

**IN THE MATTER OF AN OPPOSITION by
Georgia-Pacific Consumer Products LP to
application No. 1,125,789 for the trade-mark Daisy
Flower (Square) Pattern Design in the name of
Kruger Products Limited**

On December 18, 2001, Scott Paper Limited filed an application to register the trade-mark Daisy Flower (Square) Pattern Design [the “Mark”] based upon proposed use of the Mark in Canada in association with “hygienic paper products namely, bathroom tissue”. The Mark is shown in the drawing below:



The application states that the rectangular dotted outline does not form a feature of the mark and merely shows the placement of the mark on the wares.

The application is currently in the name of Kruger Products Limited and the term “Applicant” will be used throughout to refer to the owner of the Mark at the relevant time.

The application was advertised for opposition purposes in the Trade-marks Journal of January 21, 2004. On March 22, 2004, Fort James Operating Company filed a statement of opposition. Fort James Operating Company subsequently changed its name to Georgia-Pacific Consumer Products LP and the term “Opponent” will be used to refer to both Fort James Operating Company and Georgia-Pacific Consumer Products LP.

The grounds of opposition are summarized below:

1. The Mark is not registrable under s. 12(1)(d) of the *Trade-marks Act*, R.S.C. 1985,

c. T-13 [the “Act”] because the Mark is confusing with the Opponent’s trade-mark Wallpaper Design registered under TMA 454,160 for bathroom tissue, as shown below:



2. The Applicant is not the person entitled to registration of the Mark under s. 16(3) of the Act because, at the date of filing of the application, the Mark was confusing with the Opponent’s aforesaid registered trade-mark which had been previously extensively used and advertised in Canada on bathroom tissue by the Opponent and in respect of which an application for registration had been previously filed in Canada by the Opponent.

3. The Applicant’s Mark is not distinctive because it is not adapted to distinguish, and does not distinguish, the Applicant’s wares from the wares in association with which the Opponent has used and advertised the aforesaid registered mark of the Opponent. “On the contrary, the advertised trade-mark is calculated to give rise to confusion, and to benefit from and trade off the goodwill attaching to the aforesaid trade-mark of the opponent Fort James Operating Company.”

The Applicant filed and served a counter statement in which it denied the Opponent’s allegations.

In support of its opposition, the Opponent filed the affidavit of Brian Nickoloff. The Applicant obtained an order for the cross-examination of Mr. Nickoloff. A copy of the transcript of the cross-examination has been filed, together with exhibits to the cross-examination and answers both to undertakings given and to questions taken under advisement.

In support of its application, the Applicant filed the affidavits of Mary P. Noonan and Natalie Rizkalla-Kamel.

Each party filed a written argument and participated in an oral hearing.

Onus and Material Dates

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 C.P.R. (3d) 293 (F.C.T.D.) at 298].

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

- 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(3) - the filing date of the application [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.T.D.)].

Summary of Opponent's Evidence

Nickoloff Affidavit

Mr. Nickoloff was, as of December 28, 2004 and for 13 years prior to that date, the National Sales Manager, Warehouse Club Channel for Fort James Operating Company. He attests that the Opponent is a leading international manufacturer of consumer paper products including bath tissue and that it uses different designs on these products so as to enable the public to distinguish its products from those of other manufacturers. He further attests:

In the consumer paper products industry, manufacturers of bathroom tissues... and similar products often distinguish their products from the products of others by creating a distinctive embossed design and displaying the design on their products.

This is in part due to the fact that consumers only use such products after they have been removed from the packaging in which they are sold.

Mr. Nickoloff provides a certified copy of the Opponent's registration No. TMA 454,160 for its Wallpaper Design mark [the "Opponent's Mark"] and states that bathroom tissue bearing such mark has been sold in Canada since at least as early as July 1998. Such tissue is sold exclusively through Costco, a large, nation-wide warehouse club, which sells the tissue under its own house mark, KIRKLAND SIGNATURE. The KIRKLAND SIGNATURE bath tissue is packaged by the Opponent and shipped from the United States into Canada. Several sheets of such tissue (dating from 2004) have been provided as Exhibit "B".

