

**IN THE MATTER OF AN OPPOSITION
by Hope International Development Agency
to application no. 1018143 for the trade-mark
HOPE WORLDWIDE & Design filed by
Hope Worldwide, Ltd. (a charitable non-profit
Corporation of Delaware)**

THE RECORD

[1] On June 7, 1999, Hope Worldwide, Ltd., a charitable non-profit Corporation of Delaware, filed an application to register the trade-mark HOPE WORLDWIDE & Design, shown below,



for use in association with several beneficent services. The application was amended in response to objections by the Examination Section of the Trade-marks Office requiring a disclaimer and requiring some of the services to be stated in more specific terms. Thus, the application of record disclaims the right to the exclusive use of the word WORLDWIDE apart from the mark as a whole and is based on:

- (a) use of the mark since at least as early as 1996 in association with
 - informational services relating to medical treatments and the prevention of diseases;
 - the operation of clinics for the treatment of diseases,
- (b) proposed use of the mark in association with
 - providing education, namely, operating schools and providing mentoring and educational programs for the poor and homeless and for underprivileged children;
 - providing sports programs for underprivileged children;
 - providing technology training, namely, computer training for underprivileged children;
 - providing food, medical services and housing for the poor and homeless;

providing medical centres for the treatment of diseases for the underprivileged;
providing care and adoption services for orphans;
providing relief assistance after natural disasters;
providing immunization and medical treatment for underprivileged children;
distributing food, medical supplies, clothing and educational materials.

[2] The Examination Section raised a further objection that the applied for mark is not registrable because it is prohibited by Section 9(1)(n)(iii) of the *Trade-marks Act* in view of the official mark HOPE SEEING THE WORLD THROUGH NEW EYES owned by the Aga Khan Foundation Canada. However, the applicant's arguments (see its submissions dated May 14, 2001 and June 25, 2004) in response to the objection were accepted by the Examination Section and the subject application was subsequently advertised for opposition purposes in the *Trade-marks Journal* issue dated August 25, 2004. The subject application was opposed by Hope International Development Agency on September 7, 2004. The Registrar forwarded a copy of the statement of opposition to the applicant on September 21, 2004 as required by Section 38(5) of the *Trade-marks Act*. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[3] The opponent's evidence in chief consists of the affidavit of Brian C. Cannon. The applicant's evidence consists of the affidavits of Anil Bhole, Elenita Anastacio and Taras Kulish. The opponent's reply evidence consists of the affidavit of Amy M. Fong. Both parties filed a written argument and both parties were represented at an oral hearing held on December 7, 2009.

STATEMENT OF OPPOSITION

[4] The first three grounds of opposition are based on Sections 30(a), (b) and (i) of the *Trade-marks Act*. The opponent alleges, respectively, that the applicant's services are not described in ordinary commercial terms; that the applicant has not used the applied for mark as alleged; and that the applicant could not have been satisfied that it was entitled to use the applied for mark having regard to the opponent's official marks, trade-marks and trade-names. At the oral hearing counsel for the opponent withdrew the ground of opposition based on Section 30(a).

[5] The fourth ground alleges that the applied for mark HOPE WORLDWIDE & Design is not registrable, pursuant to Section 9(1)(n)(iii) of the *Act*, in view of the opponent's official word mark HOPE INTERNATIONAL DEVELOPMENT AGENCY and its official composite word and design marks illustrated below:



Each of the above official marks covers the following services:

operation of relief and development programs in the Third World countries and the education of Canadians in Third World developments.

[6] The fifth and sixth grounds of opposition, pursuant to Sections 16(3)(a) and 16(1)(a), allege that the applicant is not entitled to register the applied for mark because, at the relevant material dates, the mark HOPE WORLDWIDE & Design was confusing with the opponent's

marks HOPE, HOPE INTERNATIONAL, HOPE INTERNATIONAL DEVELOPMENT AGENCY, HOPE FOR TODAY, and HOPE-1INTERNATIONAL.com previously used by the opponent.

In this regard, the opponent pleads that it has used its above cited marks in association with (i) charitable fund raising services, (ii) the operation of relief and development programs in third world programs, (iii) the education of Canadians in third world development. At the oral hearing counsel for the opponent conceded that the alleged mark HOPE-INTERNATIONAL.com was not relevant to the grounds of non-entitlement.

