



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

Citation: 2010 TMOB 149
Date of Decision: 2010-09-16

**IN THE MATTER OF AN OPPOSITION by
Canadian Fly-In Fishing (Red Lake) Ltd. to
application No. 1,134,529 for the trade-mark
WWW.CANADIANFLYINFISHING.COM &
Design filed by Lac Seul Airways, Ltd.**

FILE RECORD

[1] On March 18, 2002, Lac Seul Airways, Ltd. filed an application to register the trade-mark WWW.CANADIANFLYINFISHING.COM & Design, shown below:



It may not be discernable from the above illustration that the words LAC SEUL AIRWAYS, LTD appear in the bottom right quadrant of the mark and the words AMIK OUTPOSTS appear in the bottom left quadrant. The application is based on use of the mark since November 30, 2000, in association with services described as:

provision of air transportation and outpost
cabin accommodation.

[2] A trade-mark application Examiner with the Canadian Intellectual Property Office objected that the terms (i) WWW.CANADIANFLYINFISHING.COM (ii) OUTPOSTS (iii) AIRWAYS, LTD were clearly descriptive of the applicant's services while the term

(iv) LAC SEUL was clearly descriptive of the place of origin of the applicant's services, and therefore required those terms to be disclaimed. The Examiner also objected that the applied for mark was confusing with two co-pending applications for the marks CANADIAN FLY-IN FISHING and the word and design mark shown below, both belonging to the same entity, covering services similar to those specified in the subject application.

C · A · N · A · D · I · A · N
Fly-in Fishing

The Examiner further required the applicant to provide a translation of the word AMIK appearing in the mark (in the lower left quadrant, preceding the word OUTPOSTS).

[3] The applicant responded to the Examiner by noting that the word AMIK is an indigenous Indian word for "beaver" and by amending the application to disclaim the right to the exclusive use of all the reading matter except for the word AMIK. The applicant further argued that the applications cited by the Examiner should be afforded a narrow ambit of protection and that the overall differences between the applied for mark and the cited marks are sufficient to distinguish between them. The Examiner accepted the applicant's submissions and the subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated February 18, 2004. The application was then opposed on July 15, 2004, by Canadian Fly-In-Fishing (Red Lake) Ltd. ("CFF"), the owner of the cited trade-mark applications referred to above. The Registrar forwarded a copy of the statement of opposition to the applicant on September 7, 2004, as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[4] The applicant also requested that an interlocutory ruling be made on the sufficiency of certain paragraphs of the statement of opposition. In the result, the final pleadings of record are the amended statement of opposition dated July 7, 2005 and the amended counter statement dated July 5, 2005.

[5] The opponent's evidence consists of the affidavits of Evelyn Manning (two affidavits); Ben A. Blackshire; Peter Hagedorn; Thomas Howe; Robert Garner; and Guy Manning. The applicant's evidence consists of the affidavits of John Myers; Jill Deborah Terris; Vernon Jones; Paul Leonard Britton; and Shannon Smith. Only the opponent submitted a written argument, however, both parties were represented at an oral hearing held on August 24, 2010.

STATEMENT OF OPPOSITION

[6] The first ground of opposition, pursuant to s.16(1)(a) of the *Trade-marks Act*, alleges that the applicant is not entitled to register the applied for mark because, at the date of first use on November 30, 2000, it was confusing with the opponent's marks CANADIAN FLY-IN FISHING and CANADIAN FLY-IN FISHING & Design (illustrated earlier) used in Canada by the opponent and its predecessor in title Clibbery, Ltd. since 1965 and since at least May, 1997, respectively.

[7] The second ground, pursuant to s.16(1)(b) of the *Act*, alleges that the applicant is not entitled to register the applied for mark because, at the date of first use on November 30, 2000, it was confusing with the opponent's marks CANADIAN FLY-IN FISHING and CANADIAN FLY-IN FISHING & Design in respect of which applications for registration (Serial Nos. 1,064,423 and 1,064,424, respectively) had been previously filed by the opponent.

