



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

Citation: 2011 TMOB 204
Date of Decision: 2011-10-25

**IN THE MATTER OF AN
OPPOSITION by Canadian Jewish
Congress to application No. 861,142 for
the trade-mark THE MENORAH
DESIGN in the name of Chosen People
Ministries, Inc.**

[1] On November 12, 1997, Chosen People Ministries, Inc. (the Applicant or CPM) filed a trade-mark application (the Application) for the Menorah design shown below in association with the following wares and services:



(the Mark)

WARES:

- (1) Promotional items, namely sweatshirts, golf shirts, baseball caps, coffee mugs, pens, calenders [*sic*], bumper stickers, greeting cards.
- (2) Bibles; religious literature, namely books, pamphlets, brochures, newsletters dealing with matters of ministry and missions to reach both Jewish and non-Jewish peoples with the gospel of Jesus the Messiah; pre-recorded audio and video cassettes; stationery, namely paper, pads, envelopes; promotional items, namely sweatshirts.

SERVICES:

(1) Provision of religious literature and information in an electronic format by means of a global computer network.

(2) Ministry and missions to reach both Jewish and non-Jewish peoples with the gospel of Jesus the Messiah; organizing and conducting bible study programs; street evangelism; organizing and conducting youth outreach programs; organizing and conducting conferences and seminars to reach both Jewish and non-Jewish peoples with the Gospel of Jesus the Messiah; organizing and conducting seniors outreach programs; organization and administration of religious congregations; consulting services provided to pastors and secondary and post-secondary educational institutions; organizing and conducting bible study retreats; organizing and conducting fund raising events; translation services.

[2] The Application is based on proposed use in association with Wares (1) and Services (1), and use since June 1, 1988 in association with Wares (2) and Services (2). The priority filing date is May 21, 1997.

[3] The application was advertised on November 4, 1998 and the Canadian Jewish Congress (Opponent or CJC) filed its statement of opposition on January 8, 1999; an amended statement of opposition was filed on October 31, 2003 and a further amended statement of opposition was filed on November 2, 2009. CPM filed its twice amended counterstatement on November 2, 2009.

[4] The grounds of opposition under the *Trade-marks Act* R.S.C. 1985, c. T-13 (the “Act”) may be summarized as follows:

Section 38(2)(a)/s. 30

- Contrary to s. 30(a) the services in association with which the Mark has allegedly been used and is proposed to be used have not been described in ordinary commercial terms;
- Contrary to s. 30(i) the Applicant could not have been satisfied that it was entitled to use the Mark in Canada as of the filing date of the application, in light of the common use of the menorah as a symbol of the Jewish religion, and the prior use in Canada of the Mark and menorah designs by a number of Jewish organizations in connection with wares and services relating to religious activities;

- Contrary to s. 30(i) the Applicant could not have been satisfied that it was entitled to use the Mark in Canada as of the filing date of the application, or at any time since that date in association with the wares and services described in the application, in that the Mark resembles, so as to be likely mistaken for, the prohibited mark – Application No. 970,005, advertised September 24, 1975 in the name of the Government of Israel;
- Contrary to s. 30(i) the Applicant could not have been satisfied that it was entitled to use the Mark in Canada as a result of issue estoppel and estoppel generally and, in particular, the Applicant is estopped from obtaining a registration for the Mark in Canada as a result of the decision of the Federal Court Trial Division which held that the menorah is a distinctively Jewish symbol and cannot be the exclusive property of any one organization [see *Canadian Jewish Congress v Chosen People Ministries, Inc.* (2002) 19 C.P.R. (4th) 186 (F.C.T.D.); aff'd (2003) 27 C.P.R. (4th) 193 (F.C.A.)].

