

Federal Court



Cour fédérale

Date: 20130205

Docket: T-734-10

Citation: 2013 FC 124

Toronto, Ontario, February 5, 2013

PRESENT: The Honourable Mr. Justice Hughes

BETWEEN:

**THE GOVERNOR AND COMPANY OF
ADVENTURERS OF ENGLAND TRADING
INTO HUDSON'S BAY, ALSO KNOWN AS
HUDSON'S BAY COMPANY**

Applicant

and

BEYMEN MAGAZACILIK ANONIM SIRKETI

Respondent

REASONS FOR JUDGMENT AND JUDGMENT

[1] This is an appeal taken under the provisions of section 56 of the *Trade-Marks Act*, RSC 1985, c. T-13, from a decision of a Member of the Trade-Marks Opposition Board dated the 24th day of February 2010, wherein the opposition made by the Applicant Hudson's Bay to the application made by the Respondent, application number 1,230,186, to register a trade-mark indexed as BEYMEN CLUB B, was rejected.

[2] For the reasons that follow I will allow the appeal in part; some of the wares and services will be removed from the application.

THE APPLICATION

[3] Particulars of the trade-mark sought to be registered in application 1,230,186 include the following:

Applicant: Beymen Magazacilik Anonim Sirketi
of Istanbul, Turkey

The application was assigned to the above entity from the original applicant.

Boyner Holding Anonim Sirketi
of Istanbul, Turkey

Filing Date: 14 September, 2004

The application was filed on the basis of proposed use in Canada; therefore, this filing date becomes important for some of the considerations at issue.

Trade-mark: The trade-mark is described for indexing purposes as CLUB BEYMEN CLUB B but is a combination of words and design as follows:

B E Y M E N CLUB

Wares and Services: Registration is sought in respect of a vast array of wares and services,

in particular:

WARES:

(1) Processed or unprocessed leather and hides; artificial leather, leather for lining; goods made of leather, imitations of leather or other materials and not included in other classes, namely hand bags, sport bags, briefcases, umbrellas, canes, walking sticks, wallets, travelling trunks and suitcases, portfolio, sling bags for carrying infants, infant carriers, trunks and boxes of leather for kids, cases for cheque book, card cases, empty toilet bags, empty instrument bags, purses, backpacks, shopping and school bags; parasols, whips, harness, saddlery, saddle straps and stirrup leathers; gut for making sausages; artificial guts for making sausages, salami; furniture for bedrooms, for kitchens, for dining rooms, for living rooms; display stands and showcases; filing cabinet; medicine cabinets; draughtsman's tables; writing desks; dinner wagons; deck chairs; vice benches not of metal; work benches; counters, chests; post boxes; towel dispensers, fixed, not of metal; bed mattresses, spring mattresses, air mattresses and pillows not for medical purposes, hydrostatic beds not for medical purposes, sleeping bags for camping, camping beds, sea beds; mirrors; beehives, artificial wax combs, wax comb foundations; infant seats, infant carriers, playpens for babies, cradles, infant walkers; registration plates not of metal for vehicles, signboards, boards of plastic or wood; wood casks, barrels and drums; fluid covers; boxes; containers for transportation, chests, transport pallets; plastic package covers; plastic casks, barrels and drums, depots, boxes; picture frames, mouldings for picture frames, picture frame brackets; curtain hook and eye, curtain rings, curtain hooks, curtain rods; goods made of wood and substitutes of wood or synthetic material, handles and buttons for pots & pans; clothes pins; bottle caps not of metal, corks for bottles, cork bands; rivets, nails, screws, pins, cable and pipe clips not of metal; costume stands, covers for clothes; goods of art made by wood, wax, bees wax, plastic or/and plaster, included in this class, namely sculptures, statues, bibelots, busts, mannequins, decorative wall plaques, stuffed animals; baskets; bakers breadbaskets, wicker basket, fishing baskets; pet kennels, nesting boxes for household pets, pet cushions; portable ladders of wood or

