



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

**Citation: 2010 TMOB 43**  
**Date: 2010-04-07**

**IN THE MATTER OF AN  
OPPOSITION by 88766 Canada Inc.  
against application No. 1,305,793 for  
the trade-mark EVEREST ENVIRO &  
DESIGN in the name of Converpro  
Inc.**

[1] On June 16, 2006, Converpro Inc. [the Applicant] filed an application to register the trade-mark EVEREST ENVIRO & DESIGN (shown below) [the Mark] based on proposed use in Canada in association with bathroom tissues, paper hand towels, paper napkins, paper towels, facial tissues.



[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of March 7, 2007.

[3] On July 13, 2007, 88766 Canada Inc. [the Opponent] filed a statement of opposition. The grounds of opposition can be summarized as follows:

1. The application does not comply with the requirements of s. 30 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 [the Act] since at the filing date of the application (a) the Applicant was already using the Mark in Canada; (b) the mark the Applicant intended to use was not the Mark; (c) alternatively, or cumulatively, the

Applicant never intended to use the Mark; and (d) the statement that the Applicant was satisfied as to its entitlement to the use of the Mark was false in view of the content of the statement of opposition.

2. The Mark is not registrable pursuant to s. 12(1)(d) of the Act because it is confusing with the following registered trade-marks:

<b>Trade-mark</b>	<b>Owner</b>	<b>Registration No.</b>
ENVIRO-RETREE	Baywood Paper Limited	TMA409,761
ENVIROLOGIC	Wood Wyant Canada Inc.	TMA379,007
ENVIRO-FRIENDLY	Cascades Canada Inc.	TMA391,087
ENVIROSOFT	Fort James Operating Company	TMA393,658
ENVIRO-PAPERS	Domtar Inc.	TMA412,750
ENVIRO-COPY D.P.	Domtar Inc.	TMA418,769

3. The Applicant is not the person entitled to registration of the Mark since, contrary to the provisions of s. 16(1) introductory of the Act, (a) the application does not comply with the requirements of s. 30; (b) the Mark is not a proposed one but rather a used one; and (c) the Mark is not registrable or does not function as a trade-mark.
4. The Mark is not distinctive and is not adapted to distinguish the Applicant's wares from the wares or services of others, including those of Baywood Paper Limited, Domtar Inc., Wood Wyant Inc., Cascades Canada Inc. and Fort James Operating Company. The Opponent further alleges that the Mark is not distinctive because (a) it is used outside the scope of licensed use provided for by s. 50; and (b) as a result of its transfer, more than one person had rights to the Mark and exercised these rights contrary to the provisions of s. 48(2) of the Act.

[4] The Applicant filed and served a counter statement in which it denies the Opponent's allegations. In its counter statement, the Applicant also alleges that the Mark is related to three other EVEREST marks registered in the name of the Applicant, namely EVEREST & Design (TMA516,011), EVEREST PLATINUM & Design (TMA565,563) and EVEREST ECONO & Design (TMA565,565).

[5] In support of its opposition, the Opponent filed evidence in the form of the affidavit of Audrey Baltadjian introducing particulars printed from the Canadian Trade-marks Database (a database maintained over the Internet by the Canadian Intellectual Property Office) of the third party trade-mark registrations relied on by the Opponent in support of its s. 12(1)(d) ground of opposition.

[6] In support of its application, the Applicant filed an affidavit of Isabelle Boisvert and certified copies of trade-mark registration numbers TMA516,011 (EVEREST & Design), TMA565,563 (EVEREST PLATINUM & Design), TMA565,565 (EVEREST ECONO & Design) all owned by the Applicant.

[7] Neither party filed written arguments. The Opponent originally requested an oral hearing but later withdrew this request and the hearing was cancelled.

#### Onus

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential 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 Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

#### Section 30 Grounds

[9] The material date for considering grounds of opposition based on s. 30 is the date the application was filed [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475 and *Tower Conference Management Co. v. Canadian Exhibition Management Inc.* (1990), 28 C.P.R. (3d) 428 at 432 (T.M.O.B.)].

[10] While not specifically pleaded, the Opponent's allegations that (a) the Applicant was using or had already used the Mark in association with the claimed wares, (b) the

mark the Applicant intended to use was not the Mark, and (c) the Applicant did not intend to use the Mark in association with the claimed wares, all appear to be grounded on s. 30(e) of the Act. The Opponent's allegation that the Applicant's statement that it was satisfied as to its entitlement to use the Mark was false in view of the content of the statement of opposition, appears to be grounded on s. 30(i) of the Act.