Section 38(2)(b)/s. 12(1)(b)

- The Mark is not registrable in that it is contrary to s. 12(1)(b), since it is, when depicted, written or sounded, deceptively misdescriptive of the character or quality of the wares and services in association with which it is used and proposed to be used; in particular, the Applicant's wares and services relate to the Christian religion and activities, while the menorah has been widely identified and used around the world (including Canada) as a symbol of the Jewish religion;
- The Mark is not registrable contrary to s. 12(1)(e), since it is a mark the adoption of which is prohibited by s. 9(1)(j), as the adoption of the menorah, a symbol of the Jewish religion, by an entity, whose main goal is to promote and serve the Christian religion, and specifically, to convert Jews to the Christian religion, is scandalous and immoral;
- The Mark is not registrable contrary to s. 12(1)(e), since it is a mark the adoption of which is prohibited by s. 9(1)(i) as it so nearly resembles an official mark of the

Government of Israel (Application No. 970,005, advertised September 24, 1975), so as to be likely mistaken therefore.

Section 38(2)(d)/s. 2

- The Mark is not distinctive of the Applicant within the meaning of s. 2; the Mark does not actually distinguish, nor is it adapted to distinguish, the wares and services of the Applicant from the wares and services of others used and advertised in association with the marks and trade names Menorah and/or Menorah Design, and related marks and names incorporating “menorah” designs, and in light of the common public knowledge of the menorah as being identified with wares and services relating to the Jewish religion. The Opponent alleges that, in addition, the Mark was held by the Federal Court to be not distinctive of the Applicant in a decision refusing publication of the identical mark under s. 9 [*Canadian Jewish Congress v. Chosen People Ministries, Inc.* (2002) 19 C.P.R. (4th) 186 (F.C.T.D.); *aff’d* (2003) 27 C.P.R. (4th) 193 (F.C.A.)][*CJC v CPM*].

[5] The Opponent filed the affidavit of Manuel Prutschi who was subsequently cross-examined; the transcript of cross-examination, answers and undertakings thereto were also filed. The Applicant filed the affidavit of Mitch Glaser as well as certified copies of some of the trade-marks referred to in his affidavit. The Opponent filed the affidavit of Dane Penney in reply.

[6] Both parties filed written submissions and were represented at an oral hearing.

Onus

[7] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, to the extent that the facts alleged by the Opponent are not self-evident or admitted, there is in accordance with the usual rules of evidence an initial evidential burden upon the Opponent to support the facts alleged in the ground of opposition. The presence of an evidential burden 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 [see *Joseph E. Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 (T.M.O.B.) at 329; *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

[8] Both parties filed somewhat lengthy and detailed evidence, what follows is a summary of the evidence relevant to the determinations to be made in this proceeding.

Opponent's Evidence

Affidavit of Manuel Prutschi

[9] Mr. Prutschi is the National Director of Community Relations of the Opponent, CJC. Mr. Prutschi holds undergraduate and graduate degrees in History; prior to joining the CJC he was a University Lecturer in history. The affiant states that his statements are based on his knowledge of history generally and Jewish history and religion specifically as well as his experience as National Director of Community Relations, where he has occasion to be in frequent contact with various scholars of Judaism and Jewish history.

[10] Mr. Prutschi has been involved with the CJC since 1981 and sets out that the CJC is a national body that represents Jewish groups in Canada; it is comprised of representatives of Jewish organizations from across Canada. He sets out the aims and object of the CJC and states that in accordance with its aims, CJC articulates the perspective of the Jewish community on a wide variety of issues having national scope, including matters relating to Jewish identity, anti-Semitism, other forms of discrimination, racism, promotion of hatred, Holocaust denial and policies relating to equity and justice. Mr. Prutschi asserts that the status of the CJC has been acknowledged by Canadian courts where the CJC has presented the perspective of the Canadian Jewish community in numerous cases [see *R. v. Lelas* (1990), 74 O.R. (2d) 552 (Ont. C.A.) where the Court noted at p. 555 that “the CJC represents the Jewish Community in Canada”; see also *R. v. Zundel* (1986), 16 O.A.C. 244 (Ont. C.A.) where it was noted that “the CJC has interest and expertise in combating social discrimination and anti-Semitism”].

[11] Mr. Prutschi is the author of over two dozen articles on various subjects, including human rights advocacy, inter-group relations, equality, multiculturalism, religion in the public schools, Sunday closing, and the separations between church and state. He has given evidence regarding the Jewish perspective in proceedings before the Ontario Superior Court of Justice in litigation relating to discrimination. In addition, he sits or has sat on various boards, including the Canadian Christian Jewish Consultation, the Canadian Ethnocultural Council and the Board of the Christian Jewish Dialogue of Toronto. He was a panellist in a 2001 National Colloquium on Cultural Diversity and the Media and a member of the 2000 Hate and Bias Activity Roundtable organized by the Secretary of State for Multiculturalism.

