



ICONIC CANADIAN BLACK BEAR ENTERS THE REALM OF A TRADE MARK DISPUTE BEFORE THE OPPOSITION BOARD

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A recent decision by Canada's Trade-marks Opposition Board has rejected the oppositions by City of Terrace, owner of the official marks KERMODE BEAR and KERMODEI BEAR, against an application filed by CanadianPacific Phytoplankton Ltd. for the trade-marks KERMODE WARRIOR and KERMODE WARRIOR & design, in association with dietary and nutritional supplements, beverages for medicinal purposes as well as a range of personal care products (*City of Terrace. v. Canadian Pacific Phytoplankton Ltd.*, 2013 TMOB 156, Lisa Reynolds, September 24, 2103).

Official marks

Official marks are statutory creations which may be regarded as a particular species of Canadian trade-mark law. In a nutshell, an official mark can be a badge, crest, emblem or a mark adopted and used in Canada by a public authority and for which the Registrar has given public notice thereof.

There are several important distinctions between trade-marks and official marks, including their prosecution. For example, the examination of an official mark differs from that of trade-marks. In processing an official mark request, the Registrar determines if the entity in question qualifies as a "public authority" without regard as to whether an official mark is confusing with other trade-marks nor if it is descriptive. In addition, official marks are not subject to administrative opposition proceedings or to administrative cancellation proceedings. Moreover, unlike trade-marks which are renewable every 15 years, there is no renewal period for official marks.

Most importantly, official marks may serve as barriers to the registration of trade-marks in so far as official mark rights flow from notice of their adoption and use, and as of such date, no person is allowed to adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for, an official mark, without the consent of the public authority.

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The marks at issue

On August 10, 2009 and August 11, 2009 respectively, CanadianPacific Phytoplankton Ltd. (the “Applicant”) applied to register the word mark KERMODE WARRIOR as well as the mark KERMODE WARRIOR & design as reproduced below, based on proposed use in Canada, in association with various dietary and nutritional supplements, beverages for medicinal purposes and a range of personal care products such as shampoos and body lotions:



The City of Terrace owns the official marks KERMODE BEAR and KERMODEI BEAR. The Registrar gave public notice of the City of Terrace’s adoption and use of these official marks on January 21, 2004 under application Nos. 915,507 and 915,506, respectively.

On February 25th, 2011, the The City of Terrace (the “Opponent”) filed oppositions against both of CanadianPacific Phytoplankton Ltd.’s applications on several grounds, including that:

- (i) the trade-marks are not registrable under section 12(1)(a) of the *Trade-marks Act* (the “Act”) as they are primarily merely the name or surname of an individual who is living or has died within the preceding thirty years, and
- (ii) the trade-marks are not registrable under section 12(1)(e) of the Act, as they are marks, the adoption of which is prohibited by section 9 (1)(n)(iii) of the Act, in view of the Opponent’s official marks KERMODE BEAR and KERMODEI BEAR.

Primarily merely a name or surname: ground of opposition rejected

The Opponent filed evidence suggesting that the word KERMODE has significance as a surname. The Applicant asserted that section 12(1)(a) of the Act is not applicable as the trade-marks are not KERMODE *per se*, but rather KERMODE WARRIOR and therefore not a word that is primarily merely a name or a surname.

Curiously enough, the Opponent also submitted evidence suggesting that the word KERMODE has significance as a subspecies of the American black bear which lives in the central and north coastal regions of British Columbia. This evidence likely assisted the Applicant who asserted that even if section 12(1)(a) of the Act were applicable, the evidence suggested that KERMODE is not primarily merely a surname, as it is also an animal species.

The Trade-marks Opposition Board (“TMOB”) ruled that while the evidence established that “KERMODE” is a surname, the trade-marks KERMODE WARRIOR are formed of a combination of the word KERMODE, which has significance as both a surname and as a species of bear and the word WARRIOR, which is an ordinary dictionary term. The Opposition Board ruled in favour of the Applicant by stating that the trade-marks KERMODE WARRIOR and KERMODE WARRIOR & design, in their entirety, are not primarily merely a name or surname.

The resemblance between the marks: ground of opposition rejected

In relying upon its official marks KERMODE BEAR and KERMODEI BEAR, the Opponent alleged that the Applicant’s trade-marks were not registrable having regard to the provisions of section 12(1)(e) of the Act in that they are marks, the adoption of which is prohibited by subparagraph 9(1)(n)(iii) of the Act which provides as follows:

9(1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for.

(...)

(n) any badge, crest, emblem or mark

(...)

(iii) adopted and used by any **public authority**, in Canada as an official mark for wares or services, in respect of which the Registrar has, at the request of Her Majesty or of the university or public authority, as the case may be, given public notice of its adoption and use;

It is worth noting that the test for confusion where such official marks are concerned is not the same as the test regarding trade-marks; it is a test of “resemblance”, that is, an assessment as to whether or not another mark consists of, or so nearly resembles, as to be likely to be mistaken for an official mark, which does not take into consideration the similarity between the wares and services involved.

Case law has interpreted “consisting of” in section 9 of the Act to mean “identical to” and indicates that the resemblance test should be applied as a matter of first impression and imperfect recollection, with regard to the factors set out in section

6(5)(e) of the Act (degree of resemblance in appearance, sound or in the ideas suggested).

The TMOB asserted that the Applicant's trade-mark KERMODE WARRIOR is clearly not identical to either of the Opponent's official marks KERMODE BEAR and KERMODEI BEAR and went on to assess if the Applicant's marks so nearly resembled either of the Opponent's official marks so as to be likely to be mistaken therefor.

The Opponent contended that KERMODE is commonly understood to refer to the "Kermode bear" and it therefore argued that the word KERMODE in the KERMODE WARRIOR trade-mark suggests the same meaning as it does in the Opponent's KERMODE BEAR and KERMODEI BEAR official marks. The Opponent further submitted that the Applicant's use of a bear design in conjunction with its trade-mark KERMODE WARRIOR made it clear that the KERMODE WARRIOR mark is intended to refer to the Kermode bear and is not suggestive of other ideas.

The TMOB stated that even if it were to accept that the word KERMODE in the marks at issue would be recognized as being a reference to a particular species of bear, this did not necessarily lead to an automatic conclusion that the marks would be likely to be mistaken for one another.

In rejecting the Opponent's ground of opposition, the TMOB underlined that although the parties' marks include the word KERMODE, they also include additional words which resulted in the creation of visual and phonetic dissimilarities, as well as different connotations. More particularly, the presence of the added term WARRIOR in the Applicant's marks resulted in differences in appearance and sound, as well as somewhat different connotations given that the latter part of the Opponent's official marks were formed of the word "BEAR" which, subject to evidence to the contrary, would not be considered as a "WARRIOR".

As for the KERMODE WARRIOR & design mark, several elements contributed to an overall different visual and aural impact: the presence of additional reading matter (the French words KERMOND GUERRIER in smaller print) as well as the graphic depiction of a bear forming a relatively dominant portion of the mark.

The TMOB concluded that when viewed in their entirety, the resemblance between the marks in appearance, sound and ideas suggested was insufficient to result in the Applicant's trade-marks being likely to be mistaken for the Opponent's official marks.

Conclusion

This case aptly illustrates that despite the substantial benefits generally conferred to official marks, trade-mark owners facing challenges from public authorities may nevertheless prevail. While official marks provide a broad range of rights, they are

nonetheless subject to a resemblance test that may curtail the scope of their protection. It remains to be seen if the Opponent will appeal the decision or simply grin and bear it.



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