



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

**Citation: 2014 TMOB 100**  
**Date of Decision: 2014-05-13**

**IN THE MATTER OF AN OPPOSITION  
by Forest Stewardship Council, A.C. to  
application No. 1,524,862 for the trade-  
mark TREE Design in the name of G.H.  
Imported Merchandise & Sales Limited**

[1] G.H. Imported Merchandise & Sales Limited has applied to register the trade-mark TREE Design, shown below, in association with bags, namely tote bags, backpacks, one shoulder bags, portfolios, computer cases, and brief cases.



[2] Forest Stewardship Council, A.C. has opposed the application primarily on the basis that there is a reasonable likelihood of confusion between this trade-mark and its FSC and Tree Design mark, registration No. TMA528,235, shown below. This mark is registered in association with furniture and products made from wood, printed materials relating to forest management and conservation and related services and has also purportedly been used in association with, *inter alia*, clothing, accessories, toys and bags.



Forest Stewardship Council, A.C. has also opposed the application on technical grounds under section 30 of the Act, including non-compliance with section 30(i) in view of an alleged violation of the *Copyright Act*.

[3] For the reasons that follow, I have found that this opposition should be rejected.

#### Background

[4] On April 26, 2011, G.H. Imported Merchandise & Sales Limited (the Applicant) filed application No. 1,524,862 for the registration of the applied-for mark TREE Design (the Mark) based on use of the Mark in Canada in association with bags, namely tote bags, backpacks, one shoulder bags, portfolios, computer cases and brief cases since at least as early as 2009.

[5] The application was advertised on December 14, 2011, and Forest Stewardship Council, A.C. (the Opponent) filed a Statement of Opposition on February 14, 2012. The Opponent alleges that the Mark is not registrable under section 12(1)(d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) and that the Applicant is not the person entitled to registration of the Mark under section 16(1) of the Act because the Mark is confusing with the Opponent's registered trade-

mark FSC and Tree Design (registration No. TMA528,235) that has been previously used in Canada by the Opponent. The Opponent further alleges that the application for the Mark does not comply with the requirements of section 30(i) of the Act because the Mark infringes the copyright in the Opponent's trade-mark, the Mark is not distinctive in view of the Opponent's trade-mark and copyright held therein, and the application does not comply with section 30(b) of the Act because the Applicant has not, by itself or through a predecessor-in-title, used the Mark in association with the applied for wares since the date claimed.

[6] In support of its opposition, the Opponent filed the affidavits of Michael Stephen, licensed private investigator at CKR Global Investigations (CKR Global), Elenita Anastacio, trade-mark searcher for the Opponent's agent and Monika Patel, Program Officer of Forest Stewardship Council (FSC) Canada, the Canadian national office of the Opponent. As its evidence, the Applicant filed the affidavit of David Woods, Managing Director for the Applicant, Mary P. Noonan, trade-mark searcher for the Applicant's agent, and Scott J. Douglas, student-at-law for the Applicant's agent. None of the affiants was cross-examined.

[7] Only the Applicant filed a written argument but both parties were represented at a hearing wherein the Opponent's opposition to application No. 1,475,642 for the same trade-mark (for different wares and services) was heard at the same time. A separate decision will issue for that file.

#### Onus and Material Dates

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

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

- Section 38(2)(a)/Section 30 - the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Section 38(2)(b)/Section 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- Section 38(2)(c)/Section 16(1) – the Applicant’s date of first use [section 16(1)];
- Section 38(2)(d)/Section 2 (non-distinctiveness) - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

### Preliminary Issues

[10] The Opponent made several objections to the Douglas affidavit. Before addressing these objections, I consider it useful to summarize the content of his affidavit.

[11] Mr. Douglas is a student-at-law employed by the Applicant’s agent. On November 26 and November 28, 2012, he purchased various types of bags from stores in Ontario that had tree designs. The stores he purchased from included Billabong, West 49, and Canadian Tire.

