



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

Citation: 2018 TMOB 158

Date of Decision: 2018-12-18

IN THE MATTER OF AN OPPOSITION

**William Switzer & Associates (2011)
Ltd.**

Opponent

And

Real Switzer Holdings Ltd.

Applicant

1,610,247 for

Application

SWITZERCULTCREATIVE

INTRODUCTION

[1] William Switzer and Associates Ltd. (WSA) is the predecessor-in-title to William Switzer & Associates Ltd. (2011) Ltd., a high end furniture manufacturer who is also the Opponent in this proceeding. Renee Switzer is the daughter of William Switzer, the founder of WSA and also the former President of WSA.

[2] When WSA went into bankruptcy, its assets were transferred to the Opponent, including its registered trade-marks WILLIAM SWITZER and WILLIAM SWITZER & Design. At such time Renee Switzer also struck out on her own and incorporated Real Switzer Holdings Ltd., the Applicant in these proceedings. The Applicant is in the business of selling modern and

contemporary home furnishings including furniture, lighting fixtures and textiles and does business under the name SWITZERCULTCREATIVE.

[3] The Applicant has applied for the trade-mark SWITZERCULTCREATIVE in association with various goods and services related to furniture, some of which were based on use and some on proposed use. The Opponent has opposed this application on various grounds, including non-compliance with section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) and confusion with its previously used and registered trade-marks WILLIAM SWITZER and WILLIAM SWITZER & Design, and its applied for trade-mark SWITZER.

[4] For the reasons that follow, this application should be refused.

FILE RECORD

[5] On January 17, 2013, the Applicant applied for the trade-mark SWITZERCULTCREATIVE (the Mark) in association with the following goods and services:

Goods:

(1) Lighting fixtures (based on proposed use) (Goods)

Services:

(1) Marketing services in the field of arranging for the distribution of the products of others; Business management and logistics: Furniture brokerage; Licensing furniture manufacturing rights, copyright, design rights, personality rights and designer rights; and distribution of furniture (based on use since at least as early as November 23, 2011) (Services 1)

(2) Operation of a blog in the field of furniture and lighting product designers and furniture (based on use since at least as early as February 1, 2012) (Services 2)

(3) Wholesale sales of furniture (based on use since at least as early as July 17, 2012) (Services 3)

(4) Retail sale of furniture (based on proposed use) (Services 4)

[6] The Mark was advertised in the *Trade-marks Journal* on November 26, 2014. On April 27, 2015, the Opponent filed a statement of opposition opposing the application on several grounds, three of which turn on the issue of confusion between the Mark and the Opponent's registered WILLIAM SWITZER marks: that the Mark is not registrable because it is confusing with the Opponent's registered WILLIAM SWITZER trade-marks; that the Applicant is not the person entitled to registration of the Mark as it is confusing with the Opponent's WILLIAM SWITZER trade-marks or trade-name previously used or made known by it or its predecessor-in-title; and that the Mark is not distinctive of the goods or services of the Applicant. The Opponent also pleads that the Applicant is not the person entitled to registration of the Mark in association with the Goods or Services (3) or (4) because it is confusing with the Opponent's applied for mark SWITZER trade-mark, application No. 1,574,481, which had been previously filed by the Opponent in Canada on April 23, 2012.

[7] The section 30 grounds of opposition are based on non-compliance with sections 30(a), 30(b), 30(e) or 30(i) of the Act. In particular, the Opponent pleads that the application did not contain a statement in ordinary commercial terms of the specific goods and services in association with which the Mark has been used, the Applicant has not in fact used the Mark in association with the goods or services since the claimed dates of first use; the Applicant does not intend to use the Mark in association with the goods "lighting fixtures" or the services "retail sale of furniture"; and the Applicant could not have been satisfied that it was entitled to use the Mark in Canada as it was aware of the prior use of the trade-marks SWITZER and WILLIAM SWITZER in Canada by the Opponent or its predecessors-in-title.

[8] Leave to file an amended statement of opposition was granted July 27, 2018 to correct a typographical error.

[9] On July 28, 2015, the Applicant filed and served its counter statement, along with a request for an interlocutory ruling on the sufficiency of several of the grounds of opposition. The Opponent filed its reply to the Applicant's request on August 28, 2015. On September 8, 2015, an interlocutory ruling issued striking the section 30(e) and 30(i) grounds for not having been sufficiently pleaded.

[10] As its section 41 evidence, the Opponent filed the affidavits of Corrine Viray and Bina Patel, as well as certified copies of Canadian trade-mark registration Nos. TMA550,180 (for the trade-mark WILLIAM SWITZER & Design) and TMA864,100 (for the trade-mark WILLIAM SWITZER), Canadian trade-mark application No. 1,574,481 (for the trade-mark SWITZER) and a certified copy of the complete file history of the application No. 1,610,247 for the Mark. Only Ms. Patel was cross-examined on her affidavit and her cross-examination transcript forms part of the record.

