

Federal Court



Cour fédérale

Date: 20230104

**Docket: T-1561-20
T-1575-20**

Citation: 2023 FC 2

Ottawa, Ontario, January 4, 2023

PRESENT: The Honourable Mr. Justice Zinn

BETWEEN:

G N R TRAVEL CENTRE LTD.

Applicant/Respondent

and

CWI, INC.

Respondent/Applicant

JUDGMENT AND REASONS

[1] Before the Court are two consolidated proceedings; each is an appeal pursuant to section 56 of the *Trademarks Act*, RSC 1985, c T-13, of the decision of the Registrar of Trademarks dated October 26, 2020, and amended on December 23, 2020. For the following reasons, both appeals will be dismissed.

[2] The Opposition Board considered Trademark Application 1,635,725 [the Application] for the registration of the trademark GNR CAMPING WORLD & Design [the Mark] depicted below:



1. The Trademark Application and Result

[3] The Application by GNR Travel Centre Ltd. [GNR] was for the Mark in association with the following goods and services:

Goods

- a. Recreational vehicles, namely, campers, trailers, motor homes, fifth wheels, fold down trailers, camping vans, truck campers, and their parts and accessories

[the Goods].

Services

- a. recreational vehicle dealership services;
- b. sales services relating to recreational vehicles, namely, campers, trailers, motor homes, fifth wheels, fold down trailers, camping vans, truck campers, and their parts and accessories;
- c. wholesale and retail services relating to recreational vehicles, namely, campers, trailers, motor homes, fifth wheels, fold down trailers, camping vans, truck campers, and their parts and accessories;
- d. online sales of recreational vehicles, namely, campers, trailers, motor homes, fifth wheels, fold down trailers, camping vans, truck campers, and their parts and accessories;

- e. financing services relating to recreational vehicles, namely, campers, trailers, motor homes, fifth wheels, fold down trailers, camping vans, truck campers, and their parts and accessories;
- f. operation and maintenance of an internet website containing information relating to the above noted wares and services; and
- g. storage, service, repair and maintenance services relating to recreational vehicles, namely, campers, trailers, motor homes, fifth wheels, fold down trailers, camping vans, truck campers, and their parts and accessories

[the Services]

[4] The Application was based on the stated use of the Mark in Canada since at least as early as July 24, 2008, in association with the Goods, and use of the Mark in Canada since at least as early as May 3, 2007, in association with the Services.

[5] On June 15, 2016, CWI, Inc. [CWI] filed a statement of opposition against the Application raising grounds of opposition based on registrability under paragraph 12(1)(d), entitlement under paragraphs 16(1)(a) and (b), distinctiveness under section 2, and non-compliance with paragraph 30(b) of the Act.

[6] CWI in its statement of opposition set out its grounds of opposition, as follows:

- a) Section 38(2)(a); Section 30(b):

Pursuant to Section 38(2)(a) of the *Act*, the Application does not comply with Section 30(b) of the *Act*, in that the Applicant, by itself or through a licensee, or by itself and through a licensee, had not used the Trademark in Canada with each of the goods and services listed in the Application as of the claimed dates of first use, namely since at least as early as July 24, 2008 (goods) and since at least as early as May 3, 2007 (services).

Specifically, the Applicant does not sell its own brand of recreational vehicles, related parts or accessories. Any sale

of goods by the Applicant does not constitute use of the Trademark as defined in Sections 2 and 4 of the *Act*.

Even if the Trademark had been used since the dates of first use contained in the application and even if such use was in compliance with Sections 2 and 4 of the *Act*, none of which is admitted and is expressly denied, any such use is not in compliance with Section 30(b) of the *Act*, given that:

- i. use has not been continuous;
- ii. use did not relate to the Trademark as applied-for in the Application;
- iii. the Trademark was not used by, or accrued to the benefit of, the Applicant, G N R Travel Centre Ltd.;

b) Section 38(2)(b); Section 12(1)(d):

Pursuant to Section 38(2)(b) of the *Act*, the Trademark is not registrable in that, contrary to Section 12(1)(d) of the *Act*, the Trademark was, at all material times, confusing with the registered trademark CAMPING WORLD DESIGN (Registration No. TMA245,25) owned by the Opponent. The Opponent's registration had not been abandoned as of April 15, 2015.

c) Section 38(2)(c), Section 16(1)(a):

Pursuant to Section 38(2)(c) of the *Act*, the Application does not comply with Section 16(1)(a) of the *Act* in that at the date of filing of the Application the Trademark was confusing with the Opponent's trademarks listed in Attachment A, which had been previously used by the Opponent and/or its predecessor in title, in Canada in association with the Opponent's Services. The Opponent's trademarks listed in Attachment A continue to be in use and were not abandoned as of July 18, 2013 or April 15, 2015.

d) Section 38(2)(c), Section 16(1)(b):

Pursuant to Section 38(2)(c) of the *Act*, the Application does not comply with Section 16(1)(b) of the *Act* in that at the date of filing of the Application the Trademark was confusing with the following applications owned by the Opponent in Canada:

- i. CAMPING WORLD - Application No. 1635827;
- ii. CAMPING WORLD & Horizontal Design - Application No. 1635828;
- iii. CAMPING WORLD & Vertical Design - Application No. 1635829;

The Opponent's applications listed above were filed with a priority date of July 17, 2013 and were not abandoned as of July 18, 2013 or April 15, 2015.

- e) Section 38(2)(d); Section 2:

Pursuant to Section 38(2)(d) of the *Act*, the Trademark is not distinctive within the meaning of Section 2 of the *Act*, in that the Trademark neither distinguishes the goods and services listed in the Application from those of others, including the Opponent's Services, nor is the Trademark adapted to distinguish the goods and services of the Applicant from the goods and services of others, including the Opponent's Services, nor is the Trademark capable of being distinctive of the Applicant.

