



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

**Citation: 2012 TMOB 172**  
**Date of Decision: 2012-09-28**

**IN THE MATTER OF AN OPPOSITION  
by Gemological Institute of America, Inc.  
to application No. 1,289,035 for the trade-  
mark GEMOLOGY HEADQUARTERS  
INTERNATIONAL in the name of  
Gemology Headquarters International,  
LLC**

[1] On February 7, 2006, Gemology Headquarters International, LLC (the Applicant) filed an application to register the trade-mark GEMOLOGY HEADQUARTERS INTERNATIONAL (the Mark).

[2] The application is based on proposed use of the Mark in Canada in association with the following wares and services:

wares

Certificates of authenticity and certificates of grading of diamonds, gemstones and pearls; jewelry boxes; plastic and glass displays for exhibiting gems or jewelry (Wares1).

services

Educational services regarding gemology; gemological services, namely, providing identification, authentication, and grading of diamonds, gemstones and pearls and issuing certificates relating to such grading, inscriptions on diamonds and gemstones; appraisals of diamonds, gemstones, pearls and jewelry; precious metal assaying (Services1).

[3] The application is also based on use and registration of the Mark in the United States of America in association with the following wares and services:

wares

Printed certificates of authenticity of diamonds, gemstones and pearls; printed certificates of grading of diamonds, gemstones and pearls (Wares2).

services

Gemological services, namely, providing identification, authentication, and grading of diamonds, gemstones and pearls and issuing certificates relating to such grading; precious metal assaying (Services2).

[4] A convention priority filing date of January 26, 2006 has been claimed with respect to Wares2 and Services2.

[5] The Applicant has disclaimed the right to the exclusive use of the word GEMOLOGY apart from the Mark.

[6] The application was advertised for opposition purposes in the *Trade-marks Journal* of April 16, 2008.

[7] On June 16, 2008, Gemological Institute of America, Inc. (the Opponent) filed a statement of opposition against the application. The Applicant filed and served a counter statement denying the Opponent's allegations.

[8] In support of its opposition, the Opponent filed affidavits of Susan Johnson (the Opponent's Director of Education Administration), Susan Petrich (the Opponent's Director of Marketing Operations) and Sabra Norris (the Opponent's Chief Lab Business Operations Officer). In support of its application, the Applicant filed two affidavits of Linda Marie Sanchez (a paralegal) plus certified copies of 17 Canadian trade-mark registrations/applications. No cross-examinations were conducted.

[9] Both parties filed a written argument.

[10] An oral hearing was held in which both parties participated. The Applicant wished to employ a court reporter to make an electronic recording of the oral hearing for its own purposes.

The Opponent objected to having the hearing recorded. There is no legislative requirement, nor is it the practice, to record oral hearings in opposition proceedings before the Registrar, and I did not allow the Applicant to electronically record the hearing. I note that the Registrar is master of opposition procedures, subject to the right of the parties to a fair hearing, and the refusal to allow the hearing to be recorded did not affect the Applicant's right to a fair hearing.

#### Grounds of Opposition/Material Dates/Onus

[11] The Opponent has pleaded grounds of opposition pursuant to sections 38(2)(b)/12(1)(d), 38(2)(c)/16(2)/16(3) and 38(2)(d)/2 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). Each of the grounds of opposition is premised on the allegation that there is a likelihood of confusion between the Mark and one or more trade-marks of the Opponent that incorporate the words GEMOLOGICAL INSTITUTE OF AMERICA or the Opponent's trade-name Gemological Institute of America.

[12] The material date for assessing each ground of opposition varies as follows: section 38(2)(b) ground - today's date [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)]; section 38(2)(c) ground - February 7, 2006 (re Wares1 and Services1) and January 26, 2006 (re Wares2 and Services2); section 38(2)(d) ground – June 16, 2008 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[13] 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].

[14] The Opponent's case regarding confusion is strongest under the section 38(2)(b)/12(1)(d) ground of opposition because its later material date allows all of the Opponent's evidence concerning its reputation to be considered. Therefore, if the Opponent is not successful under section 38(2)(b), then it will not be successful under either section 38(2)(c) or (d).

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 (collectively the registered marks):

1. GEMOLOGICAL INSTITUTE OF AMERICA & Design (#1) -  
registration No. TMA276,665



services: educational services, namely courses in gemology.

