

Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 034

Date of Decision: 2024-02-27

IN THE MATTER OF AN OPPOSITION

Opponent: NCL US IP Co 2, LLC

Applicant: Norwegian Brand Ltd.

Application: 1,855,549 for PLANE Design

INTRODUCTION

[1] Norwegian Brands Ltd. (the Applicant) has applied to register the trademark PLANE Design (the Mark) in association with the following goods and services (the Goods and Services):

CI 16 Brochures; printed matter, namely, airline boarding cards and tickets; travel and in-flight magazines; periodicals.

CI 35 Advertising the goods and services for others; business management; business administration; sales and promotion, namely, a loyalty and rewards programs in the distribution and sale of air transportation services, customer loyalty services, namely, administration of a frequent flyer program that allows members to purchase airline tickets using bonus points awarded through the purchase of flight segments and air fare classes, as well as through the purchase of goods or services from designated companies; retail services, in-flight sales services and Internet sales services for tobacco, cosmetics, clothing, watches, wine and liquor, jewelry and sunglasses; online retail services featuring pre-recorded audiovisual content, namely, television programs, movies, documentaries, pre-recorded downloadable music, music videos, pre-recorded musical performances, video games, pre-

recorded downloadable sports events, pre-recorded animation and news programs; electronic transmission of news and data for ticket sale, namely, customer service in the field of airline reservations providing co-working facilities equipped with office equipment; incubation services, namely, providing work space containing business equipment and other amenities to emerging, start-up and existing companies; providing coworking, temporary and shared work spaces, offices, business event spaces, facilities and office equipment; business operation of commercial real estate, offices and office space, namely, shared office venues with conference facilities;

CI 38 Telecommunications services, namely, providing access to the Internet;

CI 39 Airline services, namely, air transportation services, namely, transportation of passengers, parcels, freight and cargo by air; air transport and travel services, namely, operation of an airline for the transportation of passengers and freight; transport of passengers and goods by automobiles, trains, ships and airplanes; travel agency services, namely, travel agency services, namely, travel and tour information, travel and tour ticket purchase and reservation; travel agency and travel management services, namely, organizing all-inclusive vacation packages; air transportation for passengers, car rental, activity and travel services, namely, car rentals, rail travel, cruises, arranging tickets for sightseeing tours, arranging for local transportation at the travel destination and restaurant reservations; vehicle rental services; vehicle parking services, namely, airport parking, airport passenger shuttle services between the airport parking facilities and the airport and, operation of an airport parking facility; vehicle parking lot services; courier services; cargo storage and handling services; aircraft chartering services; booking and reservation services for tours; travel agency services, namely making reservations and bookings of seats for travel; electronic transmission of data and documents for business purposes via computer terminals from a computer-based database, namely, providing information in the field of travel and transportation and issuing airline tickets via a website; providing check-in and boarding services for air travel, namely, airline and check-in services via a website; travel agency services, namely making reservations and bookings for transportation, via a website on a global computer network; providing reservation and ticket purchase services for car rentals, sightseeing tour ticket and booking seats for travel via an interactive online website; providing check-in and boarding services for air travel, namely, airline schedules and airline check-in services via a website;

CI 41 Arranging for the reservation and purchase of tickets for concerts, operas, museums, theme parks, and amusement parks; the provision of ski packages featuring ski lift tickets, ski instruction, ski equipment rentals, the provision of golf trip packages featuring course reservations, golf instruction, golf equipment rentals, soft adventure activities such as snowmobiling and rock-climbing;

CI 43 Services for providing food and drink, namely, operation of a restaurant and operation of a take-out food and beverage facility; bar, cafe, snack-bar, cocktail lounge services, airport waiting lounge services and restaurant services; hotel booking and reservation and restaurant reservation and booking; providing reservation and ticket purchase services for hotel rooms, restaurants.

[2] NCL US IP Co 2, LLC (the Opponent) has opposed the Application. The opposition is based primarily on confusion with the many trademarks in the Opponent's name containing the term NORWEGIAN.

[3] For the reasons that follow, I allow the Application in part.

THE RECORD

[4] The Application for the Mark was filed on September 1, 2017, with the Applicant relying on the basis of the proposed use of the Mark in Canada in association with the Goods and Services. The application was advertised for opposition purposes in the *Trademarks Journal* dated November 17, 2021. On January 17, 2022, the Opponent filed a statement of opposition against the Mark pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The Act was amended on June 17, 2019. As the Application was advertised after this date, the Act as amended applies [section 69.1 of the Act].

[5] The grounds of opposition are summarized below:

- The trademark is clearly descriptive or deceptively misdescriptive of:
 - The character or quality of the Goods or Services in association with which it is used or proposed to be used
 - The conditions of or the persons employed in the production of the Goods or Services
 - The place of origin of the Goods or Services.
- The application is contrary to section 12(1)(d) of the Act as the Mark is confusing with the Opponent's registered trademarks
- The Applicant is not the person entitled to registration of the Mark pursuant to section 16(1)(a) of the Act because, at the date of filing, it was confusing with the Opponent's registered and applied for trademarks previously used or made known in Canada
- The Applicant is not the person entitled to registration pursuant to section 16(1)(b) because the Mark was confusing with pending trademark applications previously filed in Canada by the Opponent
- The Mark is not distinctive of the Applicant, contrary to section 2 of the Act
- The application does not comply with the requirements of section 38(2)(f) of the Act because the Applicant was not entitled to use the Mark in Canada in association with the Goods and Services in light of the Opponent's trademarks; that the Goods and Services are not adapted to be distinguishable from the goods and services of the Opponent in association with which the Opponent's trademarks have been used and made known in Canada; and that at the filing date of the Application the Applicant should have known that the Opponent's trademarks were used in Canada in association with its services

[6] The Applicant denied the grounds in its counterstatement filed on March 21, 2022.

[7] The Opponent relies upon Mr. Lincoln Vidal's affidavit to support its opposition. Mr. Vidal is employed by a related company, NCL Bahamas (Ltd.), a company doing business as Norwegian Cruise Line which he alleges is affiliated with the Opponent. He serves as Vice President and Assistant General Counsel of Norwegian Cruise Line Holdings Ltd, a group of related companies. Mr. Vidal was not cross-examined on his affidavit.

[8] In support of its application, the Applicant relies on multiple affidavits in the name of Mr. Mark Butler, an articling student with the Applicant's Agent. The evidence of both parties is discussed in greater detail below.

[9] On October 5, 2023, the Opponent sought and was granted leave to amend the Statement of Opposition. The amendments involved applications which, while pending at the time of filing of the Statement of Opposition, had since issued to registration. I note nothing turns on whether these trademarks are included along with the Opponent's other registered trademarks, which were initially identified in support of the registrability ground of opposition.

[10] Both parties filed written representations. While the Applicant filed a list of cases to be relied upon during the hearing well in advance pursuant to usual opposition practice, the Opponent provided its listing of the cases immediately before the hearing. I note the Applicant's agent objected to this on the basis that it was unfairly disadvantaged by the failure of the Opponent to follow the established practice. I note lawyers and trade-mark agents are asked, through the Practice in Trademark Opposition Proceedings, to provide each other with a list of cases and any unreported decisions they will rely upon at the hearing at least two weeks prior to the oral hearing as a matter of professional courtesy. Although it was clearly inappropriate for the Opponent to fail to comply with the timing set out in the Practice Notice there is no penalty available, under statute, for failing to do so.

