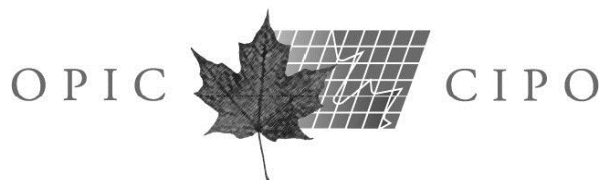


TRADUCTION/TRANSLATION



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

Citation: 2012 TMOB 27
Date of Decision: 2012-02-10

**IN THE MATTER OF AN OPPOSITION
by Les Abris Harnois Inc. to application
No. 1 348 297 for the trade-mark
NAVIGLOO & Design in the name of
Prima Innovations Inc.**

[1] May 22, 2007, Prima Innovations Inc. (the Applicant) filed an application to register the trade-mark NAVIGLOO & Design illustrated below (the Mark) in relation to "shelters for boats" based on proposed use in Canada.



[2] The application was advertised for opposition purposes on October 15, 2008, in the *Trade-marks Journal*.

[3] On October 27, 2008, Les Abris Harnois Inc. (the Opponent) filed a statement of opposition. In sum, the grounds of opposition raised pursuant to the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) are the following:

- the application does not satisfy the requirements of paragraphs 30(e) and 30(i) of the Act;

- the Mark is not registrable pursuant to paragraph 21(1)(d) of the Act because it is confusing with the IGLOU & Design trade-marks (registration Nos. TMA280 836 and TMA632 281) illustrated below:

No. TMA280 836



No. TMA632 281



- the Applicant is not the person entitled to the registration of the Mark, pursuant to subsections 16(2) and 16(3) of the Act, because at the filing date of the application, the Mark was confusing with the IGLOU and IGLOU & Design trade-marks previously used in Canada in association with temporary automobile shelters as well as with the applied-for IGLOU & Design trade-marks (Nos. 445 112 and 1 202 747) previously filed by the Opponent;
- the Mark is not distinctive in that it is not adapted to distinguish the Applicant's wares from the wares of the Opponent in association with which the latter uses the IGLOU and IGLOU & Design trade-marks.

[4] The Applicant filed and served a counter-statement in which it denied the grounds pleaded in the statement of opposition.

[5] To support its position, the Opponent filed an affidavit from Lucie Lamarche, dated May 28, 2009, accompanied by Exhibits LL-1 to LL-4. The Applicant did not cross-examine Ms. Lamarche.

[6] In support of its application, the Applicant filed an affidavit from Isabelle Richard, dated September 30, 2009, accompanied by Exhibits 1 to 7. The Opponent did not cross-examine Ms. Richard.

[7] Only the Applicant filed a written argument and attended an oral hearing.

Evidential Burden

[8] The Applicant has the onus of demonstrating that its application complies with the requirements of the Act. However, the Opponent bears the burden of ensuring that each of its grounds of opposition is duly argued and discharging its initial evidential burden by establishing facts supporting its grounds of opposition [*see John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.); and *Wrangler Apparel Corp. v. The Timberland Company* (2005), 41 C.P.R. (4th) 223 (F.C.A)].

[9] I discuss below the evidential burden filed by each party. I will discuss particular elements of evidence more specifically in my analysis of the grounds of opposition.

Opponent's Evidence

[10] Ms. Lamarche is the Director of Operations for and has been an employee of the Opponent since 1999 [para. 1-2]. The Opponent has worked in the field of temporary structure and shelter design and manufacture since 1978 [para. 5].

[11] I reproduce below paragraph 6 of Ms. Lamarche's affidavit:

[TRANSLATION] The Opponent obtained registration for the IGLOU & Design trade-mark (TMA632 281) on February 8, 2005, and the IGLOU & Design trade-mark (TMA280 836) on June 30, 1983, (hereafter "the Marks") as it appears on copies in the Trade-marks Registry filed en liasse in support of my affidavit under Exhibit LL-1.

[12] I note that the subsequent use of the terms "IGLOU & Design Marks" in my discussion of Ms. Lamarche's affidavit reflects her use of the terms "the Marks". I also note that any ambiguity resulting from the use of the terms "the Marks" in the affidavit will be interpreted against the Opponent [*see Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)].