2. GEMOLOGICAL INSTITUTE OF AMERICA & Design (#2) -  
registration No. TMA578,540



wares: (1) Pre-recorded videotapes, CD-ROMs, and audiotapes featuring educational materials in the field of gemology and telephonic and digital transmitters of information in the field of gemology. (2) Paper articles, cardboard articles and printed matter, namely, magazines, journals and newsletters in the field of gemology, books in the field of gemology, instructional and teaching materials in the field of gemology, reference materials, namely, manuals, handbooks, printed charts and printed tables, all in the field of gemology, testing materials, namely, test booklets, score sheets and answer sheets, unmounted photographs, stationery, note paper, printed diplomas, posters, gemological grading reports and cardboard.

services: Mail order catalog services and computerized on-line ordering services for purchasing products in the field of gemology.

3. GEMOLOGICAL INSTITUTE OF AMERICA - registration No. TMA579,440

wares: (1) Pre-recorded videotapes, CD-ROMs, and audiotapes featuring educational materials in the field of gemology and telephonic and digital transmitters of information in the field of gemology. (2) Paper articles, cardboard articles and printed matter, namely, magazines, journals and newsletters in the field of gemology, books in the field of gemology, instructional and teaching materials in the field of gemology, reference materials, namely, manuals, handbooks, printed charts and printed tables, all in the field of gemology, testing materials, namely, test booklets, score sheets and answer sheets, unmounted photographs, stationery, note paper, printed diplomas, posters, gemological grading reports and cardboard.

services: (1) In-residence, on-site and correspondence courses in gemology including jewelry design, sale and promotion of gems, pearls and jewelry, investigation of genuineness of gems and valuation of gems and pearls. (2) Mail order catalog services and computerized on-line ordering services for purchasing products in the field of gemology. (3) Mail order catalog services and computerized on-line ordering services for purchasing products in the field of gemology; in-residence, on-site, and correspondence courses educating students in the field of gemology.

4. GEMOLOGICAL INSTITUTE OF AMERICA & Design (#3) - registration No. TMA596,705



wares: (1) Floppy disks, magnetic tapes recorded with computer programs, magnetic disks recorded with computer programs, compact disks, digital video disks, minidisks, computer software and computer programs all related to the field of gems, jewelry, gemological, gemological training and gem and jewelry evaluations; slides, transparencies, video disks used to transmit or reproduce information and data relating to the field of gemology, sound recording disks, pre-recorded video tapes, pre-recorded audio tapes and CD-ROMS containing software and information relating to the field of gemology, jewelry, jewelry manufacturing, jewelry design;

jewelry sales, jewelry appraisal, insurance appraisal, watches and horology, crystals, beads, pearls, jade, silverware, science, management and sales, gem cutting, gem grading, and gem inscribing; diamond and gemological grading reports, pearl and gem identification reports, handbooks, office paper, colored paper, paperboards, gem papers, craft paper, wrapping paper, waxed paper, typing paper, drawing paper, fax paper, permanent paper, face tissue paper, towels of paper, table cloth and handkerchiefs, plastic stickers for decoration, magazines, cards, namely playing cards and cards containing gem and jewelry identification, grading, and analysis, envelopes, letter paper, greeting cards, bookmarks, maps, catalogues, notes, identity cards, member cards, plastic cards, periodicals, dictionaries, photo albums, calendars, posters, labels, stickers, paper boxes, loose-leaf binders, note cases, self adhesive labels, slogan banners made of paper for decoration, paper banners, teaching materials namely, textbooks, studying materials and notes, visual aids, diagrams, models, pre-recorded tapes, transparencies, reference materials in the fields of gemology, jewelry, jewelry manufacturing, gem analysis, gem cutting, gem inscribing, gem grading, jewelry design, sale and promotion of gems, pearls, and jewelry, valuation and appraisal of gems, pearls and jewelry, and identification of pearls and gems; education materials in the fields of gemology, jewelry, jewelry manufacturing, gem analysis, gem cutting, gem inscribing, gem grading, jewelry design, sale and promotion of gems, pearls, and jewelry, valuation and appraisal of gems, pearls and jewelry, and identification of pearls and gems, namely course books, reference books, exams, scientific charts and graphs, tests, textbooks, courses, booklets, note cards, study guides, course outlines, exam booklets and information pamphlets and guides, reference materials, manuals, answer sheets, printed charts and printed tables; testing materials in the fields of gemology, jewelry, jewelry manufacturing, gem analysis, gem cutting, gem inscribing, gem grading, jewelry design, sale and promotion of gems, pearls and jewelry, valuation and appraisal of gems, pearls and jewelry, and identification of pearls and gems, test booklets score sheets, unmounted photographs, note pads, printed cards, printed diplomas, posters, and cardboard.

