

O P I C



C I P O

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 247

Date of Decision: 2021-11-15

IN THE MATTER OF AN OPPOSITION

Sherwood Homes Ltd.

Opponent

and

Sonia Tarabay

Applicant

**1,777,248 for Sonia Sells Sherwood Park
Homes! & Design**

Application

INTRODUCTION

[1] Sherwood Homes Ltd. (the Opponent) opposes registration of the trademark Sonia Sells Sherwood Park Homes! & Design (the Mark), which is the subject of application No. 1,777,248 by Sonia Tarabay (the Applicant). The Mark is shown below:



[2] The Mark is applied for on the basis of use in Canada since at least as early as January 2016 in association with “Real estate services”.

[3] The opposition is primarily based on an allegation that the Mark is confusing with the Opponent’s SHERWOOD HOMES trademark, previously used in Canada in association with real estate development and related services.

THE RECORD

[4] The application for the Mark was filed on April 13, 2016. The application includes the following disclaimer: “The right to the exclusive use of the words SHERWOOD PARK HOMES is disclaimed apart from the trade-mark.”

[5] The application also includes the following colour claim: “Colour is claimed as a feature of the trade-mark. The words ‘Sonia Sells’ are red, the words ‘Sherwood Park Homes!’ are black, and the leopard print patterned heart is black, light brown, and dark brown.”

[6] The application was advertised for opposition purposes on January 24, 2018. Numerous amendments to the *Trademarks Act*, RSC 1985, c T-13 (the Act) came into force on June 17, 2019. Pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read immediately before June 17, 2019, an exception being that, with respect to confusion, sections 6(2) to (4) of the Act as it currently reads will be applied.

[7] On June 25, 2018, the Opponent opposed the application by filing a statement of opposition under section 38 of the Act. The grounds of opposition are based on non-entitlement under section 16(1) of the Act, non-distinctiveness under section 2 of the Act, and non-compliance with section 30(i) of the Act.

[8] The Applicant filed a counter statement denying the grounds of opposition.

[9] In support of its opposition, the Opponent filed the affidavit of Tim Blevins, sworn November 30, 2018 in Cambridge, Ontario (the Blevins Affidavit).

[10] In support of its application, the Applicant filed the affidavit of Sonia Tarabay, sworn January 23, 2019 in Sherwood Park, Alberta (the Tarabay Affidavit).

[11] Neither affiant was cross-examined. Both parties submitted brief written representations. An oral hearing was not requested.

[12] Before assessing the grounds of opposition, I will first provide an overview of the parties’ evidence, the evidential burden on the Opponent, and the legal onus on the Applicant.

OVERVIEW OF THE OPPONENT'S EVIDENCE

Blevins Affidavit

[13] Mr. Blevins is the President of the Opponent [para 1]. He states that, since 1998, the Opponent “has engaged in the business of property and real estate development and the building of residential homes among many other services under its trademark SHERWOOD HOMES” [para 3]. On April 5, 2018, the Opponent filed an application for the trademark SHERWOOD HOMES [para 4, Exhibit B].

[14] As evidence of the Opponent’s use of the SHERWOOD HOMES trademark, Mr. Blevins attaches the following as Exhibit C to his affidavit:

- A listing of nine of the Opponent’s real estate projects, identifying the city location of the project and each project’s “First Closing” date. The project dates range from 1998 to 2010 and all projects appear to have been located in Ontario [para 5a];
- A site plan for the Opponent’s Georgian Meadows project from 2002 [para 5b];
- Samples of the Opponent’s advertisements relating to its real estate projects from 2007 [para 5c];
- Artwork for a sign used in connection with the Opponent’s Collingwood project from 2008 [para 5d];
- A copy of an Open House invitation used in connection with the Opponent’s Silver Glen Preserve project from 2010 [para 5e]; and
- A copy of the Opponent’s advertisement relating to its Silver Glen Preserve real estate project from 2014.

[15] I note that, throughout the exhibits, the Opponent’s trademark SHERWOOD HOMES is primarily displayed in the logo shown below, or in minor variations thereof:



[16] I also note that some of the exhibits display what appears to be the Opponent's website address, *www.SherwoodHomesLtd.com*.

OVERVIEW OF THE APPLICANT'S EVIDENCE

Tarabay Affidavit

[17] In her brief affidavit, Ms. Tarabay attests that she is a real estate agent operating in Sherwood Park, Alberta [para 2]. She states that she primarily assists clients in selling and purchasing residential properties in Sherwood Park [para 2]. She confirms that Sherwood Park is the location of her office and primary place of business [para 3]. Ms. Tarabay states that she has been offering the applied-for real estate services in association with the Mark since at least as early as January 2016, the claimed date of first use in the application [para 4]. Attached as Exhibit B to her affidavit is a photograph "distributed by the Applicant in advertising material used to promote [the Applicant's] services" [para 6]. The photograph is undated, but displays the Mark.

