

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 65
Date of Decision: 2020-05-29

IN THE MATTER OF OPPOSITIONS

Parkinson Alberta Society

Opponent

and

Parkinson Canada Inc.

Applicant

**1,618,139 for PARKINSON ALBERTA
SOCIETY SOCIÉTÉ PARKINSON
ALBERTA**

Applications

**1,618,144 for PARKINSON ALBERTA
SOCIETY SOCIÉTÉ PARKINSON
ALBERTA & Tulip Design**

Overview

[1] The applications for the trademarks PARKINSON ALBERTA SOCIETY SOCIÉTÉ PARKINSON ALBERTA and PARKINSON ALBERTA SOCIETY SOCIÉTÉ PARKINSON ALBERTA & Tulip Design were filed on March 13, 2013 by Parkinson Society Canada who merged with Parkinson Canada Inc. (the Applicant). The Applicant is a national charitable organization dedicated to serving the interests of Canadians living with Parkinson disease and was founded in 1965. It has applied for these trademarks on the basis of use in Canada since at least as early as 2011.

[2] The PARKINSON ALBERTA SOCIETY SOCIÉTÉ PARKINSON ALBERTA & Tulip Design trademark is set out below:



[3] These applications have been opposed by the Parkinson Alberta Society (the Opponent). The Opponent is a non-profit organization dedicated to fundraising services relating to Parkinson disease, Parkinson disease awareness and research relating to Parkinson disease. It organizes and conducts fundraising campaigns, public awareness campaigns, information sessions and other events. The Opponent alleges that it has used the trademarks PARKINSON ALBERTA SOCIETY and PARKINSON ALBERTA and the trade name Parkinson Alberta Society prior to the filing of the subject applications.

[4] The parties are well known to each other. On July 1, 2009, the Applicant entered into a federation with 11 regional Parkinson organizations and the Opponent's predecessors. As part of the agreement governing the federation, the Opponent assigned the rights to "Parkinson Alberta Society" and "Parkinson Alberta" to the Applicant on June 6, 2011 and licensed the use of these trademarks and trade names back from the Applicant. On January 31, 2013, the Opponent disaffiliated from the federation.

[5] The Opponent has opposed these applications on a number of different grounds including that the applications are confusing with the Opponent's trademarks PARKINSON ALBERTA SOCIETY and PARKINSON ALBERTA and trade name Parkinson Alberta Society previously used in Canada.

[6] For the reasons that follow, I reject the opposition to each application as the Opponent has not met its evidential burden with respect to any of the grounds of opposition. While the Opponent was using the trademarks PARKINSON ALBERTA SOCIETY and PARKINSON ALBERTA and the trade name Parkinson Alberta Society, the Opponent fails to show that the use of these trademarks and trade name enure to it. Prior to January 31, 2013, the Opponent's use was further to a license agreement with the Applicant and the Opponent's use enured to the

Applicant. After January 31, 2013, when the Opponent disaffiliated from the Applicant, the Opponent's use does not appear to comply with the assignment of its rights to the Applicant and its license agreement which prohibited use of the trademarks after disaffiliation.

File Records

[7] On March 13, 2013, the Applicant filed applications for the trademarks PARKINSON ALBERTA SOCIETY SOCIÉTÉ PARKINSON ALBERTA (the Mark) and PARKINSON ALBERTA SOCIETY SOCIÉTÉ PARKINSON ALBERTA & Tulip Design (the Design Mark). The Goods and Services are set out at Schedule A to this decision. The applications are based on the Applicant's use of the Mark and Design Mark in Canada since 2011.

[8] The Mark and the Design Mark were advertised for opposition purposes in the *Trademarks Journals* of June 24, 2015 and April 29, 2015, respectively.

[9] The Opponent opposed the application for the Design Mark on June 26, 2015 and the application for the Mark on August 21, 2015. The grounds of opposition are summarized below. The *Trademarks Act*, RSC 1985, c T-13 (the Act) was amended on June 17, 2019. All references in this decision are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act before it was amended (see section 70 of the Act).

