



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

Citation: 2012 TMOB 206
Date of Decision: 2012-11-13

**IN THE MATTER OF AN OPPOSITION
by Pacific Carbon Trust Inc. to
application No. 1,411,595 for the trade-
mark CARBON TRUST in the name of
The Carbon Trust**

[1] On September 22, 2008, The Carbon Trust (the Applicant) filed an application to register the trade-mark CARBON TRUST (the Mark) based on proposed use in Canada and based on use in the United Kingdom and registration in OHIM (EU) on January 4, 2004 under No. 2708154 in association with:

business management and administration services; advisory consultancy and information services all in relation to the aforesaid services; administration of financial affairs; financial management; financial planning; provision of finance in respect of environmental issues in the field of carbon management; advisory, consultancy and information services relating to all the aforesaid service; education services relating to environmental issues; arranging of conferences, lectures, displays, exhibitions, presentation, seminars all for the educational purpose in respect of environmental issues in the field of carbon management; business educational and training services in respect of environmental issues in the field of carbon management; computer based education services in respect of environmental issues in the field of carbon management; environmental conservation and consultancy service; research relating to environmental protection; advisory services relating to environmental issues (the Services).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of April 28, 2010.

[3] On September 2, 2010, Pacific Carbon Trust Inc. (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- Pursuant to sections 38(2)(a) and 30(e) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), the Applicant, by itself or through a licensee, or by itself and through a licensee, could not have intended to use the Mark as the application was not filed by a legal entity, but rather by a “trading style”.
- Pursuant to sections 38(2)(b) and 12(1)(e) of the Act, the adoption of the Mark is prohibited by sections 9(1)(n)(iii) in light of the Opponent’s official mark, PACIFIC CARBON TRUST published in the *Trade-marks Journal* of July 14, 2010 under No. 919897.
- Pursuant to sections 38(2)(c) and 16(3)(a) of the Act, the Applicant is not the person entitled to registration of the Mark because at the date of filing the application the Mark was confusing with the Opponent’s trade-mark PACIFIC CARBON TRUST which had been previously used by the Opponent for services the same as or in the same general class as the Services.
- Pursuant to sections 38(2)(c) and 16(3)(c) of the Act, the Applicant is not the person entitled to registration of the Mark because at the date of filing the Mark was confusing with the Opponent’s trade names Pacific Carbon Trust and Pacific Carbon Trust Inc. which had been previously used by the Opponent in Canada
- Pursuant to sections 38(2)(d) and 2, in view of the facts supporting the registrability and non-entitlement grounds of opposition, the Mark is not distinctive because it does not actually distinguish nor is it adapted to distinguish the Services from the services of the Opponent.

[4] The Applicant served and filed a counter statement in which it denied the Opponent’s allegations and put the Opponent to the strict proof thereof.

[5] In support of its opposition, the Opponent filed the affidavit of D. Scott MacDonald, the Opponent’s CEO, sworn March 11, 2011 with Exhibits A – Z and AA - GG.

[6] The Applicant did not file any evidence in support of its application.

[7] Only the Opponent filed a written argument and was represented at an 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. However, there is an initial evidential 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* (1990), 30 CPR (3d) 293 (FCTD) at 298].

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

- sections 38(2)(a)/30(e) - the date the application was filed [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)].
- sections 38(2)(b)/12(1)(e) – the date of my decision [see *Canadian Council of Professional Engineers v Groupeg nie Inc* (2009), 78 CPR (4th) 126 (TMOB) and *Canadian Olympic Assn v Olympus Optical Co* (1991), 38 CPR (3d) 1 (FCA)];
- sections 38(2)(c)/16(3)(a) and (c) – the filing date of the application [see section 16(3) of the Act]; and
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Preliminary Remarks

[10] At the oral hearing, the Opponent brought to my attention the decision *Pacific Carbon Trust Inc v Carbon Trust* (2012), 102 CPR (4th) 81 (TMOB) regarding an opposition between the same parties with respect to the trade-mark FOOTPRINT LOGO.

[11] I was the member of the Trade-marks Opposition Board responsible for issuing that decision and thus I am very familiar with it. I note that the evidence of record in the present proceeding is very similar to that adduced in the FOOTPRINT LOGO opposition. That being said, each case must be decided based upon its own merit.

