



THE REGISTRAR OF TRADE-MARKS
LE REGISTRAIRE DES MARQUES DE COMMERCE

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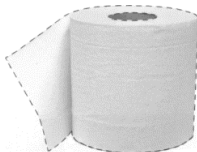
TRANSLATION

IN THE MATTER OF AN OPPOSITION

| | |
|------------------------------------------------------------------------|--------------------|
| Kruger Products L.P. | Opponent |
| and | |
| Cascades Canada ULC | Applicant |
| 1,540,778 for the trade-mark Beige- coloured roll (Drawing) | Application |

Introduction

[1] Kruger Products L.P. (the Opponent) opposes registration of the trade-mark illustrated hereinafter, covered by application No. 1,540,778 in the name of Cascades Canada ULC (the Applicant).



[2] The application indicates that the mark "consists of the colour beige applied to the entire visible surface of the object shown in the drawing, namely, toilet paper" (the Mark).

[3] This application, filed on August 23, 2011, is based on the proposed use of the Mark in association with "toilet paper".

[4] The grounds of opposition raised pursuant to subsection 38(2) of the Trade-marks Act, R.S.C. 1985, c T-13 (the Act) essentially allege that:

- the Mark is not distinctive of the Applicant's products [s. 38(2)(d) / s. 2 of the Act];
- the Mark is not registrable because, due to an ordinary and bona fide commercial practice, the Mark has become recognized in Canada as designating the kind, quality or value of toilet paper products [s. 38(2)(b) / s. 12(1)(e) and 10 of the Act];
- the Mark is not registrable because it is clearly descriptive or deceptively misdescriptive of the character or quality of the "toilet paper" [s. 38(2)(b) / s. 12(1)(b) of the Act];
- the application does not contain a drawing of the Mark constituting an exact representation of that mark [s. 38(2)(a) / s. 30(h) of the Act]; and
- the Applicant had not intended to use the Mark in Canada [s. 38(2)(a) / s. 30(e) of the Act].

[5] For the following reasons, I consider it appropriate to refuse the application.

The record

[6] The statement of opposition was filed on June 13, 2012. The grounds of opposition raised pursuant to section 38(2) of the Act are reproduced in their entirety in Appendix A hereto.

[7] The Applicant filed a counter statement denying each of the grounds of opposition.

[8] The Opponent's Evidence consists of the affidavits of Jay Candide, including its Exhibits 1 to 11, and David Morrison, including its Exhibits 1 to 54. Messrs. Candido and Morrison were cross-examined. The transcription of each cross-examination is in the record.

[9] The Applicant's Evidence consists of 25 certificates of authenticity of trade-mark registrations and a statutory declaration by Thelma Thibodeau, including its Exhibits TT-1 and TT-2. Ms. Thibodeau was not cross-examined.

[10] Each party filed a written argument and was represented at the hearing.

Relevant dates

[11] The relevant dates for considering the circumstances in regard to the grounds of opposition in the case at bar are the following:

- s. 38(2)(d) / s. 2 of the Act: the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc. v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)];
- s. 38(2)(b) / s. 12(1)(e) and 10 of the Act : the date of my decision [see *Canadian Olympic Association v Allied Corporation* (1989), 28 CPR (3d) 161 (FCA) and *Canadian Olympic Association v Olympus Optical Company Limited* (1991), 38 CPR (3d) 1 (FCA)];
- s. 38(2)(b) / s. 12(1)(b) of the Act: the filing date of the application for registration [see *Fiesta Barbeques Limited v General Housewares Corporation* (2003), 28 CPR (4th) 60 (FC)]; and
- s. 38(2)(a) / s. 30 of the Act: the filing date of the application for registration [see *Georgia-Pacific Corp. v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)].

The legal onus on the Parties

[12] The legal onus is on the Applicant to show that the application for registration does not contravene the provisions of the Act. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, the Opponent must discharge the initial burden of proving the facts on which it bases its allegations. The fact that an initial evidential burden is imposed on the Opponent means that a ground of opposition will be taken into consideration only if sufficient evidence exists to allow a

reasonable conclusion of the existence of the facts alleged in support of this ground of opposition [see *John Labatt Ltd. v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA); and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FC)].

The questions in the case at bar

[13] I identified five questions arising from the grounds of opposition in the case at bar, namely:

1. Was the Mark distinctive of the Applicant's products as of June 13, 2012?
2. Has the Mark today become recognized in Canada as designating the kind, quality or value of the "hygienic paper" with which it is associated?
3. Was the Mark clearly descriptive or deceptively misdescriptive of the character or quality of the "hygienic paper" with which it was associated at August 23, 2011?
4. Did the application contain a drawing of the Mark constituting an exact representation thereof at August 23, 2011?
5. Could the Applicant have intended to use the Mark in Canada on August 23, 2011?

[14] Before analyzing these questions, I will review the evidence of record, beginning with the Opponent's Evidence and followed by the Applicant's Evidence.

Opponent's Evidence

[15] In reviewing the affidavits of Messrs. Candido and Morisson (sic), I will refer to passages from their respective cross-examinations to the extent they are relevant in view of the evidence and the representations of the parties, in particular those of the Applicant.

Affidavit of Jay Candido made on December 20, 2012

[16] Mr. Candido identifies himself as the Opponent's "*Director of Marketing and Operations - Away from Home*", a position he has held since January 2012. Mr. Candido specifies in his affidavit that he has been employed by the Opponent since May 2002 (however, he corrected this information under cross-examination, indicating that he has been employed by the Opponent since May 2003 [Q20]). Mr. Candido declares he has always been directly involved in sales, marketing and promotion for several of the Opponent's paper product lines [para. 1 of the affidavit].

[17] Mr. Candido begins his affidavit with information about the Opponent and its business.

[18] According to Mr. Candido, the Opponent is the leading manufacturer and distributor of facial tissues and paper towels for "in-home use" in Canada. The Opponent is also a leading supplier of paper products for "away from home (AFH) use" [para. 3 of the affidavit].

[19] Mr. Candido explains that the Opponent's "in-home hygienic paper products", including facial tissues, wipers, toilet paper and napkins, are sold under a number of marks, including CASHMERE, SCOTTIES, SPONGETOWELS, WHITE SWAN and WHITE CLOUD [para. 4 of the affidavit]. The Opponent's "AFH hygienic paper products", including facial tissues and toilet paper, hand towels, paper towels, napkins and hand care products, are also sold under a number or marks, including EMBASSY, ESTEEM and WHITE SWAN [para. 5 of the affidavit].

[20] Still according to Mr. Candido, the Opponent's Away From Home Division serves important market sectors, including the hospitality, restaurant, property management and healthcare sectors. The products ultimately are used by consumers in thousands of establishments across Canada, including hotels, restaurants, office buildings and hospitals [para. 5 of the affidavit].

[21] Mr. Candido attaches to his affidavit a selection of pages from the Opponent's websites (www.krugerproducts.ca and www.afhkrugerproducts.ca), illustrating hygienic paper products for in-home and away from home use [para. 6 and Exhibit 1 of the affidavit].

[22] Mr. Candido then discusses off-white, beige or brown hygienic paper products marketed by the Opponent and third parties in Canada. He declares the following:

7. *Beige, brown and off-white and similar shades and colours naturally occur in the paper-making process if paper fibres are not bleached white or dyed another colour. Paper products made with such beige, brown and off-white paper are often referred to as "kraft paper" within the industry.*
8. *Kruger's products, and those of many of our competitors, feature the colour beige, brown or off-white when those products are unbleached. These colours now signal that hygienic paper products are environmentally-friendly or low cost, because the associated products have neither been bleached nor dyed in the manufacturing process. Light brown tissue products have been sold in Canada for many decades.*

[23] Reading the Opponent's off-white, beige and brown hygienic paper products, Mr. Candido reproduces, in paragraph 10 of his affidavit, a table identifying a selection of those sold in Canada at the date of his affidavit. He affirms these products have been sold by the Opponent for at least ten years in the same formats or comparable formats. Pages from the website (apparently *kruger.com/afh*) giving a description of each of the listed products, including an illustration, are attached to the affidavit [para. 10 and Exhibits 2 to 10 of the affidavit]. To reflect the strength of this evidence, I reproduce in Appendix B of my decision a table from the Opponent's written argument, associating the pictures of the products illustrated in Exhibits 2 to 10 of the affidavit (in colour in the written argument) with the descriptions found in paragraph 10 of the affidavit.