[8] The third ground, pursuant to s.16(1)(c), alleges that the applicant is not entitled to register the applied for mark because, at the date of first use on November 30, 2000, it was confusing with the opponent's trade-name CANADIAN FLY-IN FISHING which had been previously used in Canada by the opponent and its predecessor in title Clibbery, Ltd. since 1965.

[9] The fourth ground alleges that the application does not comply with s.30(i) because the applicant knew or ought to have known of the facts referred to in the above pleadings.

OPPONENT'S EVIDENCE

Evelyn Manning

[10] Ms. Manning identifies herself as the President and majority shareholder of the opponent company CFF. The opponent originally operated as Clibbery, Ltd. doing business and providing services under the trade-name and trade-mark CANADIAN FLY-IN FISHING from 1965 to 1980. CFF was incorporated in 1980, assuming all the assets and liabilities of Clibbery, Ltd., which became inactive. CFF has been using the mark CANADIAN FLY-IN FISHING since then. CFF and its predecessor have provided recreational tourist services in and around Red Lake, Ontario for about 38 years. The opponent provides lodging and transportation to 10 remote outpost camps on 7 lakes in northwest Ontario. The opponent provides cabins, boats, motors and other amenities for a week-long wilderness experience.

[11] The opponent began to use the mark CANADIAN FLY-IN FISHING & Design in 1990. CFF uses its marks to identify its services to consumers, merchants and suppliers. The opponent markets its services under its mark and trade-name through print advertising, television advertising and attendance at sports industry trade shows, the latter taking place, it appears, mostly in the United States. Such advertising and promotion expenses are in the range of \$100,000 annually.

[12] In February 2000, Ms. Manning became aware that the applicant had registered and commenced using the internet domain name www.canadianflyinfishing.com. As a result, the opponent commenced a legal action in Ontario against the applicant for passing off and infringement. I have not had regard to Exhibits 6 – 9 of Ms. Manning's affidavit which are comprised of copies of affidavits filed in that action.

Remaining Evidence

[13] Messrs. Blackshire, Howe, Garner and Manning are residents of the United States. Their evidence generally corroborates Ms. Manning's assertions of the opponent's long use of its marks and trade-name for providing customers with fishing and boating recreation in remote regions of northwest Ontario.

[14] Mr. Hagedorn is a resident of Red Lake, Ontario where he has owned and operated a business called Chimo Lodge since 1975. Mr. Hagedorn is a direct competitor

of the opponent. According to Mr. Hagedorn, since 1960 the trade-name CANADIAN FLY-IN FISHING “was uniquely associated with CFF and with no other business in my mind, in the trade and industry in which we compete, and in Red Lake and surrounding communities.”

APPLICANT’S EVIDENCE

Jill Terris

[15] Ms. Terris identifies herself as a trade-mark agent with the firm representing the applicant. Her evidence, based on searches of records kept at the Canadian Trade-marks Office (operating under the aegis of Industry Canada), is that the Examination Branch of the Office raised objections to the opponent’s trade-mark applications for CANADIAN FLY-IN FISHING and CANADIAN FLY-IN FISHING & Design. The objections are that the applied for marks appear not to be registrable because they are clearly descriptive of the opponent’s services specified as “providing lodging and transportation for remote outposts in wilderness settings.” I have noted that the applications are still pending as of the date of this decision.

Vernon Jones

[16] Mr. Jones resides in Minnesota, United States of America. In the 1950s, he was engaged in the business of flying clients to fishing lodges (owned by other persons) in the Canadian wilderness. Such accommodations began to develop because of the availability of “fly-in” air service. According to Mr. Jones, his company “started using the descriptions fly-in fishing and Canadian fly-in fishing in the Fort Francis area and I understand that they are now used generally throughout Canada.” Mr. Jones recalls that Rusty Myers Flying Service was a competitor at that time.

John Myers

[17] John Myers is a resident of Fort Francis, Ontario. He is the son of Rusty Myers referred to above. John Myers began working for his father in 1959 and began flying commercially for his father in 1964. Paragraph 6 of his affidavit is shown below:

Ever since I can remember, the type of service offered to fishermen by my father's company was known as Canadian flyin fishing. I also recall that at various sports shows which I attended, a great number of competitors of my father's business which were also participating in the shows used the term Canadian flyin fishing on their backdrops to describe the services which they provided to fishermen.

