



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

Citation: 2011 TMOB 33
Date of Decision: 2011-02-28

**IN THE MATTER OF AN
OPPOSITION by Scouts Canada
to application No. 1,338,850 for the
trade-mark BEAVER ED in the
name of New PAPP
INTERNATIONAL Inc.**

FILE RECORD

[1] On March 9, 2007, Papp International Inc. filed an application to register the trade-mark BEAVER ED, based on (i) use in Canada since February 1, 2007 in association with the services listed below, and (ii) proposed use in Canada in association with the wares listed below:

services

retail store services via a global computer network in the fields of children's educational products, namely workbooks teaching writing skills, arithmetic, spelling and phonics; wipe-clean books, booklets and boards; story books; puzzles; and posters; providing educational lesson plans via a global computer network for teaching young children language and arithmetic skills; providing an online newsletter via a global computer network promoting applicant's wares and services; providing children's downloadable activity sheets via a global computer network.

wares

children's educational products, namely workbooks teaching writing skills, arithmetic, spelling and phonics; wipe-clean books, booklets, boards, story books, puzzles, posters, picture books, novelty books, lift-the-flap books, cloth books, bath books, pen and activity books, sticker

books and sound books; activity cards, index cards, number charts, printing blocks, rubber stamps, activity mats, calendars, and maps; pens, pencils, crayons, markers, pencil cases, erasers made of rubber, pencil sharpeners and bookends; computer software, namely, educational software for children.

[2] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated August 8, 2007 and was opposed by Scouts Canada on December 6, 2007. The Registrar forwarded a copy of the statement of opposition to the applicant on January 22, 2008, as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[3] The opponent's evidence consists of the affidavit of John Robert Stewart. The applicant's evidence consists of the affidavit of George Papp. Both parties filed written submissions and both parties were represented at an oral hearing held on February 8, 2011.

STATEMENT OF OPPOSITION

pleadings of fact

[4] The statement of opposition pleads that (i) the opponent is a body corporate incorporated in 1914 by a special Act of parliament, (ii) the opponent carries on youth-oriented programs involving many kinds of activities including educational, outdoor and sporting activities, (iii) the opponent operates its programs in and through a number of sections designated by such titles as BEAVERS, WOLF CUBS and SCOUTS, (iv) the youngest members of the opponent are enrolled in the section designated as BEAVER or BEAVERS and occasionally as BEAVER-CANADA or BEAVERS-CANADA, (v) the BEAVER section of the opponent has been extant since 1971 and thousands of boys have been enrolled in the section, (vi) since 1971 the opponent has used the trade-marks BEAVER and BEAVERS, either alone or in combination with other word and/or design features, including representations of naturalistic and fanciful beavers.

grounds of opposition

[5] The first ground, pursuant to s.38(2)(a) of the *Trade-marks Act*, alleges that the subject application does not comply with s.30 of the *Act* because the mark BEAVER ED is non-distinctive in view of the opponent's use of its above mentioned BEAVER marks, and therefore BEAVER ED is not a trade-mark within the meaning of s.2 of the *Act*. The application is not an application for a trade-mark.

[6] The second ground alleges that the applied for mark BEAVER ED is not registrable because its adoption is prohibited pursuant to s.9 of the *Trade-marks Act*. In this regard, the opponent gave notice of the mark BEAVERS, pursuant to s.9, in April 1989.

[7] The third ground, pursuant to s.16, alleges that the applicant is not entitled to register the applied for mark (i) for the reasons given in the first ground, and (ii) because at the alleged first use of the mark BEAVER ED it was confusing with the opponent's BEAVER marks.

[8] Lastly, the opponent alleges that the applied for mark is not distinctive of the applicant's services in view of its prior pleadings.

