



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 187

Date of Decision: 2021-08-23

IN THE MATTER OF TWO OPPOSITIONS

**The Governor and Company of
Adventurers of England trading into
Hudson’s Bay, also known as
Hudson’s Bay Company** **Opponent**

and

Macy’s Merchandising Group, Inc. **Applicant**

1,562,486 and 1,639,990 for **Applications**
HUDSON PARK COLLECTION

INTRODUCTION

[1] Macy’s Merchandising Group, Inc. (the Applicant) has applied for registration of the trademark HUDSON PARK COLLECTION (the Mark) in association with the following goods:

Application No. 1,562,486	Application No. 1,639,990
(1) Textile goods, namely, pillowcases, pillow covers, pillow shams, bath towels, blanket	(1) Candles, perfumed candles, tapers, tea light candles, patio torches; household

<p>throws, throws, shower curtains; blankets, namely, bed blankets; comforters; shams; duvet covers; bed covers, namely, sheets, bed skirts, coverlets, mattress pads.</p> <p>(2) Furniture, namely, beds, dressers, chairs, tables, ottomans, sofas, night tables, end tables, bedroom sets, dining room sets; dining room sets, namely, dining tables, dining chairs, dining benches, dining buffets; sleep products, namely, pillows, mattresses, box springs, mattress foundations; bathroom towel racks; decorative pillows; china and dinnerware, namely, plates, saucers, cups, drinking glasses, mugs, bowls; serveware, namely, pie and cake servers, serving trays, platters and bowls; bath towels, blanket throws, throws, and comforters; shower curtains.</p>	<p>electric items, namely, food blenders, food choppers, food grinders, juicers, knives, knife sharpeners, salt and pepper mills, coffee grinders; sterling silver tableware, namely, forks, knives, and spoons; flatware, namely, forks, knives, spoons and ice tongs; nutcrackers, and can openers; electric toasters, electric toaster ovens, electric convection ovens, electric coffee makers, electric espresso machines, electric panini grills, electric skillet, electric slow cookers; electric Christmas and holiday lights and lighted ornaments, for outdoor use; book lights; desk lamps, lamps, lamp shades; clocks; luggage, backpacks, key cases, baby carrying bags, carryalls, duffel bags, handbags, wallets; umbrellas; toiletry kits and cases, sold empty; kitchen gadgets and utensils namely, non-electric coffee makers, stirring spoons and spoon rests; barware, namely, beer mugs, pilsner glasses, beer and wine glasses, wine openers, martini shakers, seltzer bottles; cookware, namely, griddles, frying pans, pots, pans, steamers; coasters not of paper or table linen, namely drink coasters; napkin rings; vases; candle holders; toilet brush holders; garbage and laundry bins for domestic and household use.</p>
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<p><u>Claims:</u> Goods (1) and (2) are based on use and registration in the United States (under Nos. 3,931,369 and 4,214,225, respectively).</p>	<p><u>Claims:</u> Goods (1) are based on proposed use in Canada.</p>
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[2] The Governor and Company of Adventurers of England trading into Hudson’s Bay, also known as Hudson’s Bay Company (the Opponent) has opposed these applications on the basis that the Mark is confusing with its family of trademarks that are composed of or comprise the terms HUDSON’S BAY and which are registered in association with a variety of goods (collectively, the Opponent’s HUDSON’S BAY Trademarks or the Opponent’s Registered Trademarks, listed in Schedule A below). The Opponent has further challenged the applications on the basis that they do not conform to section 30(i) of the *Trademarks Act*, RSC 1985, c T-13 (the Act), that the Applicant could not have been satisfied it was entitled to use the Mark in Canada, and that the Mark is not distinctive of the Applicant.

[3] At the outset, I note that numerous amendments to the Act came into force on June 17, 2019. All references herein 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 which provides that section 38(2) of the Act, as it read prior to June 17, 2019, applies to applications advertised before that date].

[4] For the reasons that follow, each opposition is rejected.

APPLICATION NO. 1,562,486

[5] I will first consider the Opponent’s opposition to application No. 1,562,486.

File record

[6] Application No. 1,562,486 was filed on February 2, 2012 and advertised for opposition purposes in the *Trademarks Journal* on May 21, 2014. On October 15, 2014, the Opponent filed a statement of opposition which was subsequently amended on September 9, 2015.

