



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 125

Date of Decision: 2020-10-30

IN THE MATTER OF AN OPPOSITION

**Eagle's Flight, Creative Training
Excellence Inc.**

Opponent

and

Yara International ASA

Applicant

**1,724,316 for SAFE BY CHOICE &
Design**

Application

INTRODUCTION

[1] Eagle's Flight, Creative Training Excellence Inc. (the Opponent) opposes registration of the trademark SAFE BY CHOICE & Design, shown below (the Mark), the subject of application No. 1,724,316, that was filed by Yara International ASA (the Applicant).



[2] Filed on April 17, 2015, the application is based on the dual basis of use of the Mark in Canada since at least as early as June 1, 2013, as well as use in Norway under registration No. 282,235, in association with the following services:

(1) (a) business management; business administration; office functions, namely, business administration and management, management of office buildings, office space management and word processing and typing services; business counselling in the field of health, safety, environment (HSE); business support services within HSE; management of HSE issues; risk evaluations and analysis, safety tours; (b) education within the field of work-place security, work-place health promotive solutions and environmentally friendly work-place solutions; providing of training within the field of work-place security, work-place health promotive solutions and environmentally friendly work-place solutions; organizing and providing of seminars within the field of work-place security, work-place health promotive solutions and environmentally friendly work-place solutions; (c) security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals, namely, consulting in the field of work-place safety, consultancy on regulations on safety at work, consulting in the field of work-place health issues and consulting in the field of work-place related environmental issues; inspections for safety purposes, namely, safety inspections in the field of work-place HSE; investigation and surveillance services relating to the safety of persons and entities; safety studies, namely, studies to evaluate work-place HSE.

[3] The application was advertised in the *Trademarks Journal* of December 16, 2015.

[4] The Opponent alleges that (i) the application does not comply with the provisions of section 30(b) of the *Trademarks Act*, RSC 1985, c T-13 (the Act); (ii) the Mark is not registrable under section 12(1)(d) of the Act; (iii) the Applicant is not the person entitled to the registration of the Mark under section 16 of the Act, and (iv) the Mark is not distinctive under section 2 of the Act. The last three grounds of opposition revolve around the likelihood of confusion between the Mark and the Opponent's trademark SAFE BY CHOICE (the Opponent's Mark), registered under No. TMA907,505. A complete list of the goods and services associated with the Opponent's Mark is attached as Schedule A to this decision.

[5] As a preliminary matter, I note that 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 as it read before it was amended (see section 70 of the Act which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised prior to that date).

[6] For the reasons that follow, I refuse the application.

THE RECORD

[7] The Opponent filed its statement of opposition on February 11, 2016. The Applicant filed and served its counter statement on June 10, 2016 denying all of the grounds of opposition.

[8] In support of its opposition, the Opponent filed the affidavit of David Root, sworn October 11, 2016, together with Exhibits A through I.

[9] In support of its application, the Applicant filed the affidavit of Claire Gordon, sworn July 4, 2017, together with Exhibit A; the affidavit of Gay Owens, sworn August 15, 2017, together with Exhibit A; and the affidavit of Michael S. Duchesneau, sworn August 2, 2017, together with Exhibits 1-25.

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

[11] Only the Opponent filed written representations.

[12] An oral hearing was not conducted.

THE PARTIES' RESPECTIVE BURDEN OR ONUS

[13] The Applicant bears the legal onus of establishing, on a balance of probabilities that the application complies with the requirements of the Act. This means that if a determinate conclusion cannot be reached in favour of the Applicant after a consideration of all of the evidence, then the issue must be decided against the Applicant. 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].

[14] With respect to the grounds of opposition, it is the following material dates that apply:

- Sections 38(2)(a)/30(b) – the filing date of the application, namely, April 17, 2015 [*Georgia-Pacific Corporation v Scott Paper* (1984), 3 CPR (3d) 469 at 475 (TMOB)];

- Sections 38(2)(b)/12(1)(d) – the date of my decision [see *Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd* (1981), 37 CPR (3d) 413 (FCA)];
- Sections 38(2)(c)/16(1)(a) – the date of first use claimed in the application, namely, June 1, 2013 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* 2004 FC 1185, 34 CPR (4th) 317 (FCTD) and section 16(1) of the Act]; and
- Sections 38(2)(d)/2 – the date of filing of the statement of opposition, in this case being February 11, 2016 [see *Metro-Goldwyn-Mayer supra*].