[7] The Opposition Board found on the balance of probabilities that GNR had established that it had used the Mark in association with the Goods since the claimed date of July 24, 2008. On the other hand, it found on the balance of probabilities that GNR had failed to establish that it had used the Mark in association with the Services since the claimed date of May 3, 2007. In short, it found that CWI's opposition succeeded with respect to the Services but not with respect to the Goods.

[8] The Opposition Board rejected the confusion-based ground of opposition, finding that GNR had met its burden to show that there was no likelihood of confusion between the Mark and CWI's CAMPING WORLD trademarks.

[9] As a result, the Opposition Board issued a split decision, and refused the Application with respect to the Services but allowed it with respect to the Goods.

2. Issues on Appeal

[10] There are three issues on these appeals:

1. Did the Opposition Board err in granting the Application with respect to the Goods?
2. Did the Opposition Board err in refusing the Application with respect to the Services?
3. Did the Opposition Board err in its analysis of confusion?

3. Standard of Review

[11] In a statutory appeal from a decision of the Opposition Board under subsection 56(1) of the Act, in the absence of material new evidence being filed on appeal pursuant to subsection 56(5), the Supreme Court of Canada's appellate standard of review applies: see *Canada (Minister of Citizenship and Immigration) v Vavilov*, 2019 SCC 65 at para 36. For questions of law or extricable questions of law, the standard of correctness applies. For questions of fact and mixed fact and law (except for extricable questions of law), the "palpable and overriding error" standard applies: see *Clorox Company of Canada, Ltd v Chloretec S.E.C.*, 2020 FCA 76 at para 22-23.

[12] The palpable and overriding error standard of review is highly deferential: *Mahjoub v Canada (Citizenship and Immigration)*, 2017 FCA 157 at para 61 [*Mahjoub*]. “Palpable” means an obvious error and “overriding” means that the obvious error affects the outcome of the case: see *Mahjoub* at paras 62-64.

4. The Legislation

[13] As the Application was advertised prior to June 17, 2019, the Act as it read immediately prior to the coming into force of certain amendments on June 17, 2019, applies with reference to the grounds of opposition. The provisions relevant to this appeal are the following:

2 In this Act,	2 Les définitions qui suivent s'appliquent à la présente loi.
...	[...]
<i>confusing</i> , when applied as an adjective to a trademark or trade name, means, except in sections 11.13 and 11.21, a trademark or trade name the use of which would cause confusion in the manner and circumstances described in section 6; (<i>créant de la confusion</i>)	<i>créant de la confusion</i> Sauf aux articles 11.13 et 11.21, s'entend au sens de l'article 6 lorsque employé à l'égard d'une marque de commerce ou d'un nom commercial. (<i>confusing</i>)
...	[...]
<i>distinctive</i> , in relation to a trademark, describes a trademark 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 that is adapted so to distinguish them; (<i>distinctive</i>)	<i>distinctive</i> Se dit de la marque de commerce qui distingue véritablement les produits ou services en liaison avec lesquels elle est employée par son propriétaire de ceux d'autres personnes, ou qui est adaptée à les distinguer ainsi. (<i>distinctive</i>)

...

4 (1) A trademark 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 trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

...

6 (2) The use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[...]

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.

[...]

6 (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 services soient ou non de la même catégorie générale ou figurent ou non dans la même

classe de la classification de
Nice.

...

[...]

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

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

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

(b) the length of time the trademarks or trade names have been in use;

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

(c) the nature of the goods, services or business;

c) le genre de produits, services ou entreprises;

(d) the nature of the trade; and

d) la nature du commerce;

(e) the degree of resemblance between the trademarks or trade names, including in appearance or sound or in the ideas suggested by them.

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

...

[...]

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

...

(b) in the case of a trade-mark that has been used in Canada, the date from which the applicant or his named predecessors in title, if any, have so used the trade-mark in association with each of the general classes of goods or services described in the application;

...

38 (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 subsection 30(2), without taking into account if it meets the requirement in subsection 30(3);

(a.1) that the application was filed in bad faith;

(b) that the trademark is not registrable;

(c) that the applicant is not the person entitled to registration of the trademark;

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

[...]

b) dans le cas d'une marque de commerce qui a été employée au Canada, la date à compter de laquelle le requérant ou ses prédécesseurs en titre désignés, le cas échéant, ont ainsi employé la marque de commerce en liaison avec chacune des catégories générales de produits ou services décrites dans la demande;

[...]

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

a) la demande ne satisfait pas aux exigences du paragraphe 30(2), compte non tenu de la conformité au paragraphe 30(3) de l'état que contient celle-ci;

a.1) la demande a été produite de mauvaise foi;

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

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

(d) that the trademark is
not distinctive;

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

5. Evidence of CWI

[14] CWI filed the affidavit of Tamara Ward sworn February 22, 2017, and the affidavit of Jo-Anne McConnery sworn February 22, 2017. Neither affiant was cross-examined. CWI also filed certified copies of its three Canadian trademark applications and one registration. The Court notes that each was with respect only to services; none sought or obtained registration with respect to goods.

The Ward Affidavit

[15] Ms. Ward is the Chief Marketing Officer of CWI, a company based in Illinois, USA. She attests that it is one of North America's largest RV retailer and services providers. It operates RV centres that offer RV maintenance and repair services, the sale of RV parts and supplies and the installation thereof, the sale of new and used RVs, and the sale of camping equipment and related goods.

[16] She attests that CWI's websites display the trademark CAMPING WORLD. Customers can learn about RVs, research new and used RVs for sale, purchase RVs and camping equipment from the websites.

[17] She says that there are 123 CAMPING WORLD RV centre locations. Each displays the trademark CAMPING WORLD on interior and exterior signage. All are located in the United

States. Ms. Ward indicates Canadian consumers regularly attend CAMPING WORLD RV centres for purchases. Sales to Canadian consumers between 2007 and 2016 amounted to more than \$150,000,000 USD. From 2007-2016, more than 730,000 catalogues were mailed to Canadian consumers. Canadians have made more than 50,000 purchases via CWI's websites or catalogue.

