



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

Citation: 2013 TMOB 156
Date of Decision: 2013-09-24

IN THE MATTER OF OPPOSITIONS
by City of Terrace to application
Nos. 1,447,624 and 1,447,857 for the
trade-marks KERMODE WARRIOR
and KERMODE WARRIOR & Design in
the name of CanadianPacific
Phytoplankton Ltd.

I. Background

[1] City of Terrace (the Opponent) is the owner of the official marks KERMODE BEAR and KERMODEI BEAR. The Registrar gave public notice of City of Terrace's adoption and use of these official marks on January 21, 2004 under application Nos. 915,507 and 915,506, respectively.

[2] CanadianPacific Phytoplankton Ltd. (the Applicant) applied to register the trade-marks KERMODE WARRIOR (the Mark) and KERMODE WARRIOR & Design (the Design Mark), shown below, on August 10, 2009 and August 11, 2009, respectively.



[3] Both of the applications are based upon proposed use in Canada and they both cover various dietary and nutritional supplements, beverages for medicinal purposes and a range of personal care products such as shampoos, body lotions, etc.

[4] City of Terrace has opposed the applications under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) on the grounds that: (i) they do not conform to the requirements of section 30(i) of the Act; (ii) the trade-marks are not registrable under section 12(1)(a) of the Act as they are primarily merely the name or surname of an individual who is living or has died within the preceding thirty years; and (iii) the trade-marks are not registrable under section 12(1)(e) of the Act, as they are marks, the adoption of which is prohibited by section 9 (1)(n)(iii) of the Act, in view of the Opponent's aforementioned official marks KERMODE BEAR and KERMODEI BEAR.

[5] Both of the parties filed evidence and written submissions. The evidence and the written submissions are the same in each case. The Opponent also requested leave to file additional evidence during the course of the proceedings. However, the request for leave was denied. No oral hearing was held.

[6] For the reasons that follow, I have concluded that the applications do conform to the requirements of section 30(i) of the Act and that the trade-marks are registrable under sections 12(1)(a) and 12(1)(e) of the Act.

II. Onus

[7] 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].

III. Analysis

Application No. 1,447,624

Section 30(i)

[8] Section 30(i) of the Act requires an Applicant to include a statement in the application that the Applicant is satisfied that it is entitled to use the trade-mark in Canada. Where an Applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) can be found only where there are exceptional circumstances that render the Applicant's statement untrue, such as evidence of bad faith or non-compliance with a federal statute [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155 and *Canada Post Corporation v Registrar of Trade-marks* (1991), 40 CPR (3d) 221 (FCTD)]. Those circumstances do not exist in the present case. Accordingly, this ground of opposition is rejected.

Section 12(1)(a)

[9] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of section 12(1)(a) of the Act in that it is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years.

[10] The material date to assess this ground of opposition is the filing date of the Applicant's application, namely August 10, 2009 [see *Calvin Klein Trade-mark Trust v Wertex Hosiery Inc* (2004), 41 CPR (4th) 552 (TMOB) and *Jurak Holdings Ltd v Matol Biotech Laboratories Ltd* (2006), 50 CPR (4th) 337 (TMOB)].

[11] In *Jurak Holdings Ltd v Matol Biotech Laboratories Ltd* (2007), 64 CPR (4th) 195 (TMOB), affd 69 CPR (4th) 321 (FC), Member Carrière summarized the test under section 12(1)(a) as follows, at para 16:

The leading cases on the issue of non-registrability of a trade-mark consisting of primarily merely the name or surname of an individual who is living or has died in the preceding thirty years are *Canada (Registrar of Trade-marks) v Coles Book Stores Ltd*, [1974] SCR 438, 4 CPR (2d) 1, *Gerhard Horn Investments Ltd v Registrar of Trade-marks* (1983), 73 CPR (2d) 23 (FCTD) and *Standard Oil Co v Canada (Registrar of Trade Marks)*, [1968] 2 Ex CR 523, 55 CPR 49. As set out in those cases the test under s. 12(1)(a) is two-fold:

- 1) The first and foremost condition is whether the Mark is the name or surname of a living individual or an individual who has recently died;

2) If the answer to the first question is affirmative, then the Registrar must determine if in the mind of the average Canadian consumer the Mark is "primarily merely" a name or surname rather than something else.

[12] Although the Opponent has pleaded section 12(1)(a) in its statement of opposition, it has not made any submissions in relation to this ground in its written argument. Moreover, it has filed evidence to suggest that the word KERMODE has significance as both a surname and as a subspecies of the American black bear which lives in the central and north coastal regions of British Columbia [see exhibits "B"- "D" of the affidavit of Laura Duckett, sworn August 29, 2011].

