

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

Citation: 2011 TMOB 100
Date of Decision: 2011-06-25

**IN THE MATTER OF AN OPPOSITION
by Reitmans (Canada) Limited to
application No. 1,252,795 for the trade-
mark THYMES and Design in the name
of The Thymes, Limited**

[1] On March 30, 2005, The Thymes, Limited (the Applicant), filed an application to register the trade-mark THYMES and Design (the Mark), shown below, based upon proposed use of the mark in Canada.



[2] The statement of wares currently reads:

Skin soap; hair and body shampoo; non-medicated bath preparations, namely, liquid soap, bath conditioner, gels salts and body scrubs; body creme; body powder; body oil; body lotion; sachets; perfume; eau de toilette; aerosol room scenting sprays; and candles.

[3] The application is also based upon use and registration of the Mark in association with the same wares in the United States of America and claims a convention priority filing date of March 7, 2005, based upon the corresponding U.S. application No. 78/582,007.

[4] The application was advertised for opposition purposes in the *Trade-marks Journal* of May 7, 2008.

[5] On June 23, 2008, Reitmans (Canada) Limited (the Opponent) filed a statement of opposition against the application. The grounds of opposition are that the Applicant's application does not conform to the requirements of s. 30(d), s. 30(e) and s. 30(i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), the Mark is not registrable pursuant to s. 12(1)(d), the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(2)(a), s. 16(2)(c), s. 16(3)(a), s. 16(3)(c) and the Mark is not distinctive. Each of the final six grounds is based on confusion with the Opponent's trade-mark THYME MATERNITY, which is the subject of the applications and registrations set out in the attached Schedule A, as well as the Opponent's THYME trade-names.

[6] The Applicant filed and served a counter statement, in which it denied the Opponent's allegations.

[7] The Opponent's evidence consists of certified copies of the Opponent's Canadian trade-mark registrations and applications, the affidavit of Ms. Kim Schumpert and the affidavit of Ms. Angelika Liapis. The Applicant's evidence consists of the affidavit of Mr. Sanjukta Tole.

[8] None of the affiants were cross-examined.

[9] Both the Applicant and the Opponent filed a written argument. An oral hearing was conducted at which both parties were represented. At the oral hearing, the Opponent withdrew the grounds of opposition based on s. 30(e) and s. 30(i) of the Act.

Onus and Material Dates

[10] 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 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

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

- s. 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- s. 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 C.P.R. (3d) 413 (F.C.A.)];
- s. 16(2) - the Applicant's convention priority date [see s. 16(2)];
- s. 16(3) - the Applicant's convention priority date [see s. 16(3)];
- non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Preliminary Issues

Admissibility of the Tole Affidavit

[12] Mr. Tole identifies himself as a lawyer employed by the Applicant's agent law firm. Attached to his affidavit are print-outs from the Applicant's website *www.thymes.com*,

particulars of eight U.S. trade-mark registrations owned by the Applicant which include the word THYME, particulars of one pending U.S. application and one U.S. trade-mark registration owned by the Opponent that include the word THYME, particulars of three third party Canadian registrations containing the word THYME and a definition of the word THYME taken from the Concise Oxford Dictionary of Current English.

[13] Relying on the decision in *Cross Canada Auto Body Supply (Windsor) Limited v. Hyundai Auto Canada* (2005) F.C. 1254 [*Cross Canada*], the Opponent's agent submitted that the affidavit should not be admissible because it was sworn by a lawyer employed by the Applicant's agent, and attached pages of the Applicant's website. The Opponent's agent also argued that the entire evidence of Mr. Tole consists of hearsay or documents which are not within the personal knowledge of the Applicant.

[14] The Applicant's agent responded that the present case can be distinguished from the decision in *Cross Canada* because the affidavit of Mr. Tole does not contain any opinion evidence about a contentious issue. As for the hearsay objection, the Applicant's agent argued that the exhibits attached to Mr. Tole's affidavit are both necessary and reliable. In this regard, the Applicant's agent submitted that most of the documents come from websites maintained by an official body. As for the documents from the Applicant's website, the Applicant's agent argued that they should be admissible because the Opponent's own affiant, Ms. Schumbert, also attached the same pages to her affidavit.

[15] I agree with the Applicant's agent that the present case can be distinguished from the decision in *Cross Canada* for the reasons the Applicant's agent noted. I also agree that the U.S. registrations and applications attached to the Tole affidavit are reliable. As for the pages from the Applicant's website, I am only prepared to find that the evidence shows that the website existed at the date of Mr. Tole's affidavit, and does not prove the truth of the contents of such website [see *Envirodrive Inc. v. 836442 Canada Inc.* 2005 ABQB 446; *ITV Technologies Inc. v. WIC Television Ltd.* 2003 F.C. 1056].