The McConnery Affidavit

[18] Ms. McConnery is a legal assistant employed by CWI's trademark agent. Her affidavit includes the results of various searches by her of the Canadian Intellectual Property Office online trademarks database, as well as other internet searches and searches of the internet archive known as the Wayback Machine. Specifically, she retrieved archived versions of the website www.gnrcw.com from April 12, 2006, February 20, 2007, April 9, 2007, and August 17, 2008; none of which displayed the Mark. CWI submits that the GNR website featured different trademarks, such as the following:

GNR CAMPING WORLD
2006



6. Evidence of GNR

[19] GNR filed the affidavit of Kevin Betzold sworn on June 21, 2017. He was cross-examined on his affidavit.

The Betzold Affidavit

[20] Mr. Betzold is the General Manager and Vice President of Finance and Administration of GNR, which is located in Winnipeg, Manitoba.

[21] He attests that GNR and its predecessors have operated a business selling and servicing RVs and RV accessories since 1973, and since that time, they have used trademarks that prominently include the term “GNR CAMPING WORLD” in association with the operation of the business. GNR has clients across Canada.

[22] He says that since at least as early as July 24, 2008, GNR has been using the Mark in association with the Goods listed in the Application and that GNR sold the Goods with stickers attached that display the Mark. Between February 2013 and February 2015, GNR offered for sale a private label line of RVs under the trademark SERENITY, to which stickers bearing the Mark were applied.

[23] He further attests that since at least as early as May 3, 2007, GNR has used the Mark in association with the Services. He includes examples of the display of the Mark in association with the Services, such as purchase agreements from July 12, 2008, the display of the Mark at a

trade show in March 2008, and the display of the Mark in print advertisements from July 2007 to October 2007.

[24] Since 2007, GNR sales are in excess of \$9,000,000 CAD per year and it spends in excess of \$2,100,000 CAD in advertising the Goods and Services in association with the Mark.

7. The Opposition Board Reasons and Decision

[25] The approach to decision making in opposition proceedings has two stages as described in *Corporativo De Marcas GJB SA DE CV v Bacardi & Company Ltd*, 2014 FC 323, at paragraph 31:

...At the first stage, the opponent must satisfy its *evidential burden* with respect to its ground of opposition under section 38 of the *Act*. If that is satisfied, then the analysis proceeds to the second stage, at which point the applicant must satisfy its *legal burden* with respect to the compliance of its application under section 30 of the *Act* (Roger T. Hughes, *Hughes on Trade Marks*, loose-leaf (consulted on 27 March 2014), (Markham, Ont: LexisNexis, 2005), ch 43 at 719).

[26] The Opposition Board observed that an opponent's initial evidentiary burden under the Act is light and may be met by reference not only to the opponent's evidence but also to the applicant's evidence.

[27] With respect to Goods, the Opposition Board noted that GNR relied only on its display of the Mark on stickers affixed to Goods. The Board also noted that the Goods sold as of July 24, 2008, were all goods of third parties, some or all branded with their own separate trademarks. The Opposition Board found that CWI met its initial burden of opposition.

[28] The Opposition Board concluded that GNR had used the Mark in association with the Goods for the purposes of subsection 4(1) of the Act since the claimed date of July 24, 2008. This conclusion was reached considering the evidence and because the “weight of existing legal authority suggests that such display does constitute use of a trademark in association with goods pursuant to section 4(1).” In so finding, the Board references *Mcdowell v Laverana GmbH & Co KG*, 2016 FC 1276 [*Mcdowell*] at paras 18 and 19; *Riches, McKenzie & Herbert LLP v Park Pontiac Buick GMC Ltd* (2005), 50 CPR (4th) 391 (TMOB) [*Park Pontiac Buick*] at para 9; and *Stevenson Hood Thornton Beaubier LLP v. Deedee Bodnar*, 2010 TMOB 144 [*Bodnar*] at para 8.

[29] With respect to the Services, the Opposition Board noted that the Betzold affidavit claimed: “GNR has advertised the Services in association with the [Mark] continuously on its website <http://www/gnrcw.com> since at least as early as May 3, 2007 and continuing to date in Canada.” The Opposition Board noted that GNR filed no examples of the display of the Mark on or before the claimed date and that the only evidence offered of GNR’s website were from the Wayback Machine from February 2012 to May 2016, “well after the date of use claimed in the Application.”

[30] If the date of first use in Canada claimed in an application is earlier than the applicant’s actual date of first use, then opposition under paragraph 30(b) of the Act will succeed, and the application will be refused.

[31] The Opposition Board found that the evidence of GNR regarding its first use of the Mark on the Services was “called into question” by the exhibits from the Wayback Machine attached to the McConnery affidavit. It was found that CWI had met its “initial evidential burden” for the purposes of paragraph 30(b) opposition with respect to Services and that GNR had failed to establish on the balance of probabilities that it used the Mark in association with the Services since the claimed date of May 3, 2007. Accordingly, this ground of opposition to the registration of the Mark with regard to the Services was successful.

[32] In assessing confusion, the Opposition Board applied the test set out in subsection 6(2) of the Act, which requires consideration of all relevant surrounding circumstances including the factors set out in subsection 6(5) of the Act.

[33] First, the Opposition Board recognized that the Mark had a higher degree of inherent distinctiveness than CWI’s CAMPING WORLD trademarks. Second, it also recognized the parties’ goods and services overlapped and that both parties’ businesses related to the sale and servicing of RVs and RV accessories. Third, the Opposition Board recognized that the term CAMPING WORLD alone was insufficient to give rise to a high degree of resemblance, “the marks as a whole are sufficiently different.” The Opposition Board agreed that GNR had met its burden of demonstrating on a balance of probabilities that there was no likelihood of confusion.