[13] I note that registration copies attached to the affidavit originate from the Canadian Intellectual Property Office (CIPO)'s Canadian Trade-marks Database, updated as of April 7, 2009. The Opponent is registered as the owner of the registrations. Based on the Applicant's oral representations, which I will return to in my analysis of the grounds of opposition, I note that the copies of the registrations demonstrate the following: the IGLOU & Design (TMA280 836) mark

has been registered on the basis of its use in Canada since at least September 1978; the IGLOU & Design mark (TMA632 281) has been registered on the basis of its use in Canada since January 1, 2000; the Opponent is the original owner of registration No. TMA632 281; the company "90379 Canada Ltd." was the original owner of registration No. TMA280 836. The footnotes for registration No. TMA280 836 show that CIPO registered the following changes of title:

- assignment as of September 1, 1983, from 90379 Canada Ltd. to Les Piscines et Abris Tempo Inc.;
- assignment as of January 29, 1987, from Les Piscines et Abris Tempo Inc. to 100923 Canada Ltd.;
- assignment as of November 28, 2001, from 100923 Canada Ltd. to Les Piscines et Abris Tempo Inc.; and
- name change as of March 14, 2002, from Les Piscines et Abris Tempo Inc. to Les Abris Harnois Inc.

[14] Ms. Lamarche states that the Opponent has used the IGLOU mark in association with shelters since at least as early as September 1978 and the IGLOU & Design mark (TMA632 281) in association with temporary automobile shelters made of galvanized steel and covered with canvas since at least as early as January 1, 2000 [para. 7]. Ms. Lamarche states that she has attached [TRANSLATION] "copies of invoices from 2002 to 2008... which demonstrate the sale of IGLOU shelters over the course of that period" [para. 8, Exhibit LL-2]. I note that these invoices are addressed to Rona Corporation (Boucherville, Quebec). They were issued in 2002, 2005, 2007 and 2008. The Opponent did not retain the invoices from the years prior to 2002 [para. 9].

[15] In order to demonstrate the use of the IGLOU & Design Marks, Ms. Lamarche attached photographs of automobile shelters, a data sheet and a specifications sheet for the products sold at Rona [para. 10, Exhibit LL-3]. The photographs depict the IGLOU & Design trade-mark (TMA632 281) on the shelters. Furthermore, I am of the view that the use of the IGLOU & Design trade-mark (TMA632 281) on the shelters may also be considered as use of the IGLOU mark pursuant to subsection 4(1) of the Act.

[16] Ms. Lamarche states that since 1978, [TRANSLATION] "The Opponent has sold over 40 000 products bearing the IGLOU mark to Canadian clients" [para. 12]. According to the

annual breakdown in the affidavit, shelter sales associated with the IGLOU & Design Marks total approximately \$11 663 521 for the years 2001 to 2007 [para. 13]. The amounts spent on the advertising and promotion of products associated with the IGLOU & Design Marks for the same period total approximately \$233 266 [para. 14]. The affidavit contains no information on the type of advertising, nor is it accompanied by advertising samples.

[17] Ms. Lamarche has made statements related to the notoriety of the IGLOU & Design Marks in the field of temporary shelter products [para. 11] and the risk of confusion between the Mark and the IGLOU & Design Marks [para. 15-19]. I give no weight to Ms. Lamarche's opinions regarding questions of fact and law to be determined by the Registrar on the basis of the evidence in the record. I also note that to support her opinion regarding the risk confusion, Ms. Lamarche attached excerpts from a website that she states belong to the Applicant [Exhibit LL-4]. I note that the only date related to these excerpts is found in the "Copyright © 2009..." notification which appears at the bottom of one of the excerpts.

Applicant's Evidence

[18] At the time of the affidavit, Ms. Richard had been the Applicant's treasurer for three years [para. 1]. The Applicant has manufactured and distributed boat equipment since 2004 [para. 4].

[19] Ms. Richard states that the prefix "nav" in the Mark originates from the word "navigation" and the suffix "igloo" refers to a winter shelter. [para. 6, Exhibit 1].

[20] According to Ms. Richard's statements, as of the date of the affidavit, boat shelters associated with the Mark had been sold by the Applicant [TRANSLATION] "for over two years [para. 7]. The Mark is affixed directly onto the merchandise, which is packaged in a box that also bears the Mark [para. 8-9, Exhibits 2-3]. On account of their design, shelters associated with the Mark, which comprise a system for storing boats over the winter, are installed directly onto boats. They cannot be used as automobile shelters [para. 12]. Ms. Richard has attached a copy of the system's operation manual [Exhibit 5].

