



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

Citation: 2014 TMOB 211
Date of Decision: 2014-09-29

**IN THE MATTER OF AN OPPOSITION
by Home Hardware Stores Limited to
application Nos. 1,423,996 and 1,423,997
for the trade-marks BENJAMIN MOORE
NATURA and BENJAMIN MOORE
NATURA & Design, respectively, in the
name of Benjamin Moore & Co., Limited**

APPLICATION No. 1,423,996 - BENJAMIN MOORE NATURA

FILE RECORD

[1] On January 9, 2009, Benjamin Moore & Co., Limited filed an application to register the mark BENJAMIN MOORE NATURA, based on proposed use in Canada, in association with “interior and exterior paints.”

[2] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated October 7, 2009 and was opposed by Home Hardware Stores Limited on October 26, 2009. The Registrar forwarded a copy of the statement of opposition to the applicant on November 12, 2009 as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.


[3] The opponent’s evidence consists of the affidavits of Ray Gabel, Barbara Gallagher and Nicole Vigneault. The applicant’s evidence consists of the affidavit of



Michael Kolind. Both parties filed written arguments and both were represented by counsel at an oral hearing held on August 28, 2014.

STATEMENT OF OPPOSITION

[4] The opponent pleads that it is the owner of a number of NATURA trade-mark registrations and applications, which I have summarized in Table 1 below.

Table 1

Trade-mark	First Use/ Status	Wares/Services
	2006 registered	fertilizers, weed eliminators and the like
	2009 registered	mildew stain remover
	2007 registered	a cleaning solution used prior to painting to prep a surface
	2007 registered	a cleaning solution used prior to painting to prep a surface
	2007 registered	a cleaning solution used prior to painting to prep a surface
	2009 registered	preparation for removing stains and paint from exterior wood surfaces

Trade-mark	First Use/ Status	Wares/Services
	2008 registered	dryer sheets
	2009 registered	preparation for cleaning grey weathered exterior wood
BEAUTI-TONE NATURA	proposed use application	paint, stain, wood restorer, wood filler and the like
NATURA	2011 allowed application	natural wood stripper, ice melt, peat moss

[5] The above table includes all of the marks relied upon by the opponent and included in Schedule A of the statement of opposition. The grounds of opposition, some of which refer to Schedule A, are reproduced in full, below:

First Ground

The Application does not conform to the requirements of Section 30 of the Act and more specifically to the requirements of Section 30 (e) of the Act as the Applicant does not, and did not at any material time, intend to use the Trade-mark [the applied-for mark] in association with the goods set out in the Application.

Second Ground

The Application does not conform to the requirements of Section 30 of the Act and more specifically to the requirements of Section 30(i) of the Act as the Opponent had used, registered and applied to register the marks set out on the attached Schedule "A" since prior to the date of filing of the Application. The Applicant must have been aware of the Opponent's NATURA family of trade-marks as a result of the extensive use and advertising of those trade-marks by the Opponent. The Applicant could not have been satisfied that it was entitled to use the Trade-mark in Canada in association with the wares set out in the Application since it is confusing with the Opponent's NATURA family of trade-marks and any use of the Trade-mark was likely to have the effect of depreciating the value of the goodwill attaching to the Opponent's family of trade-marks contrary to Section 22 of the Act.

Third Ground

The Trade-mark is not registrable within the meaning of Section 12(1)(d) of the Act as it is confusing with the Opponent's registrations referred to on the attached Schedule "A."

Fourth Ground

The Applicant is not the person entitled to registration of the Trade-mark since it is confusing with the Opponent's NATURA family of trade-marks which had been used in Canada by the Opponent since prior to the filing date of the Application in association with the wares set out on the attached Schedule "A". The Opponent had not abandoned its NATURA family of trade-marks as of the date of advertisement of the Application.

Fifth Ground

The Applicant is not the person entitled to registration of the Trade-mark since it is confusing with the Opponent's NATURA applications set out on the attached Schedule "A" which had been previously filed in Canada. The Opponent's NATURA applications referred to herein were pending as of the date of advertisement of the Application.

Sixth Ground

The Trade-mark is not distinctive. Section 2 of the Act provides that "distinctive" in relation to a trade-mark means a trade-mark that actually distinguishes the wares or services in association with which it is used by its owner from the wares or services of others or is adapted so as to distinguish them. The Opponent submits that the Trade-mark is not, and cannot, be distinctive of the Applicant, nor is it adapted to distinguish the Applicant's wares from the wares of others and particularly from the wares of the Opponent as set out on the attached Schedule "A".