8. Analysis

A. *The Goods*

[34] Subsection 4(1) defines when a trademark is used in association with goods. That use must be examined at the time the goods are transferred to another, in the normal course of trade. At that point in time, the trademark is used in association with the goods if (i) it is “marked on the goods themselves or on the packages in which they were distributed,” or (ii) “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.”

[35] Determining the meaning of the word “use” for the purposes of the Act is a question of law and subject to review on the correctness standard: see *Miller Thomson LLP v Hilton Worldwide Holding LLP*, 2020 FCA 134 at para 81; *Cosmetic Warriors Limited v Riches, McKenzie & Herbert LLP*, 2019 FCA 48 at para 17.

[36] In its Statement of Opposition CWI pled that the Mark had not been used by GNR as a trademark for the purpose of distinguishing or so as to distinguish GNR’s goods from those of others:

Specifically, the Applicant does not sell its own brand of recreational vehicles, related parts or accessories. Any sale of goods by the Applicant does not constitute the use of the Trademark as defined in Sections 2 and 4 of the Act.

[37] In light of this ground of opposition, the Court agrees with CWI that the question which the Opposition Board was required to address is whether the application of a retailer’s trademark

in the manner done by GNR to goods manufactured by a third party constitutes “use” of the retailer’s trademark on the Goods within the meaning of the Act.

[38] The Court further agrees with the parties that this is a question of law reviewable on the standard of correctness.

[39] I begin by examining the three precedent decisions relied on by the Opposition Board respecting the meaning of the term “use” when associated with goods made by another. Each is a decision arising under section 45 of the Act, which requires a trademark owner to show that the trademark is in use in Canada with respect to the listed goods and services within the preceding three years.

[40] The Federal Court decision, *Mcdowell*, involved the use of the trademark HONEY. It was registered with respect to several goods, which may be generally described as clothing, footwear, headwear, jewellery, fashion accessories, cosmetics, and giftware. It was an appeal of a decision arising under section 45 of the Act: *Laverana GmbH & Co KG v McDowell*, 2015 TMOB 125. Ms. McDowell was required to furnish evidence showing that the HONEY mark was used in Canada in association with each of the goods and services specified in the registrations.

[41] With respect to evidence of association with the specified goods, Ms. McDowell provided evidence of sales but did not provide any breakdown of sales with respect to the registered goods. She also attested that the HONEY mark was displayed on hangtags or stickers

attached to the goods, and by placing the goods in shopping bags or boxes displaying the Honey mark.

[42] One issue addressed by the Opposition Board was described at paragraph 19 as “whether the manner of display of the Marks constitutes use in association with any of the goods sold in HONEY stores, rather than in association with retail store services only.”

[43] With respect to the hang tags attached to the goods, the Opposition Board concluded at paragraphs 39 and 40 that this was not evidence of use in association with goods but rather relates to the services of the retail store:

With respect to the HONEY hangtags, I agree with the Requesting Party that the hangtags appear to be price tags which are only affixed to third-party goods when they are offered for sale in the HONEY retail stores. The Registrar has previously held that merely attaching a store’s price tags to a third-party good does not constitute use of a trade-mark pursuant to section 4(1) of the Act [see *Coastal Trade-mark Services v Edward Chapman Ladies’ Shop Limited*, 2014 TMOB 80, 2014 CarswellNat 1825]. Where a retailer’s trade-mark appears only on a price tag affixed by the retailer, it does not distinguish the goods but, rather, it distinguishes the retailer’s services from those of other retailers.

As the Requesting Party aptly put it: “A CANADA GOOSE® jacket purchased at a HONEY store does not become a HONEY jacket.” As such, I find that the display of the Marks on the evidenced hangtags does not give the requisite notice of association pursuant to section 4(1) of the Act.

[emphasis added]

[44] On appeal, Justice Fothergill specifically addressed this finding, stating at paragraph 21: “[H]ang tags and labels attached to goods would ordinarily be sufficient to demonstrate that a trade-mark was displayed in association with the goods during the relevant period (see, for

example, *Sim & McBurney v Garbo Group Inc*, 2013 TMOB 141 at para 10).” The referenced paragraph reads as follows:

At the oral hearing, the Requesting Party submitted that Exhibit F fails to “show” use of the Mark with any particular ware as the hang tags filed in the exhibit do not have any jewelry attached. However, in his affidavit Mr. Grundman clearly attests that the hang tags and labels are representative of those attached to the Wares sold by the Registrant during the relevant period. In my view, given the nature of the Wares and the exhibited tags and labels, this is sufficient to “show” how the Mark was displayed in association with the Wares during the relevant period.

[emphasis added]

[45] *Park Pontiac Buick* is a decision of the Opposition Board. As part of its evidence submitted to establish use of the trademark in association with cars and trucks, the registrant provided a decal and attested that decals are attached to the cars and trucks sold by the registrant and delivered to its customers. In finding that this was sufficient evidence of use with respect to these goods, the Opposition Board stated at paragraph 9, as follows:

In the circumstances of this case, I am satisfied that the registrant has shown that the mark is associated with automobiles and trucks in accordance with s. 4(1) of the Act in the normal course of its trade and that such use has continued over a number of years including the material three-year time frame. Automobiles and trucks will therefore be maintained in the registration.

[46] *Bodnar* is also an Opposition Board decision. The trademark at issue is registered for use in association with “used motor vehicles namely consumer trucks and cars used for transportation on land.” The affidavit of the registered owner attested that the trademark was “prominently displayed on stickers and licence plate holders affixed to the vehicles available for sale” and remained on them at the time of purchase and transfer to the new owner. The

Opposition Board concluded that “the evidence also shows that the Wares were sold to customers in Canada during the Relevant Period, and that the Mark was associated with the Wares in the manner required by s. 4(1) of the Act.”

