

Federal Court



Cour fédérale

**Date: 20151106**

**Docket: T-221-15**

**Citation: 2015 FC 1257**

**Ottawa, Ontario, November 6, 2015**

**PRESENT: The Honourable Madam Justice McDonald**

**BETWEEN:**

**TIGER CALCIUM SERVICES INC.**

**Applicant**

**and**

**COMPASS MINERALS CANADA CORP.**

**Respondent**

**JUDGMENT AND REASONS**

**I. Introduction**

[1] This is an appeal pursuant to section 56 of the *Trade-marks Act* (the *Act*) by the Applicant, Tiger Calcium Services Inc. (Tiger) from a decision of the Trade-marks Opposition Board (TMOB) dated December 17, 2014 rejecting their opposition to the registration of the trade-mark ENVIRO-GUARD owned by the Respondent, Compass Minerals Canada Corp (Compass).

[2] On May 25, 2010, Sifto Canada Corp (now Compass) filed an application for the trade-mark ENVIRO-GUARD. The proposed use of this trade-mark in Canada was in

association with wares for “de-icing and ice prevention preparations for roadways and sidewalks and other paved surfaces”.

[3] On January 10, 2011, Tiger filed a Statement of Opposition opposing the Respondent’s ENVIRO-GUARD trademark application based on the proposed use of the trade-marks in Canada. Tiger raised five grounds of opposition outlined by the TMOB as follows:

1. The proposed trade-mark is not registrable in view of Sections 30 and 38(2) of the Trade-marks Act in that the Application does not comply with the statutory application requirements. In particular, contrary to Section 30(a), the applied-for wares are not defined in ordinary commercial terms.
2. The proposed trade-mark is not registrable in view of Section 30 and 38(2) of the Act, in that the Application does not comply with the statutory application requirements. In particular, contrary to Section 30(i), the Applicant could not have been satisfied on the day it applied for the proposed trade-mark, namely May 25, 2010, that it was entitled to use the proposed trade-mark in Canada in association with the wares set out in the Application, in light of the prior use and making known by the Opponent and/or its licensees of its trade-marks identified or referred to in the Statement of Opposition.
3. The proposed trade-mark is not registrable in view of Section 30 and 38(2) of the Act, in that the Application does not comply with the statutory application requirements. In particular, contrary to Section 12(1)(d), the proposed trade-mark is confusing with the registered trade-marks CLEAR GUARD, (registration number TMA780,782) ROAD GUARD PLUS, (registration number TMA781,908) NANUK ENVIRO NON/CHLORIDE (registration number TMA589,398) which are in good standing and have been and continue to be used in Canada.
4. The proposed trade-mark is not registrable in view of Sections 16(3)(a), 16(3)(b), 16(3)(c) and 38(2)(c) of the Act, in that the Applicant is not the person entitled to registration of the proposed trade-mark. In particular, as of the date on which the Applicant filed the Application, namely May 25, 2010, and at all material times, the proposed trade-mark was confusing with, or likely to be confusing with, the trade-marks identified or referred to above as previously used and made known in Canada by the Opponent and/or its licensees.

5. The proposed trade-mark is not registrable in view of Section 38(2)(d) of the Act, as the proposed trade-mark is not, and at all material times has not been and could not be, distinctive of the wares of the Applicant. In particular, the trade-marks identified or referred to . . . above which have been previously used and made known by the Opponent and/or its licensees in Canada in association with a liquid de-icer. Therefore, having regard to Section 2 of the Act, the proposed trade-mark - being confused with, or likely to be confusing with, the trade-marks of the Opponent previously used and made known in Canada by the Opponent and/or its licensees - is not adapted to and does not distinguish the wares of the Applicant from the wares of the Opponent.

[4] On March 8, 2011, Compass filed a Counter-statement denying the allegations in the Statement of Opposition.

[5] Before the TMOB, Tiger relied upon the affidavits of Richard Kolodziej, CFO of Tiger sworn to on July 6, 2011 and June 5, 2013.

[6] Compass relied on the affidavit of Karen Cardinell, an assistant who conducted trade-mark searches sworn on August 3, 2013, and an affidavit of Ken Johnston, the Director of Sales of Compass, sworn on August 2, 2013.

[7] Mr. Kolodziej and Mr. Johnston were cross examined on their affidavits. The transcripts of the cross examinations formed part of the record before the TMOB.

