

**Federal Court of Appeal**



**Cour d'appel fédérale**

**Date: 20170315**

**Docket: A-559-15**

**Citation: 2017 FCA 53**

**CORAM: DAWSON J.A.  
RENNIE J.A.  
WOODS J.A.**

**BETWEEN:**

**BENJAMIN MOORE & CO. LIMITED**

**Appellant**

**and**

**HOME HARDWARE STORES LIMITED**

**Respondent**

Heard at Toronto, Ontario, on October 27, 2016.

Judgment delivered at Ottawa, Ontario, on March 15, 2017.

**REASONS FOR JUDGMENT BY:**

**WOODS J.A.**

**CONCURRED IN BY:**

**DAWSON J.A.  
RENNIE J.A.**

Federal Court of Appeal



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BETWEEN:

**BENJAMIN MOORE & CO. LIMITED**

**Appellant**

and

**HOME HARDWARE STORES LIMITED**

**Respondent**

**REASONS FOR JUDGMENT**

**WOODS J.A.**

[1] Benjamin Moore & Co. Limited has applied under section 30 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (Act) to register two trademarks: the word mark “BENJAMIN MOORE NATURA,” and the design mark depicted below. Both marks are to be used in association with interior and exterior paints.



[2] Home Hardware Stores Limited filed oppositions to the applications pursuant to section 38 of the Act. It asserts, among other things, that the Benjamin Moore marks are confusing with nine of Home Hardware's trademarks that include the term "natura." The Home Hardware marks are set out in Appendix A.

[3] Seven of the Home Hardware marks are registered design marks bearing two common features, the name of a product or product line and a stylized form of the term "natura." A typical example is the design mark that contains the words "natura wood prep", which is associated with a preparation to clean exterior wood.

[4] The other two Home Hardware marks are word marks that are not registered, and were at the relevant time the subject of pending applications for registration.

[5] One of these marks is "BEAUTI-TONE NATURA," which is used in association with paints and paint-related products. It is the only relevant Home Hardware mark used specifically with paints and is also the only relevant mark that includes the term "BEAUTI-TONE," which is a Home Hardware brand associated with paints.

[6] The other relevant Home Hardware word mark is “NATURA.” In the application for registration, this mark is associated with a diverse group of wares that does not include paints.

I. Procedural history

[7] Home Hardware’s oppositions were rejected by the Trade-marks Opposition Board (Board) in a decision dated September 29, 2014 (2014 TMOB 211). Central to the decision was a finding that there was no confusion between any of the Benjamin Moore and Home Hardware trademarks at any of the material dates at which confusion was to be determined.

[8] Home Hardware appealed this decision to the Federal Court pursuant to subsection 56(1) of the Act. In the Federal Court, Home Hardware introduced new material evidence pursuant to subsection 56(5) of the Act. As a result, the Federal Court undertook a *de novo* review of the matter.

[9] In a decision dated December 4, 2015, the Federal Court found that there was confusion between the trademarks, “particularly as those marks are used in association with paint” (reasons, paragraph 73). Accordingly, the Benjamin Moore applications for registration were refused (*Home Hardware Stores Limited v. Benjamin Moore & Co., Limited*, 2015 FC 1344, 139 C.P.R. (4th) 109).

[10] Benjamin Moore has appealed the judgment of the Federal Court to this Court.

II. Legislative framework

[11] The relevant statutory provisions are reproduced in Appendix B.

[12] Under section 38 of the Act, a person may oppose an application for registration of a trademark on any of the following grounds:

**(a)** that the application does not conform to the requirements of section 30;

**a)** la demande ne satisfait pas aux exigences de l'article 30;

**(b)** that the trade-mark is not registrable;

**b)** la marque de commerce n'est pas enregistrable;

**(c)** that the applicant is not the person entitled to registration of the trade-mark; or

**c)** le requérant n'est pas la personne ayant droit à l'enregistrement;

**(d)** that the trade-mark is not distinctive.

**d)** la marque de commerce n'est pas distinctive.

[13] The grounds of opposition above are linked to other provisions of the Act that provide requirements for registration. The registration requirements that are relevant in this appeal are set out below.