[12] Mr. Prutschi asserts that he has become very familiar with Jewish history and the symbols of Judaism. He provides that the menorah is among the most common and the most religiously and historically significant symbols in Judaism. The affiant further states that representations of the menorah as a symbol of Judaism and the Jewish people have appeared throughout history on numerous objects, such as for example, medieval Bible manuscripts, plates, coins, synagogues, mosaic floors and tombs. For many centuries, the menorah has served as a symbol which clearly describes activities and items connected with the Jewish religion or culture.

[13] Mr. Prutschi explains that Judaism teaches that the seven branched menorah was given to the Jewish people by God, through Moses; Judaism's first temple, Solomon's Temple, contained 10 menorahs. The menorah's importance as a Jewish symbol continues to the present day. It is a highly visible and prominent feature of many modern-day synagogues and plays a significant role in synagogue art, appearing on various wall paintings, stained glass windows, mosaics and other decorations. menorah-shaped lamps are a feature of many modern-day synagogues. The use of the menorah in synagogues in Canada significantly predates 1988. It is also currently used as an emblem of Judaism on Jewish educational books, Jewish prayer books, religious articles and Jewish tombstones. Mr. Prutschi provides as Exhibit Q, a collection of copies of sample literature from Jewish organizations in which a representation of the menorah is featured. I note that these organisations include (but are not limited to) the following organizations, which appear, on their face, to be Canadian

organizations: Jewish Community Council of Montreal, Holocaust Education and Memorial Centre of Toronto, Canadian Council for Reform Judaism, B’Nai Brith Canada.

[14] The affiant further states that in the present day, it is used by numerous Jewish organizations on letterhead, publicity, advertising material and stationery in order to indicate the affiliation of these organizations with Jewish faith and culture. In describing the importance of the menorah as a symbol of Judaism, Mr. Prutschi states that the seven branched menorah is among the most common and the most religiously and historically significant symbols in Judaism and holds significance to Jewish persons akin to that which the Cross holds for Christians. He states that it is a symbol which is distinctively Jewish.

[15] Mr. Prutschi provides numerous excerpts of historical, religious and scholarly writing as authorities in support of his statements. The definition provided from *The New Jewish Encyclopedia*, Berhman House, Inc. 1962 was relied on by the Federal Court in *CJC v. CPM*, *supra*, which provides, *inter alia*, the following:

Menorah: Hebrew name of the seven branched candlestick originally made by the Biblical artisan *Bezalel* and placed in the sanctuary of the Tabernacle. [...] the Menorah has since become a universal symbol of Judaism.

[16] Mr. Prutschi claims to be familiar with the operation of “Messianic” Hebrew Christian groups, such as the Applicant. Mr. Prutschi states that Messianic groups, “guided by the notion that Christianity supersedes Judaism”, specifically target Jewish persons as recipients of their gospel, that these groups proselytise and that their methods are offensive to Jewish people. He states that Judaism is not capable of embracing Christian doctrine. Jewish persons, while remaining Jewish, cannot accept Jesus Christ as divine or as the Messiah; rather, acceptance of these beliefs is inherently Christian and inconsistent with fundamental Jewish beliefs.

[17] With respect to the Applicant’s activities, the affiant provides certain pages printed from the CPM website which he attaches as Exhibit B. In addition to the first two pages that provide background and basic information about the Applicant, I have reviewed the information in the additional pages that provide information under the title “Presenting Messiah to your Jewish Friend”. This material provides insight into the nature of the

Applicant's organization and, as will be noted below, this content is supported by the Applicant's evidence.

