



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

**Citation: 2018 TMOB 14**

**Date of Decision: 2018-02-05**

**IN THE MATTER OF AN OPPOSITION**

**Thinklab Consulting Inc.**

**Opponent**

**and**

**Combustion Creativity Inc.**

**Applicant**

**1,674,873 for ThinkLab**

**Application**

INTRODUCTION

[1] Thinklab Consulting Inc. (the Opponent) opposes registration of the trade-mark ThinkLab (the Mark) that is the subject of application No. 1,674,873 by Combustion Creativity Inc. (the Applicant).

[2] The application is based upon use of the Mark in Canada since August, 2012 in association with the following goods and services:

Education and training materials in the form of training notebooks, audio visual training presentations designed to teach creativity and creative thinking skills, creativity assessment questionnaires, DVDs containing instructions teaching creativity and creative thinking skills, printed case studies demonstrating creativity and creative thinking skills, and brochures and pamphlets demonstrating creativity and creative thinking skills.

Corporate training services for others, namely preparations [*sic*] of materials for corporate training programs, presentations, training programs, seminars, workshops, and lectures to teach creativity and creative thinking skills; in-person and online delivery of programs, presentations, training programs, seminars, workshops, and lectures to teach creativity and creative thinking skills.

[3] The opposition was brought under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), and raises grounds of opposition based upon sections 2 (non-distinctiveness); 12 (non-registrability); 16 (non-entitlement); and 30 (non-conformity) of the Act.

[4] For the reasons that follow below, the opposition is successful.

#### THE RECORD

[5] The application was filed on April 23, 2014 and advertised for opposition purposes in the *Trade-marks Journal* on August 26, 2015.

[6] The statement of opposition was filed on October 16, 2015 and originally included seven grounds of opposition. However, one of these grounds, namely the section 16(1)(b) ground of opposition was voluntarily withdrawn by the Opponent at the written argument stage. The remaining grounds of opposition are:

- The application does not conform to section 30(b) of the Act because, at the date of filing of the application, the Applicant had not used the Mark as alleged in the application.
- The application does not conform to section 30(i) of the Act because, at the date of filing of the application, the Applicant could not properly have been satisfied that it was entitled to use the Mark in association with the goods or services described in the application.
- The Mark is not registrable under section 12(1)(d) of the Act because it is confusing with the Opponent's trade-mark THINKLAB registered under No. TMA843,681 in association with the following services:
  - (1) Consulting services, namely consulting services for for-profit and non-profit organizations with respect to project management, strategic management, operations management and knowledge management.

(2) Educational services in the field of organization management and strategy for for-profit and non-profit organizations; educational services in the field of public relations; educational services in the field of law.

(3) Government relations services, namely advising and assisting others with respect to interactions with government bodies and government representatives.

(4) Public relations services.

- The Applicant is not the person entitled to registration of the Mark under section 16(1)(a) of the Act because, as of the claimed date of first use of the Mark, the Mark was confusing with the Opponent's trade-mark THINKLAB, which had been previously used in Canada by the Opponent in association with the services described above.
- The Applicant is not the person entitled to registration of the Mark under section 16(1)(c) of the Act because, as of the claimed date of first use of the Mark, the Mark was confusing with the trade-name Thinklab Consulting Inc. that had been previously used in Canada by the Opponent in association with providing business management consulting services.
- The Mark is not distinctive within the meaning of section 2 of the Act because it is not capable of distinguishing the Applicant's goods or services from the Opponent's services provided under the trade-mark THINKLAB.

[7] The Applicant filed and served a counter statement on December 17, 2015 denying each of the grounds of opposition set out in the statement of opposition.

[8] In support of its opposition, the Opponent filed the affidavit of Laura Duckett, a legal assistant and registered trade-mark agent at the law firm representing the Opponent in this proceeding, sworn on May 19, 2016 (the Duckett affidavit). The Duckett affidavit introduces into evidence the results of Internet searches using the Google search engine and various terms such as "strategic planning and creative thinking" conducted by Ms. Duckett on May 16 and 17, 2016, as well as her visit of the Applicant's website on May 17, 2016.

[9] In support of its application, the Applicant filed the affidavits of:

- Richard Leblanc, a lawyer at the law firm representing the Applicant in this proceeding, sworn on September 15, 2016 (the Leblanc affidavit). The Leblanc affidavit introduces into evidence two trade-mark examiner reports, dated November 24, 2014 and April 30,

2015 respectively, sent to the Applicant by an examiner of the Canadian Intellectual Property Office during the prosecution of the application.

- Lindsay Earnshaw, a legal assistant at the same law firm, sworn on September 16, 2016 (the Earnshaw affidavit). The Earnshaw affidavit introduces into evidence dictionary definitions for the words “creativity”, “creative”, “thinking”, and “skills”.
- Leslie Ehm, President and Chief Executive Officer of the Applicant, sworn on September 19, 2016 (the Ehm affidavit). The Ehm affidavit introduces into evidence information regarding the incorporation of the Applicant and the Applicant’s business, including the promotion and use of the Mark.

