the Opponent's ARBOR MEMORIAL SERVICES mark (TMA553,551). In his affidavit, Mr. Carmichael states that the Opponent has been in business for over sixty years. He provides that the Opponent's ARBOR MEMORIAL brand has been used extensively in the course of promoting and offering the Opponent's wares and services to customers and corporate partners. In support of these statements, he provides significant annual sales figures for the years 2005-2011, as well as market share statistics, and examples of use of the ARBOR MEMORIAL SERVICES mark on promotional and product literature (Exhibits A, B, C, and E). From this evidence, I accept that the Opponent's ARBOR MEMORIAL SERVICES mark has become known in Canada to some extent with respect to the Opponent's registered services. As such, this factor favours the Opponent.

Section 6(5)(b) – the length of time in use

[30] As discussed above in the analysis of the section 6(5)(a) factor, I am satisfied that the Opponent has evidenced use of its ARBOR MEMORIAL SERVICES mark. In the absence of evidence of use of the Mark, I find that the Opponent's ARBOR MEMORIAL SERVICES mark has been in use for longer than the Mark; this factor therefore favours the Opponent.

Section 6(5)(c) and (d) – the nature of the wares and services and business or trade

[31] The Wares consist of specialty papers for the commercial printing trade, while the Opponent has registered its trade-marks in association with funeral and funeral home, cremation and cemetery services. Clearly, the Wares are significantly different from the Opponent's services, as are the businesses of the Applicant and the Opponent.

[32] The Opponent submits that in the course of promoting the services associated with its marks, it provides brochures, catalogues, contracts, booklets and guide books, all printed on publication grade and fine printing paper. These items, the Opponent submits, clearly overlap with the Applicant's Wares. I fail to see the relevance of this submission. Though the Opponent's printed promotional literature, contracts, guidebooks, etc. may be incidental to its funeral and related services, even if these items were considered to constitute wares, the Opponent's registrations do not include such wares. It is the Applicant's statement of wares as defined in its application versus the Opponent's *registered services* that govern my determination of this factor [see *Esprit International v Alcohol Countermeasure Systems Corp* (1997), 84 CPR (3d) 89 (TMOB)].

[33] In addition, the Opponent contends that the exclusionary language in the Applicant's statement of wares, namely, "all the foregoing for the commercial printing trade and excluding the direct sale of all the foregoing to funeral homes and crematoriums" does not assist the Applicant, as it fails to dispel the likelihood of confusion between the marks of the parties. The Opponent submits that *indirect sales* to funeral homes and related business are still possible given that the Applicant uses independent, third party distributors to sell its ARBOR products in Canada. However, I agree with the Applicant, that even if there was any awareness by a consumer of the products of both parties, given the highly disparate nature of the wares and services of the parties and of their respective businesses, consumers would be unlikely to conclude that the Wares emanated from or were approved by the Opponent.

[34] Lastly, the Opponent submits that confusion is also likely as the Opponent and its corporate partners buy from and contract with commercial printers and other suppliers who may act as distributors for the Applicant's paper products. My comments in the preceding

paragraph regarding awareness by consumers of the products of both parties are equally applicable to this submission.

[35] Consequently, I remain of the view that the Wares are significantly different from the Opponent's services, as are the businesses of the Applicant and the Opponent. As such, this factor favours the Applicant.

Section 6(5)(e) – degree of resemblance in appearance, when sounded, or in idea suggested

[36] The Supreme Court has advised that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique [see *Masterpiece, supra*].

[37] In this regard, the Opponent submits that the dominant and distinctive element of its registered trade-marks is the element ARBOR. As the Mark incorporates the entirety of this element, and consists only of this element, the Opponent argues that its registered marks are therefore very similar in appearance and sound to the Mark.

[38] In light of the fact that the parties' marks share this unique and striking element, I agree with the Opponent that the marks share a significant degree of similarity.

Conclusion

[39] In most instances, the degree of resemblance between the marks in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [see *Masterpiece, supra* and *Beverly Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2d) 145, conf 60 CPR (2d) 70 (FCTD)]. However, in the present case, notwithstanding any similarity between the marks in appearance or when sounded, I find the differences in the nature of the parties' wares and services and respective trades to be significant.

[40] Consequently, I am satisfied that the Applicant has discharged its onus of showing on a balance of probabilities, that there was no reasonable likelihood of confusion between the

parties' marks. Accordingly, the ground of opposition based on section 12(1)(d) of the Act is dismissed.

Non-entitlement Ground – section 16(3) of the Act

[41] In order to satisfy its onus, the Opponent must show that its ARBOR trade-mark and its Arbor, Arbor Memorial and Arbor Memorial Services Inc. trade-names were used prior to the filing date of the application and were not abandoned at the date of advertisement. In the present case, the material date is considered to be the priority filing date of September 20, 2006.

[42] In addition to Mr. Carmichael's evidence regarding use of the Opponent's registered trade-marks in association with the registered services, and incidental promotional items such as brochures, catalogues, and guide books, etc., he provides evidence relating to the use of the Opponent's Arbor and Arbor Memorial marks and Arbor Memorial Services Inc trade-name in association with such services (Exhibits A-E), as well as a variety of additional related products and services.

[43] In his affidavit, Mr. Carmichael describes these additional products and services as including personalized albums and cards/stationery and custom printing. He does not however, provide any product samples. He states that approximately eight percent of the Opponent's total sales in 2011 related to the sale of merchandise including personalized memorial albums, stationery, bereavement and notice cards, etc., and that the Opponent offers printing services for its customers on commercial grade paper featuring the ARBOR brand. He also provides an extract from the Opponent's 2011 Annual Report (Exhibit D) that describes the Opponent's business as including custom printing services.