[18] In particular, I note the following statements that appear as techniques to "reach Jewish people with the Gospel":

- Don't be discouraged when your friend rejects Christianity. There is often much historical baggage involved. Just remember: the Gospel is about a Person - Jesus the Messiah. It is about a relationship, not a religion. When you distinguish between Jesus and the Jewish understanding of the Christian religion, many objections dissipate. Your Jewish friend does not need to feel that by accepting Jesus he is giving up his Jewish identity. You are not asking him to "convert" to another religion, but to become "complete" by receiving the Jewish Messiah. Certain words may have totally different, even offensive, meanings to your Jewish friend. Often, such words as "cross" and "Christ" bring up collective memories of persecution by so-called "Christians". Be sensitive in your choice of words. Try using "Messiah" instead of "Christ", "tree" instead of "cross" and even "Yeshua" instead of "Jesus". You want to communicate the Jewishness of the Gospel message.

[19] Still further in the material under the title "Share your Testimony" is the following:

- Tell your Jewish friend that you believe in the Jewish Messiah, and then tell him what Jesus has done for you! This will be especially powerful if you are a Gentile and have accepted the Lord as an adult. Showing how even a Gentile needed to accept Jesus will counter the idea that Christians are simply "born into the religion". Your friend may realize for the first time that this relationship is entered into by faith and not merely by birth. Go ahead and tell him that God did not make you stop being Italian, Norwegian or Oklahoman, and that he doesn't have to stop being Jewish!

[20] Mr. Prutschi also attaches CPM's initial Certificate of Incorporation dated May 1, 1924, as Exhibit C. He notes that CPM was formerly known as the "American Board of Missions to the Jews, Inc." and that the current object of CPM is to spread "the Gospel of the

Lord Jesus Christ among the Jews in the United States of America and in all parts of the world” (Exhibit D).

[21] Mr. Prutschi further points out that CPM’s purpose is further set out in its own promotional material as attached in Exhibit E which appears to be a promotional letter that states that the CPM is seeking to “help Jewish people come to faith in Jesus the Messiah, to disciple Jewish believers into a solid Biblical faith and lifestyle, because Jewish people need Jesus”, and “because Jesus told his followers to ‘make disciples of all nations’ (*Matthew 28:19*)”. Mr. Prutschi provides that CPM’s Amended Certificate of Incorporation (Exhibit F) to include the Statement of Faith of American Board of Missions to the Jews, Inc., includes the following “Doctrinal Bases”:

Section 1

The members of the Corporation hereby declare and affirm their belief in the Divine Inspiration, infallibility and authority of the Old and New Testaments,; in the Triune God, the Father, the Son, and the Holy Spirit; in the Deity of the Lord Jesus Christ as the only begotten Son of God; in the pre-millennial [*sic*] second coming of the Lord Jesus Christ; in the sacrificial blood atonement of the Lord Jesus Christ at Calvary and His bodily resurrection from the dead; finally in the lost condition of every human being, whether Jew or Gentile, who does not accept salvation by faith in the Lord Jesus Christ, and, therefore, in the necessity of presenting the Gospel to the Jews.

Section II

Only persons who give assent to the doctrinal basis as contained in Section 1 of this article, either verbally or in writing as may be required by the Board of Directors and who are known to be interested in the evangelization of the Jews, shall be eligible to membership in this Corporation.

Applicant’s Evidence

Affidavit of Mitch Glaser

[22] Mr. Glaser identifies himself as the President and CEO of the Applicant CPM and provides personal background information and identifies himself as a Jewish person. He states that he holds a Masters of Divinity from Talbot Theological Seminary, as well as a Doctorate of Philosophy from Fuller Theological Seminary (Pasadena, California). He states

that he has taught at Fuller Theological Seminary, Westminster Theological Seminary (Philadelphia, Pennsylvania), Moody Bible Institute (Chicago, Illinois) and Columbia International University (Columbia, South Carolina). Since May 1997, the affiant has been Chief Executive Officer of CPM's International Ministry which has branches located in the United States, Canada, Argentina, Germany, Israel, the Ukraine and England.

[23] Mr. Glaser's affidavit is directed, in part, towards establishing the history of the CPM as an organization of Jewish people. He provides that the members believe that Jesus was the Jewish Messiah as prophesied and that CPM is an organization of Messianic Jews who consider it appropriate to worship Jesus in a Jewish context. The affidavit is also directed towards establishing that much has been written as to whether Messianic Judaism is considered a branch of Judaism. In addition, the affidavit is directed towards establishing that use of the menorah has not been restricted to "approved" Jewish organizations but has been used by third parties in the food industry and by other Messianic organizations.

