



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

Citation: 2010 TMOB 73
Date of Decision: 2010-06-10

**IN THE MATTER OF AN OPPOSITION
by Westcan Greenhouses Ltd. to
application No. 1,297,989 for the trade-
mark PATIO HARVEST in the name of
Proven Winners North America LLC**

[1] On April 18, 2006, Proven Winners North America LLC [the Applicant] filed an application to register the trade-mark PATIO HARVEST [the Mark] based on proposed use in Canada and use and registration in the United States of America under number 3,104,758 dated June 13, 2006 in association with living plants [the Wares].

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of January 31, 2007.

[3] On August 7, 2007 Westcan Greenhouses Ltd. [the Opponent] filed a statement of opposition. The grounds of opposition can be summarized as follows:

- (a) The Mark is not registrable pursuant to s. 12(1)(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 [the Act] because it is confusing with the Opponent's registered trade-mark PATIO PERENNIALS, registration No. TMA522,921 for "living plants".
- (b) The Applicant is not the person entitled to registration of the Mark since, contrary to the provisions of s. 16(2)(a) and 16(3)(a) of the Act, prior to and at

the date of filing the application, the Mark was confusing with the Opponent's trade-mark PATIO PERENNIALS which had been previously used in Canada.

(c) The Applicant is not the person entitled to registration of the Mark since, contrary to the provisions of s. 16(2)(b) and 16(3)(b) of the Act, prior to and at the date of filing the application, the Mark was confusing with the trade-mark PATIO PERENNIALS an application for which had been previously filed in Canada by the Opponent.

(d) The Mark is not distinctive because it is not capable of distinguishing the Wares from the wares of the Opponent, nor is it adapted to so distinguish them because the Mark is confusing with the Opponent's trade-mark PATIO PERENNIALS.

[4] The Applicant served and filed a counter statement on September 27, 2007 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 Eric E. Voogt sworn April 30, 2008, with Exhibits A through I.

[6] In support of its application, the Applicant filed an affidavit of Anne Muter, sworn August 28, 2008, with Exhibits A through E.

[7] Only the Applicant filed a written argument. Neither party requested an oral hearing.

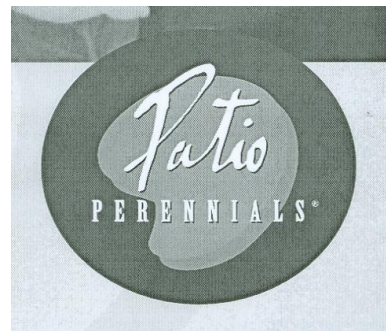
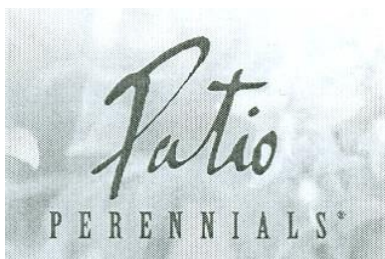
Evidence

Opponent's Evidence: Eric E. Voogt

[8] Mr. Voogt is the Opponent's President and Office Manager. Mr. Voogt states that the Opponent has operated a greenhouse business headquartered in Langley, British Columbia for over 27 years. Mr. Voogt also states that the Opponent is the owner of the trade-mark PATIO PERENNIALS registered under No. TMA522,921 for "living plants" [the Cited Mark] based on a declaration of use filed on January 19, 2000 (Exhibit A). Mr. Voogt states that PATIO

PERENNIALS is the Opponent's primary brand which it has used in association with living plants since January 19, 2000.

[9] In view of the Applicant's submission that the Opponent's evidence predominantly shows the Cited Mark in the following two forms, I note that the Opponent is not under a restriction to use the Cited Mark in any particular format by virtue of the fact that the registration is for a word mark.



[10] The use of the words "patio perennials" as part of the above designs can be considered use of the Cited Mark.