[12] Mr. Douglas also conducted a search of the online marketplace for retailers offering bags or clothing in association with tree designs for purchase. Attached to his affidavit are printouts from the following online retailers displaying various types of bags in association with tree designs: West 49, Shreadhead, Element, Canadian Tire, Army & Navy and Outbound.

[13] On November 28-29, 2012, after reviewing the state of the register search results which form Exhibits A and B to the Noonan affidavit, Mr. Douglas located the following trade-marks as used in association with bags or clothing on the Internet and attached printouts from the following websites: Mulberry (re: application No. 1,355,615); Beverly Hills Country Club (re: application No. 1,591,764); REI (re: application No. 1,555,025); Lrg (re: application No. 1,205,410); Los Angeles Sparks (re: application No. 834,970); and Timberland (re: application No. 834,970).

[14] The three objections made by the Opponent to the Douglas affidavit are as follows. First, the Opponent submits that the exhibit pages attached to Mr. Douglas' affidavit were not sworn. The Opponent therefore argues that they are inadmissible.

[15] Second, the Opponent objects to the fact that the evidence of Mr. Douglas was introduced by an employee of the Applicant's firm. The general argument is that employees are not independent witnesses giving unbiased evidence when they give opinion evidence on contested issues [see *Cross-Canada Auto Body Supply (Windsor) Ltd v. Hyundai Auto Canada* (2006), 53 CPR (4th) 286 (FCA) (*Cross-Canada*)]. The Opponent submits that, as a result, little if any weight should be accorded to this affidavit.

[16] Third, the Opponent submits that that even if the exhibits attached to Mr. Douglas' affidavit are admissible, in view that the printouts of third party websites are hearsay, these exhibits are not admissible for the truth of their contents.

[17] Dealing first with the Opponent's objection regarding the fact that Mr. Douglas' exhibit pages were not notarized, I note that unnotarized exhibits have been found admissible by the Registrar where no objection was raised by the other party or where an objection was raised at such a late stage of the opposition that the party which submitted the evidence had little or no opportunity to correct the deficiency [see *Maximillian Fur Co v Maximillian for Men's Apparel Ltd* (1983), 82 CPR (2d) 146 (TMOB); *Time Inc v Moisescu* (1990), 31 CPR (3d) 255 (TMOB)]. In the present case, the Opponent did not raise the fact that the documents appended to the Applicant's affidavit had not been certified by the Commissioner. In light of the above, I find that the documents appended to the Applicant's affidavit are admissible as exhibits.

[18] With respect to the Opponent's second objection, I do not find that the concerns raised by the Federal Court of Appeal in *Cross-Canada, supra*, apply here. Mr. Douglas' affidavit does not contain conclusions or opinions on the contentious issues of the opposition. He simply purchased various bags at a handful of stores and also searched the Internet for other examples of such wares with a tree design. I do not see how the fact that this evidence was introduced by an employee of the Applicant's agent makes it less reliable than if the Applicant or its agent had hired an outside investigator to make such purchases or do such Internet searches and swear an

affidavit. Overall, the evidence does not appear to me to be controversial [see *Canadian Jewellers Association v American Gem Society*, 2010 TMOB 106 (CanLii)].

[19] With respect to the Opponent's third objection, I find that Mr. Douglas' evidence of the display of various marks on third party websites is not being presented to evidence the truth of the contents of the pages but rather simply their existence. I am therefore satisfied that this evidence is sufficient to show that others were displaying tree designs in association with their wares on-line on the date that Mr. Douglas conducted his Internet search.

### Grounds of Opposition

#### Non-compliance – Section 30(b)

[20] The Opponent also pleads that the application does not comply with section 30(b) of the Act because the Applicant has not used the Mark in Canada in association with the applied for wares as of the claimed date of first use, namely 2009.

