

**IN THE MATTER OF AN OPPOSITION
by Boy Scouts of Canada to application No.
1,034,953 for the trade-mark BILLY
BEAVER filed by Michael Aleksiuik**

On November 28, 1999, Michael Aleksiuik (the “Applicant”) filed an application to register the trade-mark BILLY BEAVER (the “Mark”). The application is based upon proposed use of the Mark in Canada in association with pre-recorded videos, blank videos, pre-recorded tapes; blank tapes; films and television programs recorded on cassettes, tapes, videos, CD ROMS; and children's books; and the broadcasting and production of films and television programs.

The application was advertised for opposition purposes in the Trade-marks Journal of July 4, 2001.

On December 4, 2001, Boy Scouts of Canada (the “Opponent”) filed a statement of opposition against the application. The grounds of opposition can be boiled down to the following:

1. The application does not comply with s. 30 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”) because the Mark is not a trade-mark or a proposed trade-mark.
2. The Mark is not registrable pursuant to s. 12(1)(e) of the Act because it is a mark the adoption of which is prohibited under s. 9, in view of the notice given to the Opponent’s trade-mark BEAVERS under s. 9 in April 1989.
3. The Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a) of the Act because, at the date of filing of the application, the Mark was confusing with the trade-mark BEAVER that had been previously used in Canada by the Opponent in association with youth programs and activities, and a variety of wares such as videos, pre-recorded tapes, CD-Roms, books, clothing, bags, pens, pencils, calendars, games, mugs, spoons, watches, cloth patches and flags.

4. The Mark is not distinctive of the Applicant for the foregoing reasons.

The Applicant filed and served a counter statement in which it not only denied the Opponent's allegations but also set out lengthy argument and information. However, any information that pertains to evidence cannot be considered as evidence since it was not filed in the form required by the *Trade-marks Regulations (1996)*.

As rule 41 evidence, the Opponent filed the affidavits of John Robert Hallett and Wayne Stade. As rule 42 evidence, the Applicant filed the affidavit of Michael Aleksiuik. No cross-examinations were conducted.

Only the Opponent filed a written argument. An oral hearing was not requested.

Material Dates

The material date with respect to the s. 30 ground of opposition is the filing date of the application. [See *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469 at 475.] The material date with respect to the registrability ground of opposition is the date of my decision. [See *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.).] The material date with respect to the entitlement ground of opposition is the filing date of the application. [See s. 16(3).] The material date with respect to the non-distinctiveness ground of opposition is generally considered to be the date of filing of the opposition. [See *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.) at 324.]

Onus

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 Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.).]

The Evidence

Hallett Affidavit

Mr. Hallett is the Opponent's Divisional Executive Director, Operations Division. He provides various printed items concerning the history and activities of the Opponent.

The Opponent (or its predecessor) was founded in 1909 and was incorporated by an Act of Parliament in 1914. In 1976, it comprised more than 250,000 members.

The Opponent operates programmes for boys, which are divided in to sections by age. The youngest section is called BEAVERS; there are also CUBS, SCOUTS, and VENTURERS sections. The BEAVERS program was started in 1971 and by 1976 had more than 35,000 members. "A member of Scouts Canada between the ages 5 to 7 is called a BEAVER and a group would be referred to as BEAVERS." [paragraph 40, Hallett affidavit]

In addition to running its youth programmes, the Opponent sells wares both through retail sales outlets that it operates and through authorized dealers. At paragraph 38, Mr. Hallett attests:

For many years and long prior to November 8, 1999, the marks BEAVER and BEAVERS with or without design features have been used on wares including the following: emblems, crests, buttons, pins, books, videos, clothing... carryalls, pouches, pennants, flags, stick-ons, magnets, plaques, moulds for use in crafts, rings, tie tacks, decorative pins, pencils, book marks, cups, spoons, name tags, comb cases, cassette cover cases, trophy and trophy parts, plaques, saving banks, puppets, backpacks, which have been sold to dealer outlets and supplied to Council outlets by Supply Services for sale to the general public.

As Exhibits 12 through 27, Mr. Hallett provides catalogues displaying items that the Opponent sells, for each of the years 1977 through 1999.

At paragraph 41, Mr. Hallett states:

Campfire Singalong cassettes have been sold since at least 1995 and appeared in the catalogues either in CD or cassette form. It will be noted that in the 1995 Catalogue there are also BEAVERS Videos and in the 2002 Catalogue there is advertised BEAVER Jumpstart videos.

However, when I checked the catalogues I could not see the word BEAVER or BEAVERS associated with the Campfire Singalong items (*e.g.* p. 48 of the 1995/1996 catalogue). Moreover, although the word BEAVERS appears on the videos advertised at pages 32 and 41 of the same catalogue, the movie in question is an IMAX one that follows the life of a beaver family; it therefore appears that the word BEAVERS thereon is used simply to identify the subject matter, not as a trade-mark of the Opponent.