EVIDENCE

[11] While I have considered all evidence submitted by the parties, I have set out below what I consider to be the most pertinent components for my analysis of the grounds of opposition:

Opponent's Evidence

[12] The Vidal affidavit, filed on behalf of the Opponent, includes the following evidence:

- Information as to Mr. Vidal's employment as Vice President and Assistant General Counsel, a position he has held since 2007, with the Opponent's affiliated company NCL (Bahamas) Ltd., d/b/a Norwegian Cruise Line sharing common ownership with the Opponent as part of what he defines as the "NCLH Group", and his position as Assistant General Counsel to the NCLH Group [paras 1 and 2]
- Reference to, and particulars of, the Opponent's more than 20 registered trademarks and numerous pending applications for trademarks in Canada that contain the term NORWEGIAN [paras 4 to 6 and Exhibits A and B]
- A statement that the Opponent has been using trademarks that incorporate NORWEGIAN, including Registration No TMA736,538 for NORWEGIAN CRUISE LINE in Canada since at least as early as 1990 and following in association with arranging of cruises; cruise ship services; travel, excursion and cruise arrangement [paras 7 to 10]
- Copies of catalogues, brochures, itinerary guides, commercial e-mails, direct mail advertising (with associated third-party invoices), websites, social media advertising, deck plans and fleet calendars, all dated between 1990 and 2022, which were made available to consumers showing NORWEGIAN CRUISE LINE and advertising the cruising services generally or cruises involving particular ships operating over the years such as THE NORWAY, WESTWARD, SEAWARD, STARWARD, SKYWARD, SOUTHWARD, SUNWARD II, NORWEGIAN CROWN, NORWEGIAN DREAM, NORWEGIAN DYNASTY, LEEWARD, NORWEGIAN MAJESTY,

NORWAY, NORWEGIAN SEA, NORWEGIAN STAR, NORWEGIAN SKY, NORWEGIAN SUN, NORWEGIAN WIND, NORWEGIAN DAWN, NORWEGIAN GEM, NORWEGIAN JEWEL, NORWEGIAN JADE, NORWEGIAN PEARL, NORWEGIAN GETAWAY, NORWEGIAN BREAKAWAY, NORWEGIAN EPIC, NORWEGIAN SPIRIT, PRIDE OF AMERICA, NORWEGIAN ENCORE and NORWEGIAN BLISS [Exhibit C to LL]

- Information as to the number of direct mailings in Canada advertising the Opponent's services from 2011 to 2019, ranging from more than 4,000 in 2011 to almost 300,000 in 2019 [para 11i]
- A statement that the Opponent's trademarks have been prominently featured on its website since the creation of the website and a copy of a recent version of the website [para 12a and Exhibit FF]
- Information that the Opponent's cruise ships feature some of the Opponent's trademarks on the hulls and appearing throughout the ships themselves as well as on displays of those ships [para 12a and Exhibit FF]
- A statement that Canadian customers can arrange cruises, purchase cruise ship services, coordinate travel and excursions and make cruise arrangements over the website [para 12a]
- Website visits by Canadians (estimate), for example, more than 3 million total visitors in 2016 and more than 4 million total visitors (rather than unique visitors) in 2022 [para 12b]
- Information regarding social media advertising in relation to the Opponent's arranging of cruises; cruise ship services; travel, excursion and cruise arrangement; travel destinations and port excursions which utilize hyperlinks that click through to the Opponent's website [para 13a]
- A statement that the Opponent's trademarks feature prominently in the Opponent's social media advertisements, demographic information as to the number of followers and copies of social media advertising in the years 2019 to 2022 [para 13c and d and Exhibits GG to JJ]
- Information about, and copies of, the Opponent's deck plans and ship maps from 1997 to 1999 prominently displaying the Opponent's ships of the time, such as NORWEGIAN CROWN, NORWEGIAN DREAM, NORWEGIAN WIND and NORWEGIAN SEA [para 14a and Exhibit KK]
- Information pertaining to fleet calendars from 2001 to 2002 and 2008 to 2009 displaying names of the Opponent's ships at the time, such as NORWEGIAN DAWN, NORWEGIAN GEM, NORWEGIAN JADE and PRIDE OF AMERICA and copies of these calendars [para 15a and Exhibit LL]
- A statement that the Opponent's ships (including NORWEGIAN BLISS, NORWEGIAN BREAKAWAY, NORWEGIAN DAWN, NORWEGIAN ENCORE, NORWEGIAN EPIC, NORWEGIAN ESCAPE, NORWEGIAN GEM, NORWEGIAN GETAWAY, NORWEGIAN JADE, NORWEGIAN JEWEL, NORWEGIAN JOY, NORWEGIAN PEARL, NORWEGIAN PRIMA, NORWEGIAN SKY, NORWEGIAN SPIRIT, NORWEGIAN STAR, NORWEGIAN SUN, NORWEGIAN VIVA and PRIDE OF AMERICA hosted more than 1 million Canadian passengers between 2010 and 2024, with associated revenue of more than one billion dollars [para 16a and Exhibit MM]
- Information as to the number of Canadians and Canadian revenues for each ship from 2010 to 2024 with data for some ships beginning after 2010, for example, NORWEGIAN BLISS, which commenced sailing in 2018 and NORWEGIAN PRIMA, which commenced sailing in 2022 [Exhibit MM]

Applicant's Evidence

[13] The Applicant's evidence comprises a series of affidavits, all in the name of Mr. Butler, showing online search results from the Canadian and US trademark registers, as well as results using the TMView search facility to locate European trademarks. The evidence taken from the USPTO database shows trademarks belonging to the parties. The European search results include a listing of active trademarks containing NORWEGIAN. Another of Mr. Butler's affidavits includes evidence of search results from the Canadian trademark register showing trademarks incorporating the term Norwegian. Additional affidavits show Canadian register results for searches of trademarks that include the terms English, Irish, Italian, Scottish and Swedish. His evidence also includes a copy of a published Practice Notice of August 15, 2007, about CIPO's disclaimer practice.

PRELIMINARY MATTER – PROBATIVE VALUE OF APPLICANT'S EVIDENCE

[14] A portion of the Applicant's evidence involves search results from other jurisdictions. The Applicant's rationale for including these registrations appears to be to demonstrate the co-existence of the parties' trademarks in countries and regions outside Canada [Applicant's written representations paras 12 to 14]. However, it is well established that little can be drawn from co-existence, or indeed the presence of geographical terms within such trademarks, in other jurisdictions since the laws and procedures under which registration occurred differ from Canada [see, for example, *Sun-Maid Growers of California v Williams & Humbert Ltd* (1981), 54 CPR (2d) 41 (FCTD); and *Vivat Holdings Ltd v Levi Strauss & Co*, 2005 FC 707, 41 CPR (4th) 8 (FCTD)]. In the absence of arguments to the contrary, I find the evidence taken from trademark registers in countries other than Canada has no probative value and does not assist the Applicant's case.

[15] The Applicant's evidence also includes search results from the Canadian trademark register containing the terms Scottish, Swedish, Irish, Italian and English. These registrations are being relied upon to argue the "ubiquity" of registered trademarks, in the name of different owners, having similar geographical elements [Applicant's written representations, paras 16 to 20]. The Opponent argues that these registrations provide nothing more than a minimalistic view of these trademarks, and of the details surrounding these registrations [Opponent's written representations, para 23].

