

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

**Citation: 2014 TMOB 271**

**Date of Decision: 2014-12-02**

**IN THE MATTER OF OPPOSITIONS by  
Industria De Diseno Textil, S.A. to  
application Nos. 1,370,992 and 1,370,994 for  
the trade-marks ZARA TANZANIA  
ADVENTURES LOGO and ZARA TOURS  
respectively, in the name of Zainab Ansell  
and Roger Ansell, a partnership**

[1] Industria De Diseno Textil, S.A. (the Opponent) opposes registration of the trade-marks ZARA TANZANIA ADVENTURES LOGO (shown below) and ZARA TOURS (sometimes collectively referred to as the Marks) that are respectively the subject of application Nos. 1,370,992 and 1,370,994 by Zainab Ansell and Roger Ansell, a partnership (the Applicant).



[2] The applications were filed on November 7, 2007 and are based on use of the Marks in Canada since at least as early as 1998 (with respect to application No. 1,370,992) and 2000 (with respect to application No. 1,370,994) in association with the following services, as revised:

Travel agency services; operation of a wildlife campsite. (Sometimes collectively referred to as the Services)

[3] The oppositions were brought by the Opponent under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition pleaded by the Opponent in each case are numerous and can be grouped under three categories: those pertaining to non-conformity issues under section 30 of the Act; those pertaining to non-distinctiveness of the Marks under sections 2, 48 and 50 of the Act; and those revolving around the likelihood of confusion between the Marks and the Opponent's registered trade-marks made up of the word ZARA that are listed in the attached Schedule A.

[4] For the reasons explained below, I find that the non-conformity ground of opposition based upon section 30(b) of the Act is by itself determinative and that both applications ought to be refused.

#### The Record

[5] The statements of opposition were filed by the Opponent on May 24, 2011.

[6] On July 18, 2011, the Applicant filed and served its counter statement in each case and also took the position that each of the statements of opposition should be struck by the Registrar since they did not provide sufficient detail for the Applicant to properly respond thereto and the Applicant requested an interlocutory ruling in this regard.

[7] By way of Office letter dated July 26, 2011, the Registrar provided the Opponent with a three week due date in which to respond to the Applicant's request for an interlocutory ruling.

[8] On July 28, 2011, the Opponent filed as its partial evidence in each case, certified copies of the registrations listed in Schedule A referred to above. On August 1, 2011, the Opponent filed further partial evidence in each case by way of the affidavit of Gontran Paquette-Barrette, a student employed by the Opponent's agent, sworn on the same day.

[9] By way of Office letter dated August 12, 2011, the Registrar denied in each case the Applicant's request for an interlocutory ruling since the opposition had already progressed to the evidence stage. The letter indicated that any consideration of the pleadings would therefore occur

at the final decision stage, together with a consideration of the evidence [see *Novopharm Ltd v AstraZeneca AB et al* (2002), 21 CPR (4th) 289 (FC)].

[10] On November 16, 2011, the Opponent filed the remainder of its evidence in each case comprising the affidavit of Beltran Espinosa de los Monteros, Managing Director of ZARA Canada Inc. (ZARA Canada), which is a wholly-owned subsidiary of the Opponent, sworn November 14, 2011.

[11] On March 14, 2012, the Applicant filed as its evidence in each case, the affidavit of Abdirashid A. Adam, the Marketing Director of ZaraTours Inc. (ZaraTours (Canada)), sworn March 14, 2012. Mr. Adam was cross-examined on his affidavit and the transcript of his cross-examination and replies to undertakings form part of the record in each case. I shall note at this point that the Opponent had asked, in each case, for the continuation of the cross-examination of Mr. Adam, which request was denied by the Registrar by way of Office letter dated February 7, 2013. The letter indicated that the Registrar does not make rulings during the course of an opposition as to whether certain questions asked in cross-examination should be answered or whether answers given are adequate. However, the letter indicated that failure to answer proper questions or fulfill undertakings may result in negative inferences being drawn or in the affidavit being ignored at the decision stage.

