

IN THE MATTER OF AN OPPOSITION  
by WWF - World Wide Fund for Nature  
(formerly World Wildlife Fund)  
to application serial No. 592,707  
for the trade-mark PANDA SOFT  
filed by Tritap Food Broker,  
a division of 676166 Ontario Limited

On September 30, 1987, the applicant Tritap Food Broker filed an application to register the trade-mark PANDA SOFT. The application is based on proposed use in Canada for the following wares:

laundry detergent, fabric softeners, fabric conditioners, bathroom and facial tissues, towels, diapers, baby powder.

The application was amended to disclaim the right to the exclusive use of the word SOFT apart from the mark in response to an objection at the examination stage. The subject application was advertised for opposition purposes on September 28, 1988.

The opponent "WWF" filed a statement of opposition on December 16, 1988, and was subsequently granted leave, on November 30, 1990, to file an amended statement to rely on two official marks. Public notice of the two official marks had been given by the Registrar in January and June of 1990, that is, during the course of these proceedings. The final grounds of opposition are summarized below:

(a) the applied for mark PANDA SOFT is not registrable and not distinctive of the applicant's wares, and the applicant is not the person entitled to registration, because the applied for mark PANDA SOFT is confusing with the opponent's registered marks namely

(i) PANDA DESIGN, regn. Nos. 183,818 and 196,285, illustrated below,

regn. Nos. 183,818; 196,285

(ii) PANDAMARAN, regn. No. 247,059

which marks the opponent has used and made known in Canada in association with the following services and wares:

regn. No. 183,818 - PANDA DESIGN

the operation of a fund...for the conservation of Canadian fauna, flora, forests, landscape, water, soils,...

regn. No. 196,285 - PANDA DESIGN

T-shirts, soft stuffed toys, pins, posters, badges, stationery namely writing paper, cutlery, cufflinks, drinking mugs, glasses, books, calendars, lighters and chinaware, boys' and girls' shirts and pants.

regn. No. 247,059 - PANDAMARAN

boats and parts therefor.

(b) the applicant is not the person entitled to registration in view of the opponent's trade-mark applications for WWF & Design and PANDA DESIGN, serial Nos. 474,939 and 598,684 respectively, illustrated below, each covering a long list of diverse wares.

serial No. 474,939

serial No. 598,684

(c) the applied for mark is not registrable, pursuant to Sections 9 and 12(1)(e) of the Trade-marks Act, because it consists of or so nearly resembles as to be likely to be mistaken for

(i) the official mark WWF & Design, illustrated below,

public notice of which was given on January 17, 1990,

(ii) the official word mark PANDA, public notice of which was given on June 20, 1990.

(d) the applicant could not have been satisfied under Section 30(i) of its entitlement to use the applied for mark PANDA SOFT.

The applicant filed and served a counter statement, and later an amended counter statement, generally denying the grounds of opposition. The applicant also alleges that application No. 598,684 (based on proposed use) relied on by the opponent was filed on January 15, 1988, that is, after the subject application was filed, and that application No. 598,684 "has been abandoned".

The opponent's evidence consists of the affidavits of David Love, Executive Vice President, World Wildlife Fund Canada (that organization is, apparently, a registered user of the opponent's registered marks), John McKinlay, student-at-law, and Lori Schreiner, legal assistant.

The applicant's evidence consists of the affidavit of Linda Thibeault, a trade-mark searcher.

No cross-examinations were conducted on the affidavit evidence. Both parties filed written arguments and both were represented at an oral hearing.

The material time for considering the ground of opposition denoted by (c) above, arising pursuant to Sections 9 and 12(1)(e),

is the date of my decision - see Olympus Optical Co. Ltd. v. Canadian Olympic Association (1991), 38 C.P.R.(3d) 1 at pp. 3-4 (F.C.A.). The opponent is not required to evidence use and adoption of the official marks relied on, at least not in the absence of evidence suggesting that the mark was not used - see Allied Corp. v. Canadian Olympic Association (1989), 28 C.P.R.(3d) 161 at 166 (F.C.A.).

The test in Section 9(1) is whether or not the applicant's mark consists of, or so nearly resembles as to be likely to be mistaken for, the official mark. In other words, is the applicant's mark identical to, or almost the same as, the official mark? - see The Ontario Federation of Anglers and Hunters v. Murphy (1990), 34 C.P.R.(3d) 496 (TMOB). The test is one of straight comparison between the applied for mark and the official mark apart from any marketplace considerations - see Allied, supra, at 166 and Canadian Olympic Assn. v. Konica Canada Inc. (1990), 30 C.P.R.(3d) 60 at 65 (F.C.T.D.), reversed on other grounds (1991), 39 C.P.R.(3d) 400 (F.C.A.).

