



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

Citation: 2016 TMOB 115
Date of Decision: 2016-07-15

IN THE MATTER OF AN OPPOSITION

**The Kitchener and
Waterloo Community Foundation**

Opponent

and

**The Random Acts
of Kindness Foundation
a Colorado nonprofit corporation**

Applicant

**1,503,387 for THE RANDOM
ACTS OF KINDNESS FOUNDATION**

Application

[1] The Kitchener and Waterloo Community Foundation opposes registration of the trade-mark THE RANDOM ACTS OF KINDNESS FOUNDATION (the Mark) that is the subject of application No. 1,503,387 by The Random Acts of Kindness Foundation a Colorado nonprofit corporation.

[2] Filed on November 10, 2010, with a priority filing date of May 14, 2010, the application is based on proposed use of the Mark in Canada in association with goods described as “video recordings featuring content related to doing good deeds for others”. The application is also based on use and registration in the United States, as well as proposed use of the Mark in Canada, in association with services described as “computer services, namely, creating an on-line community for users to participate in discussions about doing good deeds for others, to offer

suggestions about doing good deeds for others, and to engage in social networking relating to doing good deeds for others”.

[3] The Opponent alleges that (i) the application does not conform to the requirement set out in section 30(i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), (ii) the Mark is not registrable under section 12(1)(d) of the Act, (iii) the Applicant is not the person entitled to the registration of the Mark under section 16 of the Act, and (iv) the Mark is not distinctive under section 2 of the Act. The grounds of opposition revolve around the likelihood of confusion between the Mark and the Opponent’s trade-mark RANDOM ACT OF KINDNESS DAY Design.

[4] For the reasons that follow, I reject the opposition.

The Record

[5] The Opponent filed its statement of opposition on December 19, 2014. The Applicant filed and served its counter statement on February 6, 2015, denying all of the grounds of opposition.

[6] In support of its opposition, the Opponent filed the affidavit of Rosemary Smith, Chief Executive Officer of the Opponent. Ms. Smith was not cross-examined on her affidavit. The Applicant did not to file any evidence in the present proceeding.

[7] Both parties filed a written argument; neither party requested a hearing.

The Parties’ Respective Burden or Onus

[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 Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Did the Application Conform to the Requirements of Section 30(i) of the Act?

[9] The Opponent pleads that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the applied for goods and services, contrary to section 30(i) of the Act, as it was confusing with the Opponent's trade-mark RANDOM ACT OF KINDNESS DAY Design.

[10] The material date for assessing a section 30 ground is the filing date of the application, namely November 10, 2010 [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475].

[11] Section 30(i) of the Act requires an applicant to declare in the application that it is satisfied that it is entitled to use the trade-mark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant's statement untrue [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. There is no such evidence in the present proceeding.

[12] Consequently, I dismiss the section 30(i) ground of opposition for the Opponent's failure to meet its initial evidential burden.

Is the Mark Confusing with the Opponent's Registered Trade-mark?

[13] The Opponent pleads that the Mark is not registrable pursuant to section 12(1)(d) of the Act on the ground that it is confusing with the Opponent's trade-mark RANDOM ACT OF KINDNESS DAY Design of registration No. TMA767,547. The Opponent's trade-mark, shown below, is registered for use in association with the following:

Random Act Of Kindness Day

Goods: (1) Paper goods and printed matter, namely, letterhead, envelopes, newsletters, invitations, labels and notepads; publications, namely, brochures and printed articles; clothing and accessories, namely, shirts, aprons, scarves, hats and mitts; writing instruments, namely, pens, pencils and highlighters.

Services: (1) Communication services, namely, electronic transmission of newsletters, event updates and the operation of an interactive website for community services and

promotion and funding activities, namely community services in the fields of fundraising and charitable acts and educational services in the fields of community service, fundraising, and anti-bullying.

[14] The material date for considering this issue is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[15] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if the registration(s) relied upon is(are) in good standing. In this regard, the Registrar has the discretion to check the register in order to confirm the existence of the registration(s) relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Having exercised the Registrar's discretion, I confirm that registration No. TMA767,547 is in good standing.

[16] Since the Opponent has satisfied its initial evidential burden, the issue becomes whether the Applicant has met its legal burden to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's registered trade-mark.

[17] For the reasons that follow, I reject this ground of opposition.

[18] 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 goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[19] 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-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [see *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 (CanLII), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al*, 2006 SCC 623(CanLII), 49 CPR (4th)

401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc et al*, 2011 SCC 27 (CanLII), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion].