Non-compliance with section 30(e) of the Act

[12] The Opponent has not filed any evidence in support of this ground of opposition. However, the Opponent submits that it need not have filed evidence since the relevant facts are particularly within the knowledge of the Applicant and thus the Applicant's failure to file such evidence should result in a finding adverse to the Applicant.

[13] In support of this submission, the Opponent relied on *Greenspot Co J.B. Food Industries Inc* (1986), 13 CPR (3d) 206 (TMOB) in which the Registrar held that the opponent had met its burden with respect to a section 30(e) ground of opposition despite the fact that the opponent had not filed any supporting evidence. In that case, the Registrar held that the applicant alone would have been aware of its intention to use the applied-for mark, however it elected not to file such evidence and an adverse inference was drawn. The Opponent submits that the present case is similar to *Green Spot* in that the Applicant could easily have filed evidence proving that it is a legal person, but it chose not to do so. The Opponent submits that in the absence of evidence suggesting otherwise, it could be inferred that The Carbon Trust is merely a trading style.

[14] At the oral hearing the Opponent conceded that the facts in *Green Spot* differ from the facts in the present case, however, the Opponent submitted that an analogy could still be made since the Opponent was of the view that it would be entirely within the Applicant's knowledge whether or not it was a trading style.

[15] I do not agree with the Opponent. I find the present case distinguishable from *Green Spot*. I am of the view that while an applicant's intention to use a trade-mark is clearly a fact that would be within the direct knowledge of the applicant only, the Applicant's status as a legal entity is something that is not necessarily exclusively in the knowledge of the Applicant. The legal status of the Applicant is something that would be publicly accessible and would have been easily ascertainable by the Opponent for example, by conducting a corporate records search.

[16] Based on the foregoing, this ground of opposition is dismissed on account of the Opponent's failure to meet its evidential burden.

Non-registrability ground of opposition – sections 12(1)(e) and 9(1)(n)(iii) of the Act

[17] Mr. MacDonald attaches to his affidavit a copy of the public notice given under section 9(1)(n)(iii) of the Opponent's adoption of the official mark PACIFIC CARBON TRUST in the *Trade-marks Journal* dated July 14, 2010 (Exhibit X).

[18] The test under section 9(1)(n)(iii) is whether a person, on a first impression, knowing the Opponent's official mark only and having an imperfect recollection of it, would likely be

deceived or confused by the Mark. This is not a test of straight comparison, and if, as is the case in the present opposition, the marks are not identical, then there must be consideration of whether the Mark so nearly resembles as to be likely to be mistaken for the Opponent's official mark. In assessing the degree of resemblance under section 9(1)(n)(iii), the test is not restricted to visual comparison. Regard may be had to the factors set out in section 6(5)(e) of the Act, namely the degree of resemblance between the marks in appearance, sound or in the ideas suggested by them [see *Techniquip Ltd v Canadian Olympic Assn* (1998), 80 CPR (3d) 225 at 230 (FCTD), aff'd 3 CPR (4th) 298 (FCA); *Big Sisters Association of Ontario v Big Brothers of Canada* (1999), 86 CPR (3d) 504 (FCA); *Hope International Development Agency v Aga Khan Foundation Canada* (1996), 71 CPR (3d) 407 at 413 (TMOB) at 413].

[19] The Opponent submits that the comments of the Supreme Court of Canada in *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) are relevant to the application of section 6(5)(e) to a ground of opposition based on section 9(1)(n)(iii) of the Act. I agree. In *Masterpiece* the Supreme Court of Canada advised that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique [see *Masterpiece* at para 64]. The Opponent submits that the most striking element of the Opponent's Official Mark is the words CARBON TRUST. I agree. The additional element, PACIFIC, as a geographical term acts merely as a qualifier for the striking/unique element CARBON TRUST. The most striking element of the Opponent's Official Mark is thus identical to the entirety of the Mark.

[20] The parties' marks therefore share significant similarity in appearance, sound and ideas suggested.

[21] Having regard to all of the foregoing, in particular the significant similarities in appearance, sound and ideas suggested as a result of the inclusion of the dominant CARBON TRUST element in both parties' marks, I am not satisfied that the Applicant has met the onus on it to establish that the Mark does not so nearly resemble the Opponent's official mark as to be mistaken therefore.

