

**IN THE MATTER OF AN OPPOSITION
by Gemme Canadienne P.A. Incorporated
to application no. 1106597 for the
trade-mark MAPLE LEAF DIAMONDS
filed by 844903 Ontario Limited t/a
Corona Jewellery Company**

On June 15, 2001, 844903 Ontario Limited trading as Corona Jewellery Company filed an application to register the trade-mark MAPLE LEAF DIAMONDS, based on proposed use in Canada, in association with:

wares

diamonds; diamond jewellery;
printed, lithographed and engraved material namely, books, brochures, pamphlets, postcards, calendars, pictures and posters;
paper products and office supplies namely, writing instruments, namely pencils, markers, pens, bags, writing paper and envelopes;
business supplies, namely business cards, letterhead paper, desk blotters, memo paper, note paper and invoices;
packaging material such as boxes and protective sheaths for carrying and storing diamonds, diamond handling and diamond viewing supplies namely, magnifying loupes and tweezers,

services

wholesale sales of diamonds to jewellers, jewellery designers, jewellery manufacturers, goldsmiths, and to other retail outlets; retail jewellery sales;
marketing of diamonds for third parties by means of magazine advertisements, promotional videos, brochures, mail-outs, cards and price lists;
diamond cutting;
promotion of diamond cutting.

The Examination Section of the Trade-marks Office objected to the application on the basis that (i) the applicant was required to disclaim the right to the exclusive use of the word DIAMONDS apart from the mark as a whole, at least in relation to wares and services connected to

diamonds, and (ii) the mark was confusing with three registered trade-marks including the design mark, regn. no. 356503, illustrated below, which, for ease of reference, I will designate as DIAMOND & MAPLE LEAF Design:



wares: pearls and jewellery
services: designing and manufacture of jewellery to the specification of the client

In response to the Examination Section, the applicant submitted a revised application disclaiming the word DIAMONDS and argued against the Examiner's second objection as follows (see the file record, correspondence dated September 19, 2002):

The Examiner is respectfully requested to reconsider and withdraw the objection pursuant to Section 12(1)(d) of the *Trade-marks Act*. Each of the three prior registered mark cited by the Examiner comprises the representation of a diamond and a representation of all or part of a maple leaf. If these three marks can co-exist on the Register, then the scope of protection available to each one must be very narrow. Accordingly, looking at the marks as a whole, there would be no likelihood of confusion between the subject mark and any of the prior registered marks. Accordingly, we respectfully request that the Examiner withdraw the objection pursuant to Section 12(1)(d) of the *Trade-marks Act*.

The Examiner accepted the applicant's submissions and the subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated December 11, 2002. The opponent Gemme Canadienne P.A. Incorporated filed a statement of opposition on August 11, 2003, a copy of which was forwarded to the applicant by the Registrar, on October 14, 2003, pursuant to Section 38(5) of the *Trade-marks Act*. The applicant responded by filing and serving

a counter statement generally denying the opponent's allegations.

STATEMENT OF OPPOSITION

The statement of opposition may be summarized as follows:

The opponent pleads that it is the owner of the mark DIAMOND & MAPLE LEAF Design, regn. no. 356503, referred to earlier, and is the owner of the same mark, registered in the USA (regn. no. 2528767) on January 15, 2002, covering the wares "jewellery."

The first ground of opposition, pursuant to Section 30(i) of the *Trade-marks Act*, alleges that at all material times the applicant could not have been satisfied that it was entitled to use the applied for mark MAPLE LEAF DIAMONDS. In this regard, the applied for mark "is the verbal expression for the Opponent's registered mark" and the opponent has "extensive and long-standing use" of its design mark in Canada.

The second ground, pursuant to Section 16(3)(a) of the *Act*, alleges that the applicant is not entitled to register the applied for mark MAPLE LEAF DIAMONDS because at all relevant times it is confusing with the opponent's mark DIAMOND & MAPLE LEAF Design which has a history of "long standing and extensive use" in association with pearls and jewellery.

The third ground, pursuant to Section 12(1)(d) of the *Act*, alleges that the applied for mark MAPLE LEAF DIAMONDS is not registrable because it is confusing with the opponent's aforementioned registration for DIAMOND & MAPLE LEAF Design.

