



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

Citation: 2013 TMOB 63
Date of Decision: 2013-03-26

IN THE MATTER OF AN OPPOSITION
by Gemological Institute of America, Inc.
to application No. 1,348,637 for the trade-
mark GHI GEMOLOGY
HEADQUARTERS INTERNATIONAL
& Design in the name of Gemology
Headquarters International, LLC

[1] On May 24, 2007, Gemology Headquarters International, LLC (the Applicant) filed an application to register the trade-mark GHI GEMOLOGY HEADQUARTERS INTERNATIONAL & Design (the Mark), as shown below:



Colour is claimed as a feature of the trade-mark. The color(s) blue and grey are claimed as a feature of the mark. The mark consists of stylized letters 'GHI', with the 'G' appearing in blue and the 'H' appearing in grey with an image of a white diamond outlined in blue and with the facets indicated in blue lines superimposed in the middle of the 'H', and the 'I' appearing in blue and grey with the dot of the 'i' appearing in blue and the base of the 'i' appearing in grey. Underneath the 'GHI', are the words 'GEMOLOGY HEADQUARTERS' are shown in grey, and underneath that, the word 'INTERNATIONAL' in blue.

[2] The application is based on proposed use of the Mark in Canada in association with the following wares and services:

wares: certificates of authenticity of diamonds, gemstones, pearls and jewellery; certificates of grading of diamonds, gemstones, pearls and jewellery; gemological instruments, namely, Chelsea and colour filters, dichoscopes, electronic metal testers, electronic scales, fluorescence lamps, geiger counters, gravity liquids used to test specific gravity (ratio of an object weighted first in air and then in liquid) of gem stones, infrared reflectance meters, lens, diamond and Leveridge gauges, long wave and short wave UV lights, loupes, mag lights, master colored grading sets comprised of a set of stones (such as various grades of cubic zirconium or diamonds) used for accuracy of color grading of gem stones and diamond analysis including evaluating color, fluorescence and revealing fractures and other flaws in gem stones and diamonds, microscopes, optical fiber lamps, polariscopes, quartz-mercury lamps, refractometers, spectroscopes, tweezers, ultraviolet cabinets, and x-ray machines; jewellery boxes; jewellery displays.

services: gemology services, namely, providing identification, authentication, and grading of diamonds, gemstones, pearls and jewellery and issuing certificates related to such services; inscriptions on diamonds, gemstones, pearls and jewellery; precious metal assaying; educational services regarding gemology; appraisals of diamonds, gemstones, pearls and jewellery.

[3] The application is also based on use and registration of the Mark in the United States of America in association with the following wares and services:

wares: printed certificates of authenticity of diamonds, gemstones, pearls and jewelry; printed certificates of grading of diamonds, gemstones, pearls and jewelry.

services: gemology services, namely, providing identification, authentication, and grading of diamonds, gemstones, pearls and jewellery and issuing electronic and paper certificates relating to such services; precious metal assaying.

[4] The application was advertised for opposition purposes in the *Trade-marks Journal* of June 10, 2009.

[5] On November 10, 2009, Gemological Institute of America, Inc. (the Opponent) filed a statement of opposition against the application. The Applicant filed and served a counter statement denying the Opponent's allegations.

[6] Pursuant to section 41 of the *Trade-marks Regulations*, SOR/96-195 (the Regulations), the Opponent filed as evidence in chief affidavits of Susan Johnson (the Opponent's Director of

Education Administration), Susan Petrich (the Opponent's Director of Marketing Operations) and Sabra Norris (the Opponent's Global Director of Financial Planning & Operational Analysis).

[7] Pursuant to section 42 of the Regulations, the Applicant filed certified copies of various Canadian and U.S. trade-mark registrations/applications plus an affidavit of Nachum Krasnianski (the Applicant's President). I agree with the Opponent that Exhibit Z to the Krasnianski affidavit, "a copy of an Expert report of Carole E. Chaski, PhD", is inadmissible hearsay evidence.

[8] Pursuant to section 43 of the Regulations, the Opponent filed evidence in reply, namely an affidavit of Robert M. Frank (President and Founder of Illuminor LLC). The admissibility of this reply evidence is discussed later.

