



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

**Citation: 2012 TMOB 151**  
**Date of Decision: 2012-08-01**

**IN THE MATTER OF AN OPPOSITION  
by Northland Products Company to  
application No. 1,130,482 for the trade-  
mark NORTHLAND SALES & Design in  
the name of 1324555 Ontario Inc.**

[1] On February 8, 2002, Craig Holdings Inc. filed an application to register the trade-mark NORTHLAND SALES & Design (the Mark), as shown below:



[2] The application covers the following wares and services:

wares

(1) Epoxy putty; wood epoxy putty repair; non-adhesive rubber tape for plumbing, automotive, electrical, household and sports equipment repair; glass cleaner; high temperature sealer and metal compounds; plastic and fiberglass repair compounds, lubricants, penetrants, rust corrosion protectants, and degreasing/cleaning agents, all for use in the automotive industry.

(2) Tire sealants, windshield wiper blades, engine and radiator sealants, automotive polishes and waxes.

services

(1) Operation of a business offering for sale automotive and household products of others including cleaning, sealing and repair compounds, lubricants, penetrants, rust corrosion protectants, engine and oil treatments, fuel injector cleaners, polishes and waxes, and steel wool.

[3] The application claims use of the Mark in Canada since at least as early as 1989 in association with the wares (1) and services. It claims proposed use of the Mark in Canada in association with the wares (2).

[4] On May 30, 2002, the application was assigned to 1324555 Ontario Inc. (the Applicant).

[5] The application was advertised for opposition purposes in the *Trade-marks Journal* of April 25, 2007.

[6] On September 25, 2007, Northland Products Company (the Opponent) filed a statement of opposition against the application. The Opponent has pleaded grounds of opposition pursuant to sections 38(2)(a), (b), (c) and (d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The Applicant filed and served a counter statement in which it denied the grounds of opposition.

[7] In support of its opposition, the Opponent filed affidavits of Eric Peterson (sworn March 19, 2009) and James Szumski (sworn March 23, 2009). By letter dated June 4, 2010, the Opponent's agent requested that certain privileged emails pertaining to unrelated matters that were inadvertently incorporated into Exhibit E-1 of the Szumski affidavit be removed and returned, with the consent of the Applicant's agents. This was done by the Registrar's letter of June 16, 2010.

[8] The Applicant cross-examined Mr. Peterson and Mr. Szumski on their respective affidavits and transcripts have been filed.

[9] The Applicant elected to not file any evidence.

[10] Both parties filed a written argument and participated in an oral hearing.

## Onus

[11] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

## The Evidence

[12] The following summary focuses on those portions of the parties' evidence that I consider to be the most pertinent to the issues discussed hereafter.

### *Petersen Affidavit and Cross-examination*

[13] Mr. Petersen is the Opponent's Executive Vice President, COO, a position that he has held for more than 25 years. The Opponent is located in the United States of America, which is where Mr. Petersen resides. Mr. Petersen does however travel to Canada on business approximately monthly and has a cottage in Canada.

[14] Mr. Petersen states at paragraph 4 of his affidavit that he believes that he is qualified to provide his views and opinions with respect to the likelihood of confusion between the Opponent's products, including NORTHLAND branded products, and those of competitors. However, the likelihood of confusion is an issue that I am required to assess and it is not one that requires expert evidence. In any event, it is trite to say that the view of a representative of one of the parties on such an issue is not considered to be relevant or unbiased. I am therefore disregarding those portions of his evidence where he expresses his view and conclusions regarding the likelihood of confusion.

[15] Much of Mr. Petersen's evidence is directed to his view of the likelihood of confusion and includes conclusions as to the Opponent's reputation etc. in Canada. The main facts, as opposed to opinions or conclusions, appear at paragraphs 6-9 of his affidavit, which I reproduce below:

6. Since 1908, [the Opponent's] superior products and customer-driven service have been and continue to be provided to industrial railroads, trucking fleets, OEM factory-fill and service-fill, industrial, automotive and agriculture markets. Northland Technical Laboratories, a division of [the Opponent], provides extensive oil analysis and lubricant performance evaluation services performed in state-of-the-art laboratory facilities.

7. Since at least as early as 1990, [the Opponent] has been consistently and continuously selling and marketing in Canada in the engine anti-freeze and coolant, lubricating oil, engine oil, hydraulic oil, transmission lubricant, lubricating grease, and oil and coolant analysis services industries. [The Opponent's] products, including NORTHLAND brand products, are sold throughout Canada in and to the OEM factory-fill and service fill, industrial, railroad, automotive and agriculture markets.