[22] Based on the foregoing, the ground of opposition based on sections 12(1)(e) and 9(1)(n)(iii) of the Act is successful.

Non-entitlement grounds of opposition – sections 16(3)(a) and (c) of the Act

[23] I note that, despite the fact that the Applicant has included a foreign use and registration claim the Opponent has not included a non-entitlement ground of opposition based on section 16(2) of the Act.

[24] In order to meet its evidential burden for each of these two non-entitlement grounds of opposition, the Opponent must establish that the PACIFIC CARBON TRUST trade-mark, and/or one or more of the Pacific Carbon Trust/Pacific Carbon Trust Inc. trade-names, respectively, were used prior to the filing date for the application for the Mark (September 22, 2008) and had not been abandoned at the date of advertisement of the application for the Mark (April 28, 2010) [section 16(5) of the Act].

[25] Mr. MacDonald states that the Opponent is a Crown Corporation that was incorporated on March 14, 2008 to purchase carbon offsets on behalf of public and private sector entities in the province of British Columbia (BC) who wish to offset their greenhouse gas emissions to reach their carbon reduction goals. Mr. MacDonald states that the Opponent is owned by and reports to a sole shareholder, namely the Minister of Finance of BC. Mr. MacDonald explains that the Opponent was formed as part of BC's Climate Action Plan which he states is BC's "roadmap to a green economy" with a goal of reducing greenhouse gas emissions in BC by 33% of 2007 emissions by 2020. Mr. MacDonald states that, as required under the *Greenhouse Gas Reduction Targets Act* and associated regulations, the Opponent is the exclusive vehicle to deliver offsets to the BC public sector for the provincial government's carbon neutral commitment.

[26] Mr. MacDonald states that the Opponent purchases carbon offsets on behalf of public and private sector entities in BC who wish to offset their greenhouse gas emissions or reach their carbon reduction goals. Mr. MacDonald explains that an offset represents a reduction or removal of greenhouse gas emissions from the atmosphere and is measured as a tonne or carbon dioxide equivalent (CO₂e). Mr. MacDonald explains that offsets, or carbon savings, are generated from changes made by the public and private sectors, to avoid or absorb CO₂ or any of the other main greenhouse gases. Mr. MacDonald states that typically these greenhouse gas reducing activities fall into one of three categories:

- lower carbon fuel switching (e.g. switching from oil to natural gas);
- energy efficiency (e.g. installing industrial technology to reduce energy use); and
- carbon sequestration (e.g. storage of CO₂ in trees, or capture and sequestration from industrial emissions).

[27] Mr. MacDonald states that the price attached to the offsets provides funding for innovation with a goal of reducing greenhouse gas emissions.

[28] Mr. MacDonald states that the Opponent expects to secure up to one million tonnes of offsets annually in an effort to support the BC government's carbon neutral commitment.

[29] Mr. MacDonald states that the Opponent, acting on behalf of BC, acquires offsets from projects located in BC that meet eligibility criteria as defined by the Ministry of Environment *Emission Offsets Regulations*, a copy of these regulations is attached to Mr. MacDonald's affidavit (Exhibit B).

[30] Mr. MacDonald provides examples of the projects the Opponent has been involved with. For example, Mr. MacDonald states that the Opponent has been contracted to purchase offsets generated from a greenhouse project in Abbotsford, BC. I note that Mr. MacDonald has not provided a date when the Opponent began this project and thus I can only infer that the Opponent was involved in the project at the date Mr. MacDonald swore his affidavit, namely March, 2011.

[31] Mr. MacDonald states that the Abbotsford greenhouse project is one of 15 projects the Opponent is engaged in in BC which together total reductions of over 300,000 tonnes of greenhouse gas emissions over five years. Mr. MacDonald states that the Opponent has also signed several initial agreements and is in negotiation with or assessing a wide range of new projects from many BC economic sectors for additional projects. Specifically, Mr. MacDonald states that the Opponent has signed a letter of intent with a pulp and paper company for a multi-year carbon offset project that he states will generate up to 80,000 tonnes in CO₂e reductions. Mr. MacDonald attaches to his affidavit materials printed from the Opponent's website which list the Opponent's private sector projects (Exhibit C). I note that the Opponent's trade-mark and trade-name PACIFIC CARBON TRUST appears on the Opponent's website. Again, I note that

Mr. MacDonald has not provided any dates for when these projects were engaged in and thus I can only infer that these were, at the earliest, current to the date he swore his affidavit, namely March 2011.

