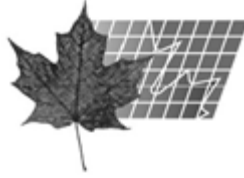


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LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 266

Date of Decision: 2021-11-29

IN THE MATTER OF AN OPPOSITION

JVF Canada Inc.

Opponent

and

Chantelle Gorham

Applicant

**1,828,663 for Wording 'Beaver Bars' and
Design 'Beaver holding Ice Cream
Sandwich'**

Application

OVERVIEW

[1] Chantelle Gorham (the Applicant) has applied to register the trademark set out below (the Mark). The application is based on the Applicant's use of the Mark since January 1, 2017 with the following Goods:



Class

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(1) Dairy cream powder.

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(2) Freeze Dried Ice Cream Bars, Freeze Dried Novelty Dessert Bars, Freeze Dried Confectionery Bars. (3) Confectionery ices; edible ices; frozen

confectionery; frozen desserts; ice cream powder

[2] JVF Canada Inc. (the Opponent) alleges that the Mark is confusing with its use and registration of its BEAVER trademarks set out below. The Opponent also alleges that the Applicant had not used the Mark as of the date claimed in the application.

BEAVER	TMA262,408	Nuts of all kinds, pumpkin and sunflower seeds, popping, popped and caramel corn.
	TMA721,220	Edible nuts of all kinds; pumpkin and sunflower seeds; popping corn and popped corn of all flavours; nut mixes; dried fruit mixes; nut and fruit mixes; baking nuts.

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

FILE HISTORY

[4] The application was filed on March 22, 2017. The application was advertised for opposition purposes in the *Trademarks Journal* dated June 6, 2018.

[5] The Opponent opposed the application on the basis of the grounds of opposition summarized below on November 6, 2018 pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (Act). This Act was amended on June 17, 2019. All references 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 (section 70 of the Act).

- (a) The application does not comply with section 30(b) of the Act.
- (b) The Applicant could not have been satisfied that she was entitled to use the Mark pursuant to section 30(i) of the Act.
- (c) The Mark is not registrable pursuant to section 12(1)(d) of the Act as it is confusing with the Opponent's registrations for the trademarks BEAVER and BEAVER & Design.

(d) The Applicant is not the person entitled to register the Mark in view of section 16(1)(a) of the Act since the Mark is confusing with the Opponent's trademarks BEAVER and BEAVER & Design.

(e) The Mark is not distinctive of the Applicant, within the meaning of section 2 of the Act.

[6] The Applicant filed and served a counter statement. To the extent that the counter statement also contains evidence in support of the Applicant's case, it has been disregarded as this evidence was not filed in accordance with rule 42 of the *Trademarks Regulations* (SOR/96-195) (the Regulations) (now section 52 of the *Trademarks Regulations* (SOR/2018-227)).

[7] The Opponent filed as its evidence the affidavit of Don Lock, its Vice President of Sales and Marketing. The Applicant filed an affidavit in her name. The Opponent filed written submissions and the Applicant appeared at a hearing.

EVIDENTIAL BURDEN AND LEGAL ONUS

[8] While there is an initial evidential burden on an opponent, the legal burden or onus remains on an applicant, on a balance of probabilities [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

GROUND OF OPPOSITION

Section 12(1)(d) Ground of Opposition

[9] The material date for this ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[10] I have exercised my discretion to check the Register to confirm that the registrations pleaded with respect to the section 12(1)(d) ground of opposition are extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent has therefore met its initial burden.

Test to Determine Confusion

[11] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated 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 and services associated with those trademarks are manufactured, sold or leased by the same person, whether or not the goods and services are of the same general class or Nice class. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): 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 goods and 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. The criteria in section 6(5) 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]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the trademarks, will often have the greatest effect on the confusion analysis.