[16] I am not persuaded that these registrations held by different owners containing, for example, the term "Scottish" in association with alcoholic beverages or the word "Italian" in association with food products are relevant to the case at hand. Even if the Applicant had made clear how such registrations support the Applicant's position, the Board is not in a position to explain why particular trademarks were permitted to proceed to registration [*Thomas J Lipton Inc v Boyd Coffee Co* (1991), 40 CPR (3d) 272 (TMOB) at 277 and *Procter & Gamble Inc v Morlee Corp* (1993), 48 CPR (3d) 377 (TMOB) at 386]. I must decide this case based on the evidence of record in the proceeding and I do not consider the evidence of the ubiquity of these registered trademarks to have probative value, particularly in the absence of specific arguments as to relevancy.

[17] The sole evidence of the Applicant that generally has potential probative value is the evidence of registered Canadian trademarks containing the term NORWEGIAN. I will discuss this evidence below as a surrounding circumstance in respect of my analysis of the likelihood of confusion.

[18] Finally, in respect of the practice notice involving disclaimers filed as evidence by the Applicant, I note that neither party has made any representations surrounding disclaimers. In the absence of submissions as to how the practice notice may apply to this case, I find this evidence to be not helpful or relevant.

ANALYSIS OF THE GROUNDS OF OPPOSITION

Ground of Opposition based on section 38(2)(f)

[19] The statement of opposition indicates that it is an allegation of confusion with the Opponent’s registered and pending trademark applications, along with a lack of distinctiveness in light of the Opponent’s trademarks, and knowledge of the Opponent’s trademarks, which provides the underlying basis for this ground of opposition. Neither party filed evidence nor made written representations in support of this ground.

[20] Section 38(2)(f) does not address the sort of allegations made by the Opponent in respect of this ground. Instead, this section contemplates an applicant’s lawful entitlement to use the trademark involving, for example, compliance with relevant federal legislation or other legal prohibitions, to “use” of the trademark within the meaning of section 4 of the Act [see *Methanex Corporation v Suez International, société par actions simplifiée*, 2022 TMOB 155]. Accordingly, this ground of opposition is rejected on the basis the Opponent has not met its initial burden.

Non-registrability Ground

[21] The Opponent has pleaded that the Mark is not registrable because, contrary to section 12(1)(d) of the Act, the Mark is confusing with the Opponent’s registrations set out below:

Registration No.	Trademark	Goods & Services
TMA848,215	CRUISE LIKE A NORWEGIAN & DESIGN	Arranging of cruises; cruise ship services; travel, excursion and cruise arrangement.
TMA848,216	CRUISE LIKE A NORWEGIAN & DESIGN	Arranging of cruises; cruise ship services; travel, excursion and cruise arrangement.
TMA635,738	NORWEGIAN SUN	Arranging and conducting transportation for ocean cruises.
TMA629,692	NORWEGIAN SEA	Arranging and conducting transportation for ocean cruises.
TMA637,416	NORWEGIAN STAR	Arranging and conducting transportation for ocean cruises.
TMA736,538	NORWEGIAN CRUISE LINE	Arranging and conducting transportation for ocean cruises.
TMA745,689	NORWEGIAN GEM	Arranging of cruises; cruise ship services; travel, excursion and cruise arrangement.
TMA707,439	NORWEGIAN CROWN	Arranging of cruises; cruise ship services; travel, excursion and cruise arrangements.

TMA707,440	NORWEGIAN JEWEL	Arranging of cruises; cruise ship services; travel, excursion and cruise arrangements.
TMA707,441	NORWEGIAN SPIRIT	Arranging of cruises; cruise ship services; travel, excursion and cruise arrangements.
TMA856,298	THE NORWEGIAN WAY	Arranging of cruises; Cruise ship services
TMA948,190	NORWEGIAN ESCAPE	Arranging of cruises; cruise ship services; travel, excursion and cruise arrangement.
TMA743,348	NORWEGIAN PEARL	Arranging of cruises; cruise ship services; travel, excursion and cruise arrangements.
TMA827,474	NORWEGIAN EPIC	Arranging of cruises; cruise ship services; travel, excursion and cruise arrangement.
TMA1,009,045	NORWEGIAN JOY	Cruise ship services; arranging of cruises; providing passenger ship, bus and car transport for excursions.
TMA1,093,421	NORWEGIAN ENCORE	(1) Arranging of cruises; cruise ship services (2) Organization of travel tours; providing air, land and water transportation of passengers for excursions; transportation of passengers by cruise ship
TMA912,100	NORWEGIAN BLISS	Arranging of cruises; cruise ship services; travel, excursion and cruise arrangement.
TMA860,022	NORWEGIAN BREAKAWAY	Arranging of cruises; cruise ship services; travel, excursion and cruise arrangement.
TMA783,319	NORWEGIAN JADE	Cruise ship services; travel, excursion and cruise arrangement.
TMA635,737	NORWEGIAN DAWN	Arranging and conducting transportation for ocean cruises.
TMA610,688	NORWEGIAN SKY	Arranging and conducting transportation for ocean cruises.
TMA1,164,113	NORWEGIAN VIVA	Arranging of cruises; cruise ship services; organisation of travel tours; providing air, land, and water transportation for excursions; transportation of passengers by cruise ship.
TMA1,182,332	NORWEGIAN ULTIMA	Arranging of cruises; Cruise ship services; Organisation of travel tours; Providing air, land and water transportation of passengers for excursions; Transportation of passengers by cruise ship.
TMA1,183,490	NORWEGIAN AQUA	Arranging of cruises; cruise ship services; organisation of travel tours; providing air, land and water transportation of passengers for excursions; transportation of passengers by cruise ship.
TMA1,183,486	NORWEGIAN BELLA	Arranging of cruises; cruise ship services; organisation of travel tours; providing air, land and water transportation of passengers for

		excursions; transportation of passengers by cruise ship.
TMA1,183,489	NORWEGIAN PRIMA	Arranging of cruises; cruise ship services; organisation of travel tours; providing air, land and water transportation of passengers for excursions; transportation of passengers by cruise ship.

[22] The material date for the section 12(1)(d) ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)]. I have exercised my discretion to check the Register and confirm the Opponent's registrations remain extant [*Quaker Oats Co of Canada Ltd v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Consequently, the Opponent has met its initial burden in respect of this ground. The Applicant, therefore, bears the legal burden of demonstrating, on a balance of probabilities, that there is no likelihood of confusion between the Mark and one or more of the Opponent's registered trademarks.

[23] In determining whether there exists a reasonable likelihood of confusion with the Mark and the Opponent's registered trademarks, I will focus on the Opponent's Registration No. TMA736,538 for the trademark NORWEGIAN CRUISE LINE, covering the services of arranging and conducting transportation for ocean cruises. I note the registrability of this trademark was recognized under section 14 of the former Act, meaning during the prosecution of its application, the Opponent satisfied the Trademarks Examiner that NORWEGIAN was not without distinctive character in Canada. The term CRUISE LINE was disclaimed apart from the trademark as a whole.

[24] I have considered each of the Opponent's registrations and conclude that its registration for NORWEGIAN CRUISE LINE represents the Opponent's strongest case. If the Opponent is unsuccessful with this trademark, it will not achieve a more favourable result with its other registered trademarks. I note, in particular, that unlike the other registered trademarks the trademark NORWEGIAN CRUISE LINE appears on virtually all advertising and promotional materials distributed in Canada over the years. The long, extensive and continuous use of this trademark means that of all the Opponent's trademarks, this one would be most recognizable to Canadians.