[8] The TMOB received written arguments from the parties and an oral hearing was conducted on September 29, 2014.

## II. Decision of the TMOB

[9] On December 17, 2014 the TMOB issued a decision rejecting Tiger's opposition to the registration on the following grounds:

[38] Having regard to the above, and considering in particular that the parties' marks are relatively weak marks, that the parties' channels of trade are different, and that the parties' marks are more different than alike in each of the three facets of resemblance, I find that, at all material times, the marks in issue are not confusing.

[10] The TMOB dismissed grounds 1 and 2 of Tiger's opposition, and identified "confusion" as the main issue to be determined. The Board correctly defined the test for confusion as follows:

[32] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are "all the surrounding circumstances including" those specifically mentioned in section 6(5)(a) to section 6(5)(e) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive and all relevant factors are to be considered. Further, all factors do not necessarily have equal weight as the weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 CPR (3d) 308 (FCTD). However, as noted by Mr. Justice Rothstein in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 CPR (4th) 361 (SCC), although the degree of resemblance is the last factor cited in section 6(5), it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

[11] The TMOB then conducted an analysis of each of the five factors for confusion outlined in s 6(5) of the *Act* and found the following:

First Factor - Inherent and Acquired Distinctiveness.

[33] The applied-for mark ENVIRO-GUARD does not possess a high degree of inherent distinctiveness as the first component of the mark would be perceived as a truncation of the word

“environment” and the second component is a commonly used dictionary word. The mark as a whole suggests either that the applicant’s protect is environmentally friendly or that the consumer will be protected against the environment by using the applicant’s product. Ms. Cardinell’s evidence underscores the non-distinctive nature of the component ENVIRO. The applied-for mark is therefore a relatively weak mark. Similarly, the opponent’s marks CLEAR GUARD and ROAD GUARD PLUS are relatively weak marks because they are composed of commonly used dictionary words and suggestive of the protective nature of the opponent’s wares. The opponent’s mark NANUK ENVIRO NON/CHLORIDE is also a relatively weak mark as the first component would be perceived as a masculine Inuit name and the last component is descriptive of the opponent’s wares. Thus, the inherent distinctiveness of the marks in issue favours neither party.

[34] The opponent’s marks CLEAR GUARD and ROAD GUARD PLUS had acquired a fair reputation as of the earliest material date May 25, 2010, and continued to acquire distinctiveness thereafter. There is no evidence to indicate that the opponent’s mark NANUK ENVIRO NON/CHLORIDE had acquired any more than a minimal degree of distinctiveness at any material time. The subject application for ENVIRO-GUARD is based on proposed use and therefore the applicant cannot claim any distinctiveness for its mark as of the earliest material date. However, the applicant’s mark began to acquire some distinctiveness through sales and advertising beginning in November 2010. The acquired distinctiveness of the parties’ mark favours the opponent at all material times. Nevertheless, the advantage to the opponent is significantly lessened given that the opponent has established a reputation for its marks with large scale institutional buyers rather than with consumers in the retail market.

Second Factor - Length of Time the Parties’ Marks have been in Use

[35] The second factor favours the opponent as the evidence indicates that the opponent was using its marks CLEAR GUARD and ROAD GUARD PLUS since about 2003, while the applicant did not begin to use its mark ENVIRO-GUARD until late 2010.

Third and Fourth Factors - The Nature of the Parties’ Wares and Channels of Trade

[36] The nature of the parties’ wares is essentially the same, which favours the opponent. However, as discussed earlier, the parties’ channels of trade are distinct with, at best, minimal

overlap, which favours the applicant. The third and fourth factors, considered together, balance each other and therefore favour neither party.

#### Fifth Factor - Resemblance between the Parties' Marks

[37] Given that the first part of a mark is the more important for the purposes of distinction, I find that the parties' marks are more different than alike visually, in sounding and in ideas suggested: see *Conde Nast Publications Inc. v. Union Des Editions Modernes* (1979) 26 CPR(2d) 183 at 188 (FCTD). The fifth and most important factor therefore favours the applicant. Additionally, there is a principle of trade-mark law that further favours the applicant namely, that comparatively small differences may suffice to distinguish between "weak" marks, that is, between marks of low inherent distinctiveness (see *GSW Ltd. v. Great West Steel Industries Ltd.* (1975) 22 CPR (2d) 154 (FCTD)) - particularly when the opponent has not presented any evidence of acquired distinctiveness for its marks so as to entitle the opponent's marks to a broadened scope of protection.

