



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

**Citation: 2013 TMOB 224**  
**Date of Decision: 2013-12-20**

**IN THE MATTER OF AN OPPOSITION  
by Cops for Kids Charitable Foundation  
to application No. 1469561 for the trade-  
mark COPS FOR KIDS SAFETY (K as  
figurine with upraised arms, maple leaf  
below d in the name of Imarketing  
Solutions Group Inc.**

### Background

[1] Imarketing Solutions Group Inc. (the Applicant) has applied to register the trade-mark COPS FOR KIDS SAFETY (K as figurine with upraised arms, maple leaf below d (the Mark), shown below, based upon use in Canada since April 20, 2007, in association with the services “promoting and marketing the community policing and safety services of others” and “promoting and marketing the social, charitable, recreational and sporting events of others”.



[2] Cops for Kids Charitable Foundation (the Opponent) has opposed the application under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[3] The application has been opposed on the grounds that: (i) it does not conform to the requirements of section 30(i) of the Act; (ii) the Applicant is not the person entitled to registration of the Mark under section 16(1)(a) of the Act in view of the Opponent's prior use of the trade-mark COPS FOR KIDS and an associated design mark both of which had been used in Canada by the Opponent and/or its predecessors since at least 2001 in association with a variety of printed and promotional materials and charitable fundraising services as set out in Schedule "A" attached hereto; (iii) the Applicant is not the person entitled to registration of the Mark under section 16(1)(c) of the Act in view of the Opponent's prior use of the trade name COPS FOR KIDS CHARITABLE FOUNDATION; iv) the Applicant is not entitled to registration of the Mark under section 16(1)(a) of the Act in view of the fact that a third party, namely, Canadian Police Association ("CPA") had already adopted and used the Mark for substantially similar services; and v) the Mark is not distinctive within the meaning of section 2 of the Act in view of the fact that CPA had already adopted and used the Mark and continues to use the Mark in association with services which are substantially similar to those of the Applicant.

[4] In support of its opposition, the Opponent filed the affidavit of Beverley Gail Harrison, President of the Opponent, sworn September 21, 2012 (the "Harrison affidavit"). Ms. Harrison was not cross-examined.

[5] As its evidence, the Applicant filed the affidavit of Len Wolstenholme, sworn January 18, 2013 (the "Wolstenholme affidavit"). Mr. Wolstenholme was not cross-examined.

[6] Both parties filed a written argument.

[7] No oral hearing was held.

## Onus

[8] The Applicant bears the legal onus of establishing on a balance of probabilities that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

## Grounds of Opposition Summarily Dismissed

### Non-compliance – Section 30(i)

[9] Section 30(i) of the Act merely requires that an Applicant declare in its application that it is satisfied that it is entitled to registration of its trade-mark. Where an applicant has provided the requisite statement, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. Mere knowledge of the existence of the Opponent's trade-mark or trade-name or a third party's trade-mark does not in and of itself support an allegation that the Applicant could not have been satisfied of its entitlement to use the Mark [see *Woot, Inc v WootRestaurants Inc Les Restaurants Woot Inc* 2012 TMOB 197 (CanLII)].

[10] Accordingly, the section 30(i) ground is dismissed.

### Non-entitlement – Section 16(1)(a) – based upon CPA's use of the Mark

[11] As one of its non-entitlement grounds of opposition, the Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark in view of the fact that a third party, namely, CPA, had already adopted and used the Mark for substantially similar services.

[12] Section 17(1) of the Act states that an application will not be refused on the basis of prior use of a confusing trade-mark or trade-name except at the instance of the user of that confusing trade-mark or trade-name.

[13] As the Opponent is not the user of the mark which it has relied upon, this ground of opposition is hereby dismissed.

#### Analysis of Remaining Grounds of Opposition

#### Non-entitlement – Sections 16(1)(a) and 16(1)(c) – based upon Opponent’s prior use of its trade-marks and trade-name

[14] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark in view of the Opponent’s prior use of its trade-mark COPS FOR KIDS and an associated design mark, both of which had been used in Canada by the Opponent and/or its predecessors since at least 2001 in association with the printed and promotional materials and charitable fundraising services as set out in Schedule “A” attached hereto. In addition, the Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark in view of the Opponent’s prior use of its trade name COPS FOR KIDS CHARITABLE FOUNDATION.

[15] In order to meet its initial burden with respect to its section 16(1)(a) ground of opposition, the Opponent must show that one or both of its pleaded marks had been used or made known in Canada prior to April 20, 2007 and had not been abandoned as at the date of advertisement of the application for the Mark, namely, February 16, 2011 [section 16(5) of the Act].

