



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

**Citation: 2014 TMOB 189  
Date of Decision: 2014-09-03**

**IN THE MATTER OF AN OPPOSITION  
by The Association of Registered Graphic  
Designers of Ontario to application  
No. 1,500,967 for the certification mark  
CGD in the name of Society of Graphic  
Designers of Canada**

[1] Society of Graphic Designers of Canada (the Applicant) has applied-for the certification mark CGD for use in association with the following services (the Services). The application claims use since September 21, 2010.

- (1) Professional graphic design services, namely graphic art, commercial art, product design consulting services, website design, product packaging design services, communication design, visual communication, interface design, multimedia design, animation, typographic design, editorial design, signage design, wayfinding design, and branding.
- (2) Educational services in the field of graphic design.
- (3) Administration and planning of educational programs in the field of graphic design.

The standard set out in the application is:

The use of the certification mark certifies that the professional has achieved excellence in the field of graphic design, and has met the following defined standard: a) accumulated the required number of years of combined graphic

design education and professional practice, b) received professional status in a province which, through legislation, registers or certifies graphic designers, or whose work, experience and professional integrity is deemed acceptable by the National Executive of the Society of Graphic Designers of Canada, or who passes a portfolio review and provides two references from other certified professionals and/or employers or clients, c) is living and working in Canada or is a Canadian citizen, and d) subscribes to the Goals and Objectives (as set out in the attached) and Code of Ethics and Professional Conduct of the Society of Graphic Designers of Canada (see attached).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of August 3, 2011.

[3] On December 14, 2011, The Association of Registered Graphic Designers of Ontario (the Opponent) opposed the application on the following grounds:

- (a) The application does not conform to section 30(a) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) because the statement of services is neither sufficiently specific, nor set out in ordinary commercial terms.
- (b) The application does not conform to section 30(b) of the Act because the Applicant or its licensees have not used the Mark in Canada since at least as early as September 21, 2010.
- (c) The application does not conform to section 30(f) of the Act because the defined standard is not sufficiently specific.
- (d) The application does not conform to section 30(i) of the Act because the Applicant could not have been satisfied it was entitled to use and/or authorize licensed use of the Mark in Canada in association with the Services.
- (e) The application is not registrable because it is confusing with the Opponent's registration No. TMA593,715 for RGD CANADA.

- (f) The application is not registrable because it is confusing with the official marks: No. 913,717 for R.G.D.; 913,716 for RGD; and 913,718 for REGISTERED GRAPHIC DESIGNER.
- (g) The application is not registrable pursuant to section 23(1) of the Act because the Applicant is engaged in the manufacture, sale, leasing and/or performance of the Services.
- (h) The Applicant is not the person entitled to registration of the Mark in view of section 16(1) of the Act since it was confusing with the Opponent's Marks.
- (i) The Mark is not distinctive in that it is not adapted to distinguish and does not actually distinguish the Services of the Applicant.

[4] The Applicant filed and served a counter statement, in which it denies the Opponent's allegations.

[5] The Opponent did not file any evidence pursuant to Rule 41 of the *Trade-marks Regulations*, SOR/96-195 (Regulations). The Applicant filed as its evidence pursuant to Rule 42 of the Regulations the affidavit of Melanie MacDonald, its Executive Director. The Opponent filed as its reply evidence pursuant to Rule 43 of the Regulations the affidavit of Lionel Gadoury, its President. I accept that paragraphs 2 and 4 and Exhibits A and C to Mr. Gadoury's evidence constitute proper reply evidence.

[6] Both parties filed a written argument and were represented at a hearing held on May 6, 2014.

#### Material Dates and Onus

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

- sections 38(2)(a)/30 - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475; *Flowers Canada/Fleurs Canada Inc v Maple Ridge Florist Ltd* (1998), 86 CPR (3d) 110 (TMOB)];

- sections 38(2)(b)/12(1)(d) and 12(1)(e) - the date of my decision [*Canadian Olympic Assn v Allied Corp* (1989), 28 CPR (3d) 161 (FCA) and *Canadian Olympic Assn/Assoc Olympique Canadienne v Olympus Optical Co* (1991), 38 CPR (3d) 1 (FCA)];
- sections 38(2)(c)/16(1) - the date of first use claimed in the application [see section 16(1)]; and
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 at 324 (FC)].