[7] The seventh and eighth grounds of opposition, pursuant to Sections 16(3)(c) and 16(1)(c), allege that the applicant is not entitled to register the applied for mark because, at the relevant material dates, the mark HOPE WORLDWIDE & Design was confusing with the opponent's trade-name Hope International Development Agency.

In this regard, the opponent pleads that it has used its trade-name in association with (i) charitable fund raising services, (ii) the operation of relief and development programs in third world programs, (iii) the education of Canadians in third world development.

[8] The ninth and tenth grounds, pursuant to Section 2, allege that the applied for mark is not distinctive because (i) it is not capable of distinguishing the applicant's services from the charitable fund raising services of the opponent and (ii) the mark has not been used by the

applicant for the purpose of distinguishing the applicant's services.

OPPONENT'S EVIDENCE

Brian C. Cannon

[9] Mr. Canon has been a staff member with the opponent since 1982 and was a manager of several departments as of the date of his affidavit. The opponent was incorporated as a non-profit corporation in 1977 under the name Food for the Hungry/Canada. In 1985 the opponent changed its name to Hope International Development Agency. Mr. Cannon describes the opponent as "an autonomous Christian agency working in cooperation with other agencies in the field of Third World development to assist the neediest of the needy to become self-reliant." The opponent provides food to the needy and destitute, provides research and development projects to help the needy become self-reliant, and educates the general public to understand the need for development of underdeveloped countries. The opponent's programs are designed to assist the poor in Africa, Asia, India, Central America and the Caribbean by improving health care, enhancing the quality of education, increasing rural income and protecting the environment. The opponent is funded by private and institutional donations, the provincial governments of Manitoba, Saskatchewan and Alberta and by the Federal Government. Mr. Cannon confirms the opponent's ownership of the official marks, trade-marks, trade-names and domain name relied on in the statement of opposition. The opponent refers collectively to its "Marks" and I will do likewise.

[10] Annual reports which bear one or more of the opponent's Marks describe the opponent's

activities in detail. The opponent also published a magazine entitled *Concern* from 1986 to 1999, thereafter published under the name *Hope for Today*. The magazine is mailed to over 5,000 donors across Canada two to three times each year. The publications all bear one or more of the opponent's Marks. Other newsletters are published at least monthly and mailed to about 5,000 donors. The newsletters all bear one or more of the opponent's Marks. The opponent regularly publishes brochures related to international development. About 83,000 brochures entitled *Resources; From Despair to Hope in Ethiopia; Building Blocks of Hope; Global Opportunities* and others have been distributed across Canada. The brochures all bear one or more of the opponent's Marks.

[11] The opponent periodically arranges for the inclusion of newsletter inserts in the publications of other organizations including *The United Church Observer* and others which have a combined circulation of over 700,000 copies. Various other publications including posters, "postal drops," and a Christmas Catalogue are also distributed regularly. The opponent advertises and solicits donations in various magazines with substantial distribution in Canada. The opponent organizes various social events to raise awareness of international development issues and in this way reaches about 50,000 people annually. The opponent's website began operating in November 1999 and by August 2005 more than 10,000 Internet users were viewing the website each year. The cost for magazine and newspaper advertising and holding fundraising dinners amounted to about \$165,000 in 1985, gradually declining to about \$42,000 in 2003, for a total cost of about \$2.2 million. Costs to raise public awareness about third world development, including the cost for the publication of the magazine *Hope for Today*, public service

announcements, curriculum materials for schools and maintaining a Resource Centre amounted to about \$5.4 million for the period 1985 to 2003 inclusive. The opponent has 10 paid employees and 250 volunteers across Canada.