[21] According to the annual breakdown in the affidavit, sales of boat shelters associated with the Mark total approximately \$768 000 for the period of June 2007 to August 2009 [para. 13]. Ms. Richard has attached copies of invoices [para.11, Exhibit 4]. I note that the invoices addressed to Kimpex (Drummondville, Quebec) and ATL Distributing (Peterborough, Ontario) cover the years 2008 and 2009.

[22] Ms. Richard states that an amount of approximately \$280 000 has been spent by the Applicant since 2007 for advertising the wares associated with the Mark, and has attached [TRANSLATION] "sample advertisements" [para. 13, Exhibit 7]. Ms. Richard states that the Applicant [TRANSLATION] "advertises [w]ares bearing the Mark through a website" at *www.navigloo.com* and has done so since 2007, and she has filed [TRANSLATION] "relevant excerpts" [para. 14, Exhibit 7].

[23] Ms. Richard states that she was unaware of any confusion between the Mark and the Opponent's IGLOU & Design trade-marks [para. 16].

Analysis of the Grounds of Opposition

[24] I will proceed to the analysis of the grounds of opposition, but not necessarily in the order in which they were pleaded.

[25] At the outset, I reject the grounds of opposition raised pursuant to subsection 16(2) of the Act by reason of the fact that they are invalid since the registration application is based on the proposed use of the Mark in Canada.

[26] I also reject, from the outset, the second prong of the ground of opposition raised pursuant to subsection 16(3) of the Act and based on registration applications previously filed by the Opponent [para. 16(3)(b) of the Act]. Since the applications alleged by the Opponent proceeded to registration on June 30, 1983, and February 8, 2005, respectively, they were no longer pending on the date of advertisement of the application for the Mark [subs. 16(4) of the Act]. Consequently, the ground of opposition is invalid [see *Governor and Co. of Adventurers of England trading into Hudson's Bay v. Kmart Canada Ltd.* (1997), 76 C.P.R. (3d) 526 (T.M.O.B.)].

Non-compliance with Section 30 of the Act

[27] The material date for assessing a ground of opposition based on non-compliance with section 30 of the Act is the registration application filing date [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)].

Non-compliance with Subsection 30(e) of the Act

[28] In addition to the lack of representations from the Opponent regarding this ground of opposition, no allegation supports the ground of opposition. Further, the evidence on record does not show that the Applicant falsely declared having had the intention to use the Mark in Canada [see *Home Quarters Warehouse, Inc. v. Home Depot, U.S.A., Inc.* (1997), 76 C.P.R. (3d) 219 (T.M.O.B.); *Jacobs Suchard Ltd. v. Trebor Bassett Ltd.* (1996), 69 C.P.R. (3d) 569 (T.M.O.B.)]. Consequently, I dismiss the ground of opposition.

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

[29] The ground of opposition is rejected because the allegation made regarding the Applicant being aware of the Opponent's use of the trade-marks does not constitute a valid ground of opposition. Paragraph 30(i) of the Act requires that the requesting party provide a statement that it is satisfied that it is entitled to use the trade-mark in Canada in association with the wares or services described in the application. The Applicant has strictly complied with the requirements of this provision. I will add that jurisprudence has long established that a ground of opposition based on non-compliance with paragraph 30(i) should not be retained except in specific cases, namely when the Applicant's bad faith is alleged and established or when specific legislative provisions provide an obstacle to the registration of the applied-for mark [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) and *Canada Post Corporation v. Registrar of Trade-marks* (1991), 40 C.P.R. (3d) 221 (F.C.T.D.)]. This is not the case.

Entitlement to Registration Pursuant to Paragraph 16(3)(a) of the Act

[30] The material date for assessing the ground of opposition based on confusion between the Mark and each of the trade-marks alleged by the Opponent is the registration application filing date [subs. 16(3) of the Act].

[31] Despite the burden of proof that is the Applicant's to establish, the Opponent has the initial burden to prove that it used the alleged marks in Canada prior to the material date and had not abandoned the use of these Marks on the advertisement date of the application [subs. 16(5) of the Act].