[11] Mr. Voogt attaches to his affidavit a screen capture of the homepage of the Opponent's website, www.patioperennials.com (Exhibit B), which displays the Cited Mark. Mr. Voogt states that the site is accessible across Canada and elsewhere but does not provide any evidence as to the number of Canadians who have viewed the website. Without such information, very little weight can be placed on Internet evidence of this nature [see *Candrug Health Solutions Inc. v. Thorkelson* (2007), 60 C.P.R. (4th) 35 (F.C.T.D.), reversed (2008), 64 C.P.R. (4th) 431 (F.C.A.), (*Candrug*)]. The screen capture cannot be adduced as evidence of the truth of the statements contained therein. The most that could be inferred from Exhibit B to the Voogt affidavit is that the homepage of the Opponent's website existed on the date it was printed. In the present case, however, I am unable even to make such an inference as the screen capture is not dated.

[12] Mr. Voogt states that the Opponent sells its living plants to distributors and wholesalers across British Columbia as set out in the list attached to his affidavit (Exhibit C). The list is printed from the Opponent's website, and as a result, I accept it only as evidence that the website existed on April 23, 2008, the date on which it was printed.

[13] In his affidavit, Mr. Voogt states that the Opponent's products are "offered on the Opponent's website". This statement is ambiguous. It is unclear whether this means that the Opponent's wares are offered for sale on the website or merely advertised on the website. Even if I was to consider the evidence from the Opponent's website adduced in the Voogt affidavit, these materials do not provide any insight into what the Opponent intended by this statement. I see nothing in the exhibits to the Voogt affidavit that shows that the Opponent's wares are available for sale on its website.

[14] The Voogt affidavit provides details of the manner in which the Opponent's living plants are sold in association with the Cited Mark. Specifically, Mr. Voogt states that the Opponent's plants are tagged with labels, sold in containers and distributed in trays, all of which prominently display the Cited Mark. Mr. Voogt attaches photographs showing the manner in which the Opponent's products and packaging are marked with the Cited Mark (Exhibits D to H). I note that none of these photographs are dated.

[15] Mr. Voogt also attaches to his affidavit a copy of a brochure advertising the Opponent's living plants (Exhibit I). While the brochure features multiple instances of the Cited Mark, this does not qualify as use pursuant to s. 4(1) of the Act as use of the Cited Mark in advertising is not in itself sufficient to constitute use in association with wares [see *BMW Canada Inc. v. Nissan Canada Inc.* (2007), 60 C.P.R. (4th) 181 (F.C.A.)].

[16] Mr. Voogt also states that he monitors the Canadian market and routinely reviews competitors' advertising and marketing and as a result, in his view, the Opponent is the only company in Canada using the Cited Mark in its advertising or marketing activities. I will not afford any significance to the affiant's opinion on this matter.

Applicant's Evidence: Anne Muter

[17] Ms. Muter, an articling student employed by the Applicant's agent, provides results from searches of the Canadian Trade-marks Database of the Canadian Intellectual Property Office (CIPO) for registered trade-marks containing the element "PATIO" for use with plants conducted on August 27, 2008. She also provides results of searches conducted on the Internet for instances of use of the trade-marks found in the Database search on August 28, 2008.

Onus

[18] 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 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Section 12(1)(d) Ground of Opposition

[19] The material date for assessing confusion between the Mark and the Cited Mark pursuant to s. 12(1)(d) of the Act is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

[20] I have exercised the Registrar's discretion to confirm that the registration for the Cited Mark is in good standing as of today's date. Since the Opponent has discharged its initial burden with respect to this ground of opposition, the burden of proof lies on the Applicant to convince the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Cited Mark.

[21] 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.

[22] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 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 C.P.R. (4th) 321 (S.C.C.)]

6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[23] Both marks at issue are made up of two ordinary dictionary words. As I may refer myself to a dictionary to determine the meaning of words, I have looked into the *Canadian Oxford Dictionary* and found definitions for the words “patio”, “harvest” and “perennial” as set out herein [see *Insurance Co. of Prince Edward Island v. Prince Edward Island Insurance Co.* (1999), 2 C.P.R. (4th) 103 (T.M.O.B.)].