- (a) The applications do not comply with section 30(a) of the Act as the applications do not include a statement in ordinary commercial terms of the specific goods and services.
- (b) The applications do not comply with section 30(b) of Act in that the Applicant did not use the Mark and the Design Mark since the date of first use claimed with all the Goods and Services.
- (c) The applications do not comply with section 30(i) of the Act. The Applicant could not have been satisfied that it is entitled to use the Mark and Design Mark with the Goods and Services since at the date of filing the applications, the Applicant had knowledge of the Opponent's extensive and prolonged use of its

trademarks PARKINSON ALBERTA SOCIETY and PARKINSON ALBERTA in Canada.

- (d) The Applicant is not the person entitled to registration of the Mark and the Design Mark pursuant to sections 16(1)(a) and 16(1)(c) of the Act as the Mark and Design Mark are confusing with the Opponent's trademarks PARKINSON ALBERTA SOCIETY and PARKINSON ALBERTA and trade name Parkinson Alberta Society previously used and made known in Canada by the Opponent.
- (e) The Mark and the Design Mark are not distinctive. The Mark and the Design Mark cannot and do not distinguish the Goods and Services from the Opponent's goods and services, nor is the Mark and the Design Mark adapted so as to distinguish the Goods and Services.

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

[11] The Opponent filed as its evidence the affidavits of John Petryshen who was cross-examined and Graeme Harrison. The Applicant filed as its evidence the affidavits of Joyce Gordon and Mary P. Noonan. For the purposes of this decision, it is unnecessary for me to discuss the evidence of Mr. Harrison or Ms. Noonan. Neither party filed a written argument. Only the Applicant appeared at a hearing.

Material Dates and Onus

[12] The material dates that apply to the grounds of opposition are:

- sections 38(2)(a)/30 - the filing date of the applications [*Georgia-Pacific Corp. v Scott Paper Ltd.* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- sections 38(2)(c)/16(1) - the date of first use claimed in the applications [section 16(1) of the Act]; and

- sections 38(2)(d)/2 - the date of filing of the oppositions [*Metro-Goldwyn-Mayer Inc. v Stargate Connections Inc.* (2004), 34 CPR (4th) 317 at 324 (FC)].

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

[14] With respect to (i) above, there is an evidential burden on an opponent to prove the facts in its allegations pleaded in the statement of opposition: *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298. The presence of an evidential burden on an opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on an applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent (for those allegations for which the opponent has met its evidential burden). The presence of a legal onus on an 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.

The Relationship Between the Parties

[15] The evidence concerning the relationship between the parties is provided by Ms. Gordon and Mr. Petryshen.

Evidence of Joyce Gordon

[16] Ms. Gordon is the Chief Executive Officer of the Applicant and has held this position since 2004 (para 1). Founded in 1965, Parkinson Canada is a national charitable organization dedicated to serving the interests of Canadians living with Parkinson disease, as well as their families and caregivers (para 7, Exhibit 2). The Applicant also raises money to fund research towards curing Parkinson disease and otherwise improving the quality of life of those afflicted with the disease (para 11, Exhibit 4). The Applicant also has a Parkinson Society Federation (the Federation) through which it works with smaller regional organizations to raise awareness,

distribute information through publications and programs and fundraise for Parkinson disease research (para 17).

The Federation

[17] Ms. Gordon provides the following information about the Federation:

- (a) The Federation was created on July 1, 2009 when the Applicant entered into an agreement with 11 regional Parkinson organizations (para 18, Exhibit 5). The parties include the Opponent's predecessors-in-title (the Parkinson Society of Southern Alberta and the Parkinson Society of Alberta). On June 6, 2011, this agreement was amended to reflect both the merging of the Opponent's predecessors into one organization and the Opponent's name change to Parkinson Alberta Society (Exhibit 6).
- (b) Both Parkinson Society of Alberta and the Parkinson Society of Southern Alberta executed license agreements on December 1, 2009 (Exhibits 7 and 8) (the License Agreement). In the License Agreement, the Opponent agreed:
 - i. to assign to the Applicant all right, title, interest and goodwill in and to any trademark or trade name owned by the Opponent (para 7 of the License Agreement);
 - ii. that all interest in the Applicant's registered and unregistered trademarks, including any goodwill and copyright, would remain the sole and exclusive property of the Applicant (para 7 of the License Agreement);
 - iii. that all use of the Applicant's registered and unregistered trademarks would enure solely to the benefit of the Applicant (para 7 of the License Agreement);
 - iv. that the Applicant would exercise control over the use of the licensed marks (para 3 of the License Agreement).
- (c) On June 16, 2011, the Opponent assigned to the Applicant the trademarks and trade names Parkinson Alberta Society and Parkinson Alberta (Exhibit 9).