[9] No cross-examinations were conducted.

[10] Both parties filed a written argument and participated in an oral hearing.

Grounds of Opposition/Material Dates/Onus

[11] The Opponent has pleaded grounds of opposition pursuant to sections 38(2)(b)/12(1)(d), 38(2)(c)/16(2)/16(3) and 38(2)(d)/2 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[12] The material date for assessing each ground of opposition varies as follows: section 38(2)(b) ground - today's date [*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) ground – May 24, 2007 [section 16(2) and (3)]; section 38(2)(d) ground – November 10, 2009 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[13] 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].

[14] Each of the grounds of opposition is based on the likelihood of confusion between the Mark and a trade-mark or trade-name owned by the Opponent. In its written argument, the Opponent has defined its registered trade-marks plus its trade-name GIA collectively as the “GIA Marks”. The confusion analysis provided by the Opponent in its written argument addresses the likelihood of confusion between the Mark and the GIA Marks. However, as indicated in *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) at pages 374-375, each trade-mark or trade-name relied upon by the Opponent must be the subject of a separate confusion analysis. At paragraph 47, the Supreme Court stated that the trial judge erred when, “instead of undertaking a separate resemblance analysis comparing each of Masterpiece Inc.’s marks and trade-name with Alavida’s mark, the trial judge undertook a single composite analysis.”

[15] The Opponent’s case regarding confusion is strongest under the section 38(2)(b)/12(1)(d) ground of opposition because its later material date allows all of the Opponent’s evidence concerning its reputation to be considered. Therefore, if the Opponent is not successful under section 38(2)(b), then it will not be successful under either section 38(2)(c) or (d).

Section 38(2)(b)/12(1)(d) Ground of Opposition

[16] The Opponent has pleaded that the Mark is not registrable pursuant to section 12(1)(d) of the Act because it is confusing with the following trade-marks that have been registered by the Opponent:

1. GIA - registration No. TMA268,985
2. GIA - registration No. TMA561,195
3. GIA - registration No. TMA583,034
4. GIA - registration No. TMA564,243
5. GTL - registration No. TMA572,882

6. GEMOLOGICAL INSTITUTE OF AMERICA –
registration No. TMA579,440
7. GIA GEMOLOGICAL INSTITUTE OF AMERICA & Design –
registration No. TMA596,705



8. GIA GEM TRADE LABORATORY & Design –
registration No. TMA561,012



[17] As each of the above registrations is extant, the Opponent has met its initial burden under section 12(1)(d).

[18] At the oral hearing, the Opponent took the position that the key common element between the Mark and any of the Opponent's marks is the string of three letters. Therefore I will assess the likelihood of confusion between the Mark and GIA. Since GIA has a greater degree of resemblance to the Mark than do the other registered marks, the Opponent's GIA mark presents its strongest case. If the Opponent is not successful based on GIA, then it will not be successful based on any of its other marks.

[19] As noted by the Opponent at the oral hearing, I held in a separate opposition decision that GIA and GHI were not confusing [*Gemological Institute of America, Inc v Gemology Headquarters International, LLC*, 2012 TMOB 171]. The Opponent expressed the view that the present opposition could not succeed in the face of my earlier decision if the evidence is identical, but noted that the Frank and Krasnianski affidavits were not of record in the earlier decision.

[20] I agree with the Opponent that my earlier decision is not decisive of the present proceeding, but for a number of reasons, such as that the applied for marks differ, the evidence differs and the material dates differ. There are however some overlapping issues.

[21] 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. Section 6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source.

[22] The test for confusion is one of first impression and imperfect recollection. 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), *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC) and *Masterpiece*.]

inherent distinctiveness of the marks

[23] Trade-marks consisting only of letters lack inherent distinctiveness and are therefore characterized as weak marks [*GSW Ltd v Great West Steel Industries Ltd et al* (1975), 22 CPR (2d) 154 (FCTD)]. Accordingly, GIA is an inherently weak mark.

