

IN THE MATTER OF AN OPPOSITION by Canadian Pacific Limited and Canadian Pacific Railway Company to application No. 1015128 for the trade-mark C.P.R. filed by Yasmin Products Pty. Limited

On May 11, 1999, the applicant, Yasmin Products Pty. Limited, filed an application to register the trade-mark C.P.R. based on proposed use of the mark in Canada in association with the following wares: “soaps, perfumery, essential oils; cosmetics namely compacts, make-up, lipstick, nail polish, blusher, face powder and skin moisturizers; and hair lotions namely shampoos, conditioners, perming solutions, straighteners and styling products.” The application is also based on use and registration of the mark in Australia in association with the above noted wares. The application was advertised for opposition purposes on January 10, 2001.

The opponents, Canadian Pacific Limited (“CPL”) and Canadian Pacific Railway Company (“CPR”), filed a statement of opposition on June 11, 2001, a copy of which was forwarded to the applicant on July 17, 2001.

The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the *Trade-marks Act*, R.S.C. 1985, C. T-13 (“the Act”) because it is confusing with the following registered trade-marks:

Trade-mark	Reg. No.	Wares
CP RAIL IMS & Design	TMA 328,210	Transportation of goods by road and rail, storage and transport of goods through intermodal terminals
CP RAIL SYSTEM & Design	TMA 436,654	Railway transportation services
CP RAIL SYSTEM	TMA 436,655	Railway transportation services

RESEAU CP RAIL	TMA 436,971	Railway transportation services
RESEAU CP RAIL & Design	TMA 437,396	Railway transportation services
CPRS	TMA 477,575	Railway transportation services
C.P.R.	TMA 541,272	Transportation of persons and goods by rail
C.P.R.	TMA 545,145	Transportation of goods by rail

CPL is also the owner of the following Canadian trade-mark applications:

Trade-mark	Application No.	Wares/Services
CPR ENTREE	836,034	Computer software, and operation of a web page, both for the provision of information about the Canadian Pacific Railway
CPR MEX	1,046,921	Transportation of goods by rail, operation of intermodal terminals
CPR MEX and Design	1,046,922	Transportation of goods by rail, operation of intermodal terminals

The second and third grounds are that the applicant is not the person entitled to registration pursuant to Subsections 16(2) and 16(3) of the Act because, as of the applicant's filing date, the applied for trade-mark was confusing with CPL's trade-marks and trade-names referred to above, all of which (with the exception of the subjects of registration TMA 545,145 and applications 1,046,921 and 1,046,922) had been previously used in Canada by the opponents, and had not

been abandoned at the date of advertisement of the applicant's application. The fourth ground is that the applicant's trade-mark is not adapted to distinguish and does not actually distinguish the applicant's wares from the wares and services of the opponents, having regard to the use and advertisement by the opponents of all the trade-marks and trade-names referred to above.

The applicant served and filed a counter statement on August 17, 2001. The opponents filed as their evidence the affidavits of Kelly Miranda and Carol Lacourte. The applicant didn't file any evidence. Both parties filed a written argument. An oral hearing was not held.

Opponent's Evidence

I will summarize what I consider to be the key points of the opponents' evidence.

Ms. Lacourte identifies herself as Senior Manager, Business Information Services/Archives of the opponent Canadian Pacific Railway Company. She explains that CPR officially came into being with Royal Assent on February 16, 1881 and commenced transporting passengers and freight by rail in 1882. Ms. Lacourte states that, since its incorporation, Canadian Pacific Railway Company has been known to the public as both CPR and C.P.R. and the company has used the trade-marks and trade-names extensively in their advertising, on signage, on trains, on their buildings and on their employee's uniforms as well as on various wares used in the provision of its services such as menus, table linen, dishes, bowls and tableware.

In the 1880's, CPR commenced building hotels in the Canadian Rockies to provide accommodations and meals for passengers on its transcontinental line. Ms. Lacourte goes on to state that over the next several decades, CPR opened or purchased a large number of major hotels across Canada, including the Empress in Victoria, The Chateau Lake Louise, Palliser Hotel in

Calgary, and the Royal York in Toronto, each of which was still in operation at the date of her affidavit. She does not state, however, whether these hotels are still in fact owned by either of the opponents.

