



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

**Citation: 2015 TMOB 70**  
**Date of Decision: 2015-04-08**

**IN THE MATTER OF AN OPPOSITION  
by K-2 Corporation and K-2 Corporation  
of Canada to application No. 1,459,465 for  
the trade-mark PLANET EARTH OUR  
EXTRAORDINARY WORLD & Design in  
the name of The British Broadcasting  
Corporation**

Introduction

[1] This opposition relates to an application filed on November 17, 2009 by The British Broadcasting Corporation (the Applicant) to register the trade-mark PLANET EARTH OUR EXTRAORDINARY WORLD & Design reproduced below:



[2] The application has been amended on several occasions and, as of now, covers a long list of products and services listed in Annex A.

[3] The application is based on use in Canada since 2008 in association with Products 1; use in Canada since 2007 in association with Products 2; and on proposed use in Canada in

association with the Products 3 and the Services. Products 1, Products 2 and Products 3 as defined in Annex A are collectively referred to as the Products. The Services are also defined in Annex A.

[4] The application was advertised on January 5, 2011 in the *Trade-marks Journal*. K-2 Corporation and K-2 Corporation of Canada (collectively referred to as the Opponent) filed a statement of opposition on June 6, 2011 against this application which has been amended with the Registrar's permission.

[5] The grounds of opposition raised by the Opponent are based on sections 30(a), (b) and (i), 16(3)(a), 16(1)(a) and section 2 (distinctiveness) of the *Trade-Marks Act* RSC 1985 c. T-13 (the Act). The specific grounds of opposition are detailed in Annex B to this decision. The Applicant denied the grounds of opposition in a counter statement filed on October 13, 2011.

[6] The Opponent filed as its evidence the affidavits of Louis Boudreault and Anne-Marie Whittle as well as a certified copy of applications 1393454 and 1353494, both for the trade-mark PLANET EARTH. The Opponent's deponents were cross-examined and the transcripts are part of the record. The Applicant filed the affidavit of Peterson Eugenio.

[7] Both parties filed written arguments and only the Applicant was represented at the hearing.

[8] For the reasons detailed hereinafter, I conclude that the Opponent failed to meet its initial burden with respect to the grounds of opposition based on sections 30(a), (b) and (i) of the Act. I also conclude that the Applicant has met its legal burden to show that it is entitled to secure registration of the Mark and that the latter is distinctive.

#### Legal Onus and Burden of Proof

[9] The legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached in favour of the Applicant once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support

that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Joseph E Seagram & Sons Ltd et al v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA) and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FC)].

[10] I wish to point out that in reaching my decision I have considered all the evidence in the file but I will refer in my reasons for this decision only to the relevant portions of the evidence.

Ground of opposition based on section 30(a) of the Act

[11] As pointed out by the Applicant, on March 14, 2014 it amended its application to delete certain products including ‘belt bags’. In the same vein, on August 12, 2014 it filed a further revised application wherein it deleted and/or particularized most of the products referred to by the Opponent under this ground of opposition. In fact the Applicant deleted ‘journals’ and ‘drinking vessels’ from the list of Products and amended certain other products as follows:

- ‘scented wood’ to ‘cedar wood for use as a deodorizer’;
- ‘computer electronic and video games programs and equipment namely software, tapes, discs, joysticks, remote controls, and interactive floor mats’ to ‘computer, electronic and video games and equipment namely video game software, tapes, discs, joysticks, remote controls, and interactive floor mats’;
- ‘glue’ to ‘glue for arts and crafts, glue for stationery use’; and
- ‘towels’ to ‘bath towels’.

[12] I consider this ground of opposition moot with respect to the above-mentioned goods in view of the deletions and modifications made by the Applicant with respect to them.