[7] The grounds of opposition can be summarized as follows:

- (a) The application does not comply with the requirements of section 30(i) of the Act because the Applicant could not have been satisfied it was entitled to use the Mark:
 - (i) as it knew, or ought to have known, of the Opponent's prior rights in and to the Opponent's Registered Trademarks; and
 - (ii) since such use would have the effect of depreciating the goodwill attaching to the Opponent's Registered Trademarks.
- (b) The Mark is not registrable pursuant to section 12(1)(d) of the Act because it is confusing with one or more of the Opponent's Registered Trademarks.
- (c) The Applicant is not the person entitled to register the Mark pursuant to section 16(2)(a) of the Act because it was confusing with the trademark HUDSON NORTH, which has been previously used by the Opponent in Canada in association with men's clothing and accessories.
- (d) The Applicant is not the person entitled to register the Mark pursuant to section 16(2)(c) of the Act because it was confusing with the trade name HUDSON'S BAY COMPANY previously used by the Opponent in Canada.
- (e) The Mark is not distinctive pursuant to section 2 of the Act, because it does not distinguish and is not adapted to distinguish the Applicant's Goods from the Opponent's goods and services, given the Opponent's HUDSON'S BAY Trademarks.

[8] The Applicant filed and served a counter statement denying each allegation contained in the statement of opposition.

[9] In support of its opposition, the Opponent filed the affidavit of Paul Karvanis, Legal Counsel of the Opponent, sworn September 17, 2015. As Mr. Karvanis was no longer employed with the Opponent and could not be made available for cross-examination, his affidavit was substituted by the affidavit of Stephen Lawson, Director, Senior Counsel of the Opponent, sworn September 6, 2016. Under similar circumstances, Mr. Lawson's affidavit was later substituted by the affidavit of Amber Fundytus, Collections Specialist, HBC Heritage Department of the

Opponent, sworn April 26, 2017 (the Fundytus affidavit). Ms. Fundytus was cross-examined on her affidavit and the transcript of her cross-examination forms part of the record.

[10] The Opponent also filed the affidavit of Tina Campagna, a legal administrative assistant employed by the Opponent's trademark agents, sworn September 17, 2015 (the Campagna affidavit), which introduces into evidence certified copies of the registrations for each of the Opponent's Registered Trademarks. Ms. Campagna was not cross-examined on her affidavit.

[11] In support of its application, the Applicant filed the affidavit of Tierney Deluzio, an articling student employed by the Applicant's trademark agents, sworn September 12, 2017 (the Deluzio affidavit). The Deluzio affidavit introduces into evidence the results of various online searches conducted in association with the term HUDSON, which the Applicant argues establishes dilution of HUDSON marks in Canada due to the common use of this term by third parties. Ms. Deluzio was cross-examined on her affidavit and the transcript of her cross-examination also forms part of the record.

[12] Both parties filed a written argument; no hearing was held.

Onus and material dates

[13] 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 [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD)]. If this burden is met, the Applicant then bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act.

[14] The material dates with respect to the grounds of opposition are as follows:

- Sections 38(2)(a) and 30 of the Act – the filing date of the application, namely, February 2, 2012 [*Tower Conference Management Co v Canadian Exhibition Management Inc*, (1990) 28 CPR (3d) 428 at 432 (TMOB)];

- Sections 38(2)(b) and 12(1)(d) of the Act – the date of my decision [*Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)];
- Sections 38(2)(c) and 16 of the Act – the filing date of the application, namely, February 2, 2012 [section 16(2) of the Act]; and
- Sections 38(2)(d) and 2 of the Act – the filing date of the opposition, namely, October 15, 2014 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185].

Analysis of the grounds of opposition

[15] The grounds of opposition mainly turn on the issue of whether there is a likelihood of confusion between the Mark and the Opponent's relied upon trademarks and trade name. In this regard, as a preliminary matter, I note that a number of the Opponent's submissions on the subject of confusion [see for example paras 46, 52, 56 and 61 of the Opponent's written argument] refer to and sometimes heavily rely on its alleged use of the unregistered trademarks HUDSON'S BAY COLLECTION and/or HBC COLLECTION. Considering that neither of these marks were pleaded in the statement of opposition and that it is questionable if the adduced evidence even properly establishes their use, they cannot be relied upon as a ground of opposition and will not be further discussed.

[16] That being said, I will now assess the grounds of opposition in an order similar to that in which they are pleaded in the parties' written representations.

