



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 093

**Date of Decision:** 2023-05-31

## **IN THE MATTER OF AN OPPOSITION**

**Opponent:** Wayfinders Manitoba Inc.

**Applicant:** Wayfinder Ventures Inc.

**Application:** 1,877,721 for WAYFINDER

### **INTRODUCTION**

[1] Wayfinder Ventures Inc. (the Applicant) has applied to register the trademark WAYFINDER (the Mark) in association with the following goods (Goods) on the basis of its proposed use in Canada for Goods (3), (5), (6) and (8):

(1) On-line and downloadable guides in the fields of hiking, camping, canoeing, kayaking, skiing, backpacking, climbing, trekking and travel

(2) Camping equipment, namely stoves

(3) Printed guides in the fields of hiking, camping, canoeing, kayaking, skiing, backpacking, climbing, trekking and travel; stationery, namely paper stationery; art pictures, art drawings, graphic art prints and graphic art pictures;

(4) Camping equipment, namely backpacks and duffle bags

(5) Camping equipment, namely sleeping bag pads

(6) Camping tents

(7) Camping equipment, namely sleeping bags

(8) Clothing, namely t-shirts, caps, shirts, pants, jackets, underwear, socks, shoes and toques

[2] Wayfinders Manitoba Inc. (the Opponent) has registered the trademarks WAYFINDERS, Registration No. TMA942,511, and wayfinders and Design, Registration No. TMA942,512 (collectively, the Opponent's Marks) in association with services relating to an educational program for high school students. The Opponent has primarily opposed this application on the basis that the Mark is confusing with its previous use and registration of the Opponent's Marks. The Opponent also raises technical challenges to the application.

[3] For the reasons that follow, I find that the opposition should be rejected in part.

### **FILE HISTORY**

[4] On January 16, 2018, the Applicant filed the application to register the Mark. The application was advertised for opposition in the *Trademarks Journal* dated January 20, 2021. On March 15, 2021, the Opponent opposed the application on the basis of the grounds summarized below:

- The application does not conform to the requirements of section 38(2)(a) and 30(2) of the *Trademarks Act*, RSC 1985, c T-13 (the Act).
- The Mark is not registrable in view of section 12(1)(d) of the Act because the Mark is confusing with the Opponent's Marks.
- The Applicant is not the person entitled to registration of the Mark pursuant to section 16(1)(a) of the Act because, as of the filing date of the Applicant's application, the Mark was confusing with the Opponent's Marks which had been previously used in Canada.

- The Mark is not distinctive under section 2 of the Act because it does not distinguish the Goods from the services of the Opponent.
- The application does not conform to the requirements of section 38(2)(e) of the Act because, as of the date of filing of the Applicant's application, the Applicant was not using and did not propose to use the Mark in Canada in association with the Goods.
- The application does not conform to the requirements of section 38(2)(f) of the Act because, as of the date of filing of the Applicant's application, the Applicant was not entitled to use the Mark in Canada in association with the Goods.

[5] The Opponent filed as its evidence the affidavit of Meghan Loewen Cook, a Director of the Opponent. The Applicant filed no evidence in this proceeding. Both parties submitted written representations; only the Opponent attended a hearing.

#### **MATERIAL DATES AND ONUS**

[6] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30: the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- sections 38(2)(b)/12(1)(d): 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)];
- sections 38(2)(c)/16(1)(a): as no evidence has been filed by the Applicant, the filing date of the application [see section 16(1) of the Act];
- sections 38(2)(d)/2: the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185]; and
- sections 38(2)(e) and (f): the filing date of the application [see section 38(2) of the Act].

[7] Before considering the grounds of opposition, it is necessary to review some of the requirements with regard to (i) the evidential burden on an opponent to support the

allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[8] With respect to (i) above, there is an evidential burden on an opponent to support the facts in its allegations pleaded in the statement of opposition: *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298. The presence of an evidential burden on an 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. With respect to (ii) above, the legal onus is on an applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent (for those allegations for which the opponent has met its evidential burden). The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant.

