



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

**Citation: 2012 TMOB 227**  
**Date of Decision: 2012-11-23**

**IN THE MATTER OF AN OPPOSITION  
by Heather Ruth McDowell to application  
No. 1,450,491 for the trade-mark  
HONEYFIG Design in the name of  
2103214 Ontario Inc.**

[1] On September 3, 2009, 2103214 Ontario Inc. (the Applicant) filed an application to register the trade-mark HONEYFIG Design (the Mark), shown below, based on use in Canada since at least as early as June 30, 2006 in association with the services “online retail store services featuring personal care products, cosmetics, toiletries, spa, skin and beauty care products, home fragrance products and personal care accessories” (the Services).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of March 10, 2010.

[3] On August 10, 2010, Heather Ruth McDowell (the Opponent) filed a statement of opposition. The Opponent filed an amended statement of opposition on August 17, 2010 leave for which was granted on October 27, 2010. The grounds of opposition can be summarized as follows:

- the Mark is not distinctive of the Services and is incapable of becoming distinctive of them for the following reasons: the Opponent is the owner of two Canadian trade-

mark registrations HONEY & Design (TMA767,134) and HONEY (TMA767,075) (the Opponent's HONEY Marks), detailed below:

- a. HONEY & Design – filed April 22, 2003; registered May 18, 2010 - TMA767,134



- b. HONEY – filed December 10, 2002; registered May 18, 2010 - TMA767,075.

Both registrations claim the following wares and services:

Wares: clothing, namely, trousers, jeans, sweat pants, yoga pants, active wear, pants, sweaters, sweatshirts, polo shirts, shirts, skirts, blouses, dresses, hosiery, jackets, blazers, coats, ski jackets, down filled jackets, fur jackets, wool coats, shorts, bathing suits, loungewear; lingerie; footwear, namely, shoes, sandals, boots, slippers; men's, women's and children's shoes made of leather, suede or silk, namely pumps, high heels, dress shoes of any kind, sneakers, running shoes, basketball shoes, golf shoes, training shoes, court shoes, track shoes, beach shoes, namely sandals, flip flops and thongs; headwear, namely, hats, caps, bandannas, headbands, visors; jewellery; fashion accessories, namely, scarves, shawls, purses, gloves, watches; hair accessories, namely, combs, brushes, hair bands made of cloth or plastic, barrettes, scrunchies, ponytail holders, hair clips, hair pins, and hair ornaments; belts, sunglasses; cosmetics, namely foundation made of liquid or powder, face creams, blush, eye shadow, eye liner, mascara, lipstick, lip gloss, lip liner, make-up bags sold empty; giftware, namely, lamps, trays, vases; ornaments and figurines made from ceramic, chinaware, glass, porcelain; candy dishes

Services: retail store services, namely, the operation of a clothing, footwear, headwear, fashion accessory and giftware outlet.

(the Opponent's Wares and Services)

- the Mark is not registrable in light of section 12(1)(d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) in that use of the Mark would lead the public to believe that the Applicant is authorized or licensed by the Opponent, which is not true. Therefore any use by the Applicant is confusing or likely to be confusing with the Opponent's use of its trade-marks.

- the Applicant is not entitled to registration of the Mark pursuant to sections 16(1)(a) and (b) of the Act because use of the Mark would lead the public to believe that the Applicant is authorized or licensed by the Opponent which is not true. Therefore any use by the Applicant is confusing or likely to be confused with the use of the Opponent and its trade-marks.
- the application does not comply with section 30(i) of the Act in that at the date of application or alleged date of first use a search of the Trade-marks Register would have located the Opponent's marks relied on herein and therefore the Applicant could not have been satisfied under section 30(i) of its entitlement to use the Mark in view of this prior knowledge of the use and notoriety of the Opponent's marks.
- the application does not comply with section 30(b) of the Act, in that the Applicant has not used the Mark since the alleged date of first use or at all in Canada. Alternatively, if the Mark was or is in use in Canada, such use was by a third party and does not comply with the requirements of section 50 of the Act. The Opponent objects to any use of the Mark which, based on the above, would be a confusing use contrary to the Act.

