



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

Citation: 2010 TMOB 70
Date of Decision: 2010-05-26

**IN THE MATTER OF AN OPPOSITION
by Boy Scouts of Canada (now Scouts
Canada) to application No. 1,212,279 for
the trade-mark BENNY'S BEAVER
TALES & DESIGN in the name of
LESLIE GAGNÉ**

THE RECORD

[1] On April 5, 2004, Leslie Gagné filed an application to register the trade-mark BENNY'S BEAVER TALES & Design, illustrated below:



The application is based on proposed use in Canada in association with the following wares:

board game, music and learning CD-ROM, T-shirts, golf shirts, sweat shirts, hats, decorative magnets, key chains, jackets, rain ponchos, pictures, boxer shorts, pencil, pens, foamed hats, tooth necklaces, golf balls, rulers, golf ball markers, golf bags, maps, scarves, pencil covers, zipper pulls, figurines, muscle shirts, temporary tattoos, medals, canoes, compasses, toques, flying discs, lapel pins, paper cubes, drinking glasses, ties, calendars and magazines.

[2] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated April 20, 2005 and was opposed by Boy Scouts of Canada on September 20, 2005. The Registrar of Trade-marks forwarded a copy of the statement of opposition to the applicant on October 4, 2005 as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition. I mention in passing that the counter statement also consists of submissions suitable for the written argument stage but otherwise superfluous.

[3] The opponent's evidence consists of the affidavit of John Robert Stewart. The applicant's evidence consists of the affidavit of Leslie Gagné. Only the opponent filed a written argument and only the opponent was represented at an oral hearing held on May 4, 2010.

STATEMENT OF OPPOSITION

[4] The opponent pleads that it is a body corporate established in 1914 by a special Act of the Parliament of Canada. The opponent carries on youth oriented programs including outdoor and sporting activities. The opponent operates its programs through a number of sections designated as BEAVERS, WOLF CUBS, SCOUTS, VENTURERS and ROVERS. The youngest members of the opponent are in the BEAVER or BEAVERS section which has been in existence since about 1971.

[5] Since 1971 the opponent has used, as a trade-mark or trade-marks, the word BEAVER or BEAVERS, either alone or in combination with other words and/or design features, including representations of a beaver (the opponent's "BEAVER marks"). The opponent's BEAVER marks have been used by the opponent in Canada in association with various wares including books, clothing, sweaters, T-shirts, hats, and scarves.

[6] The first ground of opposition alleges that "the subject application does not comply with the requirements of Section 30 of the Trade-marks Act . . . [because] . . . the mark claimed in the subject application is non-distinctive . . . [and] . . . is not a trade-mark . . ."

[7] The second ground alleges that the applied for mark BENNY'S BEAVER TALES & Design is not registerable, pursuant to s.9 of the *Act*, in view of the fact that public notice was given of the opponent's mark BEAVERS in April 1989.

[8] The third ground alleges that the applicant is not entitled to register the applied for mark BENNY'S BEAVER TALES & Design, pursuant to s.16, for the reasons set out in the first ground, and because at the date of filing the application, the applied for mark was confusing with the opponent's BEAVER marks that had been previously used in Canada by the opponent.

[9] The fourth ground, pursuant to s.2, alleges that the applied for mark BENNY'S BEAVER TALES & Design is not adapted to distinguish the applicant's wares from the wares and services of the opponent.

THE EVIDENCE OF RECORD

Opponent's Evidence - John Robert Stewart

[10] Mr. Stewart identifies himself as a member of the opponent's staff since 1982 and presently Executive Commissioner and C.E.O of the opponent. Mr. Stewart's affidavit evidence generally confirms the opponent's pleadings in paras.4 and 5 above. In particular, s.9 notices were given for the opponent's marks BEAVERS on April 5, 1989 (under No.903,521); BEAVERS CANADA & Design on May 12, 1993 (under No.905,897) and JUMP START FOR BEAVERS on February 18, 1998 (under No.909,603). The opponent's retail services are based in Ottawa. The opponent operates "Scout Shops" across Canada and has also supplied wares to independent dealers. The opponent's wares are virtually essential to participation in the opponent's activities and include clothing, uniforms, badges, camping equipment, backpacks and carry-alls. In 1976 there were about 106 dealer outlets and about 19 Scout Shops operating in Canada. As of the date of Mr. Stewart's affidavit (June 2, 2006), there were 24 Scout Shops and one dealer outlet. The opponent's BEAVER marks have been used in association with a

variety of wares including clothing, pennants, flags, pencils, book marks, plaques and lapel pins. Extensive exhibit materials attached to Mr. Stewart's affidavit collaborate his testimony.