[24] With respect to the history and mission of the Applicant, Mr. Glaser provides that CPM was originally founded in Brooklyn, New York in 1894 by a Jewish Rabbi, Leopold Cohn. The affiant states that Cohn was led to seek more information about the Messiah as prophesied in the traditional Jewish writings and scripture, and searched the Jewish scriptures and questioned other Rabbis in his community about the Messiah. Ultimately, Cohn came to the conclusion that Jesus was the Jewish Messiah, as prophesied in the Jewish Bible.

[25] The affiant provides examples of trade-mark registrations that include cross or menorah designs; particulars of 12 registrations and 2 applications for trade-marks that include a cross design are attached. As well, particulars of 8 registrations and 2 applications for trade-marks that include a menorah design are attached. In the case of the cross design trade-marks, I note that as shown in the certified copies filed, all depictions of the cross include additional design and/or text elements. With respect to the menorah design trade-marks I note that none depict a menorah alone, and further that six out of ten have been either abandoned or expunged; the remaining four are in association with wares and/or services that have no relation to religious activities.

[26] Mr. Glaser also provides exhibits showing different menorah designs in use by various Canadian Jewish organizations such as synagogues and community centers. In addition, the affiant alleges that the menorah has been used by Christian groups throughout history and refers to a number of additional web pages of other Messianic organizations.

[27] With respect to Exhibit B to Mr. Prutschi's affidavit, Mr. Glaser adopts the first two pages as having been prepared by himself. He confirms the contents to be accurate with respect to the historical background of CPM and its goals and objectives. The affiant is silent with respect to the document (described above) entitled "Presenting Messiah to your Jewish Friend".

[28] I would observe, in any event, that the messages included in the pamphlet and newsletter exhibits provided by Mr. Glaser present similar information. I reproduce the following excerpts from a pamphlet distributed in April 2002 (Exhibit 95) as an example:

Our Ministries

- It is our specific ministry to preach the Gospel of Yeshua the Messiah, and to show our Lord's love to the Jewish people throughout the world.
- The Chosen People Ministries continues to evangelize and disciple Jewish people around the world through the most effective and creative ways possible. Our representatives plant congregations; hold fellowship meetings, bible studies, worship services; and do one-on-one evangelistic work.
- Our priority is that, through effective evangelism, our missionaries will establish indigenous churches; and by discipling new believers (both Jewish and Gentile) our efforts will lead to further Jewish evangelism. These new Bible-centred congregations are designed to have a special sensitivity to reaching and ministering to Jewish people, without excluding others who need the Gospel.

Our Beliefs

- All workers and Board members of Chosen People Ministries must subscribe to doctrines fundamental to the faith. We declare our belief in the following:
- The Divine inspiration, infallibility, and authority of both the Old and New Testaments.
- The triune God and the Deity of the lord Jesus (Yeshua) as the only begotten Son of God and the promised Messiah.
- Messiah's sacrificial blood atonement at Calvary, His bodily resurrection from the dead, and His second coming.
- The necessity of presenting the Gospel to the Jewish people.

[29] Mr. Glaser attaches numerous screen prints of web pages (Exhibits 63-78) that demonstrate use of the menorah on websites of other Messianic organizations. It appears that some of these are located in Canada. I would observe that in all cases the menorah design is used in conjunction with the organization's name, and in the majority of cases integrated with (or at least in close proximity to) the words to create a unitary design. As well, I would note that there is no evidence that these are registered trade-marks in Canada.

[30] Mr. Glaser provides evidence of use of the Mark in Canada by the Applicant. He states that CPM has distributed pamphlets and brochures which bear the Mark since June 1, 1998. CPM distributes approximately 406 different brochures a year; typically 3,000 to 10,000 of each brochure is distributed. Sample brochures are attached as Exhibits 93 to 99, and I note that each features the Mark in close association with the Applicant's name.