[10] None of the affiants were cross-examined on their affidavits.

[11] Both parties filed written arguments. An oral hearing was not requested.

#### THE PARTIES’ RESPECTIVE BURDEN OR ONUS

[12] The Opponent has the initial evidentiary burden to establish the facts alleged to support each ground of opposition. Once that burden is met, the legal burden or onus that the Mark is registrable remains on the Applicant, on a balance of probabilities [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

#### ANALYSIS

### **Grounds of opposition summarily dismissed**

#### Section 30(i) ground of opposition

[13] The section 30(i) ground of opposition, as pleaded, does not raise a proper ground of opposition. The Opponent must state why the Applicant could not properly have been satisfied that it was entitled to use the Mark in Canada.

[14] Even if the ground had been properly pleaded, where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional circumstances such as where there is evidence of bad faith on the part of the applicant [see

*Sapodilla Co. Ltd v Bristol-Myers Co.* (1974), 15 CPR (2d) 152 (TMOB.)). There is no such evidence in the present case.

#### Sections 16(1)(a) and 16(1)(c) grounds of opposition

[15] The sections 16(1)(a) and 16(1)(c) grounds of opposition can be summarily dismissed on the basis that the Opponent has failed to meet its initial evidentiary burden in respect thereof.

[16] An opponent meets its evidentiary burden under such grounds if it shows that as of the date of first use claimed in the Applicant's application, its trade-mark or trade-name had been previously used or made known in Canada and had not been abandoned as of the date of advertisement of the applicant's application [section 16(5) of the Act]. The Opponent has not filed any evidence of use of its trade-mark THINKLAB or trade-name Thinklab Consulting Inc. The mere existence of registration No. TMA843,681 can establish no more than *de minimis* use of the trade-mark THINKLAB [see *Entre Computer Centers, Inc v Global Upholstery Co* (1992), 40 CPR (3d) 427 (TMOB)]. Such use does not meet the requirements of section 16 of the Act [see *Rooxs, Inc v Edit-SRL* (2002), 23 CPR (4th) (TMOB)].

#### Section 2 ground of opposition

[17] The section 2 ground of opposition can be summarily dismissed on the basis that the Opponent has failed to meet its initial evidentiary burden in respect thereof.

[18] An opponent meets its initial onus with respect to a non-distinctiveness ground if it shows that as of the filing of the opposition its trade-mark had a substantial, significant or sufficient reputation in Canada so as to negate the distinctiveness of the applied-for trade-mark [see *Bojangles' International LLC v Bojangles Café Ltd* (2006), 2006 FC 657, 48 CPR (4th) 427 (FC)]. The Opponent has not filed any evidence demonstrating the extent to which its trade-mark THINKLAB has become known in Canada.

## **Analysis of the remaining grounds of opposition**

### Section 30(b) ground of opposition

[19] As indicated above, the Opponent has pleaded that the application does not comply with section 30(b) of the Act because, at the date of filing of the application, the Applicant had not used the Mark as alleged in the application.

[20] More particularly, the Opponent submits in its written argument that it is clear that the application does not comply with section 30(b) of the Act because, at the date of filing of the application, the Applicant had not used the trade-mark with the “purported ‘goods’” listed in the application. The Opponent submits that on its face, it is clear that the statement of goods is directed to materials merely used in the presentation of the services, e.g. “training notebooks”, “audio visual training presentations”, “assessment questionnaires”, and “printed case studies”; and in the advertising of the services, e.g. “brochures and pamphlets”.

[21] The relevant date for considering the circumstances with respect to this ground of opposition is the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)]. To the extent that the relevant facts pertaining to a ground of opposition based on section 30(b) of the Act are more readily available to the Applicant, the evidentiary burden on the Opponent with respect to such a ground of opposition is less onerous [see *Tune Master v Mr P’s Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. Furthermore, this burden can be met by reference not only to the Opponent’s evidence but also to the Applicant’s evidence [see *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) (FCTD) 216].

[22] However, the Opponent may only successfully rely upon the Applicant’s evidence to meet its initial burden if the Opponent shows that the Applicant’s evidence puts into issue the claims set forth in the Applicant’s application [see *Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd* 2014 FC 323 at paras 30-38 (CanLII)]. Furthermore, while an opponent is entitled to rely on the applicant’s evidence to meet its evidentiary burden, the applicant is under no obligation to evidence its claimed date of first use if this date is not first put into issue by an opponent meeting its evidentiary burden.

[23] The Opponent's evidence concerning this ground of opposition is found in the Duckett affidavit. Ms. Duckett states at paragraph 4 of her affidavit that:

On May 17, 2016, I accessed the website at <http://combustionco.com/>, which is identified as belonging to [the Applicant]. I accessed all of the page links in the main menu of the home page searching for any indication of any of "training notebooks", "DVDs", "printed case studies", "brochures" and "pamphlets", being offered for sale. I did not find any indication of such wares being offered for sale.