### **III. Relevant Legislation**

[12] The full text of the relevant provisions of the *Act* are attached as an Appendix to these reasons.

### **IV. Issues**

[13] The following issues are raised in this Application:

- a. the appropriate standard of review;
- b. whether the TMOB erred on the issue of confusion; and
- c. whether the TMOB was wrong to reject the opposition and permit the ENIVRO-GUARD mark to proceed to registration.

## V. Discussion

### A. *The Appropriate Standard of Review*

[14] In accordance with subsection 56(5) of the *Act*, additional evidence was filed with the Court by both parties. This evidence is to be assessed for materiality, specifically what, if any, impact it would have had on the decision of the TMOB. The standard of review on appeals from the TMOB was addressed in detail in *Molson Breweries v John Labatt Ltd*, [2000] 3 FC 145, [2000] FCJ No 159 [*Molson*], and accepted by the Supreme Court of Canada in *Mattel USA Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772 [*Mattel*]. In *Molson*, Justice Rothstein explained:

47 On an appeal under section 56, the record created before the Registrar forms the basis of the evidence before the Trial Division judge hearing the appeal, which evidence may be added to by the parties. Thus, although the term trial *de novo* has come into frequent usage in describing a section 56 appeal, the term is not an entirely accurate description of the nature of such an appeal. That an appeal under section 56 is not a trial *de novo* in the strict sense of the term was noted by McNair J. in *Philip Morris Inc. v. Imperial Tobacco Ltd*.

51 ...Even though there is an express appeal provision in the *Trade-marks Act* to the Federal Court, expertise on the part of the Registrar has been recognized as requiring some deference. Having regard to the Registrar's expertise, in the absence of additional evidence adduced in the Trial Division, I am of the opinion that decisions of the Registrar, whether of fact, law or discretion, within his area of expertise, are to be reviewed on a standard of reasonableness *simpliciter*. However, where additional evidence is adduced in the Trial Division that would have materially affected the Registrar's findings of fact or the exercise of his discretion, the Trial Division judge must come to his or her own conclusion as to the correctness of the Registrar's decision.

#### (1) The Applicant's additional evidence and position

[15] The Applicant submits that the additional evidence filed in this appeal warrants a trial *de novo* using the standard of correctness, and argues that the new evidence would have materially

changed the findings of the TMOB with respect to confusion. They assert that the additional evidence establishes that the parties are direct competitors with overlapping channels of trade, and proves that that ROAD GUARD and CLEAR GUARD marks are not weak marks as found by the TMOB.

[16] The Applicant argues that four pieces of new evidence support this position: (1) evidence of the use of the Applicant's CLEAR GUARD mark in packaged format for re-sale consumers; (2) evidence of use of the unregistered trade-mark COAL GUARD; (3) evidence of the distinctiveness of the GUARD marks enjoyed by the Applicant; (4) evidence showing the non-distinctiveness of the proposed mark.

[17] This evidence was entered by way of an affidavit and exhibits sworn by Shilo Sazwan, Chief Operating Officer of Tiger, on March 17, 2015. Mr. Sazwan was cross examined on his affidavits; the resulting transcripts as well as the accompanying exhibits form part of the record before this court.

[18] Mr. Sazwan's evidence can be summarized as follows:

- Tiger is the largest manufacturer of calcium chloride products in Western Canada and one of the largest manufactures of natural calcium chloride in North America.
- Tiger products are used for dust control, road stabilization, de-icing and anti-icing, oilfield drilling fluids and mine water suppression.
- Tiger has been in operation for over 50 years with a head office in Nisku, Alberta. Tiger is concerned with the use and registration of the ENVIRO-GUARD mark by the Respondent as it is likely to cause confusion in the marketplace for de-icing and anti-icing products.