While the surrounding circumstances relevant to the test for confusion have no application in determining the issue of the registrability of an applied for mark arising pursuant to Sections 9 and 12(1)(e), nevertheless, all three aspects of resemblance referred to in Section 6(5)(e) are to be weighed in assessing the Section 9(1) test - see Canadian Olympic Association v. B.P.S. Consultants Inc. (re application serial No. 620,511 for the mark THE TORCH BEARERS, May 29, 1992, yet unreported, TMOB).

Further, the phrase "consists of" in Section 9 does not mean "includes" - see Canadian Olympic Assn. v. Hans Chr. Mengshoel (1989), 28 C.P.R. (3d) 475 at 479 (TMOB); The Board of Regents, The University of Texas System v. The Texas Longhorn Cafe Inc. (re application serial No. 594,179 for the mark THE TEXAS LONGHORN CAFE & Design, February 28, 1992, yet unreported, TMOB).

The opponent did not evidence that the Registrar gave public notice of the official marks relied on in the statement of opposition, while the applicant in its oral submission appears to have accepted that such notice was given. Nevertheless, the applicant in its written argument raised the objection that the opponent has not met its evidential burden with respect proving the facts underlying its ground of opposition pursuant to Section 9. In the circumstances I have exercised the Registrar's discretion to check records in his care to confirm that public notice of the official marks relied on by the opponent were given as alleged by the opponent in the statement of opposition.

The applied for mark PANDA SOFT is not identical to either of the opponent's official marks. Therefore it is the second branch of the Section 9(1) test that needs to be considered, that is, is the mark PANDA SOFT almost the same as either of the official marks relied on by the opponent?

Comparing the applied for mark PANDA SOFT with the official word mark PANDA, there is necessarily some degree of visual and aural resemblance owing to the word PANDA common to both marks. The ideas suggested by the marks overlap to some extent but are distinct. The idea suggested by PANDA SOFT is softness - the softness characteristic of fluffy fur; the idea suggested by PANDA, alone, is an appealing bear-like animal of that name. Considering the three aspects of resemblance for the marks in question, I find that the applied for mark PANDA SOFT, in its totality, does not so nearly resemble as to be likely to be mistaken for the official mark PANDA. As there is even less resemblance between the applied for mark and the other official mark WWF & Design, it follows that the applied for mark does not so nearly resemble as to be likely to be mistaken for WWF & Design.

In view of the above, the ground of opposition denoted by (c) fails.

The material time for considering the ground of opposition denoted by (b) above, pursuant to Section 16(3)(b), is the date of filing the subject application - September 30, 1987. The opponent is required to establish, first, that the application it relies on was filed prior to the material date September 30, 1987, and second, that the application was pending at the time of advertisement of the applied for mark, namely September 28, 1988 - see Section 16(4).

The evidence of both parties indicates that application serial No. 598,684 was filed on January 15, 1988, that is, after the material date September 30, 1987. Accordingly, application No. 598,684 cannot be relied on by the opponent to support its Section 16(3)(b) ground of opposition.

Mr. McKinlay's affidavit evidence filed on behalf of the opponent meets the first requirement with respect to the opponent's reliance on application serial No. 474,939, but does not meet the second requirement. However, the affidavit of Linda Thibeault filed on behalf of the applicant indicates that application serial No. 474,939 was pending at the time of advertisement - see page 11, Search Report, attached as exhibit A to the Thibeault affidavit - and suffices to establish the second requirement.

I consider that the characterization of application serial No. 474,939 found on page 9 of the applicant's written argument is fair comment:

There is at least one overlap between the wares covered in the subject application and the plethora of wares listed in the opponent's application No. 474,939, namely towels.

The ground of opposition pursuant to Section 16(3) (b) turns on the issue of confusion, within the meaning of Section 6(2), between the applied for mark PANDA SOFT and the opponent's trade-mark application for PANDA DESIGN.

Similarly, the several grounds of opposition pleaded together in (a) above turn on the issue of confusion between the applied for mark PANDA SOFT with various of the opponent's marks either at (i) the date of my decision with respect to registrability, (ii) the date of filing the subject application, namely September 30, 1987, with respect to entitlement, (iii) the date of filing the statement of opposition, namely December 16, 1988, with respect to distinctiveness. In this regard, I do not consider that the recent Kellogg Salada case, *infra*, has overturned the line of cases set out in Dixon Ticonderoga, *infra*, establishing the filing of the opposition as the material date for determining the issue of distinctiveness - see Kellogg Salada Canada Inc. v. The Registrar of Trade-Marks et al. (yet unreported, June 29, 1992, A-140-87, F.C.A.); Faber-Castell Canada Inc. v. Dixon Ticonderoga Inc. (1992) 41 C.P.R.(3d) 284 at 287 (TMOB). In any event, in the instant case nothing turns on which material date is considered as the evidence does not indicate that there were any significant changes in the surrounding circumstances between material dates.