8. Since at least as early as 1990, [the Opponent] has sold a variety of its NORTHLAND brand and private label products to major customers and retailers in Canada. At least for each the last 5 years, these sales have exceeded \$1,000,000.00 USD annually in sales volume. These customers are John Deere, Case New Holland, Hitachi, Canadian National Railroad, Canadian Pacific Railroad, RailAmerica and Recochem. For each of the preceding years, and since at least as early as 1990, these sales have been in the range of \$100,000.00 to \$500,000.00 annually.

9. In March of 2005, Northland Technical Laboratories opened a laboratory in Toronto, Ontario to provide lubricant analysis and testing services for its Canadian customers. These customers include John Deere, Canadian National Railroad, RailAmerica and Canadian Pacific Railroad.

[16] Some additional information concerning the Opponent's activities with respect to Canada was elucidated during Mr. Petersen's cross-examination, including the following:

- in "approximately 1989, [the Opponent] began to develop a relationship on a direct basis in Canada through an involvement with some OEM [original equipment manufacturer] customers, as well as on a direct basis with the Canadian National Railroad and some of the OEM customers that have direct business operations in Canada" [Q29]
- the Opponent sells lubricant in various containers from quarts, to a 2.5 gallon container, to a 5 gallon pail, all the way up to a bulk transport [a tanker truck with 6,500 to 7,000 gallons]; the quart "would show the Northland brand" and the bulk transport containers are branded Northland [Q82-92]
- in addition to OEMs and railroads, the Opponent's products are also sold to distributors [lubricant distributors and industrial supply distributors] in the United States who do business in Canada or have a subsidiary in Canada, but the Opponent cannot quantify how much of that sales activity happens in Canada because it does not have direct control over where those distributors sell their

products and such distributors do not provide the Opponent with their sales information [Q128-136]; however, one of the biggest distributor customers for the Opponent is Recochem, a Canadian company – although Recochem has “distributed some Northland product for us in Canada under the Northland name”, the Opponent has also “provided Northland product for them under the Reco company, or under a third party company, or under a private label customer relationship of theirs in the U.S. – the Opponent’s product could be packaged as a Recochem brand or as the brand of the automotive chain, department store or mass merchandiser that Recochem is marketing to, i.e. private label business [Q137-144]

- an individual consumer could go and buy the Opponent’s lubricants for use in equipment such as tractors, automobiles, trucks and heavy equipment at a Case New Holland or John Deere dealer [Q162-171]; however, some products that the Opponent sells do not say Northland on the label, for example certain products sold to John Deere bear the John Deere brand, not the Northland brand, but Mr. Petersen could not even roughly say what the breakdown is between private label and Northland branded activity [Q179-186]; Case New Holland also buys private label products from the Opponent [Q238-243]
- when the Opponent sells its product in 20,000 gallon rail cars to railroad companies, the vessel that the product travels in does not say Northland on it, but Mr. Petersen stated that such product was branded Northland because the purchaser makes the product selection based on the brand and because approval documents, supply contracts and the like reference the brand [Q197-204]

[17] Mr. Petersen also provided some information concerning two instances of what he considered to be confusion between the parties’ wares/services. In addition, he provided details of what he was able to learn about the activities of the Applicant.

*Szumski Affidavit and Cross-examination*

[18] Paragraphs 1 and 2 of Mr. Szumski’s affidavit read:

1. I am an articling student employed by Borden Ladner Gervais LLP (“BLG”), the firm acting on behalf of the Opponent, and, as such, have knowledge of the matters to which I hereinafter depose. Where I do not have personal knowledge, I have stated the source of my information and believe it to be true.
2. I have access to the files regarding this matter and this Opponent in the offices of BLG and have reviewed such in the context of this Affidavit.

[19] Mr. Szumski provides exhibits that relate to third parties’ marks (whose relevance has not been explained), the Applicant’s activities, and the Opponent’s use and sales.