[18] On January 31, 2013, the Opponent chose to disaffiliate from the Federation. Under the Federation Agreement, by disaffiliating, the Opponent agreed to cease operating under the name of Parkinson Society and cease using any of the Applicant's trademark or other property (Exhibit 5, para 17(d) of the Federation Agreement). The License Agreement also contained the following terms which the agreement states survive termination: "Licensee agrees that upon termination ... it will promptly cease use of each Trademark" and "Licensee acknowledges and agrees that all interest in and to the Trademarks including the goodwill and copyright therein are and shall at all times be the sole and exclusive property of Parkinson Canada" and (Exhibit 7, paras 7,14-15 of the License Agreement).

Evidence of John Petryshen

[19] Mr. Petryshen has been the Chief Executive Officer of the Opponent since 2007 (para 4). The Opponent includes as predecessors the Parkinson Society of Southern Alberta formed in September 21, 1981 and the Parkinson Society of Alberta formed in 1973. These two entities subsequently merged (para 3). Mr. Petryshen provides the following evidence in his affidavit at paragraph 12:

Since at least as early as July 2011, the Opponent has been actively operating a non-profit organization in Canada dedicated to fundraising services relating to Parkinson disease, Parkinson disease awareness and research in association with the trademark PARKINSON ALBERTA SOCIETY. The Opponent is a stand-alone Alberta-based charitable organization and relies on the generosity of donors. In its efforts to provide its members and non-members, as well as families and friends of people affected by Parkinson disease and Parkinson related illnesses with information regarding Parkinson disease, research related to the disease and assistance in the care and treatment of people affected by this disease, the Opponent has published and distributed numerous publications ... in association with its trademark PARKINSON ALBERTA SOCIETY. ... As well, the Opponent organizes and conducts fundraising campaigns, public awareness campaigns, information sessions, meetings, seminars, luncheons and dinners and numerous other events relating to Parkinson disease ... in association with its trademark PARKINSON ALBERTA SOCIETY since at least as early as July 2011. The Opponent has also used its trademark PARKINSON ALBERTA in association with all of the aforementioned services in Canada since at least as early as February 2013.

[20] Mr. Petryshen also attaches to his affidavit a membership form (Exhibit D), a letter promoting an annual fundraising event (Exhibit E), photos of tulips sold annually in association

with a banner (Exhibit G), copies of the magazine Parkinson Pulse (Exhibits K, M) and brochures (Exhibits H, N and Q), all of which display the PARKINSON ALBERTA SOCIETY or PARKINSON ALBERTA trademarks.

[21] In his examination, Mr. Petryshen confirms that:

- (a) the Opponent signed a Federation Agreement in 2009 and at the time was to be branded Parkinson Alberta Society (Q38);
- (b) under the agreement there were obligations and controls on how the Opponent could brand itself (Q39);
- (c) that the Opponent decided to voluntarily disaffiliate “around 2013-ish” (Q43);
and
- (d) that the Opponent branded itself as PARKINSON ALBERTA after disaffiliation, with its corporate documentation saying Parkinson Alberta Society (Q50), including donor receipts and contracts (Q54).

Distinctiveness Ground of Opposition

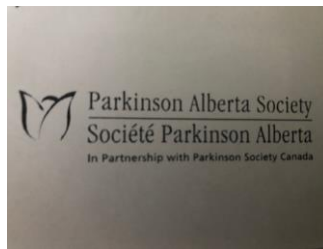
[22] I will first begin with a consideration of the distinctiveness ground of opposition.

[23] The Opponent alleges that the Mark and Design Mark are not distinctive from the Opponent’s goods and services.

[24] The Applicant does not contest that the Opponent has used the trademarks PARKINSON ALBERTA or PARKINSON ALBERTA SOCIETY or the trade name Parkinson Alberta Society. What is contested is whether the Opponent can rely on such use in support of its ground of opposition based on distinctiveness. If the Applicant controlled the Opponent’s use pursuant to a license, then any such use would enure to the benefit of the Applicant. If the Opponent is unable to rely on its use after the license was terminated because it was unauthorized or unlawful, then this ground of opposition also cannot succeed.