[6] I will address the grounds of opposition in the order in which they are pleaded, however, before doing so, I will first review the evidence of record, the evidential burden on the opponent, and the legal onus on the applicant.

OPPONENT'S EVIDENCE

Ray Gabel

[7] Mr. Gabel identifies himself as a senior executive with the opponent company. The opponent is a cooperative wholesaler with over 1,000 independent store operators ("Home Hardware stores") across Canada. The opponent has been in business since 1964. NATURA is the opponent's brand of environmentally friendly products which includes a variety of wares ranging from cleaning supplies to fertilizers.

[8] As of March, 2011, there were 85 distinct NATURA products including 12 paints in the opponent's BEAUTI-TONE NATURA line, 8 paint brushes and 2 paint roller refills, as well as 10 cleaning products for preparing surfaces to be painted. The BEAUTI-TONE NATURA paint product line is available at over 1000 Home Hardware stores. The opponent has sold NATURA-brand products in Canada since May 2005; NATURA-brand paint supplies since about July 2006; and BEAUTI-TONE NATURA PAINT since January 2009.

[9] The opponent's registered marks and allowed applications are listed in para. 11 of Mr. Gabel's affidavit. Three of the marks cited by Mr. Gabel namely, NATURA SAFE SAND for a liquid sanding product; NATURA BRUSH for paint brushes; and NATURA ROLLER for paint rollers are not relied upon in the statement of opposition.

[10] The opponent's NATURA-brand product line is promoted as environmentally friendly. For example, BEAUTI-TONE NATURA paints are advertised as free from volatile organic compounds ("VOCs") and virtually odourless.

[11] The opponent's total sales of its NATURA-branded wares to retailers in Canada averaged about \$2.6 million annually for the three-year period 2006-2008 and about \$4 million annually for the two-year period 2009-2010. The opponent has advertised and promoted its NATURA products in stores by means of signs, hanging banners and counter ads; in catalogues distributed across Canada and available at its stores; by flyers distributed by mail, door-to-door, with newspaper delivery (about 190 million flyers have been distributed annually since 2005) and online; on television since July 2008; and in magazines published in Canada. The above figures include sales and advertising for products under the marks NATURA SAFE SAND; NATURA BRUSH and NATURA ROLLER, which marks are not relied upon in the statement of opposition.

Barbara Gallagher

[12] Ms. Gallagher identifies herself as a law clerk employed by the agents for the opponent. Her affidavit serves to introduce into evidence, by way of exhibits, printouts of

various websites containing consumer reviews of the applicant's NATURA paints. Many of the reviews are critical of the applicant's paint. Her evidence is not helpful in deciding the issues in this case.

Nicole Vigneault

[13] Ms. Vigneault identifies herself as an articling student employed by the agents for the opponent. Her affidavit serves to introduce into evidence (i) by way of exhibits, printouts Internet searches for the term "Natura" at the applicant's website, (ii) an account of her visit to a Benjamin Moore store in Ottawa where, among other activities, she spoke to an interior decoration consultant. Her account of the consultant's remarks is inadmissible hearsay. Ms. Vigneault's evidence is not helpful in deciding the issues in this case.

APPLICANT'S EVIDENCE

Michael Kolind

[14] Mr. Kolind identifies himself as the Market General Manager for the applicant company. He explains that Benjamin Moore & Co. was founded in Brookland, New York in 1883 and that its Canadian operation (the applicant) was incorporated in Toronto in 1906. At present the two companies are leading North American manufacturers of quality paints. The applicant operates manufacturing and distribution facilities in Montreal, Quebec from where it sells and ships its products to about 800 independently owned Benjamin Moore retailers ("Retailers") across Canada. The applicant employs about 275 people.

[15] Products under the applied-for BENJAMIN MOORE NATURA mark are sold through 464 Retailers. The applicant began to use the applied-for mark at least as early as April 2009. Exhibit B is a sample of a label showing how the applied-for mark appears on paint cans. Wholesale sales in Canada of the applicant's wares under the applied-for mark amounted to about \$3.7 million in 2009; \$3.6 million in 2010; and \$1.5 million in the period January to August 4, 2011.