[24] The Opponent further relies on the Applicant's evidence introduced through the Ehm affidavit. In order to put the Opponent's submissions regarding the Ehm affidavit in context, I will first go over this affidavit.

*The Ehm affidavit*

[25] I shall note at this point of my decision that I am not affording weight to any of the statements made by Ms. Ehm that constitute personal opinion. Furthermore, only the most salient points (and accompanying exhibits) of her affidavit will be mentioned.

[26] According to Ms. Ehm:

- "The Applicant was incorporated in Ontario in 2012. [...] [It] is in the business of providing a unique brand of education and training, and products related thereto, to teach creativity and creative thinking skills to individuals and companies." [paras 5 and 6]
- "Training services are provided by the Applicant in association with the [Mark] as a variety of programs, presentations, training programs, seminars, workshops, and lectures that focus on developing skills of the participants in creativity and creative thinking." [para 7]
- "The Applicant provides corporate training as well as in-person and online delivery of such programs, presentations, training programs, seminars, workshops, and lectures." [para 7]
- "The training and education materials provided by the Applicant in association with the Mark include notebooks, audio visual training presentations designed to teach creativity and creative thinking skills, creativity assessment questionnaires, DVDs containing instructions teaching creativity and creative thinking skills, printed case studies

demonstrating creativity and creative thinking skills, and brochures and pamphlets demonstrating creativity and creative thinking skills, as software and mobile device apps.” [Emphasis added] [para 7]

- “The Applicant has invested substantial resources to create, promote and protect the value of the trademarks and goodwill associated with the products and services it sells and provides in Canada.” [para 8].
- Since 2012, the Applicant “has sold and provided its education and training materials, and its corporate training services, and in-person and online services, in association with [the Mark], to many Canadian clients and consumers throughout Canada each month.” [para 8]
- “The Applicant’s wares and services are made available for sale in Canada through online ordering by a client or customer who has a ‘Client Login’, or through contacting the Applicant via mail or by telephone.” [para 10]
- “The Applicant’s wares and services are advertised through online and hardcopy advertisements, and have been since 2012.”
- “The Applicant has had a website at *combustion.com* since February 2016, and previously the Applicant had a website at *thinkcombustion.com* as of 2012.” [para 11]
- “The current website is, and the prior website has been, regularly viewed by Canadians. From September 1, 2014 to August 31, 2016, there were more than 3,900 sessions of Canadian visitors to on [*sic*] the Applicant’s current and prior websites (during this period there were more than 15,800 total sessions). During the same period there were more than 2,540 new Canadian visitors to the Applicant’s current and prior websites (representing 19% of the total new users during this period). Visits by Canadians [...] were 2:54 minutes long on average during this period, and the visitors looked at three pages per session on average.” [para 15]
- “In recent years, the Applicant has expanded its online presence, using social media to publicize its products and services, including through LinkedIn™, Facebook™, Instagram™, and Twitter™. Over 500 people currently follow the Applicant’s twitter handle @CombustionTrain, and the Applicant’s Facebook page had more than 200 likes in August, 2016.” [para 16]



- The Applicant has made sales of goods and services in association with the Mark in Canada as well as outside Canada over the past several years. Information relating to sales of the Applicant’s training services provided in association with the Mark from 2013-2016 (first half) in Canada as well as in the U.S. and internationally is provided in paras 19 and 20 of the affidavit. The number of training sessions in Canada amounts to 16, and totals \$283,071.00. [paras 19 and 20]
- The Applicant’s clientele includes companies of various sizes, industries and locations in Canada and outside Canada. As an example, the Applicant’s client customers include BMO Harris Bank, HBK, Disney, Telus, Constellation Brands, Leo Burnett, Publicis, The Globe and Mail, Canada Dry, Ikea, and Mattel. [para 21]

[27] In support, Ms. Ehm attaches the following exhibits to her affidavit:

- Exhibit B: “the first two pages of a hardcopy workbook available to clients and customers of the Applicant”. Ms. Ehm attests that this exhibit “exemplifies use of the [Mark] in association with the Applicant’s educational materials in Canada occurring currently and as has occurred over the past several years.” [para 7]
- Exhibit C: “representative printouts of screens [from the Applicant’s website] available to clients and customers, including screens available through use of a Client Login and screens showing the Applicant’s contact information, whereby Canadian clients and customers can purchase the Applicant’s wares and services provided in association with the [Mark], as are presently used in Canada and have been used for the past several years.” [para 10]
- Exhibit D: “sample pages from the Applicant’s website, YouTube™ (showing a publication of December 12, 2013), and a print advertisement (promoting training being provided on February 24-25, 2014 at Sheridan College)”. Ms. Ehm attests that these samples are representative of the advertisements of goods and services provided by the Applicant in association with the Mark that are used presently in Canada and have been used for the past several years. [para 11]
- Exhibit E: “a true copy of a screen shot of the Training and Tools webpages of the Applicant’s website at *combustion.com*”. Ms. Ehm attests that these printouts are

representative of the use of the Mark by the Applicant, as currently occurs and has occurred for the past several years. [para 14]