#### **PRELIMINARY ISSUE: SERVICE**

[9] In its written representations and at the hearing, the Opponent submitted that it did not have a record of being served with the Applicant's statement that it did not wish to submit evidence pursuant to section 52(1) of the *Trademarks Regulations*, SOR/2018-227 (the Regulations). On this basis, the Opponent asked that the Registrar deem the application abandoned pursuant to section 38(11) of the Act:

(11) The application is deemed to have been abandoned if the applicant does not file and serve a counter statement within the time referred to in subsection (7) or if, in the prescribed circumstances, the applicant does not submit and serve either evidence under subsection (8) or a statement that the applicant does not wish to submit evidence.

[10] A review of the Applicant's statement shows that the Applicant submitted it electronically and indicated that it had served the statement by the Trademarks Opposition Board's e-Services, on consent. In the circumstances, where the Applicant has confirmed service, and service was effected by the Trademarks Opposition Board's e-Services, I find that service was effected as set out in the Applicant's statement pursuant to section 46(6) of the Regulations as the statement was transmitted to the Opponent.

## **GROUNDINGS OF OPPOSITION**

### ***Sections 38(2)(a) and 30(2) Ground of Opposition***

[11] It is not clear that the Opponent's statement of opposition validly pleads a ground of opposition based on section 30(2)(a) of the Act. In any event, the Opponent's allegations in paragraphs 71-77 of its written representations would not result in refusal of the application.


[12] Section 30(2)(a) of the Act requires an application to contain "a statement in ordinary commercial terms of the goods or services in association with which the trademark is used or proposed to be used". The Opponent alleges that because the application was not filed with semicolons indicating separate classes of goods, the application has not been filed in accordance with the requirements of the Act, citing *Pronuptia de Paris v Pronovias, SA*, [2007] TMOB No 63. The Examination Manual explains that goods which are separated by semi-colons (;) are generally considered to stand on their own and therefore must meet the requirements of paragraph 30(2)(a) of the Act without regard to the other listed goods or services.

[13] The Opponent further alleges that the application does not conform to the requirements of sections 38(2)(a) and 30(2) of the Act because the Applicant had not included a statement that it used the Mark within the meaning of the Act.

[14] I dismiss the Opponent's submissions regarding the lack of semicolons, as the lack of semi-colons in the present case does not give rise to goods which are not in ordinary commercial terms or lack specificity. Furthermore, the absence of a statement that the Applicant had used the Mark is not relevant given that the application is based in part on proposed use, and the Opponent has not otherwise shown how the application does not conform to the requirements of section 30(2) of the Act. Accordingly, the Opponent fails to meet its evidential burden with respect to this ground of opposition and it is rejected.

**Sections 38(2)(b) and 12(1)(d) Ground of Opposition**

[15] The Opponent has pleaded that the Mark is confusing with both of its registrations for the Opponent's Marks. An opponent's evidential burden is met with respect to a section 12(1)(d) ground of opposition, if a pleaded registration relied upon is in good standing as of the date of the opposition decision. I have exercised my discretion to check the register [*Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)] and confirm that the registrations for the Opponent's Marks set out below are valid.

Registration No.	Trademark	Services
TMA942,511	WAYFINDERS	Educational and training services, namely, the operation of a community-based mentorship and outreach program for high school students to earn credits towards graduation and develop life skills; the operation of a website in the field of education, training, coaching, and mentorship of high school students to earn credits towards graduation and develop life skills.
TMA942,512		

[16] I am of the view that comparing the Mark with the Opponent's trademark WAYFINDERS (registration No. TMA942,511) represents the Opponent's best chance of success. Unless indicated otherwise, I shall therefore focus my analysis on this registration, as it will effectively decide the outcome of this ground of opposition.

Test for Confusion

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

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.