[44] In any event, I note that there is no evidence relating to these additional wares and services prior to the material date. Furthermore, with respect to the incidental promotional items (brochures, catalogues, etc.), I am of the view that consumers are most likely to regard these items as part of the Opponent's advertising and promotional endeavours concerned with sales of funeral and funeral related services, rather than products of the Opponent [*Joseph E. Seagram & Sons Ltd v Corby Distilleries Ltd* (1978), 42 CPR (2d) 264 (TMOB)].

[45] Ms. Berent provides evidence of newspaper articles (Exhibit A). The Opponent submits that, taken in combination with Mr. Carmichael's evidence, these newspaper articles show that the Opponent's marks have become well known in Canada in association with the Opponent's ARBOR products and services. However, newspaper articles do not constitute advertising pursuant to section 4(2) of the Act, nor do they support that the Opponent's marks have been made known within the meaning contemplated by section 5 of the Act [*Williams Companies Inc et al v William Tel Ltd* (2000), 4 CPR (4th) 253 (TMOB)].

[46] However, in view of Mr. Carmichael's evidence, I am satisfied that the Opponent's marks and trade-names had been used in Canada in association with funeral and funeral home related services as of the material date and had not been abandoned at the date of advertisement. Thus, the Opponent has met its evidential burden with respect to the pleaded services.

[47] I must now assess whether the Applicant has met its legal burden. Specifically, the onus is on the Applicant to establish on a balance of probabilities that there is no likelihood of confusion between the Mark and the Opponent's marks and trade-names. In this regard, my findings under the ground of opposition based on section 12(1)(d) are equally applicable here. That is, I find the differences in the nature of the parties' wares and services and respective trades to be significant, and thus I am satisfied that the Applicant has discharged its onus of showing on a balance of probabilities, that there was no reasonable likelihood of confusion between the Applicant's mark and the Opponent's marks and trade-names. Accordingly, the ground of opposition based on section 16(3) of the Act is dismissed.

Non-Distinctiveness Ground of Opposition

[48] In order to meet its initial burden under this ground, the Opponent must establish that as of the filing date of the statement of opposition, namely, July 18, 2011, the Opponent's marks and trade-names had become known sufficiently to negate the distinctiveness of the Mark [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc, supra; Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD)].

[49] Furthermore, an attack based on non-distinctiveness is not restricted to the actual performance of services or sales of goods in Canada, it may also be based on evidence of knowledge or reputation of the Opponent's trade-marks or trade-names spread by means of word of mouth and evidence of reputation and public acclaim and knowledge by means of newspaper or magazine articles as opposed to advertising [*Motel 6*, at 58-59].

[50] As set out in further detail above in the analysis of the section 12(1)(d) and 16(3) grounds of opposition, the Opponent has provided evidence supporting a finding that its trade-mark and the trade-names had developed a reputation in Canada in association with "funeral and funeral home, cremation and cemetery services" as of the material date, such that the Opponent has met its evidential burden. I note that the newspaper articles furnished by Ms. Berent under Exhibit A of her affidavit offer further support for this conclusion. Although circulation figures have not been provided for the publications, I am able to take judicial notice of the general circulation of major Canadian daily newspapers [see *Carling O'Keefe Breweries of Canada Ltd. – Les Brasseries Carling O'Keefe du Canada Ltée – Trading as Carling O'Keefe Breweries v. Anheuser Busch, Inc* (1985), 4 CPR (3d) 216 (TMOB) and *Ports International Ltd v Amcan Charter Imports Ltd* (1984), 4 CPR (3d) 390 (TMOB)]. Furthermore, I am willing to take judicial notice that *The Globe and Mail* and *The Toronto Star*, for example, have substantial circulation in the Toronto area [see *Northern Telecom Ltd v Nortel Communications Inc* (1987), 15 CPR (3d) 540 (TMOB) at 543].

[51] Further to this, as previously mentioned, Mr. Carmichael attests that approximately eight percent of the Opponent's total sales in 2011 related to the sale of merchandise including personalized albums, stationery, bereavement and notice cards, etc. While not relevant to the ground of opposition based on non-entitlement due to the material date for that ground, I am prepared to accept that the Opponent has established a degree of reputation with respect to its marks and trade-names in association with these wares and the related printing services as of the material date for this ground of opposition as well.

[52] I must now assess whether the Applicant has satisfied its legal burden. Specifically, the onus is on the Applicant to establish on a balance of probabilities that there is no likelihood of confusion between the Applicant's mark and the Opponent's marks and trade-names.

[53] The difference in material dates is not significant and as a result my findings regarding services under the grounds of opposition based on sections 12(1)(d) and 16(3) of the Act are equally applicable here. Specifically, despite the inclusion of the Opponent's wares ("memorial albums, stationery, bereavement and notice cards, etc.") and the custom printing services associated with these products under this ground of opposition due to the material date, the Opponent's products are still within the realm of funeral and funeral related services and are not intermediate products for the commercial printing industry as are the Applicant's specialty paper products. As a result, I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Applicant's mark and the Opponent's marks and trade-names at issue. Having regard to the foregoing, I reject the ground of opposition based on non-distinctiveness.

Disposition

[54] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act, insofar as all grounds of opposition are concerned with the exception of the ground of opposition based on section 38(2)(a) and 30(b) with respect to the Applicant's proposed use claim only. Consequently, the Applicant's proposed use claim will be deleted from the subject application.

Andrea Flewelling
Member
Trade-marks Opposition Board
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