- Exhibit F: “a true copy of a YouTube™ screen showing a frame of a video published on February 12, 2013 and a related write-up that references the Applicant’s *thinkcombustion.com* website.” [para 14]
- Exhibit G: “printouts showing the Applicant’s presence on various social media sites occurring currently, and as has occurred over the past few years.” [para 16]
- Exhibit I: “a screen shot showing examples of the Applicant’s clients, and examples of client testimonials, that are interspersed in the Applicant’s ‘Street Cred’ webpage.” [para 21]

### *The Opponent’s submissions*

[28] The Opponent submits that the Applicant has not provided any evidence of use of the “purported ‘goods’” as of the claimed date of first use (since August 2012) or at any time.

[29] Commenting on the information found in paragraph 7 of the Ehm affidavit, the Opponent submits that:

From a grammatical perspective (though admittedly not from a logic or meaningful content perspective), one would read [the phrase] “software and mobile device apps” [underlined above] as modifying all of the preceding description of “goods”. Since “software and mobile device apps” are not actually listed in the description of “goods” in the application, this sentence misleading [*sic*] suggests an assertion of use but in fact is irrelevant with respect to use of the “goods” listed in the application. If anything, this sentence can be read as an implicit acknowledgement that use has not occurred with the “goods” as actually listed in the application.

[30] Commenting on Exhibit B, the Opponent notes that it consists of a cover page of a “workbook” and a sample of an inner page, being a blank lined page except for a heading “Note on Creativity” and a footer “Doodles & Inspiration”. The Opponent submits that there is no evidence of the offering or sale of the “workbook”. From its nature, there would be no reason for anyone to seek out or obtain the “workbook”, except as incidental to a workshop.

[31] Commenting on Exhibit C, the Opponent submits that nowhere in this exhibit or the Ehm affidavit is there any indication that, “clients and customers can purchase the Applicant’s

wares...” Therefore, the Opponent submits that Ms. Elm’s statement in paragraph 10 of her affidavit reproduced above, would appear to be false.

[32] The Opponent further submits that the only “ware” associated with the Mark is shown in Exhibits D and E of the Ehm affidavit. However, it is a smart phone app, referred to as “ThinkLab Brainstorming Tool”, with apparent links identified as “Available on the iPhone App Store” and “Get It On Google Play”. The Opponent submits that as “apps” are not among the “goods” listed in the opposed application, the advertising of this app is irrelevant to this opposition. The Opponent further submits that in any event, there is no evidence relating to the actual sales of the app or a date of first use for the app; the Elm affidavit provides only the vague statement “used for the past several years”.

[33] Lastly, the Opponent submits that the Ehm affidavit does not provide any indication of use from any earlier than February 2013; no evidence has been provided to substantiate the claimed date of use of August 2012.

*The Applicant’s submissions*

[34] The Applicant submits that the Ehm affidavit provides explicit statements that the Applicant has used the Mark in Canada since 2012. The Applicant submits that Exhibits D and E further provide evidence of use of the Mark in Canada with the goods and services listed in the application since 2012.

[35] The Applicant further submits that the only attempt by the Opponent to support its section 30(b) ground of opposition is a statement in paragraph 4 of the Duckett affidavit reproduced above. The Applicant submits that paragraph 17 of the Ehm affidavit states that the Mark has been used with the wares and services in the application by the Applicant in a variety of manners, namely on the Applicant’s wares; on the Applicant’s website and social media accounts; and on advertisements for the Applicant’s wares and services, as is supported by Exhibits B-G and I. Therefore, the Applicant submits that Ms. Duckett’s statement which is limited to the results from a search solely of the webpages of *combustionco.com* performed on a single day, is not sufficient to support this ground of opposition.

*Is the evidence of record sufficient to conclude that the Opponent has discharged its relatively light evidentiary burden under section 30(b) of the Act?*

[36] I agree with the Applicant that Ms. Duckett's statement in paragraph 4 of her affidavit is insufficient by itself to discharge the Opponent's evidentiary burden. The mere fact that Ms. Duckett could not find any indication of the applied-for goods being offered for sale in association with the Mark on the Applicant's website on May 17, 2016, which is after the relevant date, is insufficient to cast doubt on the correctness of the Applicant's claimed date of first use of the Mark. I note that the statement of goods as defined in the application is by no means restricted to education and training materials downloadable from a computer network or being sold through the Applicant's website only. It is entirely possible that the Applicant began using the Mark as of the claimed date of first use in some other manner.

[37] This leads me to turn to the Opponent's further reliance on the Applicant's own evidence to meet its evidentiary burden.