[18] Thus, section 6(2) of the Act does not concern the confusion of the trademarks themselves, but confusion of goods or services from one source being perceived as being from another source. The question posed by section 6(2) is whether purchasers of the Goods sold in association with the Mark would believe that the Goods are provided, authorized or licensed by the Opponent. The legal onus is on the Applicant to show, on a balance of probabilities, that there is no reasonable likelihood of confusion.

[19] In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time the trademarks have been in use; (c) the nature of the goods and 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. 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].

#### *Inherent distinctiveness*

[20] The inherent distinctiveness of a trademark refers to its uniqueness when considered with its associated goods or services. In this case, “wayfinder” is suggestive to some degree of the Applicant’s camping-related goods insofar as finding one’s way is a feature of outdoors or nature-based activities such as camping. Similarly, “wayfinders” is suggestive to some degree of the Opponent’s educational program in that it assists students find their way. The Opponent’s brochure explains at Exhibit B:

Wayfinders is a community-based mentorship and outreach program that aims to provide the chance for a better future to high-school students living in Winnipeg's Elwick Community and Watson Street neighbourhoods in North West Winnipeg and the Seven Oaks School Division. Wayfinders supports students in low-income communities, where dropout rates are often very high. The program encourages and helps students to earn credits toward high school graduation while taking part in tutoring, career exploration, community mentorship and community service. Through the Wayfinders program, students experience and learn the importance of engaging in community activities, working together and reaching their full potential.

[21] Accordingly, I find that the inherent distinctiveness factor favours neither party.

*Extent Known and Length of Time in Use*

[22] With respect to acquired distinctiveness and length of time in use, the evidence filed by the Opponent demonstrates that the Opponent has used and advertised its services in association with the Opponent's Marks since 2008 (Cook affidavit, para. 15). In particular, the Opponent's Marks appeared on the brochures shown in Exhibit B, which Ms. Cook confirms were distributed to community members in Winnipeg since 2008. The Opponent's trademarks also appear on its website which was viewed over 60,000 times from across Canada from March 1, 2015 to July 7, 2021 (para 20, Exhibit J). Accordingly, I find that the extent known and length of time in use favours the Opponent.

*Nature of the goods, services or business and nature of the trade*

[23] When considering sections 6(5)(c) and 6(5)(d) of the Act, it is the statement of goods and services in the application and the statement of goods and services in an opponent's registration that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[24] In my view, the Goods related to camping and the outdoors are significantly different from the Opponent's registered services, and their respective channels of trade would be unlikely to overlap. The Goods include camping equipment, whereas the Opponent's services relate to an educational program for high school students. Importantly, I find the target audiences of the parties to be distinct. The Applicant's Goods target those interested in camping and other outdoor pursuits. In contrast, the Opponent's services are targeted at high school students and those that care about



them. This is even the case of some of programming offered to the Opponent's students is outdoor focussed or has an outdoor component including camping, hiking and snowshoeing, canoeing, and trekking (para 8) or that the summer school programming offered is an outdoor program and ecologically focussed (para 11).

[25] The Opponent submits that the fact that it has published a Survival Gear Guide (Exhibit C) shows overlap in the nature of the Goods with its services. However, the Opponent's Survival Gear Guide was produced by Wayfinders students and provides advice, anecdotes, and tips on how to stay safe and survive the teenage experience in Winnipeg. Each chapter is illustrated with altered items of used clothing, exploring issues related to safety and survival of the teen experience. Importantly, the survival gear guide does not cover survival in nature or the outdoors.