- Both Tiger and Compass sell to the bulk (highway) and packaged (retail) markets.
- Tiger customers include municipalities and governments, road maintenance firms, wholesalers and “home improvement” retailers in Canada and primarily in western Canada.
- Tiger owns the trademarks CLEAR GUARD, ROAD GUARD PLUS, NANUK ENVIRO NON/CHLORIDE AND COAL GUARD. CLEAR GUARD, ROAD GUARD PLUS, and NANUK ENVIRO NON/CHLORIDE are all registered in association with anti-icing and de-icing in Canada.
- COAL GUARD is used in association with coal freeze proofing and dust control.
- CLEAR GUARD is a liquid anti-icer and de-icer sold in bulk and packaged formats.
- CLEAR GUARD possesses environmental qualities.
- ROAD GUARD PLUS is a liquid de-icer sold in truckload and 1 ton loads.
- ROAD GUARD PLUS possesses environmental qualities.

[19] The Applicant also filed an affidavit with exhibits sworn to by Lindsay Earnshaw on March 6, 2015. Ms. Earnshaw conducted trademark searches of the Canadian Trademark Database which revealed the following:

- There are 405 marks that contain the term “guard” or “gard” in class 1 (industry chemicals).
- 8 of the 405 marks were registered in association with de-icing, de-icers, ice melters, road salt [or] salt blends.<sup>2</sup> of the 8 marks are owned by Tiger.
- 3 of the 8 marks (including ENVIRO-GUARD) are owned by Compass.

(2) The Respondent's additional evidence and position

[20] The Respondent also filed additional evidence. The affidavit with exhibits of Ken Johnston, Director of Sales at Compass, sworn to on April 20, 2015, was filed confirming his previous affidavit of August 2, 2012. Mr. Johnston was cross examined on his affidavit, and the transcripts and the accompanying exhibits form part of the record before this court. The highlights from this evidence are:

- Compass (previously Sifto) provides salt and other minerals to consumers throughout Canada which includes mined rock salt for highway and consumer de-icing.
- ENVIRO-GUARD is sold to residential customers in retail channels including hardware stores, grocery stores and big box retailers.
- ENVIRO-GUARD is too expensive for highway use and is not sold in any bulk format.
- ENVIRO-GUARD has been sold as a residential de-icing product since November 2010.
- ENVIRO-GUARD is sold in 5.44 kg jugs, 10 kg and 20 kg bags and 20 kg pails.

[21] The Respondent contends that the Applicant's new evidence is irrelevant, has no-probative significance, and would have no material effect on the TMOB's findings. They maintain that the test to determine probative value is "quality, not quantity". Evidence that simply supplements or confirms earlier findings is not sufficient to warrant the standard of correctness. As such, the Respondent submits that the correct standard of review is reasonableness.

[22] Given the consideration of the evidence and reasons articulated in the TMOB decision, the Respondent submits that the Board's findings should not be disturbed.

[23] I agree with the Respondent. While the additional evidence is voluminous, it is largely repetitive of the original record, and would not have materially changed the findings of the TMOB. Accordingly, the appropriate standard of review is reasonableness.

B. *Did the TMOB err on the issue of confusion*

(1) Confusion Analysis

[24] As noted above, the five factors outlined in s 6(5) of the *Act* which must be considered when determining whether trade-marks are confusing are: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time the trade-marks have 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, sound or in the ideas suggested by them.

[25] The TMOB appropriately referenced the confusion analysis outlined by the Supreme Court of Canada in *Masterpiece Theatre v Alavida Lifestyles Inc*, 2011 SCC 27, [2011] 2 SCR 387 [*Masterpiece*]:

[40] At the outset of this confusion analysis, it is useful to bear in mind the test for confusion under the *Trade-marks Act*. In *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée*, 2006 SCC 23, [2006] 1 S.C.R. 824, Binnie J. restated the traditional approach, at para. 20, in the following words:

The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the [mark], at a time when he or she has no more than an imperfect recollection of the [prior] trade-marks, and does not pause to give the matter any detailed consideration or scrutiny, nor to

examine closely the similarities and differences between the marks.

Binnie J. referred with approval to the words of Pigeon J. in *Benson & Hedges (Canada) Ltd. v. St. Regis Tobacco Corp.*, [1969] S.C.R. 192, at p. 202, to contrast with what is not to be done — a careful examination of competing marks or a side by side comparison.

(2) Channels of Trade

[26] The Applicant asserts that had the TMOB considered the new evidence they would have come to a different conclusion on the issue of confusion. Specifically, they argue that the Board would have found the parties to be direct competitors with overlapping channels of trade.

