

**IN THE MATTER OF AN OPPOSITION by First Nations
Summit to application No. 744,907 for the trade-mark FIRST
NATION filed by Skoolegiate Inc.**

On February 2, 1994, the applicant, Skoolegiate Inc., filed an application to register the trade-mark FIRST NATION based upon use of the trade-mark in Canada in association with: “T-shirts. Sweatshirt” since January 1989; “Jackets. Crests” since December 18, 1986; and “Hats. Caps” since May 21, 1991. The application is also based upon proposed use of the trade-mark FIRST NATION in Canada in association with “Parkas; coats”.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of June 22, 1994 and the opponent, First Nations Summit, filed a statement of opposition on November 22, 1994, a copy of which was forwarded to the applicant on January 23, 1995. The applicant responded by filing and serving a counter statement on February 17, 1995. The opponent submitted as its evidence the affidavits of Kathryn Teneese and C. Anthony Wilson while the applicant filed as its evidence the affidavit of Jan Bohna. Both parties filed a written argument and an oral hearing was not conducted in respect of this opposition.

During the opposition proceeding, the opponent requested and was granted leave pursuant to Rule 40 of the *Trade-marks Regulations* to amend its statement of opposition. The following are the grounds of opposition asserted by the opponent in its amended statement of opposition:

- a) The present application does not comply with Subsection 30(a) of the *Trade-marks Act* in that the application does not contain a statement in ordinary commercial terms of the specific wares in association with which the trade-mark has been used, namely, “caps” and “crests”;
- b) The present application does not comply with Subsection 30(b) of the *Trade-marks Act* in that the application contains a statement of the date from which the applicant has used its trade-mark in association with each of the specific wares set forth in the application but does not contain a statement of the date from which the applicant has used the trade-mark in association with the general classes of the wares described in the application;
- c) The present application does not comply with Subsection 30(b) of the *Trade-marks Act* in that the application does not contain a description of the general class or classes of the specific wares set out in the application;
- d) The present application does not comply with Subsection 30(b) of the *Trade-marks Act* in that the applicant has not used the trade-mark in association with the wares described in the application since the dates stated in the application;
- e) The present application does not comply with Subsection 30(i) of the *Trade-marks Act* in that the applicant could not have been satisfied that it was entitled to use the trade-mark;

- f) The trade-mark is not registrable in that, contrary to Paragraph 12(1)(b) of the *Trade-marks Act*, the applicant's mark is clearly descriptive of the character or quality of the wares in association with which it is used or proposed to be used;
- g) The trade-mark is not registrable in that, contrary to Paragraph 12(1)(b) of the *Trade-marks Act*, the applicant's mark is deceptively misdescriptive of the character or quality of the wares in association with which it is used or proposed to be used;
- h) The trade-mark is not registrable in that, contrary to Paragraph 12(1)(b) of the *Trade-marks Act*, the applicant's mark is clearly descriptive of the person employed in the production of the wares in association with which it is used or proposed to be used;
- i) The trade-mark is not registrable in that, contrary to Paragraph 12(1)(b) of the *Trade-marks Act*, the applicant's mark is deceptively misdescriptive of the person employed in the production of the wares in association with which it is used or proposed to be used;
- j) The trade-mark is not registrable in that, contrary to Paragraph 12(1)(e) of the *Trade-marks Act*, the applicant's mark is a mark of which the adoption is prohibited by Paragraph 9(1)(d) of the *Trade-marks Act* in that, since at least as early as the establishment of the Assembly of First Nations in 1982, the trade-mark has been and is the designation of the governments of Canada's aboriginal peoples;
- k) The applicant is not the person entitled to registration in that, having regard to the provisions of Paragraph 16(1)(a) of the *Trade-marks Act*, at the alleged date of first use, the applicant's trade-mark was confusing with the trade-name FIRST NATIONS ARTISANS ASSOCIATION previously used in Canada by FIRST NATIONS ARTISANS ASSOCIATION;
- l) The trade-mark sought to be registered by the applicant is not distinctive in that the trade-mark does not distinguish the applicant's wares from the wares of FIRST NATIONS CLOTHING CO. who claim use of the trade-mark FIRST NATIONS in association with T-shirts, sweatshirts, shorts, jackets, vests and hats since at least as early as March 1992 in trade-mark application No. 728,539, filed May 7, 1993;
- m) The trade-mark sought to be registered by the applicant is not distinctive in that the trade-mark does not distinguish and is not adapted to distinguish the applicant's wares from the wares and services of FIRST NATIONS ARTISANS ASSOCIATION;
- n) The trade-mark sought to be registered by the applicant is not distinctive because it does not and cannot distinguish the applicant's wares from the wares and services of First Nations and the aboriginal peoples of Canada generally;
- o) The trade-mark sought to be registered by the applicant is not distinctive since, as a result of the transfer of the trade-mark, rights subsist in two or more persons to the use of confusing trade-marks and the rights were exercised by those persons, contrary to Subsection 48(2) of the *Trade-marks Act*;
- p) The trade-mark sought to be registered by the applicant is not distinctive in that the trade-mark is used outside the scope of the permitted use provided for by Section 50 of the *Trade-marks Act*;
- q) The trade-mark is not registrable in that, contrary to Paragraph 12(1)(e) of the *Trade-marks Act*, the applicant's mark is a mark the adoption of which is prohibited by Section 9 of the *Trade-marks Act* in that, it is a mark which is likely to be mistaken for the opponent's mark, FIRST NATIONS SUMMIT, published in the *Trade-marks Journal* of December 13, 1995 under Paragraph 9(1)(n)(iii) of the *Trade-marks Act*.