[20] Regarding the Applicant, he provides:

- “a copy of file No. 898,553 relating to the application for registration of the trademark NORTHLAND, filed on December 4, 1998 by the Opponent” is provided as Exhibit “A”; this application was opposed by the Applicant and a copy of the affidavit of Eric T. Chong, with only some of its exhibits, that was filed by the Applicant is provided as Exhibit “B”
- “print-outs of the webpages from the Applicant’s website accessible through the URL <http://www.northlandsales.ca>” are provided as Exhibit “E-1” (dated 11/03/2009)
- “print-outs of the webpages from the Applicant’s website accessible through the URL <http://www.nlsproducts.ca>” are provided as Exhibit “F-1” (dated 12/03/2009)

[21] After referring to Mr. Petersen’s affidavit, Mr. Szumski attests as follows, at paragraphs 13 and 14:

13. In support of Mr. Petersen’s affidavit, the Opponent produced (i) sample sales figures for Canada for both its private label products as well as its NORTHLAND brand products; and (ii) sample brochures and labels depicting the use of both its private labels and its Northland Mark in association with such products. These sales figures and sample brochures and labels were not, however, included in Mr. Petersen’s affidavit due to the unavoidable scheduling and itinerary complications referred to in BLG’s letter to the Trade-marks Office dated March 16, 2009. Marked as Exhibit “H” to this my affidavit is a copy of BLG’s letter to the Trade-marks Office dated March 16, 2009. Instead, these sales figures and sample brochures were sent directly to BLG for inclusion in my affidavit.
14. I have reviewed these sales figures and sample brochures and labels and am informed by Mr. Petersen, and do verily believe, that:
  - (a) marked as Exhibit “I” to this my affidavit are copies of sales invoices of both private label and NORTHLAND brand products made by the Opponent in Canada as referred to in Mr. Petersen’s affidavit; and
  - (b) marked as Exhibit “J” to this my affidavit are copies of both private label and NORTHLAND brand labels used in association with the Opponent’s products Canada as referred to in Mr. Petersen’s affidavit.

[22] For clarification, although Mr. Szumski refers to sales figures not being provided in Mr. Petersen’s affidavit, perhaps he meant sales invoices as sales figures were provided in Mr.

Petersen's affidavit. Also, as noted in Mr. Szumski's cross-examination, the sales invoices were actually identified as Exhibit "J" and the labels as Exhibit "I", not vice versa.

[23] On cross-examination, Mr. Szumski stated that he was asked to do his affidavit by Mr. Katul, who was at that time a partner at BLG. [Q16-17] When asked where he obtained the material that he attached as Exhibit "A", Mr. Szumski replied that the material was shown to him by Mr. Katul and that he did not know where Mr. Katul got it from. [Q23-24] Counsel for the Opponent interjected that it was a certified copy, but counsel for the Applicant noted correctly that it is a photocopy of a certified copy. A further discussion among counsel led to an agreement that Exhibit "A" does not include all of the materials in application file No. 898,553, for example the transcripts of cross-examinations. Mr. Szumski did not have any role in deciding what was included or excluded. [Q37] Similarly, Mr. Katul presented Mr. Szumski with the materials provided as Exhibit "B" with no explanation as to why some of the exhibits had been removed. [Q41] Regarding Exhibits "E-1" and "F-1", Mr. Szumski prepared screen shots of the web pages, which he sent to Mr. Katul who printed them out. [Q44]

[24] During cross-examination, Mr. Szumski advised that he did not know the details of the "unavoidable scheduling and itinerary complications" to which he referred, that language having come from the letter that he attached as Exhibit "H". [Q50-51]

[25] Regarding Mr. Szumski's communications with Mr. Petersen, there was the following exchange:

Q52 And, did you have any conversations with Mr. Petersen? Did you speak to him by telephone or otherwise?

[Opponent's counsel]: About this issue?

Q53 About anything?

A I have spoken to him, and I did review some e-mails, but I don't believe I spoke to him in person at the time.

Q54 So, you spoke to him by telephone?

A No, not by telephone.

Q55 I'm talking about during the period before you swore this affidavit.

A No, not by telephone.

Q56 You did not speak to him by telephone ---

A No.

Q57 --- in March 2009?

A No.

Q58 Did you communicate with him by e-mail?

A Yes.

Q59 And, what was the nature of that communication?

A It was an e-mail that I reviewed describing the sales figures and the labels that are referenced in paragraph 14 of the affidavit.

Q60 And, when you say it was an e-mail that you reviewed, did he send it to you?

A He sent it to Mr. Katul, and I reviewed it.

Q61 Okay. So, you didn't speak with him or e-mail with him directly?

A No.

[26] On re-examination, Mr. Szumski's counsel said to him: "My friend asked you about the discussions which you've had with Mr. Petersen, and you mentioned that you had had discussions with him. What was the nature of that discussion or those discussions?" Mr. Szumski replied, "I spoke with Mr. Petersen today, and he confirmed that Exhibits I and J in my affidavit are the sales figures and the labels referred to."