[27] The Applicant relies on Mr. Sazwan's affidavit to establish that their customer UFA Cooperative is a "well-known chain of gas stations, farm supply/home improvement stores with numerous locations throughout Alberta", making them direct competitors with Compass in the consumer market. Invoices of sales of CLEAR GUARD to UFA were added to the record before the Court.

[28] The evidence of the sale of CLEAR GUARD to retail consumers was considered by the TMOB, and while there were no invoices of sales to UFA Cooperative before the TMOB, the TMOB acknowledged at paragraph 21 of its decision that "a small portion of the opponents sales are to retail consumers".

[29] The affidavit of Mr. Swazan of March 17, 2015, states that sales of ROAD GUARD PLUS and CLEAR GUARD products have exceeded 25 million dollars since 2005. He also noted that sales and promotional expenses have exceeded 2 million dollars since 2002. This is

offered as evidence of the wide scope of the use of Tiger's trademarks in western Canada and beyond.

[30] There is no evidence, however, of the breakdown of these sales figures between Tiger's various products or the various channels of trade in which they are sold. Furthermore, this additional evidence does not provide "new evidence" to support sales of CLEAR GUARD in retail channels for the relevant dates in their opposition— May 25, 2010 (date of filing) and January 11, 2011 (non-entitlement and non-distinctiveness).

[31] On cross examination on his March 17, 2015 affidavit, Mr. Swazan confirmed that there were no sales figures or invoices provided for the NANUK ENVIRO NON-CHLORIDE product even though this is listed in the Statement of Objection.

[32] The only "new" evidence of the sale of CLEAR GUARD in retail outlets are two invoices from UFA Cooperative. This is not sufficient proof to establish a retail channel of trade. Further still, this evidence is consistent with the findings of the TMOB referenced above.

[33] I therefore conclude that the additional evidence with respect to sales and channels of trade would not have had a material impact on the TMOB's finding that the parties do not occupy the same channels of trade.

(3) Distinctiveness

[34] On the issue of distinctiveness, the TMOB concluded that the marks for both Tiger and Compass were weak and therefore the inherent distinctiveness of the marks favoured neither party.

[35] The only common element between the marks is the word GUARD. In the case of NANUK ENVIRO NON/CHLORIDE the word ENVIRO is common.

[36] No evidence of sales for NANUK ENVIRO NON/CHLORIDE was before the TMOB or a part of the additional evidence before this court.

[37] The words CLEAR, ROAD, COAL and NANUK are the predominant word elements of Tiger's marks. As such, they are distinguishable from the word ENVIRO in appearance, sound and suggested concepts.

[38] The TMOB was correct in its assertion at paragraph 37 of the decision, that the first part of the mark is the most relevant for the purpose of determining distinction.

[39] In that regard, once the marks for both CLEAR GUARD and ROAD GUARD are stripped of the word GUARD neither of the first words "CLEAR" or "ROAD" are descriptive of de-icing products.

[40] Tiger argued that the distinctiveness of the word "GUARD" should be considered. However, the state of the register evidence shows that marks containing "GUARD" or "GARD" are common: see above, Affidavit of Ms. Earnshaw at para 19.

[41] The additional evidence does not support the distinctiveness of Tiger's marks. Rather, it confirms the conclusion of the TMOB that the marks are weak.

(4) Issues outside the Statement of Objection

[42] Tiger argues that the evidence of the use of COAL GUARD is a relevant consideration in the confusion analysis.

[43] Tiger suggests that a family of trademarks analysis favours Tiger when the use of COAL GUARD is considered. However, evidence with regard to the use of COAL GUARD was not plead in the Statement of Opposition, nor was it raised at the TMOB.

[44] The court in *Procter & Gamble Inc v. Colgate-Palmolive Canada Inc*, 2010 FC 231, at paragraph 26, 364 FTR 288, was clear that while new evidence can be considered in these applications, there is no jurisdiction to consider new issues not raised before the TMOB.

[45] I therefore find that the evidence with respect to COAL GUARD is a new issue. It was not raised in the Statement of Opposition or before the TMOB. As such, it is inappropriate for this court to consider this evidence or its impact.