EVIDENTIAL BURDEN AND LEGAL ONUS

[18] In accordance with the usual rules of evidence, there is an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Ltd v Molson Companies Ltd*, 1990 CarswellNat 1053, 30 CPR (3d) 293 (FCTD)]. The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

[19] For those allegations for which the opponent has met its evidential burden, the legal onus is on the applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. The presence of a legal onus on an applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, then the issue must be decided against the applicant.

SECTION 16(1)(A) GROUND OF OPPOSITION – CONFUSING WITH A PREVIOUSLY USED TRADEMARK

[20] Per section 38(2)(c) of the Act, the Opponent pleads that the Applicant is not the person entitled to registration of the Mark. In particular, the Opponent pleads that at the date on which the Applicant first used the Mark, it was confusing with the Opponent’s trademark, SHERWOOD HOMES, which had been previously used in Canada by the Opponent in association with “property and real estate development, management, sales and rental; general contracting and building of residential homes, subdivisions and commercial properties, real estate brokerage services; plumbing; installation, repair and maintenance of electrical, heating, ventilating and air conditioning systems”, since at least as early as 1998.

[21] The material date with respect to confusion with a previously used trademark is the claimed date of first use in the application, being January 2016 in this case.

[22] I would first note that neither the Blevins Affidavit nor the Opponent’s written representations clearly correlate the evidenced exhibits with each of the services as pleaded. For example, one is left to speculate whether the pleaded “repair and maintenance of electrical, heating, ventilating and air conditioning systems” is one of the “many other services” Mr. Blevins alludes to at paragraph 3 of his affidavit. Nevertheless, at a minimum, I accept that the Opponent has demonstrated prior use of its trademark with respect to property and real estate development services. Indeed, the Applicant appears to concede this point [Applicant’s written representations at para 8] and I consider prior use with respect to such services to represent the Opponent’s strongest case in any event.

[23] Accordingly, at a minimum, the Opponent meets its evidential burden under this ground with respect to such services. Therefore, the Applicant must establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent’s SHERWOOD HOMES trademark.

Test to determine confusion

[24] The test to determine the issue of confusion is set out in section 6(2) of the Act which provides 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 or appear in the same class of the Nice Classification.

[25] The test to be applied is a matter of first impression in the mind of a casual consumer “somewhat in a hurry” who sees the Mark in association with the applied-for services at a time when they have no more than an imperfect recollection of the Opponent’s trademark and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[26] In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them.

[27] The criteria or factors in section 6(5) of the Act are not exhaustive and different weight will be given to each one in a context-specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, 1 SCR 772 at para 54]. In *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361, the Supreme Court of Canada stated that section 6(5)(e), the resemblance between the trademarks, will often have the greatest effect on the confusion analysis [at para 49] and that, while the first word in the trademark may be the most important in some cases, the preferable approach is to consider whether there is an aspect of the trademark that is particularly “striking or unique” [at para 66].

Inherent Distinctiveness and the Extent Known

[28] In its brief written representations, the Opponent essentially reiterates its pleading, noting that i) the Mark incorporates both the words SHERWOOD and HOMES, and ii) the Mark is used in the same field of business as that associated with the Opponent’s trademark [paras 3 and 4].

[29] In its written representations, the Applicant first notes that the Opponent’s trademark “consists simply of the term SHERWOOD HOMES”. It submits that, while no evidence has been provided on the topic, “it is generally understood that the word SHERWOOD is a

surname”, and further notes that the word HOMES is generic with respect to the Opponent’s services [para 7].

[30] With respect to the extent to which the Opponent’s trademark has become known, although the Applicant concedes the Opponent’s evidence of use since 1998, it submits that the evidence of use appears limited and further notes that the Opponent has not argued that the Opponent’s SHERWOOD HOMES trademark has acquired any significant degree of distinctiveness [para 8].

[31] In contrast, the Applicant notes that the Mark is a logo that incorporates the words SONIA SELLS SHERWOOD PARK HOMES, with the words SONIA SELLS in a large font relative to the disclaimed words SHERWOOD PARK HOMES. In this respect, the Applicant notes that Sherwood Park is a municipality in Alberta, in which the Applicant offers her services [para 10, referencing the Tarabay Affidavit at para 2].