[32] My analysis of this ground of opposition leads me to return to the Applicant's representations regarding the evidence of use of the IGLOU and IGLOU & Design trade-marks by the Opponent. I would add that the Applicant's representations are in part based on the footnotes of registration No. TMA280 836 [see paragraph 13 of my disposition].

[33] During the oral hearing, the Applicant submitted a statement from Ms. Lamarche to the effect that the Opponent [TRANSLATION] "obtained" registration No. TMA280 836 on June 30, 1983, is contradicted by the inscription of the Opponent (then known by the name of Les Piscines et Abris Tempo Inc.) as the owner of this registration following an assignment on November 28, 2001. Further, the Applicant reiterated its written representations to the effect that Ms. Lamarche's affidavit was insufficient to prove use of the IGLOU & Design trade-mark (TMA280 836) by the Opponent at any given time. The Applicant also reiterated its written representations to the effect that the Opponent's evidence does not support Ms. Lamarche's statements regarding the use by the Opponent of the IGLOU mark since at least as early as September 1978 and of the IGLOU & Design mark (TMA632 281) since January 1, 2000. During the oral hearing, the Applicant submitted that if I concluded that the evidence shows the use of the two marks from the alleged dates, then I must conclude that all use prior to November 28, 2001, did not constitute use by the owner. I would add that during the hearing, the Applicant acknowledged that all reliable proof of the use of the IGLOU & Design mark (TMA632 281), within the meaning of subsection 4(1) of the Act, may also be considered as evidence of the use of the IGLOU mark.

[34] It is probable that a more complete picture of the use of the IGLOU and IGLOU & Design trade-marks could have been obtained in the context of a cross-examination of Ms. Lamarche, but the Applicant chose to refuse this option. That being said, the lack of a cross-examination does not prohibit me from addressing the reliability of Ms. Lamarche's written testimony.

[35] I acknowledge that the Applicant's claims concerning use of the term [TRANSLATION] "obtained" in Ms. Lamarche's statement with respect to registration No. TMA280 836 are not without merit. However, I am not prepared to attach significant weight to this statement. In other words, I do not believe that the use of the term [TRANSLATION] "obtained" discredits Ms. Lamarche's written testimony in its entirety. Nevertheless, I am entirely convinced of the Applicant's representations regarding the lack of proof of use of the IGLOU & Design mark (TMA280 836) in Canada at any given time.

[36] I find that the chain of title of registration No. TMA280 836 tends to support the Applicant's assertions with respect to the use of the IGLOU and IGLOU & Design trade-marks (TMA632 281) by the Opponent prior to November 28, 2001. Consequently, I accept the Applicant's representations regarding the gaps in the Opponent's evidence with respect to the use of its IGLOU and IGLOU & Design marks (TMA632 281). Nevertheless, according to a reasonable interpretation of Ms. Lamarche's entire affidavit, I conclude that the evidence is sufficient to show use in Canada of the IGLOU and IGLOU & Design trade-marks (TMA632 281) by the Opponent since at least 2002.

[37] Given the above, I conclude that the Opponent has not met the initial evidential burden to show use of the IGLOU & Design mark (TMA280 836) prior to the material date, and I reject the ground of opposition based on prior use of the aforementioned mark. Nevertheless, I conclude that the Opponent has discharged its initial burden of proving that it used the IGLOU and IGLOU & Design trade-marks (TMA632 281) prior to May 22, 2007, and that it had not abandoned their use as of October 15, 2008. As a result, the Applicant has the burden of convincing the Registrar, on the balance of probabilities, that on May 22, 2007, the Mark did not cause confusion with the IGLOU and IGLOU & Design trade-marks (TMA632 281).

[38] The test for confusion is one of first impression and imperfect recollection. Subsection 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.

[39] In deciding whether or not marks are confusing, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in subsection 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 the trade-marks have 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. This is not an exhaustive list, and different weight may be attributed to each factor according to the context [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al* (2006), 49 C.P.R. (4th) 401 (S.C.C.); and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.) for an in-depth analysis of the general principles applicable to a test for confusion].

[40] In my opinion, the increase in the likelihood of confusion between the Mark and the Opponent's IGLOU trade-mark will decide the outcome of the ground of opposition. In other words, if I concluded that the Mark was not likely to create confusion with the IGLOU mark as of May 22, 2007, I would be concluding as well that the Mark was not likely to create confusion with the IGLOU & Design mark (TMA632 281).