C. *Was the TMOB wrong to reject the opposition and permit the ENIVRO-GUARD mark to proceed to registration?*

[46] Given the expertise of the TMOB, they are owed significant deference on review. This principle was articulated by the Supreme Court of Canada in *Mattel*, above, as follows:

36 The determination of the likelihood of confusion requires an expertise that is possessed by the Board (which performs such assessments day in and day out) in greater measure than is typical of judges. This calls for some judicial deference to the Board's determination ...

37 What this means in practice is that the decision of the registrar or Board "should not be set aside lightly considering the expertise of those who regularly make such determinations": *McDonald's Corp. v. Silcorp Ltd.* (1989), 24 C.P.R. (3d) 207 (F.C.T.D.), at p. 210, aff'd (1992), 41 C.P.R. (3d) 67 (F.C.A.). Reception of new evidence, of course, might (depending on its content) undermine the factual substratum of the Board's decision and thus rob the decision of the value of the Board's expertise. However, the power of the applications judge to receive and consider fresh evidence does not, in and of itself, eliminate the Board's expertise as a relevant consideration: *Lamb v. Canadian Reserve Oil & Gas Ltd.*, [1977] 1 S.C.R. 517, at pp. 527-28.

[47] The deference owed to the TMOB is in keeping with the direction from the Supreme Court of Canada in *Dunsmuir v New Brunswick*, 2008 SCC 9 at paras 48-50, [2008] 1 SCR 190.

[48] As indicated above, I find that the additional evidence of the Applicant Tiger is not new evidence which would have had a material impact on the decision of the TMOB. As a result, the findings of the Board with respect to each ground for opposition ought to be assessed on a standard of reasonableness. The conclusions reached by the Board for each ground are well reasoned and supported by the evidence, and as such, owed deference by this court.

## **VI. Conclusion**

[49] The Applicant Tiger has raised a number of other issues in this application. Nevertheless, in light of my finding with respect to the weight of the new evidence there is no need to address them. The consideration of the evidence and reasons articulated in the TMOB decision were reasonable. For all these reasons, the present application is dismissed.

## **VII. Costs**

[50] In view of the result, the Respondent shall have their disbursements in the amount of \$1500.00, and be awarded costs in the amount of \$1500.00

**JUDGMENT**

**THIS COURT'S JUDGMENT is that** the appeal is dismissed with total costs to the Respondent in the amount of \$3,000.00

"Ann Marie McDonald"

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Judge

**APPENDIX*****Trade-Marks Act*, RSC 1985, c T-13**

2. In this Act,

“confusing”, when applied as an adjective to a trade-mark or trade-name, means a trade-mark or trade-name the use of which would cause confusion in the manner and circumstances described in section 6

“distinctive”, in relation to a trade-mark, means a trade-mark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or is adapted so to distinguish them;

“proposed trade-mark” means a mark that is proposed to be used by a person for the purpose of distinguishing or so as to distinguish goods or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others;

“registered trade-mark” means a trade-mark that is on the register;

“trade-mark” means

(a) a mark that is used by a person for the purpose of distinguishing or so as to distinguish goods or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others,

(b) a certification mark,

(c) a distinguishing guise, or

(d) a proposed trade-mark;

2. Les définitions qui suivent s’appliquent à la présente loi.

« créant de la confusion » Relativement à une marque de commerce ou un nom commercial, s’entend au sens de l’article 6.

« distinctive » Relativement à une marque de commerce, celle qui distingue véritablement les produits ou services en liaison avec lesquels elle est employée par son propriétaire, des produits ou services d’autres propriétaires, ou qui est adaptée à les distinguer ainsi.

« marque de commerce projetée » Marque qu’une personne projette d’employer pour distinguer, ou de façon à distinguer, les produits fabriqués, vendus, donnés à bail ou loués ou les services loués ou exécutés, par elle, des produits fabriqués, vendus, donnés à bail ou loués ou des services loués ou exécutés, par d’autres.

« marque de commerce déposée » Marque de commerce qui se trouve au registre.

« marque de commerce » Selon le cas :

a) marque employée par une personne pour distinguer, ou de façon à distinguer, les produits fabriqués, vendus, donnés à bail ou loués ou les services loués ou exécutés, par elle, des produits fabriqués, vendus, donnés à bail ou loués ou des services loués ou exécutés, par d’autres;

b) marque de certification;

c) signe distinctif;

d) marque de commerce projetée.