*Section 30(e) Ground*

[11] No evidence has been furnished by the Opponent to show that the Applicant, as of the filing date of the application, was using or had already used the Mark in association with the claimed wares, did not intend to use the Mark in association with the wares set out in the application or that the mark the Applicant intended to use was not the Mark.

[12] The Opponent may rely on the Applicant's evidence to meet its initial burden in relation to this ground but the Opponent must show that the Applicant's evidence is clearly inconsistent with the Applicant's claim [see *Molson Canada v. Anheuser-Busch Inc.*, 2003, 29 C.P.R. (4th) 315 (F.C.T.D.), and *York Barbell Holdings Ltd. v. ICON Health and Fitness, Inc.* (2001), 13 C.P.R. (4th) 156 (T.M.O.B.)]. In the present case, there is nothing in the Applicant's evidence which is clearly inconsistent with the Applicant's claim that it intended to use the Mark in association with the applied for wares.

[13] The Opponent has failed to meet its initial evidential burden and accordingly, the s. 30(e) ground is dismissed.

*Section 30(i) Ground*

[14] The requirement under s. 30(i) of the Act is to include, in the application, a statement that the applicant is satisfied that it is entitled to use the mark in Canada in association with the wares. The Applicant provided such a statement in its application.

[15] In my opinion, in situations like the present where the relevant statement is provided, a s. 30(i) ground of opposition should only succeed in exceptional cases, such

as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 at 155 (T.M.O.B.)]. As this is not such an exceptional case, I am dismissing this ground of opposition.

Section 12(1)(d) Ground of Opposition

[16] The material date for assessing confusion pursuant to s. 12(1)(d) of the Act is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

[17] Pursuant to s. 12(1)(d) of the Act, the Opponent has pleaded that the Mark is not registrable because the Mark is confusing with the following registered trade-marks:

<b>Trade-mark</b>	<b>Owner</b>	<b>Registration No.</b>
ENVIRO-RETREE	Baywood Paper Limited	TMA409,761
ENVIROLOGIC	Wood Wyant Canada Inc.	TMA379,007
ENVIRO-FRIENDLY	Cascades Canada Inc.	TMA391,087
ENVIROSOFT	Fort James Operating Company	TMA393,658
ENVIRO-PAPERS	Domtar Inc.	TMA412,750
ENVIRO-COPY D.P.	Domtar Inc.	TMA418,769

[18] I have exercised the Registrar’s discretion to confirm whether the marks alleged by the Opponent remain in good standing as of today’s date.

[19] My review of the register reveals that the following three registrations have been expunged since the statement of opposition was filed:

<b>Trade-mark</b>	<b>Registration No.</b>	<b>Expungement Date</b>
ENVIRO-RETREE	TMA409,761	January 18, 2008
ENVIROSOFT	TMA393,658	September 13, 2007
ENVIRO-PAPERS	TMA412,750	January 8, 2009

[20] The following three registered trade-marks are extant:

<b>Trade-mark</b>	<b>Registration No.</b>
ENVIROLOGIC	TMA379,007
ENVIRO-FRIENDLY	TMA391,087
ENVIRO-COPY D.P.	TMA418,769

[21] The Opponent did not discharge its evidential burden with respect to the three registrations which have been expunged, namely, trade-marks ENVIRO-RETREE (TMA409,761), ENVIROSOFT (TMA393,658) and ENVIRO-PAPERS (TMA412,750). The Opponent did, however, discharge its burden with respect to the remaining three registrations, namely ENVIROLOGIC (TMA379,007), ENVIRO-FRIENDLY (TMA391,087) and ENVIRO-COPY D.P. (TMA418,769). The burden of proof now lies on the Applicant to convince the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and these three registered trade-marks. Unless indicated otherwise, I will hereafter collectively refer to these registered trade-marks as the “Cited Marks”.

[22] 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.

[23] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 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. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.)]

*6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known*

[24] The dominant features of the Mark are the EVEREST word element and the mountain range design feature. The borderline suggestive ENVIRO word element of the

Mark is significantly less dominant. The word EVEREST is an ordinary dictionary word which is suggestive of the renowned mountain in the Himalayas. The word EVEREST has no connection to the claimed wares, namely bathroom tissues, paper hand towels, paper napkins, paper towels and facial tissues, and thus is inherently distinctive thereof. Given the minor significance of the ENVIRO component, and the distinctiveness of the dominant EVEREST and design elements, the Mark is inherently distinctive.

[25] For each of the Cited Marks, the suggestive ENVIRO element is paired with additional word components. The words LOGIC, FRIENDLY and COPY are all ordinary dictionary words, with common meanings, namely, “reason or sound judgment”, “favourably disposed” and “a reproduction”, respectively. Some of these additional word components are suggestive of the nature of the associated wares (e.g. “COPY” for paper). Furthermore, ENVIRO-FRIENDLY is suggestive of the nature of the paper towel wares for which it is registered. Due to the suggestive nature of the word ENVIRO in association with paper products and the absence of any additional highly distinctive elements, these marks are significantly less inherently distinctive than the Mark.