ANALYSIS

Section 30(b) Ground of Opposition

[15] The Opponent has plead that the application does not comply with the provisions of section 30(b) of the Act, in that the Applicant has not used the trademark in Canada in association with the services listed in the subject application since as early as June 1, 2013, as claimed in the application.

[16] An opponent's initial burden under section 30(b) of the Act is light [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 at 89 (TMOB)], and 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) 216 at 230 (FCTD)]. In the present case, the Opponent has not provided any evidence in support of its section 30(b) ground of opposition, nor did the Applicant file any evidence of use of its Mark. In the absence of any evidence suggesting that the Applicant has not used its Mark in Canada as of the alleged date of first use, the Applicant is under no obligation to positively evidence such use. I therefore find that the Opponent has failed to meet its evidential burden and dismiss this ground accordingly.

Section 16(1)(a) Ground of Opposition

[17] The Opponent has plead that the Applicant is not entitled to registration of the subject trademark because at the date of filing of the application, namely, April 17, 2015, the trademark

was confusing with the Opponent's Mark, previously used in Canada by the Opponent in association with the goods and services listed in Schedule A to this decision since at least as early as January 2012.

[18] Under a ground of opposition based on section 16(1)(a) of the Act, the Opponent has an initial burden of establishing that its trademark alleged in support of this ground of opposition was used or made known prior to the Applicant's claimed date of first use, in this case, June 1, 2013, and was not abandoned at the date of advertisement of the application for the Mark (in this case, December 16, 2015) [section 16(5) of the Act].

[19] As previously indicated, the Opponent filed the affidavit of David Root, the CFO of the Opponent, in support of its opposition.

[20] While the Opponent's statement of opposition alleges an earlier date of first use, namely, since at least as early as January 2012, I note that Mr. Root attests in his affidavit that the Opponent first used its SAFE BY CHOICE trademark in Canada in association with the Opponent's goods and services in December 2014. As the evidence is consistent with this sworn statement, and there is no evidence that the Opponent's SAFE BY CHOICE trademark was made known in Canada prior to the Applicant's claimed date of first use, I find that the Opponent has failed to satisfy its initial burden under this ground of opposition.

[21] Consequently, the ground of opposition based on section 16(1)(a) is dismissed.

Section 12(1)(d) Ground of Opposition

[22] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if the registration relied upon is in good standing. The Registrar has the discretion to check the register in order to confirm the existence of any registrations relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. I have exercised the Registrar's discretion to confirm that the Opponent's SAFE BY CHOICE registration No. TMA907,505 is in good standing as of today's date, which, as previously indicated, is the material date for assessing a section 12(1)(d) ground of opposition [per *Park Avenue Furniture Corp, supra*]. The Opponent has therefore satisfied its evidential burden.

[23] I now have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with the Opponent's trademark.

The test for confusion

[24] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[25] 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 trademarks and the extent to which they have become known; b) the length of time each has 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. These criteria are not exhaustive and it is not necessary to give each one of them equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, 1 SCR 772 at para 54; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 (Masterpiece)].

Section 6(5)(e) - degree of resemblance in appearance, when sounded, or in idea suggested

[26] In most cases, the dominant factor in determining the issue of confusion is the degree of resemblance between the trademarks in their appearance or sound or in the ideas suggested by them, and other factors play a subservient role in the overall surrounding circumstances [see *Beverley Bedding & Upholstery Co v Regal Bedding & Upholstering Ltd* (1980), 47 CPR (2d) 145, (FCTD), aff'd (1982), 60 CPR (2d) 70 (FCA)].

[27] In *Masterpiece*, the Supreme Court of Canada considered the importance of section 6(5)(e) in conducting an analysis of the likelihood of confusion as follows at 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.

[28] Bearing this in mind, I have elected to begin my analysis by considering section 6(5)(e).

[29] The dominant portion of the parties' trademarks, that is, the word elements, are identical. Furthermore, I do not find that the design in the Applicant's Mark detracts from the degree of resemblance, because it simply reinforces the idea suggested that the Mark is related to goods and services associated with the workplace. I arrive at this conclusion having looked at the parties' marks in their totality and assessed for their effect on the average consumer as a whole.

[30] This factor therefore strongly favours the Opponent.

Section 6(5)(a) – the inherent distinctiveness and the extent to which the marks have become known

[31] The overall consideration of the section 6(5)(a) factor, involves a combination of inherent and acquired distinctiveness of the parties' marks.