[24] According to Mr. Candido's assertions, the Opponent promotes its off-white, beige and brown hygienic paper products through its websites and targeted advertising for existing and potential customers. A sales record for products associated with the ESTEEM mark is attached to the affidavit as an example of targeted advertising [para. 11 to 12 and Exhibit 11 of the affidavit].

[25] During his cross-examination, Mr. Candido was questioned on the Opponent's practice of advertising or not advertising the fact that a product is manufactured by "*using an unbleached process*". According to Mr. Candido's testimony, this fact is reflected consistently on the page of the website concerning a product, but not necessarily in the documentation [page 15 of the

transcript]. As demonstrated by the following excerpt from his cross-examination, Mr. Candido admitted it was hard for him to say how consumers perceive an unbleached process [page 17 of the transcript]:

71 *Q. If you say it's not entirely consistent, this is mentioned of the fact that -- the product is using an unbleachable process, does the message get a cross [sic] that such an unbleached process is carried out?*

A. That all depends on the perception of the consumer or consumers, right, so --

72 *Q. Do you have any knowledge of that?*

A. In many cases they may have knowledge that it's unbleached, in other cases they may not, and may not even think about it in that regard. So it would be hard for me to say --

73 *Q. About the perception of the consumer?*

A. Right.

[26] I will take a break in review of the evidence to discuss an observation by the Applicant regarding Mr. Candido's testimony concerning the beige hygienic paper products marketed by the Opponent.

[27] The Applicant claims that it must be concluded from Mr. Candido's testimony that the Opponent's only products that are beige, namely "wipers", are not even the natural result of a manufacturing process in which the fibres are not bleached or dyed.

[28] To explain the basis of the Applicant's claim, I consider it useful to reproduce excerpts from its written argument below.

33. [...] The documents mentioned [in paragraph 10] and attached to the affidavit, namely Exhibits 2 to 10, are pages taken from the Opponent's website, which give a description of each of the "off-white", "beige" and "brown" products in question:

[...]

34. If we examine all these exhibits, Exhibits 2 to 9 are for "hand towels", which are identified as "brown", while Exhibit 10 is for "wipers", which are identified as "beige".

35. In examining the different documents attached to Jay Candido's affidavit, it is noted that in Exhibits 2 to 9, i.e. the "hand towels", which are identified as "brown", there is still an indication "Made from 100% recycled fibre and over 88% post-consumer content using an unbleached process" (our underlining). For example, Exhibit 2 of the Candido affidavit shows the following indication:

- An economical choice that helps protect our environment
- Acceptable dispensing performance and strength
- Superior workmanship and consistent quality that end-users can depend on
- Made from 100% recycled fibre and over 88% post-consumer content using an unbleached process

36. However, for Exhibit 10, for the "wipers", namely the only products identified as "beige", the indication "using an unbleached process" is absent, as shown by the following excerpt from Exhibit 10:

- Embossed, multi-purpose paper wiper appropriate for manufacturing and general cleaning purposes
- Pulp based, therefore absorbent and able to soak up spills quickly
- Economical option for use and toss applications
- Made with 100% recycled fibre and over 88% post-consumer content

[...]

38. While Jay Candido indicates [under cross-examination] that the information concerning the use of an "unbleached process" is mentioned in a "consistent" manner on the Opponent's website, we must conclude that the produce advertised on the site in question and reproduced in Tab 10, namely the "beige" wipers, does not use an "unbleached process", because this process is not mentioned. [...]

[29] I respectfully consider that the Applicant is getting lost in speculation about the reasons for the absence of the indication "*using an unbleached process*" on the page of the Opponent's website filed in Exhibit 10. The Applicant has not convinced me that it must be concluded from Mr. Candido's testimony that the Opponent's only beige products are not even the natural result of a process in which the fibres are neither bleached nor dyed

[30] I will now resume my review of Mr. Candido's affidavit by reproducing below his representations regarding off-white, beige or brown hygienic paper products marketed by third parties:

13. *In the tissue paper industry in Canada, it is and has been common for many of our competitors to produce and sell unbleached tissue products, which are beige or off-white. I am personally familiar with the sales and marketing across Canada of a number of these products, including those manufactured by Georgia Pacific, Wasau Paper and Seventh Generation. I have also seen private labels brands of unbleached off-white hygienic paper products, now sold across Canada through Shopper Drug Mart under the BIO-LIFE brand. In recent years, it has become increasingly common for food retailers in the fast food industry to supply their customers with beige or light brown napkins (such as those illustrated by the marketplace evidence gathered for this proceeding).*
14. *I have reviewed the Affidavit of David Morrison, which includes print-outs from the webpages of these competitors in Canada, along with samples products. I confirm that the selected pages from these websites, and the actual samples, accurately represent the unbleached tissue products that are now and have been sold or distributed in Canada.*
15. *It is understood in our market that the colour brown or beige serves to identify a product characteristic (unbleached fibres) rather than a specific source for the product. Many of our competitors are now using the colours beige, brown or off-white to signal that their hygienic paper products are “environmentally-friendly” or low cost, because these colours convey that product feature, namely that such products have neither been bleached nor dyed.*

[31] Mr. Candido continues his affidavit by making representations concerning the sale of toilet paper rolls. He declares, in particular, that upon their sale or transfer to consumers, these products generally are obscured by wrapping or packaging, at least in part and in some cases completely. He declares that a single unwrapped and partially unwound roll, such as the one illustrated by the Mark, would not be sold to a consumer [para.17 of the affidavit]. Under cross-examination, Mr. Candido indicated he does not know all the points of sale of the Applicant's products [Q74 to Q75].

[32] To conclude my review of Mr. Candido's affidavit, I note that I do not attach any weight to his opinion that the Mark is not distinctive [para. 19 of the affidavit]. This is a question of fact and law that it is up to the Registrar to settle in the case at bar.

Affidavit of David Morrison made on December 21, 2012

[33] At the date of his affidavit, Mr. Morrison was a law student employed by the Opponent's trade-mark agents. He was no longer employed by them at the time of his cross-examination [Q14].

[34] Before beginning my review of the evidence presented by Mr. Morrison, I must discuss the Applicant's implicit argument that I should not take Mr. Morrison's affidavit into account because he is providing opinion testimony on contested questions [see *Cross-Canada Auto Body Supply (Windsor) Limited et al v Hyundai Auto Canada* (2005), 43 CPR (4th) 21 (FC); upheld by 53 CPR (4th) 286 (FCA) (*Cross-Canada*)].

[35] I agree with the Applicant that, as a law student employed by the Opponent's trade-mark agents, Mr. Morrison cannot be considered an independent witness with a totally objective deposition. Nonetheless, a reasonable reading of his affidavit leads me to conclude that Mr. Morrison is not expressing opinions, or making assertions that can be likened to opinions, that must be excluded from the evidence in application of the *Cross-Canada* decision. I therefore will consider the evidence he presents, obviously accounting for its probative force.

[36] Therefore, I will return to the review of the evidence presented by Mr. Morrison, which includes four parts.

[37] First of all, Mr. Morrison produces definitions of the word "*beige*" found in various English-language dictionaries [para. 2 and Exhibits 1 to 7 of the affidavit].