[12] Most donations to the opponent are from a base of 25,000 general public donors across Canada comprised of individuals, businesses, and churches. Provincial, federal and institutional grants comprise another source of donations. General public donations amounted to about \$37 million for the period 1985 to 2003 while governmental and institutional donations amounted to \$159 million for the same period. The opponent has issued over 100,000 charitable receipts to donors for income tax purposes since 1985. Exhibit materials attached to Mr. Cannon's affidavit provide examples of the magazines, newsletters, brochures and stationery employed by the opponent. From my perusal of the exhibit material, it appears that the marks most often used by the opponent are the word marks HOPE; HOPE INTERNATIONAL; HOPE INTERNATIONAL DEVELOPMENT AGENCY and the official mark shown below:



[13] In its written argument, the applicant objects that several portions of Mr. Cannon's evidence are inadmissible hearsay and should be ignored. As mentioned earlier, Mr. Cannon is a manager of several of the opponent's departments. Further, Mr. Cannon states in his affidavit that he has been informed of various aspects of the opponent's operations by managers of other

departments who have been identified by their name and position with the opponent. Given Mr. Cannon's senior position in his company, and in the absence of cross-examination which raises issues with his testimony, I find that such evidence is admissible: see *Vapour Canada Ltd. v MacDonald*, 6 C.P.R.(2d) 204 at 216-271(SCC); see also *Simpson's Sears v National Football League Properties Inc.* 61 C.P.R.(2d) 170 at 172 (TMOB) .

APPLICANT'S EVIDENCE

Taras Kulish

[14] Mr. Kulish identifies himself as the Chair of the Board of Directors of Hope Worldwide of Canada, a registered charity affiliated with the applicant Hope Worldwide, Ltd.. The applicant is a faith-based charity founded in 1991. As of 2006, the applicant served the poor in 75 nations on all six continents. Over 100,000 volunteers serve more than 2 million needy people with programs for disadvantaged children and the elderly. The applicant also provides education and medical services in developing countries. Hope Worldwide of Canada uses the applied for mark in Canada under license from the applicant.

[15] The applicant's website provides a link to the website for Hope Worldwide of Canada. The applicant's newsletters featuring the applied for mark are available for download from its Canadian licensee's website. In this regard, Mr. Kulish refers to Exhibit C of his affidavit which is comprised of printouts from the Canadian licensee's website. The applied for mark also appears on T-shirts from an annual fundraising activity held yearly in Toronto, and on business cards used by its licensee. In 2005 Hope Worldwide of Canada's beneficent contributions to the

community were recognized by David Miller, Mayor of Toronto; Dr. Kuldip Kular, MPP; and Malton Neighbourhood Services. The affiant Mr. Kulish is familiar with several charities which contain the word “hope” in their name including BMO Foundation of Hope; Hope for Children Foundation and Hope Air.

Anil Bhole

[16] Anil Bhole identifies himself as a student at law. In June 2006 he conducted a search of Canada Revenue Agency’s Charities Listing database for charities containing the word “hope.” The results of the search are attached as Exhibit B to his affidavit. From my inspection of Exhibit B, I note that there are 384 such charities of which 101 begin with the word HOPE.

Elentia Anastacio

[17] Ms. Anastacio identifies herself as a trade-mark searcher. In June 2006 she conducted a search of the CDName database for official marks, allowed trade-mark applications and active trade-marks registrations comprised in whole or in part of the component HOPE. The results of the search are attached as Exhibit A to her affidavit. From my inspection of Exhibit A, I note that there are 67 such third party marks covering beneficent services similar to those provided by the parties herein. I further note that in only eight of the marks does the component HOPE form the dominant first portion of the mark.

OPPONENT’S REPLY EVIDENCE

Amy Min-Chee Fong

[18] Ms. Fong identifies herself as a lawyer with the firm representing the opponent. Ms. Fong testifies that she reviewed Exhibit C of Mr. Kulish's affidavit but was unable to locate any appearance of the "Applicant's trade-mark as applied for, containing only the words HOPE and WORLDWIDE, other than one appearance . . ." From my review of Exhibit C, I note several instances where the applied for mark differs from the mark actually used by the applicant insofar as the applied for mark is underlined and the word CANADA appears beneath the line. However, I consider this difference to be a minor variation such that the variation also constitutes use of the applied for mark *per se*: in this regard see *Registrar of Trade Marks v. Compagnie Internationale pour L'Informatique CII Honeywell Bull, S.A.* (1985), 4 C.P.R.(3d) 523 (F.C.A.) and the second principle set out at page 538 in *Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R.(3d) 535 (T.M.O.B.).

Ms. Fong's evidence also shows that by December 2006, eleven of the charities cited in the Bhole affidavit, referred to earlier, had had their registered status revoked.

LEGAL ONUS AND EVIDENTIAL BURDEN

[19] 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. Of course, the opponent may rely on the evidence filed by the applicant to meet its evidential burden.