[26] Accordingly, I find that this factor strongly favours the Applicant with respect to the following goods:

- (1) On-line and downloadable guides in the fields of hiking, camping, canoeing, kayaking, skiing, backpacking, climbing, trekking and travel
- (2) Camping equipment, namely stoves
- (3) Printed guides in the fields of hiking, camping, canoeing, kayaking, skiing, backpacking, climbing, trekking and travel
- (4) Camping equipment, namely backpacks and duffle bags
- (5) Camping equipment, namely sleeping bag pads
- (6) Camping tents
- (7) Camping equipment, namely sleeping bags

[27] However, the stationery and clothing items in the application do not have any restriction as to their nature or channels of trade. As there is evidence that the Opponent has distributed promotional brochures displaying the Mark since 2008, including the above-described "survival gear guide" distributed since 2017 and showing home-made clothing items made as part of the Opponent's educational program, I

agree with the Opponent that this factor favours it to some degree with respect to the following goods:

(3) stationery, namely paper stationery; art pictures, art drawings, graphic art prints and graphic art pictures;

(8) Clothing, namely t-shirts, caps, shirts, pants, jackets, underwear, socks, shoes and toques

#### Degree of resemblance

[28] The trademarks differ only in that the Opponent's trademark WAYFINDERS is the plural of the Mark. Accordingly, this factor strongly favours the Opponent.

#### Conclusion

[29] Section 6(2) of the Act is not concerned with confusion between the marks themselves, but rather confusion as to the source of the services. Further, as the Supreme Court of Canada explains in *Mattel, supra* at para 57, the ordinary consumer is owed a certain amount of credit:

... I fully agree with Linden J.A. in *Pink Panther* that in assessing the likelihood of confusion in the marketplace "we owe the average consumer a certain amount of credit" (para. 54). A similar idea was expressed in *Michelin & Cie v. Astro Tire & Rubber Co. of Canada Ltd.* (1982), 69 CPR (2d) 260 (FCTD), at 263:

. . . one must not proceed on the assumption that the prospective customers or members of the public generally are completely devoid of intelligence or of normal powers of recollection or are totally unaware or uninformed as to what goes on around them.

[30] In this case, an assessment of confusion asks whether a consumer confronted with the Mark in association with the Goods would be confused and think that they emanate from the Opponent, an entity that offers an educational program for high school students. On a balance of probabilities, I do not find that they would with respect to the following goods:

(1) On-line and downloadable guides in the fields of hiking, camping, canoeing, kayaking, skiing, backpacking, climbing, trekking and travel

(2) Camping equipment, namely stoves

(3) Printed guides in the fields of hiking, camping, canoeing, kayaking, skiing, backpacking, climbing, trekking and travel

(4) Camping equipment, namely backpacks and duffle bags

(5) Camping equipment, namely sleeping bag pads

(6) Camping tents

(7) Camping equipment, namely sleeping bags

[31] I reach this conclusion having regard to all of the surrounding circumstances and, in particular, having regard to the differences in the nature of the parties' goods and services and business, despite the similarity between the marks. Accordingly, this ground of opposition fails with respect to the above-noted goods.

[32] With respect to the remaining goods, the evidence is that the Opponent has distributed promotional brochures and printed materials relating to clothing as well as material which could be considered graphic art pictures. As the field of use is not restricted with respect to these goods in the application, and given the absence of evidence filed by the Applicant, I find that the Applicant has not discharged its burden to show that there is not a reasonable likelihood of confusion between the parties' trademarks with respect to the following applied-for goods:

(3) stationery, namely paper stationery; art pictures, art drawings, graphic art prints and graphic art pictures;

(8) Clothing, namely t-shirts, caps, shirts, pants, jackets, underwear, socks, shoes and toques

[33] As such, this ground of opposition succeeds in part and is rejected in part.

***Sections 38(2)(c) and 16(1)(a) Ground of Opposition***

[34] The Opponent has also pleaded that the Applicant is not the person entitled to registration pursuant to section 16(1)(a) of the Act on the basis that the Mark is confusing with the Opponent's Marks. With respect to this ground of opposition, there is an initial burden on the Opponent to evidence use of at least one of its trademarks prior

to the Applicant's filing date and non-abandonment of its trademark(s) as of the date of advertisement of the Applicant's application [section 16(1) of the Act]. The Opponent's evidence of use in the Cook affidavit paras. 15-22 is sufficient to meet this burden. In particular, Ms. Cook confirms that a brochure displaying the Opponent's Marks, attached as Exhibit B, has been distributed since 2008 to community members, students, volunteers and other program stakeholders. As the difference in material dates has no impact on my analysis of this ground of opposition, I reach the same conclusions with respect to confusion as those set out in the section 12(1)(d) ground.