[32] Mr. MacDonald states that the Opponent also owns a series of design marks which incorporate the words PACIFIC CARBON TRUST with the words, Carbon Neutral Company, Carbon Neutral Vehicle, Carbon Neutral Event or Carbon Neutral Flight, respectively, along with a design feature. The Opponent grants permission to third parties to use these marks where specific criteria are met, suggesting that these are in fact certification marks. Mr. MacDonald provides a photograph showing one of these marks displayed on a delivery van where a third party had been granted permission to do so by the Opponent (Exhibit E). The photograph is undated and thus I can only infer that it is current to the date Mr. MacDonald swore his affidavit, namely March 2011, and therefore it post-dates the material date. The Opponent also provides materials printed from the website of Helijet International Inc. (Helijet), a passenger helicopter service (Exhibit F). Mr. MacDonald states that Helijet's aircraft display the "Carbon Neutral Flight" mark and Helijet's website, printed March 3, 2011, displays the Opponent's PACIFIC CARBON TRUST trade-mark/trade-name (Exhibit F).

[33] The Opponent's evidence does not establish use of the trade-mark PACIFIC CARBON TRUST in accordance with section 4(2) of the Act prior to the filing date for the application. Thus the ground of opposition based on section 16(3)(a) of the Act is dismissed on account of the Opponent's failure to meet its evidential burden.

[34] With respect to the ground of opposition based on section 16(3)(c) of the Act, I am satisfied, for the reasons that follow, that there is evidence pre-dating the material date which shows use of the trade-name Pacific Carbon Trust.

[35] Mr. MacDonald's affidavit establishes that the Opponent issued to the public a "Request for Information" (RFI) for greenhouse gas offsets in July 2008. Mr. MacDonald explains that the primary purpose of the RFI was to "obtain information from interested parties for the supply of qualifying greenhouse gas offsets meeting the parameters described in the RFI in order to assist the Opponent in its future procurement process". Mr. MacDonald attaches to his affidavit a copy of the RFI in which the Opponent is referred to as Pacific Carbon Trust (Exhibit U). I am willing

to accept this as evidence establishing that the Opponent had commenced operations in July 2008 and was operating under the trade-name Pacific Carbon Trust.

[36] Mr. MacDonald's affidavit also establishes that the Opponent was offering its carbon offset services as of July, 2008 under the trade-name Pacific Carbon Trust. Specifically, Mr. MacDonald states that the Opponent was responsible for offsetting travel emissions for the estimated 800 delegates who participated in the 18th annual Pacific Northwest Economic Region summit hosted in BC from July 20-24, 2008. Mr. MacDonald attaches to his affidavit a press release dated July 21, 2008 describing these offsets (Exhibit V). I note that the Opponent is referred to in the press release by the trade-name Pacific Carbon Trust. Mr. MacDonald states that during the summit, the Minister of Environment, Mr. Penner, gave a presentation on "Climate Action Plan – BC" in which reference is made to the Opponent (Exhibit W) by the trade-name Pacific Carbon Trust.

[37] I am prepared to accept the press release and the Minister's presentation as supporting Mr. MacDonald's sworn statement that the Opponent was responsible for offsetting travel emissions for the summit in July 2008. When viewed in association with the evidence as a whole, I accept this evidence as supporting a finding that the Opponent had begun offering its carbon offsetting services in July 2008 and was operating under the trade-name Pacific Carbon Trust.

[38] The Opponent submits that this evidence supports a finding that the Opponent was using the trade-mark PACIFIC CARBON TRUST as of the relevant date. However, the Opponent was not able to point me to any evidence of record which clearly displayed the trade-mark PACIFIC CARBON TRUST being displayed in the carrying out of the Opponent's services or in advertisements therefore in accordance with section 4(2) of the Act. My previous finding as to the Opponent's failure to meet its evidential burden under section 16(3)(a) of the Act remains applicable.