[11] The Applicant filed the affidavit of Renee Switzer as its section 42 evidence. Ms. Switzer was also cross-examined and her cross-examination transcript forms part of the record. The Opponent did not file any reply evidence.

[12] Both parties filed written arguments and both were represented at an oral hearing. The Opponent withdrew its section 30(a) ground of opposition in its written argument.

PRELIMINARY ISSUES

Interlocutory Ruling dated September 8, 2015

[13] In its written argument, the Opponent requested for the first time that the interlocutory ruling dated September 8, 2015, be reconsidered on the basis that it contained an error in law. The Opponent's section 30(e) grounds had been pleaded as follows:

The trade-mark application does not comply with the requirements of section 30(e) because the Applicant did not and does not intend to use the trade-mark SWITZERCULTCREATIVE in Canada for the retail sale of furniture.

The trade-mark application does not comply with the requirements of section 30(e) because the Applicant did not and does not intend to use the trade-mark SWITZERCULTCREATIVE in Canada for lighting fixtures.

[14] In her ruling, Ms. Fung stated the following: "I find that the section 30(e) grounds have not been sufficiently pleaded to allow the applicant to reply thereto given that the opponent failed to explain why the applicant could not have made the required statement of intent to use." The Opponent submits that the standard required is not for the Opponent to explain why the Applicant could not make the required statement of intent to use but rather to provide sufficient

facts to enable the Applicant to reply. The Opponent further submits that the facts it provided are sufficient. Finally, the Opponent submits that such an error in law deprives the Opponent of its right to proceed under section 30(e) and constitutes the special circumstances permitting the Federal Court to review an interlocutory decision of the Trade-marks Opposition Board should the matter be appealed.

[15] The Registrar can only reconsider a ruling if that ruling was made without jurisdiction, was based on an error of law, or was based on an error in the interpretation of the facts before the Registrar at the time that the ruling was made [see *Jalite Public Ltd v Lencina* (2001), 19 CPR (4th) 406 (TMOB) and *Simmons Ltd v A to Z Comfort Beddings Ltd.* (1987), 18 CPR (3d) 84 (TMOB)]. From a review of the facts and the parties' submissions in the file, I would have come to the same conclusion as Ms. Fung that these grounds were insufficiently pleaded to allow the Applicant to reply thereto. As noted by Ms. Fung, a proper pleading alleges the material facts but not the evidence which the party intends to adduce to establish those facts [see *Pepsico Inc and Pepsi-Cola Canada Ltd v Registrar of Trade-marks* (1975), 22 CPR (2d) 62 (FCTD)]. In this case, by merely stating that the Applicant did not intend to use the Mark with the applied for Goods and Services (4), the Opponent was merely reproducing the statutory wording of the Act and adding the Applicant's goods and services to it. Had the Opponent pleaded that the Applicant did not intend to use the Mark in association with the Goods or Services (4) because, for example, it had already commenced use of the Mark prior to the filing of the application, my conclusion may have been different.

[16] Since I am unable to conclude that the Registrar has committed any clear error of law or erred in the appreciation of the facts of the case at that time that the ruling was made, I am not prepared to reconsider the ruling dated September 8, 2015.

[17] The section 30(e) ground of opposition therefore remains struck for not having been sufficiently pleaded.

Evidentiary Issues

Examiner reports re: application 1574481 for the trade-mark SWITZER

[18] At the oral hearing, the Applicant submitted copies, with the Opponent's consent, of examiner reports dated October 29, 2012, February 27, 2014, March 23, 2015, and June 23, 2016, for the Opponent's application 1,574,481 for the trade-mark SWITZER. Each of these examiner reports either raised or maintained an objection to the mark pursuant to section 12(1)(a) of the Act for the reason that the word SWITZER was considered to be primarily merely the surname of an individual.

[19] I cannot have regard to these reports as they were not submitted by the Applicant as its evidence under section 42 nor did the Applicant request leave to file them under section 44(1) of the Regulations. These reports are therefore not of the record.

Cross-Examination of Ms. Switzer

[20] The Opponent submits that the affidavit of Renee Switzer is riddled with inconsistencies that severely limit the effectiveness and evidentiary value of the Applicant's evidence in this opposition. Some of the examples provided by the Opponent are as follows.

[21] In her affidavit, Ms. Switzer swore that during her capacity as President of WSA, WSA obtained registration of the trade-marks WILLIAM SWITZER and WILLIAM SWITZER design (registration Nos. TMA864,100 and TMA550,180). She also swore that she was terminated from WSA in August 2011.