[8] Before considering the grounds of opposition, it is necessary to review some of the technical requirements with regard to (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[9] With respect to (i) above, there is an evidential burden on an opponent to prove the facts in its allegations pleaded in the statement of opposition: *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298. The presence of an evidential burden on an 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. With respect to (ii) above, the legal onus is on an applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent (for those allegations for which an opponent has met its evidential burden). The presence of a legal onus on an applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against it.

### Grounds Which Can be Summarily Dismissed

#### Section 30(a) Ground of Opposition

[10] The Opponent alleges that the application does not conform to the requirements of section 30(a) of the Act as the application does not contain a statement in ordinary commercial terms. The Opponent's initial evidential burden under section 30(a) is a light one and may be met through argument [*McDonald's Corp v M.A. Comacho-Saldana International Trading Ltd* (1984), 1 CPR (3d) 101 (TMOB) at 104; *Air Miles International Trading BV v Deutsche*

*Lufthansa AG* (2010), 89 CPR (4th) 230 (TMOB) at para 30]. The Opponent submits that the application is not in ordinary commercial terms since it is not immediately apparent to the ordinary consumer what services are being described with respect to Services(1).

[11] The Canadian Trade-marks Office's Wares and Services Manual includes a representative list of acceptable wares and services under section 30(a) of the Act. I have exercised my discretion to check it [*Johnson & Johnson v Integra Lifesciences Corp* (2011), 98 CPR (4th) 429 at para 29 (TMOB)] and note that it includes the services "graphic art design". As the subject application includes this term and describes the services in greater detail, the Opponent fails to meet its initial burden. Accordingly, this ground of opposition is rejected.

#### Section 30(f) Ground of Opposition

[12] The Opponent alleges that the application does not comply with section 30(f) of the Act because the defined standard is not sufficiently specific. The application does contain particulars of the defined standard that the use of the Mark is intended to indicate. The Opponent therefore fails to meet its initial burden and this ground of opposition is rejected.

[13] The Opponent submits that while the standard referenced in the application requires adherence to the Code of Ethics and Professional Conduct of the Society of Graphic Designers of Canada, the Applicant's website indicates adherence to a different standard is required, the GDC Code of Ethics and GDC Sustainability Principles (Exhibit C to the affidavit of Lionel Gadoury). This issue, however, was not raised in the statement of opposition. As such, I am precluded from considering it. Where an opponent has pleaded that the application fails to comply with a section of the Act based on a particular set of circumstances, it is not permissible to refuse it on the basis that it does not comply with that section of the Act for reasons different than those pleaded [*Le Massif Inc v Station Touristique Massif du Sud (1993) Inc* (2011), 95 CPR (4th) 249 at paras 27-29 (FC)].

#### Sections 30(f) and 23 of the Act

[14] The Opponent alleges that the application is not registrable because the Applicant is engaged in the manufacture, sale, leasing and/or performance of the Services pursuant to section

23. Such a ground of opposition is properly considered under section 30(f). Further, as there is no evidence that the Applicant performs the Services, the Opponent has not met its evidential burden and this ground of opposition is rejected.

#### Section 30(i) Ground of Opposition

[15] The section 30(i) ground of opposition alleges that the Applicant could not have been satisfied that it was entitled to use the Mark. Where an applicant has provided the statement required by section 30(i), this ground should only succeed in exceptional cases such as where there is evidence of bad faith [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. As this application includes the required statement and there is no allegation or evidence of bad faith or other exceptional circumstances, the section 30(i) ground is dismissed.

#### Section 16(1) and Section 2 Grounds of Opposition

[16] The section 16(1)(a) and section 2 grounds of opposition are rejected because the Opponent has not met its initial burden. The Opponent has not evidenced that its trade-marks or official marks were used or made known in Canada as of the applicable material dates. Although a declaration of use has been filed in respect of the Opponent's registration No. TMA593,715 for RGD CANADA and in order to obtain the official marks Nos. 913,717 for R.G.D.; 913,716 for RGD and 913,718 for REGISTERED GRAPHIC DESIGNER, the Opponent must have adopted the marks, that is not sufficient to meet its initial evidential burden with respect to these grounds of opposition [see, for example, *Entre Computer Centers Inc v Global Upholstery Co* (1992), 40 CPR (3d) 427 (TMOB)].

