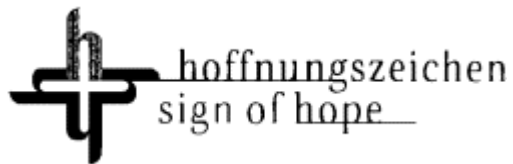


**IN THE MATTER OF AN OPPOSITION by Hope
International Development Agency to application
No. 1,068,337 for the trade-mark
HOFFNUNGSZEICHEN SIGN OF HOPE &
Design filed by Hoffnungszeichen Sign of Hope
e.V.**

On July 24, 2000, Hoffnungszeichen Sign of Hope e.V. (the "Applicant") filed an application to register the trade-mark HOFFNUNGSZEICHEN SIGN OF HOPE & Design (the "Mark"), which is shown below:



The Applicant claims the colour green as an essential feature of the Mark. In particular, the small case "h" on the top of the "+" sign and the words "sign of hope" are green. The Applicant has indicated that "hoffnungszeichen" translates in English to "sign of hope".

The application is based upon use and registration of the trade-mark in Germany and claims a convention priority filing date of February 10, 2000.

The application was advertised for opposition purposes in the Trade-marks Journal of December 4, 2002. Hope International Development Agency (the "Opponent") filed a statement of opposition on January 31, 2003.

The Applicant filed and served a counter statement in which it denied the Opponent's allegations.


On October 8, 2003, the Opponent requested leave to file an amended statement of opposition. Leave was granted on November 5, 2003. The grounds of opposition, as amended, are summarized below:




1. The application does not comply with s. 30(a) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”) because the application does not contain a statement in ordinary commercial terms of the specific wares and services in association with which the Mark is proposed to be used.

2. The application does not comply with s. 30(d) of the Act because, at the date of filing of the application, the Applicant had not used the Mark in Germany as alleged, or at all.

3. The application does not comply with s. 30(i) of the Act because, at the date of filing of the application, the Applicant could not properly have been satisfied that it was entitled to use the Mark in Canada having regard to the Opponent’s official marks, trade-marks and trade-names as set out below.

4. The Mark is unregistrable under s. 12(1)(e) of the Act because it is a mark the adoption of which is prohibited by s. 9(1)(n)(iii) in that the Mark consists of or so nearly resembles as to be likely to be mistaken for, the Opponent’s family of official marks as follows:

<u>Application No.</u>	<u>Date Advertised</u>	<u>Mark</u>
902,010	1985-11-06	 <p>HOPE International Development Agency</p>

902,319	1986-10-01	
902,580	1986-03-12	
902,581	1986-03-12	
902,582	1986-03-12	HOPE INTERNATIONAL DEVELOPMENT AGENCY

5. The Applicant is not the person entitled to registration of the Mark under s. 16(2)(a) of the Act because, at the date of filing of the application, the Mark was confusing with the trade-marks HOPE, HOPE INTERNATIONAL, HOPE INTERNATIONAL DEVELOPMENT AGENCY, HOPE FOR TODAY, and hope-international.com, which the Opponent had previously used or made known in Canada in association with charitable fund-raising services and the operation of relief and development programs in third world countries and the education of Canadians in third world development, and which was not

abandoned at the date of advertisement of the Applicant's application.

6. The Applicant is not the person entitled to registration of the Mark under s. 16(2)(c) of the Act because, at the date of filing of the application, the Mark was confusing with the trade-name HOPE INTERNATIONAL DEVELOPMENT AGENCY, which the Opponent had previously used in Canada in association with charitable fund-raising services and the operation of relief and development programs in third world countries and the education of Canadians in third world development, and which was not abandoned at the date of advertisement of the Applicant's application.

7. The Mark is not distinctive because it is not capable of distinguishing the Applicant's wares and services from the wares and services of others, particularly the fund-raising services of the Opponent, nor is it adapted to so distinguish them.

In support of its opposition, the Opponent filed the affidavit of Brian C. Cannon.