[47] In response, CWI begins by observing that proceedings under section 45 are summary in nature and *inter partes*. Whereas “an opposition proceeding based on s. 30(b) of the *Trademarks Act* is not merely an “*inter partes*” dispute but rather involves a consideration of the public interest.” I am not persuaded that this distinction effects the proper interpretation of “use” in section 4 of the Act.

[48] CWI also raised a question as to whether, in the *Mcdowell* case, the tags were attached to the registrants’ own goods or those of another. The reasons are ambiguous. Regardless, it is clear in the other two decisions relied on by the Opposition Board that the trademarks were affixed to goods manufactured by others. Unlike *Mcdowell*, these cases involved a decal, sticker, or licence plate holder that was affixed to the goods, not a hangtag.

[49] Secondly, CWI disputes the assertion in the underlying decision that the “weight of existing legal authority suggests that such display does constitute use of a trademark in association with goods.” CWI points to the following decisions: *Lavery, De Billy, LLP v Dimatt Investments Inc, Carrying on Business as Genesis*, 2021 TMOB 152 [*Genesis*]; *Moffat & Co v Big Erics Inc*, 2015 TMOB 52 [*Moffat*]; *McMillan LLP v April Cornell Holdings Ltd*, 2015 TMOB 111; *Transport For London v Stiles Clothiers Inc*, 2018 TMOB 67 [*Stiles Clothiers*]; and *6438423 Canada Inc v Consumers Nutrition Center Ltd*, 2009 CarswellNat 5047 (TMOB).

[50] I find the fact scenario of each of the above differs from the facts here. It is trite to say that each decision of the Opposition Board will depend on its unique facts.

[51] In *Genesis*, the goods were men's clothing, accessories, pens, and watches. Many of the goods sold were not made by the trademark holder. The evidence of a witness was that "he has travelled to Italy on behalf of the Owner and GEN-RAM "to bring Canadian customers the latest men's clothing, accessories and jewellery from 'MADE IN ITALY' quality and fashion" manufactured by a number of third parties [emphasis added]." There was also evidence that they "also make and sell 'Made To Measure' and 'Custom Made' men's clothing and accessories."

[52] The trademark owner provided "photographs of clothing and accessories bearing stitched-on labels or hang tags displaying" the trademark at issue. The Opposition Board held that in order for a trademark to be "marked on the goods themselves" it generally has to be displayed on the goods in a permanent fashion. Accordingly, it considered the trademark at issue to be "marked on the goods themselves" for goods bearing an embossed, engraved, or stitched-on label displaying the trademark even if the trademark at issue was "alongside third party trademarks."

[53] On other goods bearing a third-party trademark, the applicant had only affixed hang tags bearing its trademark. It was held that "as the Mark has not been permanently affixed to these goods, I am not satisfied that the Owner has demonstrated use of the Mark on the goods themselves or in association in any other manner, within the meaning of the Act."

[54] In *Genesis*, it was the permanence of the trademark affixed to the goods that led to a finding of use with respect to those goods. This was so even where another trademark was also affixed to the goods.

[55] The differentiation between permanent and non-permanent placement of trademarks on another's goods being critical to establishing use of the trademark on goods was also observed in *Moffat*. There the goods at issue were a variety of products, including sanitation equipment, food service equipment, industrial chemicals, and automotive detailing supplies. At paragraph 29, the Opposition Board describes that permanence is required to find that the mark is displayed on the goods or the original packaging, especially where the goods have a manufacturer's mark affixed:

Generally, a trade-mark displayed on a good in a permanent fashion (typically by the manufacturer) constitutes that trade-mark being "marked on the goods themselves". Similarly, the wording in section 4(1) with respect to "on the packages in which they are distributed" will depend upon the particular circumstances and the normal course of trade involved, but generally contemplates the packaging that the goods are distributed in along the entirety of the chain and not just at one stage.

[56] CWI, referencing the decisions in *Genesis*, *Stiles Clothiers*, and *Positec Group Ltd v Orange Works Kitchen & Home Corp*, 2017 TMOB 141 [*Positec Group*], submits that "*McDowell* has been read narrowly and repeatedly distinguished on its facts, and has been expressly rejected by subsequent decision-makers as standing for any general proposition that a retailer selling the branded goods of other manufacturers may be considered to be 'using' its own mark in association with those goods when it affixes price tags or hang tags bearing its mark to those goods [emphasis added]."

[57] I generally agree with this submission; however, it is with reference to “price tags or hang tags” not to something that is permanently affixed to the goods, which is the case here.

[58] The evidence of GNR is that it has “stickers” bearing the Mark and that its employees attach the stickers to the Goods prior to the sale of the Goods. The Goods are recreational vehicles, and their parts and accessories. GNR is not the original manufacturer of these Goods, but each, when sold, has a sticker on it with the Mark. Examples were provided by GNR. The Goods, or many of them, also have the trademark of the manufacturer or distributor on them.

[59] The fundamental position taken by CWI is that when GNR places its Mark on goods it sells that are manufactured by another and with its trademark attached, the placing of the GNR Mark on it by affixing a sticker to it, does not constitute use of the Mark in association with the Goods. At best, it constitutes use of the Mark with the service of selling the Goods.

[60] I am unable to accept that submission. This Court has found that there is no prohibition on there being more than one trademark on a good. In *AW Allen Ltd v Canada (Registrar of Trade Marks)*, [1985] FCJ No 824 (FCTD), Justice Cullen observed: “The law is also quite clear that there is nothing to prevent two registered trade marks being used at the same time and counsel for the respondent suggested ‘Kellogg's’ and ‘Special K’ as an example.”

[61] In the above example, the two trademarks were both applied by the manufacturer and were its trademarks. However, there is nothing in the Act making this a requirement. In *Bodnar*, for example, the Opposition Board found that the application of a decal on used cars

manufactured by another (and presumably still showing the manufacturer's trademark) constituted use of the trademark in association with those goods. This is consistent with the basic purpose of trademarks, which is to distinguish one's wares in the marketplace, and to protect consumers by communicating what they are purchasing and from whom.