#### Remaining Grounds of Opposition

[17] The remaining grounds of opposition based on sections 30(b), 12(1)(d), and 12(1)(e) of the Act will be considered below.

#### Section 30(b) Ground of Opposition

[18] The statement of opposition alleges that the Mark has not been used by the Applicant or its licensees since at least as early as September 21, 2010.

[19] Section 23 of the Act does not permit the owner of a certification mark to use the mark, but rather deems use of the mark by its licensees to be use by the owner. In *Ontario Dental Assistants Association v Canadian Dental Association*, 2013 FC 266 at para 21 aff'd 2013 FCA 279 (*Ontario Dental*), Manson J set outs that to be valid a certification mark must:

- not be used by the certification mark owner, but only by authorized licensees, in association with the performance of services, the production of wares or advertising the wares or services of those licensees, at the date of first use; and
- such use must be in accordance with section 4 of the Act.

[20] The evidential burden on an opponent respecting the issue of an applicant's non-compliance with this section of the Act is a light one and can be met by reference not only to its evidence, but also to the applicant's evidence [*Labatt Brewing Co Ltd v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD) at 230]. To do so, an opponent must show that an applicant's evidence is 'clearly' inconsistent with the claims set forth in the application [*Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd*, 2014 FC 323 at para 33]. If an opponent meets its evidential burden, an applicant must prove that it has used the Mark as of the date claimed. Further, an applicant ought to be aware that if it is unable to prove a claimed date of first use with documentary evidence, it may be better off claiming a later, provable date, rather than risk having its application refused under section 30(b) [*Guevin v Tall Dark & Handy Handyman Services Ltd* (2011), 97 CPR (4th) 444 at para 19 (TMOB)].

[21] Ms. MacDonald's evidence at paragraphs 12-13 of her affidavit is that:

On September 21, 2010, the Applicant sent out an email to all of its members directing the members whose services met the defined standard for certification to immediately begin advertising and performing the Services in association with the Mark.

I verily believe that many of the Applicant's members whose services met the defined standard for certification complied with the Applicant's direction and immediately began advertising and performing the Services in association with the Mark on or around September 21, 2010. I base this belief on the many emails and phone calls that I received from the Applicant's members on or around September 21, 2010 in respect of use of the Mark.

[22] Ms. MacDonald also attaches to her affidavit a copy of a bulletin published by the Applicant on December 22, 2010 (Exhibit A). This bulletin states that on September 15, 2010 delegates voted to change the MGDC certification to CGD certification. It advises that CGD is a clearer honorific and that the requirements and case study review remain the same. This bulletin further states:

Current MGDC members are encourage to begin using the certification mark “CGD” immediately and by January 1, 2011 at the latest. CGD certified members may use the GDC logo and the following text reference on their promotional materials CGD, Society of Graphic Designers of Canada ...

[23] In its submissions, the Opponent relies on the fact that the Applicant’s members had until January 1, 2011 to commence use of the Mark and submitted that the examples of use provided by Ms. MacDonald did not show use of the Mark as a certification mark.

[24] The use of the phrase “on or around September 21, 2010” by Ms. MacDonald suggests that she is not certain whether use of the Mark commenced by the Applicant’s members on September 21, 2010 and is clearly inconsistent with the date claimed in the application. Further, it seems unlikely that the Applicant’s Members would have used the Mark on the very same day they were advised to do so. I find that this is sufficient to meet the Opponent’s light evidential burden [see also *Society of Professional Accountants of Canada v Institute of Certified Professional Accountants of Alberta* 2010 TMOB 182 at para 21 where Myer Herzig also found that such circumstances would be sufficient to meet an opponent’s light evidential burden]. As the Opponent has met its evidential burden, I must now assess whether the Applicant has proven it has used the Mark as of the date claimed in the application.