The fourth ground on opposition, shown in full below, alleges that the applied for mark is not distinctive of the applicant's wares:

The Opponent further basis its opposition on the grounds provided by Section 38(2)(d) namely, that the trade-mark **MAPLE LEAF DIAMONDS**, covered in application no. 1,106,597 is not distinctive of the Applicant not is it adapted so as to distinguish the wares of the Applicant from the wares of the Opponent which are associated with the Opponent's trade-mark as set out and claimed in its registration no. TMA356,503. The opposed trade-mark is nothing more that the verbal expression of the Opponent's registered trade-mark and therefore, in view of the high level of reputation the Opponent has developed in its trade-marks, the Applicant's proposed trade-mark cannot and does not distinguish the Applicant's wares from the wares of the Opponent which are associated with the Opponent's trademark.

EVIDENCE

The opponent's evidence consists of the affidavit of Pierre Akkelian, President of the opponent company. The applicant's evidence consists of the affidavits of John Minister, President of the applicant company, and Petra J. McDonald, trade-marks searcher. Both parties filed a written argument and both were represented at an oral hearing.

OPPONENT'S EVIDENCE

Mr. Akkelian's evidence may be summarized as follows. The opponent company is a family business incorporated in 1973. Mr. Akkelian is one of the co-founders of the business. The opponent operates one retail store in Montreal and over the last 30 years has developed into one of Canada's leading pearl importers and pearl jewellery companies. The opponent company now has three divisions namely, manufacturing, import, and wholesale/retail. Many of the jewellery items sold by the opponent are original conceptions comprised of imported pearls. The opponent's design trade-mark is displayed on every page of its website, on business cards, on letterhead, on invoices and in advertising material, and on booths at trade shows: see Exhibits A, C to F attached to Mr. Akkelian's affidavit.

Paragraph 17 of Mr. Akkelian's affidavit is shown in full below:

My Company's has used its DIAMOND MAPLE LEAF design trade-mark in its daily business operations since 1989. The DIAMOND MAPLE LEAF design has become inexorably linked with Gemme Canadienne P.A. Incorporated. The appearance of the DIAMOND MAPLE LEAF design on articles of jewellery, business advertising materials or in any other manner associated with the jewellery industry is synonymous with the high stands of quality and design that our direct clients, our wholesale client's and our suppliers have come to expect from Gemme Canadienne P.A. Incorporated.

I note, however, that in most of the aforementioned examples of use of the opponent's design mark, the mark is accompanied by the phrase "Canadian Gem" or "Gemme Canadienne" or sometimes both phrases. However, the opponent's mark does appear by itself where it is imprinted on individual pieces of jewellery: see Exhibit G.

APPLICANT'S EVIDENCE

Mr. Minister's evidence may be summarized as follows. The applicant company commenced use of the applied for mark MAPLE LEAF DIAMONDS in December 2003. About one year later, the applicant was wholesaling jewellery to over 300 jewellery stores throughout Canada including the Yukon, Northwest and Nunavut Territories. The diamonds comprising the jewellery sold under the mark MAPLE LEAF DIAMONDS are mined in the Northwest Territories from Canada's first diamond mine. Each diamond bears (i) a laser mark ("MAPLE LEAF Design", the subject of a separate trade-mark application, no. 1195871, filed by the applicant) as shown below,



and (ii) a tracking number that can be traced to the mine of origin, as well as other indicia indicating Canadian origin.

Every piece of jewellery that is sold by the applicant under the MAPLE LEAF DIAMONDS mark is accompanied by a Certificate of Origin (a plastic card) bearing a tracking number and

prominently displaying the mark MAPLE LEAF DIAMONDS. The applied for mark also appears (sometimes accompanied by MAPLE LEAF Design) on advertising brochures, on invoices, in advertisements placed in trade journals distributed to jewellery retailers and jewellery shows across Canada, on counter cards, posters, banners, and flyers.

Mr. Minister notes that Exhibit E of Mr. Akkelian's affidavit shows that a display booth of the opponent was adjacent to a display booth of the applicant at a jewellery trade show held on August 10-12, 2003. The opponent's mark DIAMOND & MAPLE LEAF Design, together with the words CANADIAN GEM, are prominently displayed on the opponent's booth. The applicant's booth prominently displays the applicant's trade-name CORONA. It appears that the booths are displaying the parties' wares in much the same way that a jewellery retailer would display wares. Mr. Minister notes that the parties attend many, if not all, the same jewellery trade shows and advertise in the same magazines. The applicant not only sells jewellery under its mark MAPLE LEAF DIAMONDS but also sells diamonds to jewellers, jewellery designers, jewellery manufacturers and goldsmiths. Beginning in June 2001, the applicant distributed across Canada thousands of certificates of authenticity from the Government of the Northwest Territories along with diamonds sold by the opponent. The certificates attest to the authenticity of the diamond being mined, cut and polished in the Northwest Territories. The certificate prominently displays the image of a maple leaf: see Exhibit H of Mr. Minister's affidavit. Mr. Minister also testifies that during the fifteen year period prior to the date of his affidavit (December 23, 2004), he has seen the marks shown below used in the Canadian jewellery marketplace:



a mark of The Government of the Northwest Territories



a mark of The Government of the Northwest Territories



a mark of Brian Cahill & Associates Ltd.