[4] The Applicant served and filed a counter statement in which it denied the Opponent's allegations and put the Opponent to the strict proof thereof.

[5] In support of its opposition, the Opponent filed an affidavit of Elenita Anastacio, a trade-mark searcher employed by the Opponent's agent sworn February 14, 2011 with Exhibits A – C. Ms. Anastacio was not cross-examined on her affidavit.

[6] The Applicant did not file any evidence in support of its application.

[7] Neither party filed a written argument. An oral hearing was held at which only the Opponent was represented.

#### 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. 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 CPR (3d) 293 (FCTD) at 298].

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

- sections 38(2)(a)/30 - the date of filing the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)].
- sections 38(2)(b)/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)]
- sections 38(2)(c)/16(1) - the claimed date of first use [see section 16(1) of the Act].
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

### Section 30 Grounds of Opposition

#### *Non-compliance with section 30(b) of the Act*

[10] The initial burden on the Opponent is light respecting the issue of non-conformance with section 30(b) of the Act, because the facts regarding the Applicant's first use are particularly within the knowledge of the Applicant [see *Tune Masters v Mr. P.'s Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89].

[11] Section 30(b) of the Act requires that there be continuous use of the applied for trademark in the normal course of trade from the date claimed to the material date [see *Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD) at 262].

[12] In support of this ground of opposition, the Opponent relies on searches of the FP Infomart database and the Wayback Machine Internet archive both conducted by Ms. Anastacio on February 3, 2011.

[13] Ms. Anastacio searched the FP Infomart database, which she states is "Canada's largest provider of media monitoring and corporate information, including more than 275 news sources from coast to coast". Ms. Anastacio searched the database for the terms "HONEY FIG" in association with "2103214 Ontario" for the dates January 1, 2005 to February 3, 2011, which covers the relevant date. Ms. Anastacio states that she found no reference to these search terms in

the time period searched. I am satisfied that Ms. Anastacio has established the reliability of the FPInfomart database.

[14] Ms. Anastacio used the Wayback Machine Internet archive to search for archived versions of the Applicant's website, *http://honeyfig.com*. Ms. Anastacio states that the earliest archived version found on Wayback Machine was dated August 22, 2006.

[15] At the oral hearing, the Opponent acknowledged that Internet searches are generally considered to be hearsay and cannot be relied upon for the truth of their contents. However, the Opponent submitted that evidence of this nature has been accepted in situations where the affiant him or herself conducts the searches, where it is difficult for the opponent to find any other evidence to meet its burden, and where the applicant has the opportunity to reply to the evidence [see *Effigi Inc v HBI Branded Apparel Limited, Inc* 2010 TMOB 160].

[16] The Opponent submitted that the Internet evidence adduced through Ms. Anastacio's affidavit should be given some weight as each of these circumstances apply to the present case. Specifically, Ms. Anastacio conducted the searches herself, the Services are Internet-based making Internet evidence appropriate and the Applicant had the opportunity to file its own evidence in response or to cross-examine Ms. Anastacio and it chose not to. As a result, the Opponent submits that the Anastacio affidavit should be admissible and sufficient to enable the Opponent to meet its light evidential burden under this ground of opposition. The Opponent also stressed that it was not attempting to rely on this Internet evidence to support a categorical conclusion that the Applicant's date of first use is not accurate, but rather merely to meet its evidential burden.

[17] Evidence produced by the Wayback Machine indicating the state of websites in the past has been found to be generally reliable [see *Candrug Health Solutions Inc v Thorkelson* (2007), 60 CPR (4th) 35 (FC); reversed on other grounds 2008 FCA 100]. More particularly, the admissibility of Wayback Machine evidence in support of an opponent's section 30(b) ground of opposition has been commented on as follows by Board Member Bradbury in *Royal Canadian Golf Assn v O.R.C.G.A.* (2009), 72 CPR (4th) 59 (TMOB), at pages 64-65:

I appreciate that there be limitations to the accuracy of the Wayback Machine, including but not limited to possible hearsay issues. However, for the purpose of meeting the Opponent's light initial burden under s. 30(b), I find that the search results are sufficient to raise a doubt concerning the correctness of the Applicant's claimed date of first use [...]. The Applicant had the opportunity to file evidence to rebut the results of the Wayback Machine search but chose not to.