Section 12(1)(d)

[17] An opponent meets its initial onus with respect to a section 12(1)(d) ground of opposition if the registration relied upon is in good standing. In this regard, the Registrar has the discretion to check the register in order to confirm the existence of the relied upon registration [*Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Having exercised the Registrar's discretion, I confirm that registration Nos. TMDA19576, TMDA36211, TMDA9553, TMA242,822, TMA247,456, TMA248,086, TMA366,997, TMA401,655, TMA419,694, TMA431,353, TMA443,526,

TMA610,671, TMA667,459, TMA667,885, TMA879,619, TMA899,461, TMA899,463 and TMA899,464 are extant. My review of the register also shows that, following a change of name, the owner of all these registrations is currently identified as Hudson's Bay Company ULC.

[18] I will focus my analysis on the trademark HUDSON'S BAY (TMA366,997 and TMA401,655) as I consider it to represent the Opponent's strongest case. In other words, if confusion is not likely between the Mark and this trademark, then it would not be likely between the Mark and any other of the Opponent's Registered Trademarks.

Test for confusion

[19] The test to determine the issue of confusion is set out in section 6(2) of the Act which stipulates that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely 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 or appear in the same class of the Nice Classification. Therefore, section 6(2) of the Act does not concern confusion of the trademarks themselves, but confusion of the goods or services from one source as being from another.

[20] In applying the test for confusion, I must take into consideration all the relevant surrounding circumstances, including those listed 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 they 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 trademarks including in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and different weight will be given to each one in a context-specific assessment [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 where the Supreme Court of Canada states at para 49 that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

[21] In my view, the degree of resemblance between the parties' trademarks is the determining factor in the case at hand. As such, I will consider this factor first.

Degree of resemblance

[22] This factor strongly favours the Applicant as I find that, when they are considered as a whole, the parties' trademarks are decidedly more different than alike.

[23] The trademarks resemble each other to the extent that they share the word HUDSON and could both suggest the idea of a location (that is Hudson Bay – an inland sea in northeastern Canada – in the Opponent's case, and a park named Hudson in the Applicant's case). That being said, HUDSON does not strike me as being the single dominant feature of either one of the parties' trademarks. The trademark HUDSON'S BAY will likely be considered as a unitary phrase, as I believe will be the case for the HUDSON PARK element in the trademark HUDSON PARK COLLECTION. In other words, the striking aspect of the Opponent's trademark is the phrase HUDSON'S BAY as a whole, whereas the striking or unique aspect of the Mark is HUDSON PARK. Further, the trademarks are not similarly structured (given the lack of the possessive form and the presence of an additional word in the Mark) which makes them visually and aurally different. In my view, there is also a conceptual distinction as the Mark, when taken as a whole, arguably suggests the idea of a (seasonal) set of goods created as part of a specific HUDSON PARK-branded collection. HUDSON'S BAY on the other hand, arguably suggests either a geographical location or a well-known department store brand.

[24] When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality and not dissected into their component parts. Here, a focus on the individual part of the Mark, namely HUDSON, that is the same as the Opponent's trademark, appears to involve a side-by-side comparison of the type warned against by the courts.

Inherent distinctiveness and extent known

[25] With respect to the trademark HUDSON'S BAY, I find that it is not inherently distinctive because it is a geographical location, was admittedly chosen for that reason and in my view would be recognized by the average Canadian consumer as describing the Hudson Bay

area/location or at the very least would suggest a geographic link to same. [Applicant's written argument, paras 59-61; Fundytus affidavit, para 6; Fundytus cross-examination, Q 32-35]

[26] With respect to the Mark, despite the presence of the word COLLECTION which is descriptive in the context of the Applicant's goods, and considering that there is no evidence showing that HUDSON PARK is an actual place or that the average consumer would perceive it as such, the Mark has some measure of inherent distinctiveness when viewed as a whole.

[27] The strength of a trademark may be increased by it becoming known through promotion or use. The Applicant has not presented any evidence that its Mark has been used or become known to any extent in Canada. As for the Opponent, its evidence in this regard is comprised of the Fundytus affidavit.

[28] As mentioned above, at the time of her affidavit, Ms. Fundytus held the position of Collections Specialist, HBC Heritage Department of the Opponent. The HBC Heritage Department is an internal department committed to the preservation, education and promotion of the Opponent's history and the ongoing care and maintenance of its historical corporate art, artifact, image and reference collections. I note that Ms. Fundytus' position involves working with archival and historical records, as well as with some of the Opponent's more current records (such as annual reports). [para 1; Fundytus cross-examination, Q 6-12, Q18-19]

[29] The most salient portions of her evidence are outlined below.

