



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

Citation: 2011 TMOB 209
Date of Decision: 2011-10-06

**IN THE MATTER OF AN OPPOSITION
by Golden Bear International Inc. to
application No. 1,283,850 for the trade-
mark BEAR Design in the name of Stone
Creek Properties Inc.**

[1] On December 20, 2005, Stone Creek Properties Inc. (the Applicant), filed an application for the trade-mark BEAR Design (the Mark), shown below, based upon proposed use of the Mark in Canada.



[2] The statement of wares/services currently reads:

WARES:

(1) Golf equipment, namely, golf bags, golf balls, tees, ball markers, divot repair tools, golf towels, umbrellas; (2) Bags, namely, duffle bags, back packs, fanny packs, travel bags, shoe bags; (3) Clothing, namely, casual clothing, golf clothing, caps/hats, socks, swimwear and coats and jackets; (4) Novelty items, namely, key chains, glassware, namely, bowls, glasses and plates, mugs, money clips, books, pens/pencils, desk sets,

portfolios, desk diaries, organizers, note paper, note cards, spoons, patio umbrellas, stuffed animals, jewelry, prerecorded dvds featuring golf, cedar wine boxes, and paper and cardboard gift boxes.

SERVICES:

(1) Residential, commercial, recreational, namely golf course and resort property development; (2) Leasing and sale of commercial and residential property; (3) Operation and management of hotels, golf courses, clubhouses, resorts, recreational facilities, namely, hiking, biking and cross country ski trails, restaurants and retail shops relating all of the aforementioned wares; (4) Hotel and resort services; (5) Golf course and clubhouse services; (6) Restaurant services; (7) Golf retail store services.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of March 7, 2007.

[4] On June 5, 2007, Golden Bear International Inc. (the Opponent) filed a statement of opposition against the application. The grounds of opposition are that the Applicant's application does not conform to the requirements of s. 30(i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), the Mark is not registrable pursuant to s. 12(1)(d), the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a) and (c), and the Mark is not distinctive. Each of these grounds is based on confusion with the Opponent's trade-marks, details of which are in the attached Schedule A.

[5] The Applicant filed and served a counter statement, in which it denied the Opponent's allegations.

[6] The Opponent's evidence consists of the affidavit of Elenita Anastacio. The Applicant's evidence consists of the affidavit of Barbara Easthom. Ms. Easthom was cross-examined on her affidavit. The transcript of the cross-examination, exhibits and the answers to undertaking form part of the record.

[7] Only the Applicant filed a written argument. Only the Opponent requested and was represented at the oral hearing.

Onus and Material Dates

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities that its application complies with the requirements of the Act. There is, however, an initial burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

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

- s. 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- s. 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 16(3) - the filing date of the application [see s. 16(3)];
- non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Section 30(i) Ground

[10] Regarding the s. 30(i) ground, I note that the Applicant has made the requisite statement and there is no evidence that it did so in bad faith [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. I will add that even if the Applicant was aware of the existence of the Opponent's marks, this would not have precluded the Applicant from being satisfied that it was entitled to use the Mark in Canada on the basis, *inter alia*, that it did

not consider its mark to be confusing with any of the Opponent's marks. This ground is therefore unsuccessful.

Section 16 and s. 38(2)(d) Grounds of Opposition



[11] The Opponent has not met its initial burden with respect to the s. 16(3) grounds and s. 38(2)(d) grounds, because it has not evidenced that any of its marks or names were used or made known in Canada prior to December 20, 2005, the filing date of the application, or June 5, 2007, the filing date of the statement of opposition. As noted above, the only evidence of the Opponent is the affidavit of Ms. Anastacio which introduces as exhibits particulars of several of the Opponent's marks. I note that two of the Opponent's applications attached to the affidavit of Ms. Anastacio, i.e. Application no. 1,335,451 for the trade-mark 18 MAJORS and Design and Application No. 1,371,182, for the trade-mark JACK NICKLAUS GOLF CLUB and Design, were not pleaded in the Opponent's statement of opposition. In any case, it has been previously held that, where the only evidence consists of certified copies of the opponent's registrations, the Registrar will assume only *de minimus* use of the opponent's trade-marks [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.)]. Therefore the filing of certified copies of the Opponent's registrations and applications in the present case will not support the Opponent's evidential burden with respect to ground of opposition based on allegations of non-entitlement or non-distinctiveness. These grounds are therefore dismissed.

