

Year in Review: 2013 Survey Evidence

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This publication catalogues references to survey evidence in decisions by Canadian courts and regulators with respect to intellectual property and other legal matters between January 2013 and December 2013.

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Surveys in Trade-mark Cases – Trade-Marks Opposition Board

1. *Dollar Tree Stores Canada, Inc (Re), (Docket 1,330,832; 1,330,833), 2013 TMOB 25 (CanLII). January 23, 2013*

In January 2007, Dollar Giant Store (B.C.) Ltd. (the Applicant) filed an application to register the trade-mark DOLLAR GIANT NOTHING OVER A DOLLAR \$1 as well as the Design (the Mark), which included the following colour claim:

"Colour is claimed as a feature of the Trade Mark. The design consists of a concentric circle. The innermost circle contains the dollar amount \$1 shown in yellow and it is outlined in black. The innermost circle has a green background and it is outlined in black. The outermost circle contains the words DOLLAR GIANT in green lettering and the words NOTHING OVER A DOLLAR in black lettering. The outermost circle has a yellow background and it is outlined in black." [1]

The Applicant claimed use of the Mark in Canada since July 2001 in the operation of retail stores in the field of general merchandise, described as home decor products, home furnishings, and household products amongst others.

Dollarama LP (the Opponent) filed a statement of opposition in January 2008 arguing, in part, that the Mark was confusing with one or more of its marks or those of its predecessor in title, based on the Opponent's claim of using the colours green and yellow as distinctive features of its marks.

[42] *As a surrounding circumstance the Opponent seeks to rely on its long standing use of a green and yellow colour scheme and the adoption of identical shades of these colours by the Applicant. Given the similarity of the Mark and the Opponent's DOLLARAMA Polygon Design Trade-mark, the use of a more or less similar get-up would not affect my ultimate finding and as such I do not consider this to be a significant surrounding circumstance in this case.*

The Opponent filed the affidavit of a survey expert who conducted a survey and provided "evidence regarding consumer perceptions of various colour blocks including either green and yellow, red and yellow or the Applicant's trade-mark no.1,330,833 [...] [44]"

[43] *The Opponent also filed as part of its evidence the affidavit of [...] a survey expert. The Supreme Court in Masterpiece found that in trade-mark confusion cases, where the test for confusion is to be applied from the perspective of a casual consumer who is not particularly skilled or knowledgeable, expert testimony will generally not be necessary (at para 80). The Supreme Court held that where goods are marketed to the general public for ordinary use, as they are in the present case, the determination of confusion can be made by decision makers by giving effect to their own opinions as to the likelihood of confusion. Furthermore, the Supreme Court held that surveys can provide empirical evidence demonstrating consumer reactions in the marketplace, which would generally not be known by the decision maker. The Supreme Court held that in order to satisfy the R v Mohan, 1994 CanLII 80 (SCC), [1994] 2 SCR 9 (SCC) requirement of relevance the survey must be both reliable and valid.*

[45] *The Applicant submits that the survey is not relevant since it does not provide any findings with respect to confusion between the Mark and the Opponent's registered trade-marks. I agree. The survey does not assist me in making a determination regarding confusion since a determination of*

confusion as between the colour block yellow and green, or application No. 1,330,833 and the Mark is not necessarily a reliable indicator of the issue of confusion between the Mark and the DOLLARAMA Polygon Design Trade-mark (or any of the Opponent's registered marks).

The Board found that there was a reasonable likelihood of confusion between the Marks, based on the similarity of shape, layout and the predominant use of the colours green and yellow; and ultimately upheld the opposition.

2. Canadian Generic Pharmaceutical Association (Opponent) v. Pfizer Products Inc. (Applicant), (Docket 1,244,118), 2013 TMOB 27 (CanLII). January 23, 2013.