[38] Secondly, Mr. Morrison files pages from the websites of Seventh Generation Inc. (www.seventhgeneration.com), Georgia-Pacific (www.gp.com), and Wausau Paper (www.wasaupaper.com) which he accessed on December 17, 2012. According to Mr. Morrison, these pages concern all the beige, brown or off-white hygienic paper products that he found on these websites and identified in a table reproduced in his affidavit [para. 3 and Exhibits 8 to 34 of the affidavit; Q6]. During his cross-examination, Mr. Morrison indicated that "*beige*" should be replaced by "*brown*" as the colour of the product "*Towlsaver Roll Towel (C-series)*" identified in his table [Q10, Exhibit 25 of the affidavit]. Once again, to reflect the strength of this evidence, I chose to reproduce in Appendix C of my decision a table from the Opponent's written argument,

associating the pictures of the products illustrated in Exhibits 8 to 34 of the affidavit (in colour in the written argument) with the descriptions found in paragraph 3 of the affidavit, as corrected by Mr. Morrison under cross-examination.

[39] Thirdly, Mr. Morrison attaches to his affidavit some photographs of hygienic paper products he purchased in December 2012 at stores in Toronto and its vicinity, namely:

- "*a single roll of brown-coloured Seventh Generation brand recycled paper towels*", which he purchased at two different stores, one at Whole Foods Market, and the other at Vital Planet [para. 5 to 6 and Exhibits 35 to 36 of the affidavit]. I note that the Opponent at the hearing had these two rolls of paper towels in its possession so that I could inspect their wrapping more closely; and
- "*a package of 8 rolls of off-white coloured Bio Life brand paper towels*", which he purchased at Shoppers Drug Mart [para. 7 and Exhibit 37 of the affidavit].

[40] Mr. Morrison also attaches photographs of "*brown napkins*", which he collected in December 2012 in Toronto cafés and restaurants [para. 8 to 18 and Exhibits 38 to 48 of the affidavit].

[41] In the fourth and last part of his affidavit, entitled "*Internet Searches*", Mr. Morrison declares that he is filing a sampling of Web pages linked to the results of a Google search he performed on December 18, 2012 for the phrase "*beige toilet paper*". He identifies these pages as follows [para. 19 and Exhibits 49 to 53 of the affidavit]:

- *TreeCycle Recycled Paper* [Exhibit 49]
- *Is America Ready for Beige Unbleached Bathroom Tissue?* [Exhibit 50]
- *New Cascades commercial toilet paper sourced from recycled paper* [Exhibit 51]
- *Trying on Shades of Brown to Scream Green – The Wall Street Journal* [Exhibit 52]
- *Chlorine-free Paper List* [Exhibit 53]

[42] Finally, Mr. Morrison files pages from the website *www.lovegan.com*, declaring that the illustrated organic foods and products sold by LoveGan Ltd. in the Greater Toronto Area [para. 20 and Exhibit 54 of the affidavit].

Applicant's Evidence

Statutory declaration of Thelma Thibodeau made on December 19, 2013

[43] Ms. Thibodeau, a self-employed trade-marks agent, attaches to her declaration:

- the definitions of the words "*beige*", "*blue*", "*brown*", "*gold*", "*green*", "*grey*", "*kraft*", "*orange*", "*pink*", "*purple*", "*red*", "*silver*", "*violet*" and "*yellow*" found in the *Canadian Oxford Dictionary* [Exhibit TT-1]; and
- the definition of "*papier / paper*", found in the *Collins Robert*, French-English English-French dictionary [Exhibit TT-2].

Certificates of authenticity of trade-mark registrations

[44] The 25 certificates of authenticity are related to 11 registrations for trade-marks consisting of the colour beige applied to all or part of the visible surface of an object and 14 registration for trade-marks claiming the colour beige as a characteristic of the trade-mark.

Preliminary observations

[45] For the purposes of my analysis of the questions in the case at bar, I wish to make the following observations.

The case of *Rothmans, Benson & Hedges*

[46] In the course of its representations, the Applicant referred on various occasions to the case of *Rothmans, Benson & Hedges v Imperial Tobacco Products*, 2012 TMOB 226 (CanLII), in which the Registrar, acting through my colleague Cindy Folz, refused oppositions to applications for registration of two trade-marks, each consisting of the colour orange applied to

the visible surface of packaging. The Applicant correctly noted that the appeal of the Registrar's decision was dismissed by the Federal Court [see *Rothmans, Benson & Hedges, Inc v Imperial Tobacco Products Limited*, 2014 FC 300].

[47] However, I must mention that the Federal Court decision was appealed in turn; it was dismissed by the Federal Court of Appeal by a judgment rendered on May 1, 2015, two days after the hearing held in the present case [see *Rothmans, Benson & Hedges, Inc v Imperial Tobacco Products Limited*, 2015 FCA 111]. According to my reading of the Federal Court of Appeal judgment, the Appellant challenged the refusal by the Registrar of the ground of opposition, alleging that the application did not satisfy the requirements of section 30(b) and (h) of the Act.

[48] I will return to this case with regard to the Applicant's representations where I consider it appropriate to do so. I will refer to it under *Rothmans, Benson & Hedges*, specifying whether I am referring to the decision of the Registrar or of the Court.

Exhibits 50 to 52 of David Morrison's affidavit

[49] At this point I will discuss the representations of the parties concerning the pages filed under Exhibits 50 to 52 of Mr. Morrison's affidavit and referring in particular, to supposed "statements" of "Cascades Tissue" representatives concerning the MOKA beige commercial bathroom tissue line.

[50] It is important to put this evidence in context for my discussion of each party's position in terms of its probative force. For this purpose, I have reproduced in Appendix D hereof the article entitled *New Cascades commercial toilet paper sourced from recycled paper*, dated January 25, 2012, referring to a comment by Suzanne Blanchet, identified as CEO of Cascades Tissue [Exhibit 51]. This comment, which came from the media kit, is also reproduced below:

Beige is the new green, at least as it relates to towel and tissue. The last several years have brought about countless habit changes meant to preserve the environment. The quality of this bath tissue hasn't been sacrificed one bit, so adjusting to a new color seems like a small step to take for even greater sustainability.

[51] Although presented differently, this comment is repeated word for word in the blog *Is America Ready for Beige Unbleached Bathroom Tissue?* posted on the Internet on February 21, 2012 [Exhibit 50]. Moreover, this blog refers to statements by Isabelle Faivre, identified as Marketing Director for "Cascades Tissue Group". It is sufficient to reproduce the first two paragraphs of this blog to put one of these statements into context:

When Cascades Tissue Group, North America's fourth largest producer of towel and tissue paper, unveiled their beige-colored Cascades Moka line of bathroom tissue at a recent tradeshow, distributors were initially concerned by the color.

"Then they would feel the product and say, 'Oh, wow that is actually very soft!'" said Isabelle Faivre, the marketing director for Cascades Tissue Group. "And when they learned about our method for producing the 100-percent recycled, undyed and unbleached tissue, their interest immediately peaked."

[52] References to Ms. Faivre's statements are also found in the article entitled *Trying on Shades of Brown to Scream Green – The Wall Street Journal* [Exhibit 52]. It is sufficient to reproduce the second-of-last paragraph referring to one of these statements:

[...] When Cascades pitched its Moka toilet paper to distributors at a recent trade show, "faces showed disgust" at first, says Ms. Faivre. "Then they would feel the product and it was, 'Oh, wow, that would be perfect,' " for customers who want softness, but also want green credential, she says.

[53] I understand from the Opponent's oral representations that it does not contest the Applicant's position whereby Mr. Morrison's filing of the website pages but does not prove the veracity of their content. Nonetheless, the Opponent claims that I should consider the "statements" reported on these Web pages to be "*admissions against interest*". Apart from its objection to the Opponent's claim, the Applicant, during the hearing, maintained that the evidence of these "statements" is inadmissible on the ground that it consists of double hearsay.