In support of its application, the Applicant filed the affidavit of Kelly Brady. The Opponent obtained an order for the cross-examination of Ms. Brady but did not conduct a cross-examination.

As reply evidence, the Opponent filed the affidavit of Ryan Kenneth Brendzy.

Each party filed a written argument and participated in an oral hearing.

As of the date of the oral hearing, the statement of wares and services in the Applicant's application read:

Wares:

(1) Writing instruments and materials, namely lead pencils and ball-point pens; printed matter, namely newspapers, magazines, books as well as printed teaching and information materials in the form of booklets, leaflets; photographs; teaching materials (except apparatus), namely manuals, leaflets, video and audio tapes.

(2) Dishes, namely cups, table plates, glasses; tools and containers for household and

kitchen, namely food and drink containers.

(3) Clothing, namely shirts, pullovers, t-shirts, overalls; headgear for wear, namely caps; shoes.

Services:

(1) Services of a human rights organization being active in the field of charity and human rights, namely providing an organization and correspondence office for world-wide help, namely food supply, organization and administration of volunteer activities, collection and distribution of money obtained as donations; distribution of goods for advertising purposes for others, namely printed materials and merchandising articles namely booklets, brochures, newsletters, pamphlets, flyers, playing cards, bookmarks, calendars, note pads, posters, bumper stickers, stickers, decals, lapel pins, pens, pencils, coasters, mugs, glasses, stuffed animals, key rings, key chains, mouse pads, t-shirts, sweatshirts, caps, tote bags; organization and consultancy services; charitable fund raising.

(2) Telecommunications, namely installing and providing an on-line service for collecting, preparing and transmitting news and other electronic data via public telecommunication networks.

(3) Transportation services, namely transportation of people and goods by buses and vans and rental of motor vehicles; packaging, storing, collecting and distributing of charity goods, namely food, clothing, pharmaceutical and medical goods; organizing and arranging voyages.

(4) Education, namely in the field of human rights and humanitarian help, care of handicapped persons, chronically and physically ill persons, drug addicted persons, war victims; educational services namely conducting continuing education classes and workshops in the fields of human rights and humanitarian help; publication of books, newspapers and magazines; services of a free-lance journalist.

(5) Medical care and health care services, namely clinical services and physician services; beauty care salons; services, namely consultancy services in the field of veterinary medicine and agriculture; language interpreting; hospitality services, namely accommodation and catering of guests; language translations; development of programs in the fields of data processing, electronic media and the Internet; consultancy for electronic data processing; scientific research in the field of human rights and humanitarian help.

Onus and Material Dates

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential 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* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

The material dates that apply to the grounds of opposition are as follows:

- s. 30 - the convention priority filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at. 475];
- s. 12(1)(e) - the date of my decision [see *Allied Corporation v. Canadian Olympic Association* (1989), 28 C.P.R. (3d) 161 (F.C.A.) and *Olympus Optical Company Limited v. Canadian Olympic Association* (1991), 38 C.P.R. (3d) 1 (F.C.A.)];
- s. 16(2) - the convention priority filing date of the application [see s. 16(2)];
- non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

Section 30(a) Ground of Opposition

At the oral hearing, the Opponent's agent withdrew this ground of opposition.

Section 30(d) Ground of Opposition

The Opponent has submitted that certain of the Applicant's wares and services appear not to be in use according to the Applicant's own evidence. At the oral hearing, the Applicant's agent indicated that she was in agreement that some of the wares and services should be deleted and an amended application was subsequently filed in which the statement of wares and services has been restricted to certain services, specifically:

services of a human rights organization being active in the field of charity and human rights, namely providing an organization and correspondence office for world-wide help, namely food supply, organization and administration of volunteer activities, collection and distribution of money obtained as donations; organization and consultancy services; charitable fund raising; education, namely in the field of human rights and humanitarian help, care of handicapped persons, chronically and physically ill persons, drug addicted persons, war victims; educational services namely conducting continuing education classes and workshops in the fields of human rights and humanitarian help; publication of books, newspapers and magazines; services of a free-lance journalist; scientific research in the field of human rights and humanitarian help.

