

**IN THE MATTER OF AN OPPOSITION by Zeneca
Limited to application No. 806,142 for the trade-mark
BONZAI and design belonging to Raymond Junior
Courtemanche**

On March 6, 1996, Raymond Junior Courtemanche (the applicant) filed an application for registration of the trade-mark BONZAI and design, as illustrated below:



The applicant based his application for registration on use of the mark in association with certain products and services since November 24, 1988, and on its proposed use for other products and services. The wares and products are described in more detail below. The application for registration was published in the Trade-Marks Journal of November 26, 1997. Zeneca Limited (the opponent) filed its statement of opposition on April 27, 1998. The opponent amended its statement of opposition (the opposition) on July 17, 1998.

On June 17, 1999, the applicant filed an amended application, which contained the following list of wares and services: 1. Garden products in bulk and by the bag namely seeds, soil, black earth, sand, topsoil, picmost, crushed stone, asphalt, decorative stone, rocks for rock gardens, sod, lawn grass, salt for deicing surfaces in winter, abrasive products for deicing surfaces in winter; chicken manure, sheep manure, cattle manure, shrimp compost, crab compost, fertilizing products, chemical fertilizers and organic fertilizers in bulk or by the bag; insecticides, pesticides, roudenticides in liquid and powder form; fountains, basins, statuary and statuettes for decorative outdoor use, outdoor lighting, waterfalls, paving bricks, retaining wall components, retaining wall blocks, cedar poles, fencing, ties; cultivating implements, namely wheelbarrows, trailers, garden rakes, lawn rakes, spades, picks, mattocks, pruning scissors, grass cutters, lawnmowers, shovels,

dibbles, cultivators, hoes; flowers, texel, Christmas trees, legumes, garden vegetables, herbs.

2. Publications, namely: magazines, newspapers, journals, comics, brochures, images, books, pamphlets, manuals, guides, folders, communiqués, newsletters, bonus coupon booklets, gift certificates, discount coupons for advertising purposes, instruction manuals, publications related to the sale of real estate, signs and boards for the sale of real estate and real property; affinity credit cards, games and toys, namely: games of skill, parlour games, action games, card games, role-playing games, word games, educational games, dart games, checker games, chess games, dice games, domino games, solitaire games, computer games, motivational games, video games; checkerboards, chessboards, puzzles, flying saucers for throwing games, mobiles, puppets, crosswords, crossword puzzles, hidden words, hidden word puzzles, kites, skipping ropes, plush toys, dolls, building toys, miniature furniture, trucks, cars, toys requiring assembly, scale models, computer software, software used as a means of communication among franchisees, franchisers, merchants, contractors, self-employed persons; computer programs, software packages and software; household products, namely: soaps and all-purpose cleaners in liquid or powder form, cleansers, stain removers for carpets and furniture, disinfectants, air cleaners, air purifiers, glass cleaners, air fresheners, shampoo for carpets and upholstery, prewash agents, fabric softener, liquid and powdered laundry detergent, whitener, pine-oil disinfectant, cream cleanser, bleach, blanching agents, scrub brushes, pails, cleaning sponges, paper towels, toilet tissue, cleaning cloths, garbage cans, paper laundry bags, garbage bags, aprons, smocks, overalls, gloves, uniforms, mops, wax, waterless hand cleaner, furniture polish, woodwork cleaner, toilet bowl cleaner, scouring pads, brooms, deodorizers, products for the care of footwear and clothing, namely stain removers for clothing, stain removers for footwear, shoe polish, vinyl and leather cleaner, liquid protector for leather and vinyl, all-purpose brush, waxes and stain removers for floors, dust pans, dust cloths, steel wool, pump atomizers, bottles with pour-spouts, metal cleaner, furniture cleaner, deodorizer, cedar deodorizer blocks, leather and vinyl conditioner, carpet deodorizer, polishing cloths, dishwasher detergent, sets of scouring items; household appliances, namely: refrigerators, dishwashers, freezers, microwave ovens, ranges, washing machines, dryers, small electrical appliances, namely: toasters, coffee makers, woks, coffee mills, teapots, mixers, blenders, weigh scales, bathroom scales, grills, juicers, food processors, fry pans, kettles, beaters, meat grinders, fondue sets, pressing irons, can openers, percolators, corn roasters, deep fryers, espresso machines, first aid kits; toiletries, namely: aftershave, eaux de cologne, cream rinses, creams, deodorants, facial make-up, namely: false eyelashes, blush, talcum powder, wrinkle remover cream, eyebrow pencils, lip-liner pencils, eyeliner cream, hair colouring, hair styling products, namely: hair spray, hair lotion, shampoo, cream rinse, eyeshadow, mascaras, soaps, skin cleansers, nail polish, toothpaste, mouthwash, sun and tanning creams and lotions, toilet soap, skin lotions, nail brushes, hairbrushes, combs, astringents, moisturizers, perfumes, essential oils, foam bath, hand cream, face cream, pre-shave lotion, eau de toilette, hand and body lotion, body cream, lip balm, shaving cream, breath freshener, manicure kits, cosmetics bags, make-up kits, sponges, travel kits, lip colour, antiperspirant, atomizers, foundation, make-up brushes, devices and containers for dispensing essential oils, pumice stones, liquid soap, cleansing cream,