Mr. Nickoloff has also provided sales figures and advertising details with respect to his company's Wallpaper Design bathroom tissue.

I am according no weight to Mr. Nickoloff's personal view that the Canadian public may be led to believe that wares sold in association with the Applicant's Mark are sold or authorized by the Opponent.

Summary of Applicant's Evidence

Noonan Affidavit

Ms. Noonan is a trade-mark searcher employed by the Applicant's trade-mark agents. On April 20, 2006, she conducted a search of the Canadian Trade-marks Register directed to marks that consist of a design depicting an embossing flower pattern in association with either bathroom tissue or toilet tissue.

Rizkalla-Kamel Affidavit

Ms. Rizkalla-Kamel was a student-at-law in the employ of the Applicant's trade-mark agents. On April 7, 2006, she visited various stores in the Toronto area and obtained bathroom tissue, samples of which she has provided as Exhibits "A" through "X". In paragraphs 13-15, she provides samples of three bathroom tissues, which she apparently did not personally obtain

(Exhibits “Z”, “AB” and “AD”); clearly there is a hearsay issue with respect to this portion of her affidavit and the Applicant advised at the oral hearing that it is not relying on paragraphs 13-15.

Ms. Rizkalla-Kamel also provides details of certain industrial design applications and registrations for embossing patterns featuring flowers, and matches some of them with corresponding trade-mark applications/registrations.

Objection to Applicant’s Evidence

At the oral hearing, the Opponent objected to the fact that the Applicant’s evidence was introduced by employees of the Applicant’s agents. Although no impropriety was suggested, the Opponent’s position was that the Applicant’s evidence should not be accorded significant weight.

Regarding the trade-mark search introduced by Ms. Noonan, the Opponent expressed the view that Ms. Noonan has not been qualified as an expert searcher, despite the fact that Ms. Noonan did explain that she has been employed as a trade-mark searcher since June 1989 and that in such role she conducts trade-mark searches of the records of the Canadian Trade-Marks Office. In any event, given that Ms. Noonan has not expressed any opinion concerning the results of her search, the need to qualify her as an expert seems uncalled for. Nevertheless, the Opponent took the position that any trade-mark search is part of an opinion, with the result that the affiant would not be able to reveal the logic employed in the search since it would be privileged (it is noted that Ms. Noonan did provide a printout showing the parameters used in her search). I am not convinced by these arguments of the Opponent but I will not address them further since there are other reasons why I do not consider the results of Ms. Noonan’s search to be significant, which will be set out later.

The Opponent also took the position that a cross-examination of Ms. Rizkalla-Kamel would be fruitless because privilege would insulate her from answering pertinent questions concerning her purchases. Furthermore, the Opponent expressed the view that it would be acceptable to introduce evidence through such an employee if the evidence in question did not require the

affiant to make any choices during its selection. Although I understand to some degree what the Opponent means by the latter view, I think that it is a difficult concept to apply since clearly any “selection” involves choices, i.e. the submission of a certified copy of a registration by an affiant still involves the choice as to which registration, if any, should be so introduced. I believe that the Opponent stated that the issue is fact versus opinion and I do not have difficulty with that phrasing. Where we seem to disagree is as to whether the Rizkalla-Kamel affidavit deals with fact or opinion; it is my view that her evidence concerning the locating of various bathroom tissues in the marketplace is fact. While it is true that there may have been other bathroom tissues in the stores that she chose not to acquire, that does not in my view diminish her evidence. Overall, her evidence is clearly not contentious opinion evidence. Moreover, I am not willing to accept the Opponent’s view that cross-examination would have been blocked by privilege claims, given the fact that the Opponent did not pursue a cross-examination to test this presumption.

In response to another point argued by the Opponent, I disagree that Ms. Rizkalla-Kamel’s failure to state that she bought (as opposed to obtained) the various bathroom tissues referred to in paragraphs 3-12 of her affidavit is of any consequence since, reading her affidavit as a whole, it is clear that the wares she has introduced were being offered for sale.