services: (1) In-residence, on-site and correspondence courses in gemology including jewelry design, sale and promotion of gems, pearls and jewelry, investigation of genuineness of gems and valuation of gems and pearls.

[16] The Applicant has pointed out that the Opponent has disclaimed the right to the exclusive use of the words GEMOLOGICAL and INSTITUTE apart from each of the registered marks.

[17] As each of the above registrations is extant, the Opponent has met its initial burden under section 12(1)(d).

[18] The Opponent's word mark GEMOLOGICAL INSTITUTE OF AMERICA presents the Opponent's strongest case and so I will focus my analysis on the likelihood of confusion between that mark and the Mark. If the Opponent is not successful based on its word mark, then it will not be successful based on any of its other marks since the word mark has a greater degree of resemblance to the Mark than do the marks of the Opponent that incorporate designs.

[19] It is to be noted that some of the evidence discussed below refers to one or more of the design versions registered by the Opponent. Although use of any of the design versions of GEMOLOGICAL INSTITUTE OF AMERICA may qualify as use of the word mark, there are instances where the design mark appears in such a small format that the words GEMOLOGICAL INSTITUTE OF AMERICA cannot easily be made out. For example, if one looks at the pages from the Opponent's own website *www.gia.edu/education*, introduced as Exhibit 1 to the Johnston affidavit, one sees a logo at the top of each page that may be either version 1 or 2 of GEMOLOGICAL INSTITUTE OF AMERICA & Design, but the logo is so small that the words GEMOLOGICAL INSTITUTE OF AMERICA are not discernible, with the result that such use would not have the effect of the Opponent's word mark acquiring distinctiveness.

[20] 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. Section 6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source.

[21] The test for confusion is one of first impression and imperfect recollection. The Opponent has correctly pointed out that the fact that a consumer might not be confused by the time he/she makes a purchase is not relevant [*Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)].

[22] 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*.]

*inherent distinctiveness of the marks*

[23] Both marks are inherently weak as they are wholly comprised of words that are suggestive, if not descriptive, of their associated wares/services.

*the extent to which each mark has become known*

[24] A mark's distinctiveness can be enhanced through use and promotion. There is no evidence that the Mark has been used or promoted in Canada, but there is evidence that GEMOLOGICAL INSTITUTE OF AMERICA has been used and promoted in Canada, as detailed further below.

[25] The Opponent is a non-profit institution that is involved in education, research, laboratory services and instrument development, all with respect to the gems and jewelry trade. I summarize below the key evidence regarding the extent of the Opponent's use and promotion of the registered marks in Canada:

- The Opponent's gem identification services and diamond grading systems involve generating reports, samples of which are provided as Exhibits 4 and 5 to the Norris affidavit. (Although GIA is the dominant element on the reports, GEMOLOGICAL INSTITUTE OF AMERICA does appear in a legible size below its acronym, as shown in GEMOLOGICAL INSTITUTE OF AMERICA & Design (#3) above.) In the years 2003 to 2008, the annual number of reports invoiced to Canada varied annually from 913 to 2,858, for a total of approximately 10,000 gems. Ms. Norris also provides "[t]he revenue that was generated from the reports, by customers in Canada"; it ranged annually from \$85,720 to \$275,198 US. [paragraph 8, Norris affidavit]