moisturizing cream, scents, fragrant dried plants and flowers for suppressing odors, insect repellent; clothing, namely: fleece-lined garments, sweatshirts, T-shirts, tank tops, bath wraps, dressing gowns, neckties, jogging outerwear, bibs, jeans, shorts, halter tops, bathing suits, beach cover-ups, housedresses, blouses, scarves, straw hats, fabric hats, felt hats, skullcaps, caps, tuques, toques, earmuffs, visors, headbands, paper and fabric slippers, paper and cloth handkerchiefs, belts, suspenders, dresses, sweaters, sunbathing outfits, bathing outfits, pajamas, nightgowns, pants, headbands, jackets, wristbands, cloth shirts, anoraks, socks, mitts, chef's hats, oven mitts, chef's aprons, beach towels, gloves, umbrellas, beach bags, sports grips, clothing hangers, bikinis, turtlenecks, lingerie, raincoats, bonnets, berets, bathing caps, knitwear, namely garter belts, bras, nylon stockings, stockings, pantyhose, coats, socks; footwear, namely: jogging shoes, running shoes, basketball shoes, sneakers, soft slippers, low-front shoes; food products, namely: cheese, butter, cakes, pies, fruits, vegetables, semolina, rice, bread, pastries, muffins, croissants, pasta, prepared dishes, delicatessen meats, seafood, shell fish, fish, poultry, game, meat, pâtés, pâtés in crust, tourtières, quiche lorraine, chicken pie, salmon pie, tea, coffee, cocoa, mineral water, chewing gum, chocolate milk, yogurt, ice cream, ice cream bars, cereal, peanuts, seasonings, namely: mixture of spices and fine herbs, pepper, salt; maple syrup, chips, dairy products, namely: milk, butter, margarine; frozen and quick-frozen products, namely: fruits, vegetables, prepared dishes, pasta, bakery and pastry products and doughs, namely: bread, muffins, croissants, pasta, pizza, French fries, vegetables, delicatessen meats, meats, fish, poultry, game, fruits, desserts, namely: cakes, pies, cookies, seafood, shellfish, pâtés, pâtés in crust, tourtières, quiche lorraine, chicken pies, salmon pies; alcoholic products, namely: wine, spirits, beer with or without alcohol, aperitifs with or without alcohol, coolers with and/or without alcohol, brandies, liqueurs with or without alcohol; food products, namely: soft drinks, mustard, vinegar, oils, fine herbs, edible grains, orange juice, vegetable juice, spices, marshmallows, ketchup, olives, pet food, packets of sugar, condiments, peanut butter, jams, jelly, fruit juices, honey, small cakes, snack bars, candy bars, chocolate, candies, cookies, cereal, sauces, soups, desserts, namely: cakes, pies, puddings, food flavourings, pizza, chicken, French fries, hamburgers, hotdogs, recipe books, recipe cards, flavours and flavour extracts, condiments, vanilla and vanilla extract, cinnamon, barbecue sauce, magic sauce for meat, pie filling, natural spices, salt substitute, marinades, seasoning salts for popcorn, butter flavour, concentrated mix for soups and sauces, dessert mixes, concentrated punch mix, instant cocoa mix, instant coffee, coffee substitute; nutritional supplements, namely: proteins in solid, powder, liquid and tablet form, herbs, vitamins, minerals, plant extracts, meal substitutes in liquid, powder, bar and biscuit form; weight-control products in liquid, bar, powder and biscuit form, colas, instant beverages in powder and crystal form, ginseng, royal jelly, bee pollen, energy drink, energy bars, aloe vera beverage, aloe vera jelly and aloe vera capsules; health aids, namely: liniment, pain relievers, ointments in cream and/or liquid form, medicated vaporizers, liquid respiratory aid, first aid spray, camphor cream, tiger balm, analgesic balm, syrup for coughs and/or colds, mouthwash, mouthwash container, product for relieving heartburn, foot cream, foot powder, foot spray; pet care products, namely, shampoo, coat conditioner, perfume, eau de cologne, bird seed, fish food, aquariums, cages; building materials, namely: sinks, bathtubs, toilets, toilet seats, bidets, showers, barbecues, fireplaces,