[27] Evidence that is based on information and belief is *prima facie* inadmissible hearsay evidence unless it satisfies the criteria of necessity and reliability [see *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. The Applicant has submitted that most, if not all, of Mr. Szumski's evidence is inadmissible hearsay.

[28] The Opponent's main submissions in response to the hearsay objection related to Exhibits "I" and "J" to the Szumski affidavit. The Opponent seems to agree that Exhibits "I" and "J" are



hearsay but submits that they should nevertheless be considered. In particular, the Opponent submits that the requirement of necessity has been met through Mr. Szumski's statement that these materials were not included in Mr. Petersen's affidavit "due to the unavoidable scheduling and itinerary complications referred to in BLG's letter to the Trade-marks Office dated March 16, 2009." However, I am not satisfied that it was necessary to introduce these materials through an articling student, rather than through a knowledgeable employee of the Opponent.

[29] The reference to "unavoidable scheduling and itinerary complications" seems vague to me. Moreover, I note that the letter where this phrase originated does not rely on "unavoidable scheduling and itinerary complications" as the reason for not attaching invoices and labels to Mr. Petersen's affidavit. Instead, that letter (Exhibit "H") relies on "unavoidable scheduling and itinerary complications" as the reason for requesting a 7-day extension to the deadline for filing evidence. In particular, the letter reads, "the 7-day extension is required to allow the Opponent, who resides in another jurisdiction, to execute its affidavit before a commissioner for taking oaths, return the originally executed affidavit to its agents for filing with the Opposition Board – the inability of the Opponent to have its affidavit sworn and returned to its agent on time was occasioned by unforeseeable and unavoidable scheduling conflicts and itineraries." Moreover, such letter provided a draft form of Mr. Petersen's affidavit in support of the extension request and such draft did not refer to any attachments. We therefore do not know why the invoices and labels were not introduced by Mr. Petersen (or another knowledgeable employee of the Opponent). The "criterion of necessity" refers to the need of the hearsay evidence to prove a fact in issue. It is not evident to me that there was a need to file these materials of the Opponent through an outside party and I find that such documents (Exhibits "I" and "J" to the Szumski affidavit) are inadmissible hearsay in the hands of Mr. Szumski.

[30] The Opponent submitted that most of Mr. Szumski's other exhibits are of public record. The Opponent's agent also commented that the relevant point with respect to the earlier opposition was that there the Applicant asserted that there was a likelihood of confusion between the parties' marks/names. Overall, the Opponent's substantive arguments in this case have not depended on any portions of Mr. Szumski's evidence other than Exhibits "I" and "J". As the Opponent has not relied on the other portions of the evidence, I do not consider it necessary to make a detailed ruling as to their admissibility. Suffice it to say that generally exhibit material

prepared by third parties does not satisfy the test of “reliability and necessity” for hearsay evidence to become admissible.

#### Section 38(2)(a)/30(a) Ground of Opposition

[31] The Opponent has pleaded that the application does not comply with section 30(a) of the Act in that the application does not contain a statement in ordinary commercial terms of the specific wares and services applied for.

[32] In its written argument, the Opponent explained its position further at paragraph 33, as follows:

It is not clear what is the scope of “the automotive industry” in the expression “plastic and fiberglass repair compounds, lubricants, penetrants, rust corrosion protectants, and degreasing/cleaning agents, all for use in the automotive industry”. It is unclear whether individual retail consumers, when buying and using these wares for minor maintenance of their own cars, would be engaging in “use in the automotive industry”. The phrase is unclear and not expressed in ordinary commercial terms.

[33] From the foregoing submission, I conclude that the Opponent does not have a section 30(a) objection with respect to the wares and services to which it has not specifically referred.

[34] At the oral hearing, the Applicant pointed out that the pleadings did not indicate that the Opponent’s position is that the words “in the automotive industry” are vague. While this is the case, I note that the Applicant did not raise any concern about the sufficiency of the pleading in its counter statement.

[35] The phrase “all for use in the automotive industry” was added by the Applicant pursuant to an indication from the Examiner that such phrase would be acceptable to specify the field of the above-mentioned wares. There is no evidence that it is not an ordinary commercial term and it seems to clearly indicate that the related wares could be used in the manufacture, repair or maintenance of motor vehicles.

[36] I am therefore dismissing the section 30(a) ground of opposition.