[54] In the event that the "statements" are ruled admissible, during the hearing the Applicant submitted that they are irrelevant to the case at bar. In this regard, the Applicant not only argued that Ms. Blanchet and Ms. Faivre are representatives of an American company, but that it emerges from the articles and the blog in question that they concern a line of bathroom tissue for the American market rather than the Canadian market. However, according to my understanding

of its oral representations, the Applicant does not deny the existence of a connection between itself and this American company.

[55] I accept, of course, that Ms. Blanchet and Ms. Faivre are not identified as representatives of the Applicant. However, I note that the Opponent, during the hearing, rightly observed that the Exhibits refer to "Cascades Tissue or "Cascades Tissue Group" as a *North American* producer. Ultimately, I agree with the Opponent that it is reasonable to conclude that the "statements" do not exclude the Canadian market.

[56] This having been said, I agree with the Applicant that, prima facie, the evidence of these "statements" is double hearsay evidence. The question to ask ourselves, therefore, is whether this evidence satisfies the criteria of necessity and reliability.

[57] Regarding necessity, it can be presumed without fear of error that the Opponent would not have been able to obtain affidavits or statutory declarations from Ms. Blanchet and Ms. Faivre.

[58] Regarding reliability, I see no reason to challenge the information according to which Ms. Blanchet's comment in the article filed under Exhibit 51 comes from the "Cascades Tissue" media kit, especially since this comment is essentially repeated word for word in the blog filed under Exhibit 50. Ms. Faivre, for her part, is cited by two distinct sources, each time in the context of a reference to a trade show. This concordance leads me to believe that the blog and the article filed as Exhibits 50 and 52 essentially, and even exactly, repeat Ms. Faivre's statements.

[59] Finally, it is important to mention that the Applicant had the opportunity, through its evidence, to contest the accuracy of the quotations reporting Ms. Blanchet's comment and Ms. Faivre's statements. For example, it can be supposed that it would have been relatively easy for the Applicant to prove by affidavit or by statutory declaration of one of its representatives, and even of a "Cascades Tissue" representative, that Ms. Blanchet's comment did not come from the media kit in question.

[60] In the final analysis, I conclude this evidence is admissible in that it satisfies the criteria of necessity and reliability. At an opportune time, I will discuss the weight I attach to it with regard to the grounds of opposition to which it applies.

Analysis of the questions in the case at bar

[61] I previously identified five questions arising from the grounds of opposition in the case at bar. I will begin with the analysis of the first question, namely:

Was the Mark distinctive of the Applicant's products as of June 13, 2012?

[62] This question arises from the four grounds of opposition raised under section 38(2)(d) of the Act, which I remind you are reproduced in full in Appendix A of my decision.

[63] According to the order of the grounds of opposition argued, the Opponent, in summary, alleges that the Mark is not distinctive in the sense of section 2 of the Act because:

- a number of companies, including the Opponent itself, Seventh Generation, Kimberly-Clark, Georgia-Pacific, Wasau Paper and Marcal, sell off-white, beige and brown hygienic paper products (first ground of opposition);
- the colour beige for hygienic paper is, in fact, only the result of a paper-making process, in which the fibres are neither bleached nor dyed (second ground of opposition);
- the minds of Canadian consumers, colours such as off-white, beige, pale yellow, and light brown are associated with “environmentally friendly” or low cost hygienic paper products which have neither been bleached nor dyed (third ground of opposition);
- the word "beige" does not refer to an identifiable specific colour; instead it identifies a wide range of possible shades and colours, from a variety of off-white to a variety of pale yellow, to a variety of light brown (fourth ground of opposition).

[64] By raising the analysis of the question stemming from each of these grounds of opposition, I point out that, under the terms of section 2 of the Act, a distinctive 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".

To prove the distinctiveness of a trade-mark, the three conditions set out in *Philip Morris Inc v Imperial Tobacco Ltd* (1985), 7 CPR (3d) 254 (FCTD) at page 270; upheld by (1987), 17 CPR (3d) 289 (FCA) must be met:

[...] (1) that a mark and a product (or ware) be associated; (2) that the « owner » uses this association between the mark and his product and is manufacturing and selling his product; and (3) that this association enables the owner of the mark to distinguish his product from that of others.

[65] I also note the comment of Justice Evans of the Federal Court in *Novapharm Ltd v Bayer Inc* (1999), 3 CPR (4th) 305 (FCTD) at paragraph 77; upheld by (2000), 9 CPR (4th) 304 (FCA), concerning an appeal of a decision of the Registrar to refuse an opposition to registration of a trade-mark consisting of a colour applied to the visible part of a pharmaceutical tablet:

[ORIGINAL TEXT OF ENGLISH JUDGMENT]

Third, while I accept that the colour, shape and size of a product may together be capable in law of constituting a trade-mark, the resulting mark is, as a general rule, likely to be weak: [...]

[66] For the following reasons, I accept the first and third grounds of opposition raised under section 38(2)(d) of the Act. Since I am thus settling the question that arises therefrom against the Applicant, I will not analyze the second and fourth grounds of opposition raised under section 38(2)(d) of the Act.

First ground of opposition raised under section 38(2)(d) of the Act

[67] The Applicant argues that the Opponent has not discharged its initial burden concerning the ground of opposition alleging that the Mark is not adapted to distinguish the Applicant's products, due to the sale in Canada by the Opponent and by third parties of off-white, beige or brown hygienic products.

[68] More specifically, the Applicant submits that Mr. Candido's affidavit does not allow measurement of the actual presence and distribution on the market of the products the Opponent claims to sell. It also submits that neither Mr. Candido's affidavit nor Mr. Morrison's affidavit allows measurement of the actual presence and distribution on the market of products that

allegedly come from third parties. To explain the Applicant's position, I have chosen to reproduce the following excerpts from its written argument:

20. In this case, in the matter of colours, it is respectfully submitted that the Opponent's Evidence is completely deficient, because the Opponent has not provided any figure allowing measurement of the alleged presence on the market of its products or third-party products, at the date of its statement of opposition.

21. Although the Opponent's Evidence refers to the supposed existence of its products or third-party products, it is not possible to determine the distribution of these products. The Opponent's two affidavits are silent on this matter.

22. It also is not possible to measure the distribution of these products at the date of the statement of opposition, or at any other date.

23. Finally, the Opponent's products and the third-party products are different from the Applicant's product mentioned in its application for registration. The opponent's products and the third-party products, almost all of the products exhibit the colour brown, which is a different colour from the one claimed by the Applicant in its application for registration.

[69] To support its claim regarding the insufficiency of the Opponent's Evidence, the Applicant cites the case of *Rothmans, Benson & Hedges*, in which the opponent alleged the use by third parties of colours similar to the orange colour for which the Applicant was applying for registration, and based its position on these uses to contest the distinctiveness of the Applicant's mark. The Applicant notes, more specifically, that the Registrar wrote in paragraph 71:

[ORIGINAL TEXT OF ENGLISH JUDGMENT]

[71] With respect to the ROTHMANS OF PALL MALL and NUMBER 7 brands, no information is provided regarding the dates or quantities of sales of these products in Canada. The only information regarding these products are photographs of a sample package of these cigarettes, which were both purchased in the period September – October 2008, well after the relevant date for assessing distinctiveness. (Kitchens, para. 7, 9, 12 and Exhibits 24, 53 and 77). Accordingly, this evidence is not relevant to the issue of distinctiveness.

[70] The Applicant also points out that on appeal of the Registrar's decision, the Federal Court confirmed that the opponent had not discharged its initial burden. The Applicant noted the following comments of the Federal Court, in particular:

[ORIGINAL TEXT OF ENGLISH JUDGMENT]

[79] The Court is of the view that the Board did not err in concluding that RBH failed to meet its initial evidential burden of establishing lack of distinctiveness.

