



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

**Citation: 2011 TMOB 205**  
**Date of Decision: 2011-10-26**

**IN THE MATTER OF AN OPPOSITION  
by B'nai Brith Canada to application  
No. 861,142 for the trade-mark THE  
MENORAH DESIGN in the name of  
Chosen People Ministries, Inc.**

[1] On November 12, 1997, Chosen People Ministries, Inc (CPM) filed a trade-mark application (the Application) for the Menorah design shown below for use in association with the following wares and services:



Application No. 861,142 (the Mark)

**WARES:**

- (1) Promotional items, namely sweatshirts, golf shirts, baseball caps, coffee mugs, pens, calenders [*sic*], bumper stickers, greeting cards.
- (2) Bibles; religious literature, namely books, pamphlets, brochures, newsletters dealing with matters of ministry and missions to reach both Jewish and non-Jewish peoples with the gospel of Jesus the Messiah; pre-recorded audio and video cassettes; stationery, namely paper, pads, envelopes; promotional items, namely sweatshirts.

**SERVICES:**

- (1) Provision of religious literature and information in an electronic format by means of a global computer network.

(2) Ministry and missions to reach both Jewish and non-Jewish peoples with the gospel of Jesus the Messiah; organizing and conducting bible study programs; street evangelism; organizing and conducting youth outreach programs; organizing and conducting conferences and seminars to reach both Jewish and non-Jewish peoples with the Gospel of Jesus the Messiah; organizing and conducting seniors outreach programs; organization and administration of religious congregations; consulting services provided to pastors and secondary and post-secondary educational institutions; organizing and conducting bible study retreats; organizing and conducting fund raising events; translation services.

The Application is based on proposed use on Wares (1) and Services (1), and use since June 1, 1988 on Wares (2) and Services (2).

[2] On May 4, 1999, B'nai Brith Canada (the Opponent) filed its Statement of Opposition. On November 1, 1999, CPM filed its counterstatement. The Opponent filed the affidavits of David Horowitz, Ruth Klein, and Rochelle Wilner. The affidavit of Mr. Horowitz was subsequently withdrawn. Ms. Klein was cross-examined on her affidavit on April 5, 2007; the transcripts and exhibits thereto were filed with the Registrar. Ms. Wilner was cross-examined on her affidavit on March 29, 007; the transcript was filed with the Registrar.

[3] As its evidence, the Applicant filed certified copies of various Menorah trade-mark registrations, and the affidavit of Mitch Glaser (along with Exhibits 1-126). Mr. Glaser was not cross-examined on his affidavit.

[4] No further evidence was filed. Both parties filed written arguments and only the Applicant was represented at an oral hearing.

[5] The grounds of opposition under the *Trade-marks Act* R.S.C. 1985, c. T-13 (the "Act") may be summarized as follows:

Section 38(2)(a)/s.30

- The application does not comply with s. 30 in that the wares and services in association with which the Mark has allegedly been used and is proposed to be used have not been described in ordinary commercial terms.
- Contrary to s. 30(b) and s. 30(e) the Applicant has not used the Mark in Canada since the date of first use alleged in the application in association with wares (2) and services (2)

nor does the Applicant have any intention of using the Mark in association with wares (1) and services (1) contrary to sections 30(b) and 30(e) respectively.

- Contrary to s. 30(i), the Applicant could not have been satisfied that it was entitled to use or register the Mark. The menorah is in common use as a symbol of the Jewish religion and was in prior use in Canada by the Opponent and other Jewish organizations and institutions in connection with wares and services relating to religious activities.