[22] The Opponent notes that registration No. TMA864,100 was obtained on October 31, 2013. Therefore, the Opponent submits that either the affiant swore a false statement as to her date of termination or as to her association with the Opponent when the Opponent obtained the registration of the marks.

[23] In response, the Applicant's agent submitted that the mistake Ms. Switzer made regarding the registration of the WILLIAM SWITZER trade-mark was a question of semantics and a minor

oversight. I agree that this is a plausible explanation. It could very well be that she did not understand that the marks had only been applied for as opposed to registered.

[24] A second example provided by the Opponent was Ms. Switzer's testimony in her affidavit and on cross-examination that the Applicant has used the Mark on lighting fixtures and the retail sale of furniture since at least as early as November 2011 [Switzer, paras. 13-15, 46; Switzer cross-ex., Qs. 17-27]. The Opponent submits that this is inconsistent with the Applicant's application which claims proposed use of the Mark on lighting fixtures and the retail sale of furniture.

[25] I agree with the Opponent that those parts of Ms. Switzer's testimony which concern use of the Mark are inconsistent with the claims in her application. I therefore find that this inconsistency limits the effectiveness and evidentiary value of her evidence regarding use of the Mark to some extent.

ONUS AND MATERIAL DATES

[26] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[27] The material dates that apply to the grounds of opposition are:

- sections 38(2)(a)/30 - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- sections 38(2)(b)/12(1)(d) of the Act - the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- sections 38(2)(c)/16(1)(a)(b)(c) – the Applicant's date of first use [section 16(1)(a)(b) and (c) of the Act];

- sections 38(2)(c)/16(3)(a)(b)(c) – the filing date of the application for the Mark [section 16(3)(a)(b) and (c) of the Act]; and
- sections 38(2)(d)/2 - the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 2004 FC 1185 (CanLII), 34 CPR (4th) 317 (FC)].

GROUND OF OPPOSITION

Section 30(b) Ground of Opposition

[28] The section 30(b) ground of opposition alleges that the application does not comply with the requirements of section 30(b) because the Applicant has not used the Mark in Canada in association with the Services (1) – (3) (reproduced below for ease of reference) since the claimed dates of first use:

(1) Marketing services in the field of arranging for the distribution of the products of others; Business management and logistics; Furniture brokerage; Licensing furniture manufacturing rights, copyright, design rights, personality rights and designer rights; and distribution of furniture (based on use since at least as early as November 23, 2011);

(2) Operation of a blog in the field of furniture and lighting product designers and furniture (based on use since at least as early as February 1, 2012); and

(3) Wholesale sales of furniture (based on use since at least as early as July 17, 2012).

[29] The initial burden on an opponent is light respecting the issue of non-conformance with section 30(b) of the Act, because the facts regarding an applicant's first use are particularly within the knowledge of an applicant [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. This burden can be met by reference not only to the opponent's evidence but also to the applicant's evidence [*Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) (FCTD) 216]. However, the opponent may only successfully rely on the applicant's evidence to meet its initial burden if the opponent shows that the applicant's evidence puts into issue the claims set forth in the applicant's

application [*Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd* 2014 FC 323 at paras 30-38].

[30] In this case, the Opponent has relied on the Applicant's evidence to meet its burden. In this regard, I highlight the following excerpts from the Opponent's written argument:

- A blog entry on the Applicant's website dated February 19, 2012, entitled "Welcome from Allan and Renee Switzer" reads as follows:
 - "Allan and I are thrilled to be launching our new business this month... Together with our designers, craftspeople and passionate sales teams we bring you SWITZERCULTCREATIVE" (Viray affidavit, Exh. C).
- Another post dated April 9, 2012, references a public launch of the company SWITZERCULTCREATIVE on April 12, 2012 (Viray, Exh C, p.9).
- Ms. Switzer's allegations of use in her affidavit are inconsistent. In this regard, at paragraph 15 she states that the Mark has been used in association with the Applicant's Goods and Services since at least as early as November 2011 while at paragraph 46 she states that the Applicant has been providing the Goods and Services under the Mark since at least as early as 2012.

[31] I find that the Opponent's submissions above are sufficient to put into issue the claims set forth in the application for the Services (1) – (3). In this regard, I agree with the Opponent that the contradiction made by Ms. Switzer in her affidavit regarding which date she actually started using the Mark in association with the applied for goods or services satisfies the evidential burden on the Opponent to put the veracity of the claimed dates of first use into issue.

[32] The onus therefore shifts to the Applicant to support its claims to have used the Mark in association with the Services (1) – (3) since the claimed dates continuously until the filing date of its application.