The first five grounds of opposition are based on Section 30 of the *Trade-marks Act* and, more specifically, Subsections 30(a), 30(b) and 30(i) of the *Act*. The legal burden or onus is on the applicant with respect to each of these grounds to show that its application complies with Section

30. This includes both the question as to whether or not the applicant has filed an application which formally complies with the requirements of Section 30 and the question as to whether or not the statements contained in the application are correct. To the extent that the opponent relies on allegations of fact in support of its Section 30 grounds, there is an evidential burden on the opponent to prove those allegations [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330]. To meet the evidential burden upon it in relation of a particular issue, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist [see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293, at p. 298]. Further, the material time for considering the circumstances respecting the issue of non-compliance with Section 30 of the *Act* is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R.(3d) 469, at p. 475].

The first ground is based on Subsection 30(a) of the *Trade-marks Act*, the opponent alleging that the applicant's "caps" and "crests" do not comply with Subsection 30(a) of the *Act*. With respect to the test to be applied under Subsection 30(a) of the *Act*, the former Registrar of Trade-marks stated in *Dubiner and National Yo-Yo and Bo-Lo Ltd. v. Heede Int'l Ltd.*, 23 C.P.R. (2d) 128 that an applicant in its application "must clearly set forth wares or services as they are **customarily referred to in the trade** (emphasis added)." While the opponent has submitted dictionary definitions for the words "cap" and "crest", I would expect that the average consumer of the applicant's wares would readily understand the reference to "caps" as designating a head covering with a visor and no brim and to "crests" as a design applied to clothing which identifies a particular group, team, organization or the like. Consequently, I am of the view that these wares do not offend the provisions of Subsection 30(a) of the *Act* and have therefore rejected this ground.

The next three grounds are based on Subsection 30(b) of the *Trade-marks Act*, the opponent asserting that the present application does not contain a statement of the date from which the applicant has used the trade-mark FIRST NATION in association with the general classes of the wares described in the application, but rather has included a date from which the applicant has used its trade-mark in association with each of the specific wares set forth in the application. In my view, Subsection 30(b) establishes a minimum requirement with respect to the identification of a claimed

date of first use for wares or services covered in an application where the wares and services are grouped in general classes. However, if the applicant has not used its trade-mark since the date claimed with respect to certain of the wares falling within the general class, I am of the view that the claimed date with respect to those wares can be challenged in opposition proceedings by way of a Subsection 30(b) ground. As a result, I am of the view that the manner in which the applicant has identified its wares and the dates of first use of the trade-mark FIRST NATION as applied to those wares meets the technical requirements of Subsection 30(b) of the *Act*. I have therefore dismissed this ground.

As its second Subsection 30(b) ground, the opponent has alleged that the present application does not contain a description of the general class or classes of the specific wares set out in the application. Having regard to my comments relating to the previous ground, I do not consider that Section 30 of the *Act* was intended to penalize parties whose applications were more specific in the identification of wares or services associated with a trade-mark than is required by Subsection 30(b). Accordingly, I have concluded that the statements of wares identified in the present application meet the requirements of Subsection 30(b). I have therefore dismissed this ground.