Analysis of the Section 6(5) Factors

Inherent Distinctiveness

[12] The trademarks at issue are both inherently distinctive, although more so in the case of the Mark. To the extent that the beaver is one of Canada's national animals, the inherent distinctiveness of both trademarks is similarly impacted. However, only the Mark has significant distinctive design elements.

Extent Known and Length of Time in Use

[13] These factors strongly favour the Opponent.

[14] The Applicant does not provide any evidence of use of its Mark (and the reference to packaging and appearance of the Applicant's products in gift baskets in the Applicant's counter statement cannot be given any weight as material in a counter statement is not evidence).

[15] Mr. Lock's evidence is that the Opponent's nuts, seeds and popcorn are distributed by independent food stores and major grocery stores including Metro, Food Basics, Colemans, and Loblaws (para 6, Exhibit C). For each of the years 2012-2018, the Opponent sold more than \$1 million of its BEAVER branded goods through retail, wholesale, and online channels (para 8). The Opponent's products are advertised via supermarket and grocery store flyers to consumers as well as catalogs, price lists and promotional sell sheets distributed by the Opponent (paras 9-10, Exhibits E-F). Mr. Lock also explains that the Opponent and its predecessors-in-title have used the BEAVER trademark since 1931 (para 5). As such, I find that the Opponent's BEAVER trademarks are known to a significant extent and have been in use for years.

Nature of Goods, Services and Trade

[16] It is the Applicant's statement of goods as defined in its application versus the Opponent's registered goods that govern my determination of this factor.

[17] Although food items belong to the same general class of goods and are sold in the same stores, they may also be of an intrinsically different nature [*Oshawa Holdings Ltd v Fjord Pacific Marine Industries Ltd.* (1981), 55 CPR (2d) 39 at 44 (FCA); *Clorox Co v Sears Canada Inc* (1992), 41 CPR (3d) 483 (FCTD) at 490]. I consider this to be the situation here since the Opponent's registrations cover nuts, seeds, fruit and popcorn in a variety of formats and the Goods cover dairy and ice cream powder and a variety of frozen and freeze dried products. There is no evidence on which I could base an inference that consumers are likely to think that such different food products have the same source. While in its written submissions, the Opponent points out that both the Applicant and the Opponent's products can be regarded as snack products and may be shelf stable (at least with respect to the freeze dried ice cream), even so given the breadth of products in the categories snacks and shelf-stable foods, I do not find this necessarily makes the parties' products overlapping in nature.

[18] With respect to the nature of the trade, since the application does not contain a restriction, the nature of trade of the Applicant has the potential to overlap with the nature of trade of the Opponent, since the Goods could be sold in the same locations as the Opponent's registered goods.

Degree of Resemblance

[19] When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality. It is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trademarks.

[20] I agree with the Opponent that when considered in their entirety, there are similarities in appearance and sound between the parties' marks due to BEAVER, which is by far the more striking component in the Mark. There are also similarities and differences in the ideas suggested by the trademarks. While both parties trademarks suggest a beaver, the Mark also suggests ice cream bars. Accordingly, this factor favours the Opponent.

Surrounding Circumstance – State of the Register

[21] State of the register and marketplace evidence favours an applicant when the presence of a common element in trademarks causes purchasers to pay more attention to the other features of the trademarks, and to distinguish between them by those other features [*McDowell v Laverana GmbH & Co KG*, 2017 FC 327 at para 42].

[22] While the Applicant references over 800 registered trademarks containing the word BEAVER with 50 registered with edibles and consumables in her evidence, there is no evidence of these registrations [see section 49 of the Regulations which sets out that evidence in oppositions must be filed by way of affidavit, declaration or certified copy]. Further, the Registrar does not exercise discretion to take cognizance of third party applications and registrations [*Quaker Oats of Co of Canada Ltd*, supra]. Finally, there is no evidence that any of the trademarks are in use in the marketplace by third parties.