[26] There is no evidence that either the Mark, or the Cited Marks, have become known to any extent.

[27] In light of the greater inherent distinctiveness of the Mark, this factor favours the Applicant.

*6(5)(b) – the length of time each has been in use*

[28] The application claims proposed use and there is no evidence that the Mark has been used to date.

[29] The only evidence of use adduced with respect to the Cited Marks is found in the Baltadjian affidavit in the form of particulars of the registrations printed from the Canadian Trade-marks Database as follows:

ENVIROLOGIC (TMA379,007) – use in Canada since February 5, 1990 with “paper towels, bathroom tissue, facial tissue and napkins” and a declaration of use was filed on November 22, 2007 with respect to “Préparations nettoyantes tout usage; désinfectants tout usage; produits d'entretien des planchers, nommément finishes and coatings, strippers, all purpose cleaners, désinfectants and sanitizers; savons pour la peau; nettoyeurs pour salles de bain; désodorisants pour salles.”

ENVIRO-FRIENDLY (TMA391,087) – a declaration of use was filed on October 4, 1991 with respect to “paper towels”

ENVIRO-COPY D.P. (TMA418,769) – a declaration of use was filed on August 11, 1993 with respect to “recycled papers”.

[30] Where the only evidence of use provided is in the form of a certified copy or particulars of registration, the Registrar will assume only *de minimus* use of the trade-mark based on such evidence [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.)]. Under these circumstances, the mere existence of the registrations can establish no more than *de minimus* use and cannot give rise to an inference of significant and continuous use of the Cited Marks.

[31] Based on the foregoing, s. 6(5)(b) favours the Opponent, but not significantly.

*6(5)(c) and (d) – the nature of the wares, services, business and trade*

[32] The Applicant has applied to register the Mark for “bathroom tissues, paper hand towels, paper napkins, paper towels, facial tissues”.

[33] The wares associated with the Mark are either identical or overlapping with the wares “paper towels, bathroom tissue, facial tissue and napkins” associated with the registered trade-mark ENVIROLOGIC and the wares “paper towels” associated with the registered trade-mark ENVIRO-FRIENDLY. To the extent that they are made of paper, the wares associated with the Mark can be said to relate to the wares “recycled papers”



associated with the registered trade-mark ENVIRO-COPY D.P. The remainder of the wares associated with the registered trade-mark ENVIROLOGIC, namely “préparations nettoyantes tout usage; désinfectants tout usage; produits d'entretien des planchers, nommément finishes and coatings, strippers, all purpose cleaners, disinfectants and sanitizers; savons pour la peau; nettoyants pour salles de bain; désodorisants pour salles”, differ from the Applicant’s wares.

[34] No evidence was filed as to the nature of the trade engaged in by either the Applicant or the owners of the Cited Marks. However, neither the Cited Marks nor the Applicant’s application include any restriction on the channels of trade.

[35] Given that the wares associated with the Mark and the registered mark ENVIRO-FRIENDLY (TMA391,087) are essentially identical, I find it reasonable to conclude that the channels of trade associated with the trade-marks could be identical or overlapping.

[36] While paper products, the wares “recycled paper” associated with the registered mark ENVIRO-COPY D.P. (TMA418,769) are distinct from the types of paper products associated with the Mark. In light of the fact that the wares are not identical and in the absence of evidence regarding the nature of the trade, I am not prepared to infer a direct overlap in the channels of trade.

[37] To the extent that the wares “paper towels, bathroom tissue, facial tissue and napkins” associated with the registered mark ENVIROLOGIC (TMA379,007) are essentially identical to the Applicant’s wares, I find it reasonable to conclude that the channels of trade could be identical or overlapping. However, having concluded that the remainder of the registered wares differ from the Applicant’s wares, in the absence of evidence as to the channels of trade, I am not prepared to conclude to an overlap between the channels of trade.

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

[38] In most instances, the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145, conf. 60 C.P.R. (2d) 70 (F.C.T.D.)].

[39] The trade-marks all share the ENVIRO word element, however, it constitutes only a minor element of the Mark. The EVEREST word component and the design component of the Mark are the dominant and distinctive features of the Mark.

[40] There is no similarity between the dominant and distinctive EVEREST and design elements of the Mark and the “LOGIC”, “-FRIENDLY” and “-COPY D.P.” elements of the Cited Marks in either appearance, sound or ideas suggested.