Further, the ground of opposition alleging non-distinctiveness of the applied for mark does not stand alone but also depends on a finding of confusion between the applied for mark PANDA SOFT and one or more of the opponent's marks. The ground of opposition pursuant to Section 30(i) fails because the opponent has not met its evidential burden to establish facts underlying that ground - see John Labatt Ltd. v. Molson Companies Ltd. (1990) 30 C.P.R.(3d)

293 at 297-98 (F.C.T.D.).

With respect to the issue of entitlement, Sections 16 and 17(1) impose statutory requirements on the opponent to establish that it has in fact used the marks it relies on, in Canada, prior to the date of filing the subject application, and that it did not abandon those marks prior to the date of advertisement of the application being opposed.

In this regard, the opponent's unchallenged evidence is that it has used the PANDA DESIGN figure shown in application serial Nos. 474,939 and 598,684 since about 1986. The opponent was using the somewhat different PANDA DESIGN figure appearing in registration Nos. 183,818 and 196,285 prior to 1986. For the purposes of this proceeding I will take the earlier and later figures to be variants of the same design.

Mr. Love's evidence indicates that the opponent's PANDA DESIGN mark has acquired at least some reputation in Canada in association with the opponent's fund raising activities for its environmental and conservation projects, that is, in association with the services described in registration No. 183,818. In this regard, I have not given any weight to Mr. Love's reliance on extracts from a "national survey ... conducted by Gallup Canada, Inc. [concerning the] unaided recognition of WWF & Panda Mark and its association with World Wildlife Fund" as it is clearly inadmissible hearsay evidence - see Noxema Inc. v. Navana Manufacturing Ltd. (1985) 5 C.P.R.(3d) 509 at 512-13 (TMOB).

I cannot infer from the opponent's evidence that it has used or made known any of its various marks in Canada in association with any of the wares listed in the opponent's trade-mark registrations or applications. Accordingly, the opponent is unable to rely on any reputation for its marks used in association with wares to support its various grounds of opposition.



The opponent can however rely on the reputation of its mark PANDA DESIGN (regn. No. 183,818) used in association with the operation of a conservation fund. As that mark resembles the applied for mark PANDA SOFT much as any other mark that the opponent relies on, a determination of the issue of confusion between PANDA SOFT and PANDA DESIGN registration No. 183,818 will effectively decide this opposition.

In considering the issue of confusion, the Registrar is to have regard to all the surrounding circumstances including those enumerated in Section 6(5). The legal burden is on the applicant to show that there would be no reasonable likelihood of confusion.

The opponent's mark PANDA DESIGN and the applied for mark PANDA SOFT are inherently distinctive, the applicant's mark perhaps less so because PANDA SOFT is suggestive of the "soft" character of some of the applicant's wares, namely tissues, towels, diapers and baby powder, and somewhat suggestive of the "fluffy-soft" result produced by its other wares, namely detergent, softeners and conditioners.

The applied for mark PANDA SOFT is based on proposed in Canada; there is no evidence that it acquired any reputation at any material date. The opponent's mark has been used in Canada since at least 1967 and was known in Canada, to a limited extent, in association with fund raising activities for nature conservation projects, at all relevant times.

The applicant's wares have nothing in common with the opponent's fund raising activities. In the absence of evidence to the contrary, I assume that the applicant's business would not overlap with the opponent's fund raising for environmental and conservation projects.

There is little visual resemblance between the marks PANDA

SOFT and PANDA DESIGN. There is necessarily some resemblance aurally as the opponent's design mark would be sounded as "panda". The ideas suggested by the marks PANDA SOFT and PANDA DESIGN overlap to some extent but are also different, as discussed previously in regard to the Section 9 test.

As a surrounding circumstance, the applicant relies on state of the register evidence of "over sixty registrations, pending applications or notice for the adoption of official marks for such PANDA or panda design marks, including those of both the opponent and the applicant...[proving] that the word PANDA and the design of a panda bear have been commonly adopted as trade-marks by many traders for a wide variety of wares and services". A review of the applicant's evidence shows that there are about 24 registrations in the names of about 21 different owners (discounting the opponent's marks), for a wide variety of wares and services. However, this evidence does not assist the applicant to a significant extent. First, those marks are registered for wares unrelated to the applicant's wares, and second, the applicant cannot put much reliance on the non-distinctive element of its mark, namely SOFT, to differentiate its mark in the marketplace.

Considering the above, and keeping in mind that the test for confusion is one of first impression and imperfect recollection, I find that the applied for mark PANDA SOFT is not confusing with PANDA DESIGN registration No. 183,818. Essentially the same considerations as above apply to the grounds of opposition based on the remaining marks (covering wares) that the opponent relies on, and the same conclusion follows.

In view of the above, the opponent's opposition is rejected.

DATED AT HULL, QUEBEC, THIS 31<sup>st</sup> DAY OF JULY , 1992.

Myer Herzig,  
Member,  
Trade-marks Opposition Board