[31] CPM also uses approximately 100,000 letterhead and envelopes bearing the Mark in any given year, since June 1988 and continuously to the present. The Applicant also distributes monthly newsletters that prominently display the Mark; these are distributed at conferences, events sponsored by CPM, outreach programs and in mailings to members. Approximately 75,000 newsletters are distributed each year by CPM Canada, the total distribution in 2007 in Canada was 55,223. Attached are examples of newsletters stated to be typical of newsletters distributed since June 1, 1998 (Exhibits 104-107). I note that the

newsletters bear the Mark in close proximity to the name of the newsletter, THE CHOSEN PEOPLE.

[32] CPM distributes calendars bearing the Mark at conferences and events and via mailings; typically 100 are sold each year at CPM events, and approximately 200 are distributed by mail each year. Exhibit 108 is an example of such a calendar stated to be typical of ones that were distributed by CPM in Canada since June 1988, and continuously to the present. The affiant also provides evidence of signage in front of the CPM Canada headquarters. The Mark typically appears with the words CHOSEN PEOPLE MINISTRIES.

[33] CPM also places the Mark on personal items (distributed in association with its services), such as sweatshirts, golf shirts, lapel pins and tote bags since at least as early as June 1, 1988, and continuously until the present. Exhibit 112 depicts a tote bag provided at CPM conferences and to volunteers. Also attached as Exhibit 113 is a photo of a golf shirt bearing the Mark distributed at conferences and to volunteers. I note that on each of these items, the Mark appears above the words CHOSEN PEOPLE MINISTRIES.

[34] The Applicant filed certified copies of third-party trade-mark registrations that incorporate stylized versions of the cross. These registrations contain depictions of the cross in combination with other design or text material; none consist of only a cross. The Applicant also includes two registrations for trade-marks that contain depictions of a menorah; again these registrations are for marks that include a menorah as one of several design and/or text elements.

Opponent's Reply Evidence

Affidavit of Dane Penney

[35] Mr. Penney provides evidence that two of the trade-mark applications in the Applicant's evidence, THE ISRAELITE NATION & Design (No. 1,142,436) and THE ISRAELITE NATION & Design (No. 1,015,114), have been abandoned.

Discussion

Section 38(1)(a)/s. 30

[36] The material date for determining non-compliance with s. 30 of the Act is the filing date of the application (November 12, 1997) [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 at 475 (T.M.O.B)]

[37] With respect to the ground of opposition based on s. 30(a) of the Act, the Opponent did not provide any facts in support of this ground and I would observe that no submissions were made in this regard by the Opponent in either its written argument or at the oral hearing. Accordingly, the Opponent has failed to meet its initial burden under this ground and it is therefore dismissed.

[38] Where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant. [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. I am of the view that neither the awareness of the significance of the Menorah as a symbol of the Jewish religion, or of the official mark No. 970,005 that includes a depiction of a Menorah, nor awareness of the Federal Court decision [*CJC v. CPM supra*] that relates to CPM's status as a "public authority" under s. 9 of the Act would prevent the Applicant from making in good faith the statement required. Firstly, as the Applicant pointed out, the date of filing of the application (and hence the making of the s. 30(i) statement) predates the Federal Court decision and, secondly, awareness of the significance of the menorah as a Jewish symbol would appear to be the reason that the Mark has been applied for by the Applicant. In other words, the registrability of the Mark is the very subject of this proceeding and common sense would dictate that opposing views on this issue are a matter of law and/or mixed fact and law, and not a question of bad faith. As such, I am of the view that the Opponent's estoppel argument, pleaded under this ground, is not relevant here; there is no evidence of bad faith of the Applicant, therefore this ground is dismissed.

Section 38(2)(b)/s. 12(1)(b)

[39] The Opponent contends that the Mark is not registrable in that it is contrary to s. 12(1)(b). The Opponent contends that when depicted, written or sounded, the Mark is deceptively misdescriptive of the character or quality of the wares and services in association with which it is used and proposed to be used; in particular, it argues that the Applicant's wares and services relate to the Christian religion and activities, while the menorah has been widely identified and used around the world (including Canada) as a symbol of the Jewish religion. The Opponent considers the adoption by the Applicant of the Mark to be deceptive as it misleads Jewish and non-Jewish Canadians to suppose that the wares and services offered by the Applicant as part of its Christian activities are associated with the various Jewish community and religious groups that also use the menorah in connection with their operations.