[12] On November 12, 2013, the Opponent requested leave to file as additional evidence in each case, the affidavit of Alain Bédard, which leave was granted by the Registrar on February 11, 2014.

[13] Both parties filed written arguments in each case, although I shall indicate that the Opponent's written arguments consist of only two laconic paragraphs. A single hearing was held at which both parties were represented.

#### The parties' respective burden or onus

[14] The legal onus is on the Applicant to show that its applications do not contravene the provisions of the Act as alleged in the statements of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against

the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA); and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FC)].

### Analysis

#### The section 30(b) ground of opposition

[15] The section 30(b) ground of opposition, as pleaded by the Opponent in each file, has four prongs, namely:

(i) paragraph 1.1 that alleges that the application does not comply with the requirements of the Act as the Applicant never used the ZARA TANZANIA ADVENTURES LOGO or ZARA TOURS trade-marks, as the case may be, with each of the Services and the alleged dates of first use for each of the Marks are false;

(ii) paragraph 1.2 that alleges that the trade-mark allegedly used is not the ZARA TANZANIA ADVENTURES LOGO or ZARA TOURS trade-marks, as the case may be, but another, different from the ones referred to in the opposed applications;

(iii) paragraph 1.3 that alleges that alternatively or cumulatively, the use (which is denied) of each of the Marks in association with each of the Services has not been continuous; and

(iv) paragraph 1.4 that alleges that each of the Marks is solely ornamental and merely decorative contrary to section 30(b) of the Act.

[16] The Applicant has put into issue the sufficiency of each of these pleadings, which must be must be assessed in light of the evidence.

[17] The relevant date for considering the circumstances concerning each of these pleadings based upon section 30(b) of the Act is the filing date of the Applicant's applications [see *Georgia-Pacific Corporation v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB)]. In this regard, section 30(b) of the Act requires that there be continuous use of the Marks since the date claimed [see *Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD)]. To the extent that the relevant facts pertaining to a ground of opposition based on section 30(b) of the Act are more readily available to the Applicant, the evidential burden on the Opponent with respect to this ground is less onerous [see *Tune Master v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. Furthermore, the Opponent may meet its burden by reference to the Applicant's evidence, provided that the Applicant's evidence is clearly inconsistent with the claims set forth in its applications [see *Labatt Brewing Co v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD)].

[18] This brings me to review the first prong of the section 30(b) ground of opposition in light of the evidence and the submissions made by the parties.

#### The first prong of the section 30(b) ground of opposition

[19] The Opponent has pleaded that the alleged dates of first use for each of the Marks are false. To support its factual allegations, the Opponent relies, on the one hand, on the Paquette-Barrette affidavit, which purports to introduce into evidence the results of various Internet searches and, on the other hand, on the Applicant's own evidence introduced through the Adam affidavit. As per my review below of this evidence, I am satisfied that the ground of opposition is properly pleaded.

#### The Paquette-Barrette affidavit

[20] The Opponent submits that the earliest dates of first use of the Marks in Canada, if any, are later than March 11, 2001. The Opponent relies on the result of searches carried out by Mr. Paquette-Barrette through, among others, the *Internet Archive Wayback Machine* in order to access webpages from the websites *www.zaratours.com* and *www.zara.co.tz*, which relate to the Applicant.

[21] Concerning the website *www.zaratours.com*, Mr. Paquette-Barrette provides as Exhibit A-1, the welcome page printed on July 25, 2011. He states that at the bottom of the welcome page, there is a link entitled “terms and conditions” which he also printed and which forms part of Exhibit A-1. He also provides as Exhibit A-1, a printout of the “About ZARA” page. Upon review of this exhibit, I note that the website is described as the “official corporate Zara Tours website where you can book the complete range of Zara Tanzania Adventures for the best rates”. Zara Tours Inc. (Zara Tours) is described as having been founded in Tanzania in 1987 by Zainab Ansell and as being owned and managed by Mrs. Ansell. Zara Tours claims to be Tanzania’s No. 1 Kilimanjaro outfitter and one of Tanzania’s biggest safari operators. It also claims to have entered into the field of hospitality in Tanzania in the year 2000. I further note that while the printouts do display the trade-mark ZARA TANZANIA AVENTURES LOGO, they do not refer to ZARA TOURS as a trade-mark, but only as a trade-name.