Section 12(1)(d) Ground

[12] The s. 12(1)(d) ground of opposition turns on the issue of the likelihood of confusion between the Mark and twelve of the Opponent's registered marks. I note that registration No. TMA447,808 for the trade-mark GOLDEN BEAR GOLF CENTER and Design and registration No. TMA220,193 for the trade-mark POLAR BEAR and Design have both been expunged.

[13] The Opponent's initial burden with respect to the s. 12(1)(d) ground has been satisfied because all of its remaining registrations are in good standing. I consider the Opponent's case to be strongest with respect to the ground that the Mark is not registrable pursuant to s. 12(1)(d) of the Act due to a likelihood of confusion with the Opponent's registrations as set out below. I

will refer to these marks as the Opponent’s BEAR Design marks and the Opponent’s GOLDEN BEAR marks.

Trade-mark	Registration No.	Wares/Services
BEAR Design 	TMA447,807	Golf instruction services and entertainment services namely, providing golf practice facilities
BEAR Design 	TMA529,340	Shirts; slacks; shorts; socks; fleecewear namely sweatshirts, sweatpants and warm-up suits; outerwear namely wind resistant jackets and rainwear; sport coats; blazers; suits; ties; and hats.
GOLDEN BEAR	TMA144,183	(1) shirts (2) jackets (3) slacks
GOLDEN BEAR	TMA220,301	(1) Golf balls. (2) Golf clubs. (3) Golfing equipment, namely, golf bags, golf carryalls, golf umbrellas and golf club head covers.

test for confusion

[14] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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 wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; b) the length of time each has been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight.

[15] The Supreme Court of Canada discussed the appropriate process for assessing all of the surrounding circumstances to be considered in determining whether two trade-marks are confusing in its decisions in *Masterpiece Inc. v. Alavida Lifestyles Inc.*, 2011 S.C.C. 27; *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321; and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401. In *Masterpiece* in particular, the Court stated that the most significant factor for the confusion analysis is the degree of resemblance, and as a result, most confusion analyses should begin with this factor. Using this approach I shall now assess all of the surrounding circumstances.

s. 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[16] As noted in the *Masterpiece* decision, the most crucial or dominant factor in determining the issue of confusion is the degree of resemblance between the trade-marks [see also *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.) at 149, affirmed 60 C.P.R. (2d) 70].

[17] Both the Mark and the Opponent's BEAR Design marks are comprised of bear designs. There is a high degree of resemblance in sound between the marks as both could be pronounced as "Bear Design", although I note that the Opponent's BEAR Design marks may be pronounced as "Golden Bear Design" for reasons explained below. There is less resemblance between the marks in appearance and ideas suggested, however, due to their design differences. In this

regard, the Mark consists of the top portion of a bear, apparently designed to resemble a silvertip grizzly, and on the left hand side of the bear are representations of mountains with sky above. The bear has a very distinctive look showing a face with eyes, ears and a nose. The design has a black double rectangular border around it with the exception of the top portion of the bear's head.

[18] The Opponent's BEAR Design marks, on the other hand, are both silhouettes of a bear standing on all four legs with the head up and forward, with no other elements. Exhibit 4 to the cross-examination transcript of Ms. Easthom shows that the Opponent's BEAR Design appears as a gold bear figurine.

[19] With respect to the Opponent's GOLDEN BEAR word marks, there is even less resemblance between the Mark and these marks of the Opponent in all three respects. In this regard, I consider there to be considerable differences between the appearance, sound and idea suggested of the Opponent's GOLDEN BEAR marks as compared to the Applicant's Mark. As noted above, the idea suggested by the Mark is a grizzly bear in its natural environment whereas the Opponent's GOLDEN BEAR word marks suggest an artificial bear made of gold. It is also arguable, as will be discussed below, that the Opponent's GOLDEN BEAR marks suggest the professional golfer Jack Nicklaus. Either way, both ideas suggested by the Opponent's GOLDEN BEAR marks are different than the idea suggested by the Mark.

s. 6(5)(a) - inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

[20] All of the parties' marks are inherently distinctive in relation to their wares and services.