chimneys, wood stoves, paint, colouring, varnish, shellac, coatings, brushes, rollers, spatulas, paint trays, saunas, hot tubs, whirlpool baths, tanning beds, water beds, kitchen faucets, bathroom faucets, laundry room faucets, carpeting and floor tile, vinyl floor covering, vinyl floor tile, ceramic tile for walls and floors, rustproofing products, wood preservatives, wood stains, painting implements, vinyl, aluminum, wood and steel doors and windows, wood and aluminum siding, asphalt and cedar roofing shingles, clay roof tiles, glass fibre roof tiles, eavestroughs and downpipes, patio doors, baseboards and door frames, wood, wrought-iron, polymer stair railings, stairs of all kinds, wall panelling, laminated panels, acoustic ceiling tiles, window glass, windows, greenhouses, yard fences of all kinds, screens, furniture, namely: tables, chairs, armchairs, beds, coffeetables, bedside tables, stools, lamps, sofas, figurines, light fixtures, photo-engravings, laminated pictures and frames, frames, picture mats, reproduction of pictures, lithographs, posters, watercolours, pedestal tables, vases, mirrors, frames, pictures, shelves, bars, nicknacks, fabric, upholstery fabric, drapes, opaque blinds, vertical blinds, horizontal blinds, canvas blinds, sheers, bamboo blinds, paper blinds, roll-up blinds, wallpaper, wall covering, soft wallcoverings of vinyl or textile glued on foam, on canvas or on paper, in rolls or tiles, cork in rolls or tiles, straw in rolls or tiles for walls, fabric for hanging, stapling or gluing to walls, molding made of wood, plaster or plastic for walls, doors and ceilings; staplers and glue, sample books of floor coverings, wall coverings, wallpaper and fabrics, silk plants and flowers, figurines, statuettes, wicker baskets; shower curtains, dried flowers, pots, planters, live plants, artificial plants and flowers, tea and coffee sets, spice racks and jars, salt shakers, pepper shakers, bottle openers, utensil holders, glasses, cups, bowls, mixing bowls, china, china dishes, plastic dishes, earthenware dishes, cutlery, small clocks, alarm clocks, clocks, mats, spice shelves, cookie jars, beer mugs, towels, face cloths, decorative door handles, soap dishes, glass holders, towel holders, clothes hampers, wastebaskets, garbage receptacle, vanity, cupboard, bedding, namely, blankets, bedspreads, sheets, duvets, comforters, valances, slipcovers, pillowcases, pillows, cushions, rugs, doormats, table linen, mats, linoleum, tablecloths, place mats, oven mitts, apron, chef's hat, handle covers for hot pans, platters, aprons, utensils and containers, pots and pans, household containers for kitchen use, glassware, bath mats, basketware, plant shelves, bedside rugs, kitchen furniture, kitchen cabinets, bathroom furniture, kitchen counters, bathroom counters, medicine cabinets, furniture for adult bedrooms, furniture for children's bedrooms, dining room furniture, living room furniture, office furniture, indoor and outdoor wicker furniture, burglar alarms, fire extinguishers, smoke alarms, air purifiers, water filters, humidifiers, alarm systems for automobile, home, office and business; theft prevention systems for cars, motorcycles, bicycles, boats; vacuum cleaners, push brooms, sewing machines; outdoor furniture and accessories, namely, tables, servers, chairs, patio tables, stools, covers, parasols, shelters, car shelters, fences, arbors, pergolas, pavilions, greenhouses, sheds, outdoor carpeting, paving stones and decorative stones for patios, chair cushions, tablecloths, ashtrays, dinnerware, glasses, cups, pitchers, plates, saucers, small plates, bowls, cutlery, butter dishes, salt shakers, pepper shakers, chef's hats, barbecue aprons, insulated beverage containers, coolers, camping articles and equipment, namely, tents, tarpaulins for tents, pegs, yard accessories, namely, outdoor cooking accessories, barbecue grills, briquettes, fire starters, barbecue utensils, outdoor lighting systems, swings, seat