plastic, movable ladders; pulleys and bobbins of wood or plastic to wrap up; valves not of metal, taps for casks not of metal; identity cards, identification bracelets, identity plates not of metal; armatures for window and doors not of metal, locks; parts and fittings for furniture not of metal, namely rails for drawers, furniture casters; curtains; bamboo curtains, bead curtains for decoration; clothing made of cotton, tricot, jean, leather, namely skirts, sweatshirts, T-shirts, camisoles, underwear, pants, shorts, bermudas, skirts, dresses, robes, nightwear, socks, jackets, coats, jumpers, ascots, ties, bow ties, stoles, shawls, scarves, boas (necklets), gloves; footwear, namely shoes, boots, half-boots, rain boots, ski boots, special sporting/gymnastic shoes, sandals, slippers, lace boots, sports shoes and studs for sports shoes, shoe parts namely heelpieces, heels, footwear uppers; headgear, namely caps, hats, berets, skull caps, hoods, knit hats, rain hats, bandannas, headbands (clothing), clothing for babies: babies' diapers of textile, babies' napkins of textile, layettes (clothing), innerwear for babies, nylon diapers, bibs (except paper); ties, neckties, mufflers, neck scarves, shawls, scarves, sarong, collars for dresses, bandannas, maniples, muffs, wristbands, head bands; belts, suspenders, braces for clothing, garters.

SERVICES:

(1) Advertising wares and services for others; business management services; business intermediary services for the sale and purchase of goods and services; auction services; classified advertising services; mail order sales; retail department store services; retail sale of clothing, cosmetics, food, home entertainment electronics, house wares, jewellery, lingerie, sporting goods and toys by means of a global computer network, namely Internet; promoting the sale of goods and services for others through the distribution of printed material and promotional contests, by providing coupon programs pertaining to a line of food products, by providing advertising space in a periodical; business information services; business information services; on-line retail department stores services; retail convenience stores services; on-line retail convenience stores; computerized on-line ordering featuring general merchandise and general consumer goods; providing an on-line commercial information directory; providing a searchable database in the field of business information available via a global computer network; dissemination of advertising for others via an on-line electronic communications network; providing a searchable on-line database featuring goods and services of others in the field of finances, insurance, banking, real estate and vehicles; providing a searchable on-line advertising guide featuring the goods and service of other on-line vendors; database management services; computer services, namely, providing directories for telephone numbers, business

addresses, electronic mail addresses, network home page addresses, addresses and telephone number of people, places and organizations; providing multiple user access to a global computer network; electronic transmission of data and documents concerning personal and professional information via computer terminals; providing an interactive database featuring an automatically updating travel planner; providing an interactive database featuring automatically updating address book, personal planner, data reminder and alumni and professional group links all via a global computer network; providing temporary use of on-line non-downloadable software for event scheduling and for managing, viewing and editing address books and other personal and professional contact information; computer services, namely, providing search engines for locating information, resources, and the websites of others on a global computer network; providing a wide range of general interest information via a global computer network; providing electronic greeting cards via a global computer network; insurance service; accident, life, fire, health and marine insurance underwriting, insurance investigation, actuarial, insurance consultancy; financial and monetary business management; banking, financial management, financial analysis, financial sponsorship, financial information, factoring, leasing, issuance of credit cards for shopping by instalment, exchanging money; real estate affairs, real estate brokers, apartment house management, services; real estate appraisal services; antique money appraisal, antique appraisal, jewellery appraisal, stamp appraisal, art appraisal; customs brokerage.

[4] The application was examined by an Examiner in the Trade-Marks Office. Clarification was sought in respect of the description of some of the wares. In a report dated 16 March, 2005, the examiner requested that the word BEYMEN be translated into English or French. In response dated July 12, 2005, the applicant's trade-mark agents advised that BEYMEN is a coined word and does not have any translation into English or French.