Section 38(2)(b)/s.12(1)(b)

- Contrary to s. 12(1)(b) the Mark when depicted, written or sounded, is clearly descriptive or deceptively misdescriptive of the character or quality of the wares and services in association with which it is used and proposed to be used; in particular, the Mark, being an ancient and widely known and recognized religious symbol, clearly describes the religious character and quality of the Applicant's wares and services. In the alternative, the Applicant's wares and services relate specifically to the Christian religion, while the menorah has been widely identified and used around the world (including Canada) as a symbol of the Jewish religion, and hence the Mark is deceptively misdescriptive.
- Contrary to s. 12(1)(e) the adoption of the applied for Mark is prohibited by s.9(1)(j) as the adoption of the religious symbol of one religion for use in association with the wares and services of another religion and to promote the objects and beliefs of that other religion, renders the Mark, as so used, scandalous, obscene and immoral.
- Contrary to s. 12(1)(e) the adoption of the Mark is contrary to s.9(1)(n) as it consists of or so nearly resembles as to be likely to be mistaken for the prohibited mark, identified as application No. 970, 005, advertised September 24, 1975, in the name of the Government of Israel.
- Contrary to s. 12(1)(e) the adoption of the applied for Mark is contrary to s.10 as the word mark MENORAH and the MENORAH design have as a result of ordinary and bona fide usage, become recognized in Canada as designating the wares, services, organizations and institutions of the Jewish religion.

Section 38(2)(c)/s. 16(1)(a)(c)

- The Applicant is not the person entitled to registration of the Mark in view of s. 16(1)(a) and s. 16(1)(c). At the date the Mark was purportedly first used or made known in Canada, and at the date of filing of the Application and at all other times, the Mark was confusing with the trade-marks MENORAH and MENORAH Design previously used and made known in Canada by the Opponent in association with wares and services relating to religion, which trade-marks have not been abandoned by the Opponent.

Section 38(2)(d)/s. 2

- The Mark is not distinctive in view of the facts alleged in the statement of opposition, more specifically, the trade-mark does not distinguish, nor is it adapted to distinguish the goods and services of the Applicant from the goods and services of others, including the Opponent.

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[6] The Applicant bears the legal onus of establishing, on a balance of probabilities that its application complies with the requirements of the Act. However, to the extent that the facts alleged by the Opponent are not self-evident or admitted, there is in accordance with the usual rules of evidence an initial evidential burden upon the Opponent to support the facts alleged in the ground of opposition. The presence of an evidential burden with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist [see *Joseph E. Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 (T.M.O.B.) at 329; *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

[7] Both parties filed somewhat lengthy and detailed evidence, what follows is a summary of the evidence I consider relevant to the determinations to be made in this proceeding.

Opponent's Evidence

*Affidavit of Ruth Klein*

[8] Ms. Klein is the Director of Advocacy for B'nai Brith Canada. She provides a historical background of the menorah, stating that during the wanderings of children of Israel, the artisan Bezalel was commanded to fashion a seven branched candelabrum for use in the first Tabernacle. The menorah was subsequently used in the ancient Jewish Temple in Jerusalem, where priests lit the menorah every evening and cleaned it every morning. The affiant identifies Biblical passages that set out instructions of the construction of a menorah. Ms. Klein also indicates that the menorah has been used as a symbol of the nation of Israel, and is the official emblem of the State of Israel.

[9] The affiant states that the menorah was chosen as part of the Opponent's logo to emphasize its role as a Jewish organization serving the Jewish community and based on the social actions and principles of Judaism.

[10] During the cross-examination of Ms. Klein, it came to light that she is a professional historian who has worked for the last 30 years as a researcher and curator of Judaic and Hebraic books and manuscripts (Klein Transcript: Question 7-16).

[11] Ms. Klein indicated that there is a single Jewish religion with various levels of observance and traditions, stating that the tenets of Judaism are distinct from the tenets of Christianity (Klein Transcript: Question 44-47). It is rabbinic courts and synagogues throughout the world which define what constitutes the Jewish faith and Jewish beliefs (Klein Transcript: Questions 78-85).

*Affidavit of Rochelle Wilner*

[12] Ms. Wilner is the President of B'nai Brith Canada, and states that she has been active with the organization for fifteen years. She confirms that the menorah has been used as a logo of Opponent since the first Lodge was formed in 1875 in Toronto, which logo was chosen specifically because of its close historical ties to Judaism. Ms. Wilner attaches as exhibits examples of early and recent logos, which, I note, include the Opponent's name together in close proximity to a menorah.