Services (1) Marketing services in the field of arranging for the distribution of the products of others; Business management and logistics; Furniture brokerage; Licensing furniture

manufacturing rights, copyright, design rights, personality rights and designer rights; and distribution of furniture

[33] With respect to Services (1), the Applicant relies on paragraph 10 of Ms. Switzer's affidavit where she states that the Applicant hired a marketing communications agency in November of 2011 to market the general collections under the Mark. A copy of the marketing proposal was attached as Exhibit E. At paragraph 11, Ms. Switzer states that Real Switzer markets these select designers, their names and designs, brokers sales for them and licenses the right to manufacture their products. The Applicant also relies on paragraphs 20-29 and 33-45 of Ms. Switzer's affidavit where she describes the promotional campaigns of the Applicant from 2012-2016, as well as the Applicant's activities online and in social media since 2012.

[34] I am not satisfied that the Applicant has indeed shown use of the Mark with these services since November 23, 2011 for two reasons. First, the fact that it may have obtained a marketing proposal sometime in November 2011 does not mean that it had either advertised or was able to perform its services in association with the Mark since the claimed date of first use. Second, I cannot determine from the evidence that the Applicant itself was the provider of such services. In this regard, while the evidence shows that the Applicant has advertised and promoted its own furniture services offered in association with its Mark, I do not find from the evidence that the Applicant has advertised or offered marketing services, business management, or furniture brokerage, etc. for others. The section 30(b) ground is therefore successful with respect to Services (1).

Services (2) - Operation of a blog in the field of furniture and lighting product designers and furniture

[35] With respect to Services (2), Ms. Switzer states in her affidavit at paragraph 36 that the Applicant operates a blog that is accessible by the public through its website. Attached as Exhibit U to her affidavit are copies of archived webpages of the Blog section of the webpage from 2012 to 2015. However, the Applicant was not able to validate the claimed date of first use of its blog as of February 1, 2012. As noted by the Opponent, the earliest archived webpage provided by Ms. Switzer is dated February 19, 2012 and is entitled "Welcome from Allan and Renee Switzer".

[36] An applicant ought to be aware that if it is unable to prove a claimed date of first use with documentary evidence, it may be better off claiming a later, provable date rather than risk having its application refused under section 30(b) [*Guevin v Tall Dark & Handy Handyman Services Ltd* (2011), 97 CPR (4th) 444 at para 19 (TMOB)]. If the Applicant had in fact been using the Mark in association with such services since February 1, 2012, I would have expected the Applicant to have provided evidence of such. I therefore cannot find that the Applicant had in fact been using its Mark with Services (2) since the claimed date of first use. The section 30(b) ground is therefore also successful with respect to Services (2).

Services (3) Wholesale sales of furniture

[37] With respect to Services (3), Ms. Switzer states the following in her affidavit at paragraphs 30 and 31:

30. It is our procedure at Real Switzer that, when an order for a purchase of a piece of furniture from the SWITZERCULTCREATIVE collection is received from a customer, we create an invoice and provide it to the customer for payment therefore. Attached as Exhibit P to my affidavit is a copy of a representative invoice issued on August 1, 2012, for the purchase of 1 AHRPA Custom D. Table, 1 Dinig Top, and 2 AHRPA Table Bases. As shown in Exhibit P, the Mark is prominently displayed on the upper left hand corner of the invoice and the invoice provides a clear description of the items sold. Portions of the invoice have been redacted for confidentiality purposes.

Attached as Exhibit Q to my affidavit are copies of other representative invoices created and provided to the customer for each of the years 2012, 2013, 2014, 2015 and 2016...

[38] In my view, it is reasonable to infer from Ms. Switzer's evidence as a whole, including her testimony above and the representative invoice dated August 1, 2012, (for the purchase of furniture from the Applicant) that the Applicant's Services (3) were either performed or available to be performed in association with the Mark since at least as early as the claimed date of first use of July 17, 2012, and that the Mark had been used continuously with such services until the filing date of the application. The section 30(b) ground is therefore not successful with respect to Services (3).

Section 16(1)(b) & Section 16(3)(b) Grounds of Opposition

[39] As noted above, the Opponent restricted its non-entitlement grounds to the Goods and Services (3) and (4). In this regard, the Opponent alleges that the Applicant is not the person entitled to registration of the Mark for the Goods and Services (3) and (4) because it was confusing with the Opponent's SWITZER trade-mark application No. 1,574,481, filed on April 23, 2012, for use in association with furniture and the operation of a furniture store.

[40] The material date for a section 16(1)(b) ground is typically the applicant's claimed date of first use [section 16(1)(b)] while the material date for a section 16(3)(b) ground is the applicant's filing date [section 16(3)(b)]. The material dates for these grounds in this case are therefore, the Applicant's claimed date of first use for Services (3), July 17, 2012, and the Applicant's filing date, January 13, 2013, for the Goods and Services (4).