Likelihood of Confusion

Each of the grounds is premised on the likelihood of confusion between the parties’ marks.

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 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 C.P.R. (4th) 321 (S.C.C.).]

Section 12(1)(d) Ground

I shall first assess the likelihood of confusion under the s. 12(1)(d) ground. The Opponent has met its initial burden with respect to this ground of opposition since its registration is extant.

s. 6(5)(a) - inherent distinctiveness of the marks and the extent to which each has become known
Both parties' marks are inherently distinctive. However, only the Opponent has evidenced that its mark may have acquired distinctiveness in the marketplace. In that regard, the Opponent relies on sales of approximately \$100 million corresponding to over 9 million 24-roll packages [Nickoloff Affidavit, paragraph 8]. The extent of such acquired distinctiveness has been attacked by the Applicant on the following bases: 1) the Opponent's Mark is concealed at the time of purchase (only the marks of a third party are visible when the Opponent's wares are sold); and 2) there is no evidence that the Wallpaper Design has ever been identified as a trade-mark to purchasers.

Given the private labelling aspect of the manner in which the Opponent's wares are sold in Canada, the Applicant challenges the claim that the Wallpaper Design mark has functioned as a manufacturer's trade-mark and instead submits that any reputation resulting from the sale of the Wallpaper Design wares in Canada has accrued to Costco. It is noted that the packaging does not refer to the Opponent's name but does state, "Distributed by/Distribué par: COSTCO WHOLESALE CANADA LTD." In these circumstances, I am not prepared to conclude that Costco would be viewed as the source of the wares, as opposed to their distributor.

In addition to its sales, the Opponent also relies on the advertising that has occurred with respect to its bathroom tissue. However, the advertisements provided do not display the Opponent's Mark. The mark does not appear on either the Passport to Savings or the coupons referred to in paragraph 10 of Mr. Nickoloff's affidavit [see the answers to the undertakings given with respect

to Questions 379 and 390, as well as pages 79-93 of the cross-examination]. In addition, the Opponent's entire registered mark does not appear on the representative ad provided as Exhibit "C"; only a portion of the Opponent's Mark appears in the ad and that portion is covered in part by ad copy and a photo of the packaging.

Despite all of the above-mentioned shortcomings, I find that overall a consideration of the extent to which each mark has become known necessarily favours the Opponent. After all, there is no evidence that the Applicant's Mark has become known at all. On the other hand, a significant number of Canadians have purchased bathroom tissue that bears the Opponent's Mark. Even though it is not evident that the Opponent's Mark comes to the attention of such purchasers at the time of purchase, inevitably the purchaser will open the packaging and see the embossed mark. This post-purchase viewing necessarily results in the Opponent's Mark having become known to some extent, regardless of whether or not it supports a conclusion that the Opponent has used its mark in accordance with s. 4 of the Act. [For a further discussion of this latter point, see my discussion with respect to the s. 16(3) ground of opposition below, where I conclude that the Opponent has not evidenced use of its mark in accordance with s. 4 of the Act.]

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

If the Opponent had used its mark in a manner that satisfied s. 4 of the Act, then this factor would have clearly favoured the Opponent given that it claims use of its mark in Canada since as early as 1998 and has provided sales figures relating to wares sold in association with its mark since 2000. In contrast, the Applicant filed its application in 2001 on the basis of proposed use.

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

The parties' wares are identical and there is no evidence that their channels of trade could not overlap. The fact that the Opponent at present only sells its wares through Costco is not determinative of the channels of trade through which its wares could travel. Therefore, the factors to be considered under s. 6(5)(c) and (d) favour the Opponent.

s. 6(5)(e) - the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them

This circumstance is a key consideration. As stated in *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.) at 149, affirmed 60 C.P.R. (2d) 70:

Realistically appraised it is the degree of resemblance between trade marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a subservient role in the over-all surrounding circumstances.