a mark of BHP Billiton Diamonds

Lastly, Mr. Minister attests that the opponent is known in the marketplace for the sale of pearls rather than for selling diamonds or diamond jewellery. Mr. Minister's statement is supported

by Exhibit I to his affidavit namely, an excerpt from the Canadian Jeweller 2004 Jewellery World Expo Show Guide describing the applicant as a diamond jewellery and diamond dealer, while the opponent is described as a pearl specialist and pearl importer dealing in pearls and pearl jewellery.

Ms. McDonald's affidavit serves to introduce into evidence her findings in respect of computer searches of the Trade-marks Register. The first search concerns trade-marks that include "a representation of a maple leaf along with a schematic design of a precious gem or diamond." Four marks were found including the opponent's mark DIAMOND & MAPLE LEAF Design. Mr. Minister in his affidavit testifies that he is familiar with the three remaining marks, that is, two belonging to The Government of the Northwest Territories (shown earlier) and one (an expunged mark) belonging to Tordiam Inc.

The second search concerns active marks that "include the design of a 'maple leaf' and include 'jewellery' in the statement of wares and/or services." Eighty four marks were located, including two familiar to Mr. Minister namely, the marks belonging to Brian Cahill & Associates Ltd. and to BHP Billiton Diamonds referred to earlier.

The third search concerns marks that include a " 'maple leaf' in the actual trade-mark and include 'jewellery' in the statement of wares and/or services." Twenty-four marks were located with some of the marks overlapping the second search.

It appears that the marks located in the first search are primarily used in association with jewellery, while the marks located in the other searches cover a number of wares and services and incidentally include jewellery.

MAIN ISSUE

The main issue in this proceeding is whether the applied for mark MAPLE LEAF DIAMONDS is confusing with the opponent's design mark registration no. 356503. The material dates to assess the issue of confusion are (i) the date of my decision with respect to the ground of opposition alleging non-registrability; (ii) the date of opposition (October 24, 2003) with respect to the ground of opposition alleging non-distinctiveness; and (iii) the date of filing the application with respect to the grounds of opposition alleging non-entitlement: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 C.P.R.(3d) 198 at 206 - 209 (F.C.T.D.). However, in the circumstances of this case, nothing turns on whether the issue of confusion is determined at a particular material date.

The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2) of the *Trade-marks Act*, between the applied for mark and the opponent's mark. The presence of an 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: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.). 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 are

confusing, are set out in Section 6(5) of the *Trade-marks Act*: the inherent distinctiveness of the marks 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 the sound of the marks 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.).

SECTION 6(5) FACTORS

The opponent's design mark possesses little inherent distinctiveness as the diamond design component of the mark is suggestive of the applicant's wares and services, that is, of jewellery and precious or semi-precious gems. The other design component of the mark namely, the image of the maple leaf, is symbolic of Canada and, as may be inferred from Ms. McDonald's evidence, is a fairly ubiquitous feature of trade-marks in the Canadian marketplace. Thus, the opponent's mark is a relatively weak mark. The applied for word mark MAPLE LEAF DIAMONDS is also a weak mark because it is suggestive of the applicant's wares and services, that is, of diamonds and jewellery originating in Canada. It is difficult to arrive at any definite conclusion regarding the extent to which the opponent's design mark has become known in Canada. In this regard, the opponent has not provided any quantitative data regarding the extent of its sales. However, on a fair reading of the evidence, and in the absence of cross-examination of Mr. Akkelian, I am prepared to find that the opponent's mark had acquired a significant reputation in Canada at all material times. The applicant's evidence also lacks quantitative information regarding the extent of its sales. However, on a fair reading of the applicant's evidence and in the absence of cross-examination of

Mr. Minister, I am prepared to infer that the applied for mark acquired a significant reputation in Canada by December 2004, that is, one year after it began using its mark. The length of time that the marks in issue have been in use favours the opponent as its design mark has been in use since April 1989. However, because the extent of use of the opponent's mark has not been evidenced and no inferences have been made regarding the acquired distinctiveness of the mark prior to the earliest material date, the length of time that the marks in issue have been in use is not a weighty factor.