This amendment has been accepted and made of record.

As a result of the amendment, the only outstanding portion of the Opponent's s. 30(d) ground is its allegation that it is apparent that the Applicant is not involved in "organization and consultancy services; scientific research in the field of human rights and humanitarian help" (paragraph 55, Opponent's Written Argument). The Opponent submits that it has met its initial burden with respect to this by reference to the Applicant's evidence, namely the affidavit of Ms. Brady. Ms. Brady, a trade-mark agent employed at the firm that is representing the Applicant, provides, *inter alia*, a copy of the Applicant's complete German website, as it existed on November 7, 2004 (Exhibit "A").

The issue under s. 30(d) is whether the Applicant used its Mark in association with "organization and consultancy services" and "scientific research in the field of human rights and humanitarian help" in Germany as of July 24, 2000, as alleged in its application.

The evidential burden on the Opponent respecting the issue of the Applicant's non-compliance with s. 30(d) is a light one [see *Tune Masters v. Mr. P's Mastertune* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.) at 89]. Further, the Opponent may rely upon the Applicant's affidavit evidence to meet its evidential burden in relation to this ground. In such a case, however, the Opponent must show that the Applicant's evidence is 'clearly' inconsistent with the claims set forth in the Applicant's application.

As I understand it, the Opponent's position is based on the fact that the Applicant's 2004 website does not show use of the Mark in association with "organization and consultancy services" or "scientific research in the field of human rights and humanitarian help". (I will take the Opponent at its word in that regard: the website is lengthy and a poorly-translated English version has been provided. Moreover, the Applicant has not challenged the allegation that it does not show such use.) The question therefore is whether the absence of such use on the 2004 website is clearly inconsistent with the Applicant's claim that it had in fact used its Mark with such services in Germany as of July 24, 2000. Although I am sympathetic to the difficulties involved in the Opponent providing evidence of such a lack of use, I do not accept that evidence of what was happening (or perhaps not happening) four years later is evidence that is clearly inconsistent with

the allegations contained in the application. I am not aware of any obligation on the Applicant to have continued to use its Mark in Germany, or elsewhere.

The s. 30(d) ground is accordingly dismissed on the basis that the Opponent has not met its initial burden.

Section 30(i) Ground of Opposition

Where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant. [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155] I am therefore dismissing this ground of opposition.

Section 12(1)(e) Ground of Opposition

A number of issues have been raised by the parties concerning this ground of opposition.

i) whether the Opponent must demonstrate that it is a public authority

The Applicant has argued that there is no evidence of the degree of governmental control required to find that the Opponent is a public authority. In particular, it submits, “[a]side from the evidence contained in the Cannon Affidavit at paragraph 3 wherein it is suggested that some provincial governments as well as the Federal Government, provide funding, there is no nexus with any level of government let alone evidence of government control.” [paragraph 56, Applicant’s Written Argument] It relies upon *Big Sisters Assn. Of Ontario v. Big Brothers of Canada* (1999), 86 C.P.R. (3d) 504 (F.C.A.) as authority for its submission that the Opponent must demonstrate that it meets the requirements for public authority designation. It also relies upon *Canadian Council of Professional Engineers v. Krebs Engineers* (1996), 69 C.P.R. (3d) 267 (T.M.O.B.), where it was said at page 272:

Presumably, if the opposite party can cast doubt on any material aspect of the publication (*i.e.* adoption, use, public authority status, wares or services), then the party relying on the Official Mark must evidence that aspect of the publication which appears to be deficient. If the party relying on the Official Mark does not do so, then presumably the Opposition Board or the Courts, as the case may be, will not apply that Official Mark against the opposite party.