[22] Mr. Paquette-Barrette also provides as Exhibit A-2, printouts of the webpage links for “press and travel agent” as well as “Terms of Service” appearing at the bottom of the welcome page filed under Exhibit A-1. Upon review of the information disclosed on the “press and travel agent” webpages, I note that it refers to both Zara Tours and Zara Tanzania Adventures of Tanzania. (I shall indicate at this point that in response to an undertaking given during his cross-examination, Mr. Adam indicated that the Applicant operates under the business names Zara Tours, Zara Tanzania Adventures, and Zara International Agency [Q. 77]). The webpages further mention that: Mrs. Ansell founded Zara Tours in 1987 in her hometown of Moshi, Tanzania; Mrs. Ansell and Roger Ansell own Zara Tanzania Adventures; and “Zara entered the hospitality lodging industry in 2000, when Zainab and her husband Roger opened the Springland Hotel in Moshi”. As for the printouts filed under Exhibit A-1, the printouts only display the trade-mark ZARA TANZANIA ADVENTURE LOGO. They do not refer to ZARA TOURS as a trade-mark, but only as a trade-name.

[23] Mr. Paquette-Barrette further provides as Exhibit A-3, pages from the domain name *www.zaratours.com*, obtained from the *Internet Archive Wayback Machine*. Upon review of this exhibit, I note that it refers to captures for different periods of time, the oldest dating back to November 23, 2002. The printouts refer to Zara Tours, as well as to Zara Tours Inclusive Inc. (Zara Tours Inclusive), which is described as “acting as a mere agent for suppliers in selling

travel-related services, or in accepting reservations or bookings for services that are not directly supplied by [Zara Tours Inclusive]”. They also refer to the Consular Affairs Bureau of Canada for information concerning possible dangers in Tanzania as well as other international destinations.

[24] Concerning the website *www.zara.co.tz*, Mr. Paquette-Barrette provides as Exhibit A-4, the welcome page printed on July 25, 2011. He also provides as Exhibit A-4, a printout of the “about ZARA” page. Upon review of these pages, I note that they do display the trade-mark ZARA TANZANIA AVENTURES LOGO. However, they do not refer to ZARA TOURS in any way whatsoever. I further note that they provide a toll free number for Canada and the USA.

[25] Mr. Paquette-Barrette further provides as Exhibit A-5, pages from the domain name *www.zara.co.tz*, obtained from the *Internet Archive Wayback Machine*. Upon review of this exhibit, I note that it refers to captures for different periods of time, the oldest dating back to March 11, 2001. The captures further refer to Zara Travel International, Zara, Zara Tours and Travel, and Zara Tours.

[26] Moreover, Mr. Paquette-Barrette states that on April 7, 2011, he contacted the Canadian Travel Association, which has more than 3000 members, who indicated that there was no member by the name of Zara Tours, Zara Tanzania Adventure, Zara International, Zara Travel, Zainab Ansell or Roger Ansell.

[27] Mr. Paquette-Barrette further states that three Canadian provinces legislated travel agencies to protect the consumers, namely Quebec, Ontario and British Columbia. He states that on April 7, 2011, he sought to determine if Zainab Ansell and Roger Ansell or some other entity incorporating the term “Zara” were authorized to operate in these provinces. He explains in detail the searches carried out and further specifies that the registers he consulted included both current information for registered persons and information for past persons. No entries were found.

#### Conclusion – re consideration of the Paquette-Barrette affidavit

[28] According to the websites consulted, part of the Services described as the “operation of a

wildlife campsite” are neither performed nor offered to be performed in Canada in association with either mark. Also, any use made of the term ZARA TOURS is as a trade-name as opposed to a trade-mark.