[80] The Court agrees with ITLP's position and the conclusion of this Court in the related JTI case, above, that most of the evidence post-dates the relevant period for assessing the distinctiveness of the respondent's trade-marks, namely the date of the filing of the oppositions (JTI, above at para 57).

[81] RBH does not deny that finding of fact, but argues that the Board's dismissal of the majority of its evidence – notably the evidence pertaining to the sales of the MORE, NUMBER 7 and ROTHMANS OF PALL MALL products – was based on an overly restrictive approach. RBH relies on Scott Paper, above at para 37, which states that the Board can use evidence post-dating the relevant period to make inferences when data pre-dating the filing date is difficult to obtain.

[82] However, RBH failed to convince the Court that such data was indeed difficult to obtain. Moreover, the evidence concerning those products suggests that the reason why there is little data pre-dating the filing date is that those products were launched afterwards, or at an unspecified date (see JTI, above at para 58, for a similar conclusion in the related proceedings). As for the SPORTSMAN product, evidence shows that the sales were very low in comparison to ITPL's PETER JACKSON "Smooth Flavour" cigarettes and that, as such, they are insufficient to negate the distinctiveness (Jerome Alexander, above). On that basis, it was also reasonable for the Board to find that the evidence was not sufficient that some orange packages for tobacco products (Amphora Mellow Blend Tobacco, Hav-A-Tampa Jewel Cigars, Cohiba Club Cigars and White Owl Slim n Mild Cigars) were common to the tobacco trade during the relevant period.

[71] During the hearing, the Opponent contested the Applicant's claim that the first ground of opposition in the case at bar must be decided in a manner similar to the *Rothmans, Benson & Hedges* case. Unsurprisingly, the Opponent argues the well-known legal principle that each case must be considered on its merits and the circumstances. The Opponent does not contest that a substantial part of its evidence is subsequent to the relevant date, but it argues that this part must be considered in the evidence as a whole, not in isolation, depending on circumstances of the case. I agree.

[72] Indeed, on the one hand, when I consider all of the Opponent's Evidence filed in the case at bar to prove the non-distinctiveness of the Mark, I find that the absence of "figures" allowing measurement of the market presence of its products or third-party products is not fatal to the Opponent's case. On the other hand, the Applicant has not convinced me that I must disregard

the evidence subsequent to the relevant date. I instead agree with the Opponent that, in the case at bar, the evidence allows me to make inferences on the state of the market regarding the sale of off-white, beige or brown hygienic paper products by the Opponent and third parties as of June 13, 2012 [see *Scott Paper Limited v Georgia-Pacific Consumer Products LP*, 2010 CF 478 para. 37 to 38].

[73] I will address the Applicant's representations regarding the insufficiency of the Opponent's Evidence by making the following remarks. At the same time I will explain the reasons why I find that these proceedings are distinguished from the *Rothmans, Benson & Hedges* case.

[74] Regarding the Opponent's products, it is true that according to Mr. Candido's assertion, the hygienic paper products illustrated in Exhibits 2 to 10 of his affidavit are a selection of those that were sold as of December 20, 2012. However, not only does Mr. Candido clearly affirm that these products had been sold in Canada *for at least ten years*, but this assertion was not challenged in his cross-examination.

[75] Regarding third-party products, I believe I can presume without error that the Opponent would not have been able to obtain data concerning the value of volume of sales of Seventh Generation Inc., Georgia-Pacific and Wasau Paper products.

[76] It is true that Mr. Morrison's filing of the pages from the Seventh Generation Inc., Georgia-Pacific and Wasau Paper websites does not prove the veracity of their content, but at most the existence of these pages when he accessed the websites on December 17, 2012.

However, I recall the following statements by Mr. Candido:

13. In the tissue paper industry in Canada, it is and has been common for many of our competitors to produce and sell unbleached tissue products, which are beige or off-white. I am personally familiar with the sales and marketing across Canada of a number of these products, including those manufactured by Georgia Pacific, Wasau Paper and Seventh Generation. I have also seen private labels brands of unbleached off-white hygienic paper products, now sold across Canada through Shopper Drug Mart under the BIO-LIFE brand. In recent years, it has become increasingly common for food retailers in the fast food industry to supply their customers with beige or light brown napkins (such as those illustrated by the marketplace evidence gathered for this proceeding).

14. *I have reviewed the Affidavit of David Morrison, which includes print-outs from the webpages of these competitors in Canada, along with samples products. I confirm that the selected pages from these websites, and the actual samples, accurately represent the unbleached tissue products that are now and have been sold or distributed in Canada.*

(my underlining)

[77] Even though Mr. Candido is not an independent witness in this case, I find it reasonable to trust these statements. Due to his current position with the Opponent and the fact of his involvement with the Opponent since May 2003, Mr. Candido seems well placed, in my opinion, to testify about the Opponent's competitors. This is not a personal opinion per se, but rather a question of facts known to Mr. Candido. Moreover, nothing in Mr. Candido's cross-examination raises any doubts regarding his knowledge of the products of the Opponent's competitors.

[78] Contrary to the Federal Court in the *Rothmans, Benson & Hedges* cases, nothing in the Opponent's Evidence gives me reason to believe that the products found on the Seventh Generation Inc., Georgia-Pacific and Wasau Paper websites were launched after June 13, 2012.

[79] Indeed, apart from Mr. Candido's statement that the pages of the websites "*accurately represent the unbleached tissue products that are now and have been sold or distributed in Canada*" (my underlining), I agree with the Opponent that a good number of products were found on each of the websites as of December 17, 2012. I thereby agree with the Opponent that it is difficult to conceive that each and every one of these products was launched only between June 13 and December 17, 2012. Moreover, during the hearing, the Opponent pointed out that each package of rolls of SEVENTH GENERATION paper towels bears the copyright notice "© 2010 Seventh Generation, Inc." (my underlining) [Exhibits 35 and 36 of Mr. Morrison's affidavit]. I conclude this copyright notice dates back to no later than December 31, 2010. I therefore agree with the Opponent that it is reasonable to infer that a product for which the packaging bears such a copyright notice was launched on the market before June 13, 2012. [By analogy, see *Kruger Products LP v Cascades Canada ULC*, 2015 TMOB 39 (CanLII) at para. 36.]

[80] Finally, I disagree with the Applicant's claims that: (i) the hygienic paper products of the Opponent and of the third parties differ from the "hygienic paper" product associated with the Mark; and (ii) the brown colour exhibited by almost all of the products of the Opponent and of

the third parties is a colour different from the beige colour claimed by the Applicant. Instead, I agree with the Opponent that there is essentially no distinction between the products and the colours in question.

[81] Indeed, apart from the fact that the Georgia-Pacific and Wasau Paper products include hygienic paper, ultimately all the products belong to the same general product category, i.e. hygienic paper products.

[82] Moreover, with all due respect for the Applicant, I find that it is unreasonable to suggest that the colour beige is not similar to the colour brown. In this regard, it should be noted that the Applicant itself presented in evidence that the *Canadian Oxford Dictionary* defines the term "beige as: "a very pale yellowish brown" [Exhibit TT-1 of Ms. Thibodeau's declaration]. Moreover, among the definitions presented in evidence by the Opponent, *Webster's Third New International Dictionary* not only defines the term "beige" but also the term "beige brown"; the latter term is defined as "a grayish yellowish brown to light olive brown" [Exhibit 1 of Mr. Morrison's affidavit].

[83] I add that the colour of the products on the Wasau Paper website is identified by the term "natural". Having myself referred to the *Canadian Oxford Dictionary*, I note that one of the definitions of the term "natural" is: "having a colour characteristic of the unbleached and undyed state; off-white, creamy beige". Also, given that neither party presented in evidence the definition of the term "beige" in a French-language dictionary, I note that I referred to the *Le Petit Robert* dictionary, which defines this term as: "De la couleur d'un brun très clair" (A very light brown colour").