[62] The Supreme Court of Canada in *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, at paragraph 2 observed that this has always been the *raison d'être* of trademarks, although it has expanded from its original purpose:

Merchandising has come a long way from the days when "marks" were carved on silver goblets or earthenware jugs to identify the wares produced by a certain silversmith or potter. Their traditional role was to create a link in the prospective buyer's mind between the product and the producer. The power of attraction of trademarks and other "famous brand names" is now recognized as among the most valuable of business assets. However, whatever their commercial evolution, the legal purpose of trade-marks continues (in terms of s. 2 of the *Trade-marks Act*, R.S.C. 1985, c. T-13) to be their use by the owner "to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others". It is a guarantee of origin and inferentially, an assurance to the consumer that the quality will be what he or she has come to associate with a particular trade-mark (as in the case of the mythical "Maytag" repairman). It is, in that sense, consumer protection legislation. [emphasis added]

[63] The position advanced by CWI appears to be that only an original manufacturer of a good can show use of a trademark affixed to those goods; all others in the supply chain are merely providing a service and any trademark they affix to the goods thereby becomes associated only with their service.

[64] In my view, that is too narrow an interpretation of the Act and the protections it affords trademark owners.

[65] Manufacturing is no less a service than distributing or selling goods. A sign with a trademark on a manufacturer's factory may be evidence of the use of the trademark with the service of manufacturing. Just as a sign with a trademark on a retail store may be evidence of the use of that trademark with the service of selling. However, when each affixes its trademark to the goods being manufactured or sold, that is evidence of the use of that trademark in association with goods.

[66] For these reasons, I find that the Opposition Board's conclusion with respect to the Mark being used in association with the Goods was correct. The evidence is that the Mark was permanently affixed to the Goods (the recreational vehicles) and to the packages containing the parts. That is evidence of use of the Mark in association with the Goods.

B. The Services

[67] GNR submits that the Opposition Board erred in relying on the archived webpages from the Wayback Machine and says that CWI did not meet its evidentiary burden. GNR also submits that the Opposition Board erred as there is nothing which suggests that GNR websites were the sole means of offering the Services.

[68] In short, they say that the Opposition Board misunderstood or misapplied the burden of proof under paragraph 30(b) of the Act.

[69] I agree with CWI that the Betzold affidavit provides no evidence for the use of the Mark with respect to Services as of or before May 3, 2007, save and accept for his attestation of use. The only evidence provided of use of the Mark in association with the Services is from 2012.

[70] CWI submitted evidence using archived webpages from the Wayback Machine that contradicts the Betzold affidavit. Contrary to GNR's claim, the webpages show no evidence of the Trademark being used on the GNR website as of or before May 3, 2007. CWI submits they met their evidentiary burden and the onus is on GNR to demonstrate "use" of the Trademark in accordance with paragraph 30(b) of the Act.

[71] As noted above, an opponent's initial evidential burden under paragraph 30(b) is light. The absence of an applicant's trademark from a website as the date of first use claimed, as demonstrated by archived versions from the Wayback Machine, has been found sufficient to meet an opponent's evidentiary burden under section 30(b), particularly where the goods or services are offered online: see *Zillow Inc v HomeZilla Inc*, 2014 TMOB 131 at paras 12-15 and *Royal Canadian Golf Association v Ontario Regional Common Ground Alliance*, 2009 CanLII 90300 (TMOB).

[72] The Internet archive system Wayback Machine has been accepted by this Court as a reliable source for evidence as to the state of websites in the past: see *Candrug Health Solutions Inc v Thorkelson*, 2007 FC 411 at para 21, reversed on other grounds in 2008 FCA 100.

[73] The only reference in GNR's evidence to the use of the Mark on services as of May 3, 2007, was Mr. Betzold's claim to its alleged display on GNR's website. Given that the Services provided by GNR were services that could be expected to be provided online, the Opposition Board made no error in relying on the archived webpages from the Wayback Machine. Nor did the Opposition Board err in concluding that CWI had met its initial evidentiary proof for the section 30(b) ground of opposition.

[74] GNR submits that "there is no suggestion in the evidence ... that the GNR website was the sole means of offering the Services." This may be true; however, the evidentiary burden is on GNR to demonstrate that it offered Services on or before May 3, 2007, in association with the Mark. The only evidence it offered is at paragraph 12 of the Betzold affidavit wherein he claims that "GNR began providing the Services to existing clients and prospective clients on May 3, 2007 by having its sales representative tell clients and prospective clients about the Services when they came into GNR's retail store and through the Channels of Trade." Simply stating that GNR was providing Services without stating how the Services were associated with the Mark is insufficient to meet its burden of proof. Additionally, the invoices from July 12, 2008 to October 2008, attached as exhibits to the Betzold Affidavit, showing sales of the Services in association with the Mark is insufficient to show use of the Mark in relation to the Services as of the earlier date of May 3, 2007.

[75] Relying on *Norsteel Building Systems Ltd v Toti Holdings Inc*, 2021 FC 927 [*Norsteel*], GNR argues that the burden lies with CWI to establish that GNR made a false statement regarding the date of use and it says that burden has not been satisfied. *Norsteel* is

distinguishable from the case at bar. *Norsteel* concerned an application to invalidate a trademark. In invalidity proceedings, the burden of proof lies with the party seeking to invalidate. In opposition proceedings, such as that here, the opponent bears only a light initial evidentiary burden under paragraph 30(b) to put the ground of opposition into play, and if the burden is met, then the applicant bears the burden of demonstrating on a balance of probabilities that the trademark complies with the requirements of the Act.