[25] Ms. MacDonald provides printouts from several of the Applicant’s Members’ websites and LinkedIn pages in which CGD appears following the name and title of the Member or as a qualification, for example:

- “Pablo Mandel / CircularStudio Art Director & Graphic Designer, CGD” (Internet archive of [www.circularstudio.com](http://www.circularstudio.com) from November 9, 2010; Exhibit C);
- Under the heading Professional Affiliations/Boards/ Juries “CGD Member and Membership Chair, Society of Graphic Designers of Canada, Alberta South Chapter”



(Internet archive of [acad.ab.ca/faculty\\_profiles.html](http://acad.ab.ca/faculty_profiles.html) for Naoko Masuda from December 13, 2010; Exhibit D);

- “Meet Doug Coates, CGD” ([www.mcclaydesign.com](http://www.mcclaydesign.com); Exhibit E);
- “Kirsten Skipp is an award-winning designer with over 12 years experience. Kirsten received a BA in history from the University of British Columbia and studied design at Vancouver Community College. Kirsten is a professionally certified member (CGD) of the Graphic Designers of Canada”. ([www.skippdesign.com](http://www.skippdesign.com); Exhibit F);
- “Pretty/Ugly Design is an umbrella for the freelance work of graphic designer Ben Didier, CGD.” ([www.prettyugly.ca](http://www.prettyugly.ca); Exhibit F);
- “GRAPHIC DESIGN BY LISA SALAZAR, CGD” ([www.salazar.ca](http://www.salazar.ca); Exhibit F); and
- “Kevin Guenther CGD” ([ca.linkedin.com](http://ca.linkedin.com); Exhibit F).

The Applicant submits that this evidence shows that its Members have used the Mark in association with the advertising of graphic design services.

[26] I do not find that the evidence provided by Ms. MacDonald demonstrates use of the Mark as a certification mark as of the date claimed. First, the evidence is ambiguous at best as to whether any of the Applicant’s members would have commenced use on September 21, 2010. Second, the examples of use attached to her affidavit do not show use of the Mark pursuant to sections 2 and 4 of the Act. Rather, the examples show that the Applicant’s Members are using CGD as a professional designation to state their credentials to the public as opposed to as a certification mark for the purposes of distinguishing Services of a defined standard. In reaching this conclusion, I rely on the following jurisprudence:

- *Ontario Dental, supra* at paragraph 30 where use of CDA on name tags worn by dental assistants when providing services to the public was not found to distinguish the services performed.
- *Conseil canadien des ingénieurs professionnels v Alberta Institute of Power Engineers*, (2008), 71 CPR (4th) 37 (TMOB) at para 46 where it was found that the Applicant had not shown use as required by section 4(2) of the Act despite the PE designation appearing on business cards and at the end of engineers’ names.

- *Parisella Vincelli Associates Consulting Group Inc v CPSA Sales Institute* (2003), 31 CPR (4th) 308 at para 12 (TMOB) where it was found that PVA was not used in association with services but was rather used as a professional title that appears after the name of an individual on business cards, letterheads or certificates of accreditation.

[27] Accordingly, this ground of opposition is successful.

#### Section 12(1)(d) Ground of Opposition

[28] I have exercised my discretion and checked the Register to confirm that registration No. TMA593,715 for the RGD CANADA trade-mark is extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. This mark is registered for use in association with the following wares and services:

Wares: Print and electronic publications namely books, newsletters, brochures and pamphlets, all on the subject of graphic designing and the services provided by the Association; T-shirts, briefcases, canvas shopping bags, mugs, pens, baseball caps, book marks.

Services: Association services namely providing self-regulatory, disciplinary, professional qualification status and membership services to graphic designers; employment services namely facilitating members of the Association with obtaining graphic design positions and facilitating graphic design firms with obtaining graphic design employees; information services namely providing information about graphic designers via a global computer network Website and the conducting of special events namely conferences, workshops, seminars, professional development discussion groups, network and social receptions, public education forums, all of the foregoing services being on the subject of business, practice and study of graphic design; education services namely providing continuing education and professional development courses to graphic designers via conferences and seminars; philanthropic services namely providing scholarships to students to develop their graphic design interests.

Therefore, the Opponent has met its initial burden with respect to this ground.