[39] As previously indicated, I am satisfied that the Opponent has established use of the trade-name Pacific Carbon Trust in Canada prior to the filing date of the application for the Mark. Further, I am satisfied that the following evidence shows use of the trade-name Pacific Carbon

Trust in Canada and establishes non-abandonment thereof as of the date of advertisement of the application for the Mark (April 28, 2010):

- copies of corporate presentations offered by the Opponent to business groups who are interested in engaging with the Opponent for the purpose of purchasing and selling offsets – from October 14, 2009 to May 28, 2010 (MacDonald affidavit, Exhibit H). The presentations dated October 14, 2009 and November 17, 2009 predate the advertisement date;
- materials printed from the Opponent’s website on June 23, 2010 and July 7, 2009 (Exhibits I, J, K), The July 7, 2009 printouts predate the advertisement date;
- the Opponent’s Service Plans dated February 2009 (covering 2009/10 – 2011/12) and January 15, 2011 (covering 2011/12 – 2013/14) (Exhibit R). The February 2009 Service Plan predate the advertisement date; and
- Information Bulletins regarding the Opponent’s activities (March, April, July, November 2009; June, July, September, October, November 2010; and January, February 2011) (Exhibit S). The Information Bulletins from March, April, July and November 2009 all predate the advertisement date.

[40] Based on the foregoing, I am satisfied that the Opponent has met its evidential burden under section 16(3)(c) of the Act for the trade-name Pacific Carbon Trust. I note that the Opponent’s claimed trade-mark is the same as the alleged trade-name and thus even if I am wrong in finding that the Opponent has not met its burden with respect to the trade-mark, the same confusion analysis would apply.

[41] I must now assess whether the Applicant has met its legal burden. Specifically, the onus is on the Applicant to establish on a balance of probabilities that there is no likelihood of confusion between the Mark and the Opponent’s trade-name Pacific Carbon Trust.

[42] 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, or trade-name if the use of both in the same area would be likely to lead to the inference that the wares or services associated with them are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[43] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-mark and trade-name 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-mark and trade-name in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece, supra.*]

[44] Recently, in *Masterpiece*, the Supreme Court of Canada discussed the importance of the section 6(5)(e) factor in conducting an analysis of the likelihood of confusion between the parties' marks in accordance with section 6 of the Act (see para 49):

...the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis ... if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar.... As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start... [emphasis is mine]

[45] Under the circumstances of the present case, I consider it appropriate to analyse the degree of resemblance between the parties' marks first.

Section 6(5)(e) – the degree of resemblance between the trade-mark and trade-name in appearance or sound or in the ideas suggested by them

[46] I rely on my discussion regarding the section 6(5)(e) factors above in the analysis of the ground of opposition based on section 9(1)(n)(iii) of the Act wherein I found that the Mark shares a significant degree of resemblance with the Opponent's Official Mark PACIFIC CARBON TRUST, which is identical to the Opponent's trade-name, Pacific Carbon Trust. As a result, this factor significantly favours the Opponent.

[47] Having found that the Mark and the Opponent's Pacific Carbon Trust trade-name are very similar, I must now assess the remaining relevant surrounding circumstances to determine

whether any of these other factors are significant enough to shift the balance of probabilities in favour of the Applicant [see *Masterpiece*, *supra* at para 49].

Section 6(5)(a) – the inherent distinctiveness of the trade-mark and trade-name and the extent to which they have become known

[48] The Opponent submits that the parties' marks are made up of ordinary English language words and thus each possesses a moderate degree of inherent distinctiveness. The Opponent concedes that the word PACIFIC, as a geographic word, does not add much to the inherent distinctiveness of the Opponent's Pacific Carbon Trust trade-name.

[49] I am of the view that both parties' marks are suggestive of the parties' carbon management and environmental protection activities. Furthermore, I find that the word PACIFIC is suggestive of the Opponent's geographical location.

[50] Based on the foregoing, I assess the inherent distinctiveness of the Mark and the Opponent's trade-name as being essentially the same.

[51] The strength of a trade-mark or trade-name may be increased by means of it becoming known in Canada through promotion or use. I will now turn to the extent to which the Mark and the Opponent's trade-name have become known in Canada.

[52] The application for the Mark is based on proposed use and use in the United Kingdom and registration in OHIM (EU) and the Applicant has not filed any evidence of use of the Mark. As a result, I can only conclude that the Mark has not become known to any extent.