[13] Ms. Wilner indicates that members of the Opponent have called in the past year to inquire whether CPM is a Jewish organization as a result of seeing the menorah on materials used by CPM. During cross-examination, the affiant was not able to recall the identity of the people who approached her to ask whether or not CPM was affiliated with the Opponent, but it is clear that she was approached personally by persons who expressed some level of confusion.

### Applicant's Evidence

#### *Affidavit of Mitch Glaser*

[14] Mr. Glaser identifies himself as the President and CEO of the Applicant CPM and provides personal background information and identifies himself as a Jewish person. He states that he holds a Masters of Divinity from Talbot Theological Seminary, as well as a Doctorate of Philosophy from Fuller Theological Seminary, (Pasadena, California). He states that he has taught at Fuller Theological Seminary, Westminster Theological Seminary (Philadelphia, Pennsylvania), Moody Bible Institute (Chicago, Illinois) and Columbia International University (Columbia, South Carolina). Since May 1997, the affiant has been Chief Executive Officer of CPM's International Ministry which has branches located in the United States, Canada, Argentina, Germany, Israel, the Ukraine and England.

[15] The identical affidavit was filed in a separate Opposition by the Canadian Jewish Congress (CJC) and some of Mr. Glaser's statements are specifically addressed to the CJC's evidence. These remarks, specific to evidence filed by the CJC, are not relevant; however, all factual statements and documentary evidence, being part of the affidavit filed in the subject opposition, are under consideration in this proceeding.

[16] Mr. Glaser's affidavit is directed, in part, towards establishing the history of the CPM as an organization of Jewish people. He provides that the members believe that Jesus was the Jewish Messiah as prophesied and that CPM is an organization of Messianic Jews who consider it appropriate to worship Jesus in a Jewish context. The affidavit is also directed towards establishing that much has been written as to whether Messianic Judaism is considered a branch of Judaism. In addition, the affidavit is directed towards establishing that use of the menorah has

not been restricted to “approved” Jewish organizations but has been used by third parties in the food industry and by other Messianic organizations.

[17] With respect to the history and mission of the Applicant, Mr. Glaser provides that CPM was originally founded in Brooklyn, New York in 1894 by a Jewish Rabbi, Leopold Cohn. The affiant states that Cohn was led to seek more information about the Messiah as prophesied in the traditional Jewish writings and scripture, and searched the Jewish scriptures and questioned other Rabbis in his community about the Messiah. Ultimately, Cohn came to the conclusion that Jesus was the Jewish Messiah, as prophesied in the Jewish Bible.

[18] The affiant provides examples of trade-mark registrations that include cross or menorah designs; particulars of 12 registrations and 2 applications for trade-marks that include a cross design are attached. As well, particulars of 8 registrations and 2 applications for trade-marks that include a menorah design are attached. In the case of the cross design trade-marks, I note that as with the certified copies filed, all depictions of the cross include additional design and/or text elements. With respect to the menorah design trade-marks, I note that none depict a menorah alone, and further that six out of ten have been either abandoned or expunged; the remaining four are in association with wares and/or services that have no relation to religious activities.

[19] Mr. Glaser also provides exhibits showing different menorah designs in use by various Canadian Jewish organizations such as synagogues and community centers. In addition, the affiant alleges that the menorah has been used by Christian groups throughout history and refers to a number of additional web pages of other Messianic organizations.

[20] With respect to the nature of the Applicant’s activities, objects and purposes, I reproduce the following excerpts from a CPM pamphlet distributed in April 2002 (Exhibit 95) as an example:

Our Ministries

- It is our specific ministry to preach the Gospel of Yeshua the Messiah, and to show our Lord’s love to the Jewish people throughout the world.