[41] The Applicant submits that the Opponent's application No. 1,574,481 for the trade-mark SWITZER was refused by the Registrar for being contrary to section 12(1)(a) of the Act. I have exercised my discretion, however, and can confirm that the status of the Opponent's mark was pending at the material dates and remained pending at the date of advertisement. Even if the Opponent's application had been refused after these dates, I note that this would not have been considered a relevant surrounding circumstance in the confusion analysis [*ConAgra Inc v McCain Foods Ltd* (2001), 14 CPR (4th) 228 (FCTD); *Corporativo de Marcas GJB v Bacardi & Company Limited*, 2015 TMOB 51 (CanLII)].

[42] The Opponent has therefore discharged the initial burden at the material dates for both the section 16(1)(b) and 16(3)(b) grounds as its application No. 1,574,481 for the trade-mark SWITZER was filed April 23, 2012 and was pending as of the date of advertisement of the Mark (i.e. November 26, 2014) [section 16(4)]. In the circumstances of this case, nothing turns on which date is used for assessing the likelihood of confusion.

[43] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-mark.

Test for confusion

[44] Trade-marks are confusing when there is a reasonable likelihood of confusion within the meaning of section 6(2) of the Act:

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 goods or services associated with those trade-marks are manufactured . . . or performed by the same person, whether or not the goods or services are of the same general class.

[45] Thus, the issue is not confusion between the trade-marks themselves, but confusion of goods and services from one source as being from another source. In the instant case, the question posed by section 6(2) of the Act is whether purchasers of the goods and services, sold in association with the trade-mark SWITZERCULTCREATIVE, would believe that those items were produced or authorized or licensed by the Opponent.

[46] 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 wares or services are of the same general class.

[47] 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 [*Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)].

Inherent Distinctiveness

[48] The Opponent's mark is inherently weak because it is comprised of a surname [*Glaskoch B. Koch Jr GmbH & Co KG v Anglo Canadian Mercantile Co* (2006), CanLii 80333 (TMOB); *Murjani International Ltd v Universal Impex Co.* (1986), 12 CPR (3d) 481 (FCTD)].

[49] While the Mark also combines the elements of Ms. Switzer's family name, I consider it to be inherently stronger than the Opponent's mark because it is a coined word which, as noted by Ms. Switzer, combines the elements of Ms. Switzer's family name, and the culture of creativity of the Applicant [Switzer, para. 18].

Extent Known and Length of Time in Use

[50] The Opponent's application was filed on April 23, 2012, based on proposed use. The Opponent's affiant, Ms. Patel, is the controller of the Opponent. She explains that she was employed by WSA from April 30, 2007 until August 29, 2011 when the assets of WSA were sold to the Opponent as a result of bankruptcy proceedings. She further states that the assets purchased from WSA included the goodwill of the business and the right to use the name "William Switzer" or any variation thereof as well as all registered and unregistered trade-marks and trade-names. This was important to the Opponent, she adds, because the trade-marks and trade-names SWITZER and WILLIAM SWITZER are well known in the furniture industry [Patel, paras. 1-2].

[51] One of the only other references Ms. Patel makes to the trade-mark SWITZER is at paragraph 3 of her affidavit where she claims that sales of goods and services in association with the trade-marks and trade-names SWITZER and WILLIAM SWITZER have generated revenue of over \$2,000,000 Cdn for each of the years between 2012 and 2016. The only evidence submitted to corroborate this assertion are copies of representative invoices showing sales by the Opponent of various furniture items [Patel, Exh. A]. While I find that these invoices show the display of the Opponent's WILLIAM SWITZER trade-mark, I am not satisfied that they show use of the Mark SWITZER. I am therefore not satisfied that the Opponent's SWITZER mark has become known to any extent in Canada.

[52] The Applicant's Mark, on the other hand, has become known to some extent in Canada. In this regard, some of the evidence of the Applicant's affiant, Ms. Switzer is as follows:

- The Applicant has used the Mark in association with the Goods and Services since at least as early as November 2011;
- Amounts spent on promoting the Mark in association with the Goods and Services ranged between \$5,000 and \$33,000 between 2012 and 2016;
- The Applicant has been producing catalogs for its collection since at least as early as 2012; these catalogs have been distributed to resource libraries of interior designers and architects as well as to representative showrooms in Canada since such time;
- The Applicant's website advertises the Applicant's Goods and Services;
- The Applicant has made over \$400,000 in gross revenue since at least 2012, with a substantial increase in gross revenue in 2016 to the date of Ms. Switzer's affidavit.

[53] As I acknowledged earlier, I cannot give full weight to Ms. Switzer's evidence because some of it is inconsistent. I still consider it sufficient, however, to show that the Mark has become known to a greater extent in Canada than the Opponent's mark.