[41] Furthermore, there is no similarity in the ideas suggested by the Mark and the Cited Marks. The Mark is suggestive of Mount Everest whereas the ENVIROLOGIC mark suggests environmental logic, the ENVIRO-FRIENDLY mark suggests that the associated products are environmentally friendly and the ENVIRO-COPY D.P. mark suggests an environmentally conscious method of copying.

[42] Confusion will be unlikely in situations where marks share common features but also feature dominant differences [see *Foodcorp Ltd. v. Chalet Bar B Q (Canada) Inc.* (1982), 66 C.P.R. (2d) 56 at 73 (F.C.A.)].

[43] Ultimately, when considering the marks as a whole, I am not convinced that the mere fact that the Mark contains the suggestive ENVIRO element is sufficient to find that the marks share any significant degree of similarity in either appearance, sound or ideas suggested. To the contrary, the distinctive portions of the Mark, the EVEREST word and

mountain range design elements, are entirely different from the Cited Marks and thus serve to distinguish the Mark from the Cited Marks.

[44] Based on the foregoing, I conclude that the important differences between the Mark and the Cited Marks in terms of sound, appearance and ideas suggested favour the Applicant.

*Additional surrounding circumstance: Applicant's EVEREST trade-marks*

[45] By alleging in its counter statement that the Mark is related to three other registered marks featuring the word EVEREST, the Applicant is seemingly arguing that the Applicant is entitled to registration of the Mark by virtue of its ownership of these three other registered EVEREST marks.

[46] The ownership of these registrations does not give the Applicant the automatic right to the registration of the Mark no matter how closely the trade-marks may be related [see *American Cyanamid Co. v. Stanley Pharmaceuticals Ltd.* (1996), 74 C.P.R. (3d) 571 (T.M.O.B.); *Ralston Purina Canada v. H.J. Heinz Co. of Canada* (2000), 6 C.P.R. (4th) 394 (T.M.O.B.)]. Therefore, this additional circumstance is of no assistance to the Applicant's case.

*Additional surrounding circumstance: state of the register*

[47] I do not consider it necessary to consider the state of the register evidence with respect to the word "ENVIRO", as introduced by the affidavit of Isabelle Boisvert, in order to find in the Applicant's favour.

*Conclusion re s. 12(1)(d)*

[48] Having considered all of the surrounding circumstances, I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and each of the Cited Marks, namely ENVIROLOGIC (TMA379,007), ENVIRO-FRIENDLY (TMA391,087) and ENVIRO-COPY D.P. (TMA418,769).

[49] Having regard to the foregoing, I dismiss the ground of opposition based on s. 12(1)(d) of the Act.

#### Entitlement Ground of Opposition

[50] The Opponent alleges that the Applicant is not entitled to registration of the Mark, contrary to the provisions of s. 16(1) introductory of the Act, (a) the application does not comply with the requirements of s. 30; (b) the Mark is not a proposed one but rather a used one; (c) the Mark is not registrable or does not function as a trade-mark.

[51] In my view, the introductory wording of s. 16(1) does not form the basis of a ground of opposition as defined in s. 38(2) of the Act since s. 16(1) as a whole relates to the entitlement ground of opposition. Accordingly, I dismiss the ground of opposition based upon the introductory wording of s. 16(1) of the Act.

#### Distinctiveness Ground of Opposition

[52] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (T.M.O.B.)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness. The material date for assessing distinctiveness is the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

[53] The Opponent appears to have pleaded the non-distinctiveness ground of opposition as a three-pronged ground of opposition with the first prong relating to third party trade-mark rights, the second prong relating to un-licensed trade-mark use and the third prong relating to the improper assignment of the Mark. The Opponent has not alleged any facts supporting the second and third prongs of this ground of opposition and as such I find that they have both been improperly pleaded and I reject them accordingly.

[54] With respect to the first prong of the ground, pursuant to its evidential burden, the Opponent is under an obligation to show that, as of the filing of the statement of opposition, the Cited Marks had become known sufficiently to negate the distinctiveness of the Mark [see *Bojangles' International, LLC v. Bojangles Café Ltd.* (2004), 40 C.P.R. (4th) 553, affirmed (2006), 48 C.P.R. (4th) 427 (F.C.T.D.)]. The Opponent's evidence in the form of particulars of the Cited Marks printed from the Canadian Trade-marks Database is not sufficient to support the Opponent's evidential burden with respect to this ground. I therefore dismiss the first prong of the ground of opposition based upon non-distinctiveness.

[55] Based on the foregoing, I dismiss the non-distinctiveness ground of opposition in its entirety.

#### Disposition

[56] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Céline Tremblay  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office