The final Subsection 30(b) ground is that the applicant has not used the trade-mark in association with the wares described in the application since the dates stated in the application. While the legal burden is upon the applicant to show that its application complies with Subsection 30(b), there is as noted above an initial evidential burden on the opponent to establish the facts relied upon by it in support of this ground. The evidential burden on the opponent respecting the issue of the applicant's non-compliance with Subsection 30(b) of the *Act* is a light one [see *Tune Masters v. Mr. P's Mastertune*, 10 C.P.R.(3d) 84, at p. 89]. Moreover, the opponent's evidential burden can be met by reference not only to the opponent's evidence, but also to the applicant's evidence [see, in this regard, *Labatt Brewing Company Limited v. Molson Breweries, a Partnership*, 68 C.P.R.(3d) 216, at p. 230]. However, while the opponent may rely upon the applicant's evidence to meet its evidential burden in relation to this ground, the opponent must show that the applicant's evidence is 'clearly' inconsistent with the applicant's claims set forth in its application.

In his affidavit, Jan Bohna, President of the applicant, states that the applicant has been carrying on business in Winnipeg, Manitoba under the trade-name JACKET - EXPRESS since March 1, 1978 and that the applicant has been using the trade-mark FIRST NATIONS on jackets since the first sale on December 18, 1986 followed by subsequent sales to many native groups across Canada. In support of this claim, Mr. Bohna has annexed as exhibit B to his affidavit a photocopy of a document relating to the sale of what appear to be 48 jackets to Berens River First Nation with an identified production date of "Dec. 18/86". There is no reference anywhere in the photocopy to the applicant's use of the mark FIRST NATION as a trade-mark as applied to jackets. Further, from the remainder of the affidavit and the accompanying exhibits, it appears that the applicant receives orders for jackets from its clients and, according to the clients' instructions, applies crests and lettering to the jackets and subsequently ships the jackets to the clients. Thus, the applicant has produced jackets based on orders from its clients bearing wording such as "SHAWANAGA FIRST NATION", "Pic 50 First Nations" and "EABAMAMETOONG FIRST NATION". However, these activities do not establish that the applicant has used the mark FIRST NATION *per se* as a trade-mark to distinguish its wares from those of others as contemplated by Subsection 4(1) of the *Trade-marks Act*. Thus, the applicant's evidence is clearly inconsistent with its claim that it has used the trade-mark FIRST NATION since December 18, 1986 in association with "Jackets. Crests". Likewise, the applicant's evidence points to similar activities involving the mark FIRST NATION as applied to "T-shirts. Sweatshirt" and "Hats. Caps". I have concluded, therefore that the present application does not comply with Subsection 30(b) of the *Act* as applied to these wares.

The opponent has not alleged any facts in support of its Subsection 30(i) ground and this ground is therefore dismissed as being contrary to Paragraph 38(3)(a) of the *Trade-marks Act*. In any event, no evidence has been furnished by the opponent to show that, as of the filing date of the present application, the applicant could not have been satisfied that it was entitled to use its trade-mark FIRST NATION in Canada. Further, the applicant's evidence is not clearly inconsistent with its claim that it was satisfied that it was entitled to use the mark FIRST NATION as a trade-mark in Canada as applied to the wares covered in the present application. Moreover, to the extent that this ground is founded upon allegations set forth in the remaining grounds of opposition, the success of this ground is contingent upon a finding that the trade-mark FIRST NATION is not registrable or

not distinctive, or the applicant is not the person entitled to its registration, as alleged in those grounds [see *Consumer Distributing Co. Ltd. v. Toy World Ltd.*, 30 C.P.R. (3d) 191, at p. 195; and *Sapodilla Co. Ltd. v. Bristol-Myers Co.*, 15 C.P.R. (2d) 152, at p. 155]. I will therefore consider the remaining grounds which are based on Paragraphs 12(1)(b) and 12(1)(e) and Section 16 of the *Act*, as well as being based on allegations that the applicant's trade-mark FIRST NATION is not distinctive.