[21] There is an initial evidential burden on the Opponent with respect to the issue of the Applicant's non-compliance with section 30(b). This burden can be met by reference not only to the Opponent's evidence but also to the Applicant's evidence [see *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) (FCTD) 216 at 230]. However, while the Opponent may rely upon the Applicant's evidence to meet its evidential burden in relation to this ground, the Opponent must show that the Applicant's evidence is clearly inconsistent with the Applicant's claims as set forth in its application [see *Ivy Lea Shirt Co v 1227624 Ontario Ltd* (1999), 2 CPR (4th) 562 at 565-6 (TMOB), affirmed 11 CPR (4th) 489 (FCTD)]. If the Opponent shows a clear discrepancy in the evidence regarding the Applicant's claimed dates of first use, then the onus would be on the Applicant to positively support the dates it has claimed.

[22] In this case, the Opponent has relied exclusively upon the Applicant's evidence to meet its initial burden. In this regard, the Opponent has focused on what was missing in the Woods affidavit to substantiate the Applicant's claimed date of first use as opposed to pointing out where there may have been inconsistencies in the Applicant's evidence in order to meet its

evidential burden under this ground. For example, the Opponent submits that Exhibit B to the Woods affidavit is not direct evidence of use of the Mark with bags as of 2009. Further, unlike the case in the related application (application No. 1475642) there are no invoices to corroborate the Applicant's sales.

[23] Although it may have been preferable for the Applicant to have provided details pertaining to the use of the Mark in association with the applied for wares dating back to 2009, the fact that it may not have done so does not amount to an inconsistency. Further, the fact that there is no direct evidence of use of the Mark in association with bags in 2009 does not necessarily mean that the Applicant has not also properly used the Mark in association with bags since the claimed date of first use. I am therefore unable to conclude that the Opponent has met its initial evidential burden.

[24] Accordingly, this ground of opposition is dismissed.

#### Non-compliance – Section 30(i)

[25] Section 30(i) of the Act requires that an applicant declare itself satisfied that it is entitled to use the applied-for mark. Jurisprudence suggests that non-compliance with section 30(i) can be found where there is a *prima facie* case of non-compliance with a federal statute [such as the *Copyright Act* RSC 1985, c C-42, *Food and Drugs Act*, RSC 1985, c F-27 or *Canada Post Corporation Act*, RSC 1985, c C-10 and see *Interactiv Design Pty Ltd v Grafton-Fraser Inc* (1998), 87 CPR (3d) 537 (TMOB), at 542-543)].

[26] In this case, the Opponent pleads that the application does not comply with section 30(i) because the Applicant has violated the *Copyright Act*. In order to meet its evidential burden under this ground, the Opponent must establish a *prima facie* case of copyright infringement [see *E Remy Martin & Co SA v Magnet Trading Corp (HK)* (1988), 23 CPR (3d) 242, (TMOB)].

[27] In order to establish a *prima facie* case of copyright infringement, the Opponent is required to establish (i) copyright in its tree design and (ii) that the Mark is a substantial copying of this tree design [see *Jones v Dragon Tales Production Inc* (2002), 27 CPR (4th) 369 (TMOB)].

[28] Attached as Exhibit A to the affidavit of Monika Patel is a copy of a copyright assignment from the business records of the Opponent in which Tristan Kent of Kent, England, assigns to the Opponent all copyright rights in all countries and territories of the world in the works as defined therein (including the Opponent's FSC and Tree Design). The Opponent submits that the document speaks for itself and shows that the Opponent has copyright in its tree design and is the owner of the copyright.

[29] The Opponent further submits that the Mark is a substantial copying of the Opponent's mark because both tree designs incorporate the following unique elements:

- a hollow silhouette of a tree;
- an opening at the bottom of the design; and
- the use of a single continuous line in the design.

[30] In my view, there are too many points of dissimilarity between the Mark and the Opponent's tree design and too few points of similarity between them for me to conclude there is a *prima facie* case of copyright infringement. In this regard, the Mark features a round shaped tree, bordered by a square shaped element. The Opponent's mark, on the other hand, features a more triangular shaped tree combined with a check mark shape, both of which are shown in a bold, regular style in black against a white background. The Opponent's mark also includes the large and prominent letters FSC.