swings, slides, modular play structures, diving boards, accessories for outdoor and indoor fireplaces and for wood stoves and barbecues, lawn mowers, hedge trimmers; advertising articles, namely, agendas, calendars, paper napkins, paper place mats, paper plates, coasters, nicknacks, paper cups, paper tumblers, paper hats, cigarette lighters, matches, boxes of matches, colouring books, pens, pencils, ashtrays, markers, chalk, decals, artists' oil paints, artists' watercolours, artists' acrylic paints, coloured pencils, place mats for restaurants, badges, licence plate holders, licence plates, pennants, posters, signs, buttons, flags, note pads, bumper stickers, stickers, trays for paper and correspondence, magnetized note holders, notice boards, crests, emblems, satchels, file folders, binders made of cardboard and vinyl, document holders, key holders, wallets, handbags, sports bags, tote bags, golf bags, shoulder bags, umbrellas, travel kits, attaché cases, press release folders, file folders for stationery, trophies, playing card cases, inflatable balls, golf balls, score cards, cribbage boards, dart cabinets, dart sets, dartboards, keychains, letter openers, watches, pins, business card cases, gadget boxes, pencil holders, pen and pencil sets, telephones, flashlights, tape measures, rulers, paperweights, bookmarks, plaques, cards, medals, medallions, posters, banners, road maps, post cards, platters, clocks, cheese boards, can openers, balloons, bottle openers, book covers, letter paper, envelopes, greeting cards, clipboards, money holders, gift wrapping materials, guest books, pencil cases, pencil sharpeners, erasers, calculators, iron-on badges, school bags, canvas bags, water bottles, key labels, advertising umbrellas, statuettes, coin banks, bottles, fans, combs, candles, small candles, paper bags, vinyl bags, mirrors, fancy hats, welcome mats, beer mugs, bar mats, coffee cups, glasses, decorative disposable cups, coin banks, advertising posters, door handle signs, banners, sunglasses, stir sticks, assorted metal boxes, gift coupons, bonus coupons, catalogues for bonuses and gifts, catalogues for products and services, boxes of coloured pencils; calculators, computers, printers, telephones, plotters, fax machines, typewriters, telephone answering machines, electric razors; sporting goods, namely, golf clubs, balls, golf balls, inflatable balls, beach balls, tennis balls, tennis racquets, tennis bags, skis, ski poles; sailboards, sailboats, bicycles; boats; products for plants, namely, fertilizer, seeds, leaf gloss, insecticides, fungicides, insect repellents; jewellery, namely, pendants, necklaces, bracelets, earrings, pins, clips, chain bracelets, rings, charms, brooches, cuff-links, chains, small chains, medals, medallions, tie pins, jewellery cases, jewellery chests; products for automobiles, namely, tar and insect remover gel, car polish, vinyl and leather cleaner, carwash soap, chrome cleaner, rustproofing lubricant with silicone, silicone, engine shampoo, auto carpet shampoo, tires, seat covers, car mats, trim and decorative strips.

3. Snow removal service; machinery rental service, tree extractor, uni-loader, loader and trucks for snow removal, landscaping, excavation and transport of all bulk products; landscape design service; service for the preparation of rock gardens, assembly of pergolas and patios of treated wood; ground leveling service; sod installation service; excavation and landscaping service, driveways; service for the installation of paving bricks and retaining walls; service for the installation of decorative stone, construction of pools and waterfalls; service for the preparation of plans and models and improvement and installation of complete landscaping; service for the seeding, fertilization and treatment of lawns, trees, shrubs, hedges; pruning service for trees and hedges and lawn mowing; nursery and horticulture service;

hardware store, garden and horticulture centre, nursery; service for the rental of tools for the home and garden; information and advisory centre relating to horticulture and landscaping.