SECTION 30 GROUNDS OF OPPOSITION

[20] As noted earlier, the first ground has been withdrawn. The opponent has not submitted any evidence to support the remaining two grounds of opposition based on Section 30. Further, there is nothing in the evidence of record which the opponent can rely on to meet its evidential burden. The second and third grounds of opposition may therefore be rejected.

.SECTION 9(1)(N)(III) GROUND OF OPPOSITION

[21] The material time for considering the circumstances respecting the fourth ground of opposition is the date of my decision: see *Allied Corporation v. Canadian Olympic Association* (1989), 28 C.P.R.(3d) 161 (F.C.A.); *Olympus Optical Company Limited v. Canadian Olympic Association* (1991), 38 C.P.R.(3d) 1 (F.C.A.). In *Canada Post Corp. v. Butterfield & Daughters Computers Ltd.* 68 C.P.R. (4th) 280 at 291-292, Board Member Martin summarized the principles that are to be applied is considering a ground of opposition based on Section 9(1)(n)(iii):

. . . the opponent is not required to evidence use and adoption of the official marks being relied on, at least not in the absence of evidence suggesting that the marks were not used: see page 166 of the Allied

decision [see above]. Finally, if the applicant is able to cast doubt as to whether or not an official mark owner qualifies as a public authority, the opponent may be required to evidence that status before relying on any such official mark: see page 216 of the trial level decision in Big Sisters Association 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.) and Heritage Canada Foundation v. New England Business Service, Inc. (1997), 78 C.P.R.(3d) 531 at 536 and 538 (T.M.O.B.).

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, the official mark?: see page 217 of the trial level decision in the Big Sisters case noted above. It has been contended that the words "consists of" are not equivalent to "identical to" but Mr. Justice O'Keefe held otherwise in Canadian Council of Professional Engineers v. APA - The Engineered Wood Association (2000), 7 C.P.R.(4th) 239 (F.C.T.D.) at page 259 as follows:

Having outlined the protection official marks enjoy, based on the provisions of the Act, it must be determined what the scope of prohibited marks is: The meaning of "consists of" most specifically. As a result of the foregoing, which clearly shows the privileged position official marks enjoy, I reject the interpretation of subparagraph 9(1)(n)(iii) proffered by the appellant and declare that the interpretation advanced by the Registrar is correct. 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.

At pages 218-219 of the trial level decision in the Big Sisters case, 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 302-303 of the decision of the Federal Court of Appeal in Canadian Olympic Association v. Techniquip Limited (1999), 3 C.P.R.(4th) 298. Finally, the opponent can rely on a family of official marks if it evidences use of the family members: see pages 303-304 of the Techniquip decision.

First Branch of Test

[22] In the instant case, the opponent has evidenced use and adoption of its official marks while the applicant has not cast doubt on whether the opponent qualifies as a public authority. Thus, the opponent may rely on the official marks pleaded in the statement of opposition. Having inspected the applied for mark and the opponent's official marks, I find that the applied for mark HOPE WORLDWIDE & Design is not identical to any of the opponent's official marks and therefore the opponent does not succeed under the first branch of the test set out in Section 9(1)(n)(iii).

Second Branch of Test

[23] Three of the opponent's official marks are comprised in part of a design feature namely, the profile of a child's head encapsulated in a circular background, as shown below:



The above marks constitute a family or series of marks with respect to the design features rather than with respect to the word component HOPE. In this regard, given the extensive third party

adoption of the component HOPE as evidenced by the Bhole and Anastacio affidavits, the opponent cannot lay claim to a family of marks based on the word HOPE as a component unique to the opponent.

[24] In my view, the applied for mark HOPE WORLDWIDE & Design more closely resembles the opponent's family of official marks, shown above, than any other of the official marks relied on by the opponent. The visual resemblance owes to the word component HOPE and to some similarity between the circular design feature comprising the official marks and the globular design feature comprising the letter O in the applied for mark. Thus, a determination of the second branch of the Section 9(1)(n)(iii) test with respect to the opponent's family of official marks will decide the fourth ground of opposition.

[25] The second branch of the test has been discussed in *Hope International Development Agency v. Hoffnungszeichen Sign of Hope e.V.* 2008 CarswellNat 817 (TMOB) at para. 31:

(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)

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(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 . . .

