



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 001

Date of Decision: 2023-01-11

IN THE MATTER OF AN OPPOSITION

Opponent: ARBOR SNOWBOARDS INC.

Applicant: WALTERS & MASON RETAIL, INC.

Application: 1,862,106 for ARBORETUM

INTRODUCTION

[1] WALTERS & MASON RETAIL, INC. (the Applicant) has applied to register the trademark ARBORETUM (the Mark) in association with the Services in Class 35 below:

(1) Retail store services featuring apparel, jewelry, accessories, namely, bags, handbags, sports bags, backpacks, wallets, hats, cell phone accessories, hair accessories, watches, sunglasses, candles, stationery, kitchen accessories, mugs, cups, mason jars, water bottles, hand towels, dish towels, tumblers, coasters, magnets, pillows, signs and wall art, footwear, gifts, namely, gift baskets containing cosmetics, gift certificates, and home decor products.

[2] ARBOR SNOWBOARDS INC. (the Opponent) opposes registration of the Mark. The opposition is based on allegations that the Mark is confusing with the use and registrations for the Opponent's trademark ARBOR set out below:

Registration No. TMA945,211 for ARBOR for (1) Retail store services featuring sporting goods and apparel. (2) On-line retail store services featuring sporting goods and apparel.

Registration No. TMA739,689 for ARBOR for (1) Clothing, namely, hats, caps, head bands, neckwear, scarves, shirts, swimsuits, T-shirts, sweatshirts, sweatpants, coats, shorts, jeans, pants, jackets, gloves, belts, socks, shoes, slippers, robes, and undergarments .

[3] For the reasons that follow, the application is refused with respect to the Services in strikeout below and the opposition is rejected with respect to the remaining Services.

(1) Retail store services featuring ~~apparel~~, jewelry, accessories, namely, ~~bags~~, handbags, ~~sports bags~~, ~~backpacks~~, wallets, ~~hats~~, cell phone accessories, ~~hair accessories~~, watches, sunglasses, candles, stationery, kitchen accessories, mugs, cups, mason jars, ~~water bottles~~, hand towels, dish towels, tumblers, coasters, magnets, pillows, signs and wall art, ~~footwear~~, gifts, namely, gift baskets containing cosmetics, gift certificates, and home decor products.

THE RECORD

[4] The application was filed on October 11, 2017, claiming a priority filing date of April 11, 2017, and advertised for opposition purposes in the *Trademarks Journal* on July 3, 2019.

[5] On December 24, 2019, the Opponent opposed the application by filing a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T 13 (the Act).

[6] The Applicant submitted and served a counter statement denying each of the grounds of opposition. Neither the Opponent, nor the Applicant filed any evidence. Both parties submitted written representations. The Applicant attended a hearing.

PRELIMINARY ISSUE – TRADEMARK REGISTRATIONS IN THE WRITTEN SUBMISSIONS

[7] The Opponent includes a variety of trademark registrations in its written submissions at Appendix B including ARBOR some which are owned by the Opponent, some of which are owned by third parties. The Opponent submits that these trademarks show the connection between the word ARBOR and trees and gardens. In this regard,

while the Registrar will exercise its discretion to confirm the existence of applications and registrations identified in a statement of opposition, it will not do so in other instances [*John Labatt Limited/John Labatt Limitée v WCE Western Canada Water Enterprises Inc* (1991), 39 CPR (3d) 442 (TMOB); *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 at 412 (TMOB)]. As the trademarks at Appendix B of the Opponent's written submissions are not in evidence, I have not considered the Opponent's submissions that they show the word ARBOR indicates a tree or garden.

EVIDENTIAL BURDEN AND LEGAL ONUS

[8] An applicant bears the legal onus of showing that its application complies with the provisions of the Act. However, for each ground of opposition, there is an initial evidential burden on an opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist. If this initial burden is met, then an applicant must satisfy the Registrar, on a balance of probabilities, that the ground of opposition should not prevent registration of the trademark at issue [*Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd*, 1990 CanLII 11059, 30 CPR (3d) 293 (FCTD)].

SECTION 12(1)(D) GROUND OF OPPOSITION – REGISTRABILITY

[9] The material date for considering 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 CanLII 11769 (FCA)].

[10] The Opponent pleads that the Mark is not registrable under section 12(1)(d) of the Act as it is confusing with the Opponent's registrations for ARBOR (registration Nos. TMA945,211 and TMA739,689). The Opponent has met its burden with respect to this ground of opposition as these registrations are in good standing.

[11] I now have to determine, on a balance of probabilities, if there is a reasonable likelihood of confusion between the ARBOR trademark and the Mark.

