



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

**Citation: 2015 TMOB 218
Date of Decision: 2015-12-07**

IN THE MATTER OF AN OPPOSITION

Carollyne Yardley cobra Carollyne Yardley Omnimedia and	Opponent
American Girl, LLC	Applicant
1,530,071 for the trade-mark CAROLINE	Application

Summary

[1] Ms. Yardley alleges that the application for CAROLINE for use with children's books, paper dolls, dolls, doll clothing and accessories is confusing with her trade-mark CAROLLYNE registered for use in association with the retail sale of artwork and goods including paintings, books, greeting cards, children's clothing, dolls, and plush toys. Despite alleging this, Ms. Yardley has not filed any evidence other than the particulars of her registration for the trade-mark CAROLLYNE or made any submissions in support of the grounds of opposition.

[2] In this case, the fact that the trade-marks at issue are given names and lack inherent distinctiveness impacts the confusion analysis. Where trade-marks are weak, consumers are expected to be more on guard to the differences between them and owners are held to accept

some risk of confusion. In view of this and the other circumstances discussed below, I find that the Applicant has proven that there is not a reasonable likelihood of confusion between the Opponent's CAROLLYNE trade-mark and the CAROLINE trade-mark for the applied-for goods. As such, the opposition is rejected.

File Record

[3] On June 1, 2011, Mattel, Inc. filed an application to register the trade-mark CAROLINE (the Mark) with children's books, paper dolls, dolls, doll clothing, and doll accessories (the Goods as amended) on the basis of its proposed use in Canada. The application was subsequently assigned to American Girl, LLC (the Applicant).

[4] The application was advertised for opposition purposes in the *Trade-marks Journal* of July 10, 2013.

[5] On December 10, 2013, Carollyne Yardley c/o Carollyne Omnimedia (the Opponent) filed a statement of opposition pleading the grounds summarized below:

- (a) the application does not comply with section 30(e) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) since the Applicant never intended to use the Mark in Canada in association with all of the Goods;
- (b) the application does not comply with section 30(i) of the Act as the Applicant could not be satisfied that it is entitled to use the Mark in Canada;
- (c) the Mark is not registrable pursuant to section 12(1)(d) of the Act as it is confusing with registration No. TMA746,515 for the trade-mark CAROLLYNE;
- (d) the Applicant is not the person entitled to registration under section 16(3)(a) of the Act as the Mark is confusing with the Opponent's trade-marks CAROLLYNE and CAROLLYNE Design previously used or made known in Canada;

- (e) the Applicant is not the person entitled to registration under section 16(3)(c) of the Act as the Mark is confusing with one or more of the Opponent's trade-names including Carollyne Yardley and Carollyne Yardley Omnimedia which had been previously used in Canada; and
- (f) the Mark is not distinctive and is not capable of being distinctive, having regard to the provisions of sections 38(2)(d) and 2 of the Act, because:
 - 1. it is not capable of distinguishing the Goods from the goods and services of others, particularly the Opponent's goods and services sold in association with the Opponent's trade-marks and trade-names;
 - 2. as a result of the transfer of rights in the Mark, two or more entities have the right to use the Mark and those rights were exercised, contrary to section 48(2) of the Act; and
 - 3. the Mark has not and will not be used by the Applicant for the purposes of distinguishing the Goods from the goods and services of others in the marketplace.

[6] The Applicant filed and served a counter statement in which it denies the Opponent's allegations.

[7] The Opponent filed as her evidence the affidavit of Karen Matson attaching the particulars of registration No. TMA746,515 for the trade-mark CAROLLYNE. The Applicant filed as its evidence the affidavits of Matthew Boyd, Paul Girard, James Haggerty, and Laura Morrison.

[8] Only the Applicant filed a written argument and attended a hearing held on December 1, 2015.

Material Dates and Onus

[9] The material dates with respect to the grounds of opposition are as follows:

-sections 38(2)(a)/30 of the Act - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];

-sections 38(2)(b)/12(1)(d) of the Act - the date of my decision [*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(3) of the Act – the filing date of the application; and

- sections 38(2)(d) of the Act / 2 - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[10] Before considering the grounds of opposition, it is necessary to review some of the technical requirements with regard to (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[11] With respect to (i) above, there is an evidential burden on the opponent to prove the facts in its allegations pleaded in the statement of opposition: *John Labatt Limited v Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298. The presence of an evidential burden on an opponent 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. With respect to (ii) above, the legal onus is on an applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent (for those allegations for which the opponent has met its evidential burden). The presence of a legal 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 an applicant.

Grounds of Opposition

Section 30(e) and 30(i) Grounds of Opposition

[12] The Opponent has pleaded that the application is contrary to sections 30(e) and 30(i) of the Act.