The Opponent has submitted that the Applicant's submissions have caught it by surprise because the Applicant did not indicate in its counter statement that it challenged the Opponent's status as a public authority. With regard to the s. 12(1)(e) ground of opposition, the counter statement reads:

The Applicant denies the allegations raised in paragraph 1(d) of the Opponent's Statement of Opposition and submits that at all material times, the Applicant's trade-mark HOFFNUNGSZEICHEN SIGN OF HOPE & Design, identified by Application No. 1,068,337 was not confusing with a trade-mark or official mark that had been previously used, made known or adopted in Canada and more particularly, was not confusing with the Opponent's family of allegedly adopted official marks. The Applicant respectfully submits that this ground of opposition raised pursuant to Section 38(2)(b) and 12(1)(e) is not well-founded and should accordingly be rejected by the Registrar of Trade-Marks.

(my underlines)

At the oral hearing, the Applicant's agent submitted that the words underlined in the preceding paragraph amounted to pleading that the Opponent is not a public authority. I think such a conclusion is far from clear.

I note that in *Novopharm Ltd. v. AstraZeneca AB et al.* (2002), 21 C.P.R. (4th) 289 (F.C.A.), the Federal Court of Appeal held that the sufficiency of pleadings should be assessed having reference to any evidence of record. The question therefore may be whether the Applicant's pleadings, in conjunction with the evidence filed, made it evident that the Applicant was challenging the Opponent's status as a public authority. I conclude that it did not. The only evidence filed by the Applicant is an affidavit from a trade-mark agent employed at the firm that is representing the Applicant. Ms. Brady provides, *inter alia*, a copy of the Opponent's complete 2004 website (Exhibit "L"), without further comment thereon. I do not see how this can be interpreted as raising the issue of whether the Opponent was/is a public authority.

Therefore, although it is unclear from the evidence whether the Opponent was/is a public authority, I find that such issue was not sufficiently pleaded by the Applicant. If it had been, then the issue might have become whether or not it is appropriate for the Opposition Board to look behind public notices given under s. 9 of the Act and possibly not allow the Opponent to rely upon its s. 9 notices. This was done in *Heritage Canada Foundation v. New England Business Service Inc.* (1997), 78 C.P.R. (3d) 531 (T.M.O.B.), but the Opponent's submission is that such decision was wrongly decided.

In any event, if the Opponent is a public authority, the Mark is nevertheless registrable because it is not a mark of which the adoption is prohibited by s. 9 and 12(1)(e), based on the following analysis.

ii) whether the Mark is likely to be mistaken for any of the Opponent's official marks

In *Canadian Council of Professional Engineers v. APA - The Engineered Wood Assn.* (2000), 7 C.P.R. (4th) 239 (F.C.T.D.), Mr. Justice O'Keefe defined the resemblance test under s. 9(1)(n) in the following terms:

[69] ...In order to offend subparagraph 9(1)(n) (iii) so as to be unregistrable under paragraph 12(1)(e), the proposed mark must either be identical to the official mark or so nearly resemble it so as to be likely to be mistaken for it. The words "consists of" in the subsection of the Act are to be interpreted to mean "identical to" as was apparently held by the Registrar.

...

[71] The interpretation I have adopted allows the wide ambit of protection to official marks which I believe is consistent with the scheme of the Act as a whole, related sections of the Act, as well as the intention of Parliament. No one may register or use a trade-mark "ENGINEER" (or another of the official marks) in association with any ware or service, notwithstanding the fact that such a possible trade-mark may not be confusing with the appellant's marks. And no one may register or use a trade-mark which is similar to the appellant's official marks so that it is likely to be mistaken for them, again notwithstanding that the mark may be sought to be used in association with such wares or services that it may well not be held to be "confusing" with the official marks as that term is used in section 6 of the Act. "Mistaken therefor" and "confusing with" are not synonymous.