Sufficiency of the grounds as pleaded

[16] I have concerns whether several of the grounds of opposition, as pleaded, include various registrations of the Opponent.

[17] The affidavit of Kim Schumbert, President of Thyme Maternity Division, provides information about the Opponent and its use of what she refers to as the THYME trade-marks. At paragraph 11 of her affidavit, she lists 13 trade-mark registrations owned by the Opponent that incorporate the word THYME, nine of which include skincare products in the list of wares. At paragraph 13 of her affidavit she lists four trade-mark applications owned by the Opponent that incorporate the word THYME, all of which also include skincare products. In its written argument, the Opponent refers to all of these marks collectively as the THYME marks.

[18] Under the s. 12(1)(d) ground of opposition, the Opponent alleges that the Mark is confusing with only five of the registered marks identified by Ms. Schumbert. The Opponent's s. 16(2)(a) and s. 16(3)(a) grounds are only based on the Opponent's four THYME applications. The Opponent's s. 16(2)(c) and s. 16(3)(c) grounds are based on confusion with the Opponent's THYME, THYME MATERNITY and THYME MATERNITÉ trade-names. The s. 38(2)(d) ground is based on confusion with the trade-marks identified in the statement of opposition.

[19] At the oral hearing, I brought the discrepancy between the statement of opposition as pleaded and the Opponent's written argument to the Opponent's attention. The Opponent replied by requesting leave to amend its statement of opposition to include all of its registered marks. In the alternative, the Opponent argued that, in view of the evidence filed, the Opponent's pleadings should include all of the Opponent's registrations.

[20] The Applicant objected to the Opponent's request for leave to file an amended statement of opposition.

[21] By letter dated May 10, 2011, the Opponent's agent again requested leave to file an amended statement of opposition to include all of its registered marks, and enclosed the statement of opposition as amended with his letter.

[22] Having considered both parties' submissions, I agree with the Applicant that it is not in the interests of justice to grant the Opponent leave at this late stage of the proceedings to amend its statement of opposition. The Opponent's request is therefore denied.

[23] With respect to the Opponent's submission that I should still consider the Opponent's pleadings to include all of its registrations in view of the evidence filed, I am also not prepared to do so for the following reasons. Section 38(3)(a) of the Act states as follows:

38(3) A statement of opposition shall set out

(a) the grounds of opposition in sufficient detail to enable the applicant to reply thereto

[24] In *Carling Breweries Ltd. v. Molson Companies Ltd.* (1984), 1 C.P.R. (3d) 191 (F.C.T.D.); affirmed (1988), 19 C.P.R. (3d) 129 (F.C.A.), Strayer J. stated the following at p. 194 after referring to the above-noted provision (which was s. 37(3)(a) at the time):

It is an elementary condition of fairness that each party be adequately informed of the case it has to meet.

[25] On the other hand, in *Novopharm Ltd. v. AstraZeneca AB et al.* (2002), 21 C.P.R. (4th) 289 (F.C.A.), the Federal Court of Appeal held that the sufficiency of pleadings should be assessed having reference to any evidence of record.

[26] The issue therefore, is whether the Opponent's pleadings, in conjunction with the evidence filed, made it evident that the Opponent was relying on each of its 13 registered marks. I conclude that it did not. While the Opponent did file registered copies of each of its registrations in evidence, in my view, it was not reasonable to expect the Applicant to assume from such evidence that the Opponent therefore intended to rely on all of its registered marks for each of its grounds as opposed to only those registrations that were pleaded in its statement of opposition. In fact, in its written argument, the Applicant made reference only to those of the Opponent's marks which were pleaded in its statement of opposition. In my view, the statement of opposition in the present case cannot be broadened by the evidence because of the prejudice to the Applicant in not having been made fully aware of the case it had to meet. This is not a case

where there was any ambiguity in the pleadings. I will therefore consider the grounds (and registrations relied upon) as pleaded in the statement of opposition.

Section 30(d) Ground of Opposition

[27] The Opponent's s.30(d) ground of opposition was pleaded as follows:

“the Application does not conform to the requirements of s. 30(d) of the Act as the Applicant, or its predecessor-in-title, did not register and use the Mark in the United States of America in relation with each [of] the wares described in the Application at the alleged dates of registration or use, or at any relevant time or, alternatively, has abandoned same by way of non-continuous use in the United States of America.”