[15] The applicant's website has included a section devoted to BENJAMIN MOORE NATURA paint since May 2003. The website has attracted over 5 million visitors since April 2009. The applied-for mark has been featured in a variety of brochures and pamphlets, on point-of-sale materials, in various magazines, newspapers, and on television. Advertising expenditures have amounted to about \$629,500 since 2009, which includes advertising for the marks NATURA *per se* as well as the mark BENJAMIN MOORE NATURA & Design, shown below:



[16] From an inspection of the exhibits included with Mr. Kolind's affidavit, I note that the applied-for word mark BENJAMIN MOORE NATURA, as used on the applicant's paints, features the component NATURA prominently while the component BENJAMIN MOORE appears even more diminutively than shown in the above word and design mark.

LEGAL ONUS AND EVIDENTIAL BURDEN

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

[18] With respect to (i) above, there is 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 CPR (3d) 293 at 298 (FCTD). 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. With respect to (ii) above, 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 (for those allegations for which the opponent has met its evidential burden). 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.

FIRST AND SECOND GROUNDS OF OPPOSITION

[19] There is no reliable evidence to sustain any of the allegations pleaded in the first and second grounds of opposition. The first and second grounds are therefore rejected for failure of the opponent to meet its evidential burden to put the allegations in the first and second grounds into issue.

REMAINING GROUNDS OF OPPOSITION

Confusion is the Determinative Issue

[20] The determinative issue with respect to the remaining grounds of opposition turns on the issue of confusion between the applied-for mark BENJAMIN MOORE NATURA and one or more of the opponent's marks pleaded in the statement of opposition.

[21] The material dates to assess the issue of confusion are the date of filing the application, that is, January 9, 2009, with respect to the grounds of opposition alleging non-entitlement; the date of opposition, that is, October 26, 2009, with respect to the ground of opposition alleging non-distinctiveness; and the date of my decision, with respect to the ground of opposition alleging non-registrability: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 CPR(3d) 198 at 206 - 209 (FCTD).

When Are Trade-marks Confusing?

[22] Trade-marks are confusing when there is a reasonable likelihood of confusion within the meaning of s.6(2) of the *Trade-marks Act*, shown below:

The 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 . . . or performed by the same person, whether or not the wares or services . . . are of the same general class.

[23] Thus, s.6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by s.6(2) is whether purchasers of the applicant's paints sold under the mark BENJAMIN MOORE NATURA would believe that such sales were authorized or licensed by the opponent, or that the paint emanates from the opponent, who offers various wares, including paint and related products, under the various marks listed in Table 1, above. The legal onus is on the applicant to show, on the usual civil balance of probabilities standard, that there would be no reasonable likelihood of confusion.

Test for Confusion

[24] 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 "all the surrounding circumstances including" those specifically mentioned in s.6(5)(a) to s.6(5)(e) 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 and all relevant factors are to be considered. Further, all factors do not necessarily have equal weight as 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 CPR(3d) 308 (FCTD). However, as noted by Mr. Justice Rothstein in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 CPR(4th) 361 (SCC), although the degree of resemblance is the last factor cited in s.6(5), it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

Consideration of s.6(5) Factors

Inherent and Acquired Distinctiveness

[25] The applied-for mark BENJAMIN MOORE NATURA does not possess a high degree of inherent distinctiveness. In this regard, the first portion of the mark namely, BENJAMIN MOORE, would be perceived as the name of an individual while the second portion of the mark, although it is a coined word, would be perceived as a truncation of the word “natural.” In the context of the applicant’s wares, the component NATURA would be suggestive of products that are ecologically friendly. The applied-for mark is therefore a relatively weak mark.

[26] The opponent’s registered marks also do not possess high degrees of inherent distinctiveness. In this regard, they are comprised of a descriptive phrase such as MILDEW OFF or SAFE PREP and the component NATURA. Again, in the context of the opponent’s wares, the component NATURA would be suggestive of products that are ecologically friendly. The opponent in fact advertises its NATURA line of products as an “environmentally friendly alternative” to other products which serve the same purpose. The opponent’s registrations are relatively weak marks. The opponent’s proposed use mark BEAUTI-TONE NATURA is also a relatively weak mark given the laudatory connotation of the first portion of the mark. Of course the mark NATURA *per se* is also a relatively weak mark owing to its ecologically friendly connotation.