In addition, in *Assoc. Olympique Canadienne c. Coopérative Fédérée de Québec* (2000), 7 C.P.R. (4th) 309 (F.C.T.D.), Mr. Justice Lemieux stated:

I take from Gibson J.'s reasons after trial the following principles relevant to this case when dealing with official marks under section 9 which are raised to block a trade-mark applicant:

(1) The test under section 9 is one of resemblance and where the official mark and the applied for mark are not identical, the issue "then is whether or not the Defendant's mark is almost the same as, or substantially similar to any or all of BSAO's marks" and that the relevant test to determine this question, as set out in the *R. v. Kruger* [(1978), 44 C.P.R. (2d) 135 (Reg. T.M.)], is whether "a person familiar with [BSAO's] marks [or any of them] but having an imperfect recollection thereof would... be likely to mistake the [Defendant's mark therefor]". (page 217)

(2) The test adopted by Rothstein J. (as he then was) in *Canadian Olympic Assn. v. H.C.E.U.A.*, *supra*, is nothing more than a useful restatement of the *Kruger* test and does not vary from the *Kruger* test. Mr. Justice Rothstein had formulated the test as follows at page 19:

The question must be determined in the context of whether a person who, on a first impression, knowing one mark only and having an imperfect recollection of it, would likely be deceived or confused.

(3) The straight comparison test is rejected. Gibson J. at page 217 said this:

I cannot accept the argument advanced on behalf of the Plaintiffs that the test is one of "straight comparison". The concept of "straight comparison" implies a close and careful look at or comparison between BSAO's marks and the mark of the Defendant. Such a close and careful look or comparison was specifically rejected by Mr. Justice Rothstein in *Canadian Olympic Assn. v. Health Care Employees Union of Alberta*.

In the present case, it is clear that the Applicant's Mark is not identical to any of the Opponent's s. 9 marks; thus it is not unregistrable on the basis that it "consists" of any of the official marks. The question therefore becomes whether a person familiar with any of the official marks but having an imperfect recollection thereof would be likely to mistake the Mark therefor. In this regard, it is appropriate to consider the factors set out in s. 6(5)(e) of the Act, namely the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them. [See *Big Sisters Association of Ontario v. Big Brothers of Canada*, *supra*.]

I find that the official mark that most resembles the Mark is the one that is the subject of application No. 902,581. Thus, if the Mark does not so nearly resemble that official mark as to be likely to be mistaken for it, then the s. 12(1)(e) ground would fail in its entirety. That official mark is reproduced below:



The key features of this official mark are the word HOPE and a circular design encompassing the silhouette of a child's head.

There are three key features of the Applicant's Mark: 1) a Cross (or Plus Symbol) Design; 2) the word HOFFNUNGSZEICHEN; and 3) the phrase SIGN OF HOPE. It is well accepted that the first components of a trade-mark are typically considered to be more dominant than latter portions of a mark [*Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) at 188]. Therefore, the Design and the word HOFFNUNGSZEICHEN should be considered to dominate over SIGN OF HOPE.

Overall, I find that the degree of resemblance between the two marks (when considered in their entirety) in appearance, sound and idea suggested is not significant. As I result, I find that a person familiar with the official mark but having an imperfect recollection thereof would not be likely to mistake the Mark therefor.

iii) the relevancy of the Opponent's alleged family of official marks and the state of the register/marketplace evidence

The Opponent has pleaded that it has a family of official marks, namely official marks that comprise the word HOPE. However, I find that this does not improve its case for the following reasons. First, I have already found that the word HOPE is not a dominant feature of the Applicant's Mark. Second, state of the register evidence may be relied upon to rebut an alleged family of official marks [*Techniquip Ltd. v. COA* (1998), 80 C.P.R. (3d) 225 (F.C.T.D.), affirmed (1999) 3 C.P.R. (4th) 298 (F.C.A.)]. The Applicant has introduced state of the register evidence and state of the marketplace evidence that show that a number of other parties have used marks/names in association with charity-related services that include the word HOPE [see Brady affidavit, Exhibits "E" through "I"]. These third party marks/names include H.O.P.E., HOPE LINK INTERNATIONAL, WORLD HOPE CANADA, GEMS OF HOPE, HANDS OF HOPE FOR CHILDREN, CHILDREN'S HOPE, FLAME OF HOPE, GREEN RIBBON OF HOPE, HEART OF HOPE HANDS OF LOVE & Design, HOPE FOR TOMORROW & Dove Design; HOPE WORLDWIDE & Design, HOPE FOR RWANDA'S CHILDREN FUND and INTERNATIONAL NETWORK OF HOPE, among others. I find that this evidence is sufficient to rebut the Opponent's alleged family. [I acknowledge that the Opponent demonstrated in its reply evidence that some of the trade-mark applications/registrations located by Ms. Brady have subsequently been abandoned/expunged, but the outstanding marks and names are still sufficient to rebut the Opponent's alleged family of marks.]