Applicant's Evidence - Leslie Gagné

[11] Mr. Gagné identifies himself as the sole director of The Big Beaver Theme Park Inc. BENNY THE BEAVER is a fictional creation and the mascot of the theme park. The applicant has been using the mark BENNY THE BEAVER since November 2001 and has not received any queries asking if the mascot is associated with the opponent. The applicant is the owner of the registered mark THE BIG BEAVER & Design, the particulars of which are shown below, which the applicant has been using since about July 2002.

wares

merchandise sales namely T and golf shirts, sweat shirts, and hats. Other items to be sold are maple syrup, cookies, Canadiana souvenirs namely toy beavers(stuffed), flags, banners, pennants, buttons, magnets, key chains, windsocks, coins, hats, T shirts, sweaters, turtle neck sweaters, jackets, umbrellas, rain ponchos, maple syrup, pictures, party baskets, Christmas ornaments, figurines, zipper pulls, engraving balls, hand waving souvenirs, foamed shaped hats, ties, boxer shorts, bumper stickers, hockey sticks, pencils, pens, bags, mugs, glasses, lawn chairs, golf balls, golf T's, golf towels, golf ball markers, flashlights, bottle openers, storage boxes, calendars, wine flasks, paper cubes, coasters, rulers, board games, figurine pencil covers, lapel pins, toques, flying discs, tire covers, cooking aprons, oven mitts, head bans, crazy chords, Canadian themed books (w/ pictures and stories), sun glasses, maps, scarves, ear muffs, and shoe laces, and pre-packaged foods namely lobster, salmon, buffalo, bottled beer, water, fudge, and wine using The Big Beaver theme and icon,

chocolate bars, granola bars (healthy treats with maple syrup), pastries, homemade pies, and desserts,

services

a website portal for the promotion of everything Canadian namely featured travel destinations, tourism attractions, festivals, history, famous Canadians, food, significant achievements like the space arm, and the significance of the "beaver" in Canada.

[12] The applicant states that he has been using the marks THE BIG BEAVER, BENNY THE BEAVER and BENNY'S BEAVER TALES on his Internet website since about 2004 and has not received any queries asking if those marks, or the applicant's theme park, is associated with the opponent. The applicant has also evidenced that a third party, Bell Canada, uses two "talking" beavers named Frank and Gordon to advertise Bell Canada services.

NON- ENTITLEMENT GROUND OF OPPOSITION

[13] The first ground of opposition does not stand on its own but is dependent on a favourable outcome for the fourth ground alleging that the applied for mark BENNY'S BEAVER TALES & Design is not distinctive. The opponent in its written argument focuses on the third ground of opposition and I will do likewise.

Legal Onus and Evidential Burden

[14] The legal onus is on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponent in the statement of opposition. 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 the applicant. However, there is also, in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298. The

presence of an evidential burden on the 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.

[15] In the instant case, the opponent's evidence suffices to put the third ground of opposition into issue. Thus, the legal onus is on the applicant to show that, at the date of filing the application, the applied for mark BENNY'S BEAVER TALES & Design was not confusing with the opponent's BEAVER marks: see s.16(3)(a) of the *Act*.

Section 6(5) Factors

[16] Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in s.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 wares, 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. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

[17] The opponent's BEAVER marks possess some degree of inherent distinctiveness but are relatively weak marks as the beaver is generally perceived as a symbol of Canada. Similarly, the applied for mark BENNY'S BEAVER TALES & Design is a relatively weak mark as it is comprised of weak components. As of the material date April 5, 2004, I am prepared to find (despite deficiencies in Mr. Stewart's affidavit) that the opponent's BEAVER marks had acquired a fair reputation in Canada in association with the opponent's youth oriented programs and to a lesser degree in association with its wares such as clothing, scarves, badges, pins and books which form an integral part of the opponent's programs. Mr. Gagné's evidence is far more deficient than Mr. Stewart's evidence and I am not prepared to infer that any of the applicant's marks referred to by Mr. Gagné had acquired any more than a minimal reputation in Canada at

any material time. Of course, the applied for mark would not have acquired any reputation as of April 5, 2004 as the application is based on proposed use. The fact that the applicant is the owner of the registered mark THE BIG BEAVER & Design does not assist the applicant in this opposition: see, for example, *Groupe Lavo Inc. v. Proctor & Gamble Inc.*, 32 C.P.R. (3d) 533 at p.38 (T.M.O.B.)

[18] The length of time that the marks in issue have been in use favours the opponent as the opponent commenced use of its BEAVER marks in 1971. The applicant's wares overlap with the opponent's wares and it appears that some of the applicant's wares are targeted to about the same age group served by the opponent's scouting programs. There is a fairly high degree of resemblance between the marks in issue as the word BEAVER and an image of a beaver comprise conspicuous elements of the applied for mark. The applicant has incorporated the whole of the opponent's mark BEAVER into the applied for mark.

DISPOSITION

[19] Considering the above, and keeping in mind in particular the resemblance between the marks in issue, the overlap in the parties' wares and the apparent overlap in the parties' target demographic, I find that on a balance of probabilities the applicant has failed to show that his mark BENNY'S BEAVER TALES & Design is not confusing with the opponent's BEAVER marks at the material date April 5, 2004. Accordingly, it is not necessary to consider the remaining grounds of opposition. For analogous cases see *Boy Scouts of Canada v. Leslie Gagné* (March 21, 2007 T.M.O.B. (unreported) application No.1,121,302) wherein the Board refused the word mark BENNY THE BEAVER and *Boy Scouts of Canada v. Moehring* (1993), 48 C.P.R. (3d) 557 wherein the Board refused the mark EAGER BEAVER.

[20] In view of the foregoing, the subject application is refused. This decision has been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

Myer Herzig
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office