- The Chosen People Ministries continues to evangelize and disciple Jewish people around the world through the most effective and creative ways possible. Our representatives plant congregations; hold fellowship meetings, bible studies, worship services; and do one-on-one evangelistic work.
- Our priority is that, through effective evangelism, our missionaries will establish indigenous churches; and by discipling new believers (both Jewish and Gentile) our efforts will lead to further Jewish evangelism. These new Bible-centred congregations are designed to have a special sensitivity to reaching and ministering to Jewish people, without excluding others who need the Gospel.

### Our Beliefs

- All workers and Board members of Chosen People Ministries must subscribe to doctrines fundamental to the faith. We declare our belief in the following:
- The Divine inspiration, infallibility, and authority of both the Old and New Testaments.
- The triune God and the Deity of the lord Jesus (Yeshua) as the only begotten Son of God and the promised Messiah.
- Messiah's sacrificial blood atonement at Calvary, His bodily resurrection from the dead, and His second coming.
- The necessity of presenting the Gospel to the Jewish people.

[21] Mr. Glaser attaches numerous screen prints of web pages (Exhibits 63-78) that demonstrate use of the menorah on websites of other Messianic organizations. It appears that some of these are located in Canada. I would observe that in all cases the Menorah design is used in conjunction with the organization's name, and in the majority of cases integrated with (or at least in close proximity to) the words to create a unitary design. As well, I would note that there is no evidence that these are registered trade-marks in Canada.

[22] Mr. Glaser provides evidence of use of the Mark in Canada by the Applicant. He states that CPM has distributed pamphlets and brochures which bear the Mark since June 1, 1988.



CPM distributes approximately 406 different brochures a year; typically 3,000 to 10,000 of each brochure is distributed. Sample brochures are attached as Exhibits 93 to 99, and I note that each features the Mark in close association with the Applicant's name.

[23] CPM also uses approximately 100,000 letterhead and envelopes bearing the Mark in any given year, since June 1988 and continuously to the present. The Applicant also distributes monthly newsletters that prominently display the Mark; these are distributed at conferences, events sponsored by CPM, outreach programs and in mailings to members. Approximately 75,000 newsletters are distributed each year by CPM Canada; the total distribution in 2007 in Canada was 55,223. Attached are examples of newsletters stated to be typical of newsletters distributed since June 1, 1998 (Exhibits 104-107). I note that the newsletters bear the Mark in close proximity to the name of the newsletter, THE CHOSEN PEOPLE.

[24] CPM distributes calendars bearing the Mark at conferences and events and via mailings; typically 100 are sold each year at CPM events, and approximately 200 are distributed by mail each year. Exhibit 108 is an example of such a calendar stated to be typical of ones that were distributed by CPM in Canada since June 1988, and continuously to the present. The affiant also provides evidence of signage in front of the CPM Canada headquarters. The Mark typically appears with the words CHOSEN PEOPLE MINISTRIES.

[25] CPM also places the Mark on personal items, such as sweatshirts, golf shirts, label pins and tote bags since at least as early as June 1, 1988, and continuously until the present. Exhibit 112 depicts a tote bag provided at CPM conferences and to volunteers. Also attached as Exhibit 113 is a photo of a golf shirt bearing the Mark distributed at conferences and to volunteers. I note that on each of these items, the Mark appears above the words CHOSEN PEOPLE MINISTRIES.

[26] The Applicant filed certified copies of third-party trade-mark registrations that incorporate stylized versions of the cross. These registrations contain depictions of the cross in combination with other design or text material; none consist of only a cross. The Applicant also includes two registrations for trade-marks that contain depictions of a menorah; again these registrations are for marks that include a menorah as one of several design and/or text elements.

## Discussion

### *Section 38(2)(b)/s. 12(1)(b)*

[27] The Opponent contends that the Mark is not registrable in that is contrary to s. 12(1)(b). It is, when depicted, written or sounded, either clearly descriptive or deceptively misdescriptive of the character or quality of the wares and services in association with which it is used and proposed to be used. The Opponent argues that the Mark, being an ancient and widely known and recognized religious symbol, clearly describes the religious character and quality of the Applicant's wares and services, or, in the alternative, that the Applicant's wares and services relate specifically to the Christian religion, while the menorah has been widely identified and used around the world including Canada, as a symbol of the Jewish religion, and hence the Mark is deceptively misdescriptive.