- (a) A trademark may not be registered if it is confusing with a registered trademark (paragraphs 38(2)(b) and 12(1)(d) of the Act). The determination of whether trademarks are confusing is made as at “the date where the matter is disposed of on the evidence adduced” (*Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 422, 130 N.R. 223 (F.C.A.)).

- (b) An applicant is not entitled to register a proposed trademark if it is confusing with a trademark that had been previously used in Canada or made known in Canada by any other person (paragraphs 38(2)(c) and 16(3)(a) of the Act). This determination is made at the date of filing the application for registration (subsection 16(3) and *Park Avenue Furniture*, at 422).
  
- (c) An applicant is not entitled to register a proposed trademark if it is confusing with a trademark in respect of which an application for registration by any other person is pending (paragraphs 38(2)(c) and 16(3)(b), and subsection 16(4) of the Act). This is to be determined at the date of filing the application for registration (subsection 16(3) and *Park Avenue Furniture*, at 422).
  
- (d) A trademark may not be registered if it is not distinctive. The term “distinctive” is defined to mean that the trademark actually distinguishes the goods or services from the goods or services of others, or is adapted to distinguish them (paragraph 38(2)(d) and section 2 of the Act). This is to be determined at the date of filing the statement of opposition (*Park Avenue Furniture*, at 423-424).

[14] Section 6 of the Act provides the framework for determining whether one trademark is confusing with another. In general, the test is whether the use of both marks in the same area would be likely to lead to the inference that the relevant goods or services are manufactured or sold by the same person. For this purpose, the term “use” is given an expansive meaning in section 4 of the Act.

[15] Subsection 6(5) sets out the considerations to be taken into account in the confusion analysis. It provides that all the surrounding circumstances are to be considered, including:

- |   |  |
|---|--|
| <b>(a)</b> the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;             | <b>a)</b> le caractère distinctif inhérent des marques de commerce ou noms commerciaux, et la mesure dans laquelle ils sont devenus connus;                  |
| <b>(b)</b> the length of time the trade-marks or trade-names have been in use;  | <b>b)</b> la période pendant laquelle les marques de commerce ou noms commerciaux ont été en usage;  |
| <b>(c)</b> the nature of the goods, services or business;   | <b>c)</b> le genre de produits, services ou entreprises;   |
| <b>(d)</b> the nature of the trade; and   | <b>d)</b> la nature du commerce;   |
| <b>(e)</b> the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them. | <b>e)</b> le degré de ressemblance entre les marques de commerce ou les noms commerciaux dans la présentation ou le son, ou dans les idées qu'ils suggèrent. |

### III. Federal Court decision

[16] As mentioned above, the Federal Court concluded that the Benjamin Moore and Home Hardware trademarks were confusing, particularly the parties' trademarks used in association with paints.

[17] The reasons for this conclusion were summarized in paragraphs 72 and 73 of the decision, and are reproduced below at paragraph 27. I need only say that the Federal Court concluded that most of the relevant factors in the confusion analysis favoured Home Hardware.

[18] Although this conclusion is quite different from the Board's, it is not disputed that the Federal Court was entitled to undertake a *de novo* consideration of the matter on the basis that new material evidence was introduced that was not before the Board.

IV. Position of Benjamin Moore

[19] In this appeal, Benjamin Moore seeks an order that the Registrar of Trade-marks be directed to allow its applications for registration. It submits that the Federal Court's reasons contain three main errors of law: (1) there is no separate mark to mark comparative confusion analysis; (2) the grounds of opposition are not analyzed separately; and (3) the proper material dates are not applied when considering each ground of opposition.