Opponent's Use Was Under License Prior to Disaffiliation

[25] Prior to disaffiliation on January 31, 2013, I find that the Opponent's use of the trademarks PARKINSON ALBERTA and PARKINSON ALBERTA SOCIETY and trade name Parkinson Alberta Society enured to the benefit of the Applicant by virtue of i) the assignment of these trademarks to the Applicant and ii) the License Agreement (Gordon affidavit, Exhibits 7-13). This is consistent with some of the uses featured in Mr. Petryshen's affidavit including the letter at Exhibit E and the 2011 Annual Report (Exhibit T) both of which feature the following:



Opponent's Use After Disaffiliation was Unauthorized

[26] The Applicant submits that the Opponent is unable to rely on the Opponent's subsequent use of the trademarks PARKINSON ALBERTA SOCIETY and PARKINSON ALBERTA and trade name Parkinson Alberta Society to meet its evidential burden because any such use was unauthorized or unlawful since it was outside the scope of the agreements between the parties. To the extent that this use is unauthorized or unlawful, it cannot be relied upon to defeat an applicant's rights in a trademark [*Heritage Silversmiths Inc. v World Tableware International Inc.* (1994), 56 CPR (3d) 278 (TMOB); *Becon Pty Ltd. v Fast Co. Distributors, Inc.* 2012 TMOB 190 at para 44 (TMOB) both citing *McCabe v Yamamoto & Co (America) Inc* (1989), 23 CPR (3d) 498 at 503 (FCTD)] so long as the issue of lawfulness is clear [*Sunbeam Products Inc. v Mister Coffee & Services Inc.* 2001 FCT 1218]. I find the present case to be one in which the issue of lawfulness of the Opponent's use is clear in view of the agreements between the parties and find that the Opponent's use of the trademarks PARKINSON ALBERTA SOCIETY and PARKINSON ALBERTA and trade name Parkinson Alberta Society to be unauthorized after disaffiliation.

Opponent Fails to Meet its Evidential Burden

[27] In view of my findings in paragraphs 25 and 26 and in the absence of submissions from the Opponent, I find that the Opponent fails to meet its evidential burden with respect to the distinctiveness ground of opposition. As such, this ground of opposition is rejected with respect to both applications.

Section 16 Grounds of Opposition

[28] The Opponent has also pleaded that the Applicant is not the person entitled to registration of the Mark and the Design Mark pursuant to sections 16(1)(a) and 16(1)(c) of the Act as the Mark is confusing with the Opponent's trademarks PARKINSON ALBERTA SOCIETY and PARKINSON ALBERTA and trade name Parkinson Alberta Society previously used or made known in Canada.

[29] In order to meet its initial burden under section 16 of the Act, the Opponent must evidence that it was using its trademarks and trade name in Canada prior to December 31, 2011 and had not abandoned these trademarks or trade name at the date of advertisement of each application [see section 16(5) of the Act and *Canadian Jewellers Association v American Gem Society*, 2010 TMOB 106 at para 55, which confirms that a date of first use indicated with just a year is interpreted as December 31 of that year].

[30] On the basis of my finding that a license existed between the Applicant and Opponent as of this date and the assignment of rights in June 2011, it appears to me that any use by the Opponent prior to and at the material date enured to the benefit of the Applicant. As such, I find that the Opponent does not meet its evidential burden with respect to these grounds of opposition. Accordingly, the sections 16(1)(a) and 16(1)(c) grounds of opposition against both applications are rejected.

Section 30(a) Ground of Opposition

[31] The Opponent alleges that the applications do not conform to the requirements of section 30(a) of the Act as the applications do not contain a statement in ordinary commercial terms. The Opponent's initial evidential burden under section 30(a) is a light one and may be met through

argument [*McDonald's Corp v M.A. Comacho-Saldana International Trading Ltd.* (1984), 1 CPR (3d) 101 (TMOB) at 104; *Air Miles International Trading BV v Deutsche Lufthansa AG* (2010), 89 CPR (4th) 230 (TMOB) at para 30]. In this case, the Opponent has not made any submissions, nor filed any evidence directed to this ground. The Opponent, therefore, fails to meet its initial burden. The section 30(a) ground of opposition is rejected against both applications.

