



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

**Citation: 2014 TMOB 99**  
**Date of Decision: 2014-05-13**

**IN THE MATTER OF AN OPPOSITION  
by Forest Stewardship Council, A.C. to  
application No. 1,475,642 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 casual clothing, dress clothing, and athletic clothing and catalogue shopping services.



[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 mark TMA528,235, shown below. Its mark is registered in association with furniture and products made from wood, printed materials relating to forest management and conservation and several different services relating to forests, wood and products made from wood, and has also purportedly been used in association with clothing.



Forest Stewardship Council, A.C. has also opposed the application on technical grounds under section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

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

#### Background

[4] On April 6, 2010, G.H. Imported Merchandise & Sales Limited (the Applicant) filed application No. 1,475,642 for the registration of the applied-for mark TREE Design (the Mark) based upon use in association with casual clothing, dress clothing and athletic clothing since at least as early as October 2008, and use in association with catalogue shopping services in the field of clothing since April, 2008.

[5] The application was advertised on September 15, 2010, and Forest Stewardship Council, A.C. (the Opponent) filed a Statement of Opposition on February 8, 2010. The Opponent alleges that the Mark is not registrable under section 12(1)(d) of 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 had not, by itself or through a predecessor-in-title, used the Mark in association with the applied for wares or services since the dates 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 Amanda Cohen, articling student 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 the Applicant's application No. 1,524,862 for the same trade-mark (for different wares) 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

#### *Pleadings*

[10] As a preliminary issue, I have considered the sufficiency of the Opponent’s section 16(1) ground which was pleaded as follows:

Pursuant to section 16(1) of the Act, the Applicant is not the person entitled to registration of the trade-mark in association with the wares and services as, as of the filing date of the application and at all times thereafter, the trade-mark was confusing with the Opponent’s Trade-mark which has previously been used and registered in Canada.

[11] At the oral hearing, the Opponent's agent argued that pursuant to this ground the Applicant is not the person entitled to the Mark pursuant to section 16(1)(b) because at the Applicant’s date of first use it was confusing with a trade-mark in respect of which an application for registration had been previously filed in Canada by the Opponent.

[12] When challenged about the differences between the ground as pleaded in the statement of opposition and his argument on this ground at the oral hearing, the Opponent's agent submitted that the section 16(1) ground, as pleaded, was broad enough to include a claim based on section 16(1)(b). The Opponent’s agent further submitted that since the Opponent has relied upon its

Canadian trade-mark registration for other grounds, it should be implied that section 16(1)(b) is applicable.

[13] In my view, this ground would not have succeeded regardless of how I consider it to have been pleaded. In this regard, if I had found this ground to have been based on section 16(1)(b) of the Act, the Opponent would have been required to have filed its trade-mark application in Canada prior to the Applicant's date of first use, i.e. April 2008 or October 2008, and to have shown that its application was pending at the date of advertisement of the applicant's application [see section 16(4) of the Act and *Governor and Co of Adventurers of England trading into Hudson's Bay v Kmart Canada Ltd* (1997), 76 CPR (3d) 526 (TMOB) at p 528]. Although the application for the Opponent's Canadian trade-mark registration No. TMA528,235, was filed April 11, 1996, it issued to registration on May 23, 2000. It was therefore not pending as of April or October 2008 and therefore could not have supported a section 16(1)(b) ground of opposition.

[14] Had the Opponent not made any submissions about this ground, I may have considered this ground to have been based on section 16(1)(a) of the Act (despite the fact that it refers to the filing date of the application and at all times thereafter as opposed to the Applicant's date of first use). Even if I had done so however, I would have found that the Opponent's evidential burden had not been met. As will be discussed further below, the Opponent concedes that it has not shown any use of its registered mark.

[15] This ground therefore does not succeed.

#### *Admissibility Issues*

[16] The Opponent made several objections to the Applicant's evidence. As most of these objections were with regard to the Cohen affidavit, I consider it useful to summarize the contents of her affidavit first.

[17] Ms. Cohen is an articling student employed by the Applicant's agent. She was instructed to review the state of the register search results which form Exhibits A and B to the Noonan

affidavit which identifies active trade-marks from the Canadian Trade-mark Database that consist of or include a tree design, and locate those marks on the Internet.

[18] Attached as Exhibit A to her affidavit is a list of the trade-marks she found online in the time that she had. Attached as Exhibit B are screen captures showing the display of the marks on these sites.

[19] The objections made by the Opponent to the Cohen affidavit are as follows. First, the Opponent has objected to the fact that the evidence of Ms. Cohen 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.

[20] Second, the Opponent submits that that even if the exhibits attached to Ms. Cohen's affidavit are admissible, in view that printouts of third party websites are hearsay, these exhibits are not admissible for the truth of their contents.

[21] With respect to the Opponent's first objection, I do not find that the concerns raised by the Federal Court of Appeal in *Cross-Canada*, apply here. Ms. Cohen's affidavit does not contain conclusions or opinions on the contentious issues of the opposition. She simply searched the Internet for examples of wares and services with tree designs to corroborate the evidence of Ms. Noonan. I do not see how the fact that this evidence was introduced by an employee of the Applicant's agent makes it less proper than if the Applicant or its agent had hired any outside investigator to make such Internet searches and swear an affidavit. Overall, the evidence does not appear to me to be controversial.