[24] The Mark has a greater degree of inherent distinctiveness because it does not consist solely of letters, but includes words and various design features.

the extent to which each mark has become known

[25] A mark's distinctiveness can be enhanced through use and promotion.

[26] There is no evidence that the Mark has been promoted in Canada and the only evidence of use of the Mark in Canada is with respect to a book entitled “Laboratory grown Diamonds”, which Mr. Krasnianski states has been available since December 2007. Given that the volume of books sold has not been provided, and bearing in mind that books are not included in the application’s statement of wares, I find that the Mark has not become known in Canada to any significant extent.

[27] There is evidence that GIA has been used and promoted in Canada, either alone or as the dominant element in composite marks, as detailed further below. Before proceeding, I will mention that use of the design marks registered under Nos. TMA596,705 and TMA561,012 also qualifies as use of GIA [see *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 at 538-9].

[28] The Opponent is a non-profit institution that is involved in education, research, laboratory services and instrument development, all with respect to the gems and jewelry trade. I summarize below the key evidence provided by the Opponent’s evidence in chief regarding the extent of the Opponent’s use and promotion of the GIA mark in Canada:

- As part of its laboratory services, the Opponent issues Diamond Grading Reports, Diamond Dossiers, and Gemological Identification Reports, samples of which are provided as Exhibits 4 and 5 to the Norris affidavit. GIA is the dominant element on the reports. In the years 2004 to 2009, the annual number of reports invoiced to Canada varied annually from 1,126 to 2,858. Ms. Norris also provides “[t]he revenue that was generated from the reports, by customers in Canada”; it ranged annually from \$112,665 to \$275,198 US. [paragraph 9, Norris affidavit]
- Ms. Norris attests at paragraph 12 that the Opponent publishes brochures designed to help members of the public understand the diamond grading system. Exhibit 7 is a representative brochure, which displays GIA; Ms. Norris attests that it is available online to residents in Canada, but she provides no evidence that any Canadians have viewed or requested such brochure.

- Ms. Petrich attests that the Opponent advertises its wares and services in a variety of forms, such as in magazines, by direct mailing of postcards and brochures, and on its website. In particular, she discusses ads placed in trade publications that she says have subscribers in Canada. She attests that the Opponent advertised in the Canadian publications *Jewellery Business* (seven times per annum in 2006, 2007 and 2008) and *Canadian Jeweller* (in 2008 and seven times per annum in 2004, 2005 and 2006), as well as in two U.S. publications in 2006 that are available in Canada, namely *JCK* and *Modern Jeweler*. Ms. Petrich says that *Jewellery Business* is described as having over 8,000 subscribers and *Canadian Jeweller* is reported as having more than 10,000 subscribers. The Applicant submits that these figures should be given very little weight in the absence of independent verification from an audit enterprise. I agree that attributing them reduced weight is appropriate, but in view of the fact that Ms. Petrich was not cross-examined and given the nature of her position with the Applicant, I have accorded some weight to them. Copies of advertisements have been provided as Exhibits 3, 6 and 8. In addition copies of articles that refer to GIA have been provided.
- Ms. Petrich has provided copies of representative promotional pieces displaying the GIA mark that have been sent to Canadians [Exhibit 9]; between 2003 and 2008 the number of promotional pieces mailed annually to Canadian addresses varied from 1335 to 5584 (it is unknown to what extent the mailing lists differed from year to year).
- The Opponent promotes its educational services, instruments, and publications by participating in international trade shows, including a trade show in Vancouver in 2009 and in Toronto in 2010, but attendance figures have not been provided [paragraph 14 and Exhibit 10, Petrich affidavit].
- The Opponent publishes a quarterly journal entitled *Gems & Gemology* that displays the GIA mark in each issue; in each of the years 2003 through 2008 there were more than 200 subscribers to the journal who had Canadian mailing addresses [paragraphs 16-19, Exhibits 11 and 12, Petrich affidavit].
- The Opponent also publishes a quarterly newsletter entitled *The Loupe* that displays the GIA mark in each issue; although Ms. Petrich states at paragraph 20 that it is distributed

throughout the world, including to Canadian residents, only worldwide distribution figures have been provided.