APPLICANT'S EVIDENCE

[9] Mr. Papp identifies himself as President of the applicant company, which conducts business under the trade-name Beaver Books Publishing. The applicant sells a wide range of educational materials, including children's educational workbooks and activity book (the "Products"). The applicant has been selling its Products in association with the mark BEAVER ED since 2008. Attached *en liasse* as Exhibit GP-1 to Mr. Papp's affidavit are examples of how the mark BEAVER ED is used in association with children's quiz books. The applicant sells its Products to the Canadian public through 557 Dollarama stores throughout Canada and through other chain retail stores including Wal-Mart, Costco, and Zellers, as well as directly to consumers through the applicant's website. Attached *en liasse* as Exhibit GP-2 of Mr. Papp's affidavit are the results of an Internet search conducted by Mr. Papp indicating that (i) the beaver has attained official status as a symbol of Canada, and (ii) the word beaver or various representations of

beavers are used in association with various products sold in Canada or used to associate products with Canada or Canadians.

OPPONENT'S EVIDENCE

[10] Mr. Stewart identifies himself as a member of Scout Canada's professional staff since 1982 and currently the Executive Commissioner and CEO for the opponent. His evidence generally establishes, mainly by way of exhibit material, the opponent's pleadings of fact in the statement of opposition. For example, Exhibit 5 is a copy of a book entitled "Beaver Leader's Handbook;" Exhibit 6 is comprised of articles concerning the opponent's BEAVERS program that appeared in various publications including the *Ottawa Citizen* newspaper; Exhibit 7 is comprised, in part, of activity books distributed within the opponent organization entitled "Jump Start for Beavers;" Exhibit 8 is comprised of copies of various books for the opponent's BEAVER program including chapters entitled, for example, "The Beaver Law," "The Beaver Motto," and "Remembering the Beaver Promise," which books have been distributed since 1972. Exhibit 9 is comprised of Scouts Canada calendars for the years 2000, 2001 and 2002, which calendars show reference to BEAVERS. The calendars were distributed as a national fundraiser.

[11] Boys and girls who are members of the BEAVERS section of Scouts Canada usually go on to the CUBS, SCOUTS and VENTURERS sections. The programmes for the latter sections included various sports activities. Each section has a program designed for a particular age group. Exhibit 11 indicates that the BEAVER program is for children ages 5 - 7 while the VENTURER program is for youth ages 14-17. The opponent has supplied its members with wares consisting of uniforms, equipment and related items since 1972. The opponent operates SCOUT SHOPS across Canada to supply wares to its members and to the public. As of July, 2008, there were 21 such shops. The marks BEAVER and BEAVERS have been used on various wares including items of clothing, books, song books and board games since at least as early as 1993. As mentioned earlier, exhibit materials attached to Mr. Stewart's affidavit corroborate and illustrate his affidavit testimony.

[12] I have noted that in *Scouts Canada v. Beaver County Productions Inc.* (2010), 84 C.P.R. (4th) 142, the opponent herein appears to have filed evidence analogous to the evidence filed in the instant case. The Board determined, at p. 146, that:

Throughout the affidavit Mr. Stewart makes reference to either "BEAVER" or "BEAVERS". I do not consider the absence or presence of the letter "S", as the case may be, to be a determining factor in this decision. I believe that any evidence of use of the trade-mark BEAVERS to be use of the trade-mark BEAVER and vice versa (see *Canada (Registrar of Trade Marks) v. Cie Internationale pour l'Informatique CII Honeywell Bull* (1985), 4 C.P.R. (3d) 523 (F.C.A.)). Any reference hereinafter to the trade-mark BEAVER shall also include the trade-mark BEAVERS.

I am of the same view and any reference hereinafter to the opponent's mark BEAVER will likewise include the plural form.

LEGAL ONUS AND EVIDENTIAL BURDEN

[13] The legal onus is on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponent in the statement of opposition. The presence of a legal onus on the applicant 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, in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298. The presence of an evidential burden on the opponent 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.

FIRST GROUND OF OPPOSITION – S.38(2)(A) AND S.30

[14] I agree with the applicant's submissions at paragraphs 25-27 of its written argument that the first ground, as pleaded, is untenable because it is not set out in sufficient detail to enable the applicant to respond thereto. In this regard, the applicant has not specified the specific subsection of s.30 it is relying on, the opponent has failed to provide facts explaining why the applied for mark is not a trade-mark, and "non-

distinctiveness” is not a ground of opposition under s.38(2)(a). The first ground is therefore rejected.