[32] The Opponent submits that both parties' marks have a modicum of inherent distinctiveness in that the marks as a whole, do not clearly describe the characteristics or quality of either party's goods and/or services, although recognizing that the word SAFE may be somewhat suggestive.

[33] The Applicant, on the other hand has not made any submissions, but has provided evidence of dictionary meanings of the words SAFE and CHOICE, which are supportive of the Opponent's position on inherent distinctiveness.

[34] While I agree that the parties' marks as a whole are not clearly descriptive, I note that the parties' goods and services pertain to keeping employees/workers safe, or workplace safety, and thus, find the word SAFE descriptive. The parties' marks are also made up of ordinary dictionary words, and as such, I find they only possess a mild level of inherent distinctiveness. While the

Applicant's Mark incorporates a design element, the design element is not overly distinctive, being silhouettes of workers and thus related to goods and services associated with the workplace. Accordingly, and as the dominant word portions of the parties' marks are identical, I find it reasonable to conclude that the parties' trademarks are roughly equally inherently distinctive.

[35] In any event, the strength of a trademark may be increased by means of it becoming known in Canada through promotion or use.

[36] The Applicant has not provided any evidence of use or promotion of its Mark.

[37] On the other hand, with respect to use and promotion of the Opponent's trademark, Mr. Root states that the mark was first used in Canada in association with the Opponent's experiential training program and related educational materials in December 2014. Further to this, Mr. Root provides the following:

- A photograph of some of the Opponent's the SAFE BY CHOICE educational materials which bear the subject trademark (Exhibit D);
- A photocopy of further SAFE BY CHOICE training materials (including manuals and debriefing guides), which display the trademark (Exhibit E);
- Sample pages from the Opponent's website displaying the SAFE BY CHOICE trademark and describing the Opponent's services, including brochures and videos which he attests are available for download (Exhibits F, G, and H);
- Sales figures for the years 2014 to 2016 in Canada (as well as separate figures for the US and abroad) for revenues from the sales and delivery of the Opponent's SAFE BY CHOICE services and associated materials. The total in Canada over this period is almost \$170,000;
- Two sample invoices, dated in 2014, of sales of the SAFE BY CHOICE services and associated materials in Canada (Exhibit I);

- Total global advertising figures for the period 2013 to 2016 (projected). He states that the Opponent primarily advertises the trademark on its website and that promotional materials for the Opponent's services and associated goods have appeared on the website since 2013 (per Exhibits F, G, and H above); and
- Data regarding hits to the Opponent's website, however, once again, this information is global in nature as no specific data regarding hits originating from Canada have been provided.

[38] Despite the evidence of use provided by the Opponent, it is difficult to ascertain that the Opponent's trademark has become known in association with its goods and services in Canada, to an extent, to have acquired even a moderate degree of distinctiveness. The sales figures do not appear to be significant in relation to such goods and services, only two invoices have been provided, and the advertising figures and data regarding hits to the Opponent's website are global figures, rather than figures specifically attributable to Canada. Consequently, I can only conclude that this factor would, at best, marginally favour the Opponent.

Section 6(5)(b) – the length of time of use

[39] The Applicant has not provided any evidence of use of its trademark.

[40] However, as detailed above, the Opponent has provided some evidence of use of its trademark in Canada in association with its goods and services dating back to 2014. Consequently, this factor favours the Opponent.

Sections 6(5)(c) and (d) - the nature of the services and business or trade

[41] When considering sections 6(5)(c) and (d) of the Act, the statements of goods and services as defined in the application for the Mark and in the Opponent's registration govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [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)].

[42] The Opponent submits, and I agree, that the parties' respective goods and services appear to be highly similar in that both parties' goods and services relate to workplace safety. Further to this, the Opponent submits that since the Applicant did not file any evidence of use of its Mark or any detailed description of the nature of the services it offers in association with its Mark, there is nothing on the record to prove that the Applicant's safety-focused training services differ from those of the Opponent. Again, I agree, and absent evidence to the contrary, find that the parties' goods and services would conceivably involve the same channels of trade.

[43] Having regard to the aforementioned, these factors strongly favour the Opponent.

Surrounding Circumstances – State of the Register and State of the Marketplace

[44] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); and *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD), 36 CPR (3d) 562 (TMOB); and *Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)].

[45] Once again, I note that although the Applicant did not make any submissions, they did file evidence of the state of the register and marketplace.

[46] In this regard, the affidavit of Gay Owens, a trademark searcher with the agent for the Applicant, includes the results of a search conducted of the Canadian trademark registry. As Exhibit A, Ms. Owens attaches the particulars of 15 trademarks she located in the course of her search.

