



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

Citation: 2014 TMOB 19
Date of Decision: 2014-01-31

**IN THE MATTER OF AN OPPOSITION
by Susan Fiedler Incorporated to
application No. 1,472,201 for the trade-
mark F CANCER & Design in the name
of Yael Cohen**

[1] On March 8, 2010, Yael Cohen (the Applicant) filed an application to register the trade-mark F CANCER & Design (the Mark), shown below, based on use in Canada since September 28, 2009 in association with “apparel, namely t-shirts” and “operation of a charitable foundation concerned with the detection and prevention of cancer” (the Wares and Services).



[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of January 12, 2011.

[3] On March 14, 2011, Susan Fiedler Incorporated (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- the Mark is not registrable on the basis that it causes confusion with the Opponent’s trade-marks F CANCER, FUCK CANCER, F* CANCER and F---CANCER (the Opponent’s F CANCER Marks) which have been used in

Canada by the Opponent and its predecessors since May 2008 in association with jewellery and fundraising charities relating to cancer;

- the Applicant is not entitled to registration of the Mark because the Applicant is an individual and the use as claimed in the application, if any, is by an organization and because of the facts pleaded in the remainder of the statement of opposition;
- the Mark did not distinguish the Wares and Services from those of the Opponent which were used in association with the F CANCER Marks since prior to the date of use claimed by the Applicant; and
- the application does not comply with section 30 as the Applicant could not have been satisfied of her entitlement to use the Mark in Canada in association with the Wares and Services for the reasons set out in the remaining grounds of opposition.

[4] The Applicant served and filed a counter statement in which it denied the Opponent's allegations and put the Opponent to the strict proof thereof.

[5] In support of its opposition, the Opponent filed an affidavit of Susan Fiedler. Ms. Fiedler was cross-examined on her affidavit. The Opponent also filed an affidavit of Andrew Tan as its reply evidence. However, at the oral hearing, the Opponent advised that it would no longer be relying on the Tan affidavit and asked that it be removed from the record.

[6] In support of its application, the Applicant filed her own affidavit. Ms. Cohen was not cross-examined on her affidavit.

[7] Both parties filed written arguments and were represented at an oral hearing.

Onus and Material Dates

[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].

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

- sections 38(2)(a)/30 - the date of filing the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)].
- section 38(2)(b)/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 CPR (3d) 413 (FCA)]
- sections 38(2)(c)/16(1) - the claimed date of first use [see section 16(1) of the Act].
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Summary Dismissal of Grounds of Opposition

Non-registrability

[1] The Opponent does not make specific reference to section 12(1)(d) of the Act in pleading a non-registrability ground based on confusion with the Opponent's F CANCER Marks. However, I consider it appropriate to infer that this ground is based on section 12(1)(d) of the Act. According to *Novopharm Limited v AstraZeneca AB* (2002), 21 CPR (4th) 289 (FCA) I must assess the sufficiency of the pleadings in association with the evidence. As pleaded, there are no references to registration numbers for the Opponent's F CANCER Marks. Furthermore, the evidence reveals that these marks have not been registered.

[2] Based on the foregoing, I find that this ground of opposition has been insufficiently pleaded and it is dismissed accordingly.

Non-entitlement – introductory paragraph

[3] The Opponent alleges that the Applicant is not entitled to registration of the Mark since the Applicant is an individual and the use as claimed in the application, if any, is by an organization and also because of the facts pleaded in the remaining grounds of opposition (i.e. confusion with the Opponent's F CANCER Marks).

[4] While specific reference is not made thereto, it appears that the first portion of this ground of opposition is based on the introductory portion of 16(1) of the Act alleging that the application does not comply with the requirements of section 30 of the Act.

[5] The introductory paragraph of section 16(1) of the Act does not form the basis of a ground of opposition as defined in section 38(2) of the Act since section 16(1) of the Act as a whole relates to the entitlement grounds of opposition. Accordingly, I dismiss the portion of the non-entitlement ground of opposition which is based solely upon the introductory paragraph of section 16(1) of the Act.

[6] The portion of the non-entitlement ground which relates to confusion with the Opponent's previously used trade-marks is, when considered in combination with the statement of opposition as a whole, properly pleaded and will be assessed in further detail below.

Non-entitlement Ground – section 16(1)(a)

[7] Despite the onus of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's F CANCER Marks, the Opponent has the initial onus of proving that one or more of the trade-marks alleged in support of its ground of opposition based on section 16(1)(a) of the Act was used in Canada prior to the claimed date of first use for the Mark (September 28, 2009) and had not been abandoned at the date of advertisement of the application for the Mark (January 12, 2011) [section 16(5) of the Act]

[8] The Opponent pleaded that its F CANCER Marks were used in association with jewellery and fundraising for charities relating to cancer since at least May 2008.