[27] In view of the foregoing, the inherent distinctiveness of the marks in issue does not favour either party.

[28] The applied-for mark BENJAMIN MOORE NATURA was not used in Canada until some time after the date of filing and therefore had not acquired any distinctiveness as of the earliest material date. However, the applied-for mark acquired some distinctiveness through sales under the mark, and advertising, as of the second material date October 26, 2009 and continued to acquire additional distinctiveness after the second material date.

[29] The opponent's evidence of use and advertising of its marks is presented in so summary a fashion that is not possible to make any realistic quantitative assessment of which particular mark had in fact acquired distinctiveness. All that can be said is that at least one or more of the marks relied on by the opponent had acquired some distinctiveness beginning in May 2005. No definite conclusions can be reached concerning whether any of the opponent's marks used in association with paint, or related products such as paint remover or paint preparation products, had acquired more than a minimum level of distinctiveness at any material time. It may be, for example, that the opponent's marks used in association with products unrelated to paint, such as fertilizer or dryer sheets, acquired more distinctiveness than any other of the opponent's marks. As it is the responsibility of the opponent to prove each aspect of its case, I am unable to ascribe any more than a minimal degree of acquired distinctiveness to any of the opponent's marks used in association with paint or paint related products.

[30] The consequence of the summary nature of the opponent's evidence is that acquired distinctiveness favours the applicant as of the later material dates, and favours neither party as of the earliest material date. As the first factor is a combination of the inherent and acquired distinctiveness, the first factor favours the applicant at the later material dates.

Length of Time the Parties' Marks Have Been in Use

[31] The opponent has used its mark BEAUTI-TONE NATURA in association with paint since January of 2009, and has used its mark NATURA in association with unspecified "paint supplies" since about July 2006. Given that the extent of such use is indeterminate, and that the applicant began to use its mark BENJAMIN MOORE NATURA soon after January 2009, the length of time that the parties' marks have been in use does not favour either party to any significant extent.

The Nature of the Wares and Trade

[32] The nature of the parties' wares is the same with respect to the opponent's mark BEAUTI-TONE NATURA; is related with respect to some of the opponent's marks; and

is different for other of opponent's marks. However, the parties' channels of trade are quite distinct as the parties sell their wares through their own chain stores (albeit independently operated). In the circumstances of this case, where there is some overlap in the parties' wares but the wares are sold through distinct channels of trade, I find that third and fourth factors, considered together, favour the applicant.

Resemblance Between the Parties' Marks

[33] The parties' marks are more different than alike with respect to their overall visual impacts. In this regard, the design features and the descriptive phrases comprising the opponent's registered marks differentiate them from the applied-for mark. To a lesser extent, the prefix BENJAMIN MOORE differentiates the applied-for mark from the two trade-mark applications that the opponent is relying on (i.e., the last two marks in Table 1, above). The parties' marks are also more different than alike with respect to sounding owing to the descriptive phrases comprising the opponent's marks and the prefix BENJAMIN MOORE comprising the applied-for mark. The ideas suggested by the parties' marks are more different than alike for the same reasons. Thus, the last factor favours the applicant.

Jurisprudence

[34] The opponent's position at the oral hearing was that I am obliged to find that the applied-for mark BENJAMIN MOORE NATURA is confusing with the applicant's mark BEAUTI-TONE NATURA in view of *Benjamin Moore & Co. v. Home Hardware Stores Ltd.* (2013) 111 CPR(4th) 368 (TMOB). In that case, the applicant herein (Benjamin Moore) opposed the application for the mark BEAUTI-TONE NATURA which Home Hardware (the opponent herein) had filed on the basis of proposed use in Canada, in association with paint and related wares (the mark cited in Table 1, above). Benjamin Moore took the position that the applied-for mark was confusing with its marks NATURA, BENJAMIN MOORE NATURA, and BENJAMIN MOORE NATURA & Design. The opposition was successful on the issue of confusion. Accordingly, the opponent herein, Home Hardware, submits that I must find that the applied-for mark BENJAMIN MOORE NATURA is confusing with the mark BEAUTI-TONE NATURA.