SECOND GROUND OF OPPOSITION – S.(9)

[15] The opponent has met its evidential burden in respect of the second ground by including a copy of its s.9 notice as Exhibit 10 of Mr. Stewart’s affidavit. In *Boy Scouts of Canada v Aleksiuik* (2006), 56 C.P.R.(4th) 459, this Board considered a similar pleading based on s.9 in respect of the applied for mark BILLY BEAVER. In *Aleksiuk*, the Board reasoned as follows, at p.466:

In *WWF-World Wide Fund for Nature v. 615334 Alberta Ltd.* (2000), 6 C.P.R. (4th) 247 (T.M.O.B.) at 253-254, Board Member Martin discussed the test to be applied under s. 9(1)(n)(iii) with reference to the court decisions in *Big Sisters Assn. of Ontario v. Big Brothers of Canada* (1999), 86 C.P.R. (3d) 504 (F.C.A.); affg. (1997), 75 C.P.R. (3d) 177 (F.C.T.D.), as follows:

As stated in Section 9(1)(n)(iii) of the Act. the test to be applied is whether or not the applicant's mark consists of, or so nearly resembles as to be likely to be mistaken for, the official mark. In other words, is the applicant's mark identical to, or almost the same as, any of the opponent's official marks?: see page 217 of the trial level decision in the Big Sisters case noted above. At pages 218-219 of the trial level decision, Mr. Justice Gibson confirmed that in assessing the resemblance between the marks at issue, regard may be had to the factors set out in Section 6(5)(e) of the Act. Further, at page 218, Mr. Justice Gibson indicated that the test was to be applied as a matter of first impression and imperfect recollection: see also pages 8-9 of the unreported decision of the Federal Court of Appeal in *Canadian Olympic Association v. Techniquip Limited* (Court No. A-266-98; November 10, 1999).

In the present case, the Applicant's Mark is not identical to the Opponent's official mark. Further, I find that the Applicant's trade-mark BILLY BEAVER, when considered in its entirety, has only some resemblance to the official mark BEAVERS in appearance, sounding or in the idea suggested. Consequently, the Applicant's Mark is not almost the same as the Opponent's official mark. The differences between BILLY BEAVER and BEAVERS are sufficient to prevent a Canadian consumer from mistaking BILLY BEAVER for BEAVERS.

[16] In the instant case, the applied for mark is not identical to the opponent’s mark, and applying the same reasoning as above, I find that the applied for mark has only some resemblance to the official mark BEAVERS: see also paragraph 23, below.

Consequently, the applied for mark is not almost the same as the opponent's official mark. I therefore find that the mark BEAVER ED does not so nearly resemble as to be likely to be mistaken for the official mark BEAVERS.

THIRD GROUND – ENTITLEMENT

[17] The opponent's evidence suffices to put the third ground of opposition, alleging that the applicant is not entitled to register the applied for mark, into issue. The legal onus is therefore on the applicant to show that (i) at the date of filing the application (March 9, 2007), the applied for mark BEAVER ED was not confusing with the opponent's mark BEAVER in respect of the applicant's wares; and (ii) at the date of first use (February 1, 2007) claimed by the applicant, the applied for mark BEAVER ED was not confusing with the opponent's mark BEAVER in respect of the applicant's services: see s.16(3)(a) and s.16(1)(a) of the *Trade-marks Act*, respectively.

[18] The applicant is required to establish, on a balance of probabilities, that there would be no reasonable likelihood of confusion, within the meaning of s.6(2) of the *Act*, shown below, between the applied for mark BEAVER ED and the opponent's mark BEAVER:

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 . . . sold . . . or performed by the same person, whether or not the wares or services are of the same general class.

Thus, s.6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by s.6(2) is whether there would be confusion of the applicant's wares and services sold under the mark BEAVER ED as being provided by or endorsed by the opponent.