- Ms. Norris attests at paragraph 11 that the Opponent publishes brochures designed to help members of the public understand diamond grading. Exhibit 7 is a representative brochure, which displays GEMOLOGICAL INSTITUTE OF AMERICA & Design (#3); Ms. Norris attests that it is available online to residents in Canada, but she provides no evidence that any Canadians have viewed or requested such brochure.
- Ms. Petrich attests that the Opponent advertises its wares and services in a variety of forms, such as in magazines, by direct mailing of postcards and brochures, and on its website and that virtually every advertisement displays one or more of the Opponent's registered marks. In particular, she discusses ads placed in trade publications that she says have subscribers in Canada. She attests that the Opponent advertised in the Canadian publications *Jewellery Business* (seven times per annum in 2006, 2007 and 2008) and *Canadian Jeweller* (in 2008 and seven times per annum in 2004, 2005 and 2006), as well as in two U.S. publications in 2006 that are available in Canada, namely *JCK* and *Modern Jeweler*. Ms. Petrich says that *Jewellery Business* is described as having over 8,000 subscribers and *Canadian Jeweller* is reported as having more than 10,000 subscribers. While I agree with the Applicant that these figures are hearsay, in view of the fact that Ms. Petrich was not cross-examined, I have accorded some weight to them.
- Ms. Petrich has provided copies of representative promotional pieces displaying one or more of the registered marks that have been sent to Canadians [Exhibit 9]; between 2003 and 2008 the number of promotional pieces mailed annually to Canadian addresses varied from 1335 to 5584 (it is unknown to what extent the mailing lists differed from year to year).
- The Opponent promotes its educational services, instruments, and publications by participating in international trade shows, including a trade show in Toronto in 2008, but attendance figures have not been provided [paragraph 14, Petrich affidavit].
- The Opponent publishes a quarterly journal entitled *Gems & Gemology* that features the registered marks in each issue; in each of the years 2003 through 2008 there were more

than 200 subscribers to the journal who had Canadian mailing addresses [paragraphs 16-19, Petrich affidavit].

- The Opponent also publishes a quarterly newsletter entitled *The Loupe* that displays the registered marks in each issue; although Ms. Petrich states at paragraph 20 that it is distributed throughout the world, including to Canadian residents, only worldwide distribution figures have been provided.
- In addition, the Opponent publishes a bi-weekly electronic bulletin entitled *GIA Insider* which displays the registered marks; it is stated to be available worldwide, including in Canada, but no viewership figures are provided [paragraph 22, Petrich affidavit].
- The Opponent publishes textbooks in the field of gemology and Ms. Petrich says that these are available to Canadians both through Canadian booksellers and by orders placed directly with the Opponent; Ms. Petrich's Exhibit 17 indicates that there have been small sales of books (e.g. 1 in 2003 and at least 11 in 2008) but it is not clear that any of the Opponent's registered marks appears on the books.
- In the years 2003 through 2008, the Opponent annually sold between 221 and 466 "publications, instruments and other merchandise" directly to Canadian residents [paragraphs 25 and 26, Petrich affidavit]. Specimens have not been provided but Ms. Petrich's Exhibit 17 is a chart that provides details of the sales including invoice date, item category and quantity, as well as the "logo type" displayed on each of the specific items. Not all of the items displayed the GEMOLOGICAL INSTITUTE OF AMERICA trade-mark and regarding those that are said to have displayed a GEMOLOGICAL INSTITUTE OF AMERICA & Design (#1) or (#2), it is unknown whether the logo was displayed large enough to read the words GEMOLOGICAL INSTITUTE OF AMERICA.
- The Opponent does not have a campus in Canada, but the Opponent's distance education courses have been available to residents in Canada since at least as early as 1969; the number of Canadian residents enrolled in distance education courses administered in association with the registered marks between 2003 and 2008 varied annually from 307

to 416. In order to complete a program, individuals must attend and complete required laboratory classes in addition to their distance education courses; the number of individuals who attended laboratory classes provided by the Opponent in Canada between 2003 and 2008 varied annually from 91 to 153. Various materials displaying the registered marks are sent to Canadian residents who either express an interest in or are enrolled in the Opponent's distance education programs. [paragraphs 6 - 13, Johnson affidavit]

[26] Based on the foregoing summary, I find that the Opponent's GEMOLOGICAL INSTITUTE OF AMERICA trade-mark is currently more known in Canada than is the Mark, i.e. the Opponent's mark has acquired some distinctiveness whereas the Mark has not. However, based on the figures provided I cannot conclude that the Opponent's mark is well known.