The next four grounds are based on Paragraph 12(1)(b) of the *Trade-marks Act*, the opponent asserting that the trade-mark FIRST NATION is not registrable in that it is clearly descriptive or deceptively misdescriptive of the character or quality of the wares or of the person employed in the production of the wares in association with which it is used or proposed to be used. Paragraph 12(1)(b) of the *Act* provides as follows:

- 12.** (1) Subject to section 13, a trade-mark is registrable if it is not
- (b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;

The issue as to whether the trade-mark FIRST NATION is clearly descriptive or deceptively misdescriptive of the character or quality of the applicant's wares or of the person employed in their production must be considered from the point of view of the average consumer of those wares. Further, in determining whether the trade-mark at issue is clearly descriptive or deceptively misdescriptive, the trade-mark must not be dissected into its component elements and carefully analysed, but rather must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks*, 40 C.P.R. (2d) 25, at pp. 27-28 and *Atlantic Promotions Inc. v. Registrar of Trade Marks*, 2 C.P.R. (3d) 183, at p. 186]. Additionally, the material date for considering a ground of opposition based on Paragraph 12(1)(b) of the *Trade-marks Act* is the date of decision [see *Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers*, 41 C.P.R. (3d) 243 (F.C.A.)].

While the legal burden is upon the applicant to show that its trade-mark FIRST NATION is registrable, there is an initial evidential burden upon the opponent in respect of this ground to adduce

sufficient evidence which, if believed, would support the truth of the allegations that the trade-mark FIRST NATION is clearly descriptive or deceptively misdescriptive of the character or quality of the applicant's wares or of the person employed in their production. In her affidavit, Kathryn Teneese, Protocol Coordinator of First Nations Summit, states that the words FIRST NATION and FIRST NATIONS have come to be known and used by Canada's aboriginal people as the proper designation of the governing units of Canada's aboriginal peoples following the establishment of the Assembly of First Nations in 1982. According to Ms. Teneese, it is common for Canada's First Nations to identify their First Nation with these words on their letterhead and other printed material and often articles of wearing apparel. Further, the affiant has annexed to her affidavit copies of excerpts from the Canadian National Aboriginal Directory, 1994, which includes the First Nations listings for each of the regions listed therein. In the directory, the individual aboriginal governments are listed as "First Nations" and the majority of these First Nations have included in their names the designation "First Nation", even though their band name may not include this designation. I would also note that the applicant's evidence, as referred to above, confirms the use by bands of the words FIRST NATION in their names. The issue, however, is whether this evidence is of relevance to the Paragraph 12(1)(b) grounds and, if so, is it sufficient to meet the opponent's evidential burden in relation to these grounds.

The trade-mark FIRST NATION is neither descriptive nor misdescriptive of any aspect of either the character or the quality of "T-shirts; sweatshirt; jackets; crests; hats; caps; parkas; and coats". However, having regard to the Teneese affidavit, I am satisfied that the mark FIRST NATION as applied to the applicant's wares might well be perceived by the average consumer as being descriptive or misdescriptive of the persons employed in the production of those wares, that is, that the wares are produced by Canada's aboriginal people since the mark designates the governing units of Canada's aboriginal peoples. I have concluded, therefore, that the opponent has met the evidential burden upon it in respect of this ground. Furthermore, the applicant has failed to meet the legal burden upon it of establishing that its trade-mark FIRST NATION is registrable. As a result, this ground of opposition is successful. Moreover, to the extent that the non-distinctiveness ground of opposition asserted in paragraph (n) is arguably based upon the allegations set forth in paragraphs (f) to (i) of the amended statement of opposition, that ground is also successful.

In Paragraph (j) of its amended statement of opposition, the opponent has alleged that the applicant's trade-mark is not registrable in that, contrary to Paragraph 12(1)(e) of the *Trade-marks Act*, the trade-mark FIRST NATION is a mark of which the adoption is prohibited by Paragraph 9(1)(d) of the *Trade-marks Act* in that, since at least as early as the establishment of the Assembly of First Nations in 1982, the mark has been and is the designation of the governments of Canada's aboriginal peoples. Paragraph 9(1)(d) of the *Trade-marks Act* provides as follows:

9. (1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for,
(d) any word or symbol likely to lead to the belief that the wares or services in association with which it is used have received, or are produced, sold or performed under, royal, vice-regal or governmental patronage, approval or authority;

In the present case, the Teneese affidavit establishes that the words FIRST NATION have come to be known and used by Canada's aboriginal people as the proper designation of the governing units of Canada's aboriginal peoples following the establishment of the Assembly of First Nations in 1982. Further, according to Ms. Teneese, it is common for Canada's First Nations to identify their First Nation with these words on their letterhead and other printed material.