The 2002 catalogue does advertise a “Beaver JUMPSTART Video”, the cover of which appears to read “JUMPSTART for Beavers”. However, that is of course after the material dates of November 8, 1999 and December 4, 2001.

I have noted the following wares in the 1997-98 catalogue:

- page 4 - BEAVER BUGGY craft kit;
- page 26 - BEAVERS CANADA knapsack;
- page 27 - BEAVERS button/pin;
- page 28 - BEAVERS pants;
- page 28 - BEAVER KIT t-shirt;
- page 29 - BEAVERS t-shirt;
- page 41 - BEAVER song book;
- page 42 - JUMPSTART for Beavers video;
- page 54 - BEAVERS flag;
- page 56 - BEAVERS crest.

Each of these items is pictured in the catalogue with the indicated words displayed thereon. Wares are sometimes identified in the catalogue as BEAVER even though such word does not appear on the wares themselves, *e.g.* at page 26 there is a listing for Beaver Pencils but the pencils only display SHARING, SHARING, SHARING, which apparently is the Beaver motto. Although such listings might add to the notoriety of “Beaver” in the hands of the Opponent, they are not use in accordance with s. 4 of the Act.

In its written argument, the Opponent submits that it supplies books with the BEAVER and BEAVERS trade-marks. Such books include the following titles:

- Beaver Leader’s Handbook (Exhibit 5);
- A Book for GROWING BEAVERS (Exhibit 7);

- A BOOK FOR BUSY BEAVERS (Exhibit 7);
- JUMP Start for Beavers (Exhibit 7);
- A BOOK FOR EAGER BEAVERS (paragraph 9).

At paragraph 10, Mr. Hallett states, “Accompanying this affidavit and marked Exhibits 8 and 8-A are copies of BEAVER books entitled ‘Friends of the Forest’ as well as a story companion.” A review of these two exhibits shows that they do not use BEAVER as a trade-mark and I interpret Mr. Hallett’s statement as meaning that these are books used within the Beaver program.

Exhibit 9 is a SCOUTS CANADA Calendar for the year 1996 and Mr. Hallett states that there is a reference to BEAVERS under September. The reference that he is referring to is simply a drawing that is identified as being from a member of the Riverview Park Beavers.

Although Mr. Hallett attests that calendars have been distributed yearly since 1968, no details have been provided concerning the volume of distribution. Similarly, we have not been provided with distribution figures for any of the other wares sold by the Opponent.

As Exhibit 6, Mr. Hallett provides “representative articles concerning BEAVERS that appeared in various publications identified therein on the dates indicated therein.” The names of most of these publications are not familiar and no details have been provided about their circulation. In any event, the Opponent could not rely on these articles as evidence of use of any trade-mark in advertisement [see *Williams Companies Inc. et al. v. William Tel Ltd.* (2000), 4 C.P.R. (4th) 253 (T.M.O.B.)].

Stade Affidavit

Mr. Stade identifies himself as “Camp Ranger/caretaker at Camp Woods, a regional camp in Alberta.” He discusses certain events referred to in the Applicant’s counter statement and then makes some comments concerning the Opponent’s BEAVERS Section. The basis for Mr. Stade’s knowledge concerning the Opponent is not clear and therefore I am according it reduced weight.

Aleksiuk Affidavit

Mr. Aleksiuk's affidavit discusses certain personal matters and clarifies points concerning a discussion that he had with Mr. Stade. It does not provide any information concerning his BILLY BEAVER trade-mark. Instead it points the Board to the Applicant's counter statement. However, a counter statement does not qualify as evidence and so any facts referred to therein are not in evidence. The result is that we have no evidence of the Applicant's activities, or intended activities, in association with his Mark.

Section 30 Ground of Opposition

I am dismissing the s. 30 ground of opposition because the Opponent has not met its initial burden in respect thereof.

Section 12(1)(e) Ground of Opposition

The Opponent has met its initial burden with respect to its s. 12(1)(e) ground of opposition by evidencing its s. 9 notice [exhibit 10, Hallett affidavit].