[27] Before proceeding, I will note that Ms. Norris attests at paragraph 5: "[The Opponent] is considered by many to be the world's most trusted name in diamond grading and gemstone identification, and the GIA Diamond Grading Report, Diamond Dossier, and Gemological Identification Report are considered the world's premier gemological credentials. Marked as Exhibit 3 to my affidavit are printouts from third party websites describing the reputation of [the Opponent]." However, the Opponent's reputation and use in other countries are not relevant in this proceeding. In addition, copies of third party websites are only evidence that such a page existed at the time that it was printed – they are not evidence of the truth of their contents [*Candrug Health Solutions Inc v Thorkelson* (2007), 60 CPR (4th) 35 (FCTD)].

*the length of time the marks have been in use*

[28] The Opponent was founded in 1931 in the United States, but its affiants have only provided details concerning use of its registered marks in Canada from 2003. As the Applicant has not evidenced any use of its Mark, the length of time the marks have been in use in Canada favours the Opponent.

*the nature of the wares, services, business and trade*

[29] When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark application and registrations that govern in respect of the issue of confusion arising under section 12(1)(d) [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe, Inc v Dale Bohna* (1984), 58 CPR (3d) 381 (FCA)].

[30] The parties appear to be in agreement that their respective wares, services, business and trade are the same or overlap [paragraphs 52-54 of Opponent's written argument and paragraphs 50-51 of Applicant's written argument].

[31] Ms. Norris states at paragraph 9 of her affidavit, "The [Opponent] offers services to the public, as well as to government and law enforcement agencies, however the gross majority of its business and revenue comes from companies in the manufacturing and retail sector of the diamond and jewelry trade. This would be the exact client base, or prospective client base, for any business engaged in providing diamond grading or gem identification services to the jewelry business." The Applicant has not contradicted this, but instead has submitted that the dominant consumer, "companies in the manufacturing and retail sector of the diamond and jewelry trade", is sophisticated and knowledgeable.

*the degree of resemblance between the marks*

[32] The resemblance between the marks in appearance, sound and ideas suggested is primarily due to the first word of each mark (GEMOLOGY versus GEMOLOGICAL). Although the first component of a mark is often considered more important for the purpose of distinction, when a word is a common, descriptive or suggestive word, the significance of the first component decreases [see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD); *Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA); *Phantom Industries Inc v Sara Lee Corp* (2000), 8 CPR (4th) 109 (TMOB)].

[33] Although both marks suggest an organization that performs gemology-related services, the Mark suggests the head office of an international business whereas the Opponent's mark suggests an educational institute based in the United States.

[34] The words HEADQUARTERS INTERNATIONAL versus INSTITUTE OF AMERICA result in differences between the marks when considered as a whole in each of the categories of sound, appearance and ideas suggested.

[35] In the case of inherently weak marks, such as those at issue here, small differences may suffice to distinguish them and, given the clearly descriptive nature of the first word of each mark, the differences between the marks as a whole are as great as their similarities.

*other surrounding circumstances*

[36] A number of other surrounding circumstances have been raised by the parties.

[37] Ms. Sanchez has evidenced that both the Mark and GEMOLOGICAL INSTITUTE OF AMERICA have been registered as trade-marks in the United States of America. However, the mere coexistence of marks on foreign registers is not relevant to the issue of the likelihood of confusion in Canada [*Vivat Holdings Ltd v Levi Strauss & Co* (2005), 41 CPR (4th) 8 (FC)].

[38] The Applicant filed certified copies of some third party Canadian trade-mark registrations/applications, which it relies on in support of an argument that "the Canadian public is well used to distinguishing between and among various marks or names containing words such as GEMOLOGICAL or GEMOLOGY, INSTITUTE, INTERNATIONAL, LABORATORIES or LAB." [paragraph 57, Applicant's written argument]

[39] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located. [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432; *Del Monte Corporation v Welch Foods Inc* (1992), 44 CPR (3d) 205 (FCTD); *Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)] The Opponent's position is that there are insufficient relevant marks to draw any conclusion about the state of the marketplace.