4. Information, promotion, demonstration, sales, advertising booths in public places, shopping centres, fairs, bazaars, flea markets, and expositions of all products and services of third parties; service for the sale, advertising and home delivery of all products and services; service for the assistance, promotion and sale of real property, of publications, of advertisements in newspapers, on television, on billboards, on noticeboards, on signs posted in front of houses, for third parties wishing to purchase or sell their properties themselves; do-it-yourself stores, stores for renting tools for the home and garden, garden centres, gift shops, dry cleaning outlets, stores selling furniture for the home, patio and office, stores selling swimming pools and accessories for the patio and outdoor cooking; restaurant-bistros and bakery-café; general store for the family and the home; food store, home food service; wholesale and retail store, home service, telephone service, catalogue service and mail service for quick-frozen and frozen products; wholesale and retail store, home service, telephone service, catalogue service and mail service for culinary and gourmet specialties; tanning salon; mortgage brokerage, insurance brokerage, real estate brokerage, business brokerage and financial brokerage; service for referrals, help desk, on-line information using the television or other video apparatus allowing customers to receive the information requested directly on their television or other receiver in their home; shopping centres comprising stores and services; service for the surveillance of properties, homes, businesses, offices and factories belonging to third parties; service for walking animals, plant care, cleaning and housekeeping for residential and commercial premises, painting and hanging of wallpaper and wall coverings, installation of carpets and wall-to-wall carpeting, cleaning carpets, floors and vertical and horizontal blinds, sanding floors, washing walls, ceilings, windows, glass and cabinets, cleaning of upholstered furniture, installation of drapes, vertical and horizontal blinds, furniture stripping and upholstering service; moving service; placement service for domestic staff, housekeeping staff, mother's helpers, child care workers and caregivers; child care service; income tax return, accounting and bookkeeping service; secretarial, telephone answering, domiciliation and mail forwarding service for third parties; home decorating service; operation of a products and services purchasing club for third parties; referral and directory service for businesses, stores, products and services for third parties; service for surveys, information, marketing, courses, counselling, education, training, consulting, market studies, referrals, intelligence, promotion, development, soliciting, prospecting, direct marketing, by telephone, on-line, audio and video cassettes, radio and television, door-to-door, mail, newspapers, advertising, coupons, fax, signs, printed matter, catalogues, brochures, meetings, seminars, conferences on all products and services of third parties; development and administration of promotional programs on behalf of third parties with or without the provision of products, objects or services as gifts to stimulate sales of products and services of third parties; distribution of promotional samples by mail, delivery or distribution at point-of-sale for third parties, delivery and shipping on behalf of third parties of advertising materials in addressed or unaddressed envelopes, singly or in bulk; shipping of advertising gift coupons; samples, catalogues and other promotional or sales material on behalf of third parties;

service for the production and broadcast of radio and television programs, of audio and video cassettes for third parties; courses, seminars, conferences to introduce, educate, instruct, advise third parties relating to all products and services; service for the fitting up, maintenance, management and administration of office buildings, shopping centres, residential buildings, condominiums, and commercial and industrial buildings; service for the purchase, sale, trade, lease, consultation, investment relating to real estate; fitting up buildings, training and consulting service related to the marketing of real estate; establishing and brokering franchise operations, directing market studies for locating franchises, negotiating leases for franchised businesses, design, construction, fitting up, decoration of retail outlets; consulting service relating to franchises; negotiation and preparation of franchises and related agreements; service relating to the formation of networks of independent distributors for the sale, promotion of all products and services of third parties; sale, promotion and distribution at wholesale and retail of all products and services of third parties; real estate brokerage service; organizing fairs and expositions; real estate appraisal service; interior decorating service, building construction contractor, landscaping service, advertising agency, travel agency, operation of stores selling hardware, building materials and decorating products; laminating and framing service; training service relating to the operation of franchised businesses through conferences, seminars, courses and workshops; maintenance and supervision of franchises and support services relating to the operation of franchised businesses; service for the organization, administration, management, training, sales, sponsorship of a network of distributors, be they independent or not, of all products and services, and payment of discounts, bonuses, royalties and fees to such network; institute and school for training, education and apprenticeship; centre for technical and professional support, training and assistance for businesses; stores selling clothing for men, women and children; game and toy stores; book, music and video stores; development of sales and marketing plans and programs and of exclusive financial programs for third parties; development of sales and marketing plans and programs and of exclusive financial programs for networks of independent distributors. Amended application for registration is based on use of the mark since November 24, 1998, for the products and services specified in paragraphs (1) and (3) and on a proposed use for the products and services specified in paragraphs (2) and (4).

The grounds for opposition can be summarized as follows:

the applicant is not the person entitled to registration, having regard to sections 38(1)(c), 16(1)(b) and 16(3)(b) of the *Trade-Marks Act* (Act), because as of the date of filing of the applicant's application for registration, the trade-mark was confusing with the opponent's trade-mark, BONZI, for which an application for registration had been filed prior to the date of this application; and the date of first use stated in the applicant's application for certain services and wares, namely

November 24, 1988, was subsequent to the date of filing of the opponent's application for registration.