[24] Both marks at issue share the word PATIO, a definition for which is “a paved usually roofless area adjoining and belonging to a house, used for outdoor recreation”. Taken in association with “living plants”, the word PATIO is suggestive of the outdoors. In other words, it could suggest that the parties’ living plants are meant for planting outdoors as opposed to indoors. Further, I agree with the Applicant that the word PATIO is suggestive of living plants suitable for growing on patios.

[25] A definition for the word HARVEST is “the process of gathering in crops etc. the season when this takes place” which is not descriptive of living plants. While the word HARVEST may relate generally to the planting, cultivating and gathering of plants, whether agricultural crops or otherwise, the word is not necessarily suggestive of a character or quality of the living plants themselves.

[26] Finally, a definition for the word PERENNIALS is “(of a plant) lasting several years” which is descriptive of the associated wares. The Opponent has acknowledged this descriptiveness by disclaiming the word PERENNIALS in its registration for the Cited Mark.

[27] Based on the foregoing, taken as a whole, the Mark possesses a higher degree of inherent distinctiveness than the Cited Mark.

[28] As 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.

[29] The Applicant did not file any evidence directed to the use of the Mark subsequent to the filing of the application and as a result I am unable to conclude as to the extent to which the Mark has become known.

[30] The Voogt affidavit does not include sales figures, advertising expenditures or any other evidence which would provide insight into the extent to which the Cited Mark has become known. That said, the Voogt affidavit does include evidence of use of the Cited Mark. Based on a review of the Voogt affidavit as a whole, I am able to conclude that the Cited Mark has become known to some extent.

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

[31] The Mark was applied for on April 18, 2006 on the dual basis of proposed use in Canada and use and registration in the United States of America. The Applicant has not filed any evidence which is directed to the use of the Mark subsequent to the filing of the application.

[32] By contrast, the Opponent claims, through the Voogt affidavit, that it has used the Cited Mark in Canada since the date of filing the declaration of use, namely January 19, 2000. I am satisfied that the Voogt affidavit, which among other things includes a sworn statement claiming use of the Cited Mark since January 19, 2000, shows use of the Mark and therefore this factor favours the Opponent.

6(5)(c) and (d) – the nature of the wares and trade

[33] Both marks at issue are associated with living plants.

[34] The Opponent has provided evidence as to the nature of its trade. Specifically, Mr. Voogt states that the Opponent operates a greenhouse selling various types of living plants to distributors and wholesalers across British Columbia in association with the Cited Mark. The Applicant did not file any evidence as to the nature of its trade.

[35] Given that the Wares are identical to the Opponent's registered statement of wares, I find it reasonable to conclude that the channels of trade associated with the trade-marks at issue could be identical or overlapping.

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

[36] In most instances, the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145, conf. 60 C.P.R. (2d) 70 (F.C.T.D.)].

[37] It is a well-accepted principle that the first portion of a trade-mark is the most relevant for the purposes of distinction [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) at 188]. However, the importance of the first element (PATIO) is diminished in this case as it is suggestive of the associated wares [see *Vancouver Sushiman Ltd. v. Sushiboy Foods Co.* (2002), 22 C.P.R. (4th) 107 (T.M.O.B.)]. As a result, the focus will be placed on the more distinctive HARVEST element of the Mark. As noted in *United Artists Corp. v. Pink Panther Beauty Corp.* (1998), 80 C.P.R. (3d) 247 at 263 (F.C.A.),

While the marks [in issue] must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public's perception of it.

[38] Ultimately, when considering the marks as a whole, I find that there is some similarity in appearance and sound by virtue of the inclusion of the PATIO element in both marks but that this similarity is minimized by the fact that it arises as a result of a suggestive element.

[39] The Mark suggests the idea of harvesting, or gathering, plants from outdoors. The Cited Mark suggests the idea of perennial (many-season) plants which can be planted outdoors. As a result, there is some overlap in the ideas suggested by both marks since both suggest ideas of the outdoors and plants.

Additional circumstances: state of the register and marketplace evidence

[40] When analyzing the relevance of state of the register evidence, it must be noted that such evidence will only be relevant insofar as one can make inferences from it about the state of the marketplace. Inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located [see *Ports International Ltd. v. Dunlop Ltd.* (1992),

41 C.P.R. (3d) 432, (*Ports*); *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

[41] Ms. Muter searched the CIPO's Database for registered trade-marks incorporating the word "Patio" in association with wares relating to plants.