In *WWF-World Wide Fund for Nature v. 615334 Alberta Limited* (2000), 6 C.P.R. (4th) 247 (T.M.O.B.) at 253, Board Member Martin discussed the test to be applied under s. 9(1)(n)(iii) with reference to the court decisions in *Big Sisters Association of Ontario v. Big Brothers of Canada* (1999), 86 C.P.R. (3d) 504 (F.C.A.); affg. (1997), 75 C.P.R. (3d) 177 (F.C.T.D.), as follows:

As stated in Section 9(1)(n)(iii) of the Act, the test to be applied is whether or not the applicant's mark consists of, or so nearly resembles as to be likely to be mistaken for, the official mark. In other words, is the applicant's mark identical to, or almost the same as, any of the opponent's official marks?: see page 217 of the trial level decision in the Big Sisters case noted above. At pages 218-219 of the trial level decision, Mr. Justice Gibson confirmed that in assessing the resemblance between the marks at issue, regard may be had to the factors set out in Section 6(5)(e) of the Act. Further, at page 218, Mr. Justice Gibson indicated that the test was to be applied as a matter of first impression and imperfect recollection: see also pages 8-9 of the unreported decision of the Federal Court of Appeal in Canadian Olympic Association v. Techniquip Limited (Court No. A-266-98; November 10, 1999).

In the present case, the Applicant's Mark is not identical to the Opponent's official mark. Further, I find that the Applicant's trade-mark BILLY BEAVER, when considered in its entirety, has only

some resemblance to the official mark BEAVERS in appearance, sounding or in the idea suggested. Consequently, the Applicant's Mark is not almost the same as the Opponent's official mark. The differences between BILLY BEAVER and BEAVERS are sufficient to prevent a Canadian consumer from mistaking BILLY BEAVER for BEAVERS. The s. 12(1)(e) ground is accordingly dismissed.

Section 16 Ground of Opposition

With respect to its entitlement ground of opposition, the Opponent must show use of its pleaded trade-mark BEAVER prior to November 8, 1999 and establish that it had not abandoned such mark as of the date of advertisement of the Applicant's application, namely July 4, 2001. [See s. 16(3)(a) and (5) of the Act.]

I find that the Opponent has evidenced use of BEAVERS in Canada in association with youth programs and activities prior to November 8, 1999 and that such use was not abandoned as of July 4, 2001. Furthermore, I accept that use of BEAVERS supports a claim of use of BEAVER, based on Principle 2 of *Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535 at 538-9.

However, I am not satisfied that the Opponent has met its initial burden to show use of BEAVER in association with a variety of wares such as videos, pre-recorded tapes, CD-Roms, books, clothing, bags, pens, pencils, calendars, games, mugs, spoons, watches, cloth patches and flags. With respect to the wares that are most relevant in these proceedings (videos, pre-recorded tapes, CD-Roms, books and calendars), I specifically find that there is no evidence of the Opponent having used BEAVER as a trade-mark in accordance with s. 4 of the Act prior to November 8, 1999. I acknowledge that there is evidence of advertisements in catalogues of BEAVER song books and JUMPSTART for Beavers videos prior to the material date but no evidence of sales.

Accordingly, my analysis of the likelihood of confusion will be focused on the likelihood of confusion between the Opponent's BEAVER services and the Applicant's BILLY BEAVER wares and services.

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: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them.

In *Polo Ralph Lauren Corp. v. United States Polo Association et al.* (2000), 9 C.P.R. (4th) 51 (F.C.A.) at 58-59, Malone J.A. summarized the guidelines to be applied when assessing the likelihood of confusion as follows:

A review of some of the leading cases also establishes some practical guidelines. For example, the Court is to put itself in the position of an average person who is familiar with the earlier mark but has an imperfect recollection of it; the question is whether the ordinary consumer will, on seeing the later mark, infer as a matter of first impression that the wares with which the second mark is used are in some way associated with the wares of the earlier. With respect to the degree of resemblance in appearance, sound or ideas under subparagraph 6(5)(e), the trade-marks at issue must be considered in their totality. As well, since it is the combination of elements that constitutes a trade-mark and gives distinctiveness to it, it is not correct to lay the trade-marks side by side and compare and observe similarities or differences among the elements or components of the marks when applying the test for confusion. In addition, trade-marks must not be considered in isolation but in association with the wares or services with which they are used. When dealing with famous or well-known marks, it may be more difficult to demonstrate that there is no likelihood of confusion, especially if the nature of the wares are similar. Lastly, the enumerated factors in subsection 6(5) need not be attributed equal weight. Each particular case of confusion might justify greater emphasis being given to one criterion than to others.