[13] There remains ‘Entertainment services, namely... fun days’. I agree with the Applicant that the Opponent has taken the terms ‘entertainment services’ and ‘fun days’ out of context. I reproduce herein below the pertinent portion of the description of the Services:

Entertainment services, namely, organizing exhibitions, competitions, contests, games, quizzes, fun days, shows, road shows, stage events, theatrical performances, concerts, live performances, and audience participation events all pertaining to or featuring instruction, entertainment, and information relating to

television programs and films about the natural environment; motion picture films, television and radio programs featuring content relating to the natural environment

[14] I consider that the services identified as ‘entertainment services, namely fun days’ are described properly as they pertain to ‘instruction, entertainment, and information relating to television programs and films about the natural environment’.

[15] Consequently I dismiss this ground of opposition in its entirety.

Ground of opposition based on section 30(i) of the Act

[16] Section 30(i) of the Act only requires the Applicant to declare itself satisfied that it is entitled to use the Mark in Canada in association with the products and services described in the application. Such a statement is included in the present application. An opponent may rely on section 30(i) in specific cases such as where bad faith on the part of the applicant is alleged [see *Sapodilla Co Ltd v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)].

[17] The Opponent is relying on the allegation that, prior to the filing of the application, the parties participated in discussions about the terms of a license agreement recognizing the prior rights of the Opponent in its PLANET EARTH trade-mark. To support this allegation the Opponent relies on certain portions of Mr. Boudreault’s affidavit. Mr. Boudreault is the Senior Vice President Sales and Marketing for North America of K-2 Sports which is a trading style for K-2 Corporation. He joined K-2 Corporation of Canada in 1999 and has held that position since 2009. During his cross-examination he mentioned that he left that company on September 7, 2012.

[18] Mr. Boudreault alleges in his affidavit that he was informed by the Opponent’s in house counsel, Ms. Julie VanDerZanden, that in 2008 she had contacted the Applicant to enquire about licensing the Opponent’s PLANET EARTH brand to them. He further alleges that he was informed by her that the Applicant had confirmed to her that it had been trying to reach the Opponent to initiate discussions about the same issue. Ultimately they were not able to reach an agreement about royalty rates. However in the course of these discussions, it was absolutely clear they understood that the Opponent was the owner of the trade-mark PLANET EARTH.

[19] I agree with the Applicant that such evidence constitutes inadmissible hearsay evidence. Hearsay evidence may be admissible if it meets the criteria of necessity and reliability [see *R v Khan*, [1990] 2 SCR 531 and *R v Smith* [1992] SCR 915]. In the present case Mr. Boudreault does not explain why Ms. VanDerZanden was not in a position to file her own affidavit or sworn statement.

[20] I consider that the Opponent has not met its initial burden of proof with respect to this ground of opposition. Consequently, this ground of opposition is also dismissed.

#### Ground of opposition based on section 30(b) of the Act

[21] The Opponent raised as a ground of opposition that the Mark was in use in Canada in association with DVDs before the filing date of the application and the Applicant failed to claim the existing use of the Mark in Canada at the date of filing of the application.

[22] There is no argument presented by the Opponent in its written argument with respect to this ground of opposition.

[23] I agree with the Applicant that there is no evidence in the record that the Mark has been used by the Applicant in association with DVDs prior to the filing date of the application (November 17, 2009).

[24] Therefore, this ground of opposition is also dismissed.

#### Grounds of opposition based on the likelihood of confusion

[25] The remaining grounds of opposition based on sections 16(1)(a) and (b), 16(3)(a) and (b) and distinctiveness are all based on the allegation that the Mark, when used in association with the Products and Services, is likely to cause confusion with the Applicant's trade-mark PLANET EARTH.

[26] Those grounds of opposition must be assessed at different dates:

- Ground of opposition based on section 16(1)(a) and (b) of the Act: the alleged date of first use of the Mark (December 31, 2008 for the Products 1 and December 31, 2007 for the Products 2) [see section 16(1)(a) and (b) of the Act];
- Ground of opposition based on section 16(3)(a) and (b) of the Act: the filing date of the application (November 17, 2009) [see section 16(3)(a) and (b) of the Act];
- Ground of opposition based on lack of distinctiveness of the Mark: the filing date of the statement of opposition (June 6, 2011) [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)]

[27] The difference in the relevant dates is not a significant factor in the assessment of the various relevant surrounding circumstances to determine whether there was a likelihood of confusion between the marks in issue at each of the relevant dates.