[28] While the legal onus is upon an applicant to show that its application complies with s.30(d) of the Act, there is an initial evidential burden on the opponent in respect of this ground [see *Joseph E. Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 (T.M.O.B.)]. The amount of evidence required to discharge this evidential burden, however, may be very slight [see *Canadian Council of Professional Engineers v. 407736 Ontario Corp.* (1987), 15 C.P.R. (3d) 551 (T.M.O.B.)]. Further, an opponent can rely on the applicant's evidence [see *Tune Masters v. Mr. P.'s Mastertune Ignition Services* (1986), 10 C.P.R. (3d) 84 at 89].

[29] Section 30(d) provides as follows:

30. An applicant for the registration of a trade-mark shall file with the Registrar an application containing

(d) in the case of a trade-mark that is the subject in or for another country of the Union of a registration or an application for registration by the applicant or the applicant's named predecessor in title on which the applicant bases the applicant's right to registration, particulars of the application or registration and, if the trade-mark has neither been used in Canada nor made known in Canada, the name of a country in which the trade-mark has been used by the applicant and the applicant's named predecessor in title, if any, in association with each of the general classes of wares or services described in the application.

[30] In the present case, the Opponent points to the Applicant's evidence to support its contention that the Applicant has not used its trade-mark in the U.S. as claimed. In this regard, the Opponent submitted for the first time at the oral hearing that the particulars of the

Applicant's U.S. registration attached as Exhibit B to the Tole affidavit, notes a first use of "20050712" and a first use in commerce of "20050712" for all of the applied for wares except candles. For candles, the first use was "20050701" and the first use in commerce was "20050701".

[31] The Opponent submits that these dates contradict the Applicant's claim to use of its Mark in the U.S. as of the Applicant's filing date in Canada (i.e. March 30, 2005). I agree. The onus is therefore on the Applicant to show use of its Mark in the U.S. at the filing date of the application in Canada.

[32] At the oral hearing, the Applicant's agent submitted its own explanation about the possible discrepancy between the dates of first use as they appear on the U.S. registration and the date of first use as claimed. He argued that when an application is based on use in the U.S., one needs to file specimens of use. The United States Patent and Trade-mark Office bases the use claim on the dates of first use as shown in the specimens. However, there is no evidence of record to support such submissions.

[33] Subsequent to the oral hearing, the Applicant's agent requested leave to file further written submissions on this issue, and attached a copy of the Canadian application for the Mark. The Opponent promptly objected to this request for leave by way of letter dated April 20, 2011. On April 29, 2011, after considering both parties' submissions, I granted the Applicant leave to file its additional written arguments regarding the Opponent's s. 30(d) ground of opposition pursuant to Rule 46(2) of the *Trade-marks Regulations*.

[34] In its additional written arguments on this issue, the Applicant's agent submitted that, contrary to the submission of the Opponent, the Applicant did not make a claim that it has used the trade-mark in the U.S. when it applied for the Mark. Pointing to the application filed March 30, 2005, the Applicant's agent notes that the statement made under s. 16(2) of the Act states "and the applicant requests registration of the trade-mark in respect of the wares in association with which it will be registered and used." The Applicant's agent further submitted that there is no requirement in the Act that there must be use of the trade-mark in the foreign jurisdiction at the date of filing where a s. 16(2) claim is made.

[35] In my view, since the Applicant was basing its right to registration on its application in the U.S., the Applicant was required to have also used the Mark in the U.S., particularly because the Mark had neither been used nor made known in Canada. In this regard, s. 30(d) of the Act specifically states “and, if the trade-mark has neither been used in Canada nor made known in Canada, *the name of a country in which the trade-mark has been used* by the applicant and the applicant’s named predecessor in title, if any, in association with each of the general classes of wares or services described in the application” (emphasis added).

[36] As noted earlier, the print-outs from the Applicant’s website dated April 22, 2009, are only sufficient to show that the Applicant’s website existed on such date. As a result, there is nothing in the Applicant’s evidence to show that, contrary to the statement in the U.S. registration, it had used the Mark in the U.S. as of the filing date of its Canadian application.

[37] While the Opponent has been able to successfully defeat the basis of registration and use of the Mark in the U.S., the application may still proceed on the basis of proposed use of the Mark in Canada, depending on the outcome of the remaining grounds of opposition [see *A.B. Dick Company v. Platsch GmbH & Co.* (June 15, 2007) T.M.O.B. (unreported), application No. 1,053,781].

Section 12(1)(d) Ground of Opposition

[38] The s. 12(1)(d) ground of opposition turns on the issue of the likelihood of confusion between the Mark and each of the Opponent’s marks.

[39] I note that the Opponent’s initial burden with respect to the s. 12(1)(d) ground has been satisfied because all of its registrations are in good standing.