Considerations under Section 6(5)(e)

[26] Applying Section 6(5)(e) to the instant case, I find that the overall visual impacts of the applied for mark and the opponent's family of official marks are quite different notwithstanding (i) the word HOPE and (ii) a spherical design feature which are common to the parties' marks. In my view the differences in the visual perception of the parties' marks in their entireties outweigh their visual similarities. There is, however, a greater resemblance in sounding and in the ideas suggested by the parties' marks. The resemblance in sounding owes to the word component HOPE which may be considered as the first or dominant portion of the parties' marks as spoken. Ordinarily it is the first portion of a mark that is the most important for the purpose of distinguishing between marks, however, when the first or dominant portion of a mark is fairly commonplace, its importance diminishes: see *Conde Nast Publications Inc. v. Union Des Editions Modernes* (1979) 26 C.P.R.(2d) 183 at 188 (F.C.T.D.); *Vancouver Sushiman Ltd. v. Sushiboy Foods Co.* (4th) 22 C.P.R. (4th) 107 (TMOB). Accordingly, in the present case there would be a tendency to discount the importance of the word HOPE and by corollary to focus more on other components. As noted in *United Artists Corp. v. Pink Panther Beauty Corp.* (1998), 80 C.P.R. (3d) 247 at 263 (F.C.A.),

While the marks [in issue] must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative

influence on the public's perception of it.

[27] The resemblance in ideas suggested by applied for mark and the opponent's family of official marks owes to (i) the word component HOPE and (ii) the word components WORLDWIDE and INTERNATIONAL, which latter components are somewhat synonymous. However, the opponent's family of marks also suggests the idea of "a child" (from the design component) and the idea of "development" which are wholly absent in the applied for mark and therefore tend to distinguish the parties' marks.

Conclusion

[28] Considering the above, and keeping in mind the similarities in the marks in issue as well as their differences, I find that the parties' marks are more different than they are alike and that, as a matter of first impression and imperfect recollection, the applied for mark does not so nearly resemble as to be likely to be mistaken for any of the opponent's official marks.

NON-ENTITLEMENT GROUNDS OF OPPOSITION

[29] The determinative issue with respect to the grounds of opposition pursuant to Section 16 is whether the applied for mark HOPE WORLDWIDE & Design is confusing with one or more of the opponent's word marks HOPE, HOPE INTERNATIONAL and HOPE INTERNATIONAL DEVELOPMENT AGENCY at the material dates December 31, 1996 (with respect to the services listed in sub-para. (a) of para. [1], above) and the date of filing the application, that is, June 7, 1999 (with respect to the programs listed in sub-para. (b) of para. [1],

above). The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2) of the *Act*.

Test for Confusion & Section 6(5) Factors

[30] The test for confusion is one of first impression and imperfect recollection. Factors to be considered in making an assessment as to whether two marks are confusing are set out in Section 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 Section 6(5)(a) -(d) Factors

[31] The marks in issue possess a low degree of inherent distinctiveness as the parties' marks are comprised of fairly commonplace words and images and are suggestive of the parties' beneficial purposes. The opponent's evidence indicates that its marks had become known to a fairly significant extent at the pertinent material dates. On the other hand, the applicant's mark HOPE WORLDWIDE & Design was not known at all at the pertinent material dates. The length of time that the marks have been in use favours the opponent as it has been using its marks since

1986 while the applicant does not claim use of its mark until 1996. Further, the applicant's evidence does not clearly substantiate use of its mark in Canada until about 2005. The nature of the parties' services and trades are essentially the same, that is, both parties are involved in similar charitable activities.

Section 6(5)(e) Factor

[32] With respect to the resemblance between the marks in issue, I find that the overall visual impact of the applied for mark is different from the overall visual impact of the opponent's word marks. The difference owes mostly to the design feature which comprises the letter O in the applied for mark. Otherwise, the previous discussion concerning the opponent's official marks with respect to aural resemblance and resemblance in ideas suggested is partially applicable to the opponent's word marks. That is, the word component HOPE forms the dominant first element of the marks in issue but its importance is diminished owing to third party adoption. The greatest resemblance between the marks in issue is in the ideas that they suggest owing to the shared component HOPE and the similarity in meaning between the components EVERYWHERE and INTERNATIONAL. However, the ideas of "development" and "agency" are absent from the applied for mark.