The inherent distinctiveness of the trade-marks and the extent to which they have become known

[41] The word "iglou" or "igloo" is a common word in the French language designating [TRANSLATION] "a shelter in the shape of a dome, constructed using pre-cut blocks of ice or snow" [see *Le Petit Robert*, ed. 2011]. Consequently, I consider that the Opponent's IGLOU mark is suggestive of winter automobile shelters and does not benefit from a significant inherent distinctiveness.

[42] The Applicant concedes that the word "igloo" is suggestive of the function of the wares associated with the Mark. Nevertheless, it maintains that the suggestive connotation [TRANSLATION] "is tempered by the presence of other original elements", namely the prefix "nav", the lettering, and the graphic element, the latter being described by the Applicant as [TRANSLATION] "the design of an overturned canoe". Even if I accept that the Mark, as a whole, benefits from an inherent distinctiveness that is greater than that of the IGLOU mark, I am of the opinion that the other elements of the Mark do not significantly increase its inherent distinctiveness. Since the Applicant admits that the prefix "nav" originates from the word "navigation," I find it hard to believe that it maintains that it is not suggestive of a shelter for *boats*. Further, aside from the fact that the association between the graphic element and the design of an overturned canoe does not seem obvious to me, in my opinion this design is not the most important or distinctive feature of the Mark. Finally, the fonts used for the word "navigloo" cannot be disassociated from the word itself [see *Canadian Jewish Review Ltd v. Registrar of Trade-marks* (1961), 37 C.P.R. 89 (Ex. C.)].

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

[44] There is no evidence to show that the Mark was known in Canada on the material date. I am aware of the gaps in Ms. Lamarche's affidavit, namely in terms of the advertising of wares. That being said, given the samples of use and the annual sales figures, it is reasonable to conclude that the IGLOU mark was known to some extent in Canada as of the material date.

[45] Even in accepting that the Mark benefits from an inherent distinctiveness that is greater than that of the IGLOU mark, neither of the two marks benefit from a significant inherent

distinctiveness. As the evidence on record leads me to conclude that the IGLOU mark had acquired a distinctiveness as of the material date, I find that an overall examination of the factor pursuant to paragraph 6(5)(a) of the Act favours the Opponent.

The length of time the trade-marks have been in use

[46] The length of time that each party's marks have been in use as of the material date favours the Opponent.

The nature of the wares, services, or business

[47] The Applicant states that the wares are [TRANSLATION] "clearly different [...] and not susceptible to any overlap". The cost of the wares is also claimed by the Applicant as an important factor supporting the lack of a likelihood of confusion, given the attention that a consumer will pay when seeking to procure the wares associated with the marks in question.

[48] Even if I accept that the parties' wares are not identical, I cannot subscribe to the Applicant's opinion regarding the lack of an overlap between them. In this case, we are dealing with temporary shelters for a mode of transportation. Given the Applicant's representations, I would add that the question is not to determine whether or not a consumer buying a boat shelter associated with the Mark would mistakenly believe to be purchasing an automobile shelter associated with the IGLOU mark. Rather, the question is to determine whether or not the consumer would mistakenly believe that a boat shelter associated with the Mark comes from the same source as an automobile shelter associated with the IGLOU mark. In terms of the cost of the wares, I reference comments made by Justice Rothstein in *Masterpiece, supra*, in paragraphs 71-72:

[71] It is not relevant that, as the trial judge found, consumers are "unlikely to make choices based on first impressions" or that they "will generally take considerable time to inform themselves about the source of expensive goods and services" (para. 43). Both of these — subsequent research or consequent purchase — occur *after* the consumer encounters a mark in the marketplace.

[72] This distinction is important because even with this increased attentiveness, it may still be likely that a consumer shopping for expensive goods and services will be confused by the trade-marks they encounter. Careful research and deliberation may dispel any trade-mark confusion that may have arisen. However, that cannot mean that

consumers of expensive goods, through their own caution and wariness, should lose the benefit of trade-mark protection. It is confusion when they encounter the trade-marks that is relevant. Careful research which may later remedy confusion does not mean that no confusion ever existed or that it will not continue to exist in the minds of consumers who did not carry out that research.

[49] Based on the foregoing, I find that the type of wares favours the Opponent.