[31] As I am not satisfied that the evidence supports a *prima facie* case of copyright infringement, this ground of opposition fails.

#### Non-registrability - Section 12(1)(d)

[32] The Opponent further pleads that the Mark is not registrable because it is confusing with its FSC and Design trade-mark set out above. I have exercised my discretion and checked the register to confirm that the Opponent's registration No. TMA528,235 is extant [see *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Therefore, the Opponent has met its initial burden with respect to this ground.



[33] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-marks.

[34] The Opponent's mark is registered for use in association with the following wares and services:

**WARES:**

Furniture and products made from wood, namely paper, wood pulp, dimensional lumber; printed materials relating to forest management and conservation, namely books, magazines, periodicals, pamphlets.

**SERVICES:**

(1) Forest management services; evaluation of standing timber, namely review of the health, biodiversity, yields, market valuation, uses, legal status, management objectives, chain of custody, certification and care in relation to standing timber; business management and business administration services in relation to wood and products made from wood; technical and regulatory consulting services in relation to wood and products made from wood; timber felling and processing.

*test for confusion*

[35] 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 section 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks 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 in appearance or sound or in the ideas suggested by them.

[36] This list of enumerated factors is not exhaustive and it is not necessary to give each one of them equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc.* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC)]. In *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 92 CPR (4th) 361 (SCC) , the Supreme Court of Canada clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks.

*section 6(5)(a) - inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known*

[37] While neither party's mark is inherently strong, I find the Mark to be inherently stronger than the Opponent's mark because it is not suggestive of its applied for wares. The Opponent's mark, on the other hand, is suggestive when used in association with the Opponent's paper or wood products and related services.

[38] The Applicant submits that its evidence showing that tree design elements are common to the trades of both parties further supports a finding that the parties' marks are not distinctive (see Noonan affidavit). The fact that there may be other tree design trade-marks standing on the register of trade-marks does not, however, come into play when assessing the inherent distinctiveness of the parties' marks *per se*. As state of the register evidence does constitute a relevant surrounding circumstance to be considered as an additional circumstance under the test for confusion, this point will be discussed further below.

[39] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. The evidence of the Opponent's affiant, Mr. Stephen, is that several retail stores in the Toronto area sell clothing articles which feature the Opponent's FSC and Tree Design mark on the hangtag. The Opponent has not provided any evidence to show that its mark has any reputation in association with its registered wood and paper products and related services.

[40] On the other hand, the Applicant has provided uncontradicted evidence that it has used its Mark in association with the applied for wares since June 2009. For example, the affidavit of Mr. Woods shows that sales in Canada of bags bearing the Mark have been more than \$200,000

since June 2009. The Applicant has also provided evidence of advertising and promotion of its products in Canada through the distribution of over one million catalogues.

[41] Based on the foregoing information, I conclude that the Mark has become known to a greater extent in Canada than the Opponent's mark. Overall, I find that this factor favours the Applicant.

*section 6(5)(b) - the length of time each trade-mark has been in use*

[42] Although the Opponent's registration is based on use since 2000, the Opponent has not provided any clear evidence of use of its mark with its registered wares or services. Further, as noted by the Applicant, the Registrar will assume *de minimus* use only from the certified copy of the Opponent's registration see [see *Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)].

[43] In view that the Applicant has provided evidence of use of its Mark in Canada since June 2009, I find that this factor favours the Applicant.

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

[44] It is the Applicant's statement of wares as defined in its application versus the Opponent's registered wares that govern my determination of this factor [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd.* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[45] The nature of the parties' wares and services and channels of trade for those wares and services are very different. In this regard, the Applicant's Mark has been applied for in association with various bags whereas the Opponent's mark is registered for use in association with a variety of wood and paper products and forestry services. The Opponent's trade-mark is not registered for use in association with bags nor has the Opponent shown any evidence of use its mark as a trade-mark in association with such products. All the Opponent has shown is that its mark is displayed on recycled hangtags attached to clothing wares. The hangtags displaying

the Opponent's mark do not show that the Opponent is the source or manufacturer of the clothing products to which they are attached.