[13] The Applicant asserts that section 12(1)(a) is not applicable as the trade-mark is not KERMODE *per se*, but rather KERMODE WARRIOR and it is therefore not a word that is primarily merely a name or a surname. The Applicant further submits that even if section 12(1)(a) were applicable, the evidence suggests that KERMODE is not primarily merely a surname, as it is also an animal species.

[14] The evidence of record is sufficient to establish that "KERMODE" is a surname. However, as noted by the Applicant, the trade-mark is formed of a combination of the word KERMODE, which has significance as both a surname and as a species of bear and the word WARRIOR, which is an ordinary dictionary term. In view of this, I agree with the Applicant that the trade-mark as a whole is not contrary to section 12(1)(a) of the Act because in its entirety, it is not primarily merely a name or surname [see *Molson Cos v John Labatt Ltd* (1982) 58 CPR (2d) 157 (FCTD)].

[16] The ground of opposition based upon section 12(1)(a) of the Act is therefore rejected.

Section 12(1)(e)

[15] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of section 12(1)(e) of the Act in that it is a mark, the adoption of which is prohibited by section 9(1)(n)(iii) of the Act.

[16] Section 9(1)(n)(iii) of the Act is reproduced below:

9(1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for,

.....
(n) any badge, crest, emblem or mark

.....
(iii) adopted and used by any public authority, in Canada as an official mark for wares or services, in respect of which the Registrar has, at the request of Her Majesty or of the university or public authority, as the case may be, given public notice of its adoption and use;

[17] The material date for assessing this ground of opposition is the date of my decision [see *Canadian Olympic Assn v Allied Corp* (1989), 28 CPR (3d) 161 (FCA) and *Canadian Olympic Assn/Assoc Olympique Canadienne v Olympus Optical Co* (1991), 38 CPR (3d) 1 (FCA)].

[18] In support of this ground, the Opponent relies upon its official marks KERMODE BEAR and KERMODEI BEAR. I have exercised my discretion and checked the register to confirm that each of these official marks are extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[19] I note that there is no evidence on the record regarding the Opponent's adoption and use of its official marks. Nor is there any evidence to demonstrate that the Opponent is, in fact, a public authority.

[20] In this particular case, the Applicant has not called into question the Opponent's status as a public authority, nor has it challenged the Opponent's adoption and use of its official marks. In the absence of any evidence suggesting that the Opponent's official marks have not been used, the Opponent is not required to evidence adoption and use of its official marks [see *Canadian Olympic Assn v Allied Corp* at p. 166]. Moreover, since the Applicant has not cast doubt on whether the Opponent qualifies as a public authority, the Opponent is not required to evidence its status as such in order to rely upon its official marks [see *Big Sisters Association of Ontario v. Big Brothers of Canada* (1999), 86 CPR (3d)504 (FCA); affg. (1997) CPR (3d) 177 (FCTD) and *Vancouver Organizing Committee v Brownridge* (2009) CanLII 90466 (TMOB)].

[21] The Opponent has therefore met its initial burden with respect to this ground. In view of this, I must now go on to determine whether the test in section 9(1)(n)(iii) has been met.

[22] As stated in section 9(1)(n)(iii) of the Act, the test to be applied is whether or not the Applicant's mark consists of, or so nearly resembles as to be likely to be mistaken for, the official mark. The case law has interpreted "consisting of" in section 9 to mean "identical to". Regarding the resemblance test set out in section 9, the case law indicates that it should be applied as a matter of first impression and imperfect recollection, with regard to the factors set out in section 6(5)(e) [See *Big Sisters Assn of Ontario v Big Brothers of Canada* (1999), 86 CPR (3d) 504 (FCA), affirming (1997), 75 CPR (3d) 177 (FCTD) and *Canadian Council of Professional Engineers v APA-The Engineered Wood Assn* (2000), 7 CPR (4th) 239 (FCTD)].

[23] It is clear that the Applicant's trade-mark KERMODE WARRIOR is not identical to either of the Opponent's official marks, namely KERMODE BEAR and KERMODEI BEAR. I must therefore consider whether it so nearly resembles either of the Opponent's marks so as to be likely to be mistaken therefor.

[24] The Applicant takes that position that its Mark does not so nearly resemble the Opponent's official marks so as to be likely to be mistaken for them. The Applicant has extensively referenced case law in its written argument. However, its submissions are not particularly substantive in nature.