[37] In its written argument, the Opponent raised the issue of who would be the target consumer of wares identified as “for use in the automotive industry”, but that does not seem

relevant with respect to a section 30(a) ground of opposition. At the oral hearing, the Opponent's agent submitted that if this ground were to not succeed, then the use of the words "in the automotive industry" should be used to broadly define the end-users or channels of trade to be associated with such wares when considering the likelihood of confusion under other grounds, and I agree.

#### Section 38(2)(a)/30(b) Ground of Opposition

[38] The Opponent has pleaded that the application does not comply with section 30(b) of the Act "in that the Applicant has not used the Mark as a trade-mark in association with the wares (1) and (2) as applied for in Canada, and further an accurate date of alleged first use has not been set out in the application".

[39] It is noted that this ground does not challenge the Applicant's use with respect to services. Moreover, as wares (2) were applied for on the basis of proposed use, not use, a section 30(b) ground of opposition cannot apply to them. Accordingly, I need only address this ground in relation to wares (1).

[40] The material date with respect to section 30(b) is the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475]. The evidential burden on an opponent respecting the issue of an applicant's non-compliance with section 30(b) is a light one [see *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89].

[41] As the Applicant has not filed any evidence, the Opponent must meet its light initial burden through its own evidence. The Opponent submits that it has done so based on the following pieces of evidence: first, Mr. Petersen's statement that he was not aware of any products marketed under the Mark in Canada, despite his knowledge of what he considers to be the relevant market; and second, Mr. Petersen's statement that the Applicant is a mere distributor of third party products.

[42] Regarding the first piece of evidence, it appears that Mr. Petersen's statement was based both on his knowledge of what he considers to be the relevant market and inquiries that he made

when he first learned of the Applicant. Mr. Petersen attested during cross-examination that early in the Opponent's relationship with John Deere in Canada, "someone had contacted us related to Northland Sales, assuming that Northland Products Company and Northland Sales were the same entity." [Q260] He elaborated, at Q269:

It was – we were setting – in my recollection, we were setting up product for distribution into Canada, and they were setting up the supplier information in Canada, and their recollect – their assumption was Northland Products Company and Northland Sales were the same entity, and we needed to go back through and actually establish that we are not the same entity. And, at that time, I did not know who Northland Sales was, and they were, I believe at the time – I don't know what their activity was or why Deere would have known about them.

[43] Mr. Petersen then went "to some of the areas where [the Applicant might] be distributing product to find out whether they had any kind of brand presence... [but] learned very little." [Q271-272] He stated that he did become "familiar with the Rizlone scenario, because [he knew] they were the redistributor... So, that was the only product I was able to find where it had actually had any extensive distribution" [Q275-276] (it is not clear to me what exactly Mr. Petersen was referring to when he said this). When asked how he knew that the Applicant was "a mere distributor of third party products", Mr. Petersen replied, "Based on the research that I had individually done, and based on the research in our affidavit, I saw no evidence that they were out selling a NORTHLAND branded product." [Q279] Mr. Petersen also stated that he tried to find the Applicant's products in Canadian Tire, Home Hardware and maybe Beaver Lumber, but he also stated that Canadian Tire predominantly has their own private label brands and that his personal inquiries were limited. [Q281 and 285-287] (I note that, to the extent that the Applicant's wares are for the automotive industry, Home Hardware and Beaver Lumber might not be appropriate places to look for the Applicant's products.)

[44] In support of its position that the Opponent has not met its initial burden with respect to this ground, the Applicant has relied on *Weetabix Ltd v Alpina Productos Alimenticios SA* (2011), 93 CPR (4th) 54 (TMOB). In that case, the evidence in support of the opponent's initial burden under section 30(b) came from an executive who said that he was familiar with the relevant market and had investigated whether wares bearing the mark at issue were available in Canada and found no instances that they were. Member Robitaille held that this was insufficient to meet the opponent's initial burden and that the applicant was therefore under no obligation to

positively evidence use of its mark. The Opponent submitted that it considered the *Weetabix* case to be distinguishable because Mr. Petersen made significant efforts to investigate. However, Mr. Petersen did state that his personal enquiries were limited and I am not convinced that his evidence is significantly stronger than what was before the Board in *Weetabix*.

[45] Mr. Petersen also attested at paragraph 10 of his affidavit that he “found no evidence of products offered under the marks NORTHLAND SALES or NORTHLAND SALES & Design on the Applicant’s website (located at [www.northlandsales.ca](http://www.northlandsales.ca))”. However, Mr. Petersen swore his affidavit in 2009 and did not indicate when he checked the website (the relevant time period under section 30(b) being between December 31, 1989 and February 8, 2002). This evidence therefore does not serve to meet the Opponent’s initial burden.