“use”, in relation to a trade-mark, means any use that by section 4 is deemed to be a use in association with goods or services;

4. (1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

(3) A trade-mark that is marked in Canada on goods or on the packages in which they are contained is, when the goods are exported from Canada, deemed to be used in Canada in association with those goods.

6. (1) For the purposes of this Act, a trade-mark or trade-name is confusing with another trade-mark or trade-name if the use of the first mentioned trade-mark or trade-name would cause confusion with the last mentioned trade-mark or trade-name in the manner and circumstances described in this section.

« emploi » ou « usage » À l'égard d'une marque de commerce, tout emploi qui, selon l'article 4, est réputé un emploi en liaison avec des produits ou services.

4. (1) Une marque de commerce est réputée employée en liaison avec des produits si, lors du transfert de la propriété ou de la possession de ces produits, dans la pratique normale du commerce, elle est apposée sur les produits mêmes ou sur les emballages dans lesquels ces produits sont distribués, ou si elle est, de toute autre manière, liée aux produits à tel point qu'avis de liaison est alors donné à la personne à qui la propriété ou possession est transférée.

(2) Une marque de commerce est réputée employée en liaison avec des services si elle est employée ou montrée dans l'exécution ou l'annonce de ces services.

(3) Une marque de commerce mise au Canada sur des produits ou sur les emballages qui les contiennent est réputée, quand ces produits sont exportés du Canada, être employée dans ce pays en liaison avec ces produits.

6. (1) Pour l'application de la présente loi, une marque de commerce ou un nom commercial crée de la confusion avec une autre marque de commerce ou un autre nom commercial si l'emploi de la marque de commerce ou du nom commercial en premier lieu mentionnés cause de la confusion avec la marque de commerce

(2) 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, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

(3) The use of a trade-mark causes confusion with a trade-name if the use of both the trade-mark and trade-name in the same area would be likely to lead to the inference that the goods or services associated with the trade-mark and those associated with the business carried on under the trade-name are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

(4) The use of a trade-name causes confusion with a trade-mark if the use of both the trade-name and trade-mark in the same area would be likely to lead to the inference that the goods or services associated with the business carried on under the trade-name and those associated with the trade-mark are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

(2) L'emploi d'une marque de commerce crée de la confusion avec une autre marque de commerce lorsque l'emploi des deux marques de commerce dans la même région serait susceptible de faire conclure que les produits liés à ces marques de commerce sont fabriqués, vendus, donnés à bail ou loués, ou que les services liés à ces marques sont loués ou exécutés, par la même personne, que ces produits ou ces services soient ou non de la même catégorie générale.

(3) L'emploi d'une marque de commerce crée de la confusion avec un nom commercial, lorsque l'emploi des deux dans la même région serait susceptible de faire conclure que les produits liés à cette marque et les produits liés à l'entreprise poursuivie sous ce nom sont fabriqués, vendus, donnés à bail ou loués, ou que les services liés à cette marque et les services liés à l'entreprise poursuivie sous ce nom sont loués ou exécutés, par la même personne, que ces produits ou services soient ou non de la même catégorie générale.

(4) L'emploi d'un nom commercial crée de la confusion avec une marque de commerce, lorsque l'emploi des deux dans la même région serait susceptible de faire conclure que les produits liés à l'entreprise poursuivie sous ce nom et les produits liés à cette marque sont fabriqués, vendus, donnés à bail ou loués, ou que les services liés à l'entreprise poursuivie sous ce nom et les services liés à cette marque sont loués ou exécutés, par la même personne, que ces produits ou services soient ou non de la même catégorie générale.

(5) In determining whether trade-marks or trade-names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including:

(a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;

(b) the length of time the trade-marks or trade-names have 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 or trade-names in appearance or sound or in the ideas suggested by them.