- The Opponent is a publicly-traded Canadian corporation, with a head office in Toronto, Ontario. [para 3]
- Ms. Fundytus provides historical information relating to the origins of the Opponent. It is North America's oldest continuously operated corporation being a direct descendant of a joint-stock trading company created in London in 1670 by Royal Charter, which granted the land drained by rivers running into Hudson's Bay to "the Governor and Company of Adventurers of England trading into Hudson's Bay." From 1670 to about 1770, the Opponent conducted a fur-trade business from posts along the shores of James Bay and Hudson Bay. [para 6]

- The Opponent bartered blankets, weapons, foodstuffs and other trade goods to trappers, in exchange for furs. Referring to two books published on the subject in Canada and to the Opponent's archived business records, Ms. Fundytus provides a detailed history of the Opponent's wool blankets, known as "point blankets". Ms. Fundytus explains that the Opponent engaged Harold Tichenor to produce a book published in 2002 titled *The Blanket: An Illustrated History of the Hudson's Bay Blanket*. A copy of this book, which Ms. Fundytus affirms is still being sold, in both English- and French-language versions in certain HUDSON'S BAY stores, is attached as Exhibit B to her affidavit. In 2002, Mr. Tichenor also published a book called *The Collector's Guide to Point Blankets of the Hudson's Bay Company and other companies trading in North America*. A photocopy of this book is attached as Exhibit C to Ms. Fundytus' affidavit. [paras 6, 13-22, 33-34; Exhibits B, C and Q; some examples of early advertisements of the point blankets and in store displays are depicted in Exhibit B at pp. 39, 48, 49 and 70; sales information for the point blankets is depicted in the archived business records attached as Exhibit Q]
- In the late 1770s, the Opponent expanded into the interior of the North American continent. Various changes in its structure and operations followed over the years and eventually the Opponent began modernising its retail operations. Between 1913-1926, it opened the "original six" HUDSON'S BAY department stores in Victoria, Vancouver, Edmonton, Calgary, Saskatoon and Winnipeg. Substantial expansion beyond the original six stores did not take place until the early 1960s and culminated in the relocation of the Opponent's head office from London, England to Canada in 1970. [paras 6-10]
- HUDSON'S BAY is Canada's most prominent department store, with approximately 90 locations (found in all of Canada's major population centers and in seven provinces in Canada), two outlet stores and an online sales channel at www.thebay.com. The Opponent's leading "banners" are Hudson's Bay, Lord & Taylor, Saks Fifth Avenue, Saks Fifth Avenue OFF 5TH and Home Outfitters. Sold through the Opponent's brick-and-mortar and online distribution channels are clothing, fashion accessories, footwear, bedding and associated goods, home furnishings, goods for bath and kitchen, serving ware, china and dinnerware, electronics and a variety of other goods and retail services. [paras 4-6, 12 and 32]

- Ms. Fundytus states that HUDSON’S BAY and HUDSON’S BAY COMPANY branded goods and services are sold in Canada through the Opponent’s department stores and globally through various websites, including *www.thebay.com* as well as through the Opponent’s wholesaler, Standard Apparel [paras 26-27, Exhibits I-K]. She then goes on to provide some sales information relating to goods bearing one or more of the Opponent’s relied-upon trademarks, such as bedding, blankets and throws, clothes, furniture, etc. including photographs and website printouts of sample products. [paras 28-32, Exhibits L-P]
- In terms of revenue, Ms. Fundytus provides a 2014 annual report indicating that retail sales for the Opponent and its affiliates total over \$8 billion in 2014, including revenue from online sales channels at *www.thebay.com*. [paras 4-5, Exhibit A]
- With respect to yearly sales of goods “bear[ing] a tag or label with the words HUDSON’S BAY and/or HUDSON’S BAY COMPANY” across Canada, Ms. Fundytus states that since fiscal year 2011, they have never been less than \$7.25 million. She further states that in each fiscal year 2012 and 2013, such sales increased by more than 10% and that total sales of these goods in fiscal year 2014 were just below \$12 million. [para 28]
- Ms. Fundytus states that in each of fiscal years 2012-2014, the Opponent has had over 3 million unique customers who have made purchases using either a “HUDSON’S BAY-branded credit card or a HUDSON’S BAY reward account (or both)” and that sales to those customers represent approximately 60% of the Opponent’s total sales in each of those fiscal years [para 42].
- Specifically with respect to point blankets, Ms. Fundytus states that since 2011, annual sales of HUDSON’S BAY point blankets and throws have not fallen below \$3 million a year. In fiscal year 2014, sales of the point blankets totalled \$4.5 million. As of September 21, 2015, there were seven different styles of the point blanket and 19 styles of throws for sale on the Opponent’s website at *www.thebay.com* [para 21, Exhibit E].