On July 2, 1998, the applicant filed a counter statement essentially denying the opponent's grounds of opposition.

On February 2, 1999, the opponent filed the affidavit of Herbert McPhail as evidence, and on September 3, 1999, the applicant filed the affidavit of Raymond Junior Courtemanche. Neither of the deponents has been cross-examined.

The opponent was the only party to file written representations and there was no hearing.

The relevant date for analyzing the ground of opposition based on section 16(1)(b) of the Act is the date of first use stated in the application for registration, namely November 24, 1988, while the relevant date for the ground based on section 16(3)(b) is the date of filing of the application for registration, namely March 6, 1996, as set out in these sections. The application for registration of the trade-mark BONZI, in association with plant growth regulators, bearing Number 615,472 (opponent's application) on which the opponent relies, was filed prior to those two dates, namely on September 24, 1988.

The burden of proof in opposition proceedings can be briefly summarized as follows: the opponent must adduce sufficient evidence regarding the grounds of opposition on which it relies to show that it is apparent there are facts to support the grounds of opposition. Once that is done, the burden of proof shifts to the applicant who must satisfy the Registrar that the grounds of opposition should not prevent the registration of his trade-mark (*Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325).

Mr. McPhail has been working for Fetherstonhaugh & Co. for thirty years and does research for the firm. He filed as Exhibit A to his affidavit a computerized statement containing relevant information about the opponent's application 615,472. The document confirms that the opponent's application for registration of the trade-mark BONZI was filed on February 20, 1998, that it covers plant growth regulators and is based on a projected use. Lastly, the

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document proves that this application for registration was pending at the time of the applicant's advertisement in the Trade-Mark Journal, and therefore the provisions of subsection 16(4) of the Act are of no assistance to the applicant. None of this evidence has been contradicted by the applicant.

Since the opponent has discharged its initial burden of proof on the evidence, an analysis of the applicant's evidence is required.

Mr. Courtemanche states in his affidavit that he began working in horticulture in 1985 and has been using the trade-mark BONZAI since 1987. As Exhibit 1, he provided photocopies of his advertisements from 1985 to 1989 inclusive. As Exhibit 2, he provided a copy of the registration of his company, PAYSAGISTE BONZAI ENR. [BONZAI LANDSCAPING], dated November 2, 1988, in the applicant's name. The applicant states in that document that he has carried on a landscaping and snow removal business under that company name since November 1, 1988. The unaudited financial statements of PAYSAGISTE BONZAI ENR. were provided as Exhibit 3 to the affidavit of Mr. Courtemanche.

Exhibit 4 to the applicant's affidavit contains a bundle of advertisements. For purposes of this decision, it is important to describe each of the documents and to point out the anomalies. The book entitled LE PETIT JARDINIER contains two relevant advertisements on the cover pages with the trade-mark as illustrated above, to which has been added the word "*pépinière*" [nursery] above BONZAI and the word "*paysagiste*" [landscaping] below the trade-mark. A double-sided flyer was also part of Exhibit 4. One side of this flyer contains an advertisement with the trade-mark BONZAI and design as well as the word "*pépinière*" [nursery] above BONZAI and the word "*paysagiste*" [landscaping] below BONZAI.

Can we therefore conclude that we are not dealing with a representation of the mark BONZAI but of PÉPINIÈRE BONZAI PAYSAGISTE [BONZAI NURSERY AND LANDSCAPING] in both of these cases? It is not necessary for me to answer this question for the following reasons. There is no information in Mr. Courtemanche's affidavit as to the

date of publication or the methods of distribution of these documents, although inside the book there is the notation “© *Tous droits réservés 1994*” [All rights reserved 1994].

Exhibit 4 also contains an advertising flyer with the trade-mark BONZAI describing the following services: paving, landscaping, garden centre and florist. There is no evidence as to the time period during which the applicant allegedly distributed this flyer.

A sample of a sticker and a business card on which the trade-mark BONZAI and design is illustrated is also part of Exhibit 4. There is no evidence as to the date they were first used or how they were distributed.

A sample of an advertising card entitled “*carte pub extra*” [advertising card extra] was provided and contains an advertisement with the trade-mark BONZAI and design but with the word “*fleuriste*” [florist] above BONZAI. Are we dealing with the use of the trade-mark BONZAI and design or of FLEURISTE BONZAI and design [BONZAI FLORIST]? For purposes of this decision, this question need not be answered for the following reasons. There is also no evidence as to the time period or the method of distribution of this advertisement.