[53] The nature of the Opponent's business is such that the traditional methods of quantifying the extent to which a mark has become known may not be applicable (i.e. invoices, sales figures, etc.). To this end, the Opponent has provided evidence which I find, when viewed in association with the evidence as a whole, demonstrates that some individuals and organizations in BC are familiar with the Opponent by the name Pacific Carbon Trust. Specifically,

- copy of the Climate Action Secretariat of the Ministry of Environment of the Province of British Columbia publicly available report dated 2008 but made publicly available June 30, 2009 entitled "Getting to Carbon Neutral" in which the benefits of carbon neutrality and the action plan to achieve such neutrality

are described. The Opponent is referenced in the report (pages 23-24) (Exhibit P);

- copy of the Speech from the Throne, Opening of the Fourth Session of the Thirty-Eighth Parliament, dated February 12, 2008, in which the Lieutenant-Governor, The Honourable Steven L. Point mentions the Opponent by name in describing the BC's green energy initiatives (Exhibit Q, p. 17);

[54] Mr. MacDonald provides other examples (Exhibits O, Y, Z, AA, BB, CC, DD, EE, FF and GG); however these are all dated after the material date and cannot be relied upon by the Opponent to assist it in establishing a reputation for the Opponent's trade name at the material date.

[55] Based on the foregoing, I am prepared to accept that the Opponent has established some reputation for the trade-name Pacific Carbon Trust at the material date but that any such reputation would be restricted to the province of BC.

Section 6(5)(b) – the length of time each has been in use

[56] As stated above in the analysis of the section 6(5)(a) factor, the Applicant has not established any use of the Mark.

[57] As discussed in more detail above in the analysis of the section 6(5)(a) factor, the Opponent has established use of the trade-name Pacific Carbon Trust since approximately July 2008.

Sections 6(5)(c) and (d) – the nature of the wares, services or business and trade

[58] The Opponent is responsible for organizing carbon offsets to assist public and private sector businesses in BC to achieve carbon neutrality. The Opponent also permits companies to use marks which incorporate the words Pacific Carbon Trust where these companies meet certification standards set out by the Opponent. The Opponent is also engaged in business-related activities, policies, practices, communication and administrative information all in the field of carbon management and environmental protection. Specifically, the Opponent offers the following additional services:

- business and market development services namely working with industry to educate clients about emissions reductions and offsets and manages education and outreach activities across industry sectors to help organizations learn about offset development and opportunities in their sectors;
- portfolio design services namely managing a risk management strategy designed to diversify offset supply;
- policy and practices services namely developing policies and practices relating to finance, administration, information technology and other corporate operations;
- knowledge management and research services namely monitoring and distributing information related to carbon markets and carbon policy developments throughout North America;
- communications and information dissemination services namely managing a website to provide information to its clients, suppliers, partners and many stakeholders, developing and distributing news releases, brochures, bulletins, corporate reports, presentations and other industry-related information.

[59] The Applicant has not filed any evidence of use of the Mark in order to provide guidance on the nature of the Applicant's trade; however, I note that most of the Services relate to environmental issues in the field of carbon management.

[60] The parties' services are thus highly related and share a significant degree of similarity as both parties operate in the environmental education and carbon emissions field.

[61] By virtue of the similarity in the nature of the parties' services, and in the absence of evidence regarding the nature of the Applicant's trade, I find that the parties' channels of trade could also overlap.

Additional Surrounding Circumstance

[62] At the oral hearing, the Opponent submitted that because the Opponent is the only party who filed any evidence in the present proceeding and because the Applicant is a foreign entity, consumers in Canada would assume when they see the Mark that the carbon trust that is being referred to is the Opponent or that the Applicant's services are somehow related to the Opponent or that there is some association with the Opponent.

[63] I need not consider this additional surrounding circumstance in order to find in the Opponent's favour.

Conclusion

[64] The issue in this ground of opposition is whether a consumer who has a general and not precise recollection of the Opponent's trade-name Pacific Carbon Trust, will, upon seeing the Mark, be likely to think that the services share a common source. I cannot answer that question in the negative. To this end, I note that it is highly relevant that the nature of the parties' services and channels of trade share similarities by virtue of the fact that both parties operate in the carbon emissions industry.