[29] There is a likelihood of confusion if the use of both trade-marks in the same area would likely lead to the inference that the wares and services associated with those trade-marks are manufactured, sold or leased by the same person. A likelihood of confusion does not concern confusion of the marks themselves, but confusion of the goods or services from one source as

being from another source. In the instant case, the question is whether there would be confusion of the Services certified by the Applicant sold in association with the Mark as produced by, sponsored by or approved by the Opponent.

[30] In assessing confusion, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the wares and services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them.

[31] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, (2011), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

*inherent distinctiveness*

[32] This factor favours neither party as the marks under consideration possess little inherent distinctiveness. The Mark consists of the acronym CGD standing for Certified Graphic Designer. The Opponent's trade-mark consists of the acronym RGD standing for Registered Graphic Designer and the descriptive word Canada.

*degree of resemblance*

[33] When determining whether a trade-mark is confusing, the trade-mark as a whole should be considered. It should not be dissected into its component parts. Further, the first portion of a mark may be the most important for purposes of distinguishing between marks [*Conde Nast Publications Inc v Union Des Editions Modernes* (1979), 46 CPR (2d) 183 at 188 (FCTD)].

[34] The parties' trade-marks resemble each other to some extent in appearance and as sounded since RGD and CGD both share the suffix component GD. However, the inclusion of CANADA in the Opponent's mark diminishes the degree of visual and aural resemblance. If the

trade-marks suggest any idea to consumers, it would simply be that of a graphic designer or graphic design services which are certified or registered and this in itself does not lead to a high degree of resemblance in idea suggested. Further, this concept (or the acronym for it) cannot be the subject of a monopoly: see Reed J.'s comments in *American Assn of Retired Persons v Canadian Assn. of Retired Persons/Assoc Canadienne des Individus Retraités* (1998), 84 CPR (3d) 198 at para 34 (FCTD):

The marks have a resemblance in appearance and sound because the last three letters of the two acronyms are the same. When determining whether a trade-mark is confusing, the trade-mark as a whole should be considered. It should not be dissected into its component parts. The C and maple leaf in CARP's mark does distinguish it. The idea elicited by the mark should also be considered. The idea conveyed by the last three initials of both marks is that of an association of retired persons, a concept that cannot be the subject of a monopoly. The initial letters A and C signify different geographical bases and, as noted, serve as a distinguishing feature.

*extent of use and length of time in use*

[35] This factor slightly favours the Applicant. The Opponent has not filed any evidence of use of the trade-mark RGD CANADA. While the Applicant's evidence does not show use of the CGD trade-mark *per se*, I find that CGD would have some degree of reputation due to the fact it has been adopted by the Applicant's Members as a credential on their websites and the like. If I am wrong to find that this factor favours the Applicant, it would not have impacted my ultimate decision on this ground of opposition.

*nature of wares business and trade*

[36] This factor favours the Opponent. The Mark is a certification mark which certifies that a professional has achieved excellence in the field of graphic design. The Opponent's services include professional qualification services. Therefore, the parties' services and trades are essentially the same, that is, each party is concerned with ensuring that high quality graphic design services are available to businesses and individuals.

*jurisprudence on weak trade-marks*

[37] The jurisprudence on weak trade-marks supports the Applicant's position. In *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD), the Court held that trade-marks based on initials are weak trade-marks and are only entitled to a narrow ambit of protection. Further, it is well accepted that comparatively small differences will suffice to distinguish between weak marks. In *Provigo Distribution Inc v Max Mara Fashion Group SRL* (2006), 46 CPR (4th) 112 at para 31 (FCTD), Montigny J. explained:

The two marks being inherently weak, it is fair to say that even small differences will be sufficient to distinguish among them. Were it otherwise, first user of words in common use would be unfairly allowed to monopolize these words. A further justification given by courts in coming to this conclusion is that the public is expected to be more on its guard when such weak trade names are used ... This is particularly the case when abbreviations are used: it has even been held that the same letters in different order (admittedly with a different shape and design) were not confusing (*GSW Ltd v Great West Steel Industries...*).

Finally, a party adopting a weak trade-mark has been held to accept some risk of confusion [*General Motors v Bellows* (1949), 10 CPR 101 at 115-116 (SCC)].

[38] While it is possible for the degree of distinctiveness attributed to a weak trade-mark to be enhanced through extensive use [*Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 at para 6 (FCTD)], the Opponent has filed no such evidence of use.