The Opponent's Mark comprises embossing that takes the form of a loosely-diamond-shaped grid, in which each cell in every second row contains a design that might be described as the side view of a rose-like flower on a stem with two leaves.

The Applicant's Mark comprises a loosely-diamond-shaped grid, in which each cell in every second row contains a design that appears to be an overhead view of a five-petal flower.

Overall, there is a high degree of resemblance between the parties' marks.

other surrounding circumstances

i) state of the register/state of the marketplace

When two marks are similar, they may nevertheless be sufficiently different so as to prevent confusion if there is sufficient use of similar marks by third parties in the marketplace. In other words, if it can be shown that the average Canadian purchaser of bathroom tissue is used to seeing bathroom tissue that bears an embossed design comprised of a diamond-shaped rectangular grid with flower designs inside the cells, then it may be reasonable to conclude that such a consumer would note the differences between the two marks at issue in these proceedings and use them to distinguish between their sources. It is for this reason that the Applicant has introduced both state of the register and state of the marketplace evidence.

I shall first discuss the state of the register 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 C.P.R. (3d) 432; *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

Ms. Noonan's evidence regarding the state of the register is insufficient to make any meaningful inferences about the state of the marketplace, since she has located only 4 registrations for grids with flower designs, of which two are owned by the Applicant and two are owned by the Opponent. The remaining registrations reported by her do not show a grid design and overall are not sufficiently similar to the marks at issue to be of relevance.

Ms. Noonan has also provided details of some pending trade-mark applications but they include only one third party mark.

Ms. Rizkalla-Kamel has evidenced the existence of the following bathroom tissues bearing an embossed grid-like pattern with/without petal/flower designs in the Canadian marketplace (specifically drug stores, grocery stores and discount retailers) as of April 2006:

1. Ex. "B": Irving Tissue Corporation's ROYALE bathroom tissue embossed with a grid comprising rounded overlapping cells in each of which is embossed either a heart or a flower design
2. Ex. "D": Scott Paper Limited's COTTONELLE CASHMERE bathroom tissue embossed with a grid comprising scalloped overlapping cells with alternating rows displaying within each cell the side view of a rose-like flower with two leaves, as shown below:



3. Ex. “F”:
4. Ex. “H”:
5. Ex. “L”:
6. Ex. “N”:
7. Ex. “P”:
8. Ex. “R”:
9. Ex. “T”:
10. Ex. “V”:
11. Ex. “X”:

For the sake of the reader, who has not had the benefit of viewing the various embossments, I shall mention that they are unobtrusive and, to my eyes at least, not always visible, depending on either how the light strikes the tissue or the background behind the tissue. It is unfortunate that

the majority of the third party embossments cannot be easily displayed on the page for the reader's convenience (the portrayal of Ex. "D" comes from that party's trade-mark registration).

To summarize, we have marketplace evidence of what appears to be six different third party sources of bathroom tissue [Exhibits "L", "N", "P", "R", "V" and "X"] bearing embossments that are similar to those at issue. Based on that evidence, I am satisfied that the average Canadian consumer of bathroom tissue must be fairly used to seeing embossed designs that include grid-like designs encompassing floral designs.

I note that there is no evidence that the Opponent has objected to the use of any of the aforementioned third party embossed designs.

ii) section 37(3) notice

As a further surrounding circumstance, the Opponent emphasized that the Registrar issued a notice to the Opponent concerning the Applicant's application, pursuant to s. 37(3) of the Act. That section reads: When the Registrar, by reason of a registered trade-mark, is in doubt whether the trade-mark claimed in the application is registrable, he shall, by registered letter, notify the owner of the registered trade-mark of the advertisement of the application.