- In addition, the Opponent publishes a bi-weekly electronic bulletin entitled *GIA Insider* which displays the GIA mark; it is stated to be available worldwide, including in Canada, but no viewership figures are provided [paragraph 22, Petrich affidavit].
- The Opponent publishes textbooks in the field of gemology and Ms. Petrich says that these are available to Canadians both through Canadian booksellers and by orders placed directly with the Opponent; Ms. Petrich's Exhibit 17 indicates that there have been small sales of books (e.g. 1 in 2003 and at least 11 in 2008) but it is has not been shown how any of the Opponent's marks have been used in association with the books.
- In the years 2003 through 2008, the Opponent annually sold between 221 and 466 "publications, instruments and other merchandise" directly to Canadian residents [paragraphs 25 and 26, Petrich affidavit]. Specimens have not been provided but Ms. Petrich's Exhibit 17 is a chart that provides details of the sales including invoice date, item category and quantity, as well as the "logo type" displayed on each of the specific items. The "logo types" suggest that the GIA mark might have been used in association with such wares.
- The Opponent does not have a campus in Canada, but the Opponent's distance education courses have been available to residents in Canada since at least as early as 1969; the number of Canadian residents enrolled in distance education courses between 2003 and 2008 varied annually from 307 to 470. In order to complete a program, individuals must attend and complete required laboratory classes in addition to their distance education courses; the number of individuals who attended laboratory classes provided by the Opponent in Canada between 2003 and 2008 varied annually from 91 to 153. Various materials displaying the GIA mark are sent to Canadian residents who either express an interest in or are enrolled in the Opponent's distance education programs. [paragraphs 6 - 13, Johnson affidavit]

[29] Based on the foregoing summary, I find that the Opponent's GIA trade-mark is currently known in Canada. Moreover, it is clearly more known than is the Mark; the Opponent's GIA mark has acquired some distinctiveness whereas the Mark has not. I note however that in most instances, the Opponent's name Gemological Institute of America appears in close proximity to GIA, indicating to the viewer that GIA is an abbreviation for Gemological Institute of America.

[30] Before proceeding, I will note that the Opponent's reputation and use in other countries are not relevant in this proceeding. Also, in regard to Ms. Norris' evidence, I will add that copies of third party websites are only evidence that such a page existed at the time that it was printed – they are not evidence of the truth of their contents [*Candrug Health Solutions Inc v Thorkelson* (2007), 60 CPR (4th) 35 (FCTD)] and that self-serving statements by a party's executive do not have significant probative value [*Molson Breweries, A Partnership v John Labatt Ltd* (2000), 5 CPR (4th) 180 (FCA) at para 58].

[31] As alluded to earlier, the Opponent relies on certain evidence that is present in this proceeding that was absent in the earlier cited proceeding to distinguish the cases. In particular, the Opponent is relying on the Frank affidavit which it says provides evidence that the Opponent's marks have actually acquired distinctiveness in Canada. I note that in my earlier decision I did not say that the GIA mark had not acquired any distinctiveness in Canada; I did however say that based on the figures provided I could not conclude that the GIA mark was well known in Canada. The question therefore becomes whether the additional evidence in the present proceeding leads to a conclusion that the GIA mark is well known in Canada and, if so, whether this greater notoriety results in the Mark being confusing with GIA.

[32] Mr. Frank says that his company "specializes in research, consulting and expert witness testimony with respect to trade-mark infringement matters." Mr. Frank's evidence concerns i) the media exposure of the Mark in Canada, ii) the media exposure of GIA in Canada, and iii) the use of certain three-letter acronyms by third parties in Canada.

[33] The Applicant has submitted that the Frank affidavit is improper reply evidence to the extent that it relates to the relative media exposure levels of the two marks at issue; in particular, it submits that Mr. Frank's evidence regarding the Opponent's reputation is more logically connected to the promotional materials and activities of the Opponent described in the Petrich

affidavit and should have been submitted as evidence in chief, not as reply. I agree with the Applicant that Mr. Frank's evidence of articles referring to GIA serves to bolster the Opponent's evidence in chief rather than to reply to Mr. Krasnianski's evidence. I am therefore disregarding such evidence.