[38] While the Applicant was under no obligation to positively evidence continuous use of the Mark since the date of first use of August, 2012, the Applicant elected to file evidence in order to, *inter alia*, rebut Ms. Duckett's evidence. I appreciate that Ms. Ehm's affidavit does not necessarily aim to evidence use of the Mark with each and every one of the applied-for goods and services as of the date of first use claimed in the application *per se*. However, when considering her affidavit in its entirety, I find that the Applicant's evidence of use of the Mark raises more questions than it provides evidence of use of the Mark in association with the applied-for goods in the normal course of trade pursuant to section 4(1) of the Act, be it as of the claimed date of first use or at any time.

[39] Indeed, I find the evidence is quite laconic with respect to the applied-for goods. Ms. Ehm's statements of use of the Mark with respect to such goods merely constitute bald assertions of use as opposed to assertions of facts showing use. Notably, the only "goods" for which any evidence of alleged use was provided consist of a "workbook" (Exhibit B) and a smart phone "app" (Exhibits D and E). However, as stressed by the Opponent, "apps" are not among the goods listed in the application. Furthermore, there is no evidence of the offering for sale of the workbook. In the absence of any evidence to the contrary, I agree with the Opponent that the

workbook would appear to be incidental to the Applicant's applied-for services and not the object of trade in and of itself [*Critchley v Kicking Horse Coffee Co. Ltd*, 2015 TMOB 58; and *Norton Rose Canada LLP v Dr Leonard B Smith Professional Corporation*, 2014 TMOB 172]. Contrary to the Applicant's submission, the fact that Exhibit A of the Leblanc affidavit shows that the Examiner did not object to the applied-for goods on the basis that they were not properly listed in the application due to being ancillary to the applied-for services is not binding on this Board and does not have a precedential value for this Board given that the examination section does not have before it evidence that is filed by the parties in an opposition proceeding.

[40] It is also worth noting in this regard that the only sales figures provided by Ms. Ehm are with respect to the Applicant's training services (number of training sessions and revenue in Canadian dollars).

[41] With respect to the remaining goods, it is also worth recalling that Ms. Ehm asserts at paragraph 10 of her affidavit that "the Applicant's wares and services are made available for sale in Canada through online ordering by a client or customer who has a 'Client Login', or through contacting the Applicant via mail or by telephone". However, the alleged representative printouts of screens of the Applicant's website attached under Exhibit C to her affidavit fail to show how this is done with respect to the applied-for goods. In fact, nowhere in this exhibit are the applied-for goods described or even referred to. It is worth recalling in this regard that Ms. Ehms asserts that this exhibit is representative of how "the Applicant's wares and services provided in association with the [Mark] are presently used in Canada and have been for the past several years." As such, I find that far from contradicting Ms. Duckett's statement at paragraph 4 of her affidavit, Exhibit C corroborates it and is clearly inconsistent with Ms. Ehm's bald assertion of use with respect to the Applicant's applied-for goods.

[42] In view of all the foregoing, I find the Applicant's evidence seriously puts into issue the correctness of its claimed date of first use of the Mark with the applied-for goods. Thus, I find the Opponent has satisfied the light evidentiary burden upon it.

[43] The Applicant has failed to establish on the balance of probabilities that its application complied with section 30(b) of the Act with respect to the applied-for goods, as of April 23, 2014. Accordingly, the ground of opposition succeeds for these goods.

### Section 12(1)(d) ground of opposition

[44] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of section 12(1)(d) of the Act in that it is confusing with the Opponent's registered trade-mark THINKLAB identified above.

[45] I have exercised the Registrar's discretion to confirm that this registration is in good standing as of today's date, which is the material date for assessing a section 12(1)(d) ground of opposition [see *Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[46] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's registered trade-mark.

#### *The test for confusion*

[47] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act provides that 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, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[48] Thus, this section does not concern the confusion of the trade-marks themselves, but of the goods or services from one source as being from another.

[49] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at 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 the trade-marks have been in use; (c) the nature of the goods, 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. This list is not exhaustive and all relevant factors are to be considered. Further, all factors are not necessarily attributed equal weight as the weight to be given to each depends on the circumstances [see *Mattel, Inc v 3894207 Canada Inc*

(2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion].

[50] In *Masterpiece, supra*, the Supreme Court of Canada discussed the importance of the section 6(5)(e) factor in conducting an analysis of the likelihood of confusion between the parties' marks in accordance with section 6 of the Act (see para 49):

[...] the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis ... if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar. As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start.

[51] Under the circumstances of the present case, I consider it appropriate to analyse the degree of resemblance between the parties' marks first.

#### *Consideration of the section 6(5) factors*

##### The degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[52] As stressed by the Opponent in its written argument, the parties' marks are identical. The difference in presentation of the THINKLAB and ThinkLab marks is a minor matter of form that does not indicate any actual difference between the marks. They both consist of word marks. As a word mark registration protects the word (or words) in any form of presentation (e.g. style of lettering, color, etc.), the THINKLAB registration inherently includes the ThinkLab presentation [*Masterpiece, supra*, at para 55].