[20] I will now turn to the assessment of the section 6(5) factors.

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

[21] The overall consideration of the section 6(5)(a) factor involves a combination of inherent and acquired distinctiveness of the parties' trade-marks.

[22] I assess both parties' trade-marks to have a similar degree of inherent distinctiveness in that they are inherently weak as both are descriptive of their respective goods and/or services. In this regard, when viewed in the context of the goods and services in question, the most pertinent definitions found in *Merriam-Webster* of the terms of the marks are:

- for the word "random": "chosen, done, etc., without a particular plan or pattern";
- for the word "act": "something that is done";
- for the word "kindness": "the quality or state of being kind" and "a kind act";
- for the word "foundation": "an organization that is created and supported with money that people give in order to do something that helps society"; and
- for the word "day": "a specified day or date".

[23] As such, the trade-mark RANDOM ACT OF KINDNESS DAY Design describes that the Opponent's newsletters, event updates, its website, and its promotion and funding activities pertain to community services in the form of a day dedicated to the idea of kind acts performed without a particular plan or pattern, or to put it succinctly, a day dedicated to random acts of kindness. I further note that I do not consider the small design element that replaces the letter "I" in the Opponent's trade-mark to be particularly striking when the trade-mark is considered in its entirety. Similarly, THE RANDOM ACTS OF KINDNESS FOUNDATION describes that the Applicant's videos and on-line community pertain to a foundation based on the idea of doing good deeds for others in the form of kind acts performed without a particular plan or pattern, or to put it succinctly, in the form of random acts of kindness.

[24] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. I will review of the Opponent's evidence with respect to the use and promotion of its trade-mark. As mentioned above, the Applicant did not file any evidence of use of the Mark.

Extent to which the Opponent's Trade-mark has Become Known

[25] According to Ms. Smith, the Opponent is a charitable organization focused on community development and improvement. Formed in Ontario in May 1984, Ms. Smith explains the Opponent's mission as follows: "to improve quality of life in communities by building community endowment, addressing needs through grant making and providing leadership on key community issues". Attached as Exhibit B to Ms. Smith's affidavit are printouts from the Opponent's website. In particular, I note that in the printouts entitled "About Us – KWCF", the Opponent calls itself as "a charity for charities" in that even though it doesn't provide charitable services, it "do[es] help community organizations make a difference by providing them with funds for new programs, capital needs, students awards and much more", by investing donations and gifts into a permanent endowment fund which in turn "generates income that is then distributed through grants to support a wide range of charitable causes" within the Kitchener-Waterloo area.

[26] In her affidavit, Ms. Smith states that the trade-mark RANDOM ACT OF KINDNESS DAY Design has been used by the Opponent and its licenses across Canada in association with the promotion of local philanthropy through the coordination and promotion of acts of kindness since 2008. Attached as Exhibits D and E is a list of licensed foundations or organizations that have used the Opponent's trade-mark RANDOM ACT OF KINDNESS DAY Design in various communities between 2008 and 2015, including Kitchener-Waterloo, Windsor, Niagara, Banff, Saskatoon, Okanagan, SE and SW Alberta, and Fredericton. Attached as Exhibit F are sample invoices sent by the Opponent to licensees between 2010 and 2015 for items identified as "Random Act of Kindness Day – Participation Fee", "Random Act of Kindness Day Licensing" and "RAK Day Licensing Fee". Example of acts of kindness reported by the Opponent's licensee "The Community Foundation of Lethbridge and Southwestern Alberta" attached as Exhibit G include doing charitable acts and good deeds for others.

[27] In terms of promotion, Ms. Smith states that since 2008, the trade-mark RANDOM ACT OF KINDNESS DAY Design has appeared in all of the Opponent's advertising materials for the registered goods and services. In particular, Ms. Smith attests that the trade-mark has been displayed through a variety of print, signage, online, video, news and media advertising. According to Ms. Smith, the Opponent's funds attributed to marketing the trade-mark RANDOM ACT OF KINDNESS DAY Design varied between \$25,000 in 2008 and \$83,000 in 2009, totaling more than \$380,000 between 2008 and 2014.