[32] Otherwise, although Ms. Tarabay asserts use of the Mark since January 2016 and evidenced an advertisement [paras 4 and 6, Exhibit B], there is no evidence as to the extent to which the Mark had become known as of that material date or otherwise.

[33] While neither party evidenced the meaning of SHERWOOD *per se*, the Registrar may take judicial notice of dictionary terms [*Tradall SA v Devil’s Martini Inc*, 2011 TMOB 65]. In this case, I note the following definitions of SHERWOOD:

Sherwood (biographical name): Robert Emmet [Sherwood] 1896-1955 American dramatist [*merriam.webster.com*]

Sherwood: 1) Robert Emmet [Sherwood] 1896-1955, U.S. dramatist; 2) a town in central Arkansas; 3) a male given name [*dictionary.com*]

[34] The reference to the dramatist Robert Emmet Sherwood would seem to support the Applicant’s submission that SHERWOOD is a surname. I would also note the *Merriam-Webster* definition of *Sherwood Forest* as a “forest of central England chiefly in Nottinghamshire” with the following note: “Sherwood Forest was an ancient royal hunting ground and is associated with the legendary outlaw Robin Hood” [*merriam-webster.com*].

[35] In view of the foregoing, I do not consider the Opponent's SHERWOOD HOMES trademark to have a high degree of inherent distinctiveness. In contrast, the Mark is a combination of various elements that, at least in combination, results in a trademark that has a high degree of inherent distinctiveness.

[36] While there is some evidence of use of the Opponent's trademark, I agree with the Applicant that such evidence is limited and that, overall, this factor favours the Applicant.

Length of Time in Use

[37] The Opponent has evidenced use of its SHERWOOD HOMES trademark since 1998, whereas the Applicant has used the Mark only since January 2016, which is the material date under this ground.

[38] Accordingly, this factor favours the Opponent.

Nature of the Services or Business / Nature of the Trade

[39] In its representations, although the Applicant acknowledges that both parties' services "relate to residential properties", the Applicant submits that the Opponent "has not provided any evidence or argument as to whether an ordinary consumer would expect real estate services to be related to [the Opponent's] property development services" and further that the Opponent "has failed to establish that the nature of the services would be considered similar by an ordinary consumer" [paras 14 and 15].

[40] However, as the Opponent has met its initial burden under this ground, the onus is on the Applicant. While the nature of the parties' services, businesses and trades differ to some degree in that the Applicant is an Alberta-based real estate agent and the Opponent is an Ontario-based property developer, both deal in the sale of residential real estate.

[41] Accordingly, at a minimum, I accept there is the potential for overlap in the nature of the parties' services, businesses, and channels of trade to some extent.

[42] Accordingly, these factors favour the Opponent.

Degree of Resemblance

[43] In its representations, the Applicant submits that the striking or distinctive elements of the Mark are the stylized words SONIA SELLS and the leopard-print patterned heart, neither of which are reflected in the Opponent's trademark. Furthermore, the Applicant submits that an ordinary consumer "would recognize a significant difference between SHERWOOD HOMES and SHERWOOD PARK HOMES, in that SHERWOOD PARK is a municipality and would therefore be considered as a whole" [para 13].

[44] I agree with the Applicant that, considered in the context of the trademarks as a whole, the parties' trademarks have a low degree of resemblance in appearance, when sounded and in ideas suggested.

[45] I would also note that – although the Applicant appears to concede that the Opponent has evidenced prior use of the Opponent's SHERWOOD HOMES word mark – to the extent that the trees in the Opponent's SHERWOOD HOMES logo invokes the idea of Sherwood Forest, this idea is not reflected in the Mark.

[46] Accordingly, this factor favours the Applicant.

Conclusion – Confusion with the Opponent's Trademark

[47] As mentioned above, the degree of resemblance between the parties' trademarks is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

[48] Having considered all of the surrounding circumstances, I find that the Applicant has met its legal burden with respect to the likelihood of confusion between the parties' trademarks. I reach this conclusion due to the low degree of resemblance between the trademarks and the low inherent distinctiveness of the shared elements SHERWOOD and HOMES, and notwithstanding the length of time in use of the Opponent's trademark and the potential overlap in the nature of the parties' services and trades.

[49] In view of the foregoing, the section 16 ground of opposition based on confusion with the Opponent's SHERWOOD HOMES trademark is rejected.

SECTION 2 GROUND OF OPPOSITION – NON-DISTINCTIVENESS

[50] Per section 38(2)(d) of the Act, the Opponent pleads that the Mark is not distinctive within the meaning of section 2 of the Act, in that it does not actually distinguish nor is it adapted to distinguish the services in association with which it is used by the Applicant from the goods and services of others, including the services of the Opponent as associated with the Opponent’s SHERWOOD HOMES trademark.