[84] In the final analysis, I find that the Opponent discharged its burden of proof that it and at least three other paper manufacturers used colours similar to the Mark in Canada for products belonging to the same general product category as the one encompassing "hygienic paper" as of June 13, 2012.

[85] Thus, it was up to the Applicant to prove, according to the balance of probabilities, that the Mark was distinctive or adapted to distinguish the Applicant's hygienic paper from hygienic paper products of others as of June 13, 2012.

[86] Yet apart from the fact that the application for registration was filed on August 23, 2011, on the basis of a proposed use, the Applicant did not file any proof of use of the Mark in Canada. Thus, there is no evidence allowing me to conclude, according to the balance of probabilities, that the Mark was distinctive of the Applicant's hygienic paper, in the sense of section 2 of the Act, as of June 13, 2012. I therefore conclude that the Applicant did not discharge its ultimate onus.

[87] I therefore accept the first ground of opposition raised under section 38(2)(d) of the Act.

Third ground of opposition raised under section 38(2)(d) of the Act

[88] The Applicant argues that the Opponent has not discharged its initial burden of proof concerning the ground of opposition alleging that the Mark is not adapted to distinguish the Applicant's products, because the minds of Canadian consumers, colours such as off-white, beige, pale yellow, and light brown are associated with “environmentally friendly” or low cost hygienic paper products which have neither been bleached nor dyed.

[89] According to my understanding of the Applicant's representations, it essentially submits that the Opponent has not discharged its burden of proof, because it has not filed any evidence allowing a conclusion to be drawn regarding Canadian consumers' perception as of June 13, 2012. In this regard, I summarize as follows the Applicant's oral and written representations in support of its position:

- i) apart from the fact that the Opponent's Evidence does not reveal that its products that would be described as "*beige*" are paper products "*which have never been bleached nor dyed*", no evidence is presented by the Opponent regarding the perception of Canadian consumers;
- ii) during his cross-examination, Mr. Candido admitted it was hard for him to say how consumers perceive "*an unbleached process*";
- iii) to the extent that Mr. Candido, in paragraphs 8 and 15 of his affidavit on the question of the meaning of the colour beige, his assertions are made in the present tense, i.e. as of December 20, 2012 when he signed his affidavit.

Moreover, in paragraph 15 of his affidavit, Mr. Candido does not even claim to take a position on the perception of Canadian consumers. At most, he makes an assertion regarding an alleged understanding of the Opponent's market ("*in our market*"); and

- iv) there is no evidence proving the number of Canadians who had access, were aware of or had consulted the information contained on the websites presented in evidence by the Opponent.

[90] For the following reasons, the Applicant has not convinced me that the Opponent has not discharged its burden of proof regarding the part of the ground of opposition alleging that colours such as off-white, beige, pale yellow and light brown are associated with hygienic paper products that are *environmentally friendly* because they are neither bleached nor dyed. I thereby will not address the part of the ground of opposition alleging that these colours are associated with hygienic paper products that are *low cost* because they are neither bleached nor dyed.

[91] As indicated above, I do not accept the Applicant's argument that it must be concluded from Mr. Candido's testimony that the Opponent's only beige product would not even be the natural result of a manufacturing process in which the fibres are neither bleached nor dyed [see paragraph 29 of my decision].

[92] Although I agree with the Applicant that the Opponent has not provided direct evidence of the perception of the members of Canadian consumers as of June 13, 2012, the jurisprudence tells us that common senses must be applied in the assessment of the evidence. It is sufficient to note the following comment by Justice Mandamin in *Ontario Teachers' Pension Plan Board v Canada (Attorney General)* (2010), 89 CPR (4th) 301 (FC); upheld by (2012), 99 CPR (4th) 213 (FCA):

[ORIGINAL TEXT OF ENGLISH JUDGMENT]

[48] In *Neptune S.A. v Canada (Attorney General)*, 2003 FCT 715 (*Neptune S.A.*), Justice Martineau stated that the decision maker must not only consider the evidence at his or her disposal but also common sense in the assessment of the facts. Therefore, in assessing the validity of a proposed trade-mark, one must consider not only the evidence but have regard to common sense. Moreover, the decision that the

trade-mark is clearly descriptive is to be based on the initial impression having regard to the wares or services in question: *Neptune S.A.*

[93] The Opponent presented in evidence that the colour beige is defined in dictionaries as being associated with an undyed or unbleached wool fabric [Exhibits 1, 2, 6 and 7 of Mr. Morrison's affidavit]. Although it is not devoid of merit for the Applicant to note that the dictionary definitions refer specifically to fabrics, it remains nonetheless that the term "beige" is known to be associated with a product that is neither dyed nor bleached.

[94] The Applicant's argument regarding the fact that the dictionary definitions refer to fabrics leads me to return to the statements of Ms. Blanchet and Ms. Faivre presented in evidence through Exhibits 50 to 52 of Mr. Morrison's affidavit, and which would date back at least to the months of *January and February* 2012. Although I am not prepared to treat the statements presented as evidence as admissions against interest, as requested by the Opponent, this evidence nonetheless seems hard to reconcile with the Applicant's position.

[95] Indeed, how can the Applicant claim there is no probability that a Canadian consumer, as of June 13, 2012, perceived the colour beige applied to hygienic paper as the result of a manufacturing process in which neither bleaching or dyeing is used, when the use of such a process was developed by "Cascades Tissue" for the launch of a MOKA beige commercial bathroom tissue line. Ultimately, although this is not conclusive in the case at bar, it is my opinion that the evidence from the statements of Ms. Blanchet and Ms. Faivre supports the Opponent's case.

[96] As for the Applicant's representations concerning Mr. Candido's declarations, I recognize the use of the present tense reflected by the term "*now*" in paragraphs 8 and 15 of his affidavit [see paragraphs 22 and 30 of my decision]. However, I agree with the Opponent that these declarations must be considered in light of all of Mr. Candido's declarations regretting the marketing of off-white, beige or brown hygienic paper products by the Opponent and third parties for the past several years in Canada.

[97] Moreover, as I indicated previously, I find that the evidence in the case at bar allows me to conclude that the Opponent itself and at least three other paper manufacturers, namely Seventh Generation Inc., Georgia-Pacific and Wasau Paper, used colours similar to the Mark in Canada

for hygienic paper products as of June 13, 2012. I note in passing that according to my understanding of the Applicant's representations, it does not challenge that the products in question are environmentally friendly; it challenges the evidence of the perception by Canadian consumers of the significance of the colours applied to these products.

[98] It is true that the Opponent has not presented in evidence information concerning the number of Canadians who had accessed, were aware of or had consulted the information contained on the websites of the Opponent, Seventh Generation Inc., Georgia-Pacific and Wasau Paper regarding the hygienic paper products of these manufacturers. Thus, for example, we do not know the number of Canadian consumers who may have read the following information on the Seventh Generation Inc. website, illustrating its brown paper towels: "*Seventh Generation Paper Towels are made from 100% recycled paper, with a minimum of 50% post-consumer content*" and "*Brown color paper towels are unwhitened*" Exhibit 8 of Mr. Morrison's affidavit]. However, the Opponent rightly noted that each SEVENTH GENERATION roll of paper towels is sold in packaging bearing the messages "*100% Recycled*", "*Processed Chlorine Free*", "*No Added Dyes or Fragrances*" [Exhibits 35 and 36 of Mr. Morrison's affidavit]. In other words, the message that the paper towel is environmentally friendly because it is neither bleached nor dyed is found on the product packaging, and not only on the website.