[25] I note that generally, the Opponent's position is that because the Mark prominently features the word NORWEGIAN, it is therefore confusing with the Opponent's registered trademarks also containing NORWEGIAN [Opponent's written representations, para 26]. On the other hand, the Applicant considers the Mark to be a striking and complex design trademark of which the shared portion NORWEGIAN is but a small part [Applicant's written representations, para 29].

Test for Confusion

[26] The test for confusion is set out in section 6(2) of the Act. It provides 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, leased, hired or performed by the same person, whether or not the goods and services are of the same general class or appear in the same class of the Nice Classification. Section 6(2) of the Act does not deal with confusion between trademarks

themselves but with the likelihood that the goods or services from one source will be perceived as being from another.

[27] In determining whether two trademarks are confusing, all surrounding circumstances should be considered, including those enumerated in section 6(5) of the Act, namely 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, including in appearance or sound or the ideas suggested by the trademarks. These criteria are not necessarily exhaustive, and additionally, different factors will be attributed different weights in a context-specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772 at para 54; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401 (*Veuve Cliquot*)]. I have also considered the findings of the Supreme Court of Canada in *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 at para 49 (*Masterpiece*), that it is the resemblance between the trademarks that will often have the greatest effect on the confusion analysis.

[28] The test for confusion is assessed as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the applicant's trademark, at a time when they have no more than an imperfect recollection of the opponent's trademark, and do not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot*, at para 20].

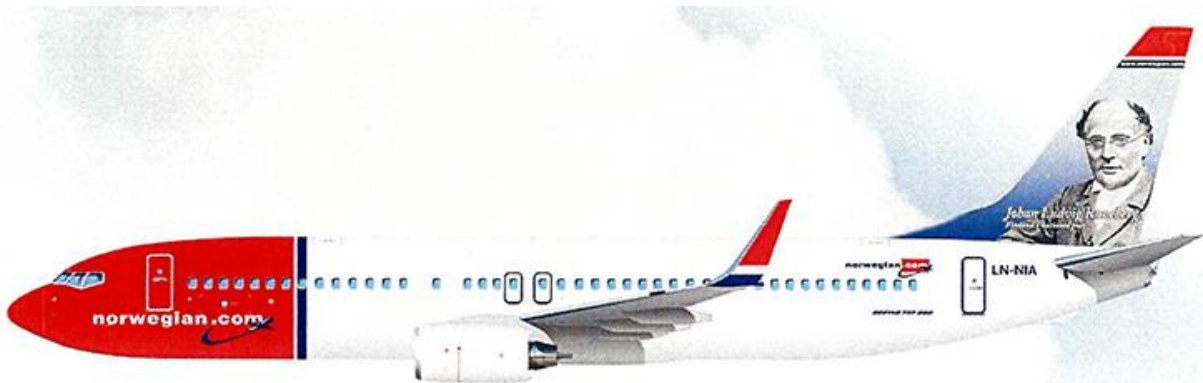
Inherent Distinctiveness, and Extent Known

[29] This factor involves a consideration of the combined inherent and acquired distinctiveness of the trademarks.

[30] The inherent distinctiveness of a trademark refers to its originality. Trademarks consisting wholly, or in part, of words that are descriptive of the associated goods or services attract a more limited scope of protection than does an invented, unique, or non-descriptive word or an original design [*General Motors Corp v Bellows*, [1949] SCR 678, 1949 CanLII 47 (SCC), citing *Office Cleaning Services Ltd v Westminster Window & General Cleaners, Ltd* (1946), 63 RPC 39 at 41 (HL); and *Fairmont Resort Properties Ltd v Fairmont Management LP*, 2008 FC 876].

[31] As noted by Justice Bédard in *Philip Morris Products SA v Imperial Tobacco Canada Limited*, 2014 FC 1237, citing *Apotex Inc v Canada (Registrar of Trademarks)*, 2010 FCA 31, whether a trademark is distinctive is a question of fact that is determined by reference to the message that it conveys to the casual consumer of the goods or services in question when the trademark is considered in its entirety and as a matter of first impression.

[32] I find the Mark possesses a degree of inherent distinctiveness. It is a composite trademark with multiple features, as shown below:



The trademark depicts a plane in flight, with multiple design components, wording and claims to particular colours.

[33] I note the Applicant has not claimed rights in the positioning of one or more signs on a three-dimensional airplane or of colours applied to the surface of a three-dimensional object. Instead, the Mark is a two-dimensional design showing a flying plane with a red nose separated from a white fuselage by a white and black stripe. The wingtips of the plane are red, white, and dark blue, as is the tail tip, with the rest of the tail in blue fading into white. The Mark's design components include the depiction of a plane itself with particular colour and stylization. Another design component, prominent on the plane's tail, is the design of the head and shoulders of a man. Clouds are faintly visible above the plane. Other more minor design elements include plane designs with swoop-shaped contrails applied to the fuselage. The word components of the Mark include not only NORWEGIAN.COM, twice, once in larger and once in smaller font, but also the words JOHAN LUDVIG RUNEBERG and in smaller lettering FINLAND NATIONAL POET. While other minor colour, word and design features have been claimed, I do not consider these particularly significant, even if they also contribute a small amount of distinctiveness.

[34] The inclusion of colour in a two-dimensional design trademark is inherently distinctive so long as the colours are arbitrary and not descriptive of the associated goods or services [*Tommy Hilfiger Licensing Inc v Produits de Qualité IMD Inc* (2005), 37 CPR (4th) 1 (FCTD) at paras 101-102; *Melo's Food Centre Ltd v Borges Food Ltd* (1995), 63 CPR (3d) 289 (FCTD) at para 39]. I note there is nothing in evidence to suggest that the colours claimed by the Applicant are anything other than inherently distinctive. The shared component, NORWEGIAN, does not add materially to the distinctiveness of the Mark, as the term, for example, describes that the associated goods or services emanate from Norway. Similarly, the ".COM" portion is not distinctive, being indicative of the top-level domain name [see *London Drugs Ltd. v. Purepharm Inc* (2006), 54 CPR (4th) 87 (TMOB), at 92.

[35] The Opponent's trademark comprises the terms NORWEGIAN and CRUISE LINE, which are descriptive language that attracts less protection than a trademark that is unique, invented, non-descriptive, or contains an original design. In the case of such trademarks, small differences may suffice to avert confusion, and a greater degree of discrimination on the part of the purchasing public may be expected [*Molson Co. v John Labatt Ltd./John Labatt Ltée*, [1994] FCJ No. 1792 (FCA) paras 5 and 6 and *Prince Edward Island Mutual Insurance v Insurance Co of Prince Edward Island* (1999), 86 C.P.R. (3d) 342 (FCTD) (*Prince Edward Island Mutual Insurance*) and *Venngo Inc v Concierge Connection Inc*, 2015 FC 1338, aff'd 2017 FCA 96 (*Venngo*)].

[36] I find that the combination of designs, colours and words other than NORWEGIAN or NORWEGIAN.COM, that result in the Mark being inherently distinctive, unlike the Opponent's trademark comprising only descriptive terms.