[28] Firstly, I must determine if the Opponent has met its initial burden of proof namely, that it has used and/or made known in Canada its trade-mark PLANET EARTH prior to any of the relevant dates listed above. On this issue the Applicant has not argued that the Opponent has not met its initial burden. I am satisfied that the allegations contained in Mr. Boudreault's affidavit to be summarized hereinafter under the various relevant surrounding circumstances are sufficient to meet such initial burden.

[29] As for the grounds of opposition based on previously filed applications 1,393,454 and 1,353,494 for the registration of the trade-mark PLANET EARTH, a certificate of authenticity for each application has been filed in the record. Application 1,393,454 was filed on April 29, 2008 and was still pending when the present application was advertised (January 5, 2011). As for application 1,353,494 it was filed on June 27, 2007 and was still pending at the advertisement date of the present application [see section 16(4) of the Act].

[30] I note that application 1,393,454 cannot be cited in support of a ground of opposition based on section 16(1)(b) of the Act, in so far as the Products 2 are concerned, as the claimed date of first use for such products is December 31, 2007 and thus prior to the filing date of the Opponent's application.

[31] The test to determine the likelihood of confusion is set out in section 6(2) of the Act wherein it is stipulated that the use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would likely lead to the inference that the products

associated with those trade-marks are manufactured, sold or leased by the same person, whether or not the products are of the same general class. The test under section 6(2) of the Act does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In making such assessment I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the products or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them.

[32] Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Clorox Co v Sears Canada Inc* (1992), 41 CPR (3d) 483 (FCTD) and *Gainers Inc v Marchildon* (1996), 66 CPR (3d) 308 (FCTD)]. I also refer to the decisions of the Supreme Court of Canada in *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC) where Mr. Justice Binnie commented on the assessment of the criteria enumerated under section 6(5) of the Act to determine if there is a likelihood of confusion between two trade-marks.

[33] Also, as stated by the Supreme Court of Canada in *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 96 CPR (4th) 361 (SCC), in the majority of cases, the degree of resemblance between the marks in issue is the most important factor. The other factors become significant only once the marks are found to be identical or very similar.

*Inherent distinctiveness of the marks and the extent to which they have become known*

[34] This factor has not been addressed by the Opponent in its written argument. I agree with the Applicant's submissions that neither the Mark nor the Opponent's trade-mark PLANET EARTH is inherently distinctive. The Mark has a design feature that renders it more inherently distinctive than the Opponent's trade-mark. However I do not consider such slight advantage to be a determining factor in the outcome of this analysis.

[35] The degree of distinctiveness of a trade-mark may be enhanced through its use or promotion in Canada. I shall now review the relevant evidence concerning the use and promotion of the parties' respective trade-marks.

[36] In his affidavit, Mr. Boudreault has provided the following information and/or produced the following documentation:

- PLANET EARTH branded bags, wallets, clothing, head gear and caps have been sold in Canada since at least 2000. He filed photographs of a jacket and tags bearing that mark.
- From 2000 until 2010, K-2 Corporation of Canada distributed PLANET EARTH products. In 2010 K-2 Sports secured a new Canadian license agreement for that brand.
- Exhibit B to his affidavit are spreadsheets evidencing some of the Opponent's customers sales for each of the years from 2000 through 2010 of PLANET EARTH branded apparel, bags, headwear and other goods.
- Exhibit F to his affidavit are copies of invoices evidencing sales of PLANET EARTH branded products over the years and Exhibit G are invoices evidencing sales of PLANET EARTH branded backpacks, bags, wallets and watches in 2005, 2006, 2007 and 2008 together with printouts from its catalogues to identify the nature of these sales.
- Yearly Canadian sales figures of products bearing the PLANET EARTH mark from 2000 to 2010 that vary from \$29,000 to over \$840,000.
- Exhibit C to his affidavit consists of excerpts from some of the catalogues for PLANET EARTH products from 2000 to 2011 illustrating bags, wallets, totes, caps, hats, posters, welcome mats, and general accessory items. These catalogues have been used by the sales team and distributed to customers and prospective customers for ordering purposes each year.
- The Opponent has been operating PLANET EARTH websites since at least 2006. They consist entirely of entertainment graphics and videos which prominently display the PLANET EARTH brand. They do not permit consumers to purchase products online but enables them to view or download its catalogues. He filed as Exhibit D screenshots from 2009 captured from the *WayBackMachine.org*.
- Exhibit E to his affidavit features photographs of a hard cover book offered by the Opponent containing pictures of scenery and nature.

[37] However during his cross-examination Mr. Boudreault admitted that:

- The DVD displayed on the Opponent's website was compiled in 2011 and no copies were ever distributed in Canada (reply to undertakings).



- The front page of the book is the 4th page of Exhibit E (the title of the book is Perspectives but the mark PLANET EARTH appears on the back cover page). It was first published in 2009 and only 75 copies were distributed free of charge (pages 40-42 and reply to undertakings).

[38] Percentages of Canadian sales of wallets bags and watches were provided for each year as an undertaking and were never more than 1.57% of the Opponent's total sales of products bearing the trade-mark PLANET EARTH.

[39] I agree with the Applicant's submissions that there is no evidence that the Opponent's trade-mark PLANET EARTH has become known in association with anything other than clothing and headgear, and to a minimal extent with bags. None of these products are covered by the present application [see Annex A].

[40] As for the use of the Mark in association with the Products and Services, there is no evidence in the record of such use.

[41] Consequently the Opponent's trade-mark PLANET EARTH was more known than the Mark at any of the relevant dates but only with respect to articles of clothing, headgear and to a minimal extent with bags. This factor favours the Opponent.

*The length of time the marks in issue have been in use*

[42] There is no evidence of use of the Mark in association with any of the Products or Services at any of the relevant dates. On the other hand, as described under the previous factor there is evidence of use of the Opponent's trade-mark PLANET EARTH since at least 2000.

[43] The Applicant argues that the use of the trade-mark PLANET EARTH by the Opponent is in association with products that are not part of the list of Products and as such the length of time this trade-mark has been in use should favour neither party. I disagree. The nature of the products and services is a factor of its own and should not be taken into consideration in the analysis of this factor.

[44] This factor favours the Opponent.

*The nature of the wares and services and the parties' respective channels of trade*

[45] The Opponent's written argument makes reference to direct overlap between the Opponent's clothing, bags, belts and accessories sold in association with its trade-mark PLANET EARTH and wallets, belt buckles, watches, bags and accessories listed at one point in the present application.

[46] As stated earlier, on March 14, 2014 the Applicant filed a revised application in which it deleted from the list of products any goods related to any sort of bags, carrying cases, wallets, belt buckles and coin purses. As such the issue of overlap concerning those products is moot.

[47] The Opponent's application 1,393,454 covers:

Bags namely, backpacks, rucksacks, knapsacks, tote bags, shoulder bags, wallets, purses; clothing namely, casual clothing, athletic clothing, snowboard clothing, ski wear, swim wear, beach wear, clothing belts; headgear namely, hats, caps and beanies;

while its application 1,353,494 covers:

Backpacks, tote bags, shopping bags, handbags.

[48] Mr. Boudreault's evidence shows use of the trade-mark PLANET EARTH in association with clothing, headgear and bags (to a minimal extent).

[49] The Opponent argues that the remainder of the Applicant's Products and Services 'are similarly ordinary consumer or household goods which one might expect to find through the same or similar retail channels as the Opponent's PLANET EARTH branded products and those wares listed in the PLANET EARTH trade-mark applications'.