Shannon Smith

[18] Ms. Smith is a student who was instructed by the agents for the applicant to conduct searches in magazines and publications dated prior to October 2000 to locate references to the terms "fly-in;" "fly-in fishing;" "fly in fishing;" and "Canadian fly in fishing." Numerous references were found in publications dealing with outdoor recreational activities.

Paul Britton

[19] In 2001, Mr. Britton, then a summer student employed by the agents for the applicant, conducted an Internet search for the term "Canadian fly-in fishing." The results of his search were coalesced in an affidavit dated December 13, 2001, which affidavit forms Exhibit A of his present affidavit. Multitudinous references were found. Such references read, for example, as follows:

. . . Looking for a Canada fly-in fishing trip . . . We offer the finest in Ontario fly-in lake outpost accommodations with exceptional equipment and all the amenities that are needed to make a truly memorable trip.

. . . before flying over camp on our final approach, you can be certain you are about to experience Canadian fly-in fishing at its finest.

Welcome . . . Looking for a Canadian fly-in fishing trip – fishing Canada at Loon Haunt's remote outpost cabins for Walleye, Northern Pike and Lake Trout is the trip of a lifetime.

LEGAL ONUS AND EVIDENTIAL BURDEN

[20] The legal onus is on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponent in the statement of

opposition. The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant. However, there is also, in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298. The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

In the instant case, the opponent's evidence suffices to show that the opponent has been using the term CANADIAN FLY-IN FISHING as a trade-mark and as a trade-name since about 1965.

MAIN ISSUE & MATERIAL DATES

[21] The main issue raised in the statement of opposition is whether the applied for mark WWW.CANADIANFLYINFISHING.COM & Design is confusing with the opponent's trade-mark or trade-name CANADIAN FLY-IN FISHING. The legal onus on the applicant is to show that there would be no reasonable likelihood of confusion, within the meaning of s.6 of the *Act*, paraphrased below, between the applied for mark and the opponent's mark or trade-name:

The use of a trade-mark causes confusion with another trade-mark [or trade-name] if the use of both trade-marks [or trade-mark and trade-name] in the same area would be likely to lead to the inference that the . . . services associated with those trade-marks [or trade-mark and trade-name] are . . . performed by the same person, whether or not the . . . services are of the same general class.

[22] Thus, s.6(2) does not concern the confusion of the marks or trade-names themselves, but confusion of services from one source as being from another source. In the instant case, the question posed by s.6(2) is whether there would be confusion of the applicant's services, sold under the mark WWW.CANADIANFLYINFISHING.COM &

Design, as being a service provided by, or endorsed by, the opponent. The material time to assess the issue of confusion is the date of first use claimed by the applicant, in this case November 30, 2000.

Test for Confusion

[23] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks (or a mark and a trade-name) are confusing, are set out in s.6(5) of the *Act*: the inherent distinctiveness of the marks (or mark and trade-name) and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks (or mark and trade-name) or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

Consideration of s.6(5) Factors

[24] The opponent's mark and trade-name CANADIAN FLY-IN FISHING in my view did not possess any inherent distinctiveness at the material date November 30, 2000. In this regard, the preponderance of the evidence is that the term "Canadian fly-in fishing" had become a commonly used term to describe recreational fishing in remote Canadian locations accessible only by small aircraft. However, the evidence also shows that the opponent's mark and trade-name had acquired some distinctiveness as a result of long use and advertising. In my view the applied for mark WWW.CANADIANFLYINFISHING.COM & Design possesses minimal inherent distinctiveness because (i) the prefix WWW. and suffix .COM are readily recognized as denoting the world-wide web and domain name level, (ii) the dominant component of the mark is the term CANADIANFLYINFISHING, which is readily recognized as the clearly descriptive phrase CANADIAN FLY-IN FISHING. There is no evidence that the applied for mark had acquired any distinctiveness at any material time. The inherent

distinctiveness of the applied for mark arises mostly from its design features. However, the design features of the mark are suggestive, if not descriptive, of the applicant's services. The term AMIK adds some inherent distinctiveness, but only to a limited extent. In this regard, the term AMIK is diminutive and is dominated by the main word component CANADIANFLYINFISHING and by the design features. Thus, the first factor, which is a combination of inherent and acquired distinctiveness, in my view favours the opponent slightly, or is at least a neutral factor favouring neither party.