[25] As evidence, the Applicant has filed the affidavit of Alan Booth, a trade-mark searcher, sworn November 7, 2011. Exhibit "A" to Mr. Booth's affidavit consists of a portion of the file history for the application for the Mark. Exhibit "B" consists of a portion of the file history for the application for the Design Mark and Exhibit "C" consists of a portion of the file history for trade-mark registration no. TMA711440 for the trade-mark KERMODE SPIRIT BEARS IN THE CITY, which is owned by a third party.

[26] The Applicant asserts that it is clear from the file histories for each of these KERMODE formative marks that the Examiner in each case was aware of the Opponent's official marks during examination and still approved them. The Applicant appears to be of the view that this is of significance in this opposition proceeding. I disagree.

[27] Indeed, a decision by the Examination Section of the Canadian Intellectual Property Office is not binding on this Board and does not have any precedential value. The Examination

Section does not have before it evidence that is filed by the parties in an opposition proceeding. Furthermore, the burden on an Applicant differs whether the application is at the examination stage or at the opposition stage.

[28] The Opponent is, of course, of the view that the Mark does so nearly resemble its official marks so as to be likely to be mistaken for them, presumably as a result of the inclusion of KERMODE in the Mark. The Opponent contends that KERMODE is commonly understood to refer to the “Kermode bear” and it therefore takes the position that the word KERMODE in the Mark suggests the same meaning as it does in the Opponent’s KERMODE BEAR and KERMODEI BEAR official marks.

[29] In addition to the evidence it has filed to demonstrate that KERMODE is a species of bear (see paragraphs 6 and 7 and Exhibits “E” and “F” of the affidavit of Laura Duckett, sworn August 29, 2011), the Opponent has also filed printouts from the Applicant’s websites located at *www.kermodewarrior.com* and *www.kermodenaturals.com* (see paragraphs 8 and 9 of the Duckett affidavit and Exhibits “G” and “H”). The websites display the Mark (Exhibit “G”) and the words Kermode Naturals (Exhibit “H”) in conjunction with bear designs.

[30] The Opponent submits that the Applicant’s use of a bear design in conjunction with its trade-mark KERMODE WARRIOR makes it clear that the Mark is intended to refer to the Kermode bear and not to suggest any other idea.

[31] Even if I were to accept that the word KERMODE in the parties’ marks would be recognized as being a reference to the Kermode bear, this does not necessarily lead to an automatic conclusion that the marks would be likely to be mistaken for one another.

[32] Although the parties’ marks may be said to be similar to the extent that they include the word KERMODE (or the variant KERMODEI), they also include additional words which serve to create visual and phonetic differences, as well as differences in connotation. In particular, the addition of the word WARRIOR in the Mark results in differences in appearance and sound, as well as a somewhat different connotation, since the latter part of the Opponent’s marks is formed of the word BEAR. In my view, a “bear” would not typically be considered to be a “warrior” and there is no evidence to suggest otherwise.

[33] When one considers the marks in their entirety, I find that the resemblance between them in appearance, sound and idea suggested is insufficient to result in the Mark being likely to be mistaken for the Opponent's official marks.

[34] Accordingly, this ground of opposition is rejected.

Application No.1,447,857

[35] The statement of opposition filed against application No.1,447,857 for the Design Mark pleads the same grounds of opposition as those which have been pleaded against application No.1,447,624.

[36] The section 30(i) and section 12 (1)(a) grounds pleaded with respect to application No. 1, 447, 857 are rejected for the same reasons that they were rejected in relation to application No. 1, 447, 624, as the minor difference in the material dates for the applications has no impact on my analysis.

[37] With respect to the section 12(1)(e) ground, I am of the view that the design features, as well as the additional reading matter in the Design Mark serve to further differentiate it from the Opponent's official marks. The Design Mark essentially consists of the words KERMODE WARRIOR against a sign or banner type backdrop enclosed within the arms of a large bear, with the French words KERMODE GUERRIER in smaller print below. The bear forms a relatively large and dominant part of the Design Mark. As a result of the overall visual impact created by the Design Mark, as well as the visual and phonetic differences between the marks in question, I am satisfied that the Design Mark does not so nearly resemble either of the Opponent's official marks so as to be likely to be mistaken therefor.

[38] Accordingly, this ground of opposition is also rejected.

Disposition

[39] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject both of the oppositions pursuant to section 38(8) of the Act.

Lisa Reynolds
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office