[46] While the parties' wares may be sold to the same consumers (eg. retailers of clothing and accessories like bags), I do not consider that this means that the parties' channels of trade for their respective wares and services overlap. In this regard, I would not expect hangtags made from recycled paper or paper products to be sold through the same channels of trade where one would typically purchase bags, even ecologically friendly bags. Further, I do not consider that the scope of the applied for wares could potentially include the same channels of trade as the Opponent's wares and services.

[47] These factors therefore favour the Applicant.

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

[48] While the Supreme Court of Canada in *Masterpiece* observed that the first word of a trade-mark may be the most important for purposes of distinction [see also *Conde Nast Publications v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)], it opined that the preferable approach is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique.

[49] I do not find there to be a high degree of resemblance between the marks in appearance or sound. In this regard, the Mark features a round shaped tree, bordered by a square shaped element. The Opponent's mark, on the other hand, features a more triangular shaped tree combined with a check mark shape, both of which are shown in a bold, regular style in black against a white background. The Opponent's mark also includes the large and prominent letters FSC.

[50] I do find that the ideas suggested by the marks to be similar in that both suggest the idea of environmental awareness or sustainability. However, as will be discussed further below, trade-marks suggesting this idea are very common in both the Applicant's and the Opponent's respective fields.

*Further surrounding circumstances*

*State of the register evidence*

[51] As an additional surrounding circumstance, the Applicant sought to rely on state of the register evidence in the Noonan affidavit to establish that the tree design component is a common element of trade-marks in Canada for bags, clothing and/or related services and paper and/or wood related wares and/or forest related services. Of course, evidence of the state of the register is only relevant inasmuch as inferences may be made on it concerning the state of the marketplace [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Del Monte Corporation v Welch Foods Inc* (1992), 44 CPR (3d) 205 (FCTD)]. Further, inferences concerning the state of the marketplace may be drawn from this evidence only if a large number of relevant registrations are found [see *Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)].

[52] The Opponent submits that few of the registrations evidenced by Ms. Noonan bear a significant resemblance to the Opponent's mark. The Opponent submits that the search was overly broad, and it included entries with no tree designs and also designs that did not contain the same unique elements as the marks in the present case, i.e. a hollow silhouette of a tree with round foliage, an opening at the bottom of the design and a single continuous line forming the design.

[53] I agree with the Opponent that not all of the registered tree designs as evidenced bear a significant resemblance to the Opponent's mark. Having said that, I respectfully disagree with the Opponent that only tree designs that contain the same unique elements as the parties' marks are relevant to the present case. In my view, state of the register evidence is relevant where it shows similar marks or portions of marks for similar wares or services. From the evidence furnished I am satisfied that there are at least 12 relevant tree design registrations (as well as several relevant applications) for bags and at least forty relevant tree design registrations for paper and/or wood related wares and/or forest related services. Given the number of relevant registrations, the presumption is that consumers are accustomed to commonly seeing these elements used in the trade for these types of wares or services.

[54] As noted by the Applicant, a trader who uses a trade-mark which incorporates an element that is common to the trade cannot expect a broad ambit of protection for his or her marks.

Where a trade-mark adopts an element in common use as a trade-mark, small differences will be sufficient to avert confusion [see *Multiplicant Inc v Petit Bateau Valton SA* (1994), 55 CPR (3d) 372 (FCTD) at para 30 citing *General Motors Corporation v Bellows* (1949), SCR 678 (SCC) at 691].

[55] With respect to Mr. Douglas' evidence, at least five of the trade-marks located by him on third party websites or purchased by him at retail stores in Toronto are trade-marks that I have identified as relevant registrations or applications in the Noonan state of the register evidence. This evidence corroborates the evidence of Ms. Noonan and further supports the presumption that consumers are accustomed to commonly seeing these elements used in the trade for these types of wares or services.

*No evidence of actual confusion*

[56] The Applicant submits that the absence of any evidence of confusion despite the co-existence of the marks is a further surrounding circumstance that favours a finding that there is no likelihood of confusion between the parties' marks.