I do not consider the issuance of such a notice to be of any significance in the present proceedings for two reasons: 1) such notice is issued during the examination process when the evidence before me now was not before the Registrar; 2) the onus during examination differs from that during opposition. In general, see *Thomas J. Lipton Inc. v. Boyd Coffee Co.* (1991), 40 C.P.R. (3d) 272 (T.M.O.B.) and *Procter & Gamble Inc. v. Morlee Corp.* (1993), 48 C.P.R. (3d) 377 (T.M.O.B.).

conclusion

Having considered all of the surrounding circumstances, I find that the Applicant has met its legal burden under s. 12(1)(d). Despite the resemblance between the marks at issue, the state of the marketplace evidence indicates that marks of this general nature are quite common in the

relevant industry, resulting in the differences between the two marks being sufficient to make confusion unlikely. In particular, as it appears that the Opponent's Mark has been able to peacefully co-exist with the embossings shown in Exhibits "D", "L", "N", "P", "R" and "X" to the Rizkalla-Kamel affidavit, which are more similar to that of the Opponent than is the Applicant's Mark, it would appear that the Applicant's Mark ought to also be able to peacefully co-exist.

Section 16(3) Grounds of Opposition

The pleading of the s. 16 ground refers to three bases: prior use; prior making known; and prior application. At the oral hearing the Opponent advised that it was not relying on its mark having been previously made known. Neither party referred to the prior application basis, but presumably that is because no such application has been identified. That reduces the entitlement ground to the basis of prior use.

In order to meet its initial burden under s. 16(3)(a), the Opponent must establish use of its mark in Canada prior to December 18, 2001, as well as non-abandonment of its mark as of January 21, 2004.

The Applicant's agent spent considerable time during the cross-examination of Mr. Nickoloff on the question of whether the Opponent's Wallpaper Design can be seen at the time of purchase of the bathroom tissue to which it is applied. Mr. Nickoloff's affidavit did not provide an example of the actual outer packaging in which the Wallpaper Design bathroom tissue is sold. However, the Applicant's agent did so during Mr. Nickoloff's cross-examination (Exhibit "4"). Moreover, further to an undertaking, the Opponent produced a current example of the 36-roll packaging.

I cannot see the Wallpaper Design through the packaging employed by the Opponent. I will also mention that had the cross-examination not yielded the packaging that enabled me to see for myself that the Opponent's Mark is not visible at the time of purchase, I might have drawn such a negative inference based on the Opponent's agent's refusal during the cross-examination to allow Mr. Nickoloff to address the question of whether the Opponent's registered mark could be seen through the packaging (Questions 221 to 240).

The inability to see the Opponent's Mark through its packaging raises the question of whether the Opponent used its mark in accordance with s. 4 of the Act prior to December 18, 2001, or at any other time. The Opponent's position is that s. 4 can be satisfied in certain situations where the mark is seen after the purchase and transfer of the wares. In this regard, it relies in part upon *BMB Compuscience Canada Ltd. v. Bramalea Ltd.* (1989), 22 C.P.R. (3d) 561 (F.C.T.D.). However, as discussed below, the *BMB* case is distinguishable.

BMB was a s. 57 expungement case that turned on the issue of whether the applicant had used its mark in association with computer software prior to the first use of the registered mark that was under attack. The applicant's mark had not been applied to the applicant's wares or the packaging of such wares; instead it was associated with the wares in other manners. In particular, the mark appeared on the computer screen when the software was used. The mark was therefore seen when the applicant demonstrated its software to potential buyers. If the software was purchased, then the applicant would load it into the purchaser's computer and the purchaser would subsequently see the mark on its computer screen whenever it "called upon" the software.

The Court held that the applicant's mark was used based on the foregoing facts but the *BMB* case is distinguishable from the present one because in *BMB* the mark had been brought to the attention of the purchaser both before and after the sale. Therefore, *BMB* does not support the Opponent's submission that seeing a mark after purchase (i.e. upon opening the package at home) satisfies the notice required by s. 4(1). *BMB* is also distinguishable because there the mark was not marked on the wares, i.e. unlike the present case, it fell under the third arm of s. 4(1), namely it was associated with the wares in a manner other than by being marked on the wares or their packaging. Finally, it is noteworthy that the Court in *BMB* seems to have felt that there was a need to accommodate the business realities of what was then the relatively new industry of software sales.