In January 2005 the Applicant, Pfizer Products Inc., applied to register the trade-mark, MISCELLANEOUS THREE DIMENSIONAL DESIGN (previously VIAGRA TABLET DESIGN). The application was based on Pfizer's use of the trade-mark in Canada since March 1999 for a medication used for the treatment of sexual dysfunction (the Wares). The Application included mention that the trade-mark "*consists of the colour blue as applied to the whole of the visible surface of the tablet...*" [1]

The Opponent, the Canadian Generic Pharmaceutical Association, filed a statement of opposition in March 2006, based on the *Trade-marks Act, RSC 1985, cT-13*, including section 38(2)(d) which specifies "that the trade-mark is not distinctive".

The Applicant filed a counter statement denying the grounds of opposition and provided expert evidence and previously commissioned survey evidence in support of its counter claim.

[26] *As part of its evidence concerning the issue of distinctiveness, the Applicant filed the affidavit of [...] a survey expert. Her affidavit attached a previous affidavit that she had sworn in the oppositions to application Nos. 883,145, 886,243 and 883,144 for the VIAGRA BLUE TABLET DESIGN (for 25, 50 and 100 mg tablets respectively). The affidavit filed in the previous cases attaches a survey of pharmacists undertaken in 2002. In order to be admissible, expert evidence must meet the four criteria set out in R v Mohan, 1994 CanLII 80 (SCC), [1994] 2 SCR 9 (SCC):*

- *relevance;*
- *necessity in assisting the trier of fact;*
- *absence of any exclusionary rule; and*
- *from a properly qualified expert.*

[27] *I do not find that the evidence of [the survey expert] is relevant to the assessment of distinctiveness at the material date of March 6, 2006. The survey of pharmacists was conducted between September 9 and October 8, 2002 (Exhibit B, page stamped 1716). It involved showing 402 pharmacists eight pharmaceuticals, including VIAGRA, with markings removed (Exhibit B, pages stamped 1717-1718). For each pharmaceutical, respondents were asked to indicate whether it was made by one company or more than one company (Exhibit B, page stamped 1718-1719). The survey purports to provide evidence that the colour, shape and size of VIAGRA is recognized by more than three quarters of pharmacists as indicating a single manufacturing source (Exhibit B, page stamped 1713).*

[28] *In her cross-examination, [she] indicates that the 2002 results are relevant to 2006 since her experience with well-marketed products means awareness would increase as a product becomes*

entrenched (Qs 20-23, 38) and this would be the case even if another blue diamond pill had been introduced (Qs 43-45). [Her] answers to Qs 27-33 appear to indicate that [her] statements with respect to distinctiveness in 2006 may be limited to VIAGRA's distinctiveness regarding medications that treat erectile dysfunction. However the relevant marketplace is all pharmaceuticals [Novopharm Ltd v Pharma reflex, (2005), 48 CPR (4th) 455 (TMOB) at 468].

The Board found there was insufficient evidence to show that pharmacists used the Mark "[...]as one of the primary characteristics by which VIAGRA tablets are distinguished from the Wares of others. Rather it appears that the DIN, name of the drug and dosage, and UPC on the cardboard box are used during the dispensing process [...]" [93]

[94] *If I had found the [...] survey admissible, I would have found that it supported the fact that the Mark was recognized as being unique and as such was recognizable to pharmacists as being associated with VIAGRA brand tablets manufactured by one company. However, it is not clear that this evidence is sufficient to meet the criteria stated [...] since the evidence shows that pharmacists primarily use other means to distinguish pharmaceuticals from one source as being from another source. As such, I am left in a state of doubt as to whether the Mark is distinctive amongst pharmacists."*

Surveys in Trade-mark Cases – Federal Court of Canada

3. *Cheah (Applicant) v. McDonald's Corporation (Respondents)*, (Docket T-228-13), 2013 FC 774 (CanLII). July 10, 2013.

In February 2007 the Applicant applied to register the word MACDIMSUM for proposed use in association with a large number of food and drink items. That application was denied in July 2012 by the Trade-marks Opposition Board (2012 TMOB 138 (CanLII)) and the Applicant filed an appeal from the decision.