- Ms. Fundytus states that the Opponent has advertised its business, goods and services in Canada for well over a century. More specifically, she states that it has spent over \$1.1 billion on marketing and advertising in Canada between 2004-2014. The Opponent advertises through newspapers, television, radio, magazines, outdoor advertising, direct mail and Internet advertising. It also advertises through sponsorship at events such as the Toronto International Film Festival. Ms. Fundytus provides advertising particulars, some of which are historical and some are more recent (for example, there are magazine spreads and newspaper articles from the 1960s through the 2000s as well as a 2015 flyer and newspaper advertisements). [paras 17, 19-20, 35-43, Exhibits B, R-V]
- With respect to the Opponent’s online presence, Ms. Fundytus states that the Opponent has successfully bid on a wide range of search terms that include “Hudson” as a root word and that its online advertisements generated over 1 billion impressions in 2014 as well as over 20 million click-throughs to the Opponent’s website. Ms. Fundytus further states that the Opponent’s “retail websites (*www.thebay.com*, *www.labaie.com*, and mobile sites)” were visited over 80 million times in 2014 [paras 44-45].
- Ms. Fundytus also discusses the Opponent’s educational and charitable activities in Canada, such as donations of its records to a public archive, the creation and work of the HBC Foundation, the Hudson’s Bay Company History Foundation, the HBC Education Program, and a partnership with the Canadian Olympic Committee [paras 46-51, Exhibits W-Z].

[30] The Applicant takes issue with most of the sales and advertising information provided by Ms. Fundytus.

[31] With respect to the total retail sales for the Opponent and its affiliates, while I note that the 2014 annual report includes segmented reporting summarizing retail sales by geographic area which shows over \$2.8 billion in Canadian sales [Exhibit A, p. F-49, Note 26], the Applicant rightly points out that there is no breakdown of sales relating to the Hudson’s Bay banner specifically (given that the affiliates are the other banners referenced above (e.g. Home Outfitters)) or relating to a particular class of goods. [Applicant’s written argument, para 14; Fundytus affidavit, paras 4-5, Exhibit A; Fundytus cross-examination Q24-28]

[32] With respect to the sales of goods “bear[ing] a tag or label with the words HUDSON’S BAY and/or HUDSON’S BAY COMPANY”, the Applicant submits that they are inadmissible hearsay and should be given little to no weight as Ms. Fundytus had never seen the corresponding sales information anywhere other than when the Karvanis and Lawson affidavits (the Opponent’s prior withdrawn affidavits) were shown to her, as she is not employed in any finance, marketing or sales function, does not look at internal sales, advertising or marketing information or documents and her role as part of the Heritage Department is instead restricted to externally published documents. For similar reasons, the Applicant also objects to the more recent advertising information provided by Ms. Fundytus (including advertising expenditures, number of customers impressions, website visits and click-throughs). [Applicant’s written argument, paras 19-21; Fundytus affidavit, paras 28, 39, 42, 44-45; Fundytus cross-examination Q61-64, Q69-85]

[33] There are hearsay issues with some of Ms. Fundytus’ statements relative to the Opponent’s sales and advertising. Be that as it may, while the weight afforded to her evidence would have been far greater in different circumstances (such as if Ms. Fundytus had also consulted contemporary internal records outside of the exhibits in the preparation of her affidavit), and despite the deficiencies that it contains, I am satisfied that a fair review of the whole of her evidence (including the Opponent’s long history of use) establishes that the Opponent’s HUDSON’S BAY trademark has a significant degree of acquired distinctiveness, at least in association with point blankets and the operation of a Canada-wide department store.

[34] Accordingly, although the inherent distinctiveness factor here somewhat favours the Applicant, only the Opponent’s trademark has become known in a way to acquire distinctiveness.

Length of time in use

[35] In view of the above, the length of time the trademarks have been in use favours the Opponent.

Goods, services or business and nature of the trade

[36] The Opponent's trademark HUDSON'S BAY is registered in association with the goods and services identified in Schedule C below.

[37] I do not believe that it is necessary to lengthily discuss these factors, especially in view of my overall conclusion regarding the likelihood of confusion below. Suffice it to say that they favour the Opponent as there is direct overlap in respect of the parties' blankets and throws. Further, while the nature of its business and trade is not in evidence, the Applicant has admitted in its submissions that the parties are competitors and sell similar products [Applicant's written argument, para 67].

Additional surrounding circumstance – Third party use of HUDSON

[38] Relying on the Fundytus cross-examination and the Deluzio affidavit, the Applicant submits that there is widespread third party advertising and use of the term HUDSON in the Canadian marketplace in association with various houseware, furniture and bedding products and, as such, this is a surrounding circumstance which significantly favours it.