Although CPR also engaged in other activities besides railway services, hotel services and ship transportation services, Ms. Lacourte attests that in more recent years, CPR has divested its interests in hotels, etc. and now concentrates on providing high quality freight rail and, to a lesser extent, passenger services, including CPR's The Royal Canadian Pacific luxury passenger service. Attached as Exhibit A to her affidavit are a collection of printouts from CPR's website which describes the activities of CPR. Under a heading entitled "company overview" in Exhibit A, it is stated that Canadian Pacific Railway (CPR) is a Class 1 North American railway, providing freight transportation services over a 14,000 mile network in Canada and the U.S. Further, at a page entitled "What We Ship", there is a heading "Sorry but we don't ship: People".

Ms. Lacourte attaches as Exhibit B to her affidavit a collection of printouts dated November 14, 2001, from CPR's website which she states describes The Royal Canadian Pacific service provided by CPR. On the page entitled "Questions Answered about the Royal Canadian Pacific", I note the following question and answer:

Q. Where do I purchase a ticket for train travel between two cities on the CPR network?
A. The CPR only operates luxury rail tours using vintage equipment. We do not offer regular rail passenger service. You can purchase single or double occupancy tickets for our unique tours through our office. Contact VIA Rail Canada to purchase regular inter-city train tickets.

Ms. Lacourte describes some of the wares distributed by CPR and attaches them as Exhibit E to her affidavit. Exhibit E comprises a collection of photographs from the CPR archives depicting menus, table linen, dishes and other tableware, all having the CPR trade-mark marked on them. The dates on which these items appeared to have been used range from 1882 - 1994, with the majority of them dating prior to 1980.

Attached as Exhibits F to O of her affidavit are particulars of CPL's registrations obtained to date and pending registrations.

Ms. Lacourte indicates that since 1882, CPR has distributed toiletry items to its rail passengers, ship passengers and hotel guests. Although Ms. Lacourte states that the volume of such products that have been distributed is high given the large number of passengers and guests who have been serviced over the past 120 years, samples of such items were not provided. Further, while she also asserts that CPR has been selling CPR merchandise, memorabilia and collectibles through its Station 29 store, mail order service and Internet site since 1998, of the products listed in the Station 29 store sample catalogue, only 5 products bearing the CPR mark were shown. These products consisted of a watch, lapel pin, stuffed beaver toy, pen and lanyard. Less than 4600 of these products have been sold since 1998.

Ms. Lacourte goes on to state that between 1971 and 1996, Canadian Pacific Railway Company changed its corporate name to Canadian Pacific Limited. In 1996, the company changed its name back to Canadian Pacific Railway Company. In 1998, CPR assigned many of its trade-mark rights and goodwill attaching thereto, including its rights to the CPR and C.P.R. trade-marks to a new company, Canadian Pacific Limited ("CPL"). At the same time, CPL licensed the use of these trade-marks back to CPR. Under the license, CPL has direct and indirect control of the

character and the quality of the wares and services in association with which the trade-marks are used by CPR.

Affidavit of Kelly Miranda

Attached as exhibits to the affidavit of Kelly Miranda, articling student employed with the opponents' agent, are the results of various searches performed of various different databases and search engines for references to the opponents. The searches were of the following: Canadian News Disc and INFOTRAC for articles wherein reference was made to the Canadian Pacific Railway or CPR; the Internet for web pages making reference to Canadian Pacific Railway or CPR; and the Ottawa Public Library for books on the history of the CPR.

Grounds of Opposition

The opponents' first and second grounds of opposition turn on the issue of confusion between the applicant's trade-mark and the opponents' trade-marks and trade-names referred to above. The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in sub-section 6(2) of the Act, the Registrar must have regard to all the surrounding circumstances including the following specifically enumerated in sub-section 6(5) of the Act: a) the inherent distinctiveness of the trade-marks and the extent to which the trade-marks have become known; b) the length of time the trade-marks have 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 in appearance or sound or in the ideas suggested by them. The weight to be given to each factor may vary, depending on the circumstances (see *Clorox Co. v. Sears Canada Inc.* (1992), 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers, Inc. v. Marchildon* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)).

The Registrar must bear in mind that the onus or legal burden is on the applicant to show that there would be no reasonable likelihood of confusion between the trade-marks and trade-names at issue as of the relevant dates. In this regard, the material date with respect to the paragraph 12(1)(d) ground of opposition is the date of my decision (see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.*, 37 C.P.R. (3d) 413 (F.C.A.)). The material date for considering the non-entitlement grounds is the applicant's filing date. In the circumstances of this case, nothing turns on which material date is chosen to assess the issue of confusion.