[57] While it is not necessary for an Opponent to evidence confusion in order for me to find that there is a likelihood of confusion, the absence of confusion despite the overlap of the services and channels of trade could result in a negative inference being drawn about the Opponent's case [see *Mattel, above; Christian Dior SA v Dion Neckwear Ltd* (2002), 20 CPR (4th) 155 (FCA)].

[58] In the present case, given that the Opponent has not shown any use of its mark and I have not found that the parties' wares or services overlap, I am not prepared to draw a negative inference.

### *Co-existence in foreign jurisdiction*

[59] The Applicant also submits that another relevant circumstance is that the Applicant's corresponding U.S. trade-mark application successfully cleared the opposition period in that country without any challenge from the Opponent.

[60] While the Applicant did provide print-outs of its U.S. applications, it did not evidence the existence of the Opponent's registrations in the U.S. Even if it had, little can be drawn from the fact that trade-marks coexist in other jurisdictions as there may be factors that justify the co-registration of marks in a foreign jurisdiction that do not exist in Canada (e.g. differences in the law or a different state of the register). The Registrar's decision must be based on Canadian standards, having regard to the situation in Canada [see *Quantum Instruments, Inc v Elinca SA* (1995), 60 CPR (3d) 264 (TMOB); *Vivat Holdings Ltd v Levi Strauss & Co* (2005), 41 CPR (4th) 8 (FC) citing *Re Haw Par Brothers International Ltd v Registrar of Trade Marks* (1979), 48 CPR (2d) 65 (FCTD) and *Sun-Maid Growers of California v Williams & Humbert Ltd* (1981), 54 CPR (2d) 41 (FCTD)].

### *Conclusion*

[61] As stated at paragraph 33 of the *Veuve Clicquot* decision, *supra*, "Section 6(2) recognizes that the ordinary somewhat-hurried consumer may be misled into drawing the mistaken inference 'whether or not the wares or services are of the same general class', but it is still a question for the court as to whether in all the circumstances such consumers are *likely* to do so in a particular case."

[62] Having considered all of the surrounding circumstances, I find that the Applicant has satisfied its onus to show that, on a balance of probabilities, confusion between the marks is unlikely. This is primarily because of the common use of the tree design in association with both parties' trades, and the differences between both parties' wares and services and their respective channels of trade. Even though the marks both include tree designs, the fact that the Applicant has a reputation in association with bags, combined with the fact that the Opponent's wares and services are products relating to forest management and conservation and related services, makes it seem unlikely that the typical consumer would think that the Applicant's Tree Design bags

emanate from the Opponent. The fact that the Opponent's mark may be displayed on wares such as recycled hangtags attached to clothing wares is not by itself enough to indicate a link between the Opponent's wares and services and the Applicant's wares or to make confusion likely.

[63] I also note that, to find in favour of the Opponent in the present case would be akin to granting the Opponent a trade-mark monopoly over the image of a tree design in any form in relation to both wood products, printed materials relating to forest management and related services **and** bags and accessories. To have made such a finding would not have been, in the terminology used by the Federal Court, "appropriate" [see *San Miguel Brewing International Limited v Molson Canada 2005* [2013] FC 156 at para 40].

[64] The section 12(1)(d) ground of opposition therefore does not succeed.

#### Non-distinctiveness – Sections 38(2)(d) and 2

[65] The Opponent has also pleaded that the Mark is not distinctive and is not capable of distinguishing the Applicant's wares from the wares and services of the Opponent in view of its trade-mark and the copyrights held therein.

[66] As noted above, the Opponent has not established a *prima facie* case of copyright infringement. Further, the Opponent has not shown that its mark had become known sufficiently to negate the distinctiveness of the Mark as of the filing date of the opposition.

[67] As I am not satisfied that the Opponent has met its burden under this ground, this ground is accordingly dismissed.



Disposition

[68] In view of the above, and pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

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Cindy R. Folz  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office