[22] With respect to the Opponent's second objection, I find that Ms. Cohen's 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 and services on-line on the date that Ms. Cohen conducted her Internet search.

[23] In considering both of the above objections, I had regard to the following comments of former Member Bradbury in *Canadian Jewellers Association v American Gem Society*, 2010 TMOB 106 (CanLII):

I disagree with the Applicant's position that the Internet search portions of the Cheng evidence are controversial. I understand that a search strategy must be developed in order to conduct a search. The specific strategy used is evident from the exhibits to the Cheng affidavits, but the Applicant's concern is the undisclosed thought that went into creating that strategy. However, I personally do not see that the concerns expressed by the Federal Court of Appeal in *Cross Canada* legitimately apply here. I do not see how any self-interest of an agent employed by a party could be seen to bias these search results. It is quite apparent that the search was directed to see if anyone other than the Applicant has employed the phrase "certified gemologist" on Canadian websites. I do not see how the fact that this evidence was introduced by an employee of the Opponent's agent makes it less proper or open to suspicion than if the Opponent or its agent had hired an outside investigator to do such searches and swear an affidavit. Either way, the Applicant could, if it desired, cross-examine the provider of such evidence to ask why they chose the search terms that they chose. In the present case, the answer seems self-evident. Overall, the evidence does not appear to me to be controversial. I also note that the Applicant could have, if it wished, provided its own Internet searches to rebut the Opponent's Internet searches.

In my view, the impugned exhibits are evidence that as of such a date, the printed pages appeared on the Internet. This does not of course mean that anyone read these pages; it simply means that someone chose to post these pages and that they were at the time of the search accessible from Canada. Such evidence, if sufficient and if prior to the relevant material date, can be good evidence on the issue of whether others employ the phrase "certified gemologist". As such evidence is not being presented to evidence the truth of the contents of the pages, but rather simply their existence, I do not consider there to be a hearsay problem.

[24] The Opponent has also objected to the printouts of the USPTO website attached to the Woods affidavit. The Opponent submits that the printouts of the USPTO websites are hearsay and are therefore not admissible.

[25] While I agree with the Opponent that the printouts of this website are hearsay, in view that I find the manner in which this type of evidence was submitted to be both necessary and reliable (in that the documents come from a website maintained by an official body), I have given full weight to this evidence [see *Envirodrive Inc v 836442 Canada Inc* (2005), ABQB 446 (CanLii); *ITV Technologies Inc v WIC Television Ltd* 2003 FC 1056].

## Grounds of Opposition

### Non-compliance – Section 30(i)

[26] 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 [see *Interactiv Design Pty Ltd v Grafton-Fraser Inc* (1998), 87 CPR (3d) 537 (TMOB), at 542-543)].

[27] 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)].

[28] 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)].

[29] Unlike in the related opposition regarding application No. 1,524,862, the Opponent did not produce a copy of a copyright assignment or any other evidence to show the existence of copyright in its tree design. Further, I disagree with the Opponent that I can infer the Applicant should have known that copyright existed just because the Opponent's trade-mark was registered in Canada.

[30] In any event, I find that 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-compliance – Section 30(b)

[32] 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 services since at least as early as April 2008 and the applied for wares since at least as early as October 2008.

[33] 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 onus does not shift to the Applicant to positively support the dates it has claimed unless the Opponent can show a clear discrepancy in the Applicant's evidence regarding its claimed dates of first use.

[34] 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 the catalogue attached as Exhibit C to the Woods affidavit does not by itself show use of the Mark in association with the Applicant's wares or services as of the dates claimed pursuant to section 4(1) or 4(2).

[35] 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 services dating back to April 2008 and the applied for wares dating back to October 2008, 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 the wares or services as of April or October 2008 does not

necessarily mean that the Applicant has not also properly used the Mark in association with the applied for wares or services since the claimed dates of first use. I am therefore unable to conclude that the Opponent has met its initial evidential burden.

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

Non-registrability – Section 12(1)(d)

[37] The Opponent further pleads that the Mark is not registrable because it is confusing with the Opponent's registered 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.

[38] 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-mark.

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

Wares:

(1) 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*

[40] 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.

[41] 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) – the inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known*

[42] Neither party's mark is inherently strong. In this regard, the Opponent's FSC and Tree Design is suggestive of its wood and paper products and related services. The Applicant's Mark is also somewhat suggestive of its ecologically-friendly clothing manufactured from recycled or more sustainable materials.

[43] 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.

[44] 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 hangtag features pricing information and a barcode likely to be scanned by the retailer at the time of purchase of the item.

[45] The Opponent has also provided information about the apparent use of FSC certified paper products by a third party, Gap Inc., in its retail operations. In this regard, attached as an exhibit to the Patel affidavit is a copy of Gap Inc.'s Social Responsibility Report where it is confirmed that its price tickets are certified by the Opponent and/or are made of 100 percent recycled material.