[35] I do not agree with the opponent's submission. An often repeated truism is that every case is decided on its own facts, that is, facts introduced through evidence. Once the opponent meets its evidential burden to put an allegation into issue, the applicant is required to prove its case on a balance of probabilities. In theory and in practice this means that the applicant has the greater burden to provide persuasive evidence. In *Benjamin Moore & Co.*, above, the only evidence of record for the applicant Home Hardware was the affidavit of Jane Buckingham, which the Board discusses at para. 21-24, shown below:

[21] As a further surrounding circumstance, I have considered the affidavit of Jane Buckingham, attached to which were copies of the Applicant's BEAUTI-TONE and NATURA applications and registrations. This evidence shows that the Applicant owns eight registrations for trade-marks that include the component BEAUTI-TONE for paint and related products, and twelve registrations for trade-marks that include the component NATURA for similar wares. The Applicant has submitted that the long standing existence on the register of such a large number of similar marks is a significant factor to consider when assessing the nature of confusion.

[22] The Opponent's agent, on the other hand, has submitted that this evidence should not have not any bearing on the issue of confusion because the Applicant has provided no evidence that any of these marks are in use.

[23] I agree with the Opponent's agent. In this regard, in order to rely on a family of trademarks in opposition proceedings, a party must prove use of each mark in the family [see *McDonald's Corp. v. Alberto-Culver Co.* (1995), 61 C.P.R. (3d) 382 , (T.M. Opp. Bd.); *McDonald's Corp. v. Yogi Yogurt Ltd.* (1982), 66 C.P.R. (2d) 101 , (Fed. T.D.)]. Further, section 19 of the Act does not give the owner of a registration the automatic right to obtain any further registrations no matter how closely they may be related to the original registration [see *Coronet-Werke Heinrich Schlerf GmbH v. Produits Ménagers Coronet Inc.* (1984), 4 C.P.R. (3d) 108 , (T.M. Opp. Bd.), at 115; *Groupe Lavo Inc. v. Procter & Gamble Inc.* (1990), 32 C.P.R. (3d) 533 , (T.M. Opp. Bd.), at 538)].

[24] I note as an aside that had the Applicant shown use of its NATURA marks, I may have concluded that consumers familiar with these marks would be more likely to assume that the Mark is part of the Applicant's family of NATURA marks and this would have decreased the likelihood of confusion in this case.

(emphasis added)

[36] In the instant case, the applicant Benjamin Moore has established significant use of its marks at the later material dates. Further, in the instant case, the evidence indicates that the parties' channels of trade are different while in *Benjamin Moore & Co.*, above, the Board, in the absence of evidence to the contrary, assumed that the parties' wares would travel though the same channels of trade. Also, in *Benjamin Moore & Co.*, above, it appears that there was no evidence of record to indicate the environmentally friendly characteristics of the parties' wares, which led the Board to credit the parties' marks with a higher degree of inherent distinctiveness than I have assigned to them. In sum, the facts established by the evidence in *Benjamin Moore & Co.*, above, and in the instant case are appreciably different.

Conclusion

[37] Having regard to the s.6(5) factors as discussed above, I find that the parties' marks are not confusing at any of the material dates.

APPLICATION No. 1,423,997 - BENJAMIN MOORE NATURA & Design

[38] The above referenced application is for the mark depicted in paragraph 15 above. Like application No.1,423,997 discussed above, the subject word and design mark application was also filed on January 9, 2009, was based on proposed use in Canada and covers the same wares namely, interior and exterior paints.

[39] The issues and material dates are entirely analogous to those discussed with respect to application No.1,423,997. As in the above opposition, the applicant's evidence consists of the affidavit of Mr. Kolind, who provides the same information as in the above opposition. However, absent from the opponent's evidence are the affidavits of Barbara Gallagher and, more importantly, of Ray Gabel. In this regard, their affidavits were filed out of time and, by an interlocutory Board ruling dated May 17, 2011, leave to include them in the record was refused. In the absence of Mr. Gabel's affidavit, the opponent's case is weaker than in the above opposition. Accordingly, I make essentially the same findings with respect to the s.6(5) factors as in the above case, and the same

conclusion follows, that is, I find that the parties' marks are not confusing at any of the material dates.

DISPOSITION

[40] In view of the foregoing, the oppositions to applications nos. 1,423,996 and 1,423,997 are rejected. These decisions have been made pursuant to a delegation of authority by the Registrar of Trade-marks under s.63(3) of the *Trade-marks Act*.

Myer Herzig, Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office