[76] I find that the Opposition Board did not err in rejecting the Application for the Mark in relation to Services. GNR failed to provide sufficient evidence to determine, on a balance of probabilities, that it first used the Mark in relation to Services on or before May 3, 2007.

Moreover, GNR did not provide any new or additional evidence substantiating their Application with respect to the Services through subparagraph 56(5) of the Act. There is no palpable and overriding error in relation to Services. This aspect of the appeal must be dismissed.

C. Confusion

[77] CWI opposed the Application on the basis that GNR CAMPING WORLD & Design is confusing with its CAMPING WORLD trademark. CWI accepts that the Opposition Board properly identified the test for confusion under the Act, the relevant factors to be considered, and the applicable jurisprudence. However, it submits that the Opposition Board committed palpable and overriding errors in its assessment and weighing of those factors, all of which, it says, tainted its finding on whether or not confusion was likely.

[78] The test for confusion considers whether as a matter of first impression, “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” would likely be confused; that is, that this consumer would likely think that the other person’s goods or services would be from the same source as those of the owner of the registered trademark: see *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 [*Masterpiece*] at paras 40 and 41.

[79] In analysing whether the trademarks are confusing, all relevant circumstances must be considered, including the factors in subsection 6(5) of the Act:

- | | |
|--|--|
| <p>(a) the inherent distinctiveness of the trademarks or trade names and the extent to which they have become known;</p> | <p>a) le caractère distinctif inhérent des marques de commerce ou noms commerciaux, et la mesure dans laquelle ils sont devenus connus;</p> |
| <p>(b) the length of time the trademarks or trade names have been in use;</p> | <p>b) la période pendant laquelle les marques de commerce ou noms commerciaux ont été en usage;</p> |
| <p>(c) the nature of the goods, services or business;</p> | <p>c) le genre de produits, services ou entreprises;</p> |
| <p>(d) the nature of the trade; and</p> | <p>d) la nature du commerce;</p> |
| <p>(e) the degree of resemblance between the trademarks or trade names, including in appearance or sound or in the ideas suggested by them.</p> | <p>e) le degré de ressemblance entre les marques de commerce ou les noms commerciaux, notamment dans la présentation ou le son, ou dans les idées qu’ils suggèrent.</p> |

[80] The Opposition Board found that CWI's CAMPING WORLD mark has "a low degree of inherent distinctiveness, as it is highly suggestive of the nature of the goods and services being offered by the Opponent, namely, the sale and service of RVs and related accessories which are used for camping." In comparison it found that GNR's Mark "has a higher degree of distinctiveness" finding that "the most striking and dominant element ... is the term 'GNR'." The Opposition Board based this finding on the fact that the term "GNR" is "displayed in the largest font and is the first term read when viewing the Mark."

[81] CWI advances two arguments to support its submission that CAMPING WORLD "is inherently distinctive." The first is that it "has acquired substantial distinctiveness through years of significant sales and marketing to Canadians." The second is its use with respect to RVs and related goods:

While "CAMPING WORLD" may to some extent be suggestive of the camping equipment which CWI offers, the same cannot be said of its RV-related goods and services. "CAMPING WORLD" does not suggest or describe that CWI sells RV-related goods or services. In association with RV-related goods and services the "CAMPING WORLD" trademark has no obvious or plain meaning, and a consumer would have to apply thought, perception, and analysis to arrive at any meaning which may be conveyed.

[82] I accept that the substantial sales made by CWI are relevant when assessing the extent to which a trademark has become known. It goes to the second of the conjunctive phrases in paragraph 6(5)(a) of the Act, but I fail to see that it has any relevance to the first because it says nothing of a trademark's "inherent" distinctiveness.

[83] It is my view, “camping” is a term generally seen as an activity of spending a vacation living in a camp, tent, or camper. Perhaps before the motor age, it was restricted to tents and lean-tos, but with affluence has come the age of motor homes, or camper vans. I am of the view, as I assume was the Opposition Board, that RVs and RV-related goods and services are associated with camping. RVs are frequently parked on campsites, and are often referred to as campers or camper vans.

[84] CWI further submits that the non-distinctive three-letter acronym GNR, the descriptive matter RV CENTRE and WINNIPEG and a generic globe design merely reinforces the same ideas suggested by the CAMPING WORLD element. It is not a proper approach to trademark assessment to look at each of the elements independently. The totality of the elements must be looked at, not each element by itself: see *Consolidated Footwear Co v Genfoot Inc* (1987), 17 CPR (3d) 557. I agree with the Opposition Board that the Mark has some degree of inherent distinctiveness based on a combination of all of the independent elements.

[85] Resemblance is assessed with a consideration of whether there is an aspect of the trademark that is particularly striking or unique: see *Masterpiece* at para 49. The Supreme Court of Canada also stated that resemblance between the trademarks will often have the greatest effect on the confusion analysis.

[86] The Opposition Board found that the striking aspect of CWI’s trademark is the term “CAMPING WORLD” but found that the most striking aspect of GNR’s Mark is the term “GNR” and as a consequence, it concludes:

Thus, while there is a degree of resemblance owing to the common presence of the term “CAMPING WORLD”, in my view, the marks as a whole are sufficiently different in appearance, sound and ideas conveyed that this factor favours the Applicant.

[87] CWI submits that there was a high degree of resemblance of the two trademarks based on the incorporation of CAMPING WORLD in the Mark. It submits that the Opposition Board made a palpable and overriding error because it failed to give the “proper ambit of protection” to CWI’s CAMPING WORLD trademark and “instead focused on the perceived lack of inherent distinctiveness based on incorrect assumptions as to the purported suggestiveness or descriptiveness of ‘CAMPING WORLD’.”

[88] Specifically CWI asserts that “[t]he addition of other generic, descriptive, or non-distinctive elements such as “GNR”, “RV CENTRE”, or “WINNIPEG” is not sufficient to reduce the strong resemblance resulting from taking CWI’s CAMPING WORLD trademark in its entirety.”