[29] This brings me to turn to the Applicant’s evidence on this ground.

The Adam affidavit and cross-examination

[30] As indicated above, Mr. Adam holds the position of Marketing Director of ZaraTours (Canada). He has held that position since January 18, 2006, the date on which ZaraTours (Canada) was incorporated. It is to be noted that the name of this Canadian company is spelled in one word (i.e. “ZaraTours”), as opposed to the name of the company Zara Tours (spelled out in two words) that is incorporated in Tanzania.

[31] In line with the result of Mr. Paquette-Barrette’s searches, Mr. Adam’s testimony makes it clear that part of the Services described as the “operation of a wildlife campsite” are neither performed nor offered to be performed in Canada under section 4(2) of the Act, be it at the claimed dates of first use of the Marks or at any time whatsoever [see by analogy *Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) (TMOB); and *Bellagio Limousines v Mirage Resorts, Incorporated*, 2012 TMOB 220 (CanLII)]. Suffice it to reproduce the following passage taken from the transcript of Mr. Adam’s cross-examination:

Q. 297 If we look at the trademark applications, in the description of services for each one there’s travel agency services and you have also operation of a wildlife camp site in each of these descriptions. You agree with me, Mr. Adam, that there is no operation of a wildlife camp site?

A. We provide the services if people want to go visit the camp site in Africa.

Q. 298 You provide a service whereby you can book to be able to attend a wildlife camp site?

A. Yes.

Q. 299 All of the wildlife camp site’s understood that the operation of this is in Africa. You don’t have a wildlife camp site here in Canada?

A. No.



[32] By way of analogy, I find that the comments of Hearing Officer Andrew Bene at paragraph 17 of the *Bellagio* case concerning the operation of a hotel apply to the operation of a wildlife campsite in the present cases: “A hotel cannot be operated via the Internet or a 1-800 telephone number; it is contrary to common sense to equate the ability to make hotel reservations with the operation of a hotel”.

[33] Accordingly, the section 30(b) ground of opposition succeeds in each case with respect to part of the Services described as the “operation of a wildlife campsite” as the Applicant has failed to satisfy the ultimate burden upon it.

[34] Turning to part of the Services described as “travel agency services”, I find that the Applicant’s evidence is clearly inconsistent with its claimed dates of first use with respect to both Marks. Mr. Adam’s testimony raises more questions than it provides answers as to the Applicant’s dates of first use of the Marks in Canada, as per my review below of the most relevant passages of his affidavit and cross-examination.

[35] Mr. Adam states that Zainab Ansell and Roger Ansell formed their partnership in Tanzania in 1986 (the Partnership). He states that Zainab Ansell is also the director of Zara Tours, which she founded in Tanzania in 1987. He states that Zara Tours is a tour operator that operates wild park safaris, climbs to Mount Meru and Mount Kilimanjaro, called ZARA TANZANIA ADVENTURES tours, as well as two hotels and three tented wildlife campsites. He further states that Zara Tours also operates in Tanzania under the trade-names Zara International Travel Agency and Zara Tanzania Adventures, making reservations and bookings for air and ground transportation, hotel accommodations, etc. for an international client base, including clients in Canada.

[36] Mr. Adam states that from 2000 to 2005, he acted as an agent in Canada for Zara Tours. His duties included providing information to potential Canadian customers in regard to the various services offered by Zara Tours, the collection of all customer information and the promotion of the various services offered by Zara Tours in Canada. He was also responsible for collecting customer payments as well as reservations and bookings in association with the various tour packages offered by Zara Tours. I shall stress at this point that nowhere in his affidavit does Mr. Adam go back prior to 2000, whereas the application for the trade-mark

ZARA TANZANIA ADVENTURES LOGO claims a date of first use dating back to as early as 1998. I will return to this point later.