[46] 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. I am therefore unable to determine the extent the Opponent's mark has become known in Canada in association with its registered wares and services.

[47] On the other hand, the Applicant has provided uncontradicted evidence that it has used its Mark in Canada since at least as early as April 2008 and has evidenced over \$14 million worth of sales of its products, which represents over 875,000 individual items sold in Canada since that time [Woods, para. 12, 14, 16 and Exhibit D]. In addition, the Applicant has provided evidence of advertising and promotion of its products in Canada. In this regard, the Applicant has promoted, advertised and offered its clothing products sold in association with the Mark through the distribution of over one million copies of its various product catalogues since 2008, as well as the distribution of sell sheets and other materials to existing and potential customers both in paper form and electronically [Woods, para. 13 and 17].

[48] Based on the foregoing information, I conclude that overall this factor favours the Applicant.

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

[49] 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 either of 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 *Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)].

[50] In view that the Applicant has provided evidence of use of its Mark in Canada, 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*

[51] It is the Applicant's statement of wares and services as defined in its application versus the Opponent's registered wares and services 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)].

[52] The Opponent's agent admitted at the oral hearing that there was no direct overlap between the parties' wares and services. The Opponent maintains, however, that there is a close connection between the parties' wares and services because the Opponent's hangtags are used in association with the Applicant's clothing. The Opponent refers to the Stephen affidavit which shows the Opponent's mark being displayed on hangtags for clothing. The Opponent also relies on the evidence of Ms. Patel which it submits shows that The Gap's clothing hangtags are certified by the Opponent and/or are made of 100 percent recycled material.

[53] In my view, the parties' wares and services are quite different. In this regard, the Applicant has applied to register its Mark in association with clothing products and related catalogue shopping services. In contrast, the Opponent's mark is registered for use in association with a variety of wood and paper products and related forestry services. The Opponent's trade-mark is not registered for use in association with clothing products or catalogue shopping services nor has the Opponent shown any evidence of use its mark as a trade-mark pursuant to section 4(1) or section 4(2) of the Act in association with such products or services. It is clear from the evidence that the Opponent does not use its FSC and Tree Design mark to indicate to consumers the manufacturing or sales origin of any clothing products (as the Applicant's Mark

does) but rather displays its mark in association with printed materials and wood products and in relation to the sustainability of wood, paper and forestry services.

[54] The Opponent further submits that there is an overlap with respect to the parties' channels of trade for the same reasons as those set out above. While the parties' wares may be sold to the same consumers (eg. clothing retailers), 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 clothing wares, even ecologically friendly clothing. Further, I do not consider that the scope of the applied for wares and services could potentially include the same channels of trade as the Opponent's wares and services.

[55] 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*

[56] When considering the degree of resemblance, the law is clear that the trade-marks must be considered in their totality.

[57] Although both marks are comprised of tree designs, I do not find there to be a high degree of resemblance in appearance or sound between the marks because of their differences. 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.

[58] With respect to the ideas suggested by the marks, the Applicant concedes that both marks 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*

*No evidence of actual confusion*

[59] 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.

[60] 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)].

[61] 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 from the absence of any evidence of confusion.

*Co-existence in foreign jurisdiction*

[62] 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 the U.S. without any challenge from the Opponent.

[63] While the Applicant did provide print-outs of its U.S. application (see Woods, para. 19 and Exhibit H) it did not evidence the existence of the Opponent's registration in the U.S. Even if it had, little can be drawn from the fact that trade-marks co-exist 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)].

*State of the Register and State of the Marketplace evidence*

[64] As a further surrounding circumstance, the Applicant has relied upon the evidence of Ms. Noonan and Ms. Cohen regarding the state of the register and the state of the marketplace. The Noonan affidavit includes the results of searches of the Trade-marks Register purporting to show various Canadian registrations and applications containing a tree design component in association with bags, clothing and paper and wood products and forestry services. Her search identified 371 such marks in association with clothing wares and/or related services and 388 such marks in association with paper and/or wood related wares and/or forest related services [Noonan, paras 3 and 4 and Exhibits A and B]. The Cohen affidavit, as noted above, shows the display of some of these marks online on third party websites.

[65] The evidence concerning the state of the register is relevant only to the extent that inferences may be drawn concerning the state of the marketplace [see *Ports International Ltd v Dunlopo 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)].

[66] 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.

[67] 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. In the present case, I am satisfied that there are at least twenty relevant tree design registrations for clothing and/or related services 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.

[68] 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].

[69] With respect to Ms. Cohen's evidence, few of the trade-marks located by her on third party websites are trade-marks that I have identified as relevant registrations within the Noonan state of the register evidence. As noted above, however, I was still able to draw inferences about the state of the marketplace from the number of relevant registrations provided by Ms. Noonan.

### *Conclusion*

[70] 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."

[71] 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's reputation lies primarily in the clothing and catalogue services industry, 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 wares and services 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 and services or to make confusion likely.

[72] 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** clothing and related services. 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].

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

#### Distinctiveness Ground of Opposition

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

[75] 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.

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

Disposition

[77] 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