[40] I consider the Opponent’s case to be strongest with respect to the ground that the Mark is not registrable pursuant to s. 12(1)(d) of the Act due to a likelihood of confusion with the Opponent’s THYME MATERNITY trade-mark, registration No. 611,775. I think that comparing this mark with the Mark will be decisive. If the Mark is not likely to cause confusion with this mark of the Opponent, it is unnecessary to consider the other THYME marks of the Opponent as they are less similar to the Mark, either in appearance or in wares and services.

[41] The Opponent's THYME MATERNITY mark (registration No. 611,775) is registered in association with the following wares and services:

Wares:

Maternity clothing, namely: hosiery, lingerie, dresses, jumpsuits, rompers, unitards, bathing suits, skirts, sweatshirts, sweatpants, outerwear, namely jackets, coats, capes and ski jackets; pants, jeans, overalls, blouses, shirts, T-shirts, tank tops, blazers, sweaters, shorts, bras, underwear, robes; exercise wear, namely sweat tops, sweat bottoms, body suits, leggings. Footwear, namely thongs, slippers, sandals and running shoes. Jewellery. Belts, hats, bags and sunglasses. Skincare products namely body lotions and creams.

Services:

Operation of retail clothing stores; retail clothing store services.

test for confusion

[42] 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 s. 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks or trade-names 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 or trade-names in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight.

[43] The Supreme Court of Canada has discussed the appropriate process for assessing all the surrounding circumstances to be considered in determining whether two trade-marks are confusing in its decisions in *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401. It is with these general principles in mind that I shall now assess all of the surrounding circumstances.

s. 6(5)(a) - inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

[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, Kim Schumbert, provides the following information:

- the Opponent, through its THYME MATERNITY division, has operated 76 retail stores in Canada, under the THYME, THYME MATERNITY or THYME MATERNITÉ marks as of December 2008(Schumbert, paras. 10 and 22);
- the above noted THYME trade-marks have been in continuous use in association with the Opponent's services by being displayed inside and outside the Opponent's store locations (representative photos of the use of THYME trade-marks with all store locations since at least 2003 are attached to the Schumbert affidavit as Exhibits KS-7 through KS-9);
- the Opponent's THYME trade-marks are in use in association with the Opponent's wares by either being printed on the wares directly, on price tags and labels attached to the Opponent's wares, and/or on shopping bags given to the clients with their purchases of the Opponent's wares (see Schumbert, Exhibit KS-4 for specimens, photographs and copies showing use of the THYME marks in association with the Opponent's wares);
- the THYME trade-marks have been promoted in print ad campaigns, promotional flyers and catalogues between the years 2002 – 2008 (Schumbert, Exhibit KS-11).

[45] As noted earlier in my decision, the evidence of Ms. Schumbert refers to all of the registered and applied for marks of the Opponent, as opposed to only those that were pleaded in the s. 12(1)(d) ground of opposition. Further, I find it surprising that Ms. Schumbert did not provide sales figures or invoices for the Opponent's THYME MATERNITY wares and services sold in Canada, or further information regarding the extent of circulation in Canada of the Opponent's print ads, campaigns, promotional flyers and catalogues. I still consider the Opponent's evidence as a whole sufficient, however, to show that its THYME MATERNITY mark has become known to a considerable extent in Canada.

[46] The Applicant, on the other hand, has not shown any use of the Mark in Canada. I therefore conclude that this factor favours the Opponent.

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

[47] The length of time that each mark has been in use favours the Opponent.

s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

[48] When considering the wares, services and trades of the parties, it is the statement of wares and/or services in the Applicant's application and the Opponent's registration that govern in respect of the issue of confusion arising under s. 12(1)(d) [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)]. However, evidence of the actual trades of the parties is useful in reading the statement of wares/services with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording [see *McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.)].

[49] The Applicant's aerosol room scenting sprays and candles are clearly different than the Opponent's wares and services.

[50] While the Applicant's skin care products which include, *inter alia*, body crème and body lotion, appear to be similar to the Opponent's skincare products, namely body lotions and creams, the Applicant submits that its wares are very different from those sold in association with the Opponent's mark for the following reasons. First, it submits that its wares are for use by all adults and children while the skin care products used in association with the Opponent's mark are manufactured for use by pregnant women. In this regard, the Applicant's agent pointed to the Opponent's evidence which shows that the skin care products provided by the Opponent include Mom and Baby Cream, Tired Legs Cream, Leg Gel, Breast Cream, Nipple Ointment, and Stretch Mark Cream, all of which are targeted to new or expectant mothers. Many of these wares also include statements on their packaging or promotional materials that they are for use

for pregnant or nursing mothers, and much of the Opponent's advertising includes pregnancy related slogans and advertising. Further, the Opponent's mark is used primarily with respect to clothing and fashion accessories, and the operation of a chain of retail stores specializing in the sale of such wares.