[9] In her affidavit, Ms. Fiedler makes the sworn statement that since May 2008 the Opponent and its predecessors in title have sold and advertised bracelets in association with the F CANCER Marks. Ms. Fiedler also explains that sales of the bracelets were combined with an act of charity by donating a portion of the profits (50\$/bracelet) to a charitable organization. In addition to a photograph of the bracelet, which clearly shows the trade-mark F U C K C A N C E R displayed thereon (Exhibit A), Ms. Fiedler provides sample invoices evidencing sales of the

bracelets identified in the invoices as F--- CANCER by the Opponent's predecessor in May 2008 (Exhibit C). The May 14, 2008 invoice refers to a "Lymphomia Donation" which means a donation raised and collected by the Opponent's predecessor for the Leukemia & Lymphoma Society. Ms. Fiedler also attaches to her affidavit a true copy of an invoice dated November 14, 2008 showing the sale of two bracelets identified by the trade-mark F-CANCER and the collection of two \$50.00 donations for InspireHealth (Exhibit D).

[10] Ms. Fiedler states that as of the date of her affidavit the Opponent had, through the sale of bracelets, raised over \$100,000 for charities relating to cancer. Furthermore, she states that the Opponent's "bracelets and 'fuck cancer' message have been very popular" (paragraph 23). In its written argument, the Opponent submits that its F CANCER Marks have become very well known in the Vancouver area and around the world through the sale of the bracelets and in association with raising funds for charities relating to cancer. Ms. Fiedler makes the sworn statement that the Opponent's bracelets and charitable activities have received significant support from people all over the world, including from celebrities like Sarah McLaughlin and the Barenaked Ladies (paragraph 23). She states that she has done interviews on television programs to discuss the work that the Opponent is doing (paragraph 23). In support of these statements, Ms. Fiedler provides printouts from the Opponent's websites: *susanfiedler.com* and *fcancerembracelife.com* as well as an article from *SamaritanMag.com* (paragraph 23, 24, Exhibit G). While the website printouts cannot be relied upon as evidence of the truth of their contents, I find that they provide corroborative evidence for Ms. Fiedler's statements regarding the media attention received by the Opponent for its bracelets and fundraising activities [*Candrug Health Solutions Inc v Thorkelson* (2007), 60 CPR (4th) 35 (FC); reversed on other grounds 2008 FCA 100].

[11] At the oral hearing, the Applicant's agent essentially conceded that the Opponent had sold bracelets and raised charitable funds in association with the words "FUCK CANCER" since prior to the Applicant's claimed use date. However, the Applicant submitted that this was of no concern since the Opponent's activities did not amount to use of the F CANCER Marks in accordance with section 4 of the Act.

[12] The Applicant submits that the Opponent did not intend to use the F CANCER Marks as a source-identifier but rather merely as a slogan/rally cry/message. Specifically, the Applicant pointed to Ms. Fiedler's statements that the slogan "fuck cancer" "signified the strong emotions [she] experienced in [her] battle with this horrible disease and in particular, the enormous fear and anger that were such a powerful part of that experience. Strong words seemed appropriate." (paragraph 7). Ms. Fiedler also stated that "many people shared the attitude toward cancer that the bracelet represented. The words 'fuck cancer' resonated deeply with people who were battling cancer or who had lost friends and family members to cancer" (paragraph 9). The Applicant also points to Ms. Fielder's comments on cross-examination where she agreed with statements that the "fuck cancer" message "was a good luck phrase" and "inspired a bold approach to dealing with cancer", etc. (p. 3 – 5 of transcript of cross-examination of Ms. Fiedler).

[13] On this basis, the Applicant submits that the Opponent has not used the trade-mark in association with jewellery and fundraising services in accordance with section 4(1) and (2) of the Act.

[14] I do not agree with the Applicant's submissions on this point. It is true that the Opponent's F CANCER Marks do communicate a message of standing up to cancer with a sort of slogan or rally cry. However, the evidence is clear that the Opponent has satisfied the requirements of section 4(1) and 4(2) in that the display of the F CANCER Marks on the bracelets and otherwise so associated with the Opponent's services, as outlined above, constitute evidence of use of the Opponent's F CANCER Marks prior to September 28, 2009 and non-abandonment of these marks at the date of advertisement. There is no reason why a trade-mark cannot function both to communicate a message and as a source identifier.

[15] Based on the foregoing, the Opponent has succeeded in meeting its evidential burden for this ground of opposition. I must now assess whether the Applicant has met its legal burden.

[16] 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.

[17] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 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 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 96 CPR (4th) 361 (SCC).]

[18] In *Masterpiece*, the Supreme Court of Canada discussed the importance of the section 6(5)(e) factor in conducting an analysis of the likelihood of confusion between the parties' marks in accordance with section 6 of the Act (see para 49):

...the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis ... if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar... As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start... [Emphasis is mine]

[19] Under the circumstances of the present case, I consider it appropriate to analyse the degree of resemblance between the parties' marks first.