Meaning of Confusion between Trademarks

[12] Trademarks are confusing when there is a reasonable likelihood of confusion within the meaning of section 6(2) of the Act:

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 . . . 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.

[13] Thus, section 6(2) does not concern mistaking one mark for the other, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether purchasers of the Applicant's Services, sold under the ARBORETUM trademark, would believe that those services emanate from or were authorized or licensed by the Opponent who sells its registered goods and services under the ARBOR trademark.

Test for Confusion

[14] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are all the surrounding circumstances including those specifically mentioned in sections 6(5)(a) to 6(5)(e) of the Act: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the goods, services or business; the nature of the trade; and the degree of resemblance including in appearance or sound or in the ideas suggested by the marks.

[15] 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 at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 (CanLII), 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.

Inherent distinctiveness, extent known and length of time in use

[16] In order to assess the inherent distinctiveness of the parties' trademarks, I am taking judicial notice of various dictionary definitions being mindful that in the absence of evidence, I cannot take notice of a single meaning [*McDowell v Laverana GmbH & Co. KG*, 2017 FC 327 at para 36].

[17] The definition of arboretum on *dictionary.com* is "a plot of land on which many different trees or shrubs are grown for study or display." The definitions of arbor on *dictionary.com* are "(1) a leafy, shady recess formed by tree branches, shrubs, etc. (2) a latticework bower intertwined with climbing vines and flowers. and (3) Obsolete. a grass plot; lawn; garden; orchard." The Opponent includes, as part of its written submissions, dictionary definitions of ARBOR excerpted from various Oxford Dictionaries. These definitions include: "(in anatomy) a tree like structure. Arbor vitae is the treelike outline of white matter seen in the sections of the cerebellum; it also refers to the treelike appearance of the inner folds of the cervix (neck)" ... and "a spindle of a milling machine used to hold a revolving cutting tool ...".

[18] Given that none of these dictionary definitions appear to connect to the parties' goods or services, I find that the trademarks ARBOR and ARBORETUM are inherently distinctive.

[19] As for the extent to which the trademarks have become known in Canada, neither party has submitted any evidence of use or promotion of their respective trademarks, or other evidence suggesting that their trademarks have become known in Canada to any extent.

[20] Therefore, the inherent distinctiveness and extent to which the trademarks have become known favours neither party.

Nature of goods, services and business and channels of trade

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

[*Esprit International v Alcohol Countermeasure Systems Corp.* (1997), 84 CPR (3d) 89 (TMOB)].

[22] Although retail services all belong to the same general class of services, I find that they may be intrinsically different as retail services may target different consumers shopping for goods of different types [for analogous case law concerning food and computer software see *Oshawa Holdings Ltd v Fjord Pacific Marine Industries Ltd* (1981), 55 CPR (2d) 39 (FCA), at 44; *Clorox Co v Sears Canada Inc* (1992), 41 C.P.R. (3d) 483 (FCTD), at 490; *Data Broadcasting Corporation v Signal 9 Solutions Canada Inc*, 2002 CanLII 61431].

[23] In the present case, the Applicant's Services below in **bold** are either identical to or fall within the description of the Opponent's registered services or are retail services selling the Opponent's goods. In the absence of evidence to the contrary, I also assume that the parties' channels of trade would overlap with respect to these Services.

(1) Retail store services featuring **apparel**, jewelry, accessories, namely, **bags**, handbags, **sports bags**, **backpacks**, wallets, **hats**, cell phone accessories, **hair accessories**, watches, sunglasses, candles, stationery, kitchen accessories, mugs, cups, mason jars, **water bottles**, hand towels, dish towels, tumblers, coasters, magnets, pillows, signs and wall art, **footwear**, gifts, namely, gift baskets containing cosmetics, gift certificates, and home decor products.

[24] The remaining Services are retail services covering a diverse number of products including jewelry, kitchen accessories and home décor products, none of which are referenced in the Opponent's ARBOR registrations. In the absence of evidence, I do not infer that these products are of a similar nature to or would necessarily be sold in close proximity to apparel or sporting equipment.

[25] Given the absence of evidence on the extent to which the Opponent's or Applicant's trademarks have become known or how they are actually used, I do not find that the potential for overlap in the nature of the goods or services or channels of trade between the Opponent's registered goods and services and the remaining retail services including those described as or related to jewelry, kitchen accessories and home décor products to be significant.

Degree of resemblance

[26] The preferable approach when assessing the degree of resemblance between two trademarks is to consider whether there is an aspect of each trademark that is particularly striking or unique [see *Masterpiece, supra*, at para 64].