[5] The Examiner allowed the application to be advertised for Opposition. It was advertised on 21 September, 2005, whereupon it was opposed by Hudson's Bay, the Applicant in this appeal.

THE OPPOSITION

[6] Hudson's Bay opposed the application for registration, raising the following grounds in its Statement of Opposition dated 5th day of January, 2006:

2. *The grounds of opposition are as follows:*

- a) *Pursuant to Sections 38(2)(b) and 12(1)(d) of the Trade-marks Act, the said trade-mark is not registerable in that it is confusing with the opponent's registered trade-marks, namely:*

(Forty-one registered trade-marks were listed, all owned by Hudson's Bay, all of which were or contained the words Bay or The Bay or Baie or La Baie, including Bay Club, for a wide variety of wares such as those found in a retail department store and services such as that of a retail department store.)

- b) *Pursuant to Sections 38(2)(c) and 16(3)(a) of the Trade-marks Act, the applicant is not the person entitled to registration of the trade-mark in that as of the filing date of the application, namely, September 14, 2004, the said trade-mark was confusing with the opponent's trade-marks, namely:*

(The same forty-one registered trade-marks were listed)

- c) *Pursuant to Section 38(2)(a) of the Trade-marks Act, the application does not conform to the requirements of Section 30 of the Trade-marks Act in that the applicant could not have been satisfied that it is entitled to use the trade-mark in Canada for the wares and services set out in the application therefor, in view of the prior adoption, use and registration by the opponent of its trade-marks as set out in paragraphs 2(a) and (b) above.*

- d) *Pursuant to Section 38(2)(d) of the Trade-marks Act, the said trade-mark is not distinctive of the applicant's wares and services, nor is it adapted to distinguish the applicant's wares and services from*

those of the opponent, for the reasons set out in paragraphs 2(a), (b) and (c) above.

[7] The applicant filed a Counter-Statement simply denying these allegations.

[8] Hudson's Bay filed copies of the forty-one registrations as evidence, but filed no other evidence.

[9] The applicant (Respondent in these proceedings) filed as its evidence an affidavit of a law student, Dinu, to which was attached, as exhibits, a print out of information from the Trade-Marks Office web site as to seventy-eight registered trade-marks, all owned by persons other than Hudson's Bay or the applicant. All of these registered trade-marks included BAY in some form. There was no cross-examination upon this affidavit.

[10] Only Hudson's Bay filed a written argument. Only Hudson's Bay appeared and made argument, through Counsel, at an oral hearing.

THE OPPOSITION MEMBER'S DECISION

[11] On February 24, 2010, a Member of the Trade-Marks Opposition Board gave a written decision rejecting the Opposition.

[12] The Member found, and I agree, that regardless how many of the grounds for opposition may be couched, they are premised on the likelihood of confusion between the trade-mark sought to

be registered and a variety of Hudson's Bay's registered trade-marks. The date for making such a determination was held to be the date of the Member's decision, February 24, 2010.

[13] The Member correctly noted that Hudson's Bay had not submitted any evidence as to actual use by it, or advertisement by it, of any of its registered trade-marks that it had put in issue. The Member also noted that the applicant had put in no evidence as to its promotion or use of the trade-mark sought to be registered.

[14] The Member analyzed the evidence having regard to the provisions of subsection 6(5) of the *Trade-Marks Act* and concluded; particularly in the absence of evidence as to use or promotion by either party that:

conclusion re likelihood of confusion

48 *When applying the test for confusion, it is the totality of the circumstances that will dictate how each consideration must be treated. I have considered that it is a matter of first impression and imperfect recollection. I have also had regard to all the surrounding circumstances including those enumerated in s. 6(5) of the Act. The basic issue to be decided is whether a consumer who has a general and not precise recollection of the Opponent's Marks will, upon seeing the Applicant's Mark be likely to think that the parties' wares and services originate from a common source. I conclude that the Applicant has satisfied its onus to show that on a balance of probabilities there is no reasonable likelihood of confusion between the Mark in association with the applied-for wares and services and the Opponent's Marks. This is primarily because of the Mark's inherent distinctiveness and the differences existing between the parties' marks which outweigh the other factors in the present circumstances.*

[15] The Member dismissed the grounds of opposition based on section 16(3)(a) of the *Trade-Marks Act* since no evidence of previous use or making known by Hudson's Bay of the various registered trade-marks had been provided.