[18] In the present case I find that the Wayback Machine search results do raise a doubt as to the correctness of the Applicant's statement that it has used the Mark in association with the Services in Canada since June 30, 2006. The Services are the operation of an online retail store and thus it seems impossible for an online retail store to operate in the absence of an active website. The Wayback Machine evidence suggests that the Applicant's website may not have been active until two months after the claimed use date. This calls into question whether the Applicant could have been offering the Services at the relevant date.

[19] While I do not find the FPIInfomart search results to be determinative, I find that in combination with the Wayback Machine search results, they serve to create further doubt as to the Applicant's presence in the Canadian marketplace at the relevant date.

[20] Based on the foregoing, I am satisfied that the Opponent has met its light evidential burden.

[21] The onus now shifts to the Applicant to establish that it had been using the Mark in association with the Services since the claimed date of first use, namely since June 30, 2006. Given that the Applicant has not filed any evidence, I am not satisfied that the Applicant has met its onus and thus the ground of opposition based on section 30(b) of the Act is successful.

*Non-compliance with section 30(i) of the Act*

[22] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. The Applicant has provided the necessary statement and this is not an exceptional case; the section 30(i) ground is accordingly dismissed.

## Non-registrability Ground of Opposition – Section 12(1)(d) of the Act

[23] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if the registrations relied upon are in good standing as of the date of the opposition decision. The Registrar has discretion to check the register in order to confirm the existence of the registrations relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. I have exercised that discretion and confirm that the registrations for the Opponent's HONEY marks remain valid.

[24] 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.

[25] 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. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 96 CPR (4th) 361 (SCC).]

### *Section 6(5)(a) – inherent distinctiveness and the extent to which the marks have become known*

[26] The Mark is made up of the common dictionary words HONEY and FIG which have been fused to form the coined word, HONEYFIG. I note that the component words have no obvious meaning with respect to the Services. The Mark also features design elements in the form of fancy scripts and embellishments. I note that the design elements are such that the component words, HONEY and FIG, are displayed in different scripts resulting in the appearance of two separate words. All of these factors lead to a finding that the Mark possesses some degree of inherent distinctiveness.

[27] The Opponent's HONEY Marks consist of the common dictionary word HONEY and, with respect to the design mark, a simple circle design surrounding the word. As with the Mark, the word HONEY has no obvious meaning with respect to the Opponent's Wares and Services. The Opponent submitted that the word could possibly be considered to be suggestive of some of the Opponent's wares, e.g. cosmetics, where honey could be an ingredient of such products, however, the Opponent submitted that any such inference would be a stretch. On this basis, the Opponent submitted that its HONEY Marks possess the same degree of inherent distinctiveness.

[28] I find that the Mark possesses a somewhat greater degree of inherent distinctiveness than the Opponent's HONEY Marks by virtue of the fact that the Mark is a coined word.

[29] A trade-mark may acquire distinctiveness through use or promotion. However, in the present case neither party has filed evidence to show use or promotion of its marks. While it is true that one of the Opponent's registrations claims use in Canada since at least as early as March 15, 2003 (TMA767,134) and the other issued subsequent to the filing of a declaration of use on April 28, 2010 (TMA767,075), at most this entitles me to assume *de minimis* use of the Opponent's HONEY Marks [see *Entre Computer Centers Inc. v. Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB) at 430]. *De minimis* use does not support a conclusion that the Opponent's HONEY Marks had become known to any significant extent.

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

[30] The application for the Mark was filed based on use in Canada since at least as early as June 30, 2006; however, the Applicant has not filed any evidence of use of the Mark.