[47] In addition to Ms. Owen's evidence, the affidavit of Michael Duchesneau, a law clerk with the agent for the Applicant, contains screenshots from a variety of websites, which appear to correspond to the trademarks and associated owners of those trademarks identified in Ms. Owen's search. Mr. Duchesneau includes screenshots dated August 2, 2017, as well as those located through use of the Wayback Machine Internet Archive for several years leading up to the date of his affidavit.

[48] All of the trademarks identified in the above affiants' evidence include the word SAFE. However, as indicated earlier, I find this word descriptive, or at the very least, highly suggestive when used in association with goods and services that pertain to safety. Furthermore, with the exception of two marks, the identified trademarks do not also include the word CHOICE. When viewed as a whole, these marks are sufficiently different in appearance, in idea, and when sounded; thus, they are not relevant. With respect to the remaining two identified trademarks, SAFE BY CHOICE, NOT BY ACCIDENT, and SAFECHOICE, Shield for Hand and Body Protection & Design, as submitted by the Opponent, they are for goods that are sufficiently different, with different channels of trade, such that they too are not relevant and do not advance the Applicant's case with respect to confusion.

Conclusion

[49] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection.

[50] As previously indicated, in *Masterpiece, supra*, the Supreme Court of Canada highlighted the importance of the section 6(5)(e) factor in the analysis of the likelihood of confusion. In the present case, the dominant portion of the parties' marks is identical.

[51] Further to this, I have concluded that there is overlap in the nature of the parties' goods and services and channels of trade and while the inherent distinctiveness of the parties' marks is relatively low, the length of time of use of the trademark is in the Opponent's favour.

[52] Having regard to the above, I find that the balance of probabilities with respect to confusion between the parties' marks strongly favours the Opponent. Therefore, the Applicant has failed to establish, on a balance of probabilities, that the Mark is not confusing with the Opponent's SAFE BY CHOICE mark.

[53] Therefore, the ground of opposition based on section 12(1)(d) of the Act is successful.

Section 2 Ground of Opposition

[54] The Opponent has plead that the Mark is not distinctive, as the Mark does not distinguish and is not adapted to distinguish the Applicant's services as set out in the Application from the goods and services of others, and in particular, the goods and services of the Opponent sold in association with the Opponent's Mark.

[55] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada, there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[56] Pursuant to its evidential burden, the Opponent is under an obligation to show that, as of the date of filing of the statement of opposition, its trade-mark had become known sufficiently to negate the distinctiveness of the Mark [see *Bojangles' International, LLC v Bojangles Café Ltd*, 48 CPR (4th) 427 (FC)].

[57] As discussed more fully in the analysis of the section 12(1)(d) ground of opposition, I am not convinced, despite the evidence of use provided by the Opponent, that the Opponent's trademark had become known to much of an extent in association with its goods and services in Canada. Indeed, the sales figures do not appear to be significant in relation to such goods and services, and only two invoices have been provided. I note that the amounts listed on the invoices range from approximately \$7,000 to \$12,000, which would suggest given the Opponent's total sales in Canada from 2014 to 2016, that the Opponent had fewer than 20 customers. Further to this, the advertising figures and data regarding hits to the Opponent's website are global figures, rather than figures specifically attributable to Canada.

[58] The earlier material date under this ground of opposition is of no assistance to the Opponent. Consequently, I am not satisfied that the Opponent has discharged its initial evidential burden of to show that, as of February 11, 2016, its trademark had become known sufficiently to negate the distinctiveness of the Mark.

[59] Accordingly, the non-distinctiveness ground is rejected.

DISPOSITION

[60] Having regard to the aforementioned, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.

Kathryn Barnett
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Opponent's registration No. TMA907,505

Goods

(1) Educational and developmental experiential training games and programs, namely kits containing games which simulate real life situations and assist in teaching business management and organizational skills and related training materials, namely workbooks, debriefing materials and training aids to assist participants in evaluating their experiences after playing the above noted games

Services

(1) Facilitating and presenting by means of training lectures, group sessions, seminars and workshops, educational and developmental experimental training games and programs, namely kits containing games which simulate real life situations and assist in teaching business management and organizational skills and related training materials, namely workbooks, debriefing materials and training aids to assist participants in evaluating their experiences after playing the above noted games

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

No hearing was held.

AGENTS OF RECORD

Bereskin & Parr LLP

For the Opponent

Fetherstonhaugh & Co.

For the Applicant