[37] As the Marketing Director for ZaraTours (Canada) since January 18, 2006, Mr. Adam is responsible for the collection of all customer information and the promotion of the various services offered by ZaraTours (Canada) and Zara Tours in Canada. He is also responsible for the processing and collecting of customer payments as well as reservations and bookings in association with the various ZARA TANZANIA ADVENTURES tour packages offered by Zara Tours as well as the advertising and promotion of these services in Canada. As Mr. Adam collectively refers to these services as the ZARA TOURS Services, I will do the same.

[38] Mr. Adam states that there exists a License Agreement between the Partnership and Zara Tours in Tanzania whereby the Partnership maintains care and control over the quality of the services performed by Zara Tours in association with the Marks. There is also a License Agreement between the Partnership and ZaraTours (Canada). In response to an undertaking given during his cross-examination, Mr. Adam indicated that the license agreement between the Partnership and ZaraTours (Canada) was not written [Q. 199]. On March 23, 2012, a written licence agreement was signed by Mr. Adam on behalf of ZaraTours (Canada) and the Partnership. Upon review of the copy of the licence agreement filed as Appendix AA10, I note that the licence so granted is exclusive for Canada and provides for quality control.

[39] Mr. Adam states that since at least as early as 2000, the ZARA TOURS Services have been performed in Canada in association with the Marks and have never been discontinued.

[40] Mr. Adam provides an annual breakdown of the ZARA TOURS Services in association with the Marks for the period between 2000 and 2011. However, no breakdown per mark is provided.

[41] Mr. Adam states that the website *www.zaratours.com* has been operational since October 17, 2001. He states that the website is accessible to all Canadians with Internet access and receives approximately 15,000 hits per month. He further states that through this website, Canadians are able to book any one of the various ZARA TANZANIA ADVENTURES tours they offer.

[42] Mr. Adam states that since at least as early as 2000 and continuing since then to date, advertising and promotion of the ZARA TOURS Services in association with the Marks have never been discontinued.

[43] Mr. Adam states that since ZaraTours (Canada) first began using the Marks in Canada in association with ZARA TOURS Services, advertising and promotion of the ZARA TOURS Services has never been discontinued, with advertising and promotion expenditures averaging approximately \$14,800 CDN annually.

[44] In support of his assertions of use and advertising of the Marks in Canada, Mr. Adam attaches the following exhibits:

- Exhibit B: copies of a selection of redacted travel vouchers and customer itinerary receipts for ZARA TANZANIA ADVENTURES tours for the years 2007 and 2009 to 2012. Upon review of these documents, I note that they display the trade-mark ZARA TANZANIA ADVENTURES LOGO. While they also refer to ZARA TOURS, I consider that the term is used as a trade-name as opposed to a trade-mark because it identifies the services provider as opposed to the Services. For instances, at the top of the vouchers (reproduced below) ZARA TOURS is followed by a business address in Moshi and the electronic confirmation receipts refer to “Payment(s) Received by Adam of Zara Tours”.

Voucher “A”:



**ZARATOURS INC.**

1066 Knotty Pine Groove  
Mississauga, ON., L5W 1J6  
Toll Free +1-866-550-4447

Email: [zara@zaratours.com](mailto:zara@zaratours.com) URL: <http://www.zaratours.com>

**Service Voucher/BILL Voucher**

**Date: 23<sup>rd</sup> July, 2010**

Voucher “B”:



Concerning more particularly the vouchers, I appreciate that the words ZARA TOURS appear in larger and bolder print than the address. However, in voucher “A”, the words ZARA TOURS are not given greater prominence than the word INC. They are clearly used as part of the full corporate name. While in voucher “B” the words ZARA TOURS are not followed by the word INC., I find it more likely than not that they would still be perceived as a trade-name rather than a trade-mark given that they are followed by a business address and further correspond to the sole business identifier appearing in the voucher [see *Road Runner Trailer Manufacturing Ltd v Road Runner Trailer Co* (1984), 1 CPR (3d) 443 (FC 1<sup>st</sup> inst) for the general principles distinguishing between trade-name and trade-mark use].