iv) the relevancy of a prior decision under s. 12(1)(e) based on the same official marks

The Opponent has directed me to the decision in *Hope International Development Agency v. Aga Khan Foundation Canada* (1996), 71 C.P.R. (3d) 407 (T.M.O.B.) in which it successfully opposed an application by a third party to register ESPOIR VOIR LE MONDE SOUS UN JOUR NOUVEAU & Design, based on the same official marks relied upon in the present proceedings. I note that a similar decision was reached with respect to the English version of that mark, HOPE SEEING OUR WORLD THROUGH NEW EYES & Design [see *Hope International Development Agency v. Aga Khan Foundation Canada*, 1996 CarswellNat 3262]. The two marks that were the subject of those decisions are shown below:



It is clear that the resemblance between each of these marks and the Opponent's official marks is much greater than the resemblance between the present Applicant's Mark and the Opponent's official marks, because the word HOPE/ESPOIR is a dominant element of each of the Aga Khan Foundation's marks. Thus I find those decisions to be distinguishable from the one at hand. (As an aside, I note that there is evidence that the Aga Khan Foundation subsequently had these marks recognized as official marks pursuant to s. 9: Exhibit "H", Brady affidavit.)

Section 16(2) Grounds of Opposition

initial burden

In order to meet its initial burden under s. 16, the Opponent must establish use of its marks/name in Canada prior to February 10, 2000, as well as non-abandonment of its marks/name as of December 4, 2002. The marks that the Opponent relies on in this regard are HOPE, HOPE INTERNATIONAL, HOPE INTERNATIONAL DEVELOPMENT AGENCY, HOPE FOR TODAY, and hope-international.com; the name that the Opponent relies on is Hope International Development Agency; and the services that the Opponent relies on are "charitable fund-raising services and the operation of relief and development programs in third world countries and the education of Canadians in third world development".

Mr. Cannon, the Opponent's Manager of Administration, Manager of Volunteers, and Manager of Human Resources, provides evidence of the Opponent's activities. In particular, I note that he provides copies of publications that are distributed in Canada, including one that is mailed to donors across Canada two to three times a year. Copies of these newsletters have been provided dating from October 1985 to Spring 2002. [See paragraph 7 and Exhibit "G", Cannon affidavit.] The publications display the Opponent's trade-name Hope International Development Agency as well as various trade-marks, which I conclude include the trade-mark HOPE [see Principle 1 in *Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535 (T.M.O.B.)]. As I consider

the Opponent's case under s. 16 to be strongest with respect to its mark HOPE, I will focus my discussion on that mark.

Mr. Cannon also provides a copy of the Opponent's 2002 Christmas catalogue (Exhibit "V"), which satisfies me that it had not abandoned its mark as of December 4, 2002.

The Applicant has not contested that the Opponent has shown prior use and non-abandonment of its marks/name. It has however submitted that there has been no trade-mark use in Canada because the Opponent may have advertised its services in Canada but the actual services are performed in third world countries. However, clearly "charitable fund-raising services and the education of Canadians in third world development" can be performed in Canada, even though they relate to third world issues.

The Opponent has met its initial burden by showing prior use and non-abandonment in Canada with respect to its mark HOPE as used in association with charitable fund-raising services and the education of Canadians in third world development and I shall accordingly now assess the likelihood of confusion between that mark and the Applicant's Mark.

test for confusion

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: a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; b) the length of time each has been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks or

trade-names in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.)]

s. 6(5)(a) - inherent distinctiveness of the marks and the extent to which each has become known
HOPE is not an inherently strong mark when associated with charitable services, because it suggests a goal or side effect of such services. Because the Applicant's Mark comprises multiple features including a unique design and a foreign word, it is inherently more distinctive than is the Opponent's mark.