[37] Distinctiveness may, however, be enhanced through use and promotion [*Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD); *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD)]. Indeed, the owner of even a clearly descriptive trademark might, through extensive use and promotion, succeed in discharging the very heavy burden of establishing that the trademark has become distinctive, as is the case with respect to the Opponent's NORWEGIAN CRUISE LINE trademark. The Opponent submits, and I agree, that the evidence shows that its NORWEGIAN CRUISE LINE trademark has acquired considerable distinctiveness through years of extensive use, advertising and promotion in Canada [Opponent's written representation, para 38]. In this regard, I note that the Applicant concedes that the Opponent's evidence establishes that a substantial reputation exists in association with cruise ship services and activities [Applicant's written representations, para 11].

[38] I find this factor of inherent and acquired distinctiveness is somewhat evenly balanced. The greater inherent distinctiveness of the Mark, along with the descriptive nature of the shared term NORWEGIAN, favour the Applicant. However, the extent to which the trademarks have become known strongly favours the Opponent. I am mindful of the cautionary warning offered by the Court in *Venngo* at para 124:

However, the Court should be wary of providing broad protection to any trademark that uses descriptive or highly suggestive words as a basis for a claim of distinctiveness and alleged confusion between that mark and other trademarks or trade names (*Molson*, above, at paras 5, 6; *Ultravite Laboratories Ltd. v Whitehall Laboratories Ltd.*, [1965] SCR 734 at p 738).

[39] I conclude this factor favours the Opponent, but only to some extent.

Degree of Resemblance

[40] In most instances, it is the degree of resemblance between the trademarks at issue which stands to have the greatest effect on the confusion analysis [*Masterpiece*, at para 49]. One must consider the degree of resemblance between the marks in appearance, sound and ideas suggested. However, it is not appropriate to set the trademarks side by side and carefully examine them to find similarities and differences; each trademark must be considered as a whole [*Veuve Clicquot*, para 20].

[41] In *Masterpiece*, at paragraph 64, the Supreme Court of Canada stated that a preferred approach when assessing the degree of resemblance is to first consider whether there is an aspect of a trademark that is particularly striking or unique.

[42] The Opponent argues that the word NORWEGIAN is the most distinctive element of the Mark [Opponent's written representations, para 44]. In contrast, the Applicant argues that trademarks should not be dissected and maintains the Mark is a striking and complex design, of which the term NORWEGIAN is a small part [Applicant's written representations, para 30].

[43] While the trademarks resemble each other in that they share the component NORWEGIAN, since this term describes that the respective goods and services originate in Norway, the impact of the similarity is minimized [*Venngo* and *Prince Edward Island Mutual*

Insurance]. Focusing on the shared component, NORWEGIAN would require a comparison of the sort warned against by the courts [*Veuve Clicquot*, at para 20; *International Stars SA v Simon Chang Design Inc*, 2013 FC 1041 at para 9].

[44] I find there is limited visual resemblance between the trademarks. The most striking feature of the Mark, in appearance, is the Plane Design, including the colours of its nose, body, wings and tail, along with the image of the head and shoulders of a man. No individual component of the Opponent's trademark is particularly striking. I find it is the entirety of the trademark, NORWEGIAN CRUISE LINE, which is most striking. The term "Norwegian" would be perceived as identifying the particular cruise line. I therefore believe this term would be perceived as a unitary phrase.

[45] As for the ideas suggested, the Mark suggests a plane, with specific colouring and designs including a male head and shoulder design depicted on the tail, in flight. One might infer the individual depicted is "Johan Ludvig Runeberg" since these words appear in conjunction with the design. The presence of NORWEGIAN.COM suggests a connection with the country of Norway and a website. To find the trademarks of the parties to be similar in the idea suggested based solely on the presence of the word NORWEGIAN would require a dissection of the Mark, warned against by the courts.

[46] Regarding the resemblance between the trademarks when sounded, I note the Mark comprises the wording NORWEGIAN.COM appearing twice. The larger of the two NORWEGIAN.COM word elements is roughly the same size as the wording JOHAN LUDVIG RNEBERG. I believe the Mark would be sounded as NORWEGIAN.COM & Plane Design or perhaps NORWEGIAN.COM JOHAN LUDVIG RNEBERG & Plane Design, rather than NORWEGIAN.COM alone. As such, the resemblance, when sounded, is again limited owing to the presence of other more dominant terms. It would be necessary to accord the Opponent's trademark a broad scope of protection to conclude that the similarity in sound prevented others from registering marks in which the descriptive term NORWEGIAN was no more than a secondary component with descriptive significance.

[47] Overall, the Mark and the Opponent's trademark are more different than they are alike in appearance, sound and idea suggested. I therefore find this factor of degree of resemblance favours the Applicant.

Length of Time in Use

[48] The Opponent has evidenced use of its NORWEGIAN CRUISE LINE trademark in Canada since at least as early as the 1990's. The Applicant has not provided any evidence of use of its Mark in Canada. Even the Applicant concedes that the length of time that the trademarks have been in use favours the Opponent, [Applicant's written representations, para 34]. I agree with the parties and find this factor favours the Opponent.

Nature of the Goods, Services and Businesses; Nature of the Trade

[49] It is the statement of the Goods and Services in the application and the statement of services in the registration that must be taken into consideration when assessing the nature of the services and businesses [*Mr. Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA) and *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (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 the wording might encompass.

[*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 1996 CanLII 3963 (FCA), 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)].

[50] For ease of reference, the Opponent's NORWEGIAN CRUISE LINE trademark covers the services of arranging and conducting transportation for ocean cruises. The Opponent argues that all the Goods and Services overlap with those of the Opponent [Opponent's written representations, paras 48 and 49]. The Applicant takes the polar view, arguing that the Goods and Services are "very different" because the Applicant is in the airline business, with the Application covering essentially airline and associated products and services, while the Opponent is in the cruise ship business, with its registrations reflecting these services [Applicant's written representations, para 35].

[51] I respectfully disagree with the Applicant's argument that there is no overlap of service as this characterization ignores the fact that some of the wording contained in its services specification not only extends beyond the airline industry but traverses into the cruise ship industry.

[52] I agree with the Opponent that, at least in respect of this ground, there is overlap with, or close relation between, its services and the Services of "transport of passengers and goods by ships" and "travel services, namely cruises" (Overlapping Services (1)). However, no such overlap exists in respect of the remaining Goods and Services.

[53] I disagree with the Opponent's contention that merely because the parties operate in the travel, transportation and recreational industries, the parties' goods, services and businesses overlap. These are extensive and general categories. The Opponent's services involve arranging and conducting transportation for ocean cruises, just one facet of the travel, transportation or recreational industries into which the parties' goods and services fall. The mere fact that the Goods and Services of the Applicant (other than Overlapping Services (1)) fall within these industries does not necessarily give rise to the conclusion that the nature of respective goods and services are similar.

[54] I find in respect of this ground, that the Opponent's provision of arranging and conducting transportation for ocean cruises differs from the Goods and Services other than the Overlapping Services (1).

[55] The Opponent has not offered specific arguments regarding channels of trade separate from the consideration of similarity in goods, services and businesses. The Applicant has argued that the mere fact that the services fall within the broad spectrum of travel services does not mean there is an overlap in channels of trade [Applicant's written representations, para 38].

[56] The Opponent's evidence suggests that at least one channel of trade through which its services are offered is its website [Vidal affidavit, para 12 a]. However, I note that the parties are free to provide their services through any available channel and that there are no limitations contained in the specifications of goods and services of the parties. I believe that it is possible that owing to the similarity in the Overlapping Services, these would be available through the same trade channels.