V. Position of Home Hardware

[20] Home Hardware submits that the Federal Court did not fail to undertake a mark to mark analysis, or to separately address the grounds of opposition, or to apply the proper material dates. It submits that the judge undertook a proper analysis in a pragmatic fashion. Nor did the judge err in his consideration of the term "natura."

[21] Further, Home Hardware submits that the Federal Court's decision is correct because its family of NATURA trademarks provides strong prior established rights.



VI. Analysis

[22] In paragraph 73 of its reasons, the Federal Court concluded that there would likely be confusion between the trademarks, and particularly the marks used in association with paints. I will first consider whether there was a proper confusion analysis with respect to the trademarks generally, and then consider the Federal Court's confusion analysis with respect to the marks used in association with paints.

A. *Did the Federal Court undertake a proper confusion analysis?*

[23] It is well-established that a confusion analysis under the Act must be undertaken on a mark to mark basis (*Masterpiece Inc. v. Alavida Lifestyles Inc.*, 2011 SCC 27, [2011] 2 S.C.R. 387, paragraph 45) and that the appropriate material dates should be applied to each ground of opposition.

[24] For the reasons below, I do not agree with Home Hardware that the Federal Court applied a proper mark to mark analysis and took into account the relevant material dates for each ground of opposition. These deficiencies represent errors of law, which are to be reviewed on a standard of correctness (*Housen v. Nikolaisen*, 2002 SCC 33, [2002] 2 S.C.R. 235).

[25] In its confusion analysis, the Federal Court undertakes a consideration of each relevant surrounding circumstance as required by subsection 6(5) of the Act. However, distinctions between the parties' respective marks and particular material dates are expressed in a very general manner. For example, in considering distinctiveness, the Federal Court concludes that

the distinctiveness factor “overall favours [Home Hardware], even if only slightly with respect to some of its trade-marks at some of the material dates” (reasons, paragraph 38).

[26] This deficiency permeates the entire decision, to the point that I conclude that a proper mark to mark comparison at the appropriate material dates was not undertaken.

[27] The Federal Court’s conclusion at paragraphs 72 and 73 of the reasons illustrates this.

[72] Summarising the conclusions I reached above:

- 1) the distinctiveness factor slightly favours the applicant;
- 2) the length of use factor slightly favours the applicant;
- 3) the nature of the wares factor weighs in favour of the applicant;
- 4) there is some overlap in the channels of trade;
- 5) the degree of resemblance factor favours the applicant; and
- 6) the “family of trademarks” argument supports the applicant’s position;

[73] Therefore, I find that an ordinary consumer would likely be confused as to whether the parties’ trade-marks originate from the same source, particularly as those marks are used in association with paint, notwithstanding the modifying aspects of BEAUTI-TONE and BENJAMIN MOORE respectively. In my opinion, as a matter of first impression, a casual consumer somewhat in a hurry who encounters BENJAMIN MOORE NATURA paint, when that consumer has no more than an imperfect recollection of BEAUTI-TONE NATURA paint, would likely be confused as to the source of these wares, at least as of the later material dates when the Applicant’s NATURA brand had acquired particular distinctiveness in respect of paint. A consumer would likely be confused as to whether the Respondent’s trade-mark originates from the same source as the Applicant’s trade-mark.

[28] It is especially important to undertake a separate mark to mark comparison at the appropriate material dates because otherwise it is impossible to undertake a proper weighing of the confusion factors in subsection 6(5).

[29] Home Hardware suggests that it is not necessary to conduct a separate trademark to trademark confusion analysis in this particular case because it owns a family of “NATURA” trademarks that have been built up over several years (Respondent’s Memorandum, paragraph 50). In this regard, Home Hardware introduced new evidence in the Federal Court to establish that it had extensively used trademarks with the term “NATURA” on environmentally-friendly wares, which included wares that were not listed in the statements of opposition.