[50] I disagree with the Opponent. By their own nature the Applicant's Products, even though some may be categorized as household goods (household cleaning preparations, toothpaste, non-medicated toilet preparations to name a few as examples), differ from articles of clothing and bags.

[51] As for the nature of the Services, they differ from the Opponent's commercial activities. As admitted by Mr. Boudreault during his cross-examination, the Opponent's PLANET EARTH trade-mark is used mainly as a clothing brand (Q. 58).

[52] On the nature of the parties channels of trade Mr. Boudreault admitted during his cross-examination that he is aware that the Applicant is a broadcasting company and he is aware that DVDs of the Applicant's television series have been on sale in Canada (pages 11-12 of his cross-examination).

[53] The Opponent argues that the Applicant's DVDs, the entertainment services and television and radio programs featuring content relating to natural environment, and the publication of books are products and services likely to be promoted or delivered through similar media, and will be associated with a similar 'environmental' or 'ecological' message; thus increasing the likelihood of confusion between the parties' marks.

[54] As stated earlier, the Opponent's DVD is used to promote the Opponent's clothing in association with its trade-mark PLANET EARTH. No copies of this DVD have ever been sold. Only 75 copies of a book entitled PERSPECTIVES with a reference to the trade-mark PLANET EARTH on the back page have been distributed in Canada free of charge. Also, Mr. Boudreault admitted during his cross-examination that the Opponent does not sell its goods through music or DVD stores (page 44). He also confirmed that the Opponent's customers are clothing stores or sport stores (page 44).

[55] The Applicant refers to Mr. Eugenio's affidavit and more particularly to searches he performed on April 23, 2013. He visited websites that purported to be the Applicant's websites that describe the nature of the Applicant's business. Even if I were to admit in the record the content of this evidence, those searches were conducted after any of the relevant dates. As such this material filed by Mr. Eugenio (Exhibit H to his affidavit) is inadmissible evidence. However, Mr. Boudreault admitted that the Applicant is a broadcasting company as mentioned above.

[56] In summary the evidence shows that, not only the parties' respective products and services are different, but also the parties use different channels of trade. These factors favour the Applicant.

### *Degree of resemblance*

[57] As stated by the Supreme Court of Canada in *Masterpiece Inc*, in the majority of cases, the degree of resemblance between the marks in issue is the most important factor.

[58] There is no doubt that there is some resemblance between the marks by the presence of the Opponent's entire trade-mark PLANET EARTH as the first component of the Mark. I note that the Mark also includes the words 'OUR EXTRAORDINARY WORLD' and a design feature in the form of a curved line. However, the additional words portion is written in much smaller script. Clearly the dominant portion of the Mark is the component 'PLANET EARTH'.

[59] As for the ideas suggested by the marks in issue, I agree with the Opponent that the Mark when used in association with motion picture films and television programs is highly suggestive of their content namely relating to natural environment. The Opponent's trade-mark, when used in association with clothing items may suggest that the garments are constructed primarily of natural, organic, or sustainable fibers as advertised (see exhibit C to Mr. Boudreault's affidavit). There is obviously a link to the environment in both cases.

[60] Overall, this factor favours the Opponent.

### *State of the register evidence*

[61] Mr. Eugenio conducted a search of the register. It reveals 20 citations wherein the words 'PLANET EARTH' are part of a trade-mark. I reviewed the search report and note the following:

- Mr. Eugenio did not limit his search to relevant products or services.
- Two of the citations were only at the 'searched' stage.
- Out of the remaining 18 citations, the present application and the Opponent's two applications cited above are included in his report.
- Even though the remaining 15 citations cover products or services related to those of the Applicant, there is not a large number of citations covering a particular type of products or services part of the list of Products and Services. For example:
  - 2 citations relate to glue and adhesive (registrations TMA703591 and TMA694,767 for the trade-mark THE TOUGHEST GLUE ON PLANET EARTH).