I would add that the Applicant did not make any submission to convince me otherwise despite the submissions made by the Opponent during the hearing that use shown in Exhibit B did not amount to trade-mark use but rather trade-name use.

- Exhibit C: copies of redacted booking receipts for airfare for Canadian clients issued by Zara Tours dated April 12, 2011 and February 25, 2012. As for the customer itinerary receipts and vouchers, these booking receipts only evidence use of the trade-mark ZARA TANZANIA ADVENTURES LOGO;
- Exhibit D: copy of a brochure featuring the ZARA TANZANIA ADVENTURES tours which are distributed to Canadian customers, as well as to potential customers at Canadian trade shows. The brochure is undated but refers to the launch of the Zara Charity in 2009. I note that as for the customer itinerary receipts and vouchers, this

brochure only evidences use of the trade-mark ZARA TANZANIA ADVENTURES LOGO;

- Exhibit E: a representative sample of webpages from the website *www.zaratours.com* printed on March 19, 2012. As for the customer itinerary receipts and vouchers, these webpages only refer to the trade-mark ZARA TANZANIA ADVENTURES LOGO. The references made to ZARA TOURS are to the trade-name, not the trade-mark; and
- Exhibits F-1 to F-3: printouts from various Canadian travel shows held during the years 2006, 2010 and 2012 where ZaraTours (Canada) advertised the ZARA TOURS Services. Mr. Adam explains that ZaraTours (Canada) has been participating in The Outdoor Adventure Show for a number of years and that the ZARA TANZANIA ADVENTURES LOGO is featured prominently on their displays and brochures. Indeed, I note that the trade-mark ZARA TANZANIA ADVENTURES LOGO is featured prominently in the photographs from one of these trade shows attached under Exhibit F-3. However, the only reference to ZARA TOURS is as part of the company name Zara Tours Inc.

[45] As per my review of Mr. Adam's affidavit and attached exhibits, there is no evidence of use of the trade-mark ZARA TOURS in Canada, be it as of the claimed date of first use of the trade-mark or any time whatsoever. The only use shown is in respect of the trade-name Zara Tours.

[46] Furthermore, while use of the trade-mark ZARA TANZANIA ADVENTURES LOGO in association with part of the Services described as "travel agency services" has been shown by Mr. Adam, the wording he used directly puts into issue the accuracy of the date of first use of this very mark claimed by the Applicant in its application. Indeed, Mr. Adam is completely silent as to the years 1998 and 1999. The only years expressly referred to by Mr. Adam are the years 2000 and following.

[47] As shown below, the cross-examination of Mr. Adam is far from dissipating these deficiencies.

[48] Considering first the trade-mark ZARA TOURS, none of the appendices filed as undertakings evidences use of ZARA TOURS as a trade-mark. Indeed, when ZARA TOURS is referred to, it is always as a trade-name or as part of a domain name that is provided for information or booking purposes. Accordingly, the section 30(b) ground of opposition in that case also succeeds with respect to the remaining services described as “travel agency services” as the Applicant has failed to satisfy the ultimate burden upon it.

[49] Turning to the trade-mark ZARA TANZANIA ADVENTURES LOGO, Mr. Adam’s testimony apparently distinguishes between four periods of use, namely:

- prior to 1998;
- between 1998 and 2000;
- between 2000 and 2006; and
- from 2006 until now.

[50] According to Mr. Adam, the trade-mark ZARA TANZANIA ADVENTURES LOGO was used in Canada prior to 1998 through travel agencies [Q. 286-293]. However, in response to Q. 294, Mr. Adam indicated that these travel agencies would not show the Applicant’s logo, as per the following passage:

Q. 294 [...] they [did not] want us to be seen. They want the market. So if they use our logo it means the client will come directly to us.