[30] The concept of a “family of marks” has been recognized in the Federal Court for many years. It was almost 20 years ago that the protection afforded by a family of marks was described by this Court in *Techniquip Ltd. v. Canadian Olympic Assn.*, 3 C.P.R. (4th) 298, 1999 CarswellNat 2511:

[15] The notion of a family of marks was developed in the context of proceedings under section 6 of the Act. In *Molnlycke Aktiebolag v. Kimberly-Clark of Canada Ltd.*, Cattanach J. explained:

If these are a series of marks all having the same features and are all owned by the same trader then this is a circumstance which must reflect adversely upon an applicant for a mark containing that common feature since the public might think that such a mark indicated goods coming from the same source as the goods covered by the other marks.

[...]

If those marks which have common characteristics are registered in the names of different owners then the presumption is that the common characteristic is a common feature in the trade and registration ought to be allowed. The fact that the marks are owned by different persons tends to negative any proprietorial significance of the common feature and so assists an applicant.

[31] Home Hardware's use of a family of "NATURA" trademarks is relevant to the mark to mark comparative analysis because such use may increase the likelihood of confusion between Benjamin Moore's "natura" products and any or all of Home Hardware's trademarks set out in Appendix A. Several factors may potentially influence this consideration, including the extent to which the Home Hardware family of marks have become known. In addition, the likelihood of confusion may possibly be decreased because of the fact that the Benjamin Moore trademarks do not use the term "natura" on their own but in conjunction with the company name, "Benjamin Moore." Further, Benjamin Moore submits the likelihood of confusion is decreased because a form of the term "natura" is commonly used by other companies. All relevant circumstances should be considered in considering how the family of marks affects the confusion analysis.

[32] Although Home Hardware's "family of marks" is relevant to this case, I do not agree with the submission of Home Hardware that as a result it is not necessary to undertake a mark to mark confusion analysis taking into account the relevant material dates. The jurisprudence does not support this and it conflicts with the relevant statutory provisions. The use of a family of marks does not obviate the need to undertake a full comparative confusion analysis on a mark to mark basis for each relevant ground of opposition.

[33] I now turn to the Federal Court's specific confusion analysis with respect to the paints trademarks.

B. *Did the Federal Court err in concluding that the paints trademarks were confusing?*

[34] As mentioned earlier, the Federal Court made a specific finding of confusion with respect to trademarks associated with paints (reasons, paragraph 73). The relevant trademarks are the word mark “BENJAMIN MOORE NATURA,” the related Benjamin Moore design mark, and Home Hardware’s word mark “BEAUTI-TONE NATURA.”

[35] Since Home Hardware’s paints trademark was not registered, paragraph 16(3)(b) of the Act is the relevant provision relating to confusion.

[36] The identification of the relevant provision is significant in this case because it affects the material date. This date for the purpose of paragraph 16(3)(b) is the date of Benjamin Moore’s applications for registration, which was January 9, 2009. This is the earliest of all the relevant material dates in this matter and at that date neither party was selling paints with these trademarks. Home Hardware started selling paints using “BEAUTI-TONE NATURA” shortly after January 9, 2009 and Benjamin Moore commenced sales of paint using “BENJAMIN MOORE NATURA” in April 2009.

[37] In my view, the Federal Court erred in its confusion analysis by not limiting its consideration to the earliest material date with respect to the paints trademarks. There are several aspects of the reasons that lead me to this conclusion.

[38] First, the Federal Court inexplicably does not mention paragraph 16(3)(b) of the Act as being at issue in the appeal (reasons, paragraph 20). This is a significant omission because this is the only provision that requires a confusion analysis for the paints trademarks.

[39] Second, throughout its confusion analysis the Federal Court refers to actual sales of paint as a factor to be considered. Examples are with respect to distinctiveness (reasons, paragraphs 37 and 38), length of use (reasons, paragraph 41), and resemblance (reasons, paragraph 51). In general, sales are an irrelevant consideration to the confusion analysis with respect to the paints trademarks because neither party was selling paints with these trademarks at the material date.