- EcoSynthetix Inc. is the owner of 4 registrations and/or applications for the trade-marks EOSYNTHETIX SUSTAINABLE POLYMERS FOR PLANET EARTH & DESIGN and EOSYNTHETIX SUSTAINABLE POLYMERS FOR PLANET EARTH in association with chemicals.
- Planet Earth Foundation is the owner of three registered trade-marks: PLANET EARTH, PLANET EARTH FOUNDATION and PLANET EARTH MEDIA in association with either broadcasting and communication services, advertising services or providing information through audio-visual media.

[62] In all, I do not agree with the Applicant's position that the state of the register evidence is a conclusive factor. Rather, I cannot conclude from this evidence that consumers are accustomed seeing numerous trade-marks incorporating the words 'PLANET EARTH' in a particular field such that they are able to distinguish them when used in association with products and services related to the Products and Services.

*Fame of the Applicant*

[63] In its written argument the Applicant argues that it is a very well-known company such that consumers that see the parties' trade-marks in the regular context in which they are used (e.g. in the case of the Mark in close association with the Applicant's BBC & Design trade-mark as depicted on some of the exhibits filed by Mr. Eugenio and in particular from the content of the Applicant's website) will be able to differentiate them.

[64] First of all, there is no evidence that the Applicant is a well-known company in Canada. Secondly the Mark does not contain the BBC & Design mark. Once the Applicant obtains registration of the Mark, it will be at liberty to use or license the Mark as registered without being obliged to use it in close proximity to its BBC & Design mark.

*Co-existence of the marks in the United States*

[65] Mr. Eugenio has filed a summary of citations found on the United States register which includes the Mark registered in association with bags and the Opponent's trade-mark PLANET EARTH also registered in association with bags. The Applicant argues that the coexistence of the parties' marks in the United States is a good indication of the lack of possible confusion between the trade-marks in Canada and should be considered as a determinative factor.

[66] To support its position the Applicant is relying on *Weetabix of Canada Ltd v Kellogg Canada Inc* (2002), 20 CPR (4th) 17 (FCTD). In that case there was evidence of use of both parties' trade-marks in the United States over a long period of time.

[67] In its written argument the Opponent is arguing that the mere coexistence of the parties' marks on the United States Trademark register is not relevant to the confusion analysis in Canada and it refers to *Vivat Holdings Ltd v Levi Strauss & Co* 2005 FC 707.

[68] There is no evidence in the record of the extent of the use of the parties' marks in the United States and the duration of such coexistence as there was in *Weetabix*. Mr. Boudreault did state in his cross-examination that the U.S. market was the largest market for the Opponent but this is not sufficient to draw a conclusion on the extent of the Opponent's sales in that market. As for the Applicant, there is no evidence of sales either in Canada or in the United States except again for the admission made by Mr. Boudreault during his cross-examination that he is aware that the Applicant is selling its television series PLANET EARTH on DVD in Canada.

[69] We are therefore left with evidence of the registration in the United States of each of the parties' marks. Evidence of mere coexistence on foreign registers is not relevant [*Vivat Holdings Ltd, supra*].

[70] As there is no evidence regarding U.S. trade-marks law, I do not find relevant the mere coexistence of the parties' trade-marks on the U.S. register.

*Additional surrounding circumstances*

[71] Mr. Eugenio visited numerous broadcasting channels' websites (for example: Discovery, CBC, Food Network) and filed extracts of webpages related to television programs. However I am not prepared to admit this portion of the evidence as those searches were conducted on April 22, 2013 and therefore after any of the relevant dates.

[72] I wish to point out that I took cognizance of the results of various searches made by Mr. Eugenio using the *www.archive.org* website to produce extracts of content of the Opponent's website at various dates, within the relevant dates. This evidence supports the conclusion I made

earlier that the Opponent's trade-mark PLANET EARTH is mainly used in association with clothing and hats.