Q. 295: They wouldn’t show your logo?

A. They wouldn’t.

[51] Turning to the years 1998-1999, Mr. Adam explains that there would have been business by the Applicant in Canada since 1998 through “Zara Travel” and “Zara Tanzania Adventures”. (I shall note that while Mr. Adam has explained that “Zara Tanzania Adventures” is a business name of Zara Tours [re para 22 of my decision], I have no information regarding the relationship between “Zara Travel” and the Applicant). Business under Zara Tours officially started in 2000 [Q. 72-74]. Zara Travel and Zara Tanzania Adventures were operated in Canada by Mr. Adam [Q. 75-76].

[52] More particularly, Mr. Adam was promoting a trip to Tanzania [Q. 78-79]. He was handing out flyers directing people to the website *zaraform-net.com* [Q. 80-84] (The website *zaraform-net.com* was registered in 1995 and discontinued in 2009 – re Q. 87 taken under advisement and Appendix AA6). There was no other type of activity that he had prior to 2000 [Q. 89].

[53] Then in 2000, Mr. Adam became an agent in Canada for Zara Tours of Tanzania. “This was new work for [him] that [he had not] previously done from 1998” [Q. 93 and 100]. He explains that he was promoting the Zara Tours or Zara Travel services through search engines, Internet and travel shows. During that period of 2000 to 2006 before ZaraTours (Canada) was incorporated, he distributed or showed flyers and CD’s [Q. 105].

[54] Mr. Adam was asked during his cross-examination to provide, among others, examples for each of the years 1998 to 2005 of the type of promotional items that he had available to him and that he did distribute in Canada [Q. 108]. He was also asked to provide documents evidencing transactions with Canadian clients for the years 1998 to 2001 and then from 2001 up until payments were made through the website. In response, Mr. Adam did:

- file under Appendix AA4, copies of a brochure for the year 2009, rates for the year 2003 and other flyers which necessarily postdate the fall 2001 as they are referencing the website *www.zaratours.com*;
- refer to the documents filed under Exhibits B and C to his affidavit discussed above;
- file under Appendix AA7, “samples of DVDs distributed in Canada from 1998”. Upon review of these materials, I note that the first CD entitled “Mount Kilimanjaro – Zara Tanzania Adventures” contains five folders of photographs taken of Mount Kilimanjaro and safaris, which all indicate September 5, 2001 under the heading “Date modified”. Except for the display of the trade-mark ZARA TANZANIA ADVENTURES LOGO on the hats and jackets worn by the individual “Zara guides” in Tanzania pictured therein, there is no reference whatsoever to the trade-mark ZARA TANZANIA ADVENTURES LOGO. The second CD entitled “Kibo” is made of a folder bearing a “Date modified” date of December 19, 2002. The CD contains similar photographs of Mount Kilimanjaro

and safaris. It does not include any picture of “Zara guides” or any reference to the trade-mark ZARA TANZANIA ADVENTURES LOGO. The third CD entitled “ZARA TANZANIA ADVENTURES” together with the display of the trade-mark ZARA TANZANIA ADVENTURES LOGO, contains four folders of photographs, two bearing a “Date modified” date of May 16, 2005, one of May 5, 2005 and one of December 12, 2004. The fourth sample consists of a DVD displaying the trade-mark ZARA TANZANIA ADVENTURES LOGO and a reference to the website *www.zaratours.com*;

- indicate in response to Q. 227 taken under advisement that:

[He has] been advised by Zara Tours (Tanzania) that records [evidencing transactions] from 1998 to 2003 are not available as they are not required by law to be kept after eight years. However, [he has] been able to obtain a record of transactions for Canadians from 2002 to 2004 through PayPal as well as copies of bill vouchers for Canadian customers for 2004 and 2006 to 2009. [Appendix AA11]. Records for 2005 are not available at this time as some of our records have been misplaced due to a new computer system installation. Bill vouchers for 2010 to 2012 were provided as Exhibit B to [his] affidavit.