[34] I see no need to deal with Mr. Frank's evidence that the Mark does not have any media recognition or exposure in Canada given that I have already concluded that the Mark has not acquired any distinctiveness in Canada.

[35] I will address Mr. Frank's evidence regarding third party acronyms under my discussion of other surrounding circumstances; such evidence does reply to evidence introduced by the Applicant.

[36] The Opponent also submits that Mr. Krasnianski has introduced some evidence that distinguishes the present case from the earlier one. It points to pages from the website *www.idexonline.com* that Mr. Krasnianski has provided as Exhibit Y, namely a 16 page article entitled *Diamond Grading Labs: Different Strokes for Different Folks* dated July 14, 2008. Mr. Krasnianski states that according to this article: "...the top six diamond grading labs controlled 78 percent of the world diamond grading industry. When diamonds without certificates were removed, the same six controlled 99.7 percent of the industry. The top six diamond grading labs in the world were identified as GIA, AGS, HRD, EGL International, EGL USA and IGI."

[37] The Opponent characterizes the reference to the IDEX article as an admission by the Applicant of the Opponent's reputation. However, I will not discuss that matter further as the article addresses the world, without any specific reference to Canada; as stated earlier, the Opponent's reputation outside of Canada is not relevant in the present proceeding.

the length of time the marks have been in use

[38] The Opponent's registration claims use of GIA in Canada since as early as 1969 but its affiants have only provided details concerning the use of GIA in Canada from 2003. The Applicant has not evidenced that it has commenced use of its Mark in Canada in association with

any of the applied for wares or services since it filed its proposed use application in 2007. Accordingly, the length of time the marks have been in use in Canada favours the Opponent.

the nature of the wares, services, business and trade

[39] When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark application and registrations that govern in respect of the issue of confusion arising under section 12(1)(d) [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe, Inc v Dale Bohna* (1984), 58 CPR (3d) 381 (FCA)].

[40] The wares and services covered by the Opponent's four registrations for the trade-mark GIA are as follows:

- registration No. TMA268,985
services: Educational services, namely courses in gemology.
- registration No. TMA564,243
wares: (1) Pre-recorded videotapes, CD-ROMs, and audiotapes featuring educational materials in the field of gemology and telephonic and digital transmitters of information in the field of gemology. (2) Paper articles, cardboard articles and printed matter, namely, magazines, journals and newsletters in the field of gemology, books in the field of gemology, instructional and teaching materials in the field of gemology, reference materials, namely, manuals, handbooks, printed charts and printed tables, all in the field of gemology, testing materials, namely, test booklets, score sheets and answer sheets, unmounted photographs, stationery, note paper, printed diplomas, posters, gemological grading reports and cardboard.
services: Mail order catalog services and computerized on-line ordering services for purchasing products in the field of gemology.
- registration No. TMA561,195
services: Gemological services, namely, grading precious gems and registering precious gems.

- registration No. TMA583,034

wares: Scientific instruments and apparatus, namely microscopes, measuring instruments, scales, refractometers, lamps, tubes, filters, colour testing equipment, colour comparators, ultraviolet and fluorescent testing equipment, photo-optical instruments, spectrosopes, grading equipment, and portable gemological instruments, namely, microscopes, refractometers, polariscopes, spectrosopes, dichrosopes, loupes, dial gages, lights; scientific instruments and apparatus for examining, testing, evaluating and appraising gems, pearls and jewellery; computer software for data carriers featuring educational materials; pre-recorded videotapes, CD-Roms and audiotapes featuring educational materials (the CD-Roms are not computer software); transmitters and reproducers of sound, images, or data namely telephonic and digital transmitters of information in the field of gemology, pearls, and jewellery; jewellery, jewellery boxes, jewellery cases, pearls, gems, gem replicas, gem boxes, gem cases, beads, pins, lapel pins, rings, ring strands; clothing namely jackets, windbreakers, sweaters, pants, shorts, skirts, sweat shirts, sweat pants, shirts, tee-shirts, socks, accessories, and hats, including canvas caps and baseball caps.