[99] Finally, I find I can automatically take note that we are in an era in which Canadians are sensitized to protection of the environment. Without knowing the precise time when we entered this era, I find I can at least conclude that such was the case as of June 13, 2012. Thus, by applying common sense in the case at bar, I find it reasonable to conclude that many Canadian consumers, as of June 13, 2012, knew that products were being designed, manufactured or marketed in such a manner that they can cause the least possible harm to the ecological environment.

[100] In my opinion, the following comment of the Federal Court in *Michelin & Cie v Astro Tire & Rubber Co of Canada Ltd* (1982), 69 CPR (2d) 260 (FCTD), at 263, although formulated in the context of the assessment of the probability of confusion between trade-marks, is totally appropriate in the case at bar.

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

(my underlining)

[101] Ultimately, considering not only the evidence, but also common sense in the assessment of the facts in the case at bar, I conclude that it is more probable than improbable that a Canadian consumer, as of June 13, 2012, noticed the beige colour applied to a roll of hygienic paper as a feature of a hygienic paper that is environmentally friendly because it is neither bleached nor dyed.

[102] Given the Mark's inherent weakness, it was incumbent on the Applicant to prove, based on the balance of probabilities, that many consumers as of June 13, 2012 recognized the colour beige applied to the entire visible surface of a roll of hygienic paper as a trade-mark and not as a feature of a hygienic paper that is environmentally friendly because it is neither bleached nor dyed. I conclude that the Applicant has not discharged its ultimate onus.

[103] Indeed, the Applicant has not filed any evidence of use of the Mark for which it has applied for registration on the basis of a proposed use in Canada. Thus, there is no evidence allowing me to conclude, according to the balance of probabilities, that the Mark was distinctive of the Applicant's hygienic paper, in the sense of section 2 of the Act, as of June 13, 2012. Moreover, the Applicant's arguments have not convinced me that the Mark was adapted to distinguish its hygienic paper as of June 13, 2012.

[104] I therefore accept the third ground of opposition raised under section 38(2)(d) of the Act, to the extent it is based on the allegation that colours such as off-white, beige and light brown are associated with hygienic paper products that are environmentally friendly because they are neither bleached nor dyed.

The four other questions in the case at bar

[105] Since I have settled the first question in the case at bar in the Opponent's favour by endorsing its position on two grounds of opposition, I do not see the necessity of analyzing the other four questions in the case at bar.

Decision

[106] In exercising the authority delegated to me pursuant to subsection 63(3) of the Act, I refuse the application for registration in application of subsection 38(8) of the Act.

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Arnold Bennett
Certified true translation

Date of hearing: 2015-04-29

Appearances

Christopher J. Pibus For the Opponent

Barry Gamache For the Applicant

Agents in the case

Gowling Lafleur Henderson LLP For the Opponent

Robic For the Applicant

APPENDIX A

Grounds of opposition






- (a) *The opponent relies upon the ground of opposition provided by Section 38(2)(d) and Section 2. The applied for trade-mark is not adapted to distinguish the wares of the applicant from the wares of others. A number of companies, including Kruger Products L.P. itself, Seventh Generation, Kimberly-Clark, Georgia-Pacific, Wasau Paper, and Marcal, have offered for sale and continue to offer hygienic paper products which are off-white, beige or brown. In view of these third party uses of off-white, beige or brown hygienic paper products in the marketplace, the subject application is not adapted to distinguish the wares of the applicant from the wares of others, nor is it capable of distinguishing the wares of the applicant from the wares of others.*
- (b) *The opponent relies upon the ground of opposition provided by Section 38(2)(d) and Section 2. The applied for trade-mark is not adapted to distinguish the wares of the applicant from the wares of others. The application claims the colour “beige” in association with toilet paper wares. The word “beige” nominates a range of shades of colours which are the natural result of the paper-making process, if the paper fibres are neither bleached so as to become white, nor dyed so as to become some other colour. The applied for mark does not identify a distinctive trade-mark as the beige colour is nothing other than a natural result of the paper-making process if the paper fibres are neither bleached nor dyed.*
- (c) *The opponent relies upon the ground of opposition provided by Section 38(2)(d) and Section 2. The applied for trade-mark is not adapted to distinguish the wares of the applicant from the wares of others. In the minds of the Canadian consuming public, colours such as off-white, “beige”, pale yellow, and light brown are associated with “environmentally friendly” or low cost hygienic paper products such as bathroom tissue, facial tissue, napkins and paper towels which have neither been bleached nor dyed, rather than being associated with any one particular source for these products.*
- (d) *The opponent relies upon the ground of opposition provided by Section 38(2)(d) and Section 2. The applied for trade-mark is not adapted to distinguish the wares of the applicant from the wares of others. The mark is identified in the application by a combination of a drawing depicting the wares, combined with a colour claim which identifies the claimed colour as “beige”. The word “beige” does not nominate any one specific identifiable colour; rather, it identifies a wide range of possible shades and colours in a range running from a variety of off-whites, to a variety of pale yellows, to a variety of light browns. The word “beige” is not specific enough to nominate any one trade-mark which could be said to be adapted to distinguish the wares of the applicant from the wares of others.*
- (e) *The opponent relies upon the ground of opposition provided by Section 38(2)(b) and Section 12(1)(e) and Section 10. The colour “beige” applied to hygienic paper products in the nature of bathroom tissue, facial tissue, paper towels and napkins has by ordinary and*


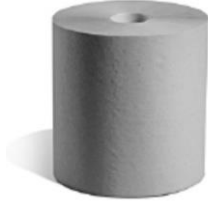


bona fide commercial usage become recognized in Canada as designating “environmentally friendly” or low cost hygienic paper products, which have neither been bleached nor dyed, and accordingly registration of the colour “beige” for toilet paper is prohibited by Section 12(1)(e) and Section 10.

- (f) *The opponent relies upon the ground of opposition provided by Section 38(2)(b) and Section 12(1)(b). The applied for trade-mark does not identify a registrable trade-mark because when depicted, the mark claimed in application 1,540,778 is either clearly descriptive or deceptively misdescriptive of the “environmentally friendly” or low cost character of the bathroom tissue covered by the application, in view of the fact that in the minds of the Canadian consuming public, the colour “beige” is associated with bathroom tissue and other hygienic paper products which are “environmentally friendly” or low cost in character, because the tissue is neither bleached nor dyed.*
- (g) *The opponent relies upon the ground of opposition provided by Section 38(2)(a) and Section 30(h). The application does not comply with the requirements of Section 30(h) in that the application identifies the mark applied for as the colour “beige” applied to the drawing. The word “beige” is insufficiently specific to identify any one alleged trade-mark, because the word “beige” could nominate any of a wide range of different shades and colours anywhere in a range from numerous different shades of off-whites, to numerous different shades of pale yellow, to numerous different shades of light browns. Application 1,540,778 cannot be said to identify one trade-mark, and accordingly the application does not comply with the requirements of section 30(h).*
- (h) *The opponent relies upon the ground of opposition provided by Section 38(2)(a) and Section 30(h) and Section 4. Application 1,540,778 does not identify anything that will ever be used as a trade-mark in accordance with the requirements of Section 4. The drawing included in the application depicts a single roll of tissue, with no exterior wrapping or packaging, partially unrolled. The drawing does not depict anything which will be seen by consumers “at the time of the transfer of the property in or possession of the wares”, as would be required to constitute use in accordance with Section 4. The drawing depicts an image that will never be seen in that form by consumers at the time of sale, and so the image depicted by the drawing is not an image of any trade-mark that can or will ever be used in accordance with Section 4.*
- (i) *The opponent relies upon the ground of opposition provided by Section 38(2)(a) and Section 30(e). The applicant does not intend to “use” any “trade-mark” which corresponds to the drawing provided in application 1,540,778. The applicant does not intend to offer at point of sale single rolls of toilet paper, with no wrapping or packaging, partially unrolled, as depicted in the drawing of application 1,540,778. The applicant does not intend to “use”, at the time of the transfer of the property in or possession of the wares (as required by Section 4) any “trade-mark” which corresponds to the drawing provided in application 1,540,778, and accordingly the application does not comply with the requirements of Section 30(e).*