[16] Further, the Member dismissed the grounds of opposition based on subsection 38(2)(a) of the *Trade-Marks Act* on the basis that such a ground should only succeed in exceptional circumstances.

[17] Lastly, the Member dismissed the grounds of opposition based on subsection 38(2)(d) of the *Trade-Marks Act* in that Hudson's Bay filed no evidence to show that its trade-mark had become sufficiently well known to negate the distinctiveness of the trade-mark as applied for.

THE APPEAL

[18] Hudson's Bay has appealed to this Court from the Member's decision under the provisions of section 56 of the *Trade-Marks Act*. In accordance with the *Federal Courts Rules*, SOR/98-106, Rule 300(d), such appeals are to be proceeded with as an application.

[19] In the Notice of Application, Hudson's Bay has raised the following grounds of appeal, stating that the Registrar (Member) erred in finding that:

- a. *as to the Section 38(2)(b) and Section 12(1)(d) of the Trade-marks Act ("the Act") issue that the Respondent has satisfied its onus on the balance of probabilities that there is no reasonable likelihood of confusion between the Respondent's trade-mark and that of the Applicant;*

- b. *as to the Section 38(2)(c) and Section 16(3)(a) of the Act issue that the Applicant failed to meet its initial burden and by dismissing this ground;*
- c. *as to the Section 38(2)(a) and Section 30(i) of the Act that that ground should be dismissed; and*
- d. *as to the Section 38(2)(d) and Section 2 ground that the Applicant had failed to show that its marks relied upon had become sufficiently known so as to negate the distinctiveness of the Respondent's mark.*

[20] Subsection 56(5) of the *Trade-Marks Act* is unusual in that it provides that, in addition to any evidence that was adduced in the Opposition proceedings, further evidence may be adduced on appeal and the Federal Court may exercise any discretion vested in the Registrar.

[21] In this case, Hudson's Bay has provided further evidence by way of two affidavits. The first is the affidavit of Patrick Dickinson, Senior Vice President, Marketing, of Hudson's Bay, sworn April 15, 2012. The second is the affidavit of Anthony Benevides, a law clerk in Hudson's Bay's solicitors' office, sworn June 7, 2012. There was no cross-examination upon either affidavit.

[22] The Dickinson affidavit, paragraph 2, attests that Hudson's Bay is one of Canada's leading fashion retailers with approximately 92 stores across the country; with flagship stores located in larger cities. He testified that for the last 30 years The Bay has continuously advertised its services across Canada through an extensive circular delivery program to homes and businesses. He further testified that over 50 million dollars has been spent by The Bay on printed publications which have been circulated in Canada annually since the year 2000, and that between 10 and 25 million dollars has been spent by The Bay on television, radio and outdoor advertising annually since the year

2000. Samples of the print and broadcast materials were provided which display some of the sorts of wares offered for sale by it in Canada.

[23] The Benevides affidavit addresses many of the registered trade-marks put in evidence by the applicant in Opposition proceedings. Of those seventy-eight registrations, twenty-two had been removed from the register, or amended, as a result of removal proceedings instituted by Hudson's Bay or by failure to renew. Other removal proceedings are ongoing.

[24] The Respondent has filed no evidence in this appeal, nor has the Respondent filed any written argument nor has the Respondent appeared at the hearing of the appeal.

[25] The nature and quality of this new evidence is important. If it is significant and addresses evidence not before the Board, then this Court is entitled, under the provisions of subsection 56(5) of the *Trade-Marks Act*, to consider the matter *de novo*.