[53] Accordingly, as reasoned in *Masterpiece, supra*, the remaining factors must be carefully considered since they become significant.

The inherent distinctiveness of the trade-marks and the extent to which they have become known

[54] The parties' marks have an equivalent inherent distinctiveness in the context of the goods and/or services with which they are associated.

[55] The strength of a trade-mark may be increased by means of it becoming known through promotion or use.

[56] As indicated above, there is no evidence that the Opponent's THINKLAB mark has been used or become known in Canada to any extent. By contrast, as per my review of the Ehm affidavit above, the Applicant's evidence establishes that the Mark has been used and become known to some extent in Canada in association with the applied-for services. Suffice it to recall:

- The number of training sessions and revenue in Canadian dollars relating to sales of the Applicant's training services provided in association with the Mark in Canada from 2013-2016.
- The Applicant's online presence, using social media; etc.

[57] In view of the foregoing, I find that this factor, which is a combination of inherent distinctiveness and acquired distinctiveness, favours the Applicant.

The length of time the trade-marks have been in use

[58] The Applicant's application is based upon use of the Mark in Canada since August, 2012 and the Applicant has evidenced continuous use of the Mark in association with the applied-for services since 2013.

[59] The Opponent's registration claims use of the trade-mark THINKLAB in Canada since at least as early as October 2008. However, as indicated above, the mere existence of a registration can establish no more than *de minimis* use of the Opponent's trade-mark and cannot give rise to an inference of significant or continuing use [see *Entre Computer Centers, supra*].

[60] In view of the foregoing, this factor favours the Applicant.



The nature of the goods, services or business; and the nature of the trade

[61] When considering the nature of the goods and services and the nature of the trade, I must compare the Applicant's statement of goods and services with the statement of services in the registration relied upon by the Opponent [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

*The Opponent's submissions*

[62] The Opponent submits that the applied-for services fall within the services listed in the Opponent's THINKLAB registration.

[63] More particularly, the Opponent submits that the applied-for "corporate training services" are clearly the same as the Opponent's "educational services in the fields of organization management and strategy for for-profit and non-profit organization services" and are related to the Opponent's "consulting services for for-profit and non-profit organizations with respect to project management, strategic management, operations management and knowledge management."

[64] The Opponent submits that the emphasis on "creativity and creative thinking skills" in the service description in the opposed application is merely a specific theoretical approach of the services, or an aspect of the services, more generally defined in the Opponent's THINKLAB registration.

[65] The Opponent submits that put simply, "creativity and creative thinking skills" have long been well recognized as an aspect of "organization management and strategy" and "strategic management".

[66] In support, the Opponent relies on the following exhibits attached to the Duckett affidavit:

- Exhibit A: an excerpt from Travis, N. TURNER, “The importance of Creative Thinking Skills in Executive Leadership”, (2011), at page 5, which the Opponent submits shows that the provision of educational services directed to engendering creativity, within the conventional corporate/business education milieu, is long standing:

Because of these difficulties, executive training (i.e. MBA programs) have taken a results-oriented approach by offering courses in innovation process and new product development but have neglected to teach creativity as a distinct but learnable leadership or thinking skill. Some business schools have attempted to spur creativity of their students by exposing them to various artistic disciplines over ten-week “immersion” period (Allio & Pinard, 2005). This approach has had some benefits but at best represents a partial solution as even these authors have noted that “[i]mproving corporate creativity is a systematic challenge” (p 51). The result of substantial investment in innovation, innovation training, and “had hoc” creativity training has had widely varying outcomes, but has produced few leaders who are truly creative. [Empahsis added]

- Exhibit B : an excerpt from Bart STRONG, “Strategic Planning: What’s So Strategic About It?”, at page 11:

Strategic’ implies: process, creative thinking, teamwork, and flexibility [Emphasis added]

- Exhibit C: an excerpt from Eric D. BEINHOCKER and Sarah KAPLAN, “Tired of Strategic Planning?” (2002), at page 19:

Encouraging creative minds

[...]

As one of the world’s leading experts on creativity, Mihaly Csikszentmihalyi, of Clermont Graduate University, has argued, creative thinking cannot be forced. Companies can, however, create conditions in which creative accidents are more likely to happen. Through our research, we identified two mechanisms by which companies increase the odds of promoting creative accidents in strategy: encouraging bottom-up experiments and driving top-down initiatives.

- Exhibit D: an excerpt from Ann HERMANN-NEHDI, “Creativity and Strategic Thinking: The Coming Competencies” (1988) at page 23:

Creativity and strategy are no longer optional in today’s rapidly changing business environment. Now considered essential to maintaining a competitive edge, many organizations are seeking ways to unleash new perspectives and fresh thinking about their products, markets, challenges and competitors. Understanding the thinking

styles involved in the different phases of the creative and strategic thinking processes (not to mention the quality process) allow individuals and organizations to more effectively take advantage and apply the brain power available to them.