APPENDIX B







Table - The Opponent's written argument - Affidavit of Jay Candido






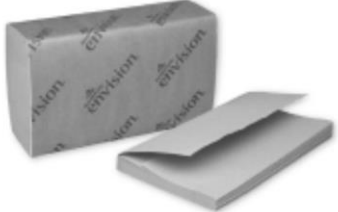

| <u>Description/ Product Code</u> | <u>Product Type</u> | <u>Colour</u> | <u>Image</u> |
|----------------------------------------------|---------------------|---------------|---------------------------------------------------------------------------------------|
| ESTEEM 100% Natural Singlefold Towel (01800) | Hand towels | Brown |  |
| ESTEEM 100% Natural Singlefold Towel (01802) | Hand towels | Brown |  |
| ESTEEM 100% Natural Multifold Towel (01820) | Hand towels | Brown |  |
| ESTEEM 100% Natural 205' Roll Towel (01830) | Hand towels | Brown |  |
| ESTEEM 100% Natural 425' Roll Towel (01845) | Hand towels | Brown |  |


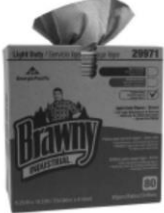





| <u>Description/ Product Code</u> | <u>Product Type</u> | <u>Colour</u> | <u>Image</u> |
|-----------------------------------------------------|---------------------|---------------|---------------------------------------------------------------------------------------|
| ESTEEM 100% Natural 800' Long Roll Towel (01855) | Hand towel | Brown |  |
| ESTEEM 800' Roll Towel (01859) | Hand towel | Brown |  |
| ESTEEM 100% Natural 350' Roll Towel (01860) | Hand towel | Brown |  |
| GENERAL WORKS, 2-Ply, 1/4 fold (02510) | Wipers | Beige |  |








APPENDIX C

Table - The Opponent's written argument - Affidavit of David Morrison

| <u>Description/ Product Code</u> | <u>Product Type</u> | <u>Colour</u> | <u>Manufacturer</u> | <u>Image</u> |
|-----------------------------------------------------------------------------|---------------------|---------------|---------------------|---------------------------------------------------------------------------------------|
| 100% Recycled Paper Towels, 120 sheets, 2-ply, single roll | Paper towel | Brown | Seventh Generation |  |
| 100% Recycled Napkins, 500 count | Napkins | Brown | Seventh Generation |  |
| enMotion Brown High Capacity Roll Towel (89480) | Paper towel | Brown | Georgia-Pacific |  |
| enMotion Brown High Capacity Roll Towel (89485) | Paper towel | Brown | Georgia-Pacific |  |
| enMotion Brown High Capacity EPA Compliant Touchless Roll Towel (89440) | Paper towel | Brown | Georgia-Pacific |  |
| SofPull Brown 100 Percent Recycled Fiber Hardwound Roll Paper Towel (26920) | Paper towel | Brown | Georgia-Pacific |  |

| <u>Description/ Product Code</u> | <u>Product Type</u> | <u>Colour</u> | <u>Manufacturer</u> | <u>Image</u> |
|--------------------------------------------------------------------------------|---------------------|---------------|---------------------|---------------------------------------------------------------------------------------|
| SofPull Brown Hardwood Roll Paper Towel (26480) | Paper towel | Brown | Georgia-Pacific |  |
| Cormatic Brown Hardwood Roll Towels on 8.25" No-slot rolls (2910P) | Paper towel | Brown | Georgia-Pacific |  |
| Envision Brown High capacity Roll Paper Towel (26301) | Paper towel | Brown | Georgia-Pacific |  |
| Envision Brown High capacity Roll Paper Towel (26401) | Paper towel | Brown | Georgia-Pacific |  |
| Envision Brown Multifold Paper Towels (23304) | Paper towel | Brown | Georgia-Pacific |  |
| Envision Brown Singlefold Paper Towels (23504) | Paper towel | Brown | Georgia-Pacific |  |
| Brawny Industrial Brown Light Duty 2-ply Paper Wipers (29222) | Wipers | Brown | Georgia-Pacific |  |

| <u>Description/ Product Code</u> | <u>Product Type</u> | <u>Colour</u> | <u>Manufacturer</u> | <u>Image</u> |
|----------------------------------------------------------------------|---------------------|---------------|---------------------|---------------------------------------------------------------------------------------|
| Brawny Industrial Brown Light Duty 3-ply ¼ fold Paper Wipers (29922) | Wipers | Brown | Georgia-Pacific |  |
| Brawny Industrial Brown Light Duty 3-ply Paper Wipers (29971) | Wipers | Brown | Georgia-Pacific |  |
| EasyNap Brown Embossed Dispenser Napkins (32015) | Napkins | Brown | Georgia-Pacific |  |
| EasyNap Jr. Brown Dispenser Napkins (32055) | Napkins | Brown | Georgia-Pacific |  |
| Towlsaver Roll Towel (C-Series) (94303) | Paper towel | Brown | Georgia-Pacific |  |
| Ecosoft Green Seal (20000) | Paper towel | Natural | Wasau Paper |  |
| Ecosoft Green Seal (31300) | Paper towel | Natural | Wasau Paper |  |

| <u>Description/ Product Code</u> | <u>Product Type</u> | <u>Colour</u> | <u>Manufacturer</u> | <u>Image</u> |
|--------------------------------------|---------------------|---------------|---------------------|---------------------------------------------------------------------------------------|
| Ecosoft Green Seal (45800) | Paper towel | Natural | Wasau Paper |  |
| Ecosoft Green Seal (71300) | Paper towel | Natural | Wasau Paper |  |
| Ecosoft Green Seal (31000) | Paper towel | Natural | Wasau Paper |  |
| Ecosoft Green Seal (71000) | Paper towel | Natural | Wasau Paper |  |
| Ecosoft Green Seal (31060) | Paper towel | Natural | Wasau Paper |  |
| Ecosoft Green Seal (71060) | Paper towel | Natural | Wasau Paper |  |
| Ecosoft Green Seal (48900) | Folded towel | Natural | Wasau Paper |  |

APPENDIX D

Exhibit 51 of David Morrison's Affidavit

100% commercial toilet paper sourced from recycled paper | SmartPlanet

New Cascades commercial toilet paper sourced from recycled paper

By Heather Clancy | January 25, 2012, 10:47 AM PST



After pioneering the concept with its Moka napkins, Cascades Tissues, Waterford, N.Y., has released a line of commercial bathroom tissue that it made out of 100 percent recycled paper fiber.

Approximately 80 percent of the paper in the new Cascades Moka bathroom tissue line comes from post-consumer materials, while the rest comes from recovered corrugated cardboard boxes, the company reports.

That's not the only environmental consideration that went into the toilet paper: the rolls are also unbleached, which means they are beige in color. That means the paper was processed without chlorine.

The CEO of Cascades Tissue, Suzanne Blanchet, comments in the media kit about the new line of paper:

"Beige is the new green, at least as it relates to towel and tissue. The last several years have brought about countless habit changes meant to preserve the environment. The quality of this bath tissue hasn't been sacrificed one bit, so adjusting to a new color seems like a small step to take for even greater sustainability."

I personally agree with that idea; it's the texture of certain "greener" bathroom tissues that tends to rub people the wrong way.

In any case, the company claims that if more restaurants, malls, office buildings and other operators of public restrooms were to use its recycled, unbleached paper rather than the alternative, it could save about 30.6 million trees annually.

Cascades Tissues, which ranks as the fourth biggest producer of paper towels and tissues in North America,

at.splend.com/blog/business-trains/.../21067

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estimates that sales of its Moka napkin line now represent more than 23 percent of the company's overall napkin product sales.

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