Nature of the goods and services

[54] For ease of reference, I reproduce the applied for goods and services of the Applicant that are at issue under this ground:

Goods:

(1) Lighting fixtures

Services:

(3) Wholesale sales of furniture

(4) Retail sale of furniture

[55] The applied for goods and services of the Opponent, on the other hand, are furniture and the operation of a furniture store.

[56] The Applicant submits that the nature of the goods, services and business of the Applicant and the Opponent are different. In this regard, the Applicant relies on the evidence which shows that it is in the business of selling modern and contemporary styled furniture and lighting while the Opponent is in the business of manufacturing and selling furniture pieces that are high-end reproductions of non-contemporary, antique reproductions, of a classical style, namely French Moderne styled furniture [Switzer, para. 4; Patel, para. 3, Patel cross-ex. Q. 97, 219, 226 and 229]. The Opponent even admits that its furniture is different than the furniture sold by the Applicant [Patel, para. 9].

[57] While I acknowledge that the style of furniture sold by the parties may be different, the parties' goods and services are at least related to the extent that both parties are in the furniture industry. I also find there to be a direct overlap between the Opponent's operation of a furniture store, and the Applicant's retail sale of furniture. This factor therefore favours the Opponent to some extent.

Nature of the trade

[58] The Applicant submits that the nature of the trade for the Applicant is different than the nature of trade for the Opponent. Some of the differences between the parties' respective trades as submitted by the Applicant are highlighted below:

- The Applicant is in the business of selling modern and contemporary styled furniture and lighting whereas the Opponent is in the business of manufacturing and selling furniture pieces that are high-end reproductions of non-contemporary, antique reproductions, of a classical style, namely French Moderne styled furniture (Switzer, para. 4; Patel, para. 3 & cross-ex. Q. 97, 219, 226 and 229);
- The Applicant provides its Goods and Services to the general public whereas the Opponent provides its goods and services to the trades only (Switzer, paras. 4, 12; Patel, para. 3); and

- The Applicant operates a storefront open to the general public whereas the Opponent does not provide its goods and services to the general public (Switzer, para. 12, Exh. F; Patel cross-ex., Q219-223).

[59] Although the Opponent has acknowledged that the furniture being sold by the parties is different in style, Ms. Patel states in her affidavit that the target markets are the same and the products are sold via similar distribution channels, namely representative showrooms. She also states that the Applicant currently has representation in showrooms where the Opponent has displayed products in the past [Patel, para. 9]. However, on cross-examination, Ms. Patel clarified that the Opponent does not have any representative showrooms in Canada, only one corporate showroom in Vancouver that does not have any furniture from the SWITZERCULTCREATIVE collection [Patel cross-ex., Q. 438-445].

[60] While I recognize that there are no restrictions in the Opponent's application to any particular channel of trade, I do find from the above that there is some evidence that the parties' goods and services are not offered through the same channels.

Degree of resemblance

[61] While the degree of resemblance is the last factor cited in section 6(5) of the Act, it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion [Masterpiece, supra at para 49]. In the circumstances of this case, the following principles of law are particularly applicable:

- When considering the degree of resemblance, the trade-marks must be considered in their totality. The appropriate test is not a side by side comparison but a matter of first impression of a consumer with an imperfect recollection of an opponent's trade-mark [Veuve Cliquot Ponsardin v Boutiques Cliquot Ltee (2006), 2006 SCC 23 (CanLII), 49 CPR (4th) 401 at para 20];
- When the first component of a trade-mark is weak, the significance of the first component decreases [see Conde Nast Publications, supra; Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd. (1991), 37 CPR (3d) 413 (FCA); Phantom Industries Inc v Sara Lee Corp (2000), 8 CPR (4th) 109 (TMOB)]; and

- While the first word of a trade-mark may otherwise, for purposes of distinctiveness, be the most important in some cases [*Conde Nast Publications Inc v Union des editions modernes* (1979), 46 CPR (2d) 183 (FCTD)], a preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique [*Masterpiece, supra*, at para 64].

[62] In this case, the Applicant has incorporated the Opponent's entire mark into the first position of its mark. However, as noted above, the word SWITZER, being a surname, is inherently weak. I therefore agree with the Applicant that the second part of the Mark, being the dominant and more inherently distinctive component CULTCREATIVE, would detract from the word SWITZER in the Opponent's mark so as to reduce its distinctiveness to a fair extent.

[63] In view of the foregoing, I only find there to be some resemblance between the parties' marks in appearance, sound and ideas suggested.