[28] In terms of the manner in which RANDOM ACT OF KINDNESS DAY Design appeared in advertisements and marketing materials, I note the following exhibits attached to Ms. Smith's affidavit:

- Exhibits I and J – sample copies of advertisements that have appeared in the daily newspaper *Waterloo Region Record* for the Kitchener, Waterloo and Cambridge regions between 2008 and 2014, with annual average circulation numbers in the sixty thousands for 2010, 2011 and 2012. While the Opponent's trade-mark RANDOM ACT OF KINDNESS DAY Design is shown prominently in the sample ads, there is no information on how long they would have run for or how frequently they would have appeared in the newspaper each year to mark the day;
- Exhibits K to O – sample ads featuring the Opponent's trade-mark in *Kitchener Citizen* in 2011 (a monthly community newspaper delivered to 62,000 homes in Kitchener), in the Greater Kitchener Waterloo Chamber of Commerce's bi-monthly publication called *Advocate* for 2010, 2011 and 2014 (with a membership of approximately 1,800), in a publication called *Exchange* circulated in Ontario with top 5 reader concentration areas in Waterloo, Kitchener, Cambridge, Guelph and Toronto in 2011 (with approximately 67,000 readers), in a 2011 calendar for the Rohr Chabad Centre for Jewish Life in the Waterloo region (no circulation number), and in the October and November 2014 issues of *Snapd*, a regional publication in Kitchener and Waterloo (no circulation number);

- Exhibits P to S – sample posters and signage featuring the Opponent’s trade-mark used by the Opponent and its licensees from 2008 to 2014 in various communities in Ontario, Saskatchewan and Alberta;
- Exhibit T – sample educational materials featuring the Opponent’s trade-mark provided to approximately 120 grade schools in Kitchener and Waterloo in 2012 and 2013;
- Exhibits U to AA – sample emails and online marketing, as well as social media and social networking presence, featuring the Opponent’s trade-mark from 2009 to 2015 including printouts from the Opponent’s website located at *www.kwcf.ca/kindness* as well as those of its licensees;
- Exhibits BB to HH – presentation materials, appearances on television, videos found in the Opponent’s YouTube channel and its website between 2008 and 2014 in which the Opponent’s trade-mark was shown. Most of the materials appear to be focused on the Opponent, located in the areas of Kitchener and Waterloo; and
- Exhibits II to MM – sample t-shirts, cards, certificates, activity and information materials, as well as cookies, bookmarks, stickers, pins, and other promotional items, featuring the Opponent’s trade-mark, distributed to participants and volunteers in Kitchener and other parts in Canada between 2009 and 2014. The exhibits also include sample invoices sent to licensees in Ontario for t-shirts bearing the Opponent’s trade-mark sold in 2012 and 2013.

[29] When I consider Ms. Smith’s affidavit in its entirety, I am satisfied that the Opponent has used and displayed the trade-mark RANDOM ACT OF KINDNESS DAY Design in the performance and/or advertising of newsletters, event updates, the operation of a website for community services, and promotion and funding activities in the field of community services, in the Kitchener and Waterloo areas of Ontario since 2008.

[30] While there is some evidence, albeit to a much lesser extent, that the Opponent’s trade-mark has also been advertised and displayed by its licensees in association with various

community services in several areas outside of Kitchener and Waterloo over the years, in the absence of any indicia of the requisite control under section 50 of the Act, I am unable to infer that the use of the Opponent's trade-mark by any of its licensees outside of Kitchener and Waterloo areas enures to the benefit of the Opponent. I would add that even if I were wrong, it would not alter the outcome of my overall confusion analysis.

[31] In the end, while I find both parties' trade-marks to be inherently weak, I am satisfied that the Opponent's trade-mark RANDOM ACT OF KINDNESS DAY Design has become well known through use and promotion for an extended period of time in the Kitchener and Waterloo areas of Ontario in association with newsletters, event updates, the operation of a website, as well as promotion and funding activities, pertaining to community services in the form of a day dedicated to the idea of random acts of kindness.

[32] Accordingly, the section 6(5)(a) factor favours the Opponent, but only to the extent that it involves the acquired distinctiveness of the parties' marks in the Kitchener and Waterloo areas of Ontario.

Section 6(5)(b) - the length of time the trade-marks have been in use

[33] The application for the Mark is based on proposed use in Canada and as discussed previously, there is no evidence that it has been used in Canada to date.

[34] In comparison, as discussed previously, the Opponent has shown use and promotion of its trade-mark for an extended period of time in the Kitchener and Waterloo areas of Ontario in association with newsletters, event updates, the operation of a website, as well as promotion and funding activities, pertaining to community services.

[35] In view of the foregoing, the section 6(5)(b) factor favours the Opponent.

Sections 6(5)(c) and (d) - the nature of the goods, services, trade and business

[36] Sections 6(5)(c) and (d) factors involve the nature of the goods, services, trade and business.