[51] The material date for this ground is the filing date of the opposition, June 25, 2018 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

[52] Section 2 of the Act, as it then was, defined “distinctive” as follows:

distinctive, in relation to a trademark, means a trademark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or is adapted so to distinguish them.

[53] A trademark “actually distinguishes” by acquiring distinctiveness through use, resulting in distinctiveness in fact. On the other hand, a trademark that is “adapted so to distinguish” is one that does not depend upon use for its distinctiveness because it is inherently distinctive [see *Astrazeneca AB v Novopharm Ltd*, 2003 FCA 57 at para 16].

[54] In its written representations, the Opponent essentially reiterates its pleading [para 5].

[55] In its written representations, the Applicant submits that the Opponent has not provided any evidence or arguments in support of its bare assertion that the Mark is not distinctive, and therefore the Opponent has failed to meet its burden [para 18]. In the alternative, the Applicant submits that the Mark contains elements with inherent distinctiveness and that, at least on this basis, the Mark is distinctive within the meaning of section 2 of the Act [para 19].

[56] As noted above, there is an evidential burden on the Opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Ltd, supra*]. In this case, there is no evidence with respect to the trademarks or services of any “others”, as referenced in the pleading. Accordingly, the initial burden is on the Opponent to prove that, as of the material date, its trademark was known to some extent in Canada in association with the relevant services

and had a reputation in Canada that was “substantial, significant or sufficient” so as to negate the distinctiveness of the Mark [see *Bojangles’ International, LLC v Bojangles Café Ltd*, 2006 FC 657 at paras 33 and 34; and *Ontario Dental Assistants Association v Canadian Dental Association*, 2013 FC 266 at para 42, aff’d 2013 FCA 279]. In *Suzanne’s Inc v Auld Phillips Ltd*, 2005 FCA 429, in the context of an expungement proceeding under section 57 of the Act, the Federal Court of Appeal stated that “Obviously, it will be a rare occurrence when one party is in a position to cause a mark to lose its distinctiveness, but nothing in principle prevents this result” [at para 7].

[57] In this case, while there is some evidence of use of the Opponent’s trademark as of the material date, I note that, at best, any use appears limited to certain municipalities in Ontario. However, it is clear that the Blevins Affidavit does not evidence substantial, significant or sufficient reputation in the Opponent’s SHERWOOD HOMES trademark so as to negate the inherent distinctiveness of the Mark.

[58] In any event, to the extent this ground in part ultimately turns on the issue of confusion, I would come to the same conclusion as above with respect to the section 16 ground, notwithstanding the later material date.

[59] Accordingly, the section 2 ground of opposition is rejected.

SECTION 30 GROUND OF OPPOSITION – NON-COMPLIANCE

[60] Per section 38(2)(a) of the Act, the Opponent pleads that the application does not conform to the requirements of section 30 of the Act. In particular, the Opponent pleads that the Applicant could not have been satisfied that it is entitled to use the Mark in Canada in association with the applied-for services, since at the date of filing, the Applicant was or should have been aware of the Opponent’s SHERWOOD HOMES trademark, with which the Mark is confusing.

[61] The Opponent submitted no evidence in support of this ground. In its written representations, the Opponent essentially reiterates its pleading, again noting that i) the Mark incorporates both the words SHERWOOD and HOMES, and ii) the Mark is used in the same field of business as that associated with the Opponent’s trademark [para 3].

[62] Section 30(i) of the Act, as it then was, merely required that an applicant include a statement in its application that it is satisfied that it is entitled to use its trademark in Canada in association with the goods or services described in the application.

[63] As noted by the Applicant in its written representations [para 3], where this statement has been provided, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co Ltd v Bristol Myers Co*, (1974) CarswellNat 476, 15 CPR (2d) 152 (TMOB)]. Knowledge of the existence of an opponent's trademark does not in and of itself support an allegation that an applicant could not have been satisfied of its entitlement to use its trademark [*Woot, Inc v WootRestaurants Inc*, 2012 TMOB 197].

[64] In this case, the requisite statement was provided, and there is no evidence that this is an exceptional case. Accordingly, the ground based on section 30(i) of the Act is rejected.

DISPOSITION

[65] In view of all of the foregoing, pursuant to section 38(12) of the Act and the authority delegated to me under section 63(3) of the Act, I reject the opposition.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: No hearing held

AGENTS OF RECORD

D. Michael Bean

For the Opponent

Nathan Woodruff

For the Applicant