Surrounding circumstances: Jurisprudence concerning weak trade-marks

[64] The Applicant referred me to the jurisprudence on weak trade-marks and I agree that this jurisprudence supports the Applicant's position. The jurisprudence was neatly summarized by Member de Paulsen in *Boutique Jacob Inc v Joseph Limited*, 2015 TMOB 121, as follows at para. 32-33:

...It is well settled that trade-marks consisting of given and surnames names are entitled to a very small ambit of protection [*Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD), at 24; *Joseph Ltd v XES-NY Ltd* (2005), 44 CPR (4th) 314 (TMOB)] and that comparatively small differences will suffice to distinguish between weak marks [*Boston Pizza International Inc v Boston Chicken Inc* (2001), 2001 FCT 1024 (CanLII), 15 CPR (4th) 345 (FCTD) at para 66]. In *Provigo Distribution Inc v Max Mara Fashion Group SRL* (2005), 2005 FC 1550 (CanLII), 46 CPR (4th) 112 at para 31 (FCTD), de Montigny J. explained:

The two marks being inherently weak, it is fair to say that even small differences will be sufficient to distinguish among them. Were it otherwise, first user of words in common use would be unfairly allowed to monopolize these words. A further justification given by courts in coming to this conclusion is that the public is expected to be more on its guard when such weak trade names are used ...

A party adopting a weak trade-mark has been held to accept some risk of confusion [*General Motors v Bellows* (1949), 1949 CanLII 47 (SCC), 10 CPR 101 at 115-116 (SCC)]. While it is possible for the degree of distinctiveness attributed to a weak trade-mark to be enhanced through extensive use [*Sarah Coventry Inc v Abrahamian, supra*], there is no evidence that the Opponent's trade-mark JOSEF has been used in Canada to any extent.

[65] Similar to the situation in the *Josef* case described above, the Opponent's mark in the present case is a weak trade-mark that consists of a surname and there is no evidence that this mark has been used in Canada to any extent. I therefore consider this surrounding circumstance to be in the Applicant's favour.

Surrounding circumstance: Applicant's media release

[66] The Opponent submits that by adopting the element SWITZER, the Applicant intentionally copied the Opponent's trade-mark or trade-name. In this regard, the Opponent points to the Applicant's media release, dated April 2, 2012, and posted on the Applicant's blog on April 8, 2012 which reads as follows:

“World renowned brother and sister duo, Allan and Renee Switzer, are announcing the launch of a new home furnishings company that reflects the quality, design and excellent craftsmanship **for which the Switzer name is known** (emphasis added).” [Viray affidavit, Exh. C, page 9].

The Opponent submits that this evidence shows that the Applicant is aware that the SWITZER element is the dominant and distinctive portion of the Mark that it wishes consumers to associate its brand with.

[67] I agree with the Opponent's submission on this point. This surrounding circumstance therefore favours the Opponent.

conclusion

[68] The question posed by section 6(5) of the Act under this ground is whether customers of the Goods and Services (3) and (4) provided under the trade-mark SWITZERCULTCREATIVE,

would believe that those goods and services originate from the same source or are otherwise related or associated with the Opponent's goods and services.

[69] Having considered all of the surrounding circumstances, I find that the probability of confusion between the parties' trade-marks is evenly balanced between a finding of confusion and a finding of no confusion.


[70] I acknowledge that it is difficult for a trader to monopolize weak words and that the Opponent's trade-mark is not the sort of mark that is typically afforded a broad scope of protection, with small differences typically being sufficient to distinguish a similar mark. Further, there is no evidence that the Opponent's mark has become known to any extent.

[71] However, notwithstanding that the style of furniture sold by the parties may be different, the services covered under this ground which are associated with the parties' marks either overlap or are related. There is also some degree of resemblance between the parties' trade-marks given that the Applicant has incorporated the whole of the Opponent's trade-mark as the first component of the Mark. Moreover, as noted earlier, the Applicant itself has acknowledged in a media release that it wishes consumers to associate its brand with "the Switzer name". In view of this, it is reasonable to conclude that a consumer, upon seeing the Mark in association with the Applicant's goods and services, would be likely to infer that the Applicant's goods and services are somehow related with the Opponent's goods and services.

[72] As the Applicant has not established, on a balance of probabilities, that there would be no reasonable likelihood of confusion between its Mark and the Opponent's mark, the section 16(1)(b) and 16(3)(b) grounds of opposition are successful with respect to the Goods and Services (3) and (4).

Section 12(1)(d) Ground

[73] The Opponent has pleaded that the Mark is not registrable under section 12(1)(d) of the Act as it is confusing with the Opponent's registered trade-marks set out below:

Trade-mark	Serial No.	Goods/Services
	TMA550,180	Furniture, namely bedroom, living room, office, dining room furniture and furniture parts
WILLIAM SWITZER	TMA864,100	Dining room furniture, living room furniture, bedroom furniture, den furniture, recreational room furniture, sitting room furniture, entry area furniture. Operation of a furniture store.

[74] I have exercised my discretion and checked the Register to confirm that these registrations are extant. Therefore, the Opponent has met its initial burden with respect to this ground.