I will focus the discussion on CPL's trade-mark C.P.R., Registration No. 541,272. To the extent that CPL's marks and names are almost all associated with the same services, it is clear that if the applicant's mark is not confusing with C.P.R., then it is not confusing with CPL's other trade-marks and trade-names.

With respect to paragraph 6(5)(a), a mark made of up letters without any accompanying distinctive indicia is inherently weak. As such, it is not entitled to a wide ambit of protection (see *GSW Ltd. v. Great West Steel Industries Ltd. (GSW)*, (1975) 22 C.P.R. (2d) 154). In the present case, the CPR mark, which is comprised of an acronym for CPL's Canadian Pacific Railway services, is inherently weak. The applicant's mark, being identical to CPL's mark, is also inherently weak although to a lesser extent since the applicant's mark is not suggestive of its wares.

With respect to the extent the parties' marks have become known, as there is no evidence of the applicant's trade-mark having acquired distinctiveness in Canada or having been used in Canada, a consideration of this factor necessarily favours the opponents. I would like to add that the

evidence furnished shows that the CPL's mark has become well known in Canada in association with railway services only.

With respect to Paragraph 6(5)(b) of the Act, in view that CPR asserts use of the CPR mark since 1882 and there is no evidence of use of the applicant's mark, the length of time the marks have been in use favours the opponents. However, as the applicant pointed out, the opponents' own evidence points to the fact that the activities of the opponents have been freight and not passenger related for many years. Therefore, although the CPR mark has been in use with rail services since 1882, the fact that the opponents have not shown use of the C.P.R. mark in association with regular inter-city passenger services for many years is very relevant to the present case. I would also like to add that CPR did not commence use of its CPR memorabilia products until 1998.

As for the wares, services and trades of the parties, it is the applicant's statement of wares and the opponents' statement of services in registration No. 541,272 that govern: see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.), *Henkel Kommanditgesellschaft v. Super Dragon* (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.) and *Miss Universe, Inc. v. Dale Bohna* (1994), 58 C.P.R.(3d) 381 at 390-392 (F.C.A.). However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful: see page 169 of the decision of the Federal Court of Appeal in *McDonald's Corporation v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168.

The nature of the applicant's wares and CPL's services are quite different. In this regard, the opponents have established that the CPR mark is very well known, if not famous in Canada, in

association with railway services. By contrast, the applicant is in the business of beauty products. I therefore do not consider that the parties' wares and services overlap.

As far as the parties' channels of trade, although the applicant did not furnish any evidence, I would expect the applicant's products to be sold in drugstores, pharmacies, department stores, convenience stores and specialty health and beauty supply stores. The markets for the opponents' transportation of freight items would be completely different. As for CPL's service of transporting passengers, there is a potential for slight overlap of wares and services if the applicant's products were to be sold in a convenience store at a train station.

There is the highest degree of resemblance possible between the parties' marks.

As a further surrounding circumstance, I have considered CPR's use of the CPR mark in association with certain wares in the provision of passenger services. In this regard, CPR has shown use of the mark in association with menus, table linen, dishes, bowls and tableware. CPR also asserts that it has distributed a large volume of toiletry items to passengers and guests over the past 120 years, although there is no indication that the CPR mark ever appeared on such items. CPR has also recently started selling items marked with the CPR trade-mark as memorabilia.

Once again, I consider it relevant that except for the memorabilia wares, the wares noted above would likely have been used in the provision of passenger services which the opponents' own evidence shows have not been provided by the opponents for many years. As for the memorabilia wares, all promotion, sales and use of the CPR trade-mark on such items (none of which I may add are related to beauty products) are clearly in the context of sales of memorabilia "of the railroad".

As another surrounding circumstance, I have considered the opponents' submission that, in view of the long and important role the opponents have played in the development and the history of Canada, the trade-mark and trade-name CPR have become famous in Canada. As such, the opponents argue that it should be accorded a greater ambit of protection.

The governing jurisprudence regarding this issue is as follows.

In *United Artists Corp. v. Pink Panther Beauty Corp.* (1998), 80 C.P.R. (3d) 247, the Federal Court of Appeal had this to say about the difference between the parties' wares and services in that case:

"...the Act makes clear that what is being protected is not the exclusive right to any mark that a person might think of, but the exclusive right to use it in association with certain products or services."