Section 30(b) Ground of Opposition

[32] The Opponent has pleaded that the Mark had not been used in Canada by the Applicant with the Goods and Services since the claimed date of first use. The Opponent's initial burden respecting the issue of the Applicant's non-compliance with section 30(b) can be met by reference not only to the Opponent's evidence but also to the Applicant's evidence [*Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) (FCTD) 216 at 230; *Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd*, 2014 FC 323 at paras 28-38].

[33] On the basis of my finding that a license existed between the Opponent and the Applicant with respect to the use of the Mark and Design Mark in Canada from the claimed date of first use until the Opponent's disaffiliation from the Applicant, I find that the Opponent fails to meet its evidential burden with respect to this ground of opposition. As such, this ground of opposition is rejected for both applications.

Section 30(i) Ground of Opposition

[34] The section 30(i) ground of opposition alleges that the Applicant could not have been satisfied that it was entitled to use the Mark and the Design Mark in association with the Goods and Services as the Applicant had knowledge of the Opponent's extensive, prolonged and prior use of the trademarks PARKINSON ALBERTA SOCIETY and PARKINSON ALBERTA.

[35] Section 30(i) requires an applicant to indicate as part of its application that it is satisfied that it is entitled to use the trademark in Canada in association with the listed goods and services. The statement provided by section 30(i) purports to be evidence of an applicant's good faith in

submitting its application [*Cerverceria Modelo, S.A. de C.V. v Marcon* (2008), 70 CPR (4th) 355 (TMOB) at 366]. Where an applicant has provided the statement required by section 30(i), this ground of opposition should only succeed in exceptional cases, such as when there is evidence of bad faith on the part of an applicant [*Sapodilla Co. Ltd. v Bristol Myers Co.* (1974), 15 CPR (2d) 152 (TMOB) at 155].

[36] The Opponent fails to meet its evidential burden in view of the assignment of the PARKINSON ALBERTA and PARKINSON ALBERTA SOCIETY trademarks to the Applicant. Given the assignment and the terms of the license agreement described above, the Opponent has not met its burden of showing that the Applicant did not believe that it was entitled to use the Mark or Design Mark in Canada or was otherwise acting in bad faith. As such, this ground of opposition is rejected with respect to both applications.

Disposition

[37] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the oppositions to application Nos. 1,618,139 and 1,618,144 pursuant to section 38(12) of the Act.

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

Hearing Date: 2020-02-12

Appearances

No one appearing For the Opponent

Kevin Sartorio For the Applicant

Agents of Record

Bennett Jones LLP For the Opponent

Gowling WLG (Canada) LLP For the Applicant

Schedule A

Goods: (1) Promotional items namely pins, buttons, pens, pencils, watches, mouse pads, mugs, plaques and awards; casual clothing; clothing, namely, t-shirts; printed materials, namely, brochures, booklets and pamphlets.

Services: (1) Operation of a non-profit organization dedicated to raising funds and awareness for Parkinson Disease; provision of information and educational services relating to Parkinson Disease, namely, public awareness campaigns, meetings, luncheons, the distribution of pamphlets, posters, literature and other handouts, speaker programs, the conduct of focus groups, providing information through a website; information and referral services relating to Parkinson Disease by telephone and the internet; fundraising services for the benefit of research and care of those suffering from Parkinson Disease; operation of fundraising events; medical, patient and public policy research services in the field of Parkinson Disease; information, referral and support services for people with Parkinson disease, their friends, family members, caregivers and health care professionals, namely on medical research and educational information and support related to Parkinson Disease, understanding the symptoms of Parkinson Disease and how to make lifestyle adjustments to cope with Parkinson Disease; coordinating and facilitating volunteer positions and activities, namely finding and placing people in volunteer positions that focus on raising funds for Parkinson research and treatment, providing information to people affected by Parkinson disease and referrals to healthcare professionals and institutions in the field of Parkinson disease, providing education on the management of living with Parkinson Disease and advocacy in the field of Parkinson Disease; advocacy services, namely influencing and developing policy and services on behalf of people and families living with Parkinson Disease and health care professionals in the fields of charitable fundraising, medical research into Parkinson Disease, treatment of Parkinson Disease and accommodation for people with Parkinson Disease.