Exhibit 4 also contains a double-sided advertising flyer on which appears the trade-mark BONZAI and design on both sides but also the words “*pépinière*” [nursery] and “*paysagiste*” [landscaping] above BONZAI on one side and the words “*entretien paysager*” [landscape maintenance] above BONZAI on the other side. Are we dealing with the use of the trade-mark BONZAI and design or of PÉPINIÈRE PAYSAGISTE BONZAI [BONZAI NURSERY AND LANDSCAPING] and design and ENTRETIEN PAYSAGER BONZAI [BONZAI LANDSCAPE MAINTENANCE]? I also need not answer this question in this opposition proceeding for the following reasons. There is again no evidence as to the time period or the method of distribution of this advertisement.

A sample of the brochure *Pub Extra* [Advertising Extra] dated July 5, 1998, and April 1999 were also provided. Each contains an advertisement with the trade-mark BONZAI and design. The one from July 1998 contains the words “*concept horticole*” [horticultural design concept] above BONZAI and describes the following services: florist, garden centre and

landscaping. In the April 1999 advertisement, the word “*paysagiste*” [landscaping] appears above BONZAI and lists the following services: paving, construction of retaining walls, installation of interlock, landscaping, garden centre and florist. There is no evidence as to the distribution of these brochures.

Lastly, Exhibit 4 contains page 13 of the May 29, 1998, edition of the Laval weekly in which the trade-mark BONZAI and design appears. The words “*centre jardin*” [garden centre], “*fleuriste*” [florist] and “*paysagiste*” [landscaping] appear above BONZAI. There is no evidence as to the distribution of this publication.

Mr. Courtemanche alleges that he spent \$37,000 in 1998 and \$22,000 in 1999 on advertising, but he does not state that the advertising was for services or wares bearing the trade-mark BONZAI and design. Lastly, he states that his sales were in the order of \$890,000 in 1998 and \$645,000 in 1999. He does not state whether they were sales of services associated with the trade-mark BONZAI and design, and if so, which ones, or whether the sales figures were for wares bearing the trade-mark BONZAI and design, and if so, which ones, or whether the services or sale of wares were in association with one or other trade-marks.

A trade-mark is considered to be used within the meaning of sections 2 and 4 of the Act if, at the time of the transfer of the property in the wares, the trade-mark appears on the wares themselves or on their packaging. There is no proof in the file of use of the trade-mark BONZAI and design within the meaning of the Act in association with the wares specified in paragraph 1 of the above-noted list of wares.

I must also conclude that there is no relevant evidence concerning the use of the applicant’s trade-mark in association with services, for the reasons stated by Mr. Justice Wetston in *Cornerstone Securities Canada Inc. v. Smart & Biggar* (1994), 58 C.P.R. (3d) 417. At page 420, he stated the following regarding evidence of use of the trade-mark in association with services:

5. The appellant has made a considerable effort towards demonstrating use of the trade mark in the normal course of business. However, it is the

opinion of the court that the evidence falls short of establishing use within the meaning of s. 4(2) of the Act. While Mr. Fields deposes that advertisements were forwarded by facsimile to corporations and individuals who placed advertisements in the Globe and Mail to attract venture capital, the evidence does not satisfy the court that the advertisements were actually distributed to prospective customers. Moreover, even if distributed, there is no evidence that the appellant provided any services at the relevant time. These deficiencies must be viewed in light of the fact that Mr. Fields claimed that the trade mark was advertised in the Globe and Mail and numerous other newspapers. While there was some evidence that an outside firm created the advertisements, there is no evidence that the ads were used or even when they were prepared for the appellant. There is no evidence that the advertisements were distributed to anyone, e.g., ex. D-3 to affidavit of June 8, 1994, nor is there any evidence confirming the alleged advertisements. Nor were any individuals identified as to whom the advertisements were sent.

The applicant must demonstrate that his trade-mark is not likely to cause confusion with the opponent's trade-mark that is the subject of an application for registration filed prior to the applicant's application. The date of the application for registration of the opponent is to his advantage regardless of whether the grounds of opposition are analyzed under subsection 16(1)(b) or 16(3)(b) of the Act. The issue of confusion must now be analyzed in accordance with the approach outlined in section 6 of the Act which reads:

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

(2) The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the 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.