[89] This submission ignores that the Opposition Board, appropriately in my view, found that the term “GNR” is the distinctive element of the Mark; whereas CWI’s trademark “CAMPING WORLD” was found to have low inherent distinctiveness as it is “highly suggestive” of the nature of the goods and services being offered.

[90] The Supreme Court of Canada in *Masterpiece* at paragraph 63 observed: “It has been held that for purposes of distinctiveness, the first word is important (see *Conde Nast Publications Inc. v. Union des éditions modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.), at p. 188, *per*

Cattanach J.)” That principle was irrelevant in *Masterpiece* as both competing trademarks had the same first word. That is not so here.

[91] Here the Mark begins with the term “GNR” which the Opposition Board found was its most distinctive element. Although the remaining words of the Mark are identical to CWI’s CAMPING WORLD trademark that is not determinative of the degree of resemblance of the competing trademarks when viewed as a whole. This is particularly the case where the first word of the competing trademark is its distinctive element.

[92] In my view, CWI’s approach amounts to an improper parsing of the words of the competing trademarks. This approach has long been rejected. One example cited by GNR is the decision of President Thorson of the Exchequer Court in *Sealy Products Ltd v Simpson’s Sears Ltd*, 1960 CarswellNat 19, [1956-60] Ex CR 441, 20 Fox Pat C 76, 33 CPR 129, at paragraph 16, referencing his earlier decision:

In the *British Drug Houses Ltd. v. Battle Pharmaceuticals* (1944) Ex. C.R. 239 at 251,(4 Fox Pat. C. 93 at 106), I made the following statement:

It is, I think, firmly established that, when trade marks consist of a combination of elements, it is not a proper approach to the determination of whether they are similar to break them up into their elements, concentrate attention upon the elements that are different and conclude that, because there are differences in such elements, the marks as a whole are different. Trade Marks may be similar when looked at in their totality even if differences may appear in some of the elements when viewed separately. It is the combination of the elements that constitutes the trade mark and gives distinctiveness to it, and it is the effect of the trade mark as a whole rather than of any particular part in it, that must be considered.

The decision in the above case was affirmed by the Supreme Court of Canada, [1946] S.C.R. 50, (5 Fox Pat. C. 135): *vide* also *Re Christiansen's Trade Mark* (1886), 3 R.P.C. 54; *Sandow Ltd.'s Application* (1914), 31 R.P.C. 196; and *Freed & Freed v. Registrar of Trade Marks et al.*, [1950] Ex. C.R. 431, (11 Fox Pat. C. 50).

[93] For these reasons, I find that the Opposition Board's analysis of the degree of resemblance of the competing trademarks was appropriate and without error.

[94] CWI addressed the remaining factors as a group. It submits that none of the remaining confusion factors or surrounding circumstances substantially reduce the likelihood of confusion. It specifically points to the fact that the parties' goods, services, channels of trade, and probable consumers directly overlap as a significant factor weighing in its favour. It says that "this is ordinarily recognized as a very weighty factor in the analysis."

[95] I agree that the Opposition Board may not have expressly considered this factor; however, it was obviously aware that these parties' goods and services and probable consumers overlapped. It is my view that the Opposition Board considered the overlap of the parties' goods, services, and customers when it examined the absence of any proof of actual confusion.

With respect to actual confusion, the Opposition Board stated at paragraphs 60 – 63:

Evidence of instances of actual confusion is not required in order to demonstrate a likelihood of confusion. However, concurrent use of two trademarks without such instances of actual confusion is a surrounding circumstance which can suggest an absence of a likelihood of confusion, depending on the specific nature and duration of that concurrent use.

In this case, the evidence indicates that the Applicant's Mark and the Opponent's trademark CAMPING WORLD have coexisted in the Canadian marketplace since at least 2008 (with both parties

having reasonably substantial Canadian sales since that time), and there is no evidence of record of any instances of actual confusion.

I note that the coexistence of the Applicant's Mark with the Opponent's trademarks has little, if any, relevance to the section 16(1)(a) and (b) grounds of opposition for which the material date is the Applicant's date of first use of the Mark. However, the Applicant's evidence demonstrates that the Applicant and its predecessors have been using trademarks which include the terms "GNR" and "CAMPING WORLD" in Canada since at least as early as 1976. While these earlier trademarks were not identical to the Mark which is the subject of this proceeding, they nevertheless included the term "CAMPING WORLD" which is the basis for the Opponent's confusion allegation in this case.

The above facts suggest that, at least in this case, the mere presence of the term "CAMPING WORLD" as a component of the Applicant's Mark is not sufficient to give rise to a likelihood of confusion. This is a surrounding circumstance which favours the Applicant.

[emphasis added and citations omitted]

[96] The analysis of the Opposition Board was appropriate and contained no palpable and overriding error warranting its reversal. Its conclusion, stated at paragraph 64, is justified based on its analysis:

Taking into account all of the relevant factors set out above, and particularly in view of the low degree of inherent distinctiveness of the Opponent's trademark CAMPING WORLD, the limited degree of resemblance between the parties' marks as a whole, and the absence of any instances of actual confusion despite many years of coexistence, I am satisfied that the Applicant has met its legal burden of demonstrating on a balance of probabilities that there is no likelihood of confusion.

9. Conclusion

[97] Both appeals will be dismissed. The parties proposed that if that were the result, then each party should bear its own costs. I agree.

JUDGMENT in T-1561-20 and T-1575-20

THIS COURT'S JUDGMENT is that the appeals in both files are dismissed, and each party shall bear its own costs.

"Russel W. Zinn"

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-1561-20 AND T-1575-20

STYLE OF CAUSE: G N R TRAVEL CENTRE LTD. v CWI, INC.

PLACE OF HEARING: HELD BY VIDEOCONFERENCE

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DATED: JANUARY 4, 2023

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