[40] Third, in paragraph 73 of the reasons the Federal Court concludes that consumers would likely be confused as to the source of paint associated with these trademarks “at least as of the later material dates.” The later material dates are not relevant to this analysis. Only the earliest material date, January 9, 2009, is relevant.

[41] The only conclusion that can reasonably be drawn from the reasons as a whole is that the Federal Court applied the wrong material dates in determining that the paints trademarks were confusing. This is an error of law.

## VII. Conclusion

[42] The errors in the Federal Court’s reasons go to the heart of its conclusion. However, since most of the surrounding circumstances were found by the Federal Court to be in Home Hardware’s favour, I have considered whether the errors would have made a difference in the outcome. Taking the reasons as a whole into account, and especially the importance that the Federal Court placed on sales of paint, I am not convinced that the overall conclusion would have been the same if a proper analysis had been undertaken.

[43] The question then is whether this Court should give the judgment that the Federal Court should have given or whether it should return the matter to the Federal Court for an initial determination on the merits. While this Court may give the judgment the Federal Court should have given, it is normally preferable to remit a matter to the Federal Court when the matter involves the assessment of evidence. This is especially the case where the Board did not consider the merits of Home Hardware's opposition to the marks on the full evidentiary record.

[44] In the result, I would allow the appeal with costs here and below, set aside the judgment of the Federal Court, and refer the matter back to the Federal Court for redetermination in accordance with these reasons.

"Judith M. Woods"








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J.A.

"I agree  
Eleanor R. Dawson J.A."

"I agree  
Donald J. Rennie J.A."

APPENDIX A  
Home Hardware Trademarks

| Trade Mark  | App./Reg. No.              | Wares/Services  |
|---|----------------------------|---|
|    | TMA661,115<br>(Registered) | Granular and water soluble fertilizers, weed eliminators, namely, a natural product whether in granular or liquid form that would be used to kill weeds or vegetation; compost and compost activators, namely, a formulation that speeds the decay of compost of garden and/or household waste.   |
|    | TMA736,137<br>(Registered) | Safe, ready to use chemical product for quickly removing mildew stains from non-metal exterior surfaces such as wood, brick, concrete, plastic, vinyl siding and stone.   |
|    | TMA698,311<br>(Registered) | A cleaning solution used prior to painting, namely, an environmentally friendly liquid to etch a floor or prep a surface for painting.  |
|    | TMA702,664<br>(Registered) | A cleaning solution used prior to painting, namely, an environmentally friendly liquid to prep a surface for painting.  |
|    | TMA739,190<br>(Registered) | Safe, ready to use preparation for removing water-based, oil-based, solid or semi-transparent stains and paint from exterior wood surfaces.   |
|  | TMA732,563<br>(Registered) | Dryer sheets.   |
|  | TMA738,815<br>(Registered) | A safe, ready to use preparation for cleaning and brightening grey weathered exterior wood.   |
| BEAUTI-TONE<br>NATURA   | 1,422,393<br>(Opposed)     | Interior paint, namely, ceiling paint, interior latex, kitchen and bathroom enamel, interior alkyd melamine, trim and door, primer; wall textures; speciality coatings, namely, clear coat, acrylic sealers, glazing liquid; exterior paint, namely, interior/exterior porch and floor enamel, interior/exterior gloss enamel, exterior semi-gloss enamel, latex exterior silk, primer, deck and siding stain; wood restorer; waterproofing sealant; water repellent clear sealer; paint and varnish removers; brush and roller cleaner; wood filler; hardwood floor reviver; interior wood stain; wood conditioner; sanding sealer; clear coat wood finish; rust paint; spray paint. |
| NATURA  | 1,294,003<br>(Allowed)     | Wood preservative, natural wood stripper, cat litter, sea sponges, ice melt, burlap wrapping, peat moss.  |



## APPENDIX B

*Trade-marks Act*, R.S.C., 1985, c. T-13**Definitions**

**2** In this Act,

...