[57] Regarding the remaining Goods and Services, I note that, as suggested by the Applicant at paragraph 38 of its written representations, merely falling into the broad spectrum of travel related services does not mean there is overlap in the channels of trade. Indeed, it would be an

exceptionally expansive channel that offered arranging and conducting transportation for ocean cruises along with the remaining Goods and Services. I find the factor involving in trade channels is not particularly significant in respect of the remaining Goods and Services and does not favour either party.

[58] In respect of this ground, the factors of similarity in goods, services business and channels of trade therefore, favour the Opponent with respect to the Services of “transport of passengers and goods by ships” and “travel services, namely cruises”. Regarding the remaining Goods and Services, the similarity of goods, services and businesses favours the Applicant.

Surrounding Circumstance – Expensive Nature of Services

[59] The Applicant argues that the respective services are expensive and greater therefore care and discernment on the part of purchasers may be expected. The court in *Masterpiece*, *supra* at paras 71-74, discussed this issue in the following terms:

71. It is not relevant that, as the trial judge found, consumers are "unlikely to make choices based on first impressions" or that they "will generally take considerable time to inform themselves about the source of expensive goods and services" (para. 43). Both of these — subsequent research or consequent purchase — occur *after* the consumer encounters a mark in the marketplace.

72. This distinction is important because even with this increased attentiveness, it may still be likely that a consumer shopping for expensive goods and services will be confused by the trade-marks they encounter. Careful research and deliberation may dispel any trade-mark confusion that may have arisen. However, that cannot mean that consumers of expensive goods, through their own caution and wariness, should lose the benefit of trade-mark protection. It is confusion when they encounter the trade-marks that is relevant. Careful research which may later remedy confusion does not mean that no confusion ever existed or that it will not continue to exist in the minds of consumers who did not carry out that research.

73. Indeed, *before* source confusion is remedied, it may lead a consumer to seek out, consider or purchase the wares or services from a source they previously had no awareness of or interest in.(...)

74. For these reasons, it was an error to discount the likelihood of confusion by considering what actions the consumer might take after encountering a mark in the marketplace. The trial judge should have instead limited his consideration to how a consumer, upon encountering the Alavida mark in the marketplace, with an imperfect recollection of the Masterpiece Inc. mark, would have reacted. Because consumers for expensive retirement residence accommodation may be expected to pay somewhat more attention when first encountering a trade-mark than consumers of less expensive wares or services, cost is not irrelevant. However, in circumstances where a strong resemblance suggests a likelihood of confusion, and the other s. 6(5) factors do not point strongly against a likelihood of confusion, then the cost is unlikely to lead to a different conclusion. (My underlining)

[60] In the present case, as there is no strong resemblance between the trademarks with other factors not pointing strongly against a likelihood of confusion, I am prepared to accept that the expensive nature of the services is a factor that would make it more likely for customers to be more alert and attentive to the trademarks encountered in the course of making purchases. This factor, therefore, favours the Applicant to a limited extent. However, the outcome of the analysis would have been the same even if I had discounted the expensive nature of the services.

Surrounding Circumstance – Family of Marks

[61] Where a family of trademarks is found to exist, there may be a greater likelihood that the public would consider a similar trademark to be yet 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 [*Everex Systems Inc v Everdata Computer Inc*, (1992), 44 CPR (3d) 175 at 183 (FCTD)]. There is, however, no presumption of the existence of a family of marks in opposition proceedings. A party seeking to establish a family of marks must prove that it is using more than one or two trademarks within the alleged family [*Techniquip Ltd v Canadian Olympic Assn*, 1998 CanLII 7573 (FC), 145 FTR 59 (FCTD), aff'd 250 NR 302 (FCA) (*Techniquip*) and *Now Communications Inc v CHUM Ltd* (2003), 32 CPR (4th) 168 (TMOB)]. In addition, the question of whether the feature common to the Opponent's marks is found in trademarks owned by others is relevant [*Techniquip, supra*]. As the Opponent has established use of a number of its trademarks [Vidal affidavit, for example, paragraphs 7, 9 to 13 and 16 and Exhibits C to I, P and R to JJ] and additionally, there is no evidence that NORWEGIAN is common to the trade, I conclude that the Opponent has established a family of trademarks.

[62] The Opponent argues that its family of NORWEGIAN trademarks affords it an enhanced scope of protection [Opponent's written representations para 2]. While this is true to some degree, I note that most of the Opponent's trademarks comprise the term NORWEGIAN followed by another, generally short, noun word. These combinations are names of the particular cruise ships, in addition to functioning as trademarks. Examples are NORWEGIAN JOY, NORWEGIAN JADE and NORWEGIAN EPIC. The other members of the Opponent's family of marks tend to be slogans such as CRUISE LIKE A NORWEGIAN or THE NORWEGIAN WAY. Of course, the family also includes the Opponent's trademark NORWEGIAN CRUISE LINE, which appears to be used essentially as a house mark in association with services relating to all its ships. I note that the Applicant's trademark incorporates NORWEGIAN or NORWEGIAN.COM as a minor component in a complex design and that the Mark overall does not fall within any of the forms or formats characteristic of the Opponent's family. I therefore find that the presence of a family of trademarks favours the Opponent, but only slightly.

Surrounding Circumstance – Third-party Use

[63] Evidence that a term is in common use may, under some circumstances, establish that purchasers are likely to pay greater attention to the other features, thereby distinguishing the trademarks [*Polo Ralph Lauren Corp v United States Polo Assn* (2000), 9 CPR (4th) 51 (FCA); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)]. However, it is generally accepted that a substantial number of registrations are required to succeed in arguing the trademarks are distinguishable. When only a small number of registrations exist, evidence of use is necessary [*McDowell v Laverana GmbH & Co KG*, 2017 FC 327; and *Canada Bread Company, Limited v Dr Smood APS*, 2019 FC 306]. I note that

regarding the Applicant's evidence relating to trademarks containing NORWEGIAN, most of the listed trademarks belong to the Opponent. The remaining registrations, numbering fewer than ten, are associated with goods and services ranging from food to charitable services, but none of these pertain to the goods or services of the parties. Three pending applications exist in the Applicant's name, including the application which is the subject of this proceeding. Only one pending application covers services related to those of the parties, namely application No. 2,218,343 for H HURTIGRUTEN NORWEGIAN COASTAL EXPRESS and Design. I, therefore, conclude that there is not sufficient evidence of registration or use of the term NORWEGIAN to support the argument that consumers might be accustomed to distinguishing between trademarks containing this term. Therefore the evidence does not support a claim that the state of the register is a factor that favours the Applicant.

Conclusion Registrability Ground

[64] The consideration posed by section 6(2) of the Act is whether customers of the Applicant's services would believe that these are provided, authorized or licensed by the Opponent owing to its NORWEGIAN CRUISE LINE trademark. I note the word NORWEGIAN is a minor component of the Mark, and also that the term is a fair and accurate description of the origin of the goods and services of the parties. I therefore find that as a matter of first impression, it is unlikely that any consumer, even one familiar with the Opponent's services would assume the Goods and Services, other than the Overlapping Services (1), emanate from the Opponent. Having considered all surrounding circumstances, in particular the lack of resemblance between the parties' trademarks, the inherent weakness of the Opponent's trademark, the dissimilarity in respect of the other Goods and Services and businesses other than the Overlapping Services and the other surrounding circumstances, I find that the Applicant has met the legal onus on it to show, on a balance of probabilities that there is no reasonable likelihood of confusion between the Mark and the Opponent's trademark at the material date, in respect of the Goods and Services, other than in respect of the Overlapping Services(1). I reach this conclusion even though the Opponent's trademark has acquired distinctiveness through long and extensive use and the Opponent possesses a family of NORWEGIAN trademarks.