### Conclusion

[73] I conclude that the Applicant has discharged its burden to prove that there was no likelihood of confusion between the Mark and the Opponent's trade-mark PLANET EARTH at any of the relevant dates. Indeed, despite the fact that the Marks resemble one another due to the common elements PLANET EARTH, the Opponent's trade-mark PLANET EARTH does not possess a high degree of inherent distinctiveness. The addition of 'OUR EXTRAORDINARY WORLD' and a design feature to 'PLANET EARTH' combined with the fact that the Products and Services do not overlap with the Opponent's products and that the parties use different channels of trade to sell their goods and services are sufficient factors to negate any likelihood of confusion between those marks.

[74] Consequently I dismiss the grounds of opposition based on sections 16(1)(a) and (b), 16(3)(a) and (b), and the distinctiveness ground of opposition.

### Disposition

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

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Jean Carrière  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

## Annex A

(1) Greeting cards and calendars; DVDs containing computer games; color and activity books; plush toys and educational science kits for young people; storybooks; board games (Products 1).

(2) Puzzles (Products 2).

(3) Household cleaning preparations; non-medicated toilet preparations, namely, soaps, shampoos, and talcum powder; preparations for use in the bath and shower, namely, bubble baths, bath foam, non-medicated bath salts, bath oil, and shower gel; hair gel; toothpaste; perfumes; eau de cologne; deodorants for personal use; essential oils for personal use; skin care preparations; cosmetics; cotton wool for cosmetic purposes; make-up removing preparations; mouth washes; nail care preparations; nail polish; nail polish removing preparations; depilatories; emery boards; pumice stone for personal use; beauty masks; perfuming sachets; cedar wood for use as a deodorizer; shoe creams and polishes; Audio, video, still and moving images, and data recordings in compressed and uncompressed form, namely, audiocassette tapes, video tapes, DVDs, compact discs, records, and CD-ROMs featuring music, entertainment, instruction, and education; downloadable electronic publications featuring entertainment, instruction, education, and news; computer, electronic and video games programs and equipment, namely video game software, tapes, discs, joy sticks, remote controls, and interactive floor mats; mouse pads; magnets; CD cases; Articles of precious metal and their alloys and articles coated with precious metal and their alloys, namely badges, coasters, serving trays, key fobs, key rings and key chains; jewellery; jewellery boxes; clocks and watches; cuff links; watch straps; tie pins; ornamental pins; and tie clips; Printed publications, namely magazines providing instruction, entertainment, and education relating to the environment; photographs; playing cards; printing blocks; posters; postcards; note cards; storage containers made of paper; trading cards; printed invitations; diaries; stationery binders and file folders, photograph albums; art prints; gift boxes; notepads and notebooks; notebook paper; notebook dividers; book covers; adhesive note pads; writing instruments and crayons; pencil sharpeners; coasters; ornaments of paper, cardboard and paper mache; stickers; iron on and plastic transfers; rubber stamps; personal organizers; address books; erasers; drawing rulers; memorandum boards; paper clips; clip boards; dry erase writing boards and surfaces; paper expanding files; adhesive tape dispensers; desk pads; gift wrap; school supply kits containing various combinations of selected school supplies, namely, writing instruments, pens, pencils, mechanical pencils, erasers, markers, crayons, highlighters, folders, notebooks, paper, graduated rulers, protractors, paper clips, pencil sharpeners, writing grips, glue for arts and crafts, glue for stationery use and book marks; disposable diapers; umbrellas; Household and kitchen utensils, namely ladles, spatulas, and mixing spoons; containers for household and kitchen use, namely beverage containers and plastic storage containers; brushes, combs and sponges for household and kitchen use; household glassware and beverage glassware; porcelain and earthenware dinnerware; plates and ornamental plates; mugs; jugs; tankards; stemware; water bottles and insulated water bottles and flasks; bottle openers; cork screws; lunch boxes; Household linen; bed linen; table linen; table cloths and runners; table mats; table napkins; coasters; fabric and vinyl