- Exhibits E to H: titles of various articles, which the Opponent submits show that “creativity” is a well established topic within corporate/business management and organizational thinking, namely:
  - Marjory PILLEY, “What Creativity Means to a Project Manager” (2011)
  - Harry B. MINGAIL, “Creativity And Innovation Enable Project Success” (2011)
  - Teresa AMABILE and Mukti KHAIRE, “Creativity and the Role of the Leader” (2008)
  - Micheal HYATT, “Leadership Question #4: How Do You Encourage Creative Thinking?” (2010)

[67] In summary, the Opponent submits “creativity and creative thinking” have been routine aspects of “organization management and strategy” and “strategic management” and corporate/business training and related education services, for years. Thus, according to the Opponent, the applied-for services of the Applicant are merely one particular approach falling within the services listed in the Opponent’s THINKLAB registration.

[68] The Opponent further submits that the applied-for “goods” of the Applicant are in fact the standard sorts of materials that one would use in the presentation and advertising of the relevant education and training services, or expect to be provided by an entity providing “educational services in the fields of organization management and strategy for for-profit and non-profit organizations”, in that one would not be surprised to see a company providing educational services separately offering educational products.

[69] Lastly, the Opponent submits that the nature of the parties’ trades is the same. The Opponent’s services are for for-profit and non-profit organizations. The Applicant’s “corporate training services...” indicate that the training services are directed to for-profit organizations, and this is borne out by Exhibit I to the Ehm affidavit, which identifies several corporations as clients of the Applicant.

*The Applicant's submissions*

[70] The Applicant submits that the services of the Opponent are directed to the business of assisting other companies with government relations and public relations issues. This differs from the business that the services of the Applicant are directed to, namely corporate training services to teach creativity and creative thinking skills.

[71] The Applicant submits that the applied-for services of the Applicant and the Opponent's registered services not only differ in nature they are also directed to entirely different businesses and trades. The Applicant submits that there is no overlap between the services of the Applicant and the Opponent's and the services that each mark is used with are distinct.

[72] Commenting on Exhibits A to H attached to the Duckett affidavit, the Applicant submits that:

- Exhibits F and G do not include any of the search terms identified in the Duckett affidavit.
- Exhibit H only includes the search term "creative thinking".
- Exhibit E only includes the search term "project management".
- None of Exhibits A to D includes any of the search terms "strategic management", "operations management", "project management" or "organization management".
- When the use of the terms "creative thinking" and "strategic planning" are compared in Exhibits A to D, the content of the exhibits makes a clear distinction between creative thinking and strategic planning. For example, Exhibit A draws a distinction between leaders who "engage in strategic thinking" and "creative leaders who apply 'creative thinking skills'" (at page 7). As another example, Exhibit C sets out that strategic planning does not engage "creative thinking about a company's vision and direction", but instead is like some "primitive tribal ritual" (at page 14). As yet another example, Exhibit D states that strategic planning and creative thinking are "very different animals indeed" (at page 26). In fact, the content of the exhibits generally point to strategic planning as being deficient because it is routinely devoid of creative thinking.

[73] The Applicant submits that in the Earnshaw affidavit definitions from *The Canadian Oxford Dictionary* are provided (Exhibit A), and these definitions confirm that:

- “creativity” and “creative” have meanings relating to the ability to create things in an imaginative way;
- “thinking” has a meaning relating to thought or rational judgment; and
- “skill” has a meaning relating to an ability or aptitude.

[74] Therefore, the Applicant submits that creative thinking skills can be described in accordance with dictionary definitions to be: an ability or aptitude in thought directed to imaginative creation.

[75] The Applicant further submits that notably, the above dictionary definitions do not in any way encompass or relate to any of the words used to define the services in the Opponent’s registration.

[76] Thus, the Applicant submits that a review of the content of Exhibits A to H of the Duckett affidavit shows that the Opponent has not provided any evidence to support the position set out in paragraph 3 of its statement of opposition that the services listed in its registration encompass the applied-for services of the Applicant, and that “creativity and thinking skills” in the applied-for services are merely “a specific theoretical approach to the services as more generally defined in” the Opponent’s registration. The Applicant submits that the Opponent’s evidence shows the opposite, that creative thinking is distinct from the planning and management services in the Opponent’s registration.

[77] The Applicant further submits that the dictionary definitions of Exhibit A provided in the Earnshaw affidavit contradict the Opponent’s assertions in its statement of opposition in that they show that there is no relationship between the services of the Opponent’s registration and the applied-for services of the Applicant.

[78] Lastly, the Applicant submits that the Opponent’s position set out in paragraph 4 of its statement of opposition that there is a “high likelihood of confusion between the sale of” the

applied-for goods and the Opponent's registration is also unsupported. The Applicant submits that the applied-for goods differ in nature, business and trade from the services of the Opponent's registration. The Applicant further submits that the Leblanc affidavit shows that the Examiner did not cite the Opponent's registration against the application for the Mark.