[13] There is no evidence that supports the ground of opposition based on section 30(e) of the Act. Consequently, this ground is rejected on the basis that the Opponent has not satisfied its initial burden.

[14] There is no evidence that supports the ground of opposition based on section 30(i) of the Act. Where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith [see *Sapodilla Co v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. As the application includes the required statement and there is no allegation or evidence of bad faith or other exceptional circumstances, the section 30(i) ground is rejected.

Section 16(3)(a), 16(3)(c) and 2 Grounds of Opposition

[15] The grounds of opposition based on sections 16(3)(a) and 16(3)(c) of the Act are rejected because the Opponent has not met her initial burden. The Opponent has not evidenced that her trade-marks or trade-names were used or made known in Canada as of the applicable material date. Although the Opponent's registration for her trade-mark refers to use, that is not sufficient for the Opponent to meet her burden for these grounds of opposition [*Roos, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB) at 268]. The grounds of opposition based on section 2 of the Act are also rejected as the Opponent has not met her initial burden as there is no evidence supporting any of the allegations set out in the distinctiveness ground of opposition.

Section 12(1)(d) Ground of Opposition

[16] The Opponent has pleaded that the Mark is not registrable under section 12(1)(d) of the Act as it is confusing with the Opponent's registered trade-mark set out below.

Registration No.	Trade-mark	Goods and Services
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TMA746,515	CAROLLYNE	GOODS: (1) Finished paintings, illustrations, reproductions and caricatures; printed matter, namely, books, greeting cards, bookmarks and post cards; Christmas decorations; clothing, namely, children's clothing; toys namely, dolls, plush toys; coffee cups; bed pillows; puzzles. SERVICES: (1) Retail sale of artwork.
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[17] I have exercised my discretion and checked the Register to confirm that this registration is extant. Therefore, the Opponent has met her initial burden with respect to this ground.

[18] Trade-marks are confusing when there is a reasonable likelihood of confusion within the meaning of section 6(2) of the Act:

The 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 goods or services associated with those trade-marks are manufactured . . . or performed by the same person, whether or not the goods or services are of the same general class.

[19] Thus, the issue is not confusion between the trade-marks themselves, but confusion of goods and services from one source as being from another source. In the instant case, the question posed by section 6(2) of the Act is whether purchasers of the Goods sold in association with the trade-mark CAROLINE would believe that those items were produced or authorized or licensed by the Opponent.

[20] 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 “all the surrounding circumstances” including those specifically mentioned in section 6(5) of the 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 goods, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, [2006] 1 SCR 772 (SCC) at para 54].

Inherent Distinctiveness

[21] As part of its evidence, the Applicant filed the affidavit of Paul Girard, an articling student employed by its agent. Mr. Girard visited the Opponent’s website www.carollyne.com and obtained copies of two radio interviews with the Opponent posted on her website. The radio interviews are admissible even though they are hearsay since it was necessary for the Applicant to file them in support of its application and they are reliable since the Opponent, being a party, has the opportunity to refute the evidence [*Reliant Web Hostings Inc v Tensing Holding BV*;

2012 TMOB 48 at para 35]. In the radio interviews it appears that there is general acknowledgement that CAROLINE and CAROLLYNE are given names. Although I do not give it much weight due to the potential reliability issues with the third party websites, the evidence of Matthew Boyd, an articling student employed by the Applicant's agent, who attaches to his affidavit printouts from various websites which state that Caroline and Carollyne are given names and variations of one another is consistent with the information in the radio interviews.

[22] As the parties' trade-marks are each comprised of a given name they have, if any, a very low degree of inherent distinctiveness [*Glaskoch B Koch Jr GmbH & Co KG v Anglo Canadian Mercantile Co* (2006), CanLii 80333 (TMOB)].

Degree of Resemblance Between the Trade-marks

[23] As to the degree of resemblance between the trade-marks at issue, I find that the trade-marks are very similar in appearance and sound with the different endings of each trade-mark resulting in small differences in appearance and sound (ie at least some consumers will sound CAROLINE as rhyming with pine, and CAROLLYNE as rhyming with pin as in the interview on CFA1070 with the Opponent). Furthermore, the trade-marks suggest similar ideas that of a given name for a girl or woman.

Extent Known and Length of Time in Use

[24] While the Opponent's registration is based on use, this only entitles me to assume *de minimis* use [*Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB) at 430]. *De minimis* use does not support a conclusion that the trade-mark has become known to any significant extent, nor that the trade-mark has been used continuously. Further, while Ms. Yardley discusses the use of her trade-mark in the radio interviews, the information provided does not allow me to conclude whether it has become known to any significant extent or its length of time in use.