[40] The material date for determining this issue is the filing date of the application, namely November 12, 1997 [see *Zorti Investments Inc v. Party City Corp.* (2004), 36 C.P.R. (4th) 90 (T.M.O.B.); *Havana Club Holdings S.A. v. Bacardi & Co.* (2004), 35 C.P.R. (4th) 541 (T.M.O.B.); *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60 (F.C.)]

[41] The Opponent has the initial burden of proof to provide some admissible evidence from which it might reasonably be concluded that the facts alleged in support of the ground of opposition exist [see *Joseph E. Seagram & Sons, Limited v. Seagram Real Estate* (1984), 3 C.P.R. (3d) 325 at 329 (F.C.T.D.); *John Labatt Ltd v. Molson Cos Ltd.* (1980), 30 C.P.R. (3d) 293 aff'd (1992), 42 C.P.R. (3d) 495 (F.C.A.)].

[42] The Opponent has met its initial burden as much of the evidence filed is directed towards establishing that the menorah is a traditional symbol of the Jewish faith and culture.

[43] The Opponent contends that CPM is not a Jewish organization and therefore that it should not be using the menorah. As such, the Opponent argues that the Mark is deceptively misdescriptive of the Applicant's services. The Applicant argues that it is a Messianic Jewish organization, and should have the right to use the menorah. It should be pointed out that the

broader issue as to whether CPM has the “right” to “use” a depiction of a menorah as a symbol in its documents, and promotional literature, etc., is beyond the scope of this proceeding; in the present opposition proceeding the Registrar can only decide whether the Mark applied for can be registered as a trade-mark pursuant to the Act.

[44] The test for descriptiveness is one of first or immediate impression, considered from the perspective of the average consumer of the wares or services. While the leading cases on this issue most often refer to wares, I take it as self-evident that the principles also apply (by analogy) to services. The meaning of a trade-mark must be considered in the context of the wares and services. “Character” in s. 12(1)(b) means a feature, trait or characteristic of the product and “clearly” does not mean the description has to be precise but must be “easy to understand, self-evident or plain” [*Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968), 55 C.P.R. 29 at 34 (Ex. Ct.); *Drolet v. Stiftung Gralsbotchaft*, (2009) 85 C.P.R. (4th) 1][*Drolet*]. To be objectionable as clearly descriptive under s. 12(1)(b), a mark must be so apt for normal description of the article (or services), that a monopoly on the use of it should not be acquired [*Clarkson Gordon v. Registrar of Trade-marks* (1985), 5 C.P.R. (3d) 252 at 256 (F.C.T.D.)].

[45] Further, to determine whether a trade-mark is registrable under s. 12(1)(b), the Registrar must not only consider the evidence but also apply common sense; the decision that the mark is either clearly descriptive or deceptively misdescriptive is based on initial impression in light of the product or service in question [*Neptune S.A. v. Attorney General of Canada* (2003), 29 C.P.R. (4th) 497 (F.C.T.D.)].

[46] To be *deceptively misdescriptive*, a trade-mark must *mislead* the public as to the character (a feature, trait or characteristic) or quality of the wares or services [*Atlantic Promotions Inc. v. Registrar of Trade-Marks* (1984), 2 C.P.R. (3d) 183 (F.C.T.D.)].

[47] Firstly, the Applicant has argued that its activities bridge the traditional dichotomy between Christianity and Judaism, and that it should be considered a Jewish organization. However, with all due respect to the Applicant, and in full recognition that this is a complex issue, I find that, on balance, the evidence demonstrates that CPM’s religious services (“ministry and missions... bible study programs...street evangelism...conferences, etc) are

those of a Christian ministry and are therefore Christian in nature. Notwithstanding that the services are sensitive to Jewish beliefs and primarily directed to Jewish people, in essence, CPM's mission is to spread the Gospel of the Lord Jesus Christ. This is evident in its articles of incorporation, its "Doctrinal Bases", and is demonstrated in its promotional literature. Scholarly debate on the possibility of a more nuanced characterization of the Applicant's services is beyond the scope of this proceeding; I am satisfied that the Opponent's evidence demonstrates that teaching the Gospel of Jesus Christ is not a religious activity that would be considered Jewish. I would observe that this is consistent with a finding of fact of the Federal Court in *CJC v CPM* (based on similar evidence) that the Applicant is a Christian organization. With respect to the material date for considering descriptiveness, I note that the Applicant's incorporation documents (and thus its purposes) existed well before the filing date of this Application.