*conclusion*

[39] Considering the factors in section 6(5), and taking into account that the trade-mark RGD relied on by the Opponent is a weak mark and there is no evidence of its use such that it would be entitled a greater scope of protection, I have concluded that the balance of probabilities between finding that there is no reasonable likelihood of confusion, and finding that there is reasonable likelihood of confusion, falls slightly in favour of the Applicant. This ground of opposition is therefore rejected. I would add that if the Opponent had established a significant degree of acquired distinctiveness for its mark, then the balance of probabilities would likely have tipped in favour of it.

*Section 12(1)(e) Ground of Opposition*

[40] The Opponent has pleaded that the Mark is not registrable having regard to section 12(1)(e) of the Act in that its adoption is prohibited by section 9(1)(n)(iii) which states:

No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for, any badge, crest, emblem or mark ...adopted and used by any public authority, in Canada as an official mark for wares or services, in respect of which the Registrar has, at the request of Her Majesty or of the university or public authority, as the case may be, given public notice of its adoption and use;

[41] In support of this ground of opposition, the Opponent relies upon its official marks set out below. I have exercised my discretion and checked the register to confirm that each of these official marks is extant [*Quaker Oats Co of Canada, supra*].

| No.     | Mark                        |
|---------|-----------------------------|
| 913,717 | R.G.D.                      |
| 913,716 | RGD                         |
| 913,718 | REGISTERED GRAPHIC DESIGNER |

[42] There is no evidence regarding the Opponent's adoption and use of its official marks. Nor is there any evidence to demonstrate that the Opponent is, in fact, a public authority. The Applicant submits at paragraphs 88-89 of its written argument:

88 It is also worth noting that the Official Marks were advertised in 2001, prior to the Practice Notice issued by the Canadian Trade-marks Office in 2007 which ushered in a more rigorous process for evaluation of "public authority status" including the requirements for government control. In particular, the simple fact that the Opponent is "statutory" does not in law constitute "government control" in this context.

89 The Opponent has not led any evidence in chief whatsoever, nor any admissible evidence in reply on this point. ... Therefore it has not supported its allegation that the Certification Mark so nearly resembles

as to be mistaken for its Official Marks, and has not satisfied its initial evidentiary burden in support of its argument.

[43] In the absence of any evidence suggesting that the Opponent's official marks have not been used, the Opponent is not required to evidence adoption and use of its official marks [see *Canadian Olympic Assn v Allied Corp*, *supra* at 166]. Moreover, since the Applicant has not filed evidence casting doubt on whether the Opponent qualifies as a public authority, the Opponent is not required to evidence its status as such in order to rely upon its official marks.

[44] The Opponent has therefore met its initial burden with respect to this ground of opposition. I must now determine whether or not the Mark consists of, or so nearly resembles as to be likely to be mistaken for, the official marks. The case law has interpreted "consisting of" in section 9 to mean "identical to" [*Big Sisters Assn of Ontario v Big Brothers of Canada* (1997), 75 CPR (3d) 177 (FCTD); *aff'd* (1999), 86 CPR (3d) 504 (FCA)].

[45] The Mark is not identical to any of the Opponent's official marks. As such, I must assess whether it so nearly resembles the Opponent's marks so as to be likely to be mistaken for any of them. Regarding the resemblance test set out in section 9, the case law indicates that it should be applied as a matter of first impression and imperfect recollection, with regard to the factors set out in section 6(5)(e) [*Big Sisters*, *supra*]. Finally, "mistaken therefore" and "confusing with" are not synonymous [*Canadian Council of Professional Engineers v APA-The Engineered Wood Assn* (2000), 7 CPR (4th) 239 at para 71 (FCTD)].

[46] The Mark is visually and aurally distinguishable from the RGD and R.G.D. official marks due to the differences in the first letter of the marks. It is also distinguishable from the official mark REGISTERED GRAPHIC DESIGNER. As a result, I find that a person familiar with any of the Opponent's official marks but having an imperfect recollection thereof would not be likely to mistake the Mark therefor. I therefore reject this ground of opposition.

Disposition

[47] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

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Natalie de Paulsen  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office