[21] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. The Opponent has not provided any evidence of use of any of its marks. I therefore cannot conclude that any of the Opponent's marks have become known to any extent in Canada.

[22] On the other hand, the affidavit of the Applicant's affiant, Ms. Easthom, establishes the following:

- the Applicant has used a similar bear design (i.e. Registration No. 456,231), shown below, in association with the Silvertip Golf Course in Canmore, Alberta, since at least January, 1993;



SILVERTIP

- the Mark is a modification of Registration No. 456,231, and has been used in Canada continuously since at least January, 2006, in relation to wares and services relating to the development, operation and management of a mountain resort community that includes a golf course, restaurants, resorts and rental accommodations;
- copies of advertisements promoting the Silvertip Golf Course and showing the Mark from the 2006, 2007 and 2008 WHERE magazine distributed in Alberta, British Columbia and Saskatchewan;
- expenditures for advertising and promotion for the Mark have been \$316,221, between 2006 and Sept. 30, 2008; and
- revenues generated by the Applicant in relation to the Silvertip Golf Course have been over \$3.5 million per year between 2006 and Sept. 30, 2008.

[23] Based on the foregoing information, I conclude that the Mark has become known to some extent in Canada.

s. 6(5)(b) - the length of time each trade-mark has been in use

[24] The length of time that each mark has been in use favours the Applicant. As noted above, Ms. Easthom testifies that the Applicant has used the Mark with the applied for wares and services since at least January 2006. As for the Opponent, the filing of a copies of its registrations, as noted above, can only support an assumption of *de minimus* use of the registered trade-marks [see *Entre Computer Centers, Inc. v. Global Upholstery Co., supra*].

s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

[25] It is the Applicant's statement of wares as defined in its application versus the Opponent's registered wares and services that govern my determination of this factor [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)]. However, that specification must be read with a view to determining the probable type of business or trade intended by the applicant rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trade of the Applicant is useful [see *McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168(F.C.A.)].

[26] Some of the applied for clothing wares and golf equipment are similar, if not identical to, the registered wares of the Opponent. I do not, however, consider that the Applicant's bags and novelty items to be similar to the clothing and golf equipment wares of the Opponent.

[27] With respect to the parties' services and the nature of their businesses, the Applicant submits that it is in the business of developing real estate and the development is a mountain resort community called Silvertip Village, as shown in Exhibit D of the Easthom affidavit. The Applicant argues that the use of the Mark is in association with the village as a whole and not specifically the golf course which is part of the resort community. The golf course is called Silvertip and the Mark is used along with the name of the golf course. As shown in the advertisement attached as Exhibit G to the Easthom affidavit, the Mark is not only used to promote the golf course but also to promote the restaurants and the village itself. I note that the applied for services are not, however, limited to that particular resort community.

[28] The Opponent's golf practice facilities are related to the golf course services of the Applicant. I agree with the Applicant, however, that the nature of the remaining services of the Applicant is different from those of the Opponent. In this regard, the remaining applied for services are all related to the development of a resort community which includes commercial and residential properties, recreational facilities and retail outlets.

[29] With respect to the parties' channels of trade, the Applicant submits that its wares are only sold at locations in the Village in the golf pro shop and in restaurants. The Applicant's application, however, is not so restricted. I must therefore consider that the channels of trade for the parties' clothing and golf equipment wares could overlap.

[30] The evidence suggests that the Applicant's services would only be offered for sale in the Applicant's resort community, which is located in the Rocky Mountains, just above the town of Canmore, Alberta. Once again, the Applicant's application is not so restricted. The parties' channels of trade for their respective services could therefore potentially overlap as well, although I do note that the Applicant's evidence of its current channels of trade suggests that this would not be likely.

