

**IN THE MATTER OF AN OPPOSITION
by S & S Productions Inc. to application
No. 1,101,107 for the trade-mark POSSUM
LODGES filed by Andre M. Messier**

On May 3, 2001, Andre M. Messier (the “Applicant”) filed an application to register the trade-mark POSSUM LODGES (the “Mark”). The application is based upon proposed use in association with “sale and rental of recreational lodging, namely, cabins, camps, lodges, campsites and cottages; time-sharing of recreational real estate; sale of recreational real-estate; rental of recreational real estate; reservations for recreational lodging, namely, cabins, camps, lodges, campsites and cottages; restaurants.” The Applicant has disclaimed the right to the exclusive use of the word LODGES apart from the Mark.

The application was advertised for opposition purposes in the Trade-marks Journal of January 8, 2003. On June 4, 2003, S & S Productions Inc. (the “Opponent”) filed a statement of opposition against the application.

The statement of opposition pleads grounds of opposition under s. 38(2)(a), (b), (c), and (d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”). The Applicant filed and served a counter statement in which it denied the Opponent’s allegations.

As rule 41 evidence, the Opponent filed the affidavit of David Smith, the Opponent’s Vice President, Business Affairs, plus certified copies of Canadian trade-mark registrations Nos. 466,531 and 466,655. Mr. Smith was not cross-examined on his affidavit.

The Applicant elected to not file any evidence.

Each party filed a written argument. An oral hearing was not held.

Onus

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its

application complies with the requirements of the Act. There is however an initial burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. [See *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.).]

Section 38(2)(b) Ground of Opposition

The ground of opposition pleaded under s. 38(2)(b) alleges that the Applicant's Mark is not registrable because it is confusing with the Opponent's trade-marks POSSUM LODGE and INTERNATIONAL POSSUM BROTHERHOOD & Design, registered under Nos. 466,531 and 466,655, respectively. The statement of wares and services in each of those registrations reads as follows:

Wares:

Clothing items, namely t-shirts, hats, suspenders, printed publications and materials, namely brochures, newsletters, books, magazines; posters, mugs, cups, bumper stickers, patches.

Services:

Operation of a business, on behalf of others; for the production and distribution of programs, films and videos for the television, theatrical and home video markets; the marketing and promotion of such programs, films and videos, and the characters therein, by organizing and maintaining a fan club, conducting market research and distributing books, newsletters and informational materials.

As the registrations are in good standing, the Opponent has satisfied its evidential burden.

The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: the inherent distinctiveness of the trade-marks or trade-names 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; and the

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

In *Polo Ralph Lauren Corp. v. United States Polo Association et al.* (2000), 9 C.P.R. (4th) 51 (F.C.A.) at 58-59, Malone J.A. summarized the guidelines to be applied when assessing the likelihood of confusion as follows:

A review of some of the leading cases also establishes some practical guidelines. For example, the Court is to put itself in the position of an average person who is familiar with the earlier mark but has an imperfect recollection of it; the question is whether the ordinary consumer will, on seeing the later mark, infer as a matter of first impression that the wares with which the second mark is used are in some way associated with the wares of the earlier. With respect to the degree of resemblance in appearance, sound or ideas under subparagraph 6(5)(e), the trade-marks at issue must be considered in their totality. As well, since it is the combination of elements that constitutes a trade-mark and gives distinctiveness to it, it is not correct to lay the trade-marks side by side and compare and observe similarities or differences among the elements or components of the marks when applying the test for confusion. In addition, trade-marks must not be considered in isolation but in association with the wares or services with which they are used. When dealing with famous or well-known marks, it may be more difficult to demonstrate that there is no likelihood of confusion, especially if the nature of the wares are similar. Lastly, the enumerated factors in subsection 6(5) need not be attributed equal weight. Each particular case of confusion might justify greater emphasis being given to one criterion than to others.

The material date for assessing the likelihood of confusion under this ground of opposition is the date of my decision. [See *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.).]