[51] I respectfully disagree with the Applicant that its skincare products do not overlap with those of the Opponent. While the Opponent's skin care products may have to date been targeted to or designed for new and expectant mothers, the wares as registered are not so restricted. There is therefore nothing preventing the Opponent from selling skin care products for women in general, as opposed to just new and expectant mothers.

[52] With respect to the nature of the trade, the Applicant submits that the Opponent's wares are only sold through its own retail stores. In this regard, much of the promotional material provided by the Opponent as evidence stresses that the Opponent's relevant wares are available "exclusively at the Thyme Maternity Stores" or "exclusivement dans les boutiques Thyme Maternité". Further, the Opponent has provided no evidence that it has produced or sold or even promoted the Opponent's relevant wares in association with its marks to consumers other than pregnant or nursing women and there is no evidence that it has any future plans to do so.

[53] In *Becker Milk Co. v. Interstate Brands Co. – Licensing Co.* (1996), 67 C.P.R. (3d) 76 (T.M.O.B.), the Board considered the likelihood of confusion between DOLLY MADISON for ice cream and DOLLY MADISON BAKERY for cakes. The applicant in that case argued that the channel of trade for the opponent's ice-cream was a narrow one because the ice cream was only sold in the opponent's particular stores. The applicant submitted that there would be very little likelihood that the opponent would sell its ice cream through independent outlets because its ice-cream was a house brand.

[54] In that decision, Member Herzig found as follows:

It is clear from the evidence that until now the opponent has sold its ice-cream product only through its own retail stores. However, there is nothing to preclude the opponent from selling its DOLLY MADISON brand ice-cream through other retail outlets such as supermarket chain stores. More importantly, the opponent has not restricted its statement of wares to any particular channel of trade (neither has the applicant) and it is the statements of wares that govern in considering s. 6(5)(c) and (d) of the Act. In other

words, I am obliged to consider whether confusion would be likely if the opponent were to operate in any way open to it...Therefore, to the extent that there is a similarity or overlap between the wares of the parties, there is also a potential for overlap in the natures of the trades.

[55] The reasoning above also applies to the present case. As there is no restriction in either the Applicant's statement of wares or the Opponent's statement of wares or services that would prevent either of them from selling their wares through the same channels of trade, I must consider that the parties' channels of trade could potentially overlap.

s. 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 between the marks, the marks must be considered in their totality; it is not correct to lay the trade-marks side by side and compare and observe similarities or differences among the elements or components of the marks [see *Chamberlain Group, Inc. v. Lynx Industries Inc.* (2010), 89 C.P.R. (4th) 122, reversing 79 C.P.R. (4th) 465]. Further, the most crucial or dominant factor in determining the issue of confusion is the degree of resemblance between the trade-marks [see *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145(F.C.T.D.) at 149, affirmed 60 C.P.R. (2d) 70].

[57] Recently, in the SCC decision *Masterpiece Inc. v. Alavida Lifestyles Inc.* (May 26, 2011, S.C.C. (unreported)), the Court observed that the most important factor when considering the degree of resemblance between the marks is whether there is a unique aspect to the trade-marks. In this regard, the Court stated the following 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. Here there is nothing striking or unique about the word "Living" or the words "the Art of Living". "Masterpiece" is the word that distinguishes Alavida and Masterpiece Inc. from other sources of retirement residence services. It is a reasonable conclusion that "Masterpiece" is the dominant word in these trade-marks, and it is obviously identical as between Alavida and Masterpiece Inc.

[58] In the present case, the component THYME in the Opponent's THYME MATERNITY mark is the word that distinguishes the Opponent's wares and services from those of others. The

Applicant has appropriated the first and most distinctive component of the Opponent's word mark in its entirety and added thereto the letter "s" at the end and the design of the letter T with a leaf motif. In my view, the word THYME is the dominant portion of both parties' marks. There is therefore a considerable degree of resemblance between the marks in appearance and sound. The ideas suggested by the marks are different, however, as the Opponent's mark suggests motherhood in part while the Mark and its design only suggest the herb known as "thyme".

further surrounding circumstances

[59] The Applicant's evidence shows that since as early as 1985, it has registered several trade-marks including the word THYME in the U.S.A. Its evidence also shows that it registered the Mark in the U.S. on July 12, 2005. The Applicant submits that the co-existence of both parties' marks in the U.S. since 2005 with no evidence of confusion is a relevant surrounding circumstance to the present opposition.