[39] During her cross-examination, Ms. Fundytus was shown printouts from the Opponent's website (*www.thebay.com*) of third party products containing the term HUDSON in the description (which she recognized and confirmed were third party products), as summarized by the Applicant in the bullet list below. Ms. Fundytus also indicated that she is not aware of any internal policy of the Opponent against selling third-party "Hudson" products in its stores.

- Hudson Chair; Hudson Sofa
- Pleasant Hearth Hudson Steel Fire Pit
- Kluft Hudson Luxury Firm Mattress
- Natura Hudson II Mattress
- Hudson jeans; Vince Camuto Hudson Braid Booties
- Rag & Bone/Jean Hudson Long Sleeve Knit Top
- Free People Hudson Linen Blend Tank Top

[Applicant's written argument, para 22; Fundytus cross-examination, Q89-108, Exhibits A-G, response to undertaking Q100]

[40] Printouts from third party websites advertising products or services in association with the term HUDSON were also presented to Ms. Fundytus, and an undertaking was given to advise whether the identified entities were affiliated with the Opponent and whether it has taken any steps to prevent the sale of these third party "Hudson" products. The response was that the Opponent is not affiliated with any of the entities and is not aware of any steps taken against them in respect of any "Hudson" products. [Applicant's written argument, para 23; Fundytus cross-examination, Q117-120, response to undertaking Q117-120]

[41] As for the Deluzio affidavit, as mentioned above, it includes third party website screenshots and archived versions of same depicting various "Hudson" products.

[42] According to the Applicant, there are over 30 businesses in Canada making use of the name, over 1000 different products noted containing the term "Hudson", as well as three businesses that have HUDSON or HUDSON'S as part of their name [Applicant's written argument, paras 24-27, 52-56, Schedule B; Deluzio Affidavit, para 2, Exhibit A].

[43] According to the Opponent, Ms. Deluzio's search results are largely irrelevant, notably because Ms. Deluzio did not make purchases of any products, she did not verify whether all the "Hudson" products were available or whether any of them could actually be purchased in Canada, and because she did not know if any sales had been made in Canada of any of the "Hudson" products located or the extent of such sales [Opponent's written argument, paras 29-33; Deluzio cross-examination, Q50-56 and Q60-107].

[44] Hearsay and deficiencies aside, I find that the Deluzio affidavit is of some relevance to the instant case to the extent that it shows multiple third party offerings of HUDSON-branded goods at the time that Ms. Deluzio performed her searches. Be that as it may, I do not believe that it is necessary to undergo a detailed review of Ms. Deluzio's search results in view of my overall conclusion regarding the likelihood of confusion below.

Additional surrounding circumstance – Fame of the Opponent’s HUDSON’S BAY Trademarks

[45] The Opponent pleads that it has a family of HUDSON’S BAY marks, that these trademarks are famous and that therefore they are deserving of a broad scope of protection.

[46] Where there is a family of trademarks, there may be a greater likelihood that the public would consider a similar trademark to be another trademark in the family and consequently, assume that the product or service that is associated with that trademark is manufactured or performed by the same person. There is, however, no presumption of the existence of a family of marks in opposition proceedings. In order to be able to benefit of the broader scope of protection afforded to a family of trademarks, the Opponent must first establish use of each mark comprised in its alleged family.

[47] The Opponent’s trademarks that contain the word HUDSON or the words HUDSON’S BAY (including its relied upon trademarks under this ground) are set out in the Fundytus affidavit. Corresponding certified copies are provided in the Campagna affidavit. As mentioned above, in her affidavit, Ms. Fundytus also discusses sales information relating to goods bearing one or more of the family of HUDSON’S BAY containing marks. [Fundytus affidavit, paras 23 and 26-32, Exhibits F and G; Campagna affidavit, Exhibit A]

[48] I however note that the bulk of the Opponent’s pleadings and evidence deal with the family of HUDSON’S BAY marks as a whole rather than with each of the individual trademarks included therein (for example, whatever sales or advertising information is provided by Ms. Fundytus, it is not broken down by the Opponent’s different relied-upon trademarks included in the alleged family of marks but rather consists of aggregate figures). What is more, on cross-examination, Ms. Fundytus indicated that several of the trademarks listed in Exhibit F to her affidavit are not used. [Fundytus affidavit, para 23, Fundytus cross-examination, Q50-51 and Q54-59]

[49] Accordingly, I do not consider this to be a case where the Opponent may effectively assert a family of trademarks.