I will begin by assessing the likelihood of confusion between the Mark and the mark that is the subject of registration No. 466,531, POSSUM LODGE.

inherent distinctiveness of the trade-marks

While both parties' marks are inherently distinctive with respect to their respective wares and services, the Applicant's Mark is less inherently distinctive since its second portion describes the Applicant's services.

the extent to which each trade-mark has become known

There is no evidence that the Applicant's proposed-use Mark has been used or promoted. In contrast, the Opponent's POSSUM LODGE mark has been used extensively in Canada since 1991. It has been displayed in the television show entitled "Red Green Show", which aired weekly, first in Hamilton, Ontario, then nationally between 1994 and 1997 on the Global Television Network, and finally nationally from 1997 to February 10, 2004 (the date of Mr. Smith's affidavit) on the Canadian Broadcasting Corporation. Reruns of the shows were also broadcast every weekday on the CBC, as well as on The Comedy Network. As of February 2004, more than 260 original half hour episodes of the "Red Green Show" had been produced and broadcast in Canada.

At paragraph 20, Mr. Smith attests:

The men's club, POSSUM LODGE, is and has always been, the focus of The Red Green Show. All activities take place in POSSUM LODGE. All episodes of the Red Green Show, as well as all video releases, and the feature film Duct Tape Forever, have always featured the characters engaged in activities in POSSUM LODGE. In each episode, video release and the feature film, the marks POSSUM LODGE and INTERNATIONAL POSSUM BROTHERHOOD & Design, are clearly displayed to viewers onscreen. Invariably, there is constant mention of POSSUM LODGE in each and every episode, video and in the feature film. Further, both these aforementioned trademarks also appear in all manner of merchandised products, as will be hereinafter outlined. The marks are also clearly displayed on the Red Green official website, and in all copies of the Red Green Newsletter, which in the early years was mailed to fan club members, also known as POSSUM LODGE members.

At paragraph 47, Mr. Smith attests, that in each RED GREEN SHOW episode, "there is constant mention of POSSUM LODGE throughout, as a place where the characters meet and engage in activities, as well as being the club or fraternal organization that the characters are members of."

Mr. Smith's exhibits include a videocassette of one episode of the Opponent's television show and copies of the fan club newsletter. [Exhibits 1, 2, 3, 4, and 27]

Mr. Smith also provides details of various merchandise sold or promoted in association with the POSSUM LODGE mark. For example, bobble head dolls that display POSSUM LODGE on their packaging and books entitled "Possum Lodge Poems and Campfire Songs" have been sold

in Canada [paragraphs 28, 38 and 39, exhibits 8, 9, 20 and 21, Smith affidavit].

the length of time each trade-mark has been in use

The length of time that each mark has been in use favours the Opponent.

the nature of the wares, services or business; the nature of the trade

The businesses and trades of the two parties are quite different. The Applicant appears to be in the business of providing recreational accommodation, through sale or rental, whereas the Opponent is in the television entertainment industry. However, there is more of a nexus than immediately meets the eye. As evidenced by the Opponent, the Opponent's television show features a group of men who regularly meet in and around POSSUM LODGE and satirize the stereotypical Canadian outdoorsman and sportsman. Accordingly, although the parties' services do not overlap, there is a connection between them.

The Opponent also sells and promotes various wares in association with its POSSUM LODGE mark [Exhibit 7, Smith affidavit] and POSSUM LODGE membership cards are distributed to members of its fan club [paragraphs 24 and 25, Exhibit 5, Smith affidavit].

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

Since the marks are essentially identical, they have the highest possible degree of resemblance.

conclusion re likelihood of confusion

The legal onus is on the Applicant to show that there is not a reasonable likelihood of confusion between the marks. Given that 1) the marks are virtually identical, 2) the Opponent's mark has a significant reputation, and 3) the Applicant has filed no evidence, I find that there is a sufficient connection between the two parties' services to conclude that there is a reasonable likelihood of confusion. In other words, the Applicant has not satisfied me that, on a balance of probabilities, a Canadian who has an imperfect recollection of the Opponent's POSSUM LODGE trade-mark as associated with the Opponent's television show, would not, as a matter of first impression,

assume that there was some connection between the Applicant's POSSUM LODGES recreational lodging, real estate and restaurant services and the Opponent's television show.

To paraphrase the Federal Court of Appeal in *Miss Universe, Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 at paragraph 19, it was the duty of the Applicant to select a name with care so as to avoid any confusion -- as is required under the definition of "proposed trade-mark" in s. 2 of the Act. I find that the Applicant did not do so.

The s. 38(2)(b) ground of opposition therefore succeeds.

As the opposition has already succeeded, I will not address the remaining grounds of opposition.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the application pursuant to s. 38(8).

DATED AT TORONTO, ONTARIO, THIS 11th DAY OF SEPTEMBER 2006.

Jill W. Bradbury
Member
Trade-marks Opposition Board