As mentioned earlier, the Opponent also relies upon Mr. Petersen’s statement that the Applicant is “a mere distributor of third party products”. However, as stated in *Yamamoto & Co (America) Inc et al v McCabe* (1985), 4 CPR (3d) 9 (TMOB) at p. 16, “[a] distributor can, of course, use a trade mark and acquire rights to a trade mark in certain circumstances”. I therefore attach no significance to Mr. Petersen’s allegation that the Applicant is a distributor.

[46] The section 30(b) ground of opposition is dismissed on the basis that the Opponent has not met its initial burden.

#### Section 38(2)(a)/30(e) Ground of Opposition

[47] The Opponent has pleaded that the application does not comply with section 30(e) of the Act “in that the Applicant, by itself and/or through a licensee, did not intend and does not intend to use the [M]ark as a trade-mark in association with the wares (1) and (2)”. As wares (1) were applied for on the basis of use, a section 30(e) ground cannot apply to them. I am therefore only considering the section 30(e) ground with respect to wares (2).

[48] The Opponent has submitted that the Applicant had no intention to use the Mark since it is a distributor of third party wares. The Opponent indicated that in support of its position it was relying on the same evidence as that relied upon with respect to its section 30(b) ground of opposition.

[49] It is difficult for an opponent to provide evidence of what an applicant's intention was when it filed its application and so the initial onus on an opponent with respect to a section 30(e) ground is necessarily light. However, I find that the Opponent has not met its initial burden in the present case because even if the Applicant were only a distributor that would not prevent it from intending to use its Mark in association with wares.

[50] The section 30(e) ground is therefore dismissed.

#### Section 38(2)(a)/30(i) Ground of Opposition

[51] The Opponent has pleaded that the application does not comply with section 30(i) of the Act "in that the Applicant could not have been and cannot be satisfied of its entitlement to use the [M]ark in association with the wares and services set out in the Application in Canada, for the reasons set out in paragraphs 2(c), (d), (f), (g)-(m) [of the statement of opposition]".

However, 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 on the part of the applicant, which is not the case here [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR.(2d) 152 (TMOB) at 155]. The section 30(i) ground is accordingly dismissed.

#### Section 38(2)(c)/16 Grounds of Opposition

[52] The Opponent has pleaded multiple grounds of opposition under section 16, namely:

1. pursuant to section 16(1)(a), the Applicant is not the person entitled to registration of the Mark in association with the wares (1) and services set out in the application in that as of the date on which the Applicant or predecessor in title first so allegedly used the Mark, the Mark was confusing with the Opponent's trade-mark NORTHLAND, that had been previously used in Canada and made known in Canada by the Opponent in association with the sale and distribution of "engine anti-freeze and coolants; lubricating oils, engine oils, hydraulic oils, transmission lubricants, and lubricating greases, analytical services and used oil analysis services" [the Opponent's Wares and Services];
2. pursuant to section 16(1)(a), the Applicant is not the person entitled to registration of the Mark in association with the wares (1) and services set out in the application in that as of the date on which the Applicant or predecessor in title first so allegedly used the Mark, the Mark was confusing with the Opponent's trade-mark NORTHLAND TECHNICAL LABORATORIES, that had been

previously made known in Canada by the Opponent in association with the services “new and used oil analysis services and lubricant performance evaluation services”;

3. pursuant to section 16(1)(c), the Applicant is not the person entitled to registration of the Mark in association with the wares (1) and services set out in the application in that as of the date on which the Applicant or predecessor in title first so allegedly used the Mark, the Mark was confusing with i) the Opponent’s trade-names NORTHLAND PRODUCTS COMPANY, NORTHLAND PRODUCTS and NORTHLAND, that had been previously used in Canada by the Opponent; and ii) various trade-names that are or include NORTHLAND that are and have been used in Canada in association with a variety of wares and services;
4. pursuant to section 16(3)(a), the Applicant is not the person entitled to registration of the Mark in association with the wares (2) set out in the application in that at the date of filing the application, the Mark was confusing with the Opponent’s trade-mark NORTHLAND, that had been previously used in Canada and made known in Canada by the Opponent in association with the Opponent’s Wares and Services;
5. pursuant to section 16(3)(c), the Applicant is not the person entitled to registration of the Mark in association with the wares (2) set out in the application in that at the date of filing the application, the Mark was confusing with i) the Opponent’s trade-names NORTHLAND PRODUCTS COMPANY, NORTHLAND PRODUCTS and NORTHLAND, that had been previously used in Canada by the Opponent in its business and ii) various trade-names that are or include NORTHLAND that are and have been used in Canada in association with a variety of wares and services.