In view of the above, I find that the opponent has met its evidential burden in that the applicant's mark FIRST NATION might well be perceived by the average consumer as identifying the governing units of Canada's aboriginal people and that the applicant's wares associated with its mark have received, or are produced under governmental approval or authority of Canada's First Nations. The legal burden is therefore upon the applicant to satisfy the Registrar that its trade-mark does not offend the provisions Paragraph 9(1)(d) of the *Trade-marks Act*. Since neither the applicant's evidence nor its written argument address this issue, the applicant has failed to meet the legal burden upon it in respect of this ground; and this ground is also successful.

As no evidence has been furnished by the opponent in support of the grounds of opposition asserted in Paragraphs (k), (l), (m), (o) or (p) of the amended statement of opposition, the opponent has failed to meet the initial burden upon it as it relates to each of these grounds. I have therefore dismissed these grounds of opposition. The only remaining ground is based on Paragraph 12(1)(e) of the *Act*, the opponent alleging that the applicant's mark is a mark the adoption of which is prohibited by Section 9 of the *Trade-marks Act* in that, it is a mark which is likely to be mistaken

for the opponent's mark, FIRST NATIONS SUMMIT, published in the *Trade-marks Journal* of December 13, 1995 under Paragraph 9(1)(n)(iii) of the *Trade-marks Act*. A copy of the opponent's public notice is annexed as Exhibit B to the Wilson affidavit. The material time for considering the circumstances respecting the Paragraph 9(1)(n)(iii) ground of opposition would appear to be the date of my decision [see *Allied Corporation v. Canadian Olympic Association*, 28 C.P.R.(3d) 161 (F.C.A.) and *Olympus Optical Company Limited v. Canadian Olympic Association*, 38 C.P.R.(3d) 1 (F.C.A.)]. Further, the opponent has evidenced use and adoption of its official mark FIRST NATIONS SUMMIT. Paragraph 9(1)(n)(iii) of the *Trade-marks Act* provides as follows:

9. (1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for

(n) any badge, crest, emblem or mark

(iii) adopted and used by any public authority, in Canada as an official mark for wares or services,

in respect of which the Registrar has, at the request of Her Majesty or of the university or public authority, as the case may be, given public notice of its adoption and use;

The test to be applied is whether or not the applicant's trade-mark FIRST NATION either consists of, or so nearly resembles as to be likely to be mistaken for the opponent's official mark FIRST NATIONS SUMMIT. In other words, is the applicant's mark identical to, or almost the same as, any of the opponent's official marks? [see *Big Sisters Association of Ontario v. Big Brothers of Canada*, 75 C.P.R. (3d) 177, at p. 217]. At page 218 of that decision, Mr. Justice Gibson confirmed that in assessing the resemblance between the marks at issue, regard may be had to the factors set out in Paragraph 6(5)(e) of the *Act*. Further, at page 217, Mr. Justice Gibson indicated that the test was to be applied as a matter of first impression and imperfect recollection and he concurred with the following test set out by Mr. Justice Rothstein in *Canadian Olympic Association v. Health Care Employees Union of Alberta*, 46 C.P.R.(3d) 12, at page 19:

The question must be determined in the context of whether a person who, on a first impression, knowing one mark only and having an imperfect recollection of it, would likely be deceived or confused.

It would appear that the learned trial judge is applying a test similar to that which is applied in considering a likelihood of confusion between trade-marks which is a broader test than the comparison test in previous opposition decisions. However, the decision reached in the *Big Sisters* case suggests that the test being applied by Mr. Justice Gibson is, in fact, a narrower test than a

broader test. While the applicant's trade-mark FIRST NATION is not the same as the opponent's official mark FIRST NATIONS SUMMIT, there is a fair degree of resemblance in appearance, sounding and ideas suggested between the marks in that the applicant's mark is almost identical to the first two words of the opponent's official mark. I am therefore left in a state of doubt regarding the issue of resemblance and, since the onus is on the applicant to show that its trade-mark is registrable, I must resolve that doubt against it. Thus, the final ground is also successful.

In view of the above, and pursuant to the authority delegated to me under Subsection 63(3) of the *Act*, I refuse the applicant's application pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC, THIS 19th DAY OF APRIL, 1999.

G.W. Partington,
Chairperson,
Trade-marks Opposition Board.