The nature of the trade

[50] The Applicant submits in its written argument that the parties' market niches are different and are unlikely to overlap. Nevertheless, these representations are not completely substantiated in the written argument. During the oral hearing, the Applicant submitted that the Opponent's evidence is not conclusive in terms of a connection in market niches.

[51] Apart from the fact that Ms. Lamarche makes no specific statement about the market niches associated with the Opponent's wares, I accord no significance to her statement to the effect that each party's wares [TRANSLATION] "will circulate in virtually the same market niches". Consequently, the Applicant's oral representations are not without merit. That being said, apart from the fact that none of Ms. Richard's statements report on the market niches associated with the Applicant's wares, there are no restrictions in the registration application's statement of wares. These comments lead me to return to Exhibit LL-4 from Ms. Lamarche's affidavit, which consists of excerpts from the Applicant's website.

[52] As a general rule, little weight is placed on website excerpts presented as proof by a third party. Further, website excerpts do not constitute evidence of the veracity of the information they contain. However, in this case's circumstances, I see no reason to doubt the reliability of the points-of-sale list found on the Applicant's website and presented as evidence by Ms. Lamarche. Further, I am prepared to infer that the points-of-sale list is representative of the type of businesses in which the Applicant, as of the material date, projected selling wares associated with the Mark. I am also prepared to infer that certain points of sale are businesses specializing in the sale of boats, nautical equipment or sporting goods. Nevertheless, I believe it is reasonable to conclude that the points of sale are not limited to businesses specializing in the sale of boats, nautical equipment or sporting goods. Indeed, I note that the list identifies points of sale such as

Home Hardware, Madeleine Automobiles, Pièces d'Auto P. & B. Gareau Inc., and Véhicules Bellehumeur.

[53] The evidence on record leads me to conclude there is a potential overlap between the nature of both parties' trades, which favours the Opponent.

The degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[54] The Supreme Court of Canada recalled in *Masterpiece, supra*, that "the degree of resemblance [...] is the statutory factor that is often likely to have the greatest effect on the confusion analysis". It is well established in law that when the degree of resemblance between two marks is examined, they are to be looked at in their entirety and not dissected [see *British Drug Houses Ltd. v. Battle Pharmaceuticals* (1944), 4 C.P.R. 48, p. 56 (Ex. C.), affirmed (1946), 5 C.P.R. 71 (S.C.C.)]. In assessing the resemblance between trade-marks, Justice Rothstein indicated in paragraph 64 of *Masterpiece, supra*, that: "[w]hile the first word may, for the purposes of distinctiveness, be the most important in some cases, I think the preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique."

[55] The Applicant's written arguments as they relate to differences between the Mark and the IGLOU & Design mark (TMA632 281) apply equally to differences between the Mark and the IGLOU mark. For the following reasons, the Applicant has not convinced me that there is no resemblance between the Mark and the Opponent's IGLOU mark.

[56] According to the Applicant's representations, the only element that is [TRANSLATION] "more or less common' between the marks is the word 'IGLOU' (or rather, the first four letters of that word: 'I', 'G' 'L' and 'O')". Further, still according to the Applicant's representations, that which distinguishes the Mark from the IGLOU mark [TRANSLATION] "is not this nominal portion, but its distinct visual and phonic elements".

[57] With all due respect, I consider that the Applicant's argument to the effect that there is [TRANSLATION] "more or less" of a resemblance between the words "igloo" and "iglou" is unconvincing. In addition to their being essentially identical in their presentation, they are

identical in terms of their sound. Further, even if the Applicant quite rightly states that the prefix "nav" results in differences in terms of presentation and sound, the Mark must be considered such as it is presented in the application. That being said, one cannot disregard the use of different character fonts for the "nav" and "igloo" elements. Even if I remarked earlier that this feature of the Mark does not significantly increase its inherent distinctiveness, the fact remains that the prefix "nav" is distinguished from the word "igloo". In other words, "nav" and "igloo" are perceived separately, which leads to a certain degree of resemblance in terms of presentation.