[26] I repeat what Justice Manson wrote recently in *CEG License Inc v Joey Tomato's (Canada) Inc*, 2012 FC 1541 at paragraphs 14 to 16:

14 Given new evidence was filed by the opponent in this matter that was not before the Opposition Board, the Court has an unfettered discretion to consider the matter and come to its own conclusion as to the correctness of the Board's decision, if the new evidence is significant and would materially affect the underlying decision: (Bojangles' International, LLC v Bojangles Café Ltd, 2006 FC 657 [Bojangles]; Mattel, Inc v 3894207 Canada Inc, 2006 SCC 22 at paras 35, 37)

15 *However, where no new significant evidence is added on appeal, the standard of review is reasonableness simpliciter (Molson Breweries v John Labatt Ltd, [2000] F.C.J. No. 159, [2000] 3 FC 145; Novopharm Ltd v AstraZeneca AB, 2001 FCA 296).*

16 *Thus, the real question for consideration by the Court is the nature and quality of the new evidence, and whether it materially affects the decision below, so that the standard is correctness, or whether the new evidence is not significant and would not materially affect the decision below, such that the standard of review is reasonableness and considerable deference should be given to the decision below (Telus Corp v Orange Personal Communications Services Ltd, 2005 FC 590 at 397; aff'd 2006 FCA 6 (FCA)).*

[27] I am satisfied that the evidence of Dickenson provides evidence as to use and advertising of the various THE BAY and LA BAIE trade-marks by Hudson's Bay in Canada, and that the affidavit of Benevides significantly impacts upon the evidence of the law student filed by the applicant with the Board.

[28] In considering the matter *de novo* I will use the date of my decision as the date for determining the issue of confusion just as the Member determined that the date of her decision was the relevant date for this purpose, since there has been significant new evidence put before me on this appeal, the date of my determination should be the relevant date.

[29] Since the date of the Member's decision, February 24, 2010, there has been an important decision released by the Supreme Court of Canada, *Masterpiece Inc. v Alavida Lifestyles Inc.*, [2011] 2 SCR 387 (*Masterpiece*) as well as other decisions including the decision of Justice Harrington of this Court in *Movenpick Holding AG v Exxon Mobil Corporation*, 2011 FC 1397 (*Movenpick*).

[30] Given the significant new evidence and significant new jurisprudence it is clear that the matter must be addressed by this Court *de novo*.

BURDEN

[31] The initial burden rests upon a party seeking to register a trade-mark to persuade the Registrar that the trade-mark is registrable. If the registrar is as persuaded, the application is advertised for opposition. A party seeking to oppose the registration of the trade-mark bears the evidential burden to persuade the Registrar that the grounds of opposition are sustainable and preclude registration of the trade-mark.

[32] I repeat what Justice Harrington wrote at paragraph 7 of *Movenpick*:

7 As in any case, there is an initial burden on the party who wishes to change the status quo. The burden is on Exxon Mobil (hereinafter referred to as "Esso", the name under which their gasoline stations are branded) to persuade the Registrar that it is entitled to have its trade-marks "Marché Express" word and design registered. If it succeeds, and there is no opposition, the registration would follow in the normal course. However, in the event of opposition, as here, if a prima facie case has been made out, an evidential burden falls upon Movenpick to adduce sufficient evidence to rebut Esso's case, i.e. to persuade the Registrar that its grounds of opposition are sustainable. Once all the evidence is in, if the Registrar is unable to reach a conclusion, the application must be rejected (John Labatt Ltd v Molson Co (1990), 30 CPR (3d) 293, 36 FTR 70 (FC), aff'd (1992) 42 CPR (3d) 495, 144 NR 318 (FCA)).

[33] Thus, on this appeal, the burden rests upon The Bay to persuade the Court, on the evidence and pertinent jurisprudence, that the grounds that it asserts in opposing the registration of the trade-marks at issue, are sustainable.