[41] The parties are in agreement that their respective wares, services, business and trade are the same or overlap [paragraphs 77-79 of Opponent's written argument and paragraphs 76-77 of Applicant's written argument].

the degree of resemblance between the marks

[42] I will begin by reiterating that I am disregarding Exhibit Z to the Krasnianski affidavit, which is "a copy of the Expert report of Carole E. Chaski, PhD prepared on behalf of the Applicant in respect of the lack of linguistic similarities of the [Mark] or GHI and representative trade-marks of the Opponent." There is no need for expert evidence on this point [*Masterpiece* at paras 90-92] and if there was then the fact that Dr. Chaski did not provide her own affidavit, and therefore was sheltered from cross-examination, would make her evidence inadmissible hearsay.

[43] The resemblance between the marks in appearance, sound and ideas suggested is due to the fact that both incorporate a string of three letters that begins with G. As discussed earlier, I have already held that the degree of resemblance between GIA and GHI is insufficient to result in a likelihood of confusion [see paras 30-31 of *Gemological Institute of America, Inc*]. In any event, the Mark that is the subject of the present application bears less resemblance to GIA than did GHI. When seen and when pronounced the Mark is very different from GIA because it

includes the words GEMOLOGY HEADQUARTERS INTERNATIONAL. The inclusion of these words also results in the Mark suggesting a very different idea since GIA on its own has no meaning whereas it is clear from the Mark that GHI stands for Gemology Headquarters International.

[44] Overall, the differences between the marks are far greater than their similarities.

other surrounding circumstances

[45] A number of other surrounding circumstances have been raised by the parties.

[46] Mr. Krasnianski has provided evidence that the Mark and the Opponent's marks coexist on registers abroad, and that the Opponent's marks have coexisted with various third party marks abroad. None of this is relevant to the issue of whether confusion is likely in Canada [see *Vivat Holdings Ltd v Levi Strauss & Co* (2005), 41 CPR (4th) 8 (FC)].

[47] The Applicant filed certified copies of some third party Canadian trade-mark registrations but did not present any argument based on such evidence. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located. [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Del Monte Corporation v Welch Foods Inc* (1992), 44 CPR (3d) 205 (FCTD); *Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)]

[48] The Opponent's position is that the Applicant's evidence regarding third party marks is irrelevant; not only are there insufficient relevant registered marks to draw any meaningful conclusion about the state of the marketplace, but Mr. Frank's evidence establishes that "none of the 24 acronyms set out in paragraphs 48 and 52 of the Krasnianski Affidavit provide a three-letter acronym beginning with 'G' that is used in Canada."

[49] I agree that the evidence of third party marks is not a significant surrounding circumstance in this case.

conclusion re section 12(1)(d) ground

[50] Having considered all of the surrounding circumstances, I have concluded that, on a balance of probabilities, there is not a reasonable likelihood of confusion between the marks at issue. While it is true that the majority of the circumstances listed under section 6(5) favour the Opponent, it is the degree of resemblance between the trade-marks that is the most crucial factor in determining the issue of confusion [*Masterpiece; Beverley Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2d) 145 (FCTD) at 149, affirmed 60 CPR (2d) 70]. Here, the differences are more than sufficient to distinguish the marks and to make confusion unlikely.

[51] For the foregoing reasons, the section 12(1)(d) ground of opposition is dismissed in its entirety.

[52] I note that had I considered Mr. Frank's evidence regarding the media exposure of GIA in Canada, it would not have changed the outcome of this proceeding. Although it might lead to a conclusion that GIA has an increased degree of acquired distinctiveness, the extra weight accorded to this circumstance would not be sufficient to overcome the significant differences between the parties' marks. I also note that the additional articles provided by Mr. Frank largely refer to GIA as an abbreviation of Gemological Institute of America, with the result that these articles might actually serve to emphasize that the competing marks indicate different sources of wares/services.

Other Grounds of Opposition

[53] As indicated earlier, the section 12(1)(d) ground presented the Opponent's strongest case. Therefore the remaining grounds fail for reasons similar to those set out with respect to the section 12(1)(d) ground.

Disposition

[54] 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.

Jill W. Bradbury
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office