[58] I note that the Applicant concedes in its written arguments that the marks both suggest the [TRANSLATION] "notion of shelter". Nevertheless, the Applicant submits that the Mark [TRANSLATION] "also evokes, through its prefix as well as the graphic element that it contains (the design of an overturned canoe), the naval sector or the idea of navigation". Having previously remarked that the association between the graphic element and the design of an overturned canoe is not clear, I find it difficult to accept the Applicant's claims with respect to the importance of this element in considering the idea suggested by the Mark. Nevertheless, I acknowledge that the idea of navigation suggested by the prefix "nav" is not an idea that is suggested by the IGLOU mark. However, I cannot subscribe to the Applicant's position that [TRANSLATION] "the ideas suggested by the marks represented here are different". The fact is, the marks both suggest the idea of a shelter.

Additional circumstance - lack of a genuine case of confusion

[59] The Applicant has made no representations with respect to Ms. Richard's statement on the lack of a genuine case of confusion. Consequently, I conclude that the Applicant does not invoke the lack of a genuine case of confusion as an additional circumstance. Without ruling on the evidentiary weight of Ms. Richard's statement, I nevertheless note that since the Mark was not used as of the material date, the lack of a genuine case of confusion cannot constitute an appropriate additional circumstance.

[60] I would add that it is well established that it does not fall to the opponent to prove confusion. It falls to the applicant to prove the unlikelihood of confusion. In other words, a lack of evidence of confusion does not relieve applicants of their evidential burden. Further, citing Justice Décarý's observations in *Christian Dior S.A. v. Dion Neckwear Ltd.* (2002), 20 C.P.R. (4th) 155, the Supreme Court of Canada, in *Mattel, supra*, recalled that "[a]n adverse inference may be drawn when concurrent use on the evidence is extensive, yet no evidence of confusion has been given by the opponent."

Conclusion – likelihood of confusion

[61] In applying the test for confusion, I took into consideration the fact that this test relies on first impression and imperfect recollection. In taking into account all the circumstances of the case, including the extent to which the IGLOU mark became known, the length of time it has been in use, the nature of the wares, and the nature of the trade associated with the parties' marks, as well as the degree of resemblance between the trade-marks, I conclude that the Applicant has not discharged its burden of showing that there was no likelihood of confusion between the Mark and the Opponent's IGLOU mark as of May 22, 2007.

[62] In regards to the above, pursuant to paragraph 16(3)(a) of the Act, I allow the ground of opposition based on the previous use of the Opponent's IGLOU trade-mark.

Non-distinctiveness

[63] It is generally acknowledged that the material date to assess this ground of opposition is the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

[64] Though the legal onus is on the Applicant to show that the Mark is distinctive, the Opponent must establish that its IGLOU and IGLOU & Design trade-marks had become sufficiently known as of the material date to negate the distinctiveness of the Mark [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.); *Bojangles' International, LLC and Bojangles Restaurants, Inc. v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)].

[65] Following my examination of the evidence on record, I conclude that the Opponent has not met its initial evidential burden with respect to the IGLOU & Design trade-mark (TMA280 836), but that it has met its initial evidential burden in terms of the IGLOU and IGLOU & Design trade-marks (TMA632 281). Therefore, the Applicant has the legal onus to convince the Registrar, on a balance of probabilities, that the Mark did not cause confusion with the IGLOU and IGLOU & Design trade-marks (TMA632 281) as of October 27, 2008.

[66] Once again, I find that the increase in the likelihood of confusion between the Mark and the Opponent's IGLOU mark will be a deciding factor in the outcome of this ground of opposition. The difference between the material date of this ground of opposition and the material date of the ground of opposition based on paragraph 16(3)(a) of the Act does not have significant impact on my previous analysis of the case's circumstances. In fact, even if a reasonable interpretation of Ms. Richard's affidavit allowed me to conclude that the use of the Mark began in the month of June 2007, I would remain of the opinion that the length of time the marks have been in use, the nature of the wares, the nature of the trade, and the degree of resemblance between the two marks would tip the balance of probabilities in the Opponent's favour.

[67] In view of the foregoing, I conclude that the Applicant has failed to meet its burden of showing that there was no likelihood of confusion between the Mark and the Opponent's IGLOU mark as of October 27, 2008, and I allow the ground of opposition based on the lack of distinctiveness.

Registrability Pursuant to Paragraph 12(1)(d) of the Act

[68] Since I have accepted two grounds of opposition, I find that it is unnecessary to rule on the remaining ground of opposition.

Disposition

[69] Pursuant to the authority delegated to me under subsection 63(3) of the Act, I refuse the registration application pursuant to subsection 38(8) of the Act.

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
Jane Kuna