[16] In order to meet its initial burden with respect to its section 16(1)(c) ground of opposition, the Opponent must show that its pleaded trade name had been used in Canada prior to April 20, 2007.

[17] In support of these grounds of opposition, the Opponent filed the affidavit of Beverley Gail Harrison, sworn September 21, 2012. I have summarized the contents of Ms. Harrison’s affidavit in the paragraphs which follow.

*The Harrison Affidavit*

[18] Ms. Harrison has been actively involved with the affairs of the Opponent as a director since June 27, 2007 and she has served as its President since June 24, 2009 [see paras 1 and 2].

[19] In paragraph 3, Ms. Harrison states that the Opponent has been using its trade-mark COPS FOR KIDS since at least 2001. Attached as Exhibit “A” is a copy of a document entitled “Cops for Kids 2001 Executive Report Nov. 22, 2001”, which Ms. Harrison states details the historical background of the charitable activities of the Opponent and its predecessors. It is unclear whether the document was prepared for internal or external circulation.

[20] Attached as Exhibit “B”, is a certified copy of the Certificate of Incorporation for the Opponent. The Certificate of Incorporation confirms that the Opponent was incorporated on May 29, 2001 in the Province of British Columbia. I note that the fact that the Opponent was incorporated on May 29, 2001 doesn’t lead to an automatic conclusion that the trade-name was in use by the Opponent on that date.

[21] In paragraph 5, Ms. Harrison states that the Opponent has continuously used its trade-mark COPS FOR KIDS in association with, among other things, charitable fundraising services, organizing community events for charitable purposes, namely softball tournaments, golf tournaments and bike-a-thons, since 2001 and the operation of a website to support charitable fundraising efforts. Ms. Harrison states that the Opponent’s activities are conducted with the involvement and support of numerous members of the Royal Canadian Mounted Police. However, Ms. Harrison has not attached any exhibits which show how the trade-mark COPS FOR KIDS was used in connection with the aforementioned services. Moreover, she has not provided any annual sales or advertising figures or any information regarding how the Opponent’s services are promoted in association with its trade-mark.

[22] In paragraph 6, Ms. Harrison states that on or about July 24, 2009, the Opponent began receiving inquiries from persons who had received aggressive telemarketing calls made on behalf of CPA soliciting donations. Ms. Harrison states that the inquiries clearly indicate that the persons who received the telephone solicitations mistakenly believed that the callers were associated with the Opponent rather than the Applicant. Attached as Exhibit “C” are copies of

emails which Ms. Harrison states document complaints. Although Ms. Harrison states that the Opponent received the inquiries, she has not provided any specific details regarding the circumstances under which the emails were obtained or from whom she obtained them.

[23] Ms. Harrison states in paragraph 8 that she spoke with a supervisor of the CPA regarding the nature and extent of the confusion that was occurring amongst consumers between the Applicant's Mark and the Opponent's trade-mark. She has attached a copy of an email detailing this call as Exhibit "D" to her affidavit. The email attached as Exhibit "D" appears to be an email which was sent internally by Ms. Harrison, rather than an external email to someone within the Applicant's company.

[24] In paragraph 9, Ms. Harrison states that on or about January 2010 and February 2010, the Opponent received emails from persons who had received telemarketing calls made on behalf of CPA by the Applicant's telemarketers and that recipients of those calls were directed to the Opponent's website during the calls, rather than to CPA's website or the website of the Applicant. Attached as Exhibit "E" is a copy of some of these emails.

[25] In paragraph 10, Ms. Harrison states that shortly before the Applicant filed its application for the Mark on February 12, 2010, a volunteer board member of the Opponent sent an email to CPA regarding the Opponent's concerns about instances of confusion with respect to the Applicant's Mark and the Opponent's trade-mark. Ms. Harrison indicates that she was advised by the volunteer board member that no reply was ever received from CPA.

[26] In paragraph 11, Ms. Harrison states that the Opponent's signature event is an annual bike-a-thon which takes place in September. Ms. Harrison further states that over the past several years and in particular, the past two years, there has been a significant increase during the months of July and August of the number of complaints and other reports of cold calls initiated by or on behalf of the Applicant within the Southern Interior Region of British Columbia.

[27] In paragraph 12, Ms. Harrison provides some information regarding the Applicant's company. Attached as Exhibit "G" is a copy of a news release issued by the Applicant which indicates that the Applicant had entered into a voluntary settlement agreement with the Canadian Radio-television and Telecommunications Commission ("CRTC") under which it agreed to pay

an administrative monetary penalty to resolve outstanding complaints that had been filed with CRTC arising from calls made by the Applicant's benefit events and marketing business and campaigns for non-profit organizations that are not registered charities. There is no reference to the Applicant's Mark or to the Opponent's trade-mark in the article.