[31] The Opponent submitted that for the purposes of assessing the length of time the HONEY Marks have become known I should use a deemed date of first use of the filing date for the HONEY Word Mark (December 10, 2002) and the claimed date of first use of March 15, 2003 for the HONEY Design Mark. The Opponent relies on section 3 of the Act in support of its submission regarding the deemed date of first use for the HONEY word mark. I do not agree with this approach. The earliest date of use I may be willing to infer for the word mark would be the date of filing the declaration of use, namely, April 28, 2010. In any event, as discussed further above in the analysis of the section 6(5)(a) factor, the Opponent's registrations only



enable me to assume *de minimis* use of the Opponent's HONEY Marks. While it may be true that *de minimis* use is more than no use, in the absence of evidence of use of either party's marks, this factor does not significantly favour either party.

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

[32] It is the Applicant's statement of wares as defined in its application versus the Opponent's registered wares that govern my determination of this factor [see *Esprit International v Alcohol Countermeasure Systems Corp* (1997), 84 CPR (3d) 89 (TMOB)]. The Mark is applied for in association with services only whereas the Opponent's HONEY Marks are registered for use in association with both wares and services.

[33] The Opponent submits that the Opponent's "retail store services, namely, the operation of a clothing, footwear, headwear, fashion accessory and giftware outlet" would be broad enough to encompass the Applicant's online retail store services thereby creating an exact overlap between the nature of the parties' wares and services. I do not agree for two reasons. Firstly, I am not prepared, in the absence of evidence of the parties' actual services, to find an overlap between a physical store and an online store. Secondly, and more importantly, I note that the Opponent's claimed retail store services cover the sale of different types of wares as compared to those sold by the Applicant through the Services. Thus, I do not find there to be an overlap between the parties' services.

[34] The Opponent also submitted that a direct overlap is created between the parties' wares and services by virtue of the fact that the Opponent's wares include wares which are sold by the Applicant through the Services. Specifically, the Opponent's wares include cosmetics. The Services include the sale of cosmetics as well as personal care products, toiletries, spa, skin and beauty care products, all of which I am willing to find overlap with the Opponent's cosmetics.

[35] The Opponent submits that, given that we have no evidence as to the exact nature of the products sold through the Services, it is conceivable that the Opponent's HONEY brand cosmetics could be sold through the Applicant's online retail store. The Opponent submits that this would likely cause confusion with consumers believing that the HONEY brand cosmetics belonged to the Applicant, as opposed to the Opponent.

[36] I am willing to find that there is an overlap between the parties' wares and services with respect to the Applicant's "online retail store services featuring personal care products, cosmetics, toiletries, spa, skin and beauty care products, ... and personal care accessories".

[37] The Opponent submits that there would also be an overlap between the Applicant's "home fragrance products" and the Opponent's "lamps, trays and vases". I disagree.

[38] While I have not been provided with any evidence of the parties' channels of trade it is conceivable that the Opponent's cosmetics could be sold through an online retail store, thus creating a potential overlap in the parties' channels of trade as well.

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

[39] Recently, in *Masterpiece*, the Supreme Court of Canada discussed the importance of the section 6(5)(e) factor in conducting an analysis of the likelihood of confusion between the parties' marks in accordance with section 6 of the Act (see para 49):

...the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis ... if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar. [...]

[40] At the oral hearing, the Opponent relied on the following passage from *Masterpiece* regarding the proper approach to be followed when assessing the degree of resemblance between the parties' marks [at para 64]:

While the first word may, for purposes of distinctiveness, be the most important in some cases, I think a preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique.

[41] In the present case, the Opponent submits that the "striking or unique" element in the Mark is the word HONEY which is also the first portion of the Mark and is also identical to the entirety of the Opponent's HONEY Mark. On this basis, the Opponent submits that the essential impression left by the parties' marks is the same. Since HONEY and FIG are both words for

food products, the addition of the word FIG to HONEY to form the Mark does not create any significant differences between the parties' marks.

[42] I disagree with the Opponent that the word HONEY in the Mark is unique or striking. This is a common dictionary word, which I find could be suggestive of some of the associated wares and services (e.g. as an ingredient in cosmetics). I do not find that the inclusion of the word HONEY in the Mark is sufficient to find any significant degree of similarity between the parties' marks by virtue of the fact that I find that neither of the elements HONEY or FIG are particularly unique or striking.

[43] Having reviewed the evidence of record and the parties' submissions, ultimately, I find that the addition of the word FIG which renders the Mark a coined word, and the addition of the design features in the Mark, while minor, are instrumental in creating differences between the parties' marks in terms of appearance, sound and idea suggested.