12. (1) Subject to section 13, a trade-mark is registrable if it is not

(d) confusing with a registered trade-mark;

16. (3) Any applicant who has filed an application in accordance with section 30 for registration of a proposed trade-mark that is registrable is entitled, subject to sections 38 and 40, to secure its registration in respect of the goods or services specified in the application, unless at the date of filing of the application it was confusing with

(a) a trade-mark that had been previously used in Canada or made known in Canada by any other person;

(5) En décidant si des marques de commerce ou des noms commerciaux créent de la confusion, le tribunal ou le registraire, selon le cas, tient compte de toutes les circonstances de l'espèce, y compris:

a) le caractère distinctif inhérent des marques de commerce ou noms commerciaux, et la mesure dans laquelle ils sont devenus connus;

b) la période pendant laquelle les marques de commerce ou noms commerciaux ont été en usage;

c) le genre de produits, services ou entreprises;

d) la nature du commerce;

e) le degré de ressemblance entre les marques de commerce ou les noms commerciaux dans la présentation ou le son, ou dans les idées qu'ils suggèrent

12. (1) Sous réserve de l'article 13, une marque de commerce est enregistrable sauf dans l'un ou l'autre des cas suivants ;

d) elle crée de la confusion avec une marque de commerce déposée;

16. (3) Tout requérant qui a produit une demande selon l'article 30 en vue de l'enregistrement d'une marque de commerce projetée et enregistrable, a droit, sous réserve des articles 38 et 40, d'en obtenir l'enregistrement à l'égard des produits ou services spécifiés dans la demande, à moins que, à la date de production de la demande, elle n'ait créé de la confusion :

a) soit avec une marque de commerce antérieurement employée ou révélée au Canada par une autre personne;

(b) a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person; or

(c) a trade-name that had been previously used in Canada by any other person.

b) soit avec une marque de commerce à l'égard de laquelle une demande d'enregistrement a été antérieurement produite au Canada par une autre personne;

c) soit avec un nom commercial antérieurement employé au Canada par une autre personne.

30. An applicant for the registration of a trade-mark shall file with the Registrar an application containing

(a) a statement in ordinary commercial terms of the specific goods or services in association with which the mark has been or is proposed to be used;

(i) a statement that the applicant is satisfied that he is entitled to use the trade-mark in Canada in association with the goods or services described in the application.

30. Quiconque sollicite l'enregistrement d'une marque de commerce produit au bureau du registraire une demande renfermant:

a) un état, dressé dans les termes ordinaires du commerce, des produits ou services spécifiques en liaison avec lesquels la marque a été employée ou sera employée;

i) une déclaration portant que le requérant est convaincu qu'il a droit d'employer la marque de commerce au Canada en liaison avec les produits ou services décrits dans la demande.

38. (1) Within two months after the advertisement of an application for the registration of a trade-mark, any person may, on payment of the prescribed fee, file a statement of opposition with the Registrar

(2) A statement of opposition may be based on any of the following grounds:

(a) that the application does not conform to the requirements of section 30;

(b) that the trade-mark is not registrable;

(c) that the applicant is not the person entitled to registration of the trade-mark; or

(d) that the trade-mark is not distinctive.

38. (1) Toute personne peut, dans le délai de deux mois à compter de l'annonce de la demande, et sur paiement du droit prescrit, produire au bureau du registraire une déclaration d'opposition.

(2) Cette opposition peut être fondée sur l'un des motifs suivants :

a) la demande ne satisfait pas aux exigences de l'article 30;

b) la marque de commerce n'est pas enregistrable;

c) le requérant n'est pas la personne ayant droit à l'enregistrement;

d) la marque de commerce n'est pas distinctive.

56. (1) An appeal lies to the Federal Court from any decision of the Registrar under this Act within two months from the date on which notice of the decision was dispatched by the Registrar or within such further time as the Court may allow, either before or after the expiration of the two months.

(5) On an appeal under subsection (1), evidence in addition to that adduced before the Registrar may be adduced and the Federal Court may exercise any discretion vested in the Registrar.

56. (1) Appel de toute décision rendue par le registraire, sous le régime de la présente loi, peut être interjeté à la Cour fédérale dans les deux mois qui suivent la date où le registraire a expédié l'avis de la décision ou dans tel délai supplémentaire accordé par le tribunal, soit avant, soit après l'expiration des deux mois.

(5) Lors de l'appel, il peut être apporté une preuve en plus de celle qui a été fournie devant le registraire, et le tribunal peut exercer toute discrétion dont le registraire est investi.

**FEDERAL COURT**  
**SOLICITORS OF RECORD**

**DOCKET:** T-221-15

**STYLE OF CAUSE:** TIGER CALCIUM SERVICES INC. v COMPASS  
MINERALS CANADA CORP.

**PLACE OF HEARING:** TORONTO, ONTARIO

**DATE OF HEARING:** SEPTEMBER 22, 2015

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