[42] The Muter affidavit provides particulars of the following four trade-mark registrations owned by three different entities as found in the August 27, 2008 search:

- (a) PATIO (TMA325,723) – registered on April 10, 1987 by All Treat Farms Limited of Arthur, Ontario for *inter alia*, lawn, flower, vegetable and plant seeds; flower and plant bulbs; shrubs and plants;
- (b) PATIOHIT (TMA577,189) – registered on March 10, 2003 by Poulsen Roser ApS of Denmark for roses, natural plants and flowers;
- (c) TUDOR PATIO (TMA577,424) – registered on March 12, 2003 by Poulsen Roser ApS of Denmark for natural plants and flowers;
- (d) PATIO TROPICS (TMA456,701) – registered on April 19, 2004 by Hines Nurseries Inc. (current owner Hines Horticulture, Inc.) of California for living plants.

[43] The pending "advertised" application for PATIO GARDEN revealed by Ms. Muter's search is not relevant in considering the state of the register.

[44] Ms. Muter also conducted a search of the Internet for materials which she purports show "active use" of the PATIOHIT (TMA577,189), PATIO TROPICS (TMA456,701) and PATIO GARDEN trade-marks (Exhibits C-E).

[45] As Exhibit C to her affidavit, Ms. Muter attaches pages printed from the Aldershot Greenhouses Ltd. and Vandermeer Nursery Ltd. websites both of which purport to offer PATIOHIT brand roses for sale in Ontario. As Exhibit D to her affidavit, Ms. Muter attaches a page printed from Yahoo! Canada Finance which provides information about Hines Horticulture, Inc., the owner of the PATIO TROPICS trade-mark. As Exhibit E to her affidavit, Ms. Muter attaches pages printed from a website advertising PATIO GARDEN brand plants.

[46] I note that the Internet evidence provided in Ms. Muter's affidavit is of little assistance to the Applicant. The contents of these websites constitute hearsay evidence. Furthermore, the mere existence of a website does not show that it was accessed by Canadians at any time [see

Candrug, supra]. As a result, I am only able to infer that the websites adduced as exhibits to the Muter affidavit (and described in paragraph 45 above) existed on the date they were printed, namely April 23, 2008.

[47] In addition to the hearsay deficiencies of the Internet evidence, the display of the trade-marks on these websites would not qualify as use of the trade-marks pursuant to s. 4(1) of the Act. Specifically, none of the websites adduced feature the trade-marks PATIOHIT, PATIO TROPICS or PATIO GARDEN marked on the wares (plants) themselves, marked on their packaging or otherwise associated therewith.

[48] The purpose of the register and marketplace evidence is to demonstrate that the PATIO element of the Mark and the Cited Mark is so commonly adopted in the marketplace that consumers are used to distinguishing among competing marks that share this common feature and are aware that the wares and services associated with each one of them come from a different source [see *Ports, supra* and *T. Eaton Co. v. Viking GmbH & Co.* (1998), 86 C.P.R. (3d) 382]. Here, the evidence falls far short of enabling me to reach such a conclusion as I do not consider four registrations owned by three distinct entities to be a large number of relevant registrations.

Conclusion re s. 12(1)(d) of the Act

[49] Having regard to the above, I find that the balance of probabilities is evenly balanced between a finding of confusion between the marks in issue and a finding of no confusion. As the onus is on the Applicant to establish on a balance of probabilities that the Mark is not confusing with the Cited Mark, I must decide against the Applicant. The state of the register evidence as well as the state of the marketplace evidence as introduced by Ms. Muter's affidavit does not allow me to afford any significance to these additional circumstances so as to shift the balance of probabilities in the Applicant's favour.

[50] Based on the foregoing, I find that the ground of opposition based on s. 12(1)(d) of the Act is successful.

Entitlement Grounds of Opposition

[51] The material date for considering the entitlement grounds of opposition is the date of filing the application for the Mark, namely, April 18, 2006 [see s. 16(2) and (3) of the Act].