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

[20] In its written argument the Opponent submits that its trade-mark F--- CANCER is the most visually similar to the Mark as it includes a horizontal line beside the letter "F" much like the Mark features a ribbon design. The Opponent submits that the only purpose of the horizontal line in the trade-mark F--- CANCER is to truncate the word "fuck" which is offensive to some and itself not registrable as a trade-mark.

[21] I am of the view that the parties' marks are essentially identical. While the Mark features design elements, the dominant word element, F CANCER, is identical to the Opponent's trademarks F CANCER, F* CANCER and F--- CANCER and almost identical to the trade-mark FUCK CANCER. All of the marks suggest the idea of standing up to cancer with a rally cry of sorts expressing the frustration of individuals suffering from (or otherwise affected by) cancer.

[22] Having found that the parties' marks share a significant degree of resemblance, I must now assess whether any of the other factors are sufficient to shift the balance of probabilities in the Applicant's favour.

Section 6(5)(a) – inherent distinctiveness and the extent to which the marks have become known

[23] As discussed in greater detail above, the parties' marks are made up of a letter and a dictionary word which in both cases work together to create a "slogan" which possesses a moderate degree of inherent distinctiveness.

[24] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. I will now turn to the extent to which the trade-marks have become known in Canada.

[25] The Applicant's evidence establishes use of the Mark since September 2009. In her affidavit, Ms. Cohen states that the Applicant operates a website at www.letsfcancer.com which can be accessed across Canada and which prominently displays the Mark (Exhibit D). Ms. Cohen explains that the website features an online store selling t-shirts which bear the Mark. She also explains that profits from the sale of these t-shirts are donated to the Applicant's charitable foundations which serve to educate individuals and raise monies for the early detection of cancer. She provides a screenshot of the official store from her webpage which shows t-shirts available for sale bearing the Mark. Ms. Cohen also provides approximate total volumes of sales for t-shirts in Canada for the years 2009 – 2012 with sales ranging from \$25,000 to \$46,000. Ms. Cohen also provides statistics on hits to her website for the same years as well as invoices supporting the sales of t-shirts to various individuals and companies from October 7, 2009 to July 8, 2011 (Exhibit F).

[26] As discussed in further detail above, the Opponent provides evidence of use and reputation for its F CANCER Marks since May 2008. The Opponent has raised significant funds and received substantial media attention. While the Opponent has not provided sales figures for sales of its bracelets directly, Ms. Fiedler states that sales of the bracelets have generated at least \$100,000 in monies raised for charity. Given that this amounts to only a portion of the proceeds from the sales of the bracelets, I am prepared to infer that sales figures for the bracelets would have been substantial.

[27] Based on a review of the evidence as a whole, I am of the view that the considerations of inherent distinctiveness and extent to which the marks have become known do not significantly favour either party.

Section 6(5)(b) – the length of time each has been in use

[28] The Applicant claims use of the Mark since September 28, 2009. The Opponent claims, and has established, use of its F CANCER Marks since May 2008.

Section 6(5)(c) and (d) – the nature of wares, services or business and trade

[29] The parties' services are identical. While the parties' wares are not identical, jewellery and apparel are both personal items relating to fashion, and thus they share some degree of similarity.

Conclusion

[30] As discussed above, in *Masterpiece* the Supreme Court of Canada highlighted the importance of the section 6(5)(e) factor in the analysis of the likelihood of confusion. In the present case, I have found the parties' marks to share a significant degree of similarity in sound, appearance and idea suggested. None of the other factors were sufficient to shift the balance of probabilities in the Applicant's favour and thus, I am not satisfied that the Applicant has discharged its burden of showing that there is no reasonable likelihood of confusion between the parties' marks. Having regard to the foregoing, I find that the non-entitlement ground of opposition based on section 16(1)(a) of the Act is successful.

Non-Distinctiveness Ground – section 38(2)(d)

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

[32] Pursuant to its evidential burden, the Opponent is under an obligation to show that, as of the filing of the statement of opposition, one or more of its F CANCER Marks had become known sufficiently to negate the distinctiveness of the Mark [see *Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FC)].

[33] As discussed more fully in the analysis of the non-entitlement ground of opposition based on section 16(1)(a) of the Act, the Opponent was successful in establishing that one or more of its F CANCER Marks had become known to some extent as of the date of filing the statement of opposition and as a result the Opponent has met its evidential burden.

[34] The difference in material dates is not significant and as a result my finding under the grounds of opposition based on section 16(1)(a) of the Act is equally applicable here. As a result, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there was no reasonable likelihood of confusion between the Mark and one or more of the Opponent's F CANCER Marks as of the filing of the opposition and thus, the non-distinctiveness ground is also successful.

Remaining Ground of Opposition

[2] As I have already refused the application under two grounds, I will not address the remaining ground of opposition alleging non-compliance with section 30(i) of the Act.

Disposition

[35] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office