[28] The material date for determining this issue is the filing date of the application, namely November 12, 1997 [see *Zorti Investments Inc v. Party City Corp.* (2004), 36 C.P.R. (4th) 90 (T.M.O.B.); *Havana Club Holdings S.A. v. Bacardi & Co.* (2004), 35 C.P.R. (4th) 541 (T.M.O.B.); *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60 (F.C.)]

[29] The Opponent has the initial burden of proof to provide some admissible evidence from which it might reasonably be concluded that the facts alleged in support of the ground of opposition exist [see *Joseph E. Seagram & Sons, Limited v. Seagram Real Estate* (1984), 3 C.P.R. (3d) 325 at 329 (F.C.T.D.); *John Labatt Ltd v. Molson Cos Ltd.* (1980), 30 C.P.R. (3d) 293 aff'd (1992), 42 C.P.R. (3d) 495 (F.C.A.)].

[30] The Opponent has met its initial burden as much of the evidence filed is directed towards establishing that the menorah is a traditional symbol of the Jewish faith and culture.

[31] With respect to the allegation that the Mark is deceptively misdescriptive, the Opponent contends that CPM is a Christian organization and therefore that it should not be using the menorah. As such, the Opponent argues that the Mark is deceptively misdescriptive of the Applicant's services. The Applicant argues that it is a Messianic Jewish organization, and should

have the right to use the menorah. It should be pointed out that the broader issue as to whether CPM has the “right” to “use” a depiction of a menorah as a symbol in its documents, and promotional literature, etc., is beyond the scope of this proceeding; in the present opposition proceeding the Registrar can only decide whether the Mark applied for can be registered as a trade-mark pursuant to the Act.

[32] The test for descriptiveness is one of first or immediate impression, considered from the perspective of the average consumer of the wares or services. While the leading cases on this issue most often refer to wares, I take it as self-evident that the principles also apply (by analogy) to services. The meaning of a trade-mark must be considered in the context of the wares and services. “Character” in s. 12(1)(b) means a feature, trait or characteristic of the product and “clearly” does not mean the description has to be precise but must be “easy to understand, self-evident or plain” [*Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968), 55 C.P.R. 29 at 34 (Ex. Ct.); *Drolet v. Stiftung Gralsbotchaft*, (2009) 85 C.P.R. (4th) 1][*Drolet*]. To be objectionable as clearly descriptive under s. 12(1)(b), a mark must be so apt for normal description of the article (or services), that a monopoly on the use of it should not be acquired [*Clarkson Gordon v. Registrar of Trade-marks* (1985), 5 C.P.R. (3d) 252 at 256 (F.C.T.D.)].

[33] Further, to determine whether a trade-mark is registrable under s. 12(1)(b), the Registrar must not only consider the evidence but also apply common sense; the decision that the mark is either clearly descriptive or deceptively misdescriptive is based on initial impression in light of the product or service in question [*Neptune S.A. v. Attorney General of Canada* (2003), 29 C.P.R. (4th) 497 ( F.C.T.D.)].

[34] To be *deceptively misdescriptive*, a trade-mark must *mislead* the public as to the character (a feature, trait or characteristic) or quality of the wares or services [*Atlantic Promotions Inc. v. Registrar of Trade-Marks* (1984), 2 C.P.R. (3d) 183 (F.C.T.D.)].

[35] Firstly, the Applicant has argued that its activities bridge the traditional dichotomy between Christianity and Judaism, and that it should be considered a Jewish organization. However, with all due respect to the Applicant, and in full recognition that this is a complex issue, I find that, on balance, the evidence demonstrates that CPM’s religious services (“ministry and missions... bible study programs...street evangelism...conferences” etc.) are those of a