furniture coverings; blanket throws; sheets; pillow cases; duvet covers; bed spreads; bath towels; face towels; curtains; wall hangings of textile; banners; bunting cloth; flags; handkerchiefs; cushion covers; textile fabrics for the making of cushions and cushion covers; blinds of textile; Toys, games and playthings, namely, puppets, bath toys, toy models, jigsaw and crossword puzzles; kites; play balls and play balloons; flippers for swimming; floats and inflatable toys for play purposes; electronic and video game apparatus, namely, handheld units for playing electronic and video games; Agricultural seeds; fresh fruit; fresh vegetables; pet food (Products 3)

Entertainment services, namely, organizing exhibitions, competitions, contests, games, quizzes, fun days, shows, road shows, stage events, theatrical performances, concerts, live performances, and audience participation events all pertaining to or featuring instruction, entertainment, and information relating to television programs and films about the natural environment; motion picture films, television and radio programs featuring content relating to the natural environment; publication and electronic publication of magazines, brochures, books, booklets and pamphlets, pertaining to or featuring instruction, entertainment, and information relating to television programs and films about the natural environment; provision of information relating to films and radio and television programs for accessing via communication and computer networks (the Services).

## Annex B

The grounds of opposition raised by the Opponent can be summarized as follow:

1. The subject application contravenes the provisions of Section 30(a) of the *Trade-marks Act* RSC 1985, c T-13, (the Act) in some of the products and services are not defined in ordinary commercial terms;
2. The application does not comply with the requirements of section 30(b) of the Act in that the Mark was in use in Canada in association with DVDs since before the filing date of this application and the Applicant failed to claim this existing use in Canada at the date of filing;
3. The application contravenes the provisions of Section 30(i) of the Act in that as early as 2008, the Applicant and the Opponent participated in discussions about the terms of a license arrangement, recognizing the prior rights of the Opponent in its PLANET EARTH trade-mark. As such the Applicant could not properly make the statement of entitlement as required;
4. The Applicant is not the person entitled to the registration of the Mark pursuant to section 16(3)(a) of the Act in that at the date of filing of the application the Mark was confusing with:
  - i. The Opponent's PLANET EARTH trade-mark previously used by the Opponent in Canada since at least as early as 2000 in association with bags, clothing and hats;
  - ii. The Opponent's PLANET EARTH trade-mark subject of application 1,393,454 previously filed and previously used in association with bags namely, backpacks, rucksacks, knapsacks, all-purpose sports bags, luggage, tote bags, shoulder bags, duffel bags, day packs, wallets, purses; clothing namely, casual clothing, athletic clothing, snowboard clothing, ski wear, swim wear, beach wear, clothing belts; headgear namely, hats, caps, visors and beanies;
  - iii. The Opponent's PLANET EARTH trade-mark subject of application 1,353,494 previously filed in association with backpacks, tote bags,

shopping bags, luggage, portfolios, handbags, wallets, computer bags, lunch bags, pencil cases and binders

5. The Applicant is not the person entitled to the registration of the Mark pursuant to section 16(1) of the Act in that at the alleged dates of first use of the Mark it was confusing with:
  - i) The Opponent's PLANET EARTH trade-mark previously used by the Opponent in Canada since at least as early as 2000 in association with bags, clothing and hats;
  - ii) The Opponent's PLANET EARTH application previously filed and previously used in association with bags namely, backpacks, rucksacks, knapsacks, all-purpose sports bags, luggage, tote bags, shoulder bags, duffel bags, day packs, wallets, purses; clothing namely, casual clothing, athletic clothing, snowboard clothing, ski wear, swim wear, beach wear, clothing belts; headgear namely, hats, caps, visors and beanies;
6. Pursuant to section 38(2)(d) of the Act, the Mark is not distinctive of the products or services of the Applicant since the Mark does not actually distinguish the products or services in association with which the Mark is used by the Applicant from the products of the Opponent, nor is adapted to so distinguish them in view of the above.