SECTION 6(5) FACTORS

[19] Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in s.6(5) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the

nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

Consideration of s.6(5) Factors

[20] The opponent's mark BEAVER mark possesses some degree of inherent distinctiveness but it is a relatively weak mark as the beaver is generally perceived as a symbol of Canada. Similarly, the applied for mark BEAVER ED is a relatively weak mark as it is comprised of weak components. In this regard, the component ED would be perceived as a first name. As of the material dates in February and March 2007, I am prepared to find, despite deficiencies in Mr. Stewart's affidavit in quantifying the extent of use of the opponent's mark BEAVER, that the opponent's mark BEAVER had acquired a fair reputation in Canada in association with the opponent's youth oriented programs and some reputation in association with wares such as clothing, scarves, badges, pins and books which form an integral part of the opponent's youth service programs. As noted by the applicant at paragraph 52 of its written argument:

The Opponent did not provide any evidence of actual sales in association with the alleged BEAVER trade-marks. The Opponent did not provide any (i) invoice evidencing sales, (ii) sales figures or (iii) figures concerning volume of wares sold through catalogues or sales outlets.

[21] Mr. Papp's evidence, like Mr. Stewart's evidence, is deficient in quantifying the extent of use of the applied for mark BEAVER ED, and given the short time frame of actual use, I am not prepared to infer that the applicant's mark had acquired any more than a minimal reputation in Canada in respect of services. Of course, the applied for mark would not have acquired any reputation in respect of wares as the application is based on proposed use in respect of wares.

[22] The length of time that the marks in issue have been in use favours the opponent as the opponent commenced use of its mark BEAVER since at least as early as 1993. The

applicant's wares and services overlap with the opponent's wares and services to some extent, and it appears that some of the applicant's wares and services would be targeted to about the same age group served by the opponent's BEAVER scouting program. However, the opponent merchandises its products through outlets and catalogues dedicated to its youth programs rather than through retail outlets intended for the general public. I therefore agree with the applicant's submission, at paragraph 60 of its written argument, that:

Given the differences between the channels of trade of the Applicant's and Opponent's respective wares and the restricted nature of the channels of trade of the Opponent's wares . . . it is very unlikely that the Applicant's wares would ever be sold through the same retail outlets or catalogues.

[23] There is of course a resemblance between the marks in issue visually and in sounding as the applicant has incorporated the whole of the opponent's mark BEAVER as the first component of the applied for mark BEAVER ED: in this regard see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.). However, when the first component of a mark is a common, descriptive or suggestive word, the significance of the first component decreases: see, for example, *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.*, [1991], 37 C.P.R. (3d) 413 (F.C.A.) and *Phantom Industries Inc. v. Sara Lee Corp.* (2000), 8 C.P.R. (4th) 109 (T.M.O.B.). Further, the parties' marks suggest different ideas as the opponent's mark suggests a living creature while the applied for mark suggests a fictional character.

Conclusion

[24] When considering relatively weak marks, Mr. Justice Cattanach, in *GSW Ltd. v. Great West Steel Industries* (1975), 22 C.P.R.(2d) 154 at 169 (F.C.T.D.), noted as follows:

. . . there is ample judicial authority for the proposition that in the case of "weak" marks, small differences may be accepted to distinguish one from the other and a greater degree of discrimination may be fairly expected of the public.

[25] Applying the above principle to the facts of this case, I find that the applicant has met the onus on it to show that, on a balance of probabilities, there is no reasonable likelihood of confusion between the applied for mark BEAVER ED and the opponent's mark BEAVER at the material dates. Accordingly, the third ground of opposition is rejected.

FOURTH GROUND – DISTINCTIVENESS

[26] In the instant case, the issue of whether the applied for mark is distinctive or adapted to distinguish the applicant's wares and services turns on the issue of confusion between the applied for mark and the opponent's mark at the material date December 6, 2007: see *Metro-Goldwyn-Meyer Inc. v Stargate Connections Inc* (2004), 34 C.P.R.(4th) 317 at 324 (F.C.T.D.). For reasons essentially the same as those discussed under the third ground of opposition, I find that the applied for mark was not confusing with the opponent's mark as of December 6, 2007. Accordingly, the fourth ground is rejected.

DISPOSITION

[27] In view of the foregoing, the opposition is rejected. This decision has been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

Myer Herzig
Member
Trade-marks Opposition Board