[27] The resemblance between the trademarks is due to the common element ARBOR which appears at the beginning of the Mark. However, in my view, the striking aspect of the Opponent's trademark is not ARBOR, but the word ARBORETUM as a whole. I therefore find that, when they are considered in their entireties, the parties' trademarks differ in appearance and in sound to a small extent. Notwithstanding the Opponent's submissions, I find that the ideas suggested by the parties' trademarks is somewhat more different than alike. While I accept that the idea of ARBORETUM is that of a plot of land where trees are grown, given the various definitions of ARBOR, it is not clear what idea is suggested by the Mark, other than it may suggest a tree, tree like structure or structure in a garden. Accordingly, overall, I find this factor favours the Applicant, albeit not strongly.

Section 37(3) notice raised in the statement of opposition

[28] The statement of opposition alleges that the Registrar previously identified a risk of confusion between the parties' trademarks by issuing a section 37(3) notice to the Opponent. The Registrar, in an opposition proceeding before the Trademarks Opposition Board, is not required to give consideration or deference to the Examiner because the onus and evidence before an Examiner differs from that in an opposition proceeding [*Cortefiel, SA v Doris Inc*, 2013 FC 1107 at paras 37-38]. Further, the issuance of a section 37(3) notice to the Opponent, may only show that the Registrar is in doubt as to whether there is a reasonable likelihood of confusion with a single applied-for service and does not identify which services are of concern.

Conclusion regarding confusion

[29] Ultimately, the test to be applied is whether a casual Canadian consumer, having an imperfect recollection of the Opponent's trademark ARBOR in association with the Opponent's registered goods and services, when they see the trademark ARBORETUM

in association with the Services, who does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks, would think that the Services come from the same source.

[30] Having considered all of the surrounding circumstances contemplated by section 6(5) of the Act, I conclude that the Applicant has not met its legal onus of establishing on a balance of probabilities that there is not a reasonable likelihood of confusion is between the Mark and the Opponent's ARBOR trademark registrations with respect to the Services in ~~strikeout~~ below :

(1) Retail store services featuring ~~apparel~~, jewelry, accessories, namely, ~~bags~~, handbags, ~~sports bags~~, ~~backpacks~~, wallets, ~~hats~~, cell phone accessories, ~~hair accessories~~, watches, sunglasses, candles, stationery, kitchen accessories, mugs, cups, mason jars, ~~water bottles~~, hand towels, dish towels, tumblers, coasters, magnets, pillows, signs and wall art, ~~footwear~~, gifts, namely, gift baskets containing cosmetics, gift certificates, and home decor products.

With respect to the remaining Services, the difference in these Services and the Opponent's goods and services shifts the balance of probabilities in the Applicant's favour and the opposition is rejected with respect to them.

SECTION 16(1)(A) GROUND OF OPPOSITION

[31] The Opponent alleges in its statement of opposition that the Applicant is not the person entitled to register the Mark because it is confusing with the Opponent's use of its ARBOR trademark in association with the Opponent's registered goods and services. In order to meet its initial evidential burden in support of the non-entitlement ground of opposition, the Opponent is required to show that its trademark ARBOR has been previously used in Canada prior to the priority filing date of the application. As the Opponent has filed no evidence, it fails to meet its evidential burden and this ground of opposition is rejected.

SECTION 2 GROUND OF OPPOSITION - DISTINCTIVENESS

[32] The Opponent alleges in its statement of opposition that the Mark is not distinctive of the Applicant because it does not distinguish and is not adapted to distinguish the Services from the Opponent's trademark ARBOR. In order to meet its

evidential burden in support of the non-distinctiveness ground of opposition, the Opponent was required to show that as of the date of filing its statement of opposition, December 24, 2019, that its trademark ARBOR was known to some extent at least and the reputation of this trademark in Canada was substantial, significant or sufficient [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd* 2006 FC 657]. It has not done so. This ground of opposition is therefore rejected.

DISPOSITION

[33] In view of the above, and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to the services in ~~strikeout~~ below and reject the opposition with the remaining services.

(1) Retail store services featuring apparel, jewelry, accessories, namely, ~~bags,~~ handbags, ~~sports bags, backpacks,~~ wallets, ~~hats,~~ cell phone accessories, ~~hair accessories,~~ watches, sunglasses, candles, stationery, kitchen accessories, mugs, cups, mason jars, ~~water bottles,~~ hand towels, dish towels, tumblers, coasters, magnets, pillows, signs and wall art, ~~footwear,~~ gifts, namely, gift baskets containing cosmetics, gift certificates, and home decor products.

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

Hearing Date: November 8, 2022

APPEARANCES

For the Opponent: No one appearing

For the Applicant: Barry Gamache

AGENTS OF RECORD

For the Applicant: ROBIC