[53] As pointed out by the Applicant, an opponent can only rely on its own prior use or making known of a trade-mark or trade-name under section 16 (see section 17(1)). Therefore, 3(ii) and 5(ii) above are not valid grounds of opposition.

[54] In order to meet its initial burden with respect to its section 16(1)(a) grounds of opposition, the Opponent’s evidence must show that its pleaded marks had been used or made known in Canada prior to December 31, 1989. A trade-mark is made known if it meets the test set out in section 5 of the Act and to do so requires a finding that the mark has become well known in Canada by reason of the distribution or advertising of the Opponent’s wares or services in association with the mark in a substantial area of Canada [*Marineland Inc v Marine Wonderland and Animal Park Ltd* (1974), 16 CPR (2d) 97 (FCTD)].

[55] In order to meet its initial burden with respect to its section 16(1)(c) grounds of opposition, the Opponent's evidence must show that its pleaded names had been used in Canada prior to December 31, 1989.

[56] In order to meet its initial burden with respect to its section 16(3)(a) grounds of opposition, the Opponent's evidence must show that its pleaded marks had been used or made known in Canada prior to February 8, 2002.

[57] In order to meet its initial burden with respect to its section 16(3)(c) grounds of opposition, the Opponent's evidence must show that its pleaded names had been used in Canada prior to February 8, 2002.

[58] Mr. Petersen has not provided any exhibits to show how his company's marks or names have been used. In addition, he has referred to "since at least as early as 1990" and "approximately 1989" when discussing his company's first activities with respect to Canada. Clearly his evidence does not meet the Opponent's initial burden with respect to sections 16(1)(a) or (c). I also note that I have not been directed to any evidence (admissible or not) in the Szumski affidavit that would meet the Opponent's initial burden under these grounds. The section 16(1)(a) and (c) grounds are therefore all dismissed.

[59] I turn now to consider the evidence as of February 8, 2002.

[60] There is no evidence that the Opponent's NORTHLAND mark had been made known in accordance with section 5 as of any date and so the portion of the section 16(3)(a) pleading that relies on making known cannot succeed.

[61] As already mentioned, Mr. Petersen did not provide any exhibits to show how his company's marks or names have been used. He did state during cross-examination that the wares are branded NORTHLAND, but without seeing the manner in which the wares are "branded" I cannot reach a conclusion that use of the trade-mark NORTHLAND occurred in accordance with section 4 of the Act. The word "use" is a legal term defined in section 4 of the Act and one must look at the evidence filed in order to determine if in fact there has been use of a trade-mark in association with wares and services within the meaning of section 4.



[62] Mr. Szumski attempted to introduce “copies of both private label and NORTHLAND brand labels used in association with the Opponent’s products Canada [*sic*] as referred to in Mr. Petersen’s affidavit” but, as it was not possible to effectively cross-examine Mr. Szumski regarding these exhibits, I ruled them to be inadmissible. Thus there is no evidence before me that shows that the Opponent used NORTHLAND as a trade-mark in Canada as of any date, let alone prior to February 8, 2002.

[63] Similarly, there is no admissible evidence showing that the Opponent used any of its trade-names in Canada prior to February 8, 2002.

[64] All of the section 16 grounds of opposition are therefore dismissed on the basis that the Opponent has not satisfied its initial burden.

#### Distinctiveness Ground of Opposition

[65] The Opponent has pleaded that the Mark is not distinctive in that it does not distinguish nor is it adapted to distinguish nor capable of distinguishing the wares and services of the Applicant from the wares and services of others, and more particularly:

- i) the Opponent’s family of NORTHLAND trade-marks and trade-names, and domain names that are and have been used and made known in Canada;
- ii) the Opponent’s trade-names NORTHLAND TECHNICAL LABORATORIES and NORTHLAND TECHNICAL LABORATORIES CORP., that are and have been used and made known in Canada in association with “new and used oil analysis and lubricant performance evaluation services”;
- iii) the Mark has been improperly licensed for use in association with the wares (1) and (2) and is used in a manner that does not distinguish and is incapable of so distinguishing the source of said wares;
- iv) three third party applications and eight third party registrations for trade-marks that include NORTHLAND;
- v) various unnamed trade-marks and trade-names that are or include NORTHLAND that are or have been used in Canada in association with a variety of wares and services;
- vi) “the extensive use of the word NORTHLAND in trade-names and corporate names in Canada”;

- vii) “the extensive use of the word NORTHLAND in domain names in Canada”;
- viii) “the connotation of the word NORTHLAND”;
- ix) “the state of the Register”.