[40] The most relevant of the marks that are the subject of registrations or allowed applications are:

1. UNIVERSAL GEMOLOGICAL SERVICES
2. INTERNATIONAL GEMOLOGICAL INSTITUTE
3. CI CANADIAN INSTITUTE OF GEMMOLOGY & Design
4. EUROPEAN GEMOLOGICAL LABORATORY
5. AGS GEMOLOGICAL LABORATORIES & Design
6. AMERICAN GEM SOCIETY LABORATORIES
7. GEM SCAN INTERNATIONAL INC. & Design
8. GEMLAB GROUP & Design
9. GEMMOLOGIST PELAGRINA GEMMOLOGIST
10. ACCREDITED GEMMOLOGIST (C.I.G.)

[41] It is questionable if any meaningful inference can be drawn from this quantity of evidence. At best, the inference would be that marks which include a formative of the word GEM seem to coexist in common fields without the benefit of distinctive additional components. While such an inference might serve the Applicant's interests, it is not necessary to rely on state of the register evidence to apply the principle that small differences may serve to distinguish marks that have a low degree of inherent distinctiveness.

[42] Ms. Sanchez also provided evidence of some third party websites, some of which seem to corroborate that the marks identified as #2 and 3 above are present in the Canadian marketplace. The Opponent's position is that the website pages are meaningless because they are only evidence of their existence and there is no evidence that Canadians have accessed such websites. I agree that a website is not evidence of the truth of its contents and that the mere existence of a website does not show that it has been accessed by Canadians [see *Candrug, supra*]. I am not however prepared to discount the website evidence completely, as I consider it to be of some value in showing that some of the registered marks are not deadwood. That said, I do not consider Ms. Sanchez' website evidence to be determinative of the outcome of this case.

[43] Regarding the state of the marketplace, I note that the Opponent's own evidence shows Gemological Institute of America (the Opponent's mark/name) listed in the Buyers' Guide index of a 2008 edition of the Canadian publication *Jewellery Business*, where the following similar trade-marks or trade-names are also listed: Canada Gem Laboratory; Canadian Institute of Gemmology; European Gemological Laboratory; Gem Grade Appraisal Service; Gem Scope Appraisal Laboratories; Gemlab Books & Instruments; Gemmologistes Associes; International Gemological Institute [Exhibit 4, Petrich affidavit]. Such evidence bolsters the Applicant's position.

*conclusion re section 12(1)(d) ground*

[44] Having considered all of the surrounding circumstances, I have concluded that, on a balance of probabilities, there is not a reasonable likelihood of confusion between the marks at issue. While it is true that the majority of the circumstances listed under section 6(5) favour the Opponent, the assessment of the likelihood of confusion is not an arithmetical process. In most instances it is the degree of resemblance between the trade-marks that is the most crucial factor in determining the issue of confusion [*Masterpiece; Beverley Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2d) 145 (FCTD) at 149, affirmed 60 CPR (2d) 70]. Here, the resemblance between the marks is primarily a result of the fact that one begins with GEMOLOGY and the other with GEMOLOGICAL – words that are clearly descriptive of the parties' field. The Opponent is not entitled to monopolize the descriptive word GEMOLOGY or derivatives thereof.

[45] The Opponent seems most concerned that confusion might arise in the mind of an unsophisticated individual consumer of a gem grading report or certificate. There is very little evidence concerning this portion of the parties' trade/clientele. Ms. Norris has indicated that such a consumer is a very minor portion of the Opponent's clientele and the Opponent has submitted at paragraph 58 of its written argument, "It is important to realize that the consumer may focus more on the trade-marks of the manufacturer or retailer of the jewelry and, while recognizing the need for a grading report, may pay less attention to [the] entity behind the grading report."

[46] Regardless of whether I consider a manufacturer, retailer or individual, I am satisfied that the inherent weakness of the parties' marks prevents confusion from occurring as a matter of first

impression. Both marks are almost generic in nature and include no highly distinctive portion; the Opponent's mark is known in Canada but it has not been shown to be well known. I do not think that it is appropriate to conclude that a consumer is likely to assume that there is a common source just because both marks make reference to gemology; the differences between the marks as a whole are sufficient to distinguish one from the other.

[47] For the foregoing reasons, the section 12(1)(d) ground of opposition is dismissed in its entirety.

#### Other Grounds of Opposition

[48] As indicated earlier, the section 12(1)(d) ground presented the Opponent's strongest case. Therefore the remaining grounds fail for reasons similar to those set out with respect to the section 12(1)(d) ground.

#### Disposition

[49] 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.

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