[37] When considering sections 6(5)(c) and (d) of the Act, it is the statements of goods and services as defined in the application for the Mark and in the Opponent's registration No. TMA767,547 that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. The statements of goods and/or services must be read with a view to determine the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[38] The Opponent's trade-mark RANDOM ACT OF KINDNESS DAY Design is registered for use in association with a variety of stationery, writing instruments, printed matters, clothing and accessories, as well as newsletters, event updates, the operation of a website, and promotion and funding activities, pertaining to community services in the form of fundraising, charitable acts and educational services in the fields of community service, fundraising and anti-bullying. As per my review of Ms. Smith's affidavit, the Opponent's trade-mark has been used and promoted for an extended period of time in the Kitchener and Waterloo areas of Ontario in association with newsletters, event updates, the operation of a website, as well as promotion and funding activities, pertaining to community services in the form of a day dedicated to random acts of kindness since 2008.

[39] In comparison, the Mark is applied for use in association with computer services in the form of an online community related to doing good deeds for others, as well as video recordings related thereto.

[40] There is clear overlap between the Applicant's goods and services and the Opponent's services as they both pertain to communication services related to charitable acts. In addition, neither of the Opponent's registration nor the subject application contains any restriction on the parties' channels of trade. Given that the parties' goods and services clearly overlap and in view

of the Opponent's physical and online presence, for the purpose of assessing confusion, I conclude that there is potential for overlap between the parties' channels of trade.

[41] Accordingly, these two factors favour the Opponent.

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

[42] In *Masterpiece Inc v Alavida Lifestyles Inc et al [supra]*, the Supreme Court of Canada indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the parties' trade-marks [see also *Beverley Bedding & Upholstery Co v Regal Bedding & Upholstering Ltd* (1980), 47 CPR (2d) 145 (FC), at 149, affirmed (1982), 60 CPR (2d) 70 (FCA)].

[43] When considering the degree of resemblance, the law is clear that the trade-marks must be considered in their totality. It is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trade-marks. It is nevertheless possible to focus on particular features of a mark that may have a determinative influence on the public's perception of it [see *United Artists Corp v Pink Panther Beauty Corp* (1998), 80 CPR (3d) 247 at 263 (FCA)].

[44] There are both similarities and differences between the parties' marks. In this regard, both marks contain the expression "random act(s) of kindness" which suggests that the associated activities encourage others to perform unplanned acts of compassion and kindness. However, the parties' marks differ in that the Mark refers to a "foundation" dedicated to random acts of kindness while the Opponent's trade-mark refers to a "day" dedicated to random acts of kindness. There is also a design component to the Opponent's mark that is visually different from the Mark in that the letter "I" in the Opponent's trade-mark is replaced by a depiction of a stick human figure.

[45] In the end, in view of the descriptive nature of the marks when considered in their entirety, the degree of resemblance between the marks is diminished by the fact that the only similarity between them lies in the expression "random act(s) of kindness".

Conclusion regarding the likelihood of confusion

[46] In *Man and His Home Ltd v Mansoor Electronic Ltd* (1999), 87 CPR (3d) 218 (FCTD), the Court states the following regarding marks that have little inherent distinctiveness:

It is well established that trade-marks containing words which are suggestive of the wares or services offered by the owner are considered to be weak marks and consequently, are afforded a minimal level of protection. In such cases, even a small difference between the marks will be sufficient to diminish the likelihood of confusion. Furthermore, where a person adopts a word in common use and seeks to prevent competitors from doing the same, the trade-marks will have less inherent distinctiveness and the range of protection granted by the Court will be limited. Finally, where a party chooses to use a suggestive non-distinctive name, regardless of any acquired distinctiveness, it must accept a certain amount of confusion without sanction.

[47] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, despite the Opponent's trade-mark RANDOM ACT OF KINDNESS DAY Design being well known in the Kitchener and Waterloo areas of Ontario since 2008, the overlap in the nature of the parties' goods and/or services as well as the potential for overlap for their channels of trade, I am of the view that low inherent distinctiveness of the Opponent's trade-mark and the differences in the marks are significant enough to shift to balance of probabilities in favour of the Applicant.

[48] It is difficult to monopolize expressions such as "random act(s) of kindness" for services pertaining to the idea of random act(s) of kindness, which is effectively what the Opponent is arguing for that expression is the only similarity between the parties' trade-marks. Furthermore, the fact that there are overlaps and potential for overlap between the parties' goods and services related to "random act(s) of kindness" simply reinforces the principle that no one single trader can monopolize, and prevent competitors from using, words or expressions that describe their goods and services.