[66] The material date for assessing this ground is the filing date of the opposition, September 25, 2007 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)]. However, the Opponent has not met its initial burden with respect to any prong of its distinctiveness pleading. Regarding its reliance on its own marks and names, I cannot find that its marks/names had acquired a sufficient reputation in Canada as of the material date in the absence of any admissible evidence showing how the marks or names were displayed in Canada. The Opponent elected to not make any submissions in support of the pleading insofar as it relies on other bases and the evidence does not satisfy the Opponent’s initial burden in regard thereto.

[67] The distinctiveness ground is accordingly dismissed in its entirety.

#### Section 38(2)(b)/12(1)(d) Grounds of Opposition

[68] The Opponent has pleaded that the Mark is not registrable pursuant to section 12(1)(d) of the Act because it is confusing with the following third party registered trade-marks:

1. NORTHLAND - registration No. TMA493,456
2. NORTHLAND - registration No. TMA441,572
3. NORTHLANDER - registration No. TMA148,143
4. NORTHLAND - registration No. TMA221,770
5. NORTHUMBERLAND PAINTS - registration No. TMA297,556
6. NORTHLAND STONE - registration No. TMA696,423
7. NORTHLAND POWER CHIPS – registration No. TMA659,426
8. NORTHLAND POWER – registration No. TMA575,544.

[69] The material date for assessing a section 12(1)(d) ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[70] I have exercised the Registrar's discretion to check the register in order to confirm the existence of the registrations relied upon by the Opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Registration No. TMA441,572 was expunged in 2010. However, the remaining pleaded registrations are extant, and so the Opponent's initial burden has been met with respect to those seven registrations under section 12(1)(d).

[71] 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.

[72] The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC), *Veuve Cliquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC).]

[73] I note that each of the registrations relied upon is owned by a different third party and the registrations cover a variety of wares and services, none of which overlap with the Applicant's wares and services and none of which are for use in the automotive industry.

[74] The Opponent has not made any submissions regarding its section 12(1)(d) grounds of opposition but has made it clear that it is not withdrawing such grounds.

[75] The Applicant has made brief submissions to the effect that the section 12(1)(d) grounds are without merit given the differences between the marks, wares and services of each of the cited registrations and the Applicant's Mark and wares/services.

[76] In the present case, it is not necessary to do a protracted analysis of the likelihood of confusion. Although the Mark shares the word NORTHLAND with some of the registered marks, that is not an inherently strong word and there is no evidence that any of the registered marks have become known. The nature of the parties' wares, services, business, or trade do not overlap and there is no evidence that they are related.

[77] Having considered all of the surrounding circumstances, I have concluded that there is not a reasonable probability of confusion between the marks at issue. I cannot conclude that any of the registered marks is entitled to a scope of protection that is broad enough to preclude the registration of the Mark given the distinct differences between their associated wares and services.

[78] The section 12(1)(d) grounds are accordingly dismissed.

#### Section 38(2)(b)/12(1)(e) Grounds of Opposition

[79] The Opponent has pleaded that the Mark was and is not registrable pursuant to section 12(1)(e) of the Act in that it is a mark the adoption of which is prohibited by section 9 of the Act, namely the Mark consists of or so nearly resembles as to be likely to be mistaken for certain third parties' official marks, i.e. ONTARIO NORTHLAND & Design, ONTARIO'S NORTHLAND Design, THE GREAT ONTARIO NORTHLAND & Design, NORTHLAND PARK & Design, NORTHLANDS PARK, EDMONTON NORTHLANDS & Design and EDMONTON NORTHLANDS.

[80] The Opponent has not made any submissions regarding its section 12(1)(e) grounds of opposition but has made it clear that it is not withdrawing such grounds. The Applicant has submitted that the Mark does not consist of or so nearly resemble any of the pleaded official

marks as to be mistaken therefore and I agree, because there are sufficient differences between the Mark and each of the official marks.

[81] The section 12(1)(e) grounds are therefore dismissed.

Disposition

[82] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

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Jill W. Bradbury  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office