[60] I respectfully disagree with the Applicant on this point. In this regard, the Applicant has not provided any evidence of the extent to which the Mark has been used in the U.S. In the absence of evidence of significant use of both parties' marks in the U.S. over a considerable period of time, I do not consider the fact the Opponent has not put forward any evidence of confusion between the marks in the U.S. to be relevant to the present case. In any event, 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), and so co-existence on a foreign trade-mark register is to be accorded little weight [see *Quantum Instruments, Inc. v. Elinca S.A.* (1995), 60 C.P.R. (3d) 264 (T.M.O.B.) at 268-9].

[61] As a further surrounding circumstance, the Applicant has relied upon state of the register evidence put forth by the Tole affidavit. 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 [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Welch Foods Inc. v. Del Monte Corp.* (1992), 44 C.P.R. (3d) 205; *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

[62] The particulars of the three third party registered trade-marks evidenced by Mr. Tole are as follows:

- TIMOTEI THYME AND ROSEMARY & Design (TMA473,205) for use in association with “hair care products, namely, shampoo and conditioner” since October 24, 1995;
- IT’S ABOUT THYME (TMA700,609) for use in association with “all purpose disinfectant spray for sanitizing and cleaning surfaces” since January, 2006; and
- THYME 2 CLEANSE (TMA728,663) for use in association with “herbal dietary supplements for reducing toxins from the body; herbal essential oils for use as human nutritional and dietary supplements” since November 12, 2008.

[63] The above noted three trade-mark registrations are far from sufficient to allow any inferences to be made about the possible common adoption of THYME marks in the marketplace, especially when one considers the differences between some of the above-listed wares and the wares at issue in these proceedings.

conclusion re likelihood of confusion

[64] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees THYMES and Design on the Applicant’s wares at a time when he or she has no more than an imperfect recollection of the Opponent’s THYME MATERNITY trade-mark, and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot*].

[65] In view of my findings above, and in particular the extent known of the Opponent’s THYME MATERNITY mark, the fact that most of the Applicant’s wares overlap with those of the Opponent, and the considerable degree of resemblance between the marks in appearance, it seems to me that such a consumer would, as a matter of first impression, be likely to believe that the wares associated with the THYME MATERNITY and THYMES and Design were manufactured, sold or performed by the same person.

[66] The s. 12(1)(d) ground of opposition therefore succeeds.

Section 16(2) and Section 16(3) Grounds of Opposition

[67] The Opponent has also pleaded that the Applicant is not the person entitled to registration pursuant to s. 16(2) and s. 16(3) on the basis that the Mark is confusing with the various THYME marks and trade-names previously used and made known in Canada by the Opponent.

[68] With respect to this ground of opposition, there is an initial burden on the Opponent to evidence use of its trade-marks and trade-names prior to the Applicant's convention priority filing date and non-abandonment of its trade-marks and trade-names as of the date of advertisement of the Applicant's application [s. 16].

[69] I am not satisfied that the Opponent has met its evidential burden under the s. 16 grounds of opposition with respect to its trade-marks as the Opponent has not shown that it has used or made known any of the marks relied upon under these grounds in association with their respective wares and services prior to the material date.

[70] I am satisfied, however, that the Opponent has met its burden with respect to its trade-names. The material date for assessing the likelihood of confusion in respect of this ground is the Applicant's convention priority filing date. For the most part, my conclusions above under the s. 12(1)(d) ground also apply to these grounds of opposition. Thus, my finding above that the trade-marks are likely to be confused also applies to the Mark and the Opponent's trade-names. These grounds of opposition therefore succeed on that basis.

Distinctiveness Ground of Opposition

[71] The Opponent has pleaded that the Mark is not distinctive and is not capable of distinguishing the Applicant's wares from the wares and services associated with the Opponent's trade-marks and trade-names.

[72] In order to meet its evidential burden with respect to this ground, the Opponent must show that as of the filing of the opposition, the Opponent's marks and names had become known sufficiently to negate the distinctiveness of the Mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.); *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.); and *Park Avenue Furniture Corporation v. Wickes/Simmons*

Bedding Ltd. (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)). Ms. Schumpert's evidence satisfies the Opponent's initial burden.

[73] As stated earlier, the material date for assessing the likelihood of confusion in respect of the non-distinctiveness ground is the date of opposition. In my view, the difference in material dates between this ground and the s. 12(1)(d) ground do not have any significant impact on the determination of the issue of confusion between the trade-marks of the parties. Thus, my finding above that the trade-marks are likely to be confused applies to this ground which also succeeds to the extent that it relies on trade-marks owned by the Opponent.

Remaining Grounds of Opposition

[74] As the opposition has already succeeded on more than one ground, I will not discuss the remaining grounds of opposition.