[65] Regarding the Overlapping Services (1), I believe the same consumer discussed above might assume the Opponent offers these Overlapping Services. Therefore, again having considered all surrounding circumstances, and in particular, the long and extensive use, promotion and advertising resulting in the acquisition of distinctiveness, as well as the similarity of the respective services, businesses and possibly channels of trade, and mindful of all surrounding circumstances, I find that the Applicant has not met the legal onus on it to show on a balance of probabilities that there is no reasonable likelihood of confusion between the Mark and the Opponent's trademark at the material date in respect of the Overlapping Services (1). I reach this conclusion notwithstanding that the Mark and the Opponent's NORWEGIAN CRUISE LINE trademark are more different than they are alike.

Non-entitlement Grounds

[66] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark pursuant to section 16(1)(a) of the Act because it was confusing with the Opponent's trademarks previously used or made known in Canada. The Opponent also pleads that the Applicant is not the person entitled to registration of the Mark because it was confusing with several pending trademark applications previously filed by the Opponent. The material date for these grounds of opposition is the application's filing date, September 1, 2017.

[67] The Opponent has met its initial evidential burden concerning the 16(1)(a) ground of opposition through its evidence of prior use of its trademarks, including NORWEGIAN CRUISE LINE discussed above. Again, this trademark provides the Opponent with its strongest case.

[68] While the material date is slightly earlier than for the registrability ground, the material date does not influence the outcome of the confusion analysis. Ultimately, the result of the analysis of the factors assessed with respect to the confusion assessment remains the same for all factors, other than the nature of the goods, services and businesses and the nature of the trades. I will now consider the nature of the goods, services and businesses of the parties, along with the channels of trade. In doing so, I will rely on the Opponent's evidence of use rather than the description of services contained in the Opponent's registration, as I did for the registrability ground discussed above.

[69] Beyond the services claimed in its registration for the trademark NORWEGIAN CRUISE LINE, I note that the Opponent's evidence shows that its cruise ship services involve shore excursions such as visits to cities or towns and associated landmarks such as temples, palaces and ruins [for example, see Vidal affidavit, Exhibit N page 30 and 57]. While I note that there is no explicit evidence or argument involving the precise nature of the shore excursions, I conclude that the probable type of business offered by the Opponent includes booking such excursions and arranging associated transport of passengers to the locales. Likewise, the Opponent's evidence suggests it provides meals as a component of its cruise ship offering. As such, there is a further potential association of these types of services. I find, therefore, that the following Services are overlapping or closely related to those of the Opponent (Overlapping Services (2)):

- CI 39 [...] transport of passengers and goods by [...] ships [...]; travel agency services, namely, travel agency services, namely, travel and tour information, travel and tour ticket purchase and reservation; [...]; [...] and travel services, namely, [...] cruises, arranging tickets for sightseeing tours, arranging for local transportation at the travel destination and restaurant reservations; [...]; booking and reservation services for tours; travel agency services, namely making reservations and bookings of seats for travel; [...] travel agency services, namely making reservations and bookings for transportation, via a website on a global computer network; [...] sightseeing tour ticket and booking seats for travel via an interactive online website; [...]

- CI 43 Services for providing food and drink, namely, operation of a restaurant and operation of a take-out food and beverage facility; bar, cafe, snack-bar, cocktail lounge services, [...]; [...] restaurant reservation and booking; [...] restaurants

[70] I note that the Opponent argued at the hearing that the Goods and Services overlap with its cruise ship services that include providing flights to its passengers. However, there is no evidence that it is the Opponent itself who provides the airline services. There is also no evidence that the Opponent offers any of the other Services.

[71] In the absence of additional evidence or arguments specific to the parties' channels of trade, I cannot conclude that this factor favours either party to any great extent, other than in respect of the Overlapping Services 2 which are similar in nature.

[72] Thus, my findings in respect of the section 16(1)(a) entitlement ground are that the trademarks of the parties are likely to be confused in respect of the Overlapping Services (2) but not in respect of the other Services. Therefore, this ground succeeds regarding the Overlapping Services (2) but is rejected for the remaining Goods and Services.

[73] In respect of the section 16(1)(b) ground of opposition, the Opponent must establish that its relied upon applications were filed prior to the date of filing of the Application and that these were not abandoned as of advertisement of the Application on November 17, 2021. The Registrar has the discretion to check the register in order to confirm the existence of the application relied upon by an opponent [*Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[74] I note the Opponent did not address its 16(1)(b) ground of Opposition in its written representations. This is likely because, as I have found by checking the register, all of the applications relied upon by the Opponent had yet to be filed as of the filing date of the Application. This ground may, therefore, be summarily dismissed.

Non-distinctiveness Ground

[75] The Opponent has pleaded that the Mark is not distinctive within the meaning of section 2 of the Act as it does not distinguish, since it is not adapted to distinguish, the Goods and Services from the Opponent's services in Canada in light of the Opponents NORWEGIAN family of trademarks.

[76] The material date to assess this ground of opposition is the filing date of the statement of opposition, namely January 17, 2022 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[77] To meet the initial evidential burden for a distinctiveness ground of opposition, an opponent must show that its trademark had a substantial, significant or sufficient reputation in Canada as of the material date [*Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427 (FC) at paras 33 and 34].

[78] The Opponent has established a substantial reputation through its evidence of use, advertising and promotion of its trademarks including NORWEGIAN CRUISE LINE, the trademark used for the purposes of comparison above, which underpins the Opponent's strongest case. This ground of opposition ultimately turns on the issue of confusion as well. Again, the material date does not impact the outcome of my analysis. I reach the same conclusion as I have concerning the registrability and entitlement grounds discussed above. My finding above that the parties' trademarks are likely to be confused for the Overlapping Services (1) and (2), but not for the other Goods and Services, applies equally to this ground. This ground, therefore, succeeds in respect of the Overlapping Services (1) and Overlapping Services (2), but is rejected in respect of the remaining Goods and Services.

Clearly Descriptive or Deceptively Misdescriptive Ground

[79] The Opponent pleads that the Mark, when depicted, written or sounded, is either clearly descriptive or deceptively misdescriptive in the English or French language of the place of origin of the Goods and Services.

[80] The Opponent did not file evidence or make written representations in support of this ground of opposition but offered brief arguments at the hearing.

[81] Registrability of the Mark under section 12(1)(b) must be assessed as of the filing date of the application, in this case, September 1, 2017 [*General Housewares Corp v Fiesta Barbeques Ltd* (2003), 2003 FC 1021 (CanLII), 28 CPR (4th) 60 (FC)].

[82] “Clearly” means “easy to understand, self-evident or plain” [*Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 (Ex Ct) at 34]. In deciding whether a trademark offends section 12(1)(b), the trademark must not be carefully analyzed but instead must be considered in its entirety as a matter of immediate impression [*Wool Bureau of Canada Ltd v Registrar of Trade-marks* (1978), 40 CPR (2d) 25 (FCTD); *Atlantic Promotions Inc v Registrar of Trade-marks* (1984), 2 CPR (3d) 183 (FCTD)]. That is, the trademark must not be considered in isolation but rather in its full context in conjunction with the associated goods and services [*Ontario Teachers’ Pension Plan Board v Canada*, 2012 FCA 60]. Finally, one must apply common sense in determining descriptiveness [*Neptune SA v Canada (Attorney General)*, 2003 FCT 715].