[50] That being said, to the extent that the Opponent has shown longstanding use of the mark HUDSON'S BAY throughout Canada, I accept that this trademark is well-known in association with point blankets and the operation of a department store. In this regard, relying on *Adidas AG v Globe International Nominees Pty Ltd*, 2015 FC 443, at paras 63-64, the Applicant argues that fame is a double-edged sword given that when a trademark becomes well-known or famous to the point that the public readily identifies that mark, it may follow that even as a matter of first impression, any differences with another mark used on the same goods may serve to distinguish and reduce the likelihood of the confusion. I would not go as far as to agree with this contention, particularly in light of the Registrar's comments in *RE/MAX, LLC v GMAX WORLD REALTY INC*, 2017 TMOB 126 at para 153. I will however note that I do not consider this to be dispositive of the issue of confusion, nor do I consider it as determining a factor as the assessment of the degree of resemblance between the trademarks discussed above.

Conclusion regarding likelihood of confusion

[51] In view of the above and notwithstanding the Opponent's longstanding history of use, I find that the Applicant has met its onus to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the trademark HUDSON'S BAY relied upon by the Opponent. I reach this conclusion mainly as I find that the lack of resemblance between the trademarks at hand outweighs the overlap with respect to the parties' goods, businesses and their channels of trade.

[52] I will add that my conclusion regarding the likelihood of confusion would remain unchanged even had I considered any other of the Opponent's Registered Trademarks in my assessment of this ground of opposition as they are even more different than the Mark. Similarly, it would likely remain unchanged even had the Opponent actually established a family of HUDSON'S BAY trademarks or had I considered confusion as against the Opponent's purported family of HUDSON'S BAY trademarks as a whole.

[53] Accordingly, the section 12(1)(d) ground of opposition is rejected.

Sections 16(2) and 2

[54] As mentioned above, these grounds also turn on the issue of confusion. The non-entitlement grounds of opposition rely on the Opponent's prior use of the trademark HUDSON NORTH and the trade name HUDSON'S BAY COMPANY. The non-distinctiveness ground of opposition relies on the Opponent's Registered Trademarks.

[55] Seeing that the Opponent was not successful under the section 12(1)(d) ground of opposition, it will also not succeed under the section 16(2)(c) and section 2 grounds as they rely on the same trademarks and a very similar trade name. The same goes for the section 16(2)(a) ground where for reasons analogous to those discussed above, I reach the same conclusion with respect to the likelihood of confusion as under the section 12(1)(d) ground of opposition. Specifically, even were I to consider Ms. Fundytus' evidence as sufficient to meet the low threshold for the Opponent's burden under the section 16(2)(a) ground of opposition (which is questionable), I would nonetheless find, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's HUDSON NORTH trademark (mainly as I find that the degree of resemblance factor still strongly favours the Applicant despite some differences in the Opponent's aforementioned mark, and considering the different nature of goods at issue (textile goods and furniture versus men's clothing and accessories)). The difference in material dates here has no significant impact on my overall conclusion regarding likelihood of confusion.

Section 30(i)

[56] The first prong of this ground of opposition fails because mere knowledge of the existence of the Opponent's Registered Trademarks or confusion with the Opponent's Registered Trademarks alone, does not support the allegation that Applicant could not have been satisfied of its entitlement to use the Mark. Where an applicant has provided the necessary statement, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith. The application for the Mark contains the required statement and the evidence adduced does not demonstrate that this is an exceptional case.

[57] The second prong of this ground of opposition fails because the Opponent has not met its initial evidential burden with respect to its allegation that the Applicant could not be satisfied it was entitled to use the Mark in view of a combination of section 30(i) with section 22(1) of the Act. For example, there is no evidence of actual use of the Mark in Canada in association with any goods or services. Also, I am not satisfied that the Mark is sufficiently similar to any of the Opponent's relied upon trademarks or that the evidence establishes that there would be a mental association or linkage between any of the Opponent's relied upon trademarks and the Mark.

[58] Accordingly, the section 30(i) ground of opposition, in its entirety, is also rejected.