The Respondents (McDonald's Corporation) opposed the registration of the trade-mark on the grounds that MACDIMSUM *"is confusing, with a large number of trade-marks referred to as a "family" of trade-marks registered and used by McDonald's in Canada in association with foods and drinks and restaurant services. These are referred to in argument as the MC plus food item, or MAC plus food item, marks. It is argued that the public does not distinguish between MC and MAC for this purpose. I have no evidence before me that would serve to disabuse me of that conclusion."* [5]

McDonalds commissioned a survey designed to test confusion as part of its evidence and submitted the affidavit of *"a survey expert. He conducted surveys in which members of the Canadian public were shown a card bearing the word MACDIMSUM, and, in another survey, different persons were shown a card bearing the word MAZDIMSUM. They were asked various questions. The results led [him] to the conclusion that a statistically significant proportion of consumers would identify McDonald's as the source of certain listed food products (as those listed in the application at issue) with the name MACDIMSUM. He reached other conclusions, as well."* [6]

In the original decision, the Board found the survey evidence reliable. The Court revisited the use of the evidence and sought to answer whether the survey evidence was flawed or improperly relied upon. The Court upheld that while the survey supported conclusions of confusion *"the survey was not the principal reason upon which the [TMOB] Member arrived at his conclusion as to confusion."* [25]

On the use of survey evidence, the Court remarked:

[26] *The Court has been suspect as to the growing use of and reliance upon surveys in proceedings such as this. The remarks of Rothstein J, in the Supreme Court of Canada decision in Masterpiece Inc v Alavida Lifestyles Inc, 2011 SCC 27 (CanLII), [2011] 2 SCR 387 at paragraphs 78 to 101, stating that survey evidence should be used with caution and not supplant the role of the judge, are apt.*

[27] *Nonetheless, in this case, the manner in which the Member used the survey evidence in this case cannot be faulted.*

The appeal was dismissed by the Court.

Other applications of survey evidence

4. **McEwing (Applicant) v. Canada (Attorney General) (Respondent), (Dockets T-621-12; T-619-12; T-620-12; T-634-12; T-635-12; T-633-12) 2013 FC 525(CanLII). May 23, 2013.**

This case involved eight voters, the Applicants, from six electoral districts across Canada who claimed to be victims of voter suppression and as a result, sought to have the results of the 2011 General Elections annulled in their ridings. They claimed voter suppression in the form of telephone calls to voters providing false information about the location of polling stations the day before the vote.

[4] *The evidence presented in these applications points to a concerted campaign by persons who had access to a database of voter information maintained by a political party. It was not alleged that any of the candidates of that party, including those who were successful in the six ridings at issue, were responsible for this campaign but that others took it upon themselves to attempt to influence the election results in their favour.*

...

[6] *The central issue to be determined in these proceedings was the effect the calls had, if any, on the election results in the six subject ridings. If satisfied that the calls affected the result in one or more of the ridings or called into question the integrity of the electoral process, the Court may annul the outcome in that riding or ridings. For the reasons that follow, I find that electoral fraud occurred during the 41st General Election but I am not satisfied that it has been established that the fraud affected the outcomes in the subject ridings and I decline to exercise my discretion to annul the results in those districts.*

The Applicants commissioned an expert to investigate through the use of a survey:

- [128]
- a. *to what extent may certain voter suppression techniques have been used to influence the outcome of the 2011 election in the six ridings in question?*
 - b. *did any voter suppression activities found to have taken place deliberately target electors who were supporters of a particular political party or parties?*

- c. *were any such voter suppression techniques and activities effective in discouraging those who would have otherwise voted from casting a ballot?*

[129] *[A survey was conducted] between April 13 and 19, 2012 using Interactive Voice Response (IVR) technology, which selects respondents through random digit dialing (RDD) and allows respondents to enter their responses through the use of the keypad on their telephones rather than speaking with an interviewer. The results of the survey, analysis and conclusions were presented in a report, completed on April 23, 2012 and revised on October 24, 2012, which was attached as an exhibit to [the survey expert's] affidavit and tendered as expert opinion evidence.*

[130] *To be admissible, expert opinion evidence must meet the four part test set out in R v Mohan 1994 CanLII 80 (SCC), [1994] 2 SCR 9, [1994] SCJ No 36 (QL) [Mohan], at para 17: Admission of expert evidence depends on the application of the following criteria:*

- (a) relevance;*
- (b) necessity in assisting the trier of fact;*
- (c) the absence of any exclusionary rule;*
- (d) a properly qualified expert.*

The Respondents challenged the Applicant's expert on the fourth point, namely his qualifications as an expert and alleged "*partiality or bias*" [131].