[52] Despite the burden 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 Cited Mark, the Opponent has the initial onus of proving that the trade-mark alleged in support of its grounds of opposition based on s. 16(2)(a) and 16(3)(a) of the Act was being used at the date of filing the application and had not been abandoned at the date of advertisement of the application, namely, January 31, 2007 [s. 16(5) of the Act]. With respect to the grounds of opposition based on s. 16(2)(b) and 16(3)(b), the Opponent must establish that its pending application was filed as of the filing date of the application for the Mark and that it was pending as of the date of advertisement of the Applicant's application.

Section 16(2)(a) and 16(3)(a) of the Act

[53] The Opponent has filed the Voogt affidavit as evidence of use of the Cited Mark and through it claims use of the Cited Mark since January 19, 2000. The specimens of use annexed to the Voogt affidavit are largely undated and as a result I am unable to conclude whether or not the Cited Mark was in use at the material date. Only one exhibit affixed to the Voogt affidavit is dated, namely, Exhibit C, which features a list of the Opponent's distributors and wholesalers from the Opponent's website. This page is dated April 23, 2008 and features the Cited Mark. Even if I was willing to infer from this exhibit that the Opponent was selling its products in association with the Cited Mark to the listed wholesalers and distributors on April 23, 2008, this remains insufficient to support the ground of opposition as this date is approximately two years subsequent to the material date, namely April 18, 2006.

[54] Based on the foregoing, I find that the Opponent did not discharge its burden of showing use of the Cited Mark prior to the filing date of the application for the Mark and I dismiss the grounds of opposition based on s. 16(2)(a) and 16(3)(a) of the Act accordingly.

Section 16(2)(b) and 16(3)(b) of the Act

[55] In its statement of opposition, the Opponent bases the s. 16(2)(b) and 16(3)(b) grounds of opposition on a “previously filed” application for PATIO PERENNIALS, however, the Opponent does not include a serial number for this application. According to *Novopharm Limited v. AstraZeneca AB* (2002), 21 C.P.R. (4th) 289 (F.C.A.) I must assess the sufficiency of the pleadings in association with the evidence. The opponent did not file any evidence regarding a pending application. Even if I were to infer that the Opponent intended to base these grounds of opposition on the application for its Cited Mark, this application had matured to registration and was no longer pending as of the date of advertisement of the Applicant’s application.

[56] In view of the above, I dismiss the non-entitlement grounds of opposition on the basis that they were insufficiently pleaded. Alternatively, I dismiss these grounds of opposition on the basis that they are not valid grounds of opposition.

Distinctiveness Ground of Opposition

[57] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its Wares from those of others throughout Canada [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (T.M.O.B.)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness. The material date for assessing distinctiveness is the date of filing of the opposition, namely, August 7, 2007 [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

[58] The Opponent must demonstrate that, as of the filing of the statement of opposition, the Cited Mark had become known sufficiently to negate the distinctiveness of the Mark [see *Bojangles’ International, LLC v. Bojangles Café Ltd.* (2004), 40 C.P.R. (4th) 553, aff’d (2006), 48 C.P.R. (4th) 427 (F.C.T.D.); *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.); *Clarco Communications Ltd. v. Sassy Publishers Inc.* (1994), 54 C.P.R. (3d) 418 at 431 (F.C.T.D.); *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A.); and *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.)].

[59] While the Voogt affidavit provides evidence of use of the Cited Mark in the form of photographs of products and packaging of the Opponent's wares featuring the Cited Mark, these photographs are undated. Furthermore, the Voogt affidavit does not include any evidence which would enable me to conclude as to the extent to which the Cited Mark had become known (e.g. sales figures, advertising expenditures or any other evidence which would provide insight into the extent to which the Cited Mark has become known in the Canadian marketplace).

[60] On this basis, the Opponent has not met its evidential burden to demonstrate that, as of the filing of the statement of opposition, the Cited Mark had become known sufficiently to negate the distinctiveness of the Mark.

[61] Based on the foregoing, I reject the non-distinctiveness ground of opposition in its entirety.

Disposition

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

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