The Opponent's mark had been promoted and used to a significant degree as of February 10, 2000 (promotional expenditures exceeded \$1,943,000; expenditures to increase public awareness and educate the public exceeded \$4,166,000; and fundraising received by the Opponent from the general public exceeded \$29,000,000). There is no evidence of any use or promotion of the Applicant's Mark in Canada. Thus, consideration of the extent to which each mark has become known favours the Opponent.

s. 6(5)(b) - the length of time each has been in use

This factor clearly favours the Opponent as its mark has been used in Canada since 1985.

s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

Neither party has contended that there are any significant differences between their services or business or the nature of their trades. The Opponent has suggested that there is a considerable risk of imperfect recollection on the part of donors due to the fact that donations are made largely in response to mail campaigns. There is however no evidence supporting a conclusion that this nature of the trade increases the risk of imperfect recollection.

s. 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

I have already discussed this factor under my discussion of the s. 12(1)(e) ground. I reiterate that overall I do not consider there to be a significant degree of resemblance between HOPE and

HOFFNUNGSZEICHEN SIGN OF HOPE & Design. I acknowledge that the Applicant's Mark does incorporate the Opponent's mark in its entirety, but given that the Opponent's mark consists of only a single word, and that word is an ordinary dictionary word that is apt in the parties' field of interest, I do not consider this to be significant, especially since the word "hope" is not *per se* a dominant feature of the Applicant's Mark.

other surrounding circumstances

i) state of the register and marketplace

As discussed earlier, the Applicant has evidenced that other charities and the like use marks or names that include the word HOPE. I note that not all of its evidence predates February 10, 2000 but there is still sufficient evidence to conclude that the Canadian public was used to distinguishing one HOPE mark from another as of the material date. [See *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432; *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.).] The Opponent has submitted that the nature of some of these third parties differs from those of the parties, *i.e.* not all of the third parties are involved in third world issues. If this were to be considered significant, it would still not change the outcome of my conclusions since a number of the third parties are clearly involved in fields that are similar to those of the parties (*e.g.* CHILDHOPE for "housing projects in less developed countries", FOUNTAIN OF HOPE for "charitable fundraising for distribution to and in support of charitable organizations and similar needy causes", and HOPE WORLDWIDE & Design for "providing care and adoption services for orphans; providing relief assistance after natural disasters"). I also note that the specific focus of the charitable activities of a number of the third parties is simply not apparent.

conclusion regarding likelihood of confusion

"Realistically appraised it is the degree of resemblance between trade marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a subservient role in the over-all surrounding circumstances." [*Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.*

(1980), 47 C.P.R. (2d) 145 (F.C.T.D.) at 149, affirmed 60 C.P.R. (2d) 70]. In the present case, I find that the differences between the parties' marks are sufficient on their own to make confusion unlikely. This conclusion is reinforced further when one considers that "hope" appears to be a commonly adopted formative of marks/names in the field of charitable services. The Applicant has accordingly satisfied its legal burden and this ground is dismissed.

Non-distinctiveness Ground of Opposition

In order to meet its initial burden with respect to this ground, the Opponent need only show that its marks were "known to some extent at least" as of January 31, 2003. [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.) at 58]

I find that the Opponent has met its initial burden. However, I also find that the Applicant has met its legal onus to show that its Mark is adapted to distinguish its services. I reach this conclusion for two reasons: 1) the differences between the Applicant's Mark and each of the Opponent's marks or names is significant; and 2) it is clear from the evidence that other parties use marks that include the word HOPE in fields similar to that of the Opponent.

Accordingly the distinctiveness ground of opposition fails.

Disposition

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

DATED AT TORONTO, ONTARIO, THIS 21st DAY OF FEBRUARY 2008.

Jill W. Bradbury
Member
Trade-marks Opposition Board