[25] The Applicant submits the affidavit of Laura Morrison, an articling student employed by the Applicant's agent, who attended the American Girl Specialty Boutique in Ottawa and obtained print-outs from the American Girl website. In the course of her visit to the store, she

located and took pictures of the CAROLINE brand doll. In the absence of information regarding sales or the length of time in use, however, I am unable to determine to what extent, if any, this factor favours the Applicant.

Nature of the Goods and Services and Trade

[26] In the absence of evidence from the Opponent, this factor favours the Applicant. Although I recognize that there are no restrictions in Opponent's registration or the application to any particular type of doll or any particular channel of trade, I do have some evidence from the Applicant that the Opponent's products do not appear to be identical and do not appear to be sold through the same channels.

[27] The nature of the goods appears to be different. The radio interviews with Ms. Yardley sets out that she is an artist that supports her paintings and artwork through the sale of merchandise such as dolls, cards and bookmarks. Ms. Yardley's artwork specializes in a type of pop surrealism she has termed "squirrealism" with human characters with squirrel masks and squirrel faces. In contrast, the evidence attached to the affidavit of Ms. Morrison shows that the Mark is used in association with a doll who connects girls 8 and up with a historical character named Caroline Abbott "a heroic girl who must test her bravery and wits to help her family during the War of 1812" and related products including doll clothes, accessories and furniture and books about the character.

[28] Likewise, the channels of trade may well be different. The affidavit of Ms. Morrison shows that the Goods sold in association with the Mark are sold on the Applicant's website and through an American Girl Specialty boutique.

Surrounding Circumstance: Jurisprudence Concerning Weak Trade-marks

[29] The jurisprudence on weak trade-marks supports the Applicant's position. It is well settled that trade-marks consisting of given and surnames names are entitled to a very small ambit of protection [*Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD) at 240; *Joseph Ltd v XES-NY Ltd* (2005), 44 CPR (4th) 314 (TMOB)] and that comparatively small differences will suffice to distinguish between weak marks [*Prince Edward Island Mutual*

Insurance Co. v. Insurance Co. of Prince Edward Island (1999), 86 CPR (3d) 342 (FCTD) at paras 32-34]. In *Provigo Distribution Inc v Max Mara Fashion Group SRL* (2005), 46 CPR (4th) 112 at para 31 (FCTD), de Montigny J. explained:

The two marks being inherently weak, it is fair to say that even small differences will be sufficient to distinguish among them. Were it otherwise, first user of words in common use would be unfairly allowed to monopolize these words. A further justification given by courts in coming to this conclusion is that the public is expected to be more on its guard when such weak trade names are used

...

[30] A party adopting a weak trade-mark has been held to accept some risk of confusion [*General Motors v Bellows* (1949), 10 CPR 101 at 115-116 (SCC)]. While it is possible for the degree of distinctiveness attributed to a weak trade-mark to be enhanced through extensive use [*Sarah Coventry Inc v Abrahamian*, supra], there is no evidence that the Opponent's trade-mark CAROLLYNE has been used in Canada to any such extent.

Surrounding Circumstance: State of the Register Evidence

[31] As state of the Register evidence, the Applicant submits the affidavit of James Haggerty, a trade-mark searcher employed by the Applicant's agent. He conducted a search for active applications and registrations for trade-marks consisting of first names for use in association with dolls. Mr. Haggerty's search located over 90 trade-marks. At the hearing, the Opponent submitted that the evidence shows that it is common in the trade for dolls to be sold in association with trade-marks consisting of given names. Given the number of trade-marks located by Mr. Haggerty, I find that this evidence results in the inference that trade-marks consisting of given names for use with dolls have some presence in the marketplace in Canada and consumers have at least some exposure to them.

Conclusion

[32] The question posed by section 6(5) of the Act is whether customers of the Goods, provided under the trade-mark CAROLINE, would believe that those goods were provided or authorized or licensed by the Opponent owing to its trade-mark CAROLLYNE.

[33] Having regard to the section 6(5) factors, in particular the low inherent distinctiveness of the Opponent's trade-mark which is a given name, that small differences may suffice to distinguish between weak marks, that there is no evidence that the Opponent's trade-mark has become known to any significant extent or that the parties' nature of goods or channels of trade overlap, I find that the Applicant has met the legal onus on it show that, on a balance of probabilities, there is no reasonable likelihood of confusion between the Mark and the opponent's mark CAROLLYNE.

Disposition

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

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Hearing Date: 2015-12-01

Appearances

No one appearing

For the Opponent

Michael O'Neill

For the Applicant

Agents of Record

Oyen Wiggs Green & Mutala LLP

For the Opponent

Gowling Lafleur Henderson LLP

For the Applicant