#### *Additional Surrounding Circumstance – Average Consumer*

[44] At the oral hearing, the Opponent relied on *Mattel* in support of its submission that the average consumer for wares and services of the type covered by the parties' marks in the present case is generally running behind schedule and not paying a lot of attention to the details.

[45] While I agree with the Opponent as to the nature of the average consumer of the parties' wares and services, I do not agree with the Opponent that this increases the likelihood of confusion between the parties' marks. This is merely the standard test for confusion.

#### *Conclusion*

[46] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. While, I acknowledge that there is some degree of similarity between the parties' wares and services by virtue of the fact that the Opponent's registrations claim wares which are similar to some of those claimed to be sold through the Services, I note that, as mentioned previously the degree of resemblance is often considered to be the statutory factor that is likely to have the greatest effect on the confusion analysis. As pointed out above, I have found that when considered as a whole, there are differences between the parties' marks which prevent

me from finding that the parties' marks are very similar in sound, appearance, and ideas suggested.

[47] As a result, and considering 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 the Opponent's HONEY Marks.

[48] I note that I may have found differently had the Opponent provided evidence of a reputation for the Opponent's HONEY Marks, particularly in association with the Opponent's cosmetics wares.

[49] Having regard to the foregoing, the ground of opposition based on section 12(1)(d) is dismissed.

#### Non-entitlement Grounds of Opposition

##### *Section 16(1)(a) of the Act*

[50] Despite the onus of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's HONEY Marks, the Opponent has the initial onus of proving that one or more of the trade-marks alleged in support of its ground of opposition based on section 16(1) of the Act was used in Canada prior to the claimed date of first use (June 30, 2006) and had not been abandoned at the date of advertisement of the application for the Mark (March 10, 2010) [section 16(5) of the Act].

[51] The Opponent has not filed any evidence showing use of its HONEY Marks. Moreover, any reference to use in the Opponent's registrations is not sufficient to satisfy the Opponent's evidential burden under section 16(1)(a) of the Act [see *Rooxs, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB)].

[52] Based on the foregoing, the Opponent has failed to meet its evidential burden under section 16(1)(a) of the Act and this ground of opposition is dismissed accordingly.

*Section 16(1)(b) of the Act*

[53] Despite the burden of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's HONEY Marks, the Opponent has the initial onus of proving that the applications for the trademarks alleged in support of its ground of opposition based on section 16(1)(b) of the Act were pending at the claimed date of first use for the Mark, June 30, 2006, and remained pending at the date of advertisement of the application for the Mark, March 10, 2010 [section 16(5) of the Act].

[54] The Registrar has the discretion, in view of the public interest, to check the register for applications relied upon by an opponent [see *Royal Appliance Mfg Co v Iona Appliance Inc* (1990), 32 CPR (3d) 525 (TMOB)]. I have exercised my discretion to check the status of the applications for the Opponent's HONEY Marks. Despite the fact that the Opponent's HONEY Marks have since matured to registration, the applications were filed prior to the material date and remained pending at the advertisement date and thus the Opponent has met its evidential burden with respect to this ground of opposition.

[55] The difference in material dates is not significant and as a result my findings under the section 12(1)(d) ground of opposition are equally applicable here. As a result, 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 the Opponent's HONEY Marks and thus, the ground of opposition based on section 16(1)(b) of the Act is also dismissed.

Non-distinctiveness Ground of Opposition – Section 38(2)(d) of the Act

[56] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its Services from those of others throughout Canada [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd.* (1985), 4 CPR (3d) 272 (TMOB)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness.

[57] Pursuant to its evidential burden, the Opponent is under an obligation to show that, as of the filing of the statement of opposition, one or more of its HONEY Marks had become known

sufficiently to negate the distinctiveness of the Mark [see *Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FC)].

[58] As the Opponent has failed to provide any evidence of use or reputation for the HONEY Marks the Opponent has failed to meet its evidential burden and this ground of opposition is dismissed.

#### Disposition

[59] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

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Andrea Flewelling  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office