[28] Attached as Exhibit "H" to Ms. Harrison's affidavit is an article dated July 23, 2012 which Ms. Harrison states details another example of consumer confusion between the Applicant's Mark and the Opponent's trade-mark arising from the Applicant's telemarketing activities.

[29] Ms. Harrison concludes by stating that it is her belief that the Applicant's use of its Mark continues to cause confusion amongst Canadian consumers generally and amongst the Opponent's existing and prospective donors [see para 14]. I am not prepared to accord any weight to this statement, as the test for confusion involves questions of fact and law to be determined by the Registrar.

### *Conclusion*

[30] As mentioned previously, Ms. Harrison did not provide any exhibits to show how the Opponent's trade-marks or trade-name have been used. In addition, she has not provided any evidence to establish that the Opponent's trade-marks and/or trade-name were in use prior to the Applicant's April 20, 2007 claimed date of first use. Notably, the instances of confusion which she refers to in her affidavit appear to have taken place subsequent to this date.

[31] In paragraph 5 of her affidavit, she does state that "The Opponent has continuously used the Opponent's Mark in association with, among other things, charitable fundraising services, organizing community events for charitable purposes, namely softball tournaments, golf tournaments and bike-a-thons, since 2001 and the operation of a website to support charitable fundraising efforts". However, without seeing the manner in which it was used, I cannot reach a conclusion that use of the trade-mark occurred in accordance with section 4 of the Act.

[32] The word "use" is a legal term defined in section 4 of the Act and one must look at the evidence filed in order to determine if in fact there has been use of a trade-mark in association with services within the meaning of section 4.

[33] Since the Opponent has not discharged its initial burden to show use of the trade-marks and trade-name upon which it relies in support of these grounds, it is unnecessary for me to discuss the Applicant's evidence with a view to assessing whether or not there is a likelihood of confusion between the Applicant's trade-mark and the Opponent's trade-marks and/or trade-name.

[34] In view of the foregoing, the section 16(1)(a) and (c) grounds are dismissed.

#### Non-distinctiveness – Section 2

[35] The Opponent has pleaded that the Mark is not distinctive within the meaning of section 2 of the Act in view of the fact that CPA had already adopted and used the Mark and continues to use the Mark in association with services which are substantially similar to those of the Applicant.

[36] The material date for assessing this ground is the filing date of the opposition, namely, March 15, 2012 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[37] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its services from those of others throughout Canada there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness [*Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[38] In the present case, the Opponent is under an obligation to show that, as of the filing date of the statement of opposition, namely, March 15, 2012, CPA's trade-mark had become known sufficiently in Canada to negate the distinctiveness of the Applicant's Mark. The reputation of the trade-mark relied upon by the Opponent should be substantial, significant or sufficient



[*Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FC)].

[39] I am not satisfied that the Opponent has met its burden. The Opponent has specifically pleaded that the Mark is not distinctive because as of the material date, CPA had already adopted and used the Mark and continues to do so in association with services which are substantially similar to those of the Applicant. There is no evidence of use of such a mark by CPA in Ms. Harrison's affidavit, nor is there any evidence to suggest that a trade-mark of CPA had become known sufficiently in Canada to negate the distinctiveness of the Applicant's Mark.

[40] Although there are references made to instances of confusion in Ms. Harrison's affidavit, it is not clear that those instances relate to confusion between the Applicant's Mark and a mark which is used and/or owned by CPA. Rather, it appears as though they relate to confusion between the Applicant's Mark and the Opponent's trade-mark.

[41] Accordingly, the non-distinctiveness ground of opposition is also dismissed.

[42] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

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Lisa Reynolds  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

## **Schedule “A”**

### **Wares:**

(1) Printed materials, namely calendars; printed materials in paper and electronic format, namely newsletters, books, maps, advertisements, articles, brochures, posters, banners and booklets; promotional materials, namely mugs, sports bottles, novelty pins, bookmarks, banners and signs; casual clothing; children's clothing; athletic clothing; sports clothing; headwear, namely hats and caps; stationary, namely greeting cards, letterhead, envelopes, writing pads, pens and pencils; souvenir items, namely pins, buttons, cups, mugs, flags, plush toys, labels; stickers, decals, picture frames, balloons and binders; event tents.

### **Services:**

(1) Charitable fundraising services; organizing community events for charitable purposes, namely softball tournaments, golf tournaments and bike-a-thons; operation of a website to support charitable fundraising efforts.