Further Surrounding Circumstances

[31] As a further surrounding circumstance, I have considered the Opponent's agent's argument at the oral hearing that the Opponent's GOLDEN BEAR trade-marks are synonymous with Jack Nicklaus, a professional golfer. The Opponent submits that Jack Nicklaus' nickname is the GOLDEN BEAR and that this factor could increase the likelihood of confusion between the parties' marks. In support of this position, the Opponent's agent relied upon the following testimony of Ms. Easthom on cross-examination at p.16:

Q. ...And I take it you're familiar with Jack Nicklaus?

A. Yes.

Q. And you've known him as a person or sports entity for some time?

A. For the last few months.

Q. And you know I guess his nickname is “the Golden Bear”?

A. I know that now, yes.

[32] While Ms. Easthom states that, at the date of her cross-examination, she was aware that Jack Nicklaus’ nickname was the “golden bear”, I do not consider the evidence of one person sufficient for me to conclude that the average consumer would associate the Opponent’s GOLDEN BEAR marks with Jack Nicklaus. No evidence has been provided concerning the individual Jack Nicklaus and I cannot take judicial notice that he may be a well-known golfer, and that “golden bear” is his nickname. Even if I could take judicial notice of these facts, there is no evidence of record of the association between the Opponent and Jack Nicklaus. Therefore, even if a consumer who saw the Mark in association with golf equipment would make an association with Jack Nicklaus, the Opponent has not shown how that consumer would likely be confused into thinking that the wares or services provided by the Applicant under its Mark were associated with the Opponent.

[33] As a further surrounding circumstance, I note that Ms. Easthom did state on cross-examination that she was aware that Jack Nicklaus had a golf resort, or golf course, in Kelowna, B.C. The only marks of the Opponent which are registered for such particular services include registration No. TMA476,091 for NICKLAUS NORTH AT WHISTLER and No. TMA476,098 for NICKLAUS NORTH AT WHISTLER and Design, shown below. The Opponent’s application No. 1,371,182 for JACK NICKLAUS GOLF CLUB, shown below, and attached to the affidavit of Ms. Anastacio, also includes such services.

Registration No. TMA476,098





[34] I consider it of interest that each of the Opponent's marks for golf course services focus on the name JACK NICKLAUS, or NICKLAUS, as opposed to the Opponent's BEAR Design. In fact, the Opponent's BEAR Design is only a small and almost unnoticeable feature of the above noted application No. 1,371,182.

[35] As a further surrounding circumstance, and as previously noted, Ms. Easthom states on cross-examination that the Applicant is also the owner of the registered trade-mark BEAR Design, registration No. 456,231. She notes that this is the original bear design and that the Mark is an updated version of this mark. I note that the fact that the Applicant owns this registration does not give it the automatic right to the registration of the Mark no matter how closely the trade-marks may be related to the trade-mark covered in the original registration [see *Mister Coffee & Services Inc. v. Mr. Coffee, Inc.* (1999), 3 C.P.R. (4th) 405 (T.M.O.B.) at 416 and *American Cyanamid Co. v. Stanley Pharmaceuticals Ltd.* (1996), 74 C.P.R. (3d) 572 (T.M.O.B.) at 576].

conclusion re likelihood of confusion

[36] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the Applicant's BEAR Design on its wares and services at a time when he or she has no more than an imperfect recollection of the Opponent's GOLDEN BEAR and BEAR Design trade-marks, and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot*].

[37] In view of my findings above, and in particular the low degree of resemblance between the marks in appearance and ideas suggested, and the differences between the nature of the



parties' businesses, it seems to me that such a consumer would not, as a matter of first impression, be likely to believe that the wares and services associated with any of the Opponent's GOLDEN BEAR or BEAR Design marks and the Applicant's BEAR Design mark were manufactured, sold or performed by the same person.



[38] The s. 12(1)(d) ground of opposition therefore fails.



Disposition

[39] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Cindy R. Folz
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Trade-mark	Registration No.
BEAR Design 	TMA447,807
BEAR Design 	TMA529,340
GOLDEN BEAR	TMA144,183
GOLDEN BEAR	TMA220,301

	TMA447,808
JACK NICKLAUS SIGNATURE LOGO	TMA448,706
	TMA485,588
NICKLAUS	TMA547,804
<p>NICKLAUS</p>	TMA448,519
<p>NICKLAUS NORTH AT WHISTLER</p>	TMA476,091

 <p data-bbox="212 415 646 464">NICKLAUS NORTH AT WHISTLER</p>	TMA476,098
	TMA220,193