APPLICATION NO. 1,639,990

[59] Application No. 1,639,990 was filed on August 19, 2013 and advertised for opposition purposes in the *Trademarks Journal* on April 1, 2015. The application was opposed on June 1, 2015 and the statement of opposition submitted against it raises substantially the same grounds of opposition as those which were pleaded with respect to application No. 1,562,486. The main variation in terms of pleadings is with respect to the non-entitlement ground where the Opponent alleges non-entitlement pursuant to section 16(3)(b) based on confusion with its previously filed applications for trademarks that are composed of or comprise the terms HUDSON'S BAY in respect of its opposition to trademark application No. 1,639,990. The particulars of the applications relied upon by the Opponent are set out in Schedule B below. All in all though, this case essentially revolves around the likelihood of confusion between the Mark and the Opponent's HUDSON'S BAY-type trademarks and trade name. In other words, the issues, evidence (including transcripts of cross-examinations and answers to undertakings) and submissions regarding application No. 1,639,990 are analogous to those discussed with respect to application No. 1,562,486 and the difference in material dates here bears no significant impact on the assessment of the grounds of opposition.

[60] Accordingly, my findings above regarding the ground of opposition based upon non-compliance with section 30 apply *mutatis mutandis*. The same goes with respect to the grounds of opposition based upon non-registrability, non-entitlement and non-distinctiveness, where for reasons similar to those discussed above, I reach the same conclusion regarding the likelihood of confusion as for application No. 1,562,486.




DISPOSITION





[61] Having regard to the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the oppositions pursuant to section 38(12) of the Act.





Iana Alexova
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

The Opponent's Registered Trademarks



Trademark	Registration No.
<p>COMPAGNIE DE LA BAIE D'HUDSON & Design</p> 	TMA667,885
COUVERTURES A POINTS DE LA BAIE D'HUDSON	TMA247,456
HUDSON'S BAY	TMA366,997
HUDSON'S BAY	TMA401,655
HUDSON'S BAY CO.	TMA899,463
<p>HUDSON'S BAY CO.</p>  <p>HUDSON'S BAY CO.</p>	TMA899,461
<p>Hudson's Bay Co.</p>  <p>HUDSON'S BAY CO.</p>	TMA899,464
HUDSON'S BAY COMPANY	TMA879,619

<p>HUDSON'S BAY COMPANY & DESIGN</p> 	<p>TMA242,822</p>
<p>HUDSON'S BAY COMPANY & DESIGN</p>  <p>The Seal of Quality Le sceau de qualité</p>	<p>TMA248,086</p>
<p>HUDSON'S BAY COMPANY & DESIGN</p> 	<p>TMA419,694</p>
<p>HUDSON'S BAY COMPANY & DESIGN</p> 	<p>TMA431,353</p>

<p>HUDSON'S BAY COMPANY & Design</p> 	<p>TMA667,459</p>
<p>HUDSON'S BAY COMPANY, TWO STAGS AND SHIELD DESIGN</p>  <p>HUDSON'S BAY COMPANY,</p>	<p>TMDA9553</p>
<p>HUDSONS BAY "POINT"</p>	<p>TMDA36211</p>
<p>HUDSON'S BAY "POINT" BLANKETS & DESIGN</p> 	<p>TMDA19576</p>
<p>HUDSON'S BAY POINT BLANKET</p>	<p>TMA610,671</p>
<p>MARKET SQUARE HUDSON'S BAY COMPANY & DESIGN</p> 	<p>TMA443,526</p>

SCHEDULE B

The Opponent's prior pending applications

Trademark	Application No.
Logo 	1,605,247
Logo 	1,605,248
Logo HUDSON'S BAY	1,605,242
Logo HUDSON'S BAY	1,605,243
HUDSON'S BAY COMPANY TRADING POST	1,593,695
French Logo LA BAIE D'HUDSON	1,621,801

SCHEDULE C

Statement of services covered by registration No. TMA366,997

Operation of outlets dealing in: the retail distribution of general merchandise and food products.

The operation of an office relating to the wholesale distribution of food products (excluding the actual wholesale distribution of such products); wholesale distribution of food products.

Purchase and sale of raw furs.

Operation of an office relating to the purchase and sale of Inuit Art; purchase and sale of Inuit Art.

Operation of an office relating to the retail distribution of general merchandise and food products (excluding the actual retail distribution of such merchandise and products); the operation of an office relating to the purchase and sale of raw furs.

Statement of goods covered by registration No. TMA401,655

Blankets and decorative throws; blanket garments, namely jackets and coats for men and women; men's outer wear, namely, coats, parkas, jackets and shirts; women's outer wear, namely, coats, hats, parkas, jackets and shirts; women's sportswear, namely, blazers, shirts and pants; and sweaters.

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

No Hearing Held

AGENTS OF RECORD

All the trademark agents at OSLER, HOSKIN & HARCOURT LLP For the Opponent

All the trademark agents at SMART & BIGGAR LLP For the Applicant