Conclusion

[23] Having considered all of the surrounding circumstances, I find that the Applicant has met the legal onus to prove, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's registered trademarks. I reach this conclusion

due to the differences in the nature of the Goods and the Opponent's registered goods, despite the high resemblance between the trademarks.

Sections 16(1)(a) and 2 Grounds of Opposition

[24] Both the second and third grounds of opposition turn on the issue of confusion, although the material dates are different. The material time respecting the issue of prior entitlement is the Applicant's date of first use in the application [section 16(1)(a) of the Act] and the material time respecting the issue of distinctiveness is the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185]. The circumstances as of those earlier dates are not materially different from those as of the date of this decision. Thus, my finding of no reasonable likelihood of confusion is equally applicable respecting the second and third grounds and they, too, are therefore rejected.

Section 30(b) Ground of Opposition

[25] The Opponent pleads that the application does not comply with section 30(b) of the Act because the Applicant had not used the Mark prior to the January 1, 2017 date claimed in the application.

[26] The initial burden on an opponent is light respecting the issue of non-conformance with section 30(b) of the Act because the facts regarding an applicant's first use are particularly within the knowledge of an applicant [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986) 10 CPR (3d) 84 (TMOB) at 89]. To meet its burden, an opponent must show that an applicant's evidence is clearly inconsistent with the claimed date of first use or raises doubt as to the veracity of the claimed date of first use [*Ivy Lea Shirt Co v Muskoka Fine Watercraft & Supply Co* (1999), 2 CPR (4th) 562 (TMOB), at 565 -6, aff'd (2001), 11 CPR (4th) 489 (FCTD); *Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd*, 2014 FC 323; *Reitmans (Canada) Limited v Atlantic Engraving Ltd*, 2005 CanLII 78234 (TMOB)]. While rare, in certain circumstances, the Registrar will find an opponent has met its evidential burden due to allegations contained in the counter statement [*Société nationale Elf Aquitaine v Spex Design Inc* (1988), 22 CPR (3d) 189 (TMOB); *Les Systèmes de Formation et de Gestion Perform Inc. v Scissons*, 2004 CanLII 71840].

[27] This is such a case. In the counter statement, the Applicant states at paragraph 7-8:

... It is further submitted that the Applicant is in continuous and lawful use of the said Trademark since January 1, 2017 (Invoice attached) at Northwest Trading Company and to make the product, the Applicant had purchased Freezer Dryer in December 2016 itself ... The packaging was designed in March 2017, which included the logo being used. ...

The Applicant's evidence is similarly inconsistent with the date of first use claimed. In her evidence, Ms. Gorham states: "the name and logo were added to updated packaging in March of 2017."

[28] As the Applicant's evidence fails to show use of the Mark in association with the Goods as of the claimed date of first use in compliance with section 4(1) of the Act, this ground of opposition succeeds. In particular, there is no evidence of transfer of the property or of the possession of any of the Goods with the Mark on or before the date of first use claimed in the application.

Section 30(i) Ground of Opposition

[29] Section 30(i) of the Act requires an applicant to include a statement in the application that the applicant is satisfied that it is entitled to use the trademark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant's statement untrue, such as evidence of bad faith or non-compliance with a federal statute [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155; *Canada Post Corporation v Registrar of Trademarks* (1991), 40 CPR (3d) 221 (FCTD)]. Mere knowledge of the existence of an opponent's trademark is not sufficient to support a section 30(i) ground of opposition [*Woot Inc v WootRestaurants Inc*, 2012 TMOB 197].

[30] In the present case, the application contains the requisite statement and there is no evidence that this is an exceptional case involving bad faith or the violation of a federal statute. Accordingly, the section 30(i) ground of opposition is rejected.

DISPOSITION

[31] 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.

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

Hearing Date: 2021-07-28

Appearances

Chantelle Gorham

For the Applicant

Agents of Record

Bereskin & Parr LLP/S.E.N.C.R.L.,S.R.L.

For the Opponent

No Agent Appointed

For the Applicant