*distinctive*, in relation to a trade-mark, means a trade-mark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or is adapted so to distinguish them; (*distinctive*)

**When mark or name confusing**

**6 (1)** For the purposes of this Act, a trade-mark or trade-name is confusing with another trade-mark or trade-name if the use of the first mentioned trade-mark or trade-name would cause confusion with the last mentioned trade-mark or trade-name in the manner and circumstances described in this section.

**(2)** The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or

**Définitions**

**2** Les définitions qui suivent s'appliquent à la présente loi.

[...]

*distinctive* Relativement à une marque de commerce, celle qui distingue véritablement les produits ou services en liaison avec lesquels elle est employée par son propriétaire, des produits ou services d'autres propriétaires, ou qui est adaptée à les distinguer ainsi. (*distinctive*)

**Quand une marque ou un nom crée de la confusion**

**6 (1)** Pour l'application de la présente loi, une marque de commerce ou un nom commercial crée de la confusion avec une autre marque de commerce ou un autre nom commercial si l'emploi de la marque de commerce ou du nom commercial en premier lieu mentionnés cause de la confusion avec la marque de commerce ou le nom commercial en dernier lieu mentionnés, de la manière et dans les circonstances décrites au présent article.

**(2)** L'emploi d'une marque de commerce crée de la confusion avec une autre marque de commerce lorsque l'emploi des deux marques de commerce dans la même région serait susceptible de faire conclure que les produits liés à ces marques de commerce sont fabriqués, vendus, donnés à bail ou loués, ou que les

services are of the same general class.

services liés à ces marques sont loués ou exécutés, par la même personne, que ces produits ou ces services soient ou non de la même catégorie générale.

...

[...]

**(5)** In determining whether trade-marks or trade-names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including

**(5)** En décidant si des marques de commerce ou des noms commerciaux créent de la confusion, le tribunal ou le registraire, selon le cas, tient compte de toutes les circonstances de l'espèce, y compris :

**(a)** the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;

**a)** le caractère distinctif inhérent des marques de commerce ou noms commerciaux, et la mesure dans laquelle ils sont devenus connus;

**(b)** the length of time the trade-marks or trade-names have been in use;

**b)** la période pendant laquelle les marques de commerce ou noms commerciaux ont été en usage;

**(c)** the nature of the goods, services or business;

**c)** le genre de produits, services ou entreprises;

**(d)** the nature of the trade; and

**d)** la nature du commerce;

**(e)** the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them.

**e)** le degré de ressemblance entre les marques de commerce ou les noms commerciaux dans la présentation ou le son, ou dans les idées qu'ils suggèrent.

### **When trade-mark registrable**

### **Marque de commerce enregistrable**

**12 (1)** Subject to section 13, a trade-mark is registrable if it is not

**12 (1)** Sous réserve de l'article 13, une marque de commerce est enregistrable sauf dans l'un ou l'autre des cas suivants :

...

[...]

**(d)** confusing with a registered trade-mark;

**d)** elle crée de la confusion avec une marque de commerce déposée;

...

[...]

**Registration of marks used or made known in Canada**

...

**16 (3)** Any applicant who has filed an application in accordance with section 30 for registration of a proposed trade-mark that is registrable is entitled, subject to sections 38 and 40, to secure its registration in respect of the goods or services specified in the application, unless at the date of filing of the application it was confusing with

(a) a trade-mark that had been previously used in Canada or made known in Canada by any other person;

(b) a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person; or

...

**Where application for confusing mark pending**

**16 (4)** The right of an applicant to secure registration of a registrable trade-mark is not affected by the previous filing of an application for registration of a confusing trade-mark by another person, unless the application for registration of the confusing trade-mark was pending at the date of advertisement of the applicant's application in accordance with section 37.

**Enregistrement des marques employées ou révélées au Canada**

[...]