[25] As an aside, I would mention that the evidence submitted by the opponent in this opposition proceeding to establish the distinctiveness of its mark and trade-name would probably be insufficient to permit registration of its marks under the exception, in s.12(2) of the *Trade-marks Act*, to the prohibition against registering clearly descriptive marks. However, the outcomes of the opponent's applications to register its marks are not particularly relevant to the outcome of this opposition proceeding as different issues, evidential thresholds and legal considerations are involved.

[26] The length of time that the parties' marks (and the opponent's trade-name) have been in use favours the opponent, as the opponent's use predates the applicant's use by about 35 years. The nature of the parties' businesses and trades appear to be the same or at least highly overlapping, which is disadvantageous to the applicant. Lastly, in my view there is a very high degree of resemblance between the opponent's mark and trade-name CANADIAN FLY-IN FISHING and the applied for mark WWW.CANADIANFLYINFISHING.COM & Design in all respects (visually, in sounding, and in ideas suggested) as the dominant component of the applied for mark incorporates the entirety of the opponent's mark. Thus, the resemblance between the parties' marks is a factor which is disadvantageous to the applicant.

Jurisprudence

[27] At the oral hearing, counsel for the applicant relied on *Questor Commercial Inc. v. Discoverer Services Ltd.* (1979), 46 C.P.R.(2d) 58 (F.C.T.D.) as *stare decisis* which, counsel submitted, must result in a rejection of the present opposition. In *Questor*, the opponent was relying solely on its trade-mark registration for SPEEDY MUFFLER CENTRE (for use in association with mufflers and their installation) to oppose the mark

MUFFLER CENTRE & Design (for mufflers). Aside from a certified copy of the opponent's registration, neither party filed any evidence before this Board. The Board refused the application on the basis of confusion with the opponent's registered mark. The applicant filed evidence on appeal to the Trial Division while the opponent did not participate in the appeal. The appeal was allowed on the basis that the words "muffler centre" were generic and common to the trade. The opponent was not permitted to rely on the common features of the marks to establish confusion.

[28] It is not clear to me that *Questor* should be applied in the instant case. As noted by counsel for the opponent, there was no evidence of acquired distinctiveness of the opponent's mark and therefore no discussion in *Questor* of the effect of acquired distinctiveness on the issue of confusion. Further, as noted by counsel for the opponent, more recent cases in the Federal Court of Appeal have taken into account the acquired distinctiveness of a clearly descriptive mark: see, for example, *Miss Universe, Inc v. Bohna* (1995), 58 C.P.R. (3d) 381.

[29] Even if counsel for the applicant is correct that *Questor* should be followed in the instant case, it is not clear to me that *Questor* applies in deciding the issue of confusion between a trade-name and a trade-mark. In this regard, a trade-name is fundamentally different from a trade-mark. A trade-name is not defined as a trade-mark in s.2 the *Act* (as are certification marks, distinguishing guises, and proposed trade-marks). Further, there is no requirement in the *Act* for a trade-name to distinguish particular wares or services. Thus, even if *Questor* does not permit the present opponent to rely on its trade-marks, the opponent may still rely on its trade-name.

DISPOSITION

[30] Considering the above, and keeping in mind in particular the resemblance between the marks in issue, the overlap in the parties' services and the distinctiveness acquired by the opponent's marks and trade-name, I find that on a balance of probabilities the applicant has failed to show that the applied for mark is not confusing with the opponent's marks and trade-name at the material date November 30, 2000.

[31] In view of the foregoing, the subject application is refused. This decision has been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*. The outcome would have been the same if the opponent had relied only on its trade-name.

Myer Herzig
Member
Trade-marks Opposition Board