Disposition

[75] In view of the above, and pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

Cindy R. Folz

Member,



Trade-marks Opposition Board


Canadian Intellectual Property Office


SCHEDULE A

Trade-mark	Registration/ Application No.	Wares/Services
<p>SEED THE BEGINNING OF THYME & Design</p> 	<p>TMA 401,032</p>	<p>Maternity clothing, namely: hosiery, lingerie, dresses, jumpsuits, rompers, unitards, bathing suits, skirts, sweatshirts, sweatpants, outerwear namely jackets, coats, capes and ski jackets; pants, jeans, overalls, blouses, shirts, T-shirts, tank tops, blazers, sweaters, shorts, bras, underwear, robes; exercise wear, namely sweat tops, sweat bottoms, body suits, leggings; baby clothing, namely sleepers, jumpers, caps and bonnets; maternity footwear, namely thongs, slippers, sandals and running shoes; video cassettes, seeds, books, cups, assorted windup toys, stuffed animals, magazines, hats, jewellery, belts, layettes, namely new born baby sleepers, bags, sunglasses, fragrance namely a scented fragrance sold in bottles and dispensers.</p>
<p>THYME EN COMPAGNIE & Design</p> 	<p>TMA 403,803</p>	<p>Wares: Maternity clothing, namely: hosiery, lingerie, dresses, jumpsuits, rompers, unitards, bathing suits, skirts, sweatshirts, sweatpants; outerwear, namely jackets, coats, capes and ski jackets; pants, jeans, overalls, blouses, shirts, T-shirts, tank tops, blazers, sweaters, shorts, bras, underwear, robes; exercise wear namely sweat tops, sweat bottoms, body suits, leggings; baby clothing, namely sleepers, jumpers, caps and bonnets; maternity footwear, namely thongs, slippers, sandals and running shoes; video cassettes, seeds, books, cups, assorted wind up toys, stuffed animals, magazines, hats, jewellery, belts; layettes namely new born baby sleepers; bags, sunglasses; fragrance namely a scented fragrance sold in bottles and dispensers.</p> <p>Services: Operation of retail clothing stores.</p>

<p>THYME MATERNITY & Design</p> 	<p>TMA 522,482</p>	<p>Maternity clothing, namely: hosiery, lingerie, dresses, jumpsuits, rompers, unitards, bathing suits, skirts, sweatshirts, sweatpants, outerwear, namely jackets, coats, capes and ski jackets; pants, jeans, overalls, blouses, shirts, T-shirts, tank tops, blazers, sweaters, shorts, bras, underwear, robes; exercise wear, namely sweat tops, sweat bottoms, body suits, leggings.</p> <p>Footwear, namely thongs, slippers, sandals and running shoes.</p> <p>Jewellery.</p> <p>Belts, hats, bags and sunglasses.</p> <p>Skincare products namely body lotions and creams.</p> <p>Services: Operation of retail clothing stores; retail clothing store services.</p>
<p>THYME MATERNITÉ and Design</p> 	<p>TMA 522,553</p>	<p>Maternity clothing, namely: hosiery, lingerie, dresses, jumpsuits, rompers, unitards, bathing suits, skirts, sweatshirts, sweatpants, outerwear, namely jackets, coats, capes and ski jackets; pants, jeans, overalls, blouses, shirts, T-shirts, tank tops, blazers, sweaters, shorts, bras, underwear, robes; exercise wear, namely sweat tops, sweat bottoms, body suits, leggings.</p> <p>Footwear, namely thongs, slippers, sandals and running shoes.</p> <p>Jewellery.</p> <p>Belts, hats, bags and sunglasses.</p> <p>Skincare products namely body lotions and creams.</p> <p>Services: Operation of retail clothing stores; retail clothing store services.</p>
<p>THYME MATERNITY</p>	<p>TMA 611,775</p>	<p>Maternity clothing, namely: hosiery, lingerie, dresses, jumpsuits, rompers, unitards, bathing suits, skirts, sweatshirts, sweatpants, outerwear, namely jackets, coats, capes and ski jackets; pants, jeans, overalls, blouses, shirts, T-shirts, tank tops, blazers, sweaters, shorts, bras, underwear, robes; exercise wear, namely sweat tops, sweat bottoms, body</p>