"A trade-mark is a mark used by a person to distinguish his wares or services from those of others. The mark, therefore, cannot be considered in isolation, but only in connection with those wares or services. This is evident from the wording of subsection 6(2). The question posed by that subsection does not concern the confusion of marks, but the confusion of goods or services from one source as being from another source."

"The wide scope of protection afforded by the fame of the appellant's mark only becomes relevant when applying it to a connection between the applicant's and the opponent's trade and services. No matter how famous a mark is, it cannot be used to create a connection that does not exist."

"United Artists produces movies. It does not manufacture or distribute beauty products. United Artists' products are not likely to be made available in the same places of trade as the appellant's products. Shampoo is not sold in movie theatres or video stores. Videos are not available in beauty parlours. These are facts recognized by the Trial Judge, but they bear emphasizing. What the Trial Judge did not give sufficient weight to is that, not only were the wares in each case completely disparate, but there is no connection whatsoever between them. As I stated earlier, where no such connection exists a finding of confusion will be rare."

In *Lexus Foods Inc. v. Toyota Jidosha Kabushiki Kaisha*, November 20, 2000, A-622-99, at page 6 the Federal Court of Appeal said the following about the extent to which notoriety might extend the scope of protection accorded to a trade-mark:

Famousness alone does not protect a trade-mark absolutely. It is merely a factor that must be weighed in connection with all the rest of the factors. If the fame of a name could prevent any other use of it, the fundamental concept of a trade-mark being granted in relation to certain wares would be rendered meaningless.

More recently, in *Mattel Inc. v. 3894207 Canada Inc.* (2004), 30 C.P.R. (4th) 456

(F.C.T.D.), Justice Rouleau stated the following at p.465:

“The notoriety of a mark is only one factor that must be taken into consideration. If the fame of a name could prevent any other use of this name, the fundamental concept of granting a trade-mark in association with certain wares would be rendered meaningless.”

Applying the above principles to the present case, while I agree that the mark CPR is well known for railway services, I do not find a connection between the opponents' railway services and the applicant's beauty related products. CPL transports freight by rail. It does not manufacture beauty products. Even if it used to distribute shampoo, soap, etc. to railway passengers, these wares were distributed in the provision of its railway passenger services. It is difficult to imagine that an individual would buy a train ticket in order to receive shampoo. Likewise, consumers would not visit a train station or a train company's web site, mail order service or memorabilia store, to buy beauty related products. Further, I would not think that consumers would even entertain the thought that the railway company CPR was the source of the applicant's beauty related products. I therefore do not find a connection between the opponents' railway services and the applicant's beauty related products.

As a final surrounding circumstance, I have taken judicial notice that the letters CPR are also a commonly used acronym for “cardio pulmonary resuscitation”. Although the applicant has also asked that I take judicial notice that the letters CPR are a known abbreviation for Canadian Patent Reporter, I will not do so as I consider this fact to be known primarily by those in the intellectual property and legal communities, and not those in the general public.

The issue is whether a consumer who has a general and not precise recollection of CPL’s mark, will, upon seeing the applicant’s mark, be likely to think that the wares/services share a common source. Having considered all the surrounding circumstances, and in particular the low inherent distinctiveness of the parties’ marks, and the differences in the parties’ wares and services and channels of trade, and notwithstanding the extent to which CPL’s mark has become known, I find that the applicant has met the legal burden on it to show no reasonable likelihood of confusion between its mark and CPL’s mark. The first and second grounds of opposition are therefore unsuccessful.

The same conclusion is reached with respect to each of the other marks pleaded by the opponents both because the discussion above regarding the subsection 6(5) factors applies and because the differences between the other marks of the opponents and the applicant’s mark are greater.

With respect to the final ground of opposition, the material date with respect to non-distinctiveness is the date of filing of the opposition (see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)). The factors set out under subsection 6(5) of the Act in regards to the

assessment of confusion also apply in respect of this ground of opposition. Having regard to those factors and all the surrounding circumstances, I am satisfied that the proposed mark was distinctive at the material date.

In view of the above, and pursuant to the authority delegated to me under Sub-section 63(3) of the Act, I reject the opponents' opposition.

DATED AT GATINEAU, QUEBEC, THIS 19th DAY OF October, 2004.

C. R. Folz
Member,
Trade-Marks Opposition Board