Christian ministry and are therefore Christian in nature. Notwithstanding that the services are sensitive to Jewish beliefs and primarily directed to Jewish people, in essence, CPM's mission is to spread the Gospel of the Lord Jesus Christ. This is evident in its promotional literature as set out above. Scholarly debate on the possibility of a more nuanced characterization of the Applicant's services is beyond the scope of this proceeding; I am satisfied that teaching the Gospel of Jesus Christ is not a religious activity that would generally be considered Jewish. I would observe that this is consistent with a finding of fact that the Applicant is a Christian organization in *Canadian Jewish Congress v Chosen People Ministries, Inc.* (2002) 19 C.P.R. (4th) 186 (F.C.T.D.); aff'd (2003) 27 C.P.R. (4th) 193 (F.C.A.) [*CJC v CPM*] (relating to s.9 of the Act, but based on similar evidence). With respect to the material date for considering descriptiveness, I am satisfied, on a fair reading of the evidence as a whole, as well as the date of first use of the Mark on the primary services, that this would have been the case at the filing date of the application.

[36] Secondly, I am of the view that the evidence clearly establishes that the seven branched candelabrum known as the menorah is a universally known symbol of Jewish faith and culture. Again, I observe that this is consistent with the finding of fact of the Federal Court in the *CJC v CPM* decision, which cited the excerpt from *The New Jewish Encyclopedia* which provides the following:

Menorah: Hebrew name of the seven branched candlestick originally made by the Biblical artisan *Bezalel* and placed in the sanctuary of the Tabernacle. [...] the Menorah has since become a universal symbol of Judaism.

[37] Thirdly, I am also of the view that the public in Canada would immediately recognize the Mark as a menorah when used in association with religious services and related wares. In so finding, I am guided by the other depictions of the menorah in evidence and the characteristics that each has in common. The menorah is recognizable as a candelabrum with seven branches with flames; the branches are characteristically curved or bent toward the centre.

[38] Further, unlike other registrations and applications in evidence relating to religious symbols, such as those with depictions of the cross, for example, there is no additional material in the Mark besides what is clearly recognizable as a menorah.

[39] Thus, the question then becomes, as a matter of first impression on seeing the Mark in association with the applied for religious wares and services, would the public be deceived into thinking that they are Jewish in nature - and would this have been the case at the date of filing of the Application?

[40] Based on the significance and recognisability of the menorah in Canada, and that the Applicant's services and related wares are essentially Christian in nature, I am of the view that a member of the public would, as a matter of first impression on seeing the Mark (as applied for, i.e. alone without additional material) in association with the Applicant's religious services and related wares, be deceived into thinking that an essential feature, trait or characteristic was that they were Jewish religious services and related wares. The Mark is deceptively misdescriptive and the Opponent is therefore successful under this ground of opposition.

#### Distinctiveness

[41] The material date for the determination under this ground is the filing date of the statement of opposition (May 4, 1999) [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

[42] The Opponent has pleaded that the Mark is not distinctive within the meaning of s. 2 of the Act, by reason of the fact that the Mark does not actually distinguish and is not adapted to distinguish the wares and services in association with which it is proposed to be used by the Applicant from the wares of others, including those of the Opponent. The Opponent submitted that instances of confusion of some of its members over the use by CPM of the Mark arose because the menorah is a generic symbol that relates to Judaism. I tend to agree. It is a basic principle that if a trade-mark cannot function so as to indicate a single source, it is not distinctive and, in fact, is not a trade-mark at all [see *Canadian Council of Professional Engineers v. APA-The Engineered Wood Association*, (2000), 7 C.P.R. (4th) 239][*CCPE v APA*]. Further, as Mr. Justice O'Keefe stated in that case, "a purely descriptive or a deceptively misdescriptive trade-mark is necessarily not distinctive". Therefore based on my earlier finding that the Mark is deceptively misdescriptive, the difference in material date having no effect on this issue, I conclude that at the material date the Mark was not adapted to distinguish nor did it actually distinguish the

services and related wares of the Applicant from those of others within the meaning of s. 2 of the Act.

[43] The opposition is therefore successful, and it is unnecessary to consider the remaining grounds of opposition.

[44] In view of all of the foregoing, pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

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P.Heidi Sprung  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office