In the recent Supreme Court of Canada decision in *Mattel, Inc. v. 3894207 Canada Inc.*, 2006 SCC 22, at paragraph 58 Mr. Justice Binnie elaborated on the consumer in question as follows:

A consumer does not of course approach every purchasing decision with the same attention, or lack of it. When buying a car or a refrigerator, more care will naturally be taken than when buying a doll or a mid-priced meal: *General Motors Corp. v. Bellows*, [1949] S.C.R. 678. In the case of buying ordinary run-of-the-mill consumer wares and services, this mythical consumer, though of average intelligence, is generally running

behind schedule and has more money to spend than time to pay a lot of attention to details. In appropriate markets, such a person is assumed to be functionally bilingual: *Four Seasons Hotels Ltd. v. Four Seasons Television Network Inc.* (1992), 43 C.P.R. (3d) 139 (T.M.O.B.). To those mythical consumers, the existence of trade-marks or brands make shopping decisions faster and easier. The law recognizes that at the time the new trade-mark catches their eye, they will have only a general and not very precise recollection of the earlier trade-mark, famous though it may be or, as stated in *Coca-Cola of Canada Ltd. v. Pepsi-Cola Co. of Canada Ltd.*, [1942] 2 D.L.R. 657 (P.C.), “as it would be remembered by persons possessed of an average memory with its usual imperfections” (p. 661). The standard is not that of people “who never notice anything” but of persons who take no more than “ordinary care to observe that which is staring them in the face”: *Coombe v. Mendit Ltd.* (1913), 30 R.P.C. 709 (Ch. D.), at 717. However, if ordinary casual consumers somewhat in a hurry are likely to be deceived about the origin of the wares or services, then the statutory test is met.

inherent distinctiveness of the trade-marks

Neither BILLY BEAVER nor BEAVER is suggestive of their respective wares and services. Accordingly, each mark is inherently distinctive.

the extent to which each trade-mark has become known

This factor favours the Opponent as there is no evidence that the Applicant’s Mark has become known.

the length of time each trade-mark has been in use

The length of time that each trade-mark has been in use clearly favours the Opponent.

the nature of the wares, services or business; the nature of the trade

The Opponent’s main activity is the provision of youth programs in association with a number of marks, including BEAVER.

Mr. Hallett has evidenced that the Opponent sells wares in support of its youth programs through two types of retail outlets: independent retail sales outlets that are duly authorized by the Opponent and retail sales outlets operated by the Opponent or one of its councils. Given the nature of these restricted channels of trade, it seems unlikely that the Applicant’s wares would ever be sold through the outlets employed by the Opponent.

The subject matter of the Applicant's wares/services (pre-recorded videos, blank videos, pre-recorded tapes; blank tapes; films and television programs recorded on cassettes, tapes, videos, CD ROMS; and children's books; and the broadcasting and production of films and television programs) has not been evidenced, nor has its channels of trade.

the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

In considering the two marks as a whole, I find that there is not a great degree of resemblance. There is of course a degree of resemblance between the parties' marks as a result of their common use of the word "beaver". However, I do not consider the fact that the Applicant has incorporated the Opponent's mark as a whole into his Mark to be decisive, in part because I can take judicial notice of the fact that the beaver is one of Canada's national emblems. Moreover, as stated in *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) at 188, "It is axiomatic that the first word or the first syllable in a trade mark is far the more important for the purpose of distinction." In the present case, the first word of the Applicant's Mark, BILLY, serves to distinguish BILLY BEAVER from BEAVER in appearance, sound and idea suggested. With respect to the idea suggested, I find that the Applicant's Mark suggests a character whereas the Opponent's BEAVER mark merely suggests the animal.

conclusion re likelihood of confusion

Having considered all of the surrounding circumstances, I conclude that, on a balance of probabilities, there is not a reasonable likelihood of confusion between BILLY BEAVER and BEAVER. The most crucial or dominant factor in determining the issue of confusion is the degree of resemblance between the trade-marks [see *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.) at 149, affirmed 60 C.P.R. (2d) 70]. I find that the differences between BILLY BEAVER and BEAVER in appearance, sound and idea suggested are sufficient to make confusion unlikely, especially when one considers that 1) the Opponent's main activity is the provision of youth programs, 2) the Opponent does not use its BEAVER mark in association with the specific wares and services applied for by the Applicant, and 3) whatever wares the Opponent does sell are stated to travel

specific channels of trade.

The s. 16 grounds of opposition are accordingly dismissed.

Distinctiveness Ground of Opposition

According to Mr. Justice Noël in the recent decision in *Bojangles' International, LLC and Bojangles Restaurants, Inc. v. Bojangles Café Ltd.* 2006 FC 657, the initial onus on the Opponent with respect to its distinctiveness grounds of opposition requires it to show that its mark had a reputation in Canada that was either substantial, significant or sufficient as of December 4, 2001. I must therefore assess if the Opponent's evidence shows that its BEAVER(S) mark had a reputation in Canada that was either substantial, significant or sufficient as of that date. I find that the Opponent has met its initial burden with respect to its distinctiveness ground. Nevertheless, I reject the ground on the basis that the Applicant's Mark is not confusing with the Opponent's mark as of December 4, 2001, for reasons similar to those set out with respect to the s. 16 grounds of opposition.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8).

DATED AT TORONTO, ONTARIO, THIS 7th DAY OF SEPTEMBER 2006.

Jill W. Bradbury
Member
Trade-marks Opposition Board