CONFUSION

[34] The essential issue is whether the use by The Bay of its registered trade-marks which include the words BAY or BAIE alone or in combination with other words or designs, registered for a variety of wares and services, essentially the services associated with a department store and wares sold in such stores, is likely to be confusing with the trade-mark sought to be registered here.

[35] I find that the essential part of the trade-mark sought to be registered is the word BEYMEN. The rest of the trade-mark adds little to this word. The part likely to be remembered by the average consumer is BEYMEN.

[36] Thus the issue is that of likelihood of confusion between BAY or BAIE and BEYMEN. The *Trade-Marks Act*, section 6, in particular subsection 6(2) and 6(5) provide the framework within which confusion is to be considered. I repeat what Justice Harrington wrote at paragraphs 40 to 42 of *Movenpick*:

40 *Nevertheless, the test for confusion, no matter the form of the dispute, is set out in section 6 of the Act. It is important to bear in mind that the wares and services need not be of the same general class.*

41 *The key is section 6(5) which provides:*

(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 wares, 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.

* * *

(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 marchandises, 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.

42 *The five sub-sections are not exhaustive of surrounding circumstances.*

[37] The approach to the issue of confusion has been established by the Supreme Court of Canada in *Masterpiece*, it is a matter of first impression in the mind of a casual consumer, somewhat in a hearing, with an imperfect recollection, and without close examination. I repeat what Justice Rothstein, for the Court, wrote at paragraph 40:

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.

[38] In the same decision Justice Rothstein instructed as to how the trade-mark should be considered. The Court should not tease out each portion of the mark, a mark must be considered as a whole, as a matter of first impression. The dominant portion which affects the overall impression of the average consumer should not be ignored.

[39] He wrote at paragraphs 83 and 84:

83 *Neither an expert, nor a court, should tease out and analyze each portion of a mark alone. Rather, it should consider the mark as it is encountered by the consumer - as a whole, and as a matter of first impression. In Ultravite Laboratories Ltd. v. Whitehall Laboratories Ltd., [1965] S.C.R. 734, Spence J., in deciding whether the words "DANDRESS" and "RES DAN" for removal of dandruff were confusing, succinctly made the point, at pp. 737-38: "[T]he test to be applied is with the average person who goes into the market and not one skilled in semantics."*

84 *However, considering a trade-mark as a whole does not mean that a dominant component in a mark which would affect the overall impression [page421] of an average consumer should be ignored:*

see esure Insurance Ltd. v. Direct Line Insurance plc, 2008 EWCA Civ 842, [2008] R.P.C. 34, at para. 45, per Arden L.J. This is because, while the consumer looks at the mark as a whole, some aspect of the mark may be particularly striking. That will be because that aspect is the most distinctive part of the whole trade-mark. In this case, contrary to the view of the expert, the most distinctive and dominant component of the marks in issue is in all cases the word "Masterpiece" because it provides the content and punch of the trade-mark. The word "Living" is bland by comparison.

[40] In the present case the Court must consider the dominant characteristics of the relevant marks which is whether BAY or BAIE would be likely to be confused by the average consumer of department store wares and services with BEYMEN, given an imperfect recollection.

[41] The nature of the confusion has been established long ago by the Supreme Court of Canada in *Benson & Hedges (Canada) Ltd. v St. Regis Tobacco Corp.*, [1969] SCR 192 where Ritchie J. for the majority wrote at page 196:

I have underlined the words "would be likely to lead to the inference" as it appears to me to be clear that in opposing an application for registration, the holder of a trade mark which is already registered is not required to show that the "mark" which is the subject of the application is the same or nearly the same as the registered mark, it being enough if it be shown that the use of this mark would be likely to lead to the inference that wares associated with it and those associated with the registered trade mark were produced by the same company.

[42] Thus the test for confusion is not that the "average consumer" confuses one for the other, rather, it is that the average consumer is likely to infer that one is produced by the other. In other words it is not substitutional error but relationship error.