***Sections 38(2)(d) and 2 Ground of Opposition***

[35] The Opponent has also pleaded that contrary to section 2 of the Act, the Mark does not actually serve to distinguish and is not adapted to distinguish the Goods from the services associated with the Opponent's Marks.

[36] In *Bojangles' International, LLC v Bojangles Café Ltd*, 2006 FC 657 at paras 33-34, the Federal Court provided that a trademark could negate another mark's distinctiveness if it was known to some extent at least and its reputation in Canada was substantial, significant or sufficient or alternatively, if it is well known in a specific area of Canada. An attack based on non-distinctiveness is not restricted to the sale of goods or services in Canada. It may also be based on evidence of knowledge or reputation of an opponent's trademark including reputation spread by means of word of mouth or newspaper and magazine articles [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD)].

[37] The Opponent's evidence of use detailed in paragraph 21 of this decision is sufficient to meet its evidential burden. As the difference in material dates has no impact on my analysis of this ground of opposition, I reach the same conclusions with respect to confusion as those set out in the section 12(1)(d) ground.

***Section 38(2)(e) Ground of Opposition***

[38] The Opponent has pleaded that the Applicant either was not using or did not intend to use the Mark in Canada in association with the Goods. With respect to this

ground of opposition, an application is under no obligation to prove that it has used the Mark or intends to use the Mark unless the Opponent meets its evidential burden.

[39] In this case, the Opponent has failed to meet its evidential burden with respect to this ground of opposition as there is no evidence that the Applicant did not intend to use or was not using the Mark. As such, this ground of opposition is rejected.

***Section 38(2)(f) Ground of Opposition***

[40] The Opponent has pleaded that the Applicant is not entitled to use the Mark in Canada in association with the Goods because the Applicant should have known that the Opponent's Marks were used in Canada.

[41] I do not find this to be a valid ground of opposition under section 38(2)(f) of the Act because this section has nothing to do with whether or not an applicant was aware of an opponent's trademarks. In so finding, while section 38(2)(f) of the Act appears on its face to be similar to section 30(i) of the Act (as it was prior to June 17, 2019), there is a significant difference as section 30(i) required that an applicant include in the application a statement that "he is satisfied that he is entitled to use the trademark in Canada in association with the goods or services". No such focus on whether the applicant is satisfied that he is entitled to use the applied-for trademark exists in section 38(2)(f) of the Act. As such, this ground of opposition is rejected.

**DISPOSITION**

[42] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to:

(3) stationery, namely paper stationery; art pictures, art drawings, graphic art prints and graphic art pictures;

(8) Clothing, namely t-shirts, caps, shirts, pants, jackets, underwear, socks, shoes and toques

[43] I reject the opposition with respect to the remainder of the goods set out below:

(1) On-line and downloadable guides in the fields of hiking, camping, canoeing, kayaking, skiing, backpacking, climbing, trekking and travel

(2) Camping equipment, namely stoves

(3) Printed guides in the fields of hiking, camping, canoeing, kayaking, skiing, backpacking, climbing, trekking and travel

(4) Camping equipment, namely backpacks and duffle bags

(5) Camping equipment, namely sleeping bag pads

(6) Camping tents

(7) Camping equipment, namely sleeping bags

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Natalie de Paulsen  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

# Appearances and Agents of Record

**HEARING DATE:** 2023-02-28

## **APPEARANCES**

**For the Opponent:** Michael Zacharias

**For the Applicant:** No one appearing

## **AGENTS OF RECORD**

**For the Opponent:** Fillmore Riley LLP

**For the Applicant:** No agent appointed