The parties' wares, services and the nature of their trades overlap considerably but are also distinct. Both parties manufacture their own jewellery and the evidence shows that the opponent's wares are sometimes comprised of both pearls and diamonds. Nevertheless, it appears to me that each party occupies a specialty niche in the jewellery trade, the applicant's niche being Canadian diamonds and the opponent's niche being imported pearls.

The opponent is not under any obligation to evidence confusion in order for me to find that there is a likelihood of confusion. However, in certain cases the absence of confusion despite an overlap of wares, services or channels of trade may lead to a negative inference about the strength of the opponent's case: see *MonSport Inc. v. Vetements de Sport Bonnie (1978) Ltée* (1988), 22 C.P.R. (3d) 356 (F.C.T.D.), *Mercedes-Benz A.G. v. Autostock Inc. (formerly Groupe T.C.G. (Québec) Inc.)*, 69 C.P.R. (3d) 518 (TMOB). In the subject case there have been no instances of actual confusion despite an overlap in the wares, services, and channels of trade of the parties and despite contemporaneous use of the marks. The applicant offers a cogent explanation at pages 8-9 of its written argument:

At the oral hearing counsel for the applicant argued that another contributing factor was at play. The argument went as follows. The opponent uses its design mark almost invariably together with the phrase "Canadian Gem." The jewellery trade, and the average consumer of jewellery, may therefore have been conditioned to "translate" the opponent's design mark as "Canadian gem" rather than as "diamond and maple leaf" since the maple leaf design is iconic of Canada. Further, a "gem" is as valid an interpretation of the line drawing as a "diamond." If so, then the resemblance

Given the nature of the jewellery business, the consumer is very discriminating in purchasing jewellery. Any type of jewellery, whether it is a diamond ring, a pearl necklace, earrings, bracelet or a brooch, even if it is expensive or relatively inexpensive, is not purchased casually. Considerable thought and deliberation is made by the ultimate consumer, often with the advice of a partner (Le. spouse, friend or parent) before any type of jewellery is purchased. Therefore, due to the unique nature of the jewellery industry, jewellery stores and ultimate consumers are very deliberate in their decision-making process. The consumer will not be confused between the Applicant's Trade-mark and the Opponent's mark. Furthermore, considering that each diamond sold by the Applicant in association with this Trade-mark also includes a distinctive geometric laser mark and tracking number evidencing the Canadian mine of origin, and that each diamond comes with an individual Certificate of Origin bearing the unique tracking number assigned to that diamond (see paragraphs 9 and 10, Exhibit A to the Minister affidavit), there is no possibility of confusion with the ~~Opponent's mark~~ between the applicant's design mark and the applied for mark (as particularized in Section 6(5)(e)) is considerably lessened, resulting in a reduced likelihood of confusion. In my view, the applicant's above arguments have some merit.

With respect to Section 6(5)(e) of the *Act*, I find that the overall visual impacts of the marks in issue are decidedly different. In this regard, the applied for mark is a word mark and the opponent's mark is a design mark. There are no word components comprising the opponent's mark and there are no design components comprising the applied for mark. Hence, there is no visual

resemblance. The ideas suggested by the marks in issue are similar to the extent that consumers would be led to believe that the parties' jewellery originate in Canada. Lastly, there is potential for overlap in the aural aspects of the marks in issue as the opponent's mark might be vocalized as "diamond shape with a maple leaf in it." However, as argued by the applicant, it is also quite plausible that the opponent's mark would be vocalized as "Canadian gem."

Considering the above, and keeping in mind in particular that (i) the parties' marks are inherently weak marks and small differences suffice to distinguish weak marks: see *GSW Ltd. V. Great West Steel Industries Ltd.* (1975), 22 C.P.R.(2d) 154 (F.C.T.D.), (ii) the visual impacts of the marks in issue are decidedly different, (iii) the parties occupy specialty niches albeit within the same trade namely, the jewellery trade, and (iv) consumers are generally careful and deliberate concerning purchases of jewellery, I find that the applicant has met the onus on it to show, on a

balance of probabilities, that at all material times the marks in issue are not confusing.

DECISION

In view of the above, the opposition is rejected.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 3rd DAY OF JANUARY, 2007.

Myer Herzig,
Member,
Trade-marks Opposition Board