**16 (3)** Tout requérant qui a produit une demande selon l'article 30 en vue de l'enregistrement d'une marque de commerce projetée et enregistrable, a droit, sous réserve des articles 38 et 40, d'en obtenir l'enregistrement à l'égard des produits ou services spécifiés dans la demande, à moins que, à la date de production de la demande, elle n'ait créé de la confusion :

(a) soit avec une marque de commerce antérieurement employée ou révélée au Canada par une autre personne;

(b) soit avec une marque de commerce à l'égard de laquelle une demande d'enregistrement a été antérieurement produite au Canada par une autre personne;

[...]

**Si une demande relative à une marque créant de la confusion est pendante**

**16 (4)** Le droit, pour un requérant, d'obtenir l'enregistrement d'une marque de commerce enregistrable n'est pas atteint par la production antérieure d'une demande d'enregistrement d'une marque de commerce créant de la confusion, par une autre personne, à moins que la demande d'enregistrement de la marque de commerce créant de la confusion n'ait été pendante à la date de l'annonce de la demande du

requérant selon l'article 37.

### **Statement of opposition**

**38 (1)** Within two months after the advertisement of an application for the registration of a trade-mark, any person may, on payment of the prescribed fee, file a statement of opposition with the Registrar.

### **Grounds**

**(2)** A statement of opposition may be based on any of the following grounds:

**(a)** that the application does not conform to the requirements of section 30;

**(b)** that the trade-mark is not registrable;

**(c)** that the applicant is not the person entitled to registration of the trade-mark; or

**(d)** that the trade-mark is not distinctive.

### **Appeal**

**56 (1)** An appeal lies to the Federal Court from any decision of the Registrar under this Act within two months from the date on which notice of the decision was dispatched by the Registrar or within such further time as the Court may allow, either before or after the expiration of the two months.

...

**(5)** On an appeal under subsection (1), evidence in addition to that adduced

### **Déclaration d'opposition**

**38 (1)** Toute personne peut, dans le délai de deux mois à compter de l'annonce de la demande, et sur paiement du droit prescrit, produire au bureau du registraire une déclaration d'opposition.

### **Motifs**

**(2)** Cette opposition peut être fondée sur l'un des motifs suivants :

**a)** la demande ne satisfait pas aux exigences de l'article 30;

**b)** la marque de commerce n'est pas enregistrable;

**c)** le requérant n'est pas la personne ayant droit à l'enregistrement;

**d)** la marque de commerce n'est pas distinctive.

### **Appel**

**56 (1)** Appel de toute décision rendue par le registraire, sous le régime de la présente loi, peut être interjeté à la Cour fédérale dans les deux mois qui suivent la date où le registraire a expédié l'avis de la décision ou dans tel délai supplémentaire accordé par le tribunal, soit avant, soit après l'expiration des deux mois.

[...]

**(5)** Lors de l'appel, il peut être apporté une preuve en plus de celle qui a été

before the Registrar may be adduced and the Federal Court may exercise any discretion vested in the Registrar.

fournie devant le registraire, et le tribunal peut exercer toute discrétion dont le registraire est investi.

**FEDERAL COURT OF APPEAL**

**NAMES OF COUNSEL AND SOLICITORS OF RECORD**

**DOCKET:** A-559-15

**APPEAL FROM A JUDGMENT OF THE HONOURABLE MR. JUSTICE CAMP  
DATED DECEMBER 4, 2015, NO. T-2441-14**

**STYLE OF CAUSE:** BENJAMIN MOORE & CO.  
LIMITED v. HOME HARDWARE  
STORES LIMITED

**PLACE OF HEARING:** TORONTO, ONTARIO

**DATE OF HEARING:** OCTOBER 27, 2016

**REASONS FOR JUDGMENT BY:** WOODS J.A.

**CONCURRED IN BY:** DAWSON J.A.  
RENNIE J.A.

**DATED:** MARCH 15, 2017

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