		<p>suits, leggings. Footwear, namely thongs, slippers, sandals and running shoes. Jewellery. Belts, hats, bags and sunglasses. Skincare products namely body lotions and creams.</p> <p>Services: Operation of retail clothing stores; retail clothing store services.</p>
<p>THYME MATERNITY & Design</p> 	<p>Application No. 1,275,849</p>	<p>Maternity clothing, namely: hosiery, lingerie, dresses, jumpsuits, rompers, unitards, bathing suits, skirts, sweatshirts, sweatpants, outerwear, namely jackets, coats, capes and ski jackets; pants, jeans, overalls, blouses, shirts, T-shirts, tank tops, blazers, sweaters, shorts, bras, underwear, robes; exercise wear, namely sweat tops, sweat bottoms, body suits, leggings, hats; baby clothing, namely sleepers, jumpers, caps and bonnets; layettes, namely: newborn baby sleepers maternity footwear, namely thongs, slippers, sandals and running shoes. Books and magazines dealing with subjects of pregnancy, prenatal and post-pregnancy care and child rearing. Assorted wind up toys, stuffed animals. Costume jewellery. Belts, handbags, purses, bags. Sunglasses. Videocassettes, compact discs, DVD's, all for subjects concerning pregnancy, prenatal and post-pregnancy. Skin care products, namely: body lotions and creams.</p> <p>Services: Operation of retail stores. Operation of a web site. E-commerce. Direct wholesale business in the field of maternity. Licensing business.</p>
<p>THYME MATERNITÉ & Design</p> 	<p>Application No. 1,275, 851</p>	<p>Wares: Maternity clothing, namely: hosiery, lingerie, dresses, jumpsuits, rompers, unitards, bathing suits, skirts, sweatshirts, sweatpants, outerwear, namely jackets, coats, capes and ski jackets; pants, jeans, overalls, blouses, shirts, T-shirts, tank tops, blazers, sweaters, shorts, bras, underwear, robes; exercise wear,</p>

		<p>namely sweat tops, sweat bottoms, body suits, leggings, hats; baby clothing, namely sleepers, jumpers, caps and bonnets; layettes, namely: newborn baby sleepers maternity footwear, namely thongs, slippers, sandals and running shoes. Books and magazines dealing with subjects of pregnancy, prenatal and post-pregnancy care and child rearing. Assorted wind up toys, stuffed animals. Costume jewellery. Belts, handbags, purses, bags. Sunglasses. Videocassettes, compact discs, DVD's, all for subjects concerning pregnancy, prenatal and post-pregnancy. Skin care products, namely: body lotions and creams.</p> <p>Services: Operation of retail stores. Operation of a web site. E-commerce. Direct wholesale business in the field of maternity. Licensing business.</p>
<p>THYME MATERNITY and Design</p> 	<p>Application No. 1,275,852</p>	<p>Maternity clothing, namely: hosiery, lingerie, dresses, jumpsuits, rompers, unitards, bathing suits, skirts, sweatshirts, sweatpants, outerwear, namely jackets, coats, capes and ski jackets; pants, jeans, overalls, blouses, shirts, T-shirts, tank tops, blazers, sweaters, shorts, bras, underwear, robes; exercise wear, namely sweat tops, sweat bottoms, body suits, leggings, hats; baby clothing, namely sleepers, jumpers, caps and bonnets; layettes, namely: newborn baby sleepers maternity footwear, namely thongs, slippers, sandals and running shoes. Books and magazines dealing with subjects of pregnancy, prenatal and post-pregnancy care and child rearing. Assorted wind up toys, stuffed animals. Costume jewellery. Belts, handbags, purses, bags. Sunglasses. Videocassettes, compact discs, DVD's, all for subjects concerning pregnancy, prenatal and post-pregnancy. Skin care products, namely: body lotions and creams.</p> <p>Services: Operation of retail stores. Operation of a web site. E-commerce. Direct wholesale business in the field of maternity. Licensing business.</p>

<p>THYME MATERNITÉ and Design</p> 	<p>Application No. 1,275,853</p>	<p>Maternity clothing, namely: hosiery, lingerie, dresses, jumpsuits, rompers, unitards, bathing suits, skirts, sweatshirts, sweatpants, outerwear, namely jackets, coats, capes and ski jackets; pants, jeans, overalls, blouses, shirts, T-shirts, tank tops, blazers, sweaters, shorts, bras, underwear, robes; exercise wear, namely sweat tops, sweat bottoms, body suits, leggings, hats; baby clothing, namely sleepers, jumpers, caps and bonnets; layettes, namely: newborn baby sleepers maternity footwear, namely thongs, slippers, sandals and running shoes. Books and magazines dealing with subjects of pregnancy, prenatal and post-pregnancy care and child rearing. Assorted wind up toys, stuffed animals. Costume jewellery. Belts, handbags, purses, bags. Sunglasses. Videocassettes, compact discs, DVD's, all for subjects concerning pregnancy, prenatal and post-pregnancy. Skin care products, namely: body lotions and creams.</p> <p>Services: Operation of retail stores. Operation of a web site. E-commerce. Direct wholesale business in the field of maternity. Licensing business.</p>
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