[83] A trademark is clearly descriptive of the place of origin if the trademark, whether depicted, written or sounded, is a geographic name, and the associated goods or services originate from that geographic locale [*MC Imports Inc v AFOD Ltd*, 2016 FCA 60].

[84] The Opponent has not provided evidence of its own in support of this ground of opposition, and I am therefore not convinced it has met its burden under this ground. However, I also recognize that the Court has held that in determining whether a trade-mark is clearly descriptive or deceptively misdescriptive of the place of origin, beyond any evidence, I may also apply common sense [*Neptune SA v Canada (Procureur General)*, 2003, 29 CPR (4th) 497 (FC) and *Ontario Teachers’ Pension Plan Board v Canada*, 2011 FC 58 at para 29]. Additionally, I may exercise my discretion to take into account dictionary definitions for the words that make up the Mark [*Yahoo! Inc v audible.ca inc* (2009), 76 CPR (4th) 222 (TMOB)].

[85] The *Oxford Dictionary* defines NORWEGIAN as:

Adjective

Of or relating to Norway or its inhabitants

Noun

1. A native or inhabitant of Norway
2. The North Germanic language of Norway

[86] Judicial notice may also be taken that “.COM” merely refers to the top-level domain of a website address. It has been found that the addition of such a term is not sufficiently distinctive to render registrable an otherwise clearly descriptive trademark [see, for example, *London Drugs Limited v. Purepharm, Inc.* (2006), 54 C.P.R. (4th) 87].

[87] The word “Norwegian” is not a geographic name. It is a term used to describe natives or inhabitants of the country of Norway or the North Germanic language they speak [for an analogous finding for “Dutch,” see *Old Dutch Foods v 1904838 Ontario Inc*, 2016 TMOB 183].

The term NORWEGIAN may relate to the Goods and Services because they originate in Norway, but this does not equate to being clearly descriptive of the place of origin of the Goods and Services. Therefore, I conclude that the Mark is not a geographic name and cannot be considered clearly descriptive of the place of origin of the Goods and Services.

[88] Even if I am incorrect, the outcome of this analysis of clear descriptiveness would nonetheless be the same. In this regard, I note that the Court has held that the provisions of section 12(1)(b) are clear on their face and prohibit the registration of trademarks that are clearly descriptive when depicted, written or sounded. Therefore, trademarks comprising both word and design components offend section 12(1)(b) if the word portion is the dominant feature when depicted, written or sounded [*Best Canadian Motor Inns Ltd v Best Western International, Inc*, 2004 FC 135 and *Ottawa Athletic Club Inc (Ottawa Athletic Club) v Athletic Club Group Inc*, 2014 FC 672 at para 29]. However, in respect of the Mark, it is the PLANE & Design component which predominates and, as such, the combination of these other, more dominant components, used along-side NORWEGIAN, does not offend section 12(1)(b).

[89] Therefore, on a balance of probabilities, as of the material date, the Mark cannot be considered clearly descriptive of the place of origin of the Goods or Services, within the meaning of section 12(1)(b) of the Act.

DISPOSITION

[90] 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, for the Overlapping Services (1) and (2), namely:

- CI 39 [...] ships [...]; travel agency services, namely, travel agency services, namely, travel and tour information, travel and tour ticket purchase and reservation; [...]; [...] cruises, arranging tickets for sightseeing tours, arranging for local transportation at the travel destination and restaurant reservations; [...]; booking and reservation services for tours; travel agency services, namely making reservations and bookings of seats for travel; [...] travel agency services, namely making reservations and bookings for transportation, via a website on a global computer network; [...] sightseeing tour ticket and booking seats for travel via an interactive online website; [...]
- CI 43 Services for providing food and drink, namely, operation of a restaurant and operation of a take-out food and beverage facility; bar, cafe, snack-bar, cocktail lounge services, [...]; [...] restaurant reservation and booking; [...] restaurants.

and I reject the opposition, pursuant to section 38(12) of the Act, for the remaining Goods and Services, namely:

- CI 16 Brochures; printed matter, namely, airline boarding cards and tickets; travel and in-flight magazines; periodicals.
- CI 35 Advertising the goods and services for others; business management; business administration; sales and promotion, namely, a loyalty and rewards programs in the distribution and sale of air transportation services, customer loyalty services,

namely, administration of a frequent flyer program that allows members to purchase airline tickets using bonus points awarded through the purchase of flight segments and air fare classes, as well as through the purchase of goods or services from designated companies; retail services, in-flight sales services and Internet sales services for tobacco, cosmetics, clothing, watches, wine and liquor, jewelry and sunglasses; online retail services featuring pre-recorded audiovisual content, namely, television programs, movies, documentaries, pre-recorded downloadable music, music videos, pre-recorded musical performances, video games, pre-recorded downloadable sports events, pre-recorded animation and news programs; electronic transmission of news and data for ticket sale, namely, customer service in the field of airline reservations providing co-working facilities equipped with office equipment; incubation services, namely, providing work space containing business equipment and other amenities to emerging, start-up and existing companies; providing coworking, temporary and shared work spaces, offices, business event spaces, facilities and office equipment; business operation of commercial real estate, offices and office space, namely, shared office venues with conference facilities;

- CI 38 Telecommunications services, namely, providing access to the Internet;
- CI 39 Airline services, namely, air transportation services, namely, transportation of passengers, parcels, freight and cargo by air; air transport and travel services, namely, operation of an airline for the transportation of passengers and freight; transport of passengers and goods by automobiles, trains [...] and airplanes; [...]; travel agency and travel management services, namely, organizing all-inclusive vacation packages; air transportation for passengers, car rental, activity and travel services, namely, car rentals, rail travel, [...]; vehicle rental services; vehicle parking services, namely, airport parking, airport passenger shuttle services between the airport parking facilities and the airport and, operation of an airport parking facility; vehicle parking lot services; courier services; cargo storage and handling services; aircraft chartering services; [...]; electronic transmission of data and documents for business purposes via computer terminals from a computer-based database, namely, providing information in the field of travel and transportation and issuing airline tickets via a website; providing check-in and boarding services for air travel, namely, airline and check-in services via a website; [...]; providing reservation and ticket purchase services for car rentals [...]; providing check-in and boarding services for air travel, namely, airline schedules and airline check-in services via a website;
- CI 41 Arranging for the reservation and purchase of tickets for concerts, operas, museums, theme parks, and amusement parks; the provision of ski packages featuring ski lift tickets, ski instruction, ski equipment rentals, the provision of golf trip packages featuring course reservations, golf instruction, golf equipment rentals, soft adventure activities such as snowmobiling and rock-climbing;
- CI 43 [...] airport waiting lounge services [...]; hotel booking and reservation [...]; providing reservation and ticket purchase services for hotel rooms [...].

Coleen Morrison
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-10-31

APPEARANCES

For the Opponent: Julia Ryckman

For the Applicant: Adele Finlayson

AGENTS OF RECORD

For the Opponent: Fillmore Riley LLP

For the Applicant: Moffat & Co.