*Conclusion regarding the nature of the goods, services or business; and the nature of the trade*

[79] Contrary to the Applicant's submissions, the Opponent's services are not restricted "to the business of assisting other companies with government relations and public relations issues" but also include consulting services for for-profit and non-profit organizations with respect to project management, strategic management, operations management and knowledge management; and educational services in the field of, *inter alia*, organization management and strategy for for-profit and non-profit organizations.

[80] In the same vein, the Applicant's submissions that the parties' services are directed to "entirely different businesses and trades" are unpersuasive and unsupported by evidence. Suffice it to reiterate that the Opponent's consulting services and educational services are for both for-profit and non-profit organizations, and that Exhibit I to the Ehm affidavit identifies several corporations as clients of the Applicant.

[81] In other words, there is no reason to conclude that the parties' services would not travel through the same channels of trade and be directed to the same clientele, at least insofar as the "for-profit organizations" referred to in the statement of services in the Opponent's registration are concerned.

[82] Turning to the Applicant's submissions that "there is no relationship" between the services of the Opponent and the applied-for goods and services of the Applicant and that the Opponent has not provided any evidence to support the position that the services listed in the Opponent's registration encompass the ones listed in the Applicant's application for the Mark, I first wish to reiterate that it is not necessary that the parties operate in the same general field or industry or that their respective goods and services be of the same type or quality for there to be

a likelihood of confusion. As stated in section 6(2) of the Act, confusion may occur “whether or not the goods or services are of the same general class”.

[83] Second, I acknowledge that creative thinking skills can be described as an ability or aptitude in thought directed to imaginative creation. I also acknowledge that the content of some of the exhibits attached to the Duckett affidavit makes a clear distinction between creative thinking and strategic planning. Still, the concepts of “creative thinking” and “strategic planning” are interrelated, as amply demonstrated by Exhibits A-H of the Duckett affidavit, which highlight, *inter alia*, the importance of creative thinking skills in successful executive leadership and strategic planning. Of note also, is the “testimonial” below taken from Exhibit H to the Ehm affidavit:

Through ThinkLAB, Combustion delivered tangible tools and a process that is already being used to effectively identify problems while creatively solving for them in our everyday business. Moreover, the training that Combustion delivered was highly engaging and inspirational, so much so that mindsets are quite literally changing.

– Anna Seymour, Director, Strategic Planning, Insights & Innovation, Corby [Emphasis added]

[84] In other words, I do not find convincing the Applicant’s position that there is no overlap or relationship whatsoever between the parties’ respective services. In the end, while the parties’ services may have a different focus, they are still not so far removed from one another.

[85] Likewise, the Applicant’s submissions that the applied-for goods “differ in nature, business and trade from the services of the Opponent’s registration” are unpersuasive. As indicated above, decisions by the Examination section are not binding and have no precedential value in determining the registrability of a trade-mark in an opposition. Furthermore, as submitted by the Opponent, some of the applied-for goods are the sorts of products that one would expect to be provided by an entity providing “educational services in the fields of organization management and strategy for for-profits and non-profit organizations”, in that one would not be surprised to see a company providing educational services separately offering educational products.

[86] In view of the foregoing, these factors favour the Opponent.

*Conclusion regarding the likelihood of confusion*

[87] As indicated above, section 6(2) of the Act is not concerned with the confusion of the trade-marks themselves, but confusion of goods or services from one source as being from another. In the present case, the question posed is whether an individual, who has an imperfect recollection of the Opponent's THINKLAB trade-mark in association with the Opponent's registered services, would, as a matter of first impression and imperfect recollection, be likely to conclude that the Applicant's applied-for goods and services are manufactured or sold by the Opponent.

[88] While I acknowledge that the Mark has been used in association with the applied-for services over the last five years or so and become known to some extent in Canada, whereas there is no evidence that the Opponent's THINKLAB trade-mark has been used or become known in Canada to any extent, I find these two factors are not significant enough to outweigh the overall consideration of the section 6(5) factors discussed above. As stressed before, the parties' marks are identical and there is a potential overlap between the applied-for goods and services of the Applicant and the services of the Opponent, which are, furthermore, directed towards the same clientele. At best for the Applicant, I find the balance of probabilities as to the likelihood of confusion as to the source of the parties' goods and services to be evenly balanced. As the onus is on the Applicant to show, on a balance of probabilities, that there is no reasonable likelihood of confusion, I must find against the Applicant.

[89] The non-registrability ground of opposition therefore succeeds.



DISPOSITION

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

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Annie Robitaille  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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No Hearing Held

**AGENTS OF RECORD**

Thompson Cooper LLP

FOR THE OPPONENT

Miller Thomson LLP

FOR THE APPLICANT