The Applicant relies upon *Syntex Inc. v. Apotex Inc.* (1984), 1 C.P.R. (3d) 145 (F.C.A.) in support of its position that a mark must come to the attention of a purchaser at the time of

transfer in order to satisfy s. 4. In particular, it points to Mr. Justice Stone's statements at page 151 of *Syntex*:

Use of a trade-mark is deemed to have occurred if at the time property in or possession of the wares is transferred, in the normal course of trade, it is "marked on the wares themselves or on the packages in which they are distributed". **The mark must thus come to the attention of the transferee in a direct way at the time of transfer which is the critical time.** [emphasis added]

The above quote is more applicable to the present case than is the *BMB* approach. I am therefore dismissing the s. 16(3) ground on the basis that the Opponent has not satisfied the initial burden on it to establish prior use of its Wallpaper Design mark in accordance with s. 4 of the Act.

Distinctiveness Ground of Opposition

Although the legal onus is on the Applicant to show that its Mark is adapted to distinguish or actually distinguishes its wares from the Opponent's wares throughout Canada [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (T.M.O.B.)], there is an evidential burden on the Opponent to prove the allegations of fact supporting its ground of non-distinctiveness. However, the Opponent need not show that its trade-mark is well known in Canada or has been made known solely by the restricted means set out in s. 5 of the Act in order to meet this evidential burden [see *Motel 6, Inc. v. No. 6 Motel Ltd.*, 56 C.P.R. (2d) 44 at p. 55 (F.C.T.D.)] "A mark must be known to some extent at least to negate the established distinctiveness of another mark, and its reputation in Canada should be substantial, significant or sufficient." [*Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.T.D.) at paragraph 34]

I do not consider it necessary for the Opponent to demonstrate use of its mark in accordance with s. 4 of the Act in order for it to succeed under its distinctiveness ground of opposition. It seems fair to accept that the appearance of the Opponent's Mark on its wares may have resulted in an acquired reputation in Canada, even though the Opponent's Mark may not be seen until the consumer opens the packaging after purchase.

As of March 22, 2004, there had been sales of more than 6,560,000 units of 24 roll packages of

the Opponent's Wallpaper Design bathroom tissue, worth more than \$72 million (paragraph 8, Nickoloff affidavit). There was also in excess of \$320,000 print advertising; however, given that only a portion of the Opponent's Mark appears in the ad and that portion is covered in part by ad copy and a photo of the packaging, I question whether such ads resulted in the mark acquiring any reputation. In any event, I find that Mr. Nickoloff's evidence of the sales of bathroom tissue bearing the Opponent's Mark is sufficient on its own to meet the Opponent's initial burden, given that there was a significant number of rolls of bathroom tissue displaying the Opponent's Mark in the hands of Canadian consumers as of the material date.

Turning to the Applicant's evidence, I can only conclude that there is no evidence relevant to the material date of March 22, 2004. There is no evidence that the Applicant's Mark had acquired any reputation as of that date or that it was common for others to use similar design marks in association with bathroom tissue as of that date. Accordingly, the Applicant has not satisfied its onus. As discussed under the s. 12(1)(d) ground, the parties' marks resemble each other and in the absence of pertinent marketplace evidence (which tipped the issue of confusion in favour of the Applicant under the s. 12(1)(d) ground), the balance of probabilities under the distinctiveness ground weighs in favour of the Opponent. To put it another way, in a universe where no one other than the Opponent is embossing a mark onto bathroom tissue that consists of a grid-like design encompassing floral designs, the Applicant's Mark is not sufficiently different from the Opponent's Mark to distinguish its bathroom tissue from that of the Opponent. In this regard, I note that the consumer to be considered is one with an imperfect recollection of the Opponent's Mark.

For the foregoing reasons, the Applicant has not satisfied me, on a balance of probabilities, that its Mark was distinctive as of March 22, 2004. The distinctiveness ground of opposition accordingly succeeds.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

DATED AT TORONTO, ONTARIO, THIS 3rd DAY OF NOVEMBER 2008.

Jill W. Bradbury
Member
Trade-marks Opposition Board