[49] In my view, the Opponent's trade-mark the sort of mark that has such low inherent distinctiveness that it can only be given a small ambit of protection considering that the Opponent elected to take terms that are common to the English language, with clear and apparent meaning to the average consumer, as its trade-mark. While the Opponent might have shown that its trade-mark is well known in the Kitchener and Waterloo areas of Ontario, the ambit of

protection for the Opponent's mark does not extend to the expression "random act of kindness" alone. This is a case where small differences are sufficient to distinguish a similar mark [see *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD), *Anamet Inc v Acklands Ltd* (1996), 67 CPR (3d) 478 (FCTD) and *Commercial Union Assurance Co plc v Canadian Co-Operative Credit Society Ltd* (1992), 42 CPR (3d) 239 (FC)].

[50] I therefore find that the marks are sufficiently different to make confusion unlikely. Consequently, the Applicant has discharged its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's mark.

[51] Accordingly, the ground of opposition based on section 12(1)(d) of the Act is dismissed.

Was the Applicant Entitled to Registration of the Mark under Sections 16(2)(a) and 16(3)(a) of the Act?

[52] The Opponent alleges that the Applicant is not the person entitled to registration of the Mark pursuant to sections 16(2)(a) and (3)(a) of the Act, on the ground that it is confusing with the Opponent's trade-mark RANDOM ACT OF KINDNESS DAY Design which has been previously used and continue to be used in Canada by the Opponent in association the goods and services set out in registration No. TMA767,547, the particulars of which have been set out under the section 12(1)(d) analysis.

[53] The material date for considering this ground of opposition is the priority filing date of the subject application, namely May 14, 2010 [see sections 16(2), 16(3) and 34 of the Act].

[54] The Opponent has the initial burden of proving that its trade-mark was used in Canada prior to the material date and had not been abandoned at the date of advertisement of the application for the Mark, namely August 20, 2014 [section 16(5) of the Act].

[55] As per my analysis under the section 12(1)(d) ground of opposition, I accept that the Opponent has shown use and promotion of its trade-mark for an extended period of time in the Kitchener and Waterloo areas of Ontario in association with newsletters, event updates, the operation of a website, as well as promotion and funding activities, pertaining to community services in the form of a day dedicated to random acts of kindness.

[56] Even though the material date for the section 16 grounds of opposition falls earlier than today's date, the different dates do not result in a different outcome.

[57] For the reasons set out with the section 12(1)(d) ground of opposition, I find that the marks are sufficiently different to make confusion unlikely. Consequently, the Applicant has discharged its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's trade-mark.

[58] Having regard to the foregoing, the grounds of opposition based on non-entitlement are dismissed.

Was the Mark Distinctive of the Applicant's Goods and Services at the Filing Date of the Statement of Opposition?

[59] The Opponent has pleaded that the Mark does not actually distinguish the Applicant's goods and services from those of the Opponent, in view of the provisions of section 2 of the Act.

[60] The material date to assess the ground of opposition is the filing date of the statement of opposition, namely December 19, 2014 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[61] In order to meet its initial burden under this ground, the Opponent must establish that as of the filing date of the statement of opposition, the Opponent's trade-mark had become known to such an extent that it could negate the distinctiveness of the Mark. In *Bojangles' International, LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC) at para 33, the Federal Court provided that a mark could negate another mark's distinctiveness if it was known to some extent in Canada or alternatively, if it is well known in a specific area of Canada.

[62] As per my review of Ms. Smith's affidavit under the section 12(1)(d) ground of opposition, I accept that the Opponent's mark has become well known in the Kitchener and Waterloo areas of Ontario, in view of its significant advertising and use for an extended period of time in association with various services pertaining to community services in the form of a day dedicated to random acts of kindness.

[63] Even though the material date for the section 2 ground of opposition falls earlier than today's date, the different dates do not result in a different outcome.

[64] For the reasons set out with the section 12(1)(d) ground of opposition, I find that the marks are sufficiently different to make confusion unlikely. Consequently, the Applicant has discharged its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's trade-mark.

[65] Having regard to the foregoing, the ground of opposition based on non-distinctiveness is dismissed.

Disposition

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

Pik-Ki Fung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No hearing held.

AGENTS OF RECORD

Norton Rose Fulbright Canada LLP/S.E.N.C.R.L., s.r.l. FOR THE OPPONENT

Fasken Martineau DuMoulin LLP FOR THE APPLICANT