[43] In the present case I am deliberately avoiding a slavish conformity to section 6(5) of the *Trade-Marks Act*, these provisions are guidelines and not a rigorous formula to be followed in every case:

- i. The Bay's trade-marks BAY and BAIE have a long history of substantial use and advertising throughout Canada. BEYMEN has none.
- ii. In many instances the wares and services are closely related and in some cases identical.
- iii. Phonetically and visually BAY or BAIE and BEYMEN are very close. A logical inference is that BEYMEN is a menswear branch of the BAY.
- iv. There have been no instances of actual confusion. BEYMEN filed no evidence that it has ever been on the Canadian market.
- v. In the Opposition proceedings the Respondent (trade-mark applicant) filed some evidence. It was a computer print and taken by a stagiaire in the Respondent's agent's office of what apparently was posted on the Canadian Trade-Marks Office website as to registered trade-marks which included the word BAY or the like. This evidence is of limited value. The affidavit of Benevides shows that a good portion of these registrations have been abandoned or removed from the register. There is no evidence as to the use, or extent of use of any of them. I afford this evidence of little weight (see e.g. *Del Monte Corp. v Welch Foods Inc.* (1992), 44 CPR (3d) 205 per Strayer J. at paras 9-10).

[44] I am satisfied that, given the jurisprudence, the average consumer, somewhat in a hurry, with imperfect recollection would be likely to be confused in thinking that BEYMEN was in some way connected with The Bay and its BAY trade-marks in respect of department store services and like services and wares sold in such stores including those listed in The Bay's trade-mark registrations and illustrated in the new evidence filed with this Court.

[45] I have the sense that the wares and services as extensively listed in the application at issue reflect wares and services as listed have been derived from some sort of classification system, whether Turkish or international. Unfortunately, Canada has not yet adopted a classification system for wares and services. Canada still uses the old fashioned individual itemization system for each of the wares and services for which registration is sought.

[46] In the present case the Court must endeavour to sort out, from the large number of wares and services listed in the application, those in respect of which confusion with BAY or BAIE is likely. In this regard I am grateful to the assistance and candour of Applicant's Counsel as well as the resources of the Court. As a result I have determined that only the following wares and services should remain in the application at issue:

WARES: (1) Processed or unprocessed leather and hides; artificial leather, leather for lining; whips, harness, saddlery, saddle straps and stirrup leathers; gut for making sausages; artificial guts for making sausages, salami; beehives, artificial wax combs, wax comb foundations; registration plates not of metal for vehicles, wood casks, barrels and drums; fluid covers; transport pallets;

plastic package covers; pulleys and bobbins of wood or plastic to wrap up; valves not of metal, taps for casks not of metal; identity cards, identification bracelets, identity plates not of metal.

SERVICES: Business management services; business intermediary services for the sale and purchase of goods and services; auction services; classified advertising services; by providing coupon programs pertaining to a line of food products, by providing advertising space in a periodical; business information services; business information services; providing an on-line commercial information directory; providing a searchable database in the field of business information available via a global computer network; providing a searchable on-line database featuring goods and services of others in the field of finances, insurance, banking, real estate and vehicles; providing a searchable on-line advertising guide featuring the goods and service of other on-line vendors; database management services; computer services, namely, providing directories for telephone numbers, business addresses, electronic mail addresses, network home page addresses, addresses and telephone number of people, places and organizations; providing multiple user access to a global computer network; electronic transmission of data and documents concerning personal and professional information via computer terminals; providing an interactive database featuring an automatically updating travel planner; providing an interactive database featuring automatically updating address book, personal planner,

data reminder and alumni and professional group links all via a global computer network; providing temporary use of on-line non-downloadable software for event scheduling and for managing, viewing and editing address books and other personal and professional contact information; computer services, namely, providing search engines for locating information, resources, and the websites of others on a global computer network; providing a wide range of general interest information via a global computer network; providing electronic greeting cards via a global computer network; insurance service; accident, life, fire, health and marine insurance underwriting, insurance investigation, actuarial, insurance consultancy; financial and monetary business management; banking, financial management, financial analysis, financial sponsorship, financial information, factoring, leasing, exchanging money; real estate affairs, real estate brokers, apartment house management, services; real estate appraisal services; antique money appraisal, antique appraisal, jewellery appraisal, stamp appraisal, art appraisal; customs brokerage.