[75] As I am satisfied that the Opponent has met its evidential burden under this ground of opposition, I must now determine whether the Applicant has met its onus of proving no reasonable likelihood of confusion between either of the Opponent's marks and the Mark on a balance of probabilities.

[76] I will now apply the test for confusion set out above as of the material date for this ground which is the date of decision.

Inherent Distinctiveness of the Marks

[77] Both of the Opponent's registered marks are weak because they are comprised of a given name and a surname. As noted above, the Mark possesses some degree of inherent distinctiveness because it is a coined word and possesses other distinctive elements.

Extent Known and Length of Time in Use

[78] As of today's date, both parties' marks have become known to some extent. As noted above, the Applicant has been using its Mark since at least as early as November 2011. Also as noted above, the net revenue generated by the Opponent for goods and services associated with the trade-marks and trade-names SWITZER and WILLIAM SWITZER have been in excess of \$2,000,000 CDN for each year between 2012 and 2015. Ms. Patel also states that the WILLIAM SWITZER trade-mark appears on most documents used by the Opponent including Product Confirmations, Requests for Balances, Sample/Cutting for Approval, Sales Orders and Work Orders, and attaches representative samples of these documents as Exhibit B. She also asserts that the Opponent's trade-mark appears on signage within the organization, at the Opponent's representative showroom locations, on all product identification tags, packaging, furniture collection catalogues, staff uniforms and a showroom located in Vancouver, B.C.

[79] The Applicant submits that neither of the WILLIAM SWITZER marks are presently distinctive of the Opponent because there is no evidence of the Opponent's acquisition of these marks. In this regard, the Applicant submits that a negative inference should be drawn from Ms. Patel's refusal on cross-examination to produce the alleged assignments of the WILLIAM SWITZER marks to the Opponent from the Predecessor in Title [Patel cross-ex., Q. 50-51].

[80] If, based on the Opponent's failure to produce a copy of its assignment document, I am entitled to draw the negative inference that the distinctiveness acquired by the Opponent's marks through use/promotion by the assignor (i.e. WSA.) prior to August 29, 2011, has subsequently diminished because the associated goodwill has since such date enured to a party other than the assignee (the Opponent), this inference would have a negative impact on the extent to which the Opponent's mark has become known as of today's date.

The nature of the goods, services or business and the nature of the trade

[81] My findings for these factors above under the section 16 ground are, for the most part, also applicable under this ground. With respect to the nature of the parties' goods, the main difference is that the Opponent's registered goods for both WILLIAM SWITZER trade-marks are defined more narrowly than the goods applied for in association with its SWITZER mark. Further, as opposed to only applying to a select few services, this ground applies to all of the Applicant's applied for services.

[82] With respect to the parties' services, I agree with the Applicant that Opponent has not provided any evidence to suggest that it provides broader marketing, management, brokerage, licensing or blogging services such as those the Applicant provides. I therefore find that this factor favours the Applicant for Services (1) and Services (2). Again, although the Opponent's registered services are not restricted, I do find that there is some evidence that the parties' goods and services are not offered through the same channels [Patel, para. 9; Patel cross-ex., Q. 438-445].

Degree of resemblance between the marks

[83] I find there to be less resemblance between the registered marks of the Opponent and the Mark in appearance, sound and idea suggested than between the Opponent's applied for mark and the Mark. In this regard, both components of the Opponent's marks, being the first and last name of an individual, are inherently weak, and the first component of the parties' marks are different (i.e. WILLIAM v SWITZER). Further, the Applicant has added the components CULTCREATIVE to its Mark which further distinguish it from the Opponent's trade-marks. I therefore do not find there to be much resemblance between the parties' marks.

Surrounding circumstances – Jurisprudence concerning weak trade-marks and the Applicant's media release dated April 2, 2012

[84] My comments above with respect to the jurisprudence concerning weak trade-marks and the Applicant's media release dated April 2, 2012, and posted on the Applicant's blog on April 8, 2012, are equally applicable to this ground. These surrounding circumstance therefore favour the Applicant and the Opponent respectively.

conclusion

[85] Having regard to the section 6(5) factors, including the low inherent distinctiveness of trade-marks comprised of a given name, that small differences may suffice to distinguish between weak marks, and notwithstanding that the parties goods and services are related, I find that difference in resemblance between the marks tips the balance of probabilities slightly in favour of the Applicant. The section 12(1)(d) grounds of opposition are therefore not successful.

REMAINING GROUNDS OF OPPOSITION

[86] As I have already found in favour of the Opponent with respect to Services (1) and (2) under the section 30(b) ground, and with respect to the Goods and Services (3) and (4) under the section 16(1)(b) and section 16(3)(b) grounds, I do not consider it necessary to discuss the remaining grounds of opposition

DISPOSITION

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

Cindy R. Folz
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2018-09-26

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