Summary of Section 6(5) Factors

[33] The factors which favour the opponent are the low degrees of inherent and acquired distinctiveness of the applied for mark, the acquired distinctiveness of the opponent's marks

(predominantly the mark HOPE INTERNATIONAL DEVELOPMENT AGENCY), the length of time that the marks have been in use, and the similarities in the parties' charitable activities. The factors that favour the applicant are the relatively low inherent distinctiveness of the opponent's marks and the differences in the parties' marks. In regard to the latter, I find that the differences in the parties' marks outweigh their similarities, but only slightly. However, it appears to me that once the importance of the component HOPE is diminished, owing to third party adoption, then the resemblance between parties' marks is correspondingly diminished. Accordingly, I find that the parties' marks, considered in their entireties, are more different than alike.

Protection Accorded to Weak Marks

[34] The principles discussed in *M. & K. Stereo Plus Ltd. v. Broadway Sound Plus Ltd.* 5 C.P.R. (3d) 390 at 397 (FCTD) concerning weak marks are applicable in the instant case:

As to the point that a weak trade mark is less entitled to a wide ambit of protection, Rand J. had this to say in *General Motors Corp. v. Bellows* (1949), 10 C.P.R. 101 at pp. 115-6, [1950] 1 D.L.R. 569, [1949] S.C.R. 678 (S.C.C.):

Mr. Fox submitted this basic consideration: that where a party has reached inside the common trade vocabulary for a word mark and seeks to prevent competitors from doing the same thing, the range of protection to be given him should be more limited than in the case of an invented or unique or non- descriptive word; and he has strong judicial support for that proposition: *Office Cleaning Services Ltd. v. Westminster Window and Gen'l Cleaners Ltd.* (1944), 61 R.P.C. 133 at p. 135; (1946), 63 R.P.C. 39; *Br. Vacuum Cleaner Co. v. New Vacuum Cleaner Co.*, [1907] 2 Ch. 312 at p. 321; *Aerators Ltd. v. Tollitt*, [1902] 2 Ch. 319. In *Office Cleaning Services*, 63 R.P.C. at p. 43, Lord Simonds used this language: "It comes in the end, I think, to no more than this, that where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first

user is allowed unfairly to monopolize the words. The Court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered."

No doubt there is a public interest against confusion of these marks, but on the other hand there is a like interest in the freedom of the individual trader in ordinary trade practices and in particular in using the main stock of the language. If the latter interest is disregarded, a single word might effect a wholesale appropriation of the only apt language available.

Further, as noted in *GSW Ltd. v. Great West Steel Industries Ltd.* (1975), 22

C.P.R.(2d) 154 at 169 (F.C.T.D.),

. . . 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.

[35] Having regard to the foregoing and applying the above principles of trade-mark law, I find that, despite the fact that the applied for mark is a weak mark and that there are similarities between the parties' marks, the applicant has met the legal onus on it show that, on a balance of probabilities, there is no reasonable likelihood of confusion between the applied for mark and any of the opponent's marks or trade-name at the relevant material dates. The grounds of opposition alleging non-entitlement are therefore rejected.

NON-DISTINCTIVENESS GROUNDS OF OPPOSITION

[36] The final two grounds of opposition essentially turn on the issue of confusion between the applied for mark HOPE WORLDWIDE & Design and the opponent's trade-marks and trade-

name at the material date September 7, 2004, that is, at the date of filing the opposition: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 C.P.R.(3d) 198 at 206 - 209 (F.C.T.D.). For the most part, my conclusions regarding the issues pertaining to the grounds of opposition based on non-entitlement also apply to the last two grounds. Accordingly, I find that, on a balance of probabilities, the applicant has shown that its mark distinguished and was adapted to distinguish the applicant's services at the material date September 7, 2004. The grounds of opposition alleging non-distinctiveness are therefore rejected.

DISPOSITION

[37] As each of the grounds of opposition has been rejected, the opposition is rejected. This decision has been made pursuant to a delegation of authority under Section 63(3) of the *Trade-marks Act*.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 21st DAY OF DECEMBER, 2009.

Myer Herzig,
Member,
Trade-marks Opposition Board