- file under Appendix AA12, an older version of the booklet (incorrectly identified as a “brochure” under Exhibit D of his affidavit – re Q. 247/257 taken under advisement). Mr. Adam indicated in response to an undertaking given during his cross-examination that “[they] have brochures which are different from the booklet referred to above, which we used from 1998 to 2004” [Q. 259/260]. However, the copy filed under Appendix AA12 necessarily postdates the fall 2001 as it is referencing the *zaratours.com* domain name;
- file under Appendix AA-13, “samples of brochures from 1998 to 2012”. However, upon review of these brochures, I conclude that they necessarily postdate the fall 2001 as they are referencing the *www.zaratours.com* website. In fact, these brochures would apparently consist of the newer version of the brochure that started in 2007 [Q. 265/266]; and
- indicate that while Zara Tours “did participate in about two or three trade shows between 2000 and 2004, it shared booth space with the Tanzania Tourist Board or



Tanzanian Embassy”.

[55] At the hearing, the Opponent put great emphasis on the fact that the Applicant should have kept within its business records, documentation evidencing the claimed date of first use of the Marks. In the absence of any such supporting documentation, the Opponent submitted that “to be on the safe side”, the Applicant should have claimed dates of first use which could be substantiated. The Opponent further stressed that it did ask, in each case, for the continuation of the cross-examination of Mr. Adam so as to clarify some of the responses to undertakings provided by Mr. Adam that were vague or ambiguous, which request was denied by the Registrar as indicated above.

[56] I appreciate that the Applicant may not be, in the words of the Applicant’s agent at the hearing, a “sophisticated company” and that records evidencing transactions with Canadian clients from 1998 to 2003 are not available as they are not required by Tanzanian law to be kept after eight years. However, the fact remains that except for Mr. Adam’s verbal answer that in the years 1998-1999 he was promoting a trip to Tanzania by handing out flyers directing people to the website *zaraform-net.com*, the Applicant’s evidence is completely silent as to the use made of the trade-mark ZARA TANZANIA ADVENTURES LOGO back to 1998. As stressed above [re para 46 of my decision], the wording used by Mr. Adam in his affidavit directly puts into issue the correctness of the date of first use of the trade-mark ZARA TANZANIA ADVENTURES LOGO claimed by the Applicant. The answers to undertakings and appendices provided by the Applicant do not remedy these deficiencies.

[57] As per my review above of Mr. Adam’s testimony, there was no other type of activity prior to 2000 than the alleged promotion of a trip to Tanzania by handing out flyers directing people to the website *zaraform-net.com*. Mr. Adam only became an agent in Canada for Zara Tours in 2000. This was “new work” for him. The exact role played by Mr. Adam prior to 2000 is unclear. The earliest specimens of brochures or flyers displaying the trade-mark ZARA TANZANIA ADVENTURES LOGO all postdate the fall 2001. Mr. Adam did not start attending trade shows in Canada on behalf of the Applicant prior to 2000. There is no indication as to where and to whom Mr. Adam would have handed out the alleged flyers directing people to the website *zaraform-net.com*. Nor is there any indication as to the number of Canadians that would

have visited the website *zaraform-net.com* at that time or as to what that website looked like.

[58] To sum up, I find that the Applicant's own evidence raises more questions than it provides answers as to the Applicant's date of first use of the trade-mark ZARA TANZANIA ADVENTURES LOGO in Canada and its continuous use by the Applicant up to the filing date of the application. Accordingly, the section 30(b) ground of opposition in that case also succeeds with respect to the remaining services described as "travel agency services" as the Applicant has failed to satisfy the ultimate burden upon it.

Remaining grounds of opposition

[59] In view of the foregoing, I find it is not necessary to consider the remaining grounds of opposition.



Disposition

[60] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the applications pursuant to section 38(8) of the Act.

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Annie Robitaille  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

Schedule "A"

Trade-mark	Reg. No.
TEXTURES ZARA	747356
ZARA	526805
	526538
ZARA	513706
ZARA	557205
ZARA	531098
	534585
ZARA BASIC	546483