[47] Therefore, I will allow the appeal in part and return the application to the Trade-marks Office for further processing there, including the request for and reception of any statement as to use in Canada restricted to the wares and services as set out above.

[48] I will not award costs. The Bay has been successful in part only. It has furnished evidence in appeal which could have been provided in the Opposition proceeding. The Respondent has taken no

active role in the appeal. It is located in Turkey and there is no evidence that it has assets in Canada, costs may be unrecoverable in any event.

JUDGMENT

FOR THE REASONS PROVIDED:

THIS COURT'S JUDGMENT is that:

1. The appeal is allowed in part;
2. Trade-mark application no. 1,230,186 is returned to the Trade-Marks Office for further processing with the wares and services restricted to the following:

WARES: (1) Processed or unprocessed leather and hides; artificial leather, leather for lining; whips, harness, saddlery, saddle straps and stirrup leathers; gut for making sausages; artificial guts for making sausages, salami; beehives, artificial wax combs, wax comb foundations; registration plates not of metal for vehicles, wood casks, barrels and drums; fluid covers; transport pallets; plastic package covers; pulleys and bobbins of wood or plastic to wrap up; valves not of metal, taps for casks not of metal; identity cards, identification bracelets, identity plates not of metal.

SERVICES: Business management services; business intermediary services for the sale and purchase of goods and services; auction services; classified advertising services; by providing coupon programs pertaining to a line of food products, by providing advertising space in a periodical; business information services; business information services; providing an on-line commercial information directory;

providing a searchable database in the field of business information available via a global computer network; providing a searchable on-line database featuring goods and services of others in the field of finances, insurance, banking, real estate and vehicles; providing a searchable on-line advertising guide featuring the goods and service of other on-line vendors; database management services; computer services, namely, providing directories for telephone numbers, business addresses, electronic mail addresses, network home page addresses, addresses and telephone number of people, places and organizations; providing multiple user access to a global computer network; electronic transmission of data and documents concerning personal and professional information via computer terminals; providing an interactive database featuring an automatically updating travel planner; providing an interactive database featuring automatically updating address book, personal planner, data reminder and alumni and professional group links all via a global computer network; providing temporary use of on-line non-downloadable software for event scheduling and for managing, viewing and editing address books and other personal and professional contact information; computer services, namely, providing search engines for locating information, resources, and the websites of others on a global computer network; providing a wide range of general interest information via a global computer network;

providing electronic greeting cards via a global computer network;
insurance service; accident, life, fire, health and marine insurance
underwriting, insurance investigation, actuarial, insurance
consultancy; financial and monetary business management; banking,
financial management, financial analysis, financial sponsorship,
financial information, factoring, leasing, exchanging money; real
estate affairs, real estate brokers, apartment house management,
services; real estate appraisal services; antique money appraisal,
antique appraisal, jewellery appraisal, stamp appraisal, art appraisal;
customs brokerage.

3. No costs are allowed.

“Roger T. Hughes”

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-734-10

STYLE OF CAUSE: THE GOVERNOR AND COMPANY OF
ADVENTURERS OF ENGLAND TRADING INTO
HUDSON'S BAY, ALSO KNOWN AS HUDSON'S
BAY COMPANY v BEYMEN MAGAZACILIK
ANONIM SIRKETI

PLACE OF HEARING: Toronto, Ontario

DATE OF HEARING: February 4, 2013

**REASONS FOR JUDGMENT
AND JUDGMENT:** HUGHES J.

DATED: February 5, 2013

APPEARANCES:

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No One FOR THE RESPONDENT

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