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THE QUESTION OF DISTINCTIVENESS APPRECIATED BY THE FEDERAL COURT OF CANADA

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Scott Paper Limited v. Georgia-Pacific Consumer Products LP, 2010 FC 478 (April 30, 2010)

In a proceeding before the Federal Court of Canada, Scott Paper Limited ("Scott Paper") successfully appealed a decision rendered by the Opposition Board in which was refused its application to register the Daisy Flower (Square) Pattern Design in association with bathroom tissue due to lack of distinctiveness over Georgia-Pacific Consumer Products LP's ("Georgia-Pacific") own bathroom tissue design mark.

In its decision, the Opposition Board rejected Georgia-Pacific's opposition grounds based on confusion (Section 12(1)(d) of the *Trade-marks Act* (the "Act")) since it was found that small differences between the marks at issue were likely sufficient to avoid confusion. Moreover, Georgia-Pacific's ground based on entitlement (Section 16(3) of the Act) was also rejected. Indeed, the Opposition Board found that Scott Paper's trade-mark was not confusing with Georgia-Pacific's mark since at the time of purchase of the product associated with same, the trade-mark was not visible to the consumer and that therefore, there could not have been prior use in accordance with Section 4 of the Act (definition of use in association with wares).

This being said, the Opposition Board accepted that the trade-mark of Georgia-Pacific may have become known to some extent due to considerable sales, whereas Scott Paper had not provided any evidence of its reputation or that the use of certain design in association with bathroom tissue was common to the trade. Thus, Scott Paper's application was held to be non-distinctive (Section 38(2)(d) of the Act).

Before the Federal Court, Scott Paper filed additional evidence in order to demonstrate common use and coexistence on the marketplace of various similar designs applied to bathroom tissue.

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Upon review of Scott Paper's evidence and based on the standard of review of correctness, the Federal Court noted that Georgia-Pacific had an initial burden to demonstrate that its mark was known to a certain extent and had a significant reputation. As mentioned by the Court, the reputation relating to a trade-mark requires that such mark is known as an indicator of source.

The evidence filed by Scott Paper showed that Georgia-Pacific's wallpaper design mark was only apparent once the bathroom paper packaging was opened.

In reviewing such evidence, the Federal Court held that the Opposition Board had erred in concluding that Georgia-Pacific had met its initial burden of proof regarding the distinctiveness issue. Indeed, the Court noted that even though Georgia-Pacific had proven substantial sales of its products, it was insufficient to conclude that consumers were recognizing Georgia-Pacific's bathroom tissue wallpaper design as an indicator of source.

In view of the foregoing, the Court allowed Scott Paper's appeal and directed the Registrar of trade-mark to allow its application.