[48] Secondly, I am of the view that the evidence clearly establishes that the seven branched candelabrum known as the menorah is a universally known symbol of Jewish faith and culture. Again, I observe that this is consistent with the finding of the Federal Court in the *CJC v CPM* decision, which cited the excerpt from *The New Jewish Encyclopedia* (also in evidence in this proceeding as Exhibit U) which provides the following:

Menorah: Hebrew name of the seven branched candlestick originally made by the Biblical artisan *Bezalel* and placed in the sanctuary of the Tabernacle. [...] the Menorah has since become a universal symbol of Judaism.

[49] Thirdly, I am also of the view, based on the evidence of widespread appearance of this symbol in Canada, that the public in Canada would immediately recognize the Mark as a menorah when used in association with religious services and related wares. In so finding, I am guided by the other depictions of the menorah in evidence and the characteristics that each has in common. The menorah is recognizable as a candelabrum with seven branches with flames; the branches are characteristically curved or bent toward the centre.

[50] Further, unlike other registrations and applications in evidence relating to religious symbols, such as those with depictions of the cross, for example, there is no additional material in the Mark besides what is clearly recognizable as a menorah.

[51] Thus, the question then becomes, as a matter of first impression on seeing the Mark in association with the applied for religious wares and services, would the public be deceived into thinking that they are Jewish in nature - and would this have been the case at the date of filing of the Application?

[52] Based on the foregoing findings of the significance and recognisability of the menorah in Canada, and that the Applicant's services and related wares are essentially Christian in nature, I am of the view that a member of the public would, as a matter of first impression on seeing the Mark (as applied for, i.e. alone without additional material) in association with the Applicant's religious services and related wares, be deceived into thinking that an essential feature, trait or characteristic was that they were Jewish religious services and related wares. The Opponent is therefore successful under this ground of opposition.

Section 38(2)(d)/s. 2 Non-distinctiveness

[53] The material date for the determination under this ground is the filing date of the statement of opposition (January 8, 1999) [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

[54] The Opponent has pleaded that the Mark is not distinctive within the meaning of s. 2 of the Act, by reason of the fact that the Mark does not actually distinguish and is not adapted to distinguish the wares and services in association with which it is proposed to be used by the Applicant from the wares of others, including those of the Opponent; the Opponent has pleaded that the Mark does not function as a trade-mark.

[55] As set out in *Drolet, supra* (at para 169), to be distinctive, a trade-mark must meet three tests: (1) the trade-mark must be associated with a product; (2) the owner must use this association between the trade-mark and his product and sell this product or service; and (3) this association must allow the owner of the trade-mark to distinguish his product from those of other owners [see *Philip Morris Inc. v. Imperial Tobacco Ltd.* (1985), 7 C.P.R. (3d) 254 (F.C.T.D.)].

[56] The Mark does not satisfy the test with respect to (3) above. The association of the Mark with the services and related wares would not allow the Applicant to distinguish its services from those of others. As Mr. Justice O’Keefe stated in *Canadian Council of Professional Engineers v. APA- The Engineered Wood Assn.* (2002), 7 C.P.R. (4th) 239 (F.C.T.D.), “a purely descriptive or a deceptively misdescriptive trade-mark is necessarily not distinctive”. Therefore based on my earlier finding that the Mark is deceptively misdescriptive, the difference in material date having no effect on this issue, I conclude that at the material date the Mark was not adapted to distinguish nor did it actually distinguish services and related wares of the Applicant from those of others within the meaning of s. 2 of the Act.

Disposition

[57] The opposition is therefore successful, and it is unnecessary to consider the remaining grounds of opposition.

[58] In view of all of the foregoing, 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.

P.Heidi Sprung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office