(3) The use of a trade-mark causes confusion with a trade-name if the use of both the trade-mark and trade-name in the same area would be likely to lead to the inference that the wares or services associated with the trade-mark and those associated with the business carried on under the trade-name are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

(4) The use of a trade-name causes confusion with a trade-mark if the use of both the trade-name and trade-mark in the same area would be likely to lead to the inference that the wares or services associated with the business carried on under the trade-name and those associated with the trade-mark are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

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

(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 the trade-marks or trade-names have been in use;	
(c)	the nature of the wares, services or business;	
(d)	the nature of the trade;	
(e)	the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them.	

The Registrar must bear in mind that the onus lies with the applicant, who must establish that there is no reasonable possibility of confusion within the meaning of section 2 of the Act between the parties' trade-marks at the relevant dates for purposes of this decision.

The criterion of distinctiveness of the trade-marks in this case does not favour either party. In fact, the opponent states in its written submissions that the trade-mark originated from the Japanese word "bonsai", which refers to the art of artificially cultivating dwarf trees and shrubs, but does not adduce any evidence on this point.

As I stated above, either the applicant has not submitted any evidence or there are significant gaps in the evidence regarding the use of the trade-mark BONZAI and design in association

with the wares and services specified in the application for registration. The application by the opponent is based on a proposed use. Therefore, the criterion of the length of time the trade-marks have been in use does not favour either party.

The statement of opposition of the opponent is written in general terms and does not specify the wares or services that it is opposing. However, it must be noted that the opponent's written submissions refer only to the following wares and services specified in the applicant's application for registration:

chicken manure, sheep manure, cattle manure, shrimp compost, crab compost, fertilizing products, chemical fertilizers and organic fertilizers in bulk or by the bag, insecticides, pesticides, roudenticides in liquid and powder form, legumes, garden vegetables, herbs, and landscape design service, service for the preparation of plans and models and improvement and installation of complete landscaping, service for the seeding, fertilization and treatment of lawns, trees, shrubs and hedges, nursery and horticulture service, garden and horticulture centre, and nursery, and information and advisory services relating to horticulture and landscaping.

The nature of the wares described in the opponent's application and the nature of some of the services and wares described in the applicant's application for registration overlap with respect to horticultural and agricultural products and services.

There was no evidence submitted by the opponent concerning the nature of the trade. Accordingly, that factor does not favour either party.

With respect to the degree of resemblance between the marks at issue, I have concluded that the applicant's trade-mark BONZAI and design and the trade-mark BONZI, which is the subject of the opponent's application, contain obvious similarities in sound.

Under the circumstances, I have concluded that the applicant has not discharged his onus to demonstrate that his trade-mark is not likely to cause confusion with the trade-mark BONZI, which is the subject of the application by the opponent and which covers the following wares and services:

chicken manure, sheep manure, cattle manure, shrimp compost, crab compost, fertilizing products, chemical fertilizers and organic fertilizers in bulk or by the bag, insecticides, pesticides, roudenticides in liquid and powder form, legumes, garden vegetables, herbs, and landscape design service, service for the preparation of plans and models and improvement and installation of complete landscaping, service for the seeding, fertilization and treatment of lawns, trees, shrubs and hedges, nursery and horticulture service, garden and horticulture centre, and nursery, and information and advisory services relating to horticulture and landscaping.

Therefore, the grounds of opposition based on subsections 16(1)(b) and 16(3)(b) of the Act are allowed, and in accordance with the powers delegated to me by the Registrar of Trade-Marks under subsection 63(3) and applying the principles set out in *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich SCH* 10 C.P.R. (3d) 482, I am rejecting the applicant's application for registration with respect to the following wares and services:

chicken manure, sheep manure, cattle manure, shrimp compost, crab compost, fertilizing products, chemical fertilizers and organic fertilizers in bulk or by the bag, insecticides, pesticides, roudenticides in liquid and powder form, legumes, garden vegetables, herbs, and landscape design service, service for the preparation of plans and models and improvement and installation of complete landscaping, service for the seeding, fertilization and treatment of lawns, trees, shrubs and hedges, nursery and horticulture service, garden and horticulture centre, and nursery, and information and advisory services relating to horticulture and landscaping.

All of the above is in accordance with subsection 38(8) of the Act.

DATED AT MONTRÉAL, QUEBEC, THIS 4th DAY OF JULY 2003.

Jean Carrière
Member, Trade-Marks Opposition Board