[65] Based on the foregoing, and having considered all of the relevant surrounding circumstances based on first impression and an imperfect recollection, in particular the significant similarities between the Mark and the Opponent's trade-name appearance, sound and ideas suggested, I am not satisfied that the Applicant has satisfied its onus of proving on a balance of probabilities that there is no likelihood of confusion between the Mark and the Opponent's trade-name Pacific Carbon Trust. As a result, the ground of opposition based on section 16(3)(c) of the Act is also successful to the extent that it is based upon the trade-name Pacific Carbon Trust.

Section 38(2)(d) Ground of Opposition

[66] In order to meet its initial burden with respect to this ground, the Opponent must establish that one or more of the Opponent's trade-mark PACIFIC CARBON TRUST or Pacific Carbon Trust/Pacific Carbon Trust Inc. trade-names were known to some extent at least in Canada as of September 2, 2010 [see *Bojangles' International LLC v. Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC) and *Motel 6, Inc v No. 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD)]. As stated in *Bojangles* at para 34:

A mark must be known to some extent at least to negate the established significance of another mark, and its reputation in Canada should be substantial, significant or sufficient.

[67] As discussed above in the analysis of the section 6(5)(a) factor, the nature of the Opponent's business is such that traditional types of documentation which are provided as evidence supporting reputation for a mark (i.e. invoices, sales figures, etc.) may not be as applicable. In addition to the evidence discussed above in the non-entitlement ground of opposition, the Opponent may rely on the following additional evidence which pre-dates the material date for this ground of opposition:

- printout from the website of Offsetters Clean Technology Inc. with whom the Opponent signed an agreement in April 2009 to purchase high quality emission offsets to address climate change in BC (Exhibit DD). The website was printed March 3, 2011 but displays a news release from April 2009 and is adduced to support Mr. MacDonald's sworn statement that the Opponent signed an agreement with this organization in April 2009;
- printouts from the University of Toronto Centre for Environment website as well as a promotional advertisement (Exhibit FF). The Opponent partners with the University of Toronto in presenting a workshop on carbon finance which enables students to obtain a Certificate of Achievement: Carbon Finance. The workshop was held in November 2009 and November 2010. The November 2009 workshop predates the material date.
- printout from the PricewaterhouseCoopers website describing the Global Forest & Paper Industry Conference held May 11, 2010 which was sponsored by the Opponent (Exhibit GG).

[68] Aside from the University of Toronto Centre for Environment website described above the evidence supports a finding that the Opponent's reputation was restricted to the province of BC.

[69] In cases where reputation is limited to a specific geographical area in Canada, the threshold for establishing a reputation may be higher. In this regard, I refer to the first part of paragraph 33 of *Bojangles*, as reproduced below (emphasis is mine):

[33] The following propositions summarize the relevant jurisprudence on distinctiveness where there is an allegation that a mark's reputation negates another mark's distinctiveness, as per s. 2 and para. 38(2)(d) of the Act :

- The evidential burden lies on the party claiming that the reputation of its mark prevents the other party's mark from being distinctive;
- However, a burden remains on the applicant for the registration of the trade-mark to prove that its mark is distinctive;

- A mark should be known in Canada to some extent at least to negate another mark's distinctiveness;
- Alternatively, a mark could negate another mark's distinctiveness if it is well known in a specific area of Canada;
- A foreign trade-mark owner cannot simply assert that its trade-mark is known in Canada, rather, it should present clear evidence to that effect;
- The reputation of the mark can be proven by any means, and is not restricted to the specific means listed in section 5 of the Act, and it is for the decision-maker to weigh the evidence on a case-by-case basis.

[70] As noted in the fourth bullet above, when an opponent's reputation is restricted to a specific area of Canada, the opponent's initial onus may be satisfied if one or more of its trade-mark and/or trade-names are well known in that specific area. However, the evidence before me does not enable me to conclude that the Opponent's trade-names were well known in BC. Rather, it appears to be only a small and specific group in BC that would be aware of the Opponent. Even if I were to accept the University of Toronto website as evidencing a reputation for the Opponent which expands outside of BC, I am not satisfied that the reputation for the Pacific Carbon Trust trade-name was substantial, significant or sufficient as of the material date. As a result, I find that the Opponent has not met its initial onus with result that the distinctiveness ground of opposition is dismissed.

Disposition

[71] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office