The Court did not dispute the value of survey evidence in this case, noting that it has been used in Canada "*to determine the effect of voter registration rules on vulnerable populations, [...]has been admitted in a number of other contexts involving other public policy issues [...], [and has] also been used in trade-mark confusion cases where it is impractical to call hundreds of witnesses [198].*"

[199] *The respondent MPs contend that the [applicant expert's] Survey is inadmissible hearsay as it is tendered for the purpose of establishing contested facts, namely the proof that actual voters were prevented from voting. The applicants, they argue, do not merely use it as evidence that there was a program of voter suppression, but as evidence that this program was effective and did suppress voters.*

[200] *The applicants submit that in dealing with fraud preventing voting, there is no readily available way to count the electors who did not vote other than through such a survey. They rely on the statements by the Supreme Court in Opitz at paragraphs 23 and 72 that the assessment under s 524 cannot involve an investigation into voters' actual choices and that the evidence must not compromise the secrecy of the ballot. The only reasonable alternative, they submit, was for a qualified professional to conduct a survey.*

[201] *In my view, there was no question that the survey evidence was relevant. I concluded that it was admissible in support of [the applicant expert's] opinion subject to the principles set out in Mattel, above, that it was properly designed and conducted in an impartial manner. I found that the survey was "both reliable (in the sense that if the survey were repeated it would likely produce the same results) and valid (in the sense that the right questions have been put to the right pool of respondents in the right way, in the right circumstances to provide the information sought)": Mattel, para 45. The weight to be given to it remained to be determined.*

[...]

- [208] *Acknowledging the limitations of the study, the [...] Survey concludes, among other things, that:*
- a. *The evidence strongly suggests that there was a targeted program of voter suppression in place in the subject ridings. Based on the survey samples, it appears that tens of thousands of voters were targeted.*
 - b. *These activities were clearly targeted at non-CPC voters in a manner that is highly improbable to have happened by chance. They included false reports of polling station changes and faux calls claiming to be from Elections Canada. In fact, Elections Canada made no such calls and there were virtually no voting station changes, yet many thousands of voters in the six ridings claim to have received these calls.*
 - c. *Exposure to these calls clearly had a dampening effect on propensity for non-CPC supporters to vote. [The Survey] estimated the effect in the range of 1.0%. Applying a margin of error to those estimates would produce a band of 0.8% to 1.8%. In other words if these actions had not been in place, the CPC advantage would have been reduced by this amount on average in these six ridings.*

[...]

[213] *The [...] Survey acknowledged the difficulty of estimating the actual number of electors deterred from voting in consequence of receiving such a call. It states:*

Assessing causal impacts is an exceedingly complex problem and this research cannot provide definitive estimates of the size of the causal impacts. It does, however, provide a reasonable basis for estimating these impacts.

[214] *The survey asked respondents to report whether they failed to vote as a result of getting such a call. The results indicated that more respondents from the comparison group reported being deterred from voting as a result of receiving a call indicating that the polling station location had been changed. [The expert's] opinion was that this made sense because eligible voters in "swing" ridings have more incentive to vote and are thus less easily dissuaded from voting than voters in party strongholds, which were better represented in the comparison group.*

[215] *One of the difficulties with the survey evidence, however, is that some of those who reported having been discouraged from going to the polls had previously indicated that they had in fact voted. This inherent conflict in the results was never explained to my satisfaction.*

[...]

The Respondents commissioned the opinion of an expert witness in critiquing the Applicants' survey.

[221] *[The Respondent's expert] conceded that the self-reported non-voting activity disclosed by the [Applicants] Survey, if taken at face value, establishes that some voters were deterred from voting. However, the survey failed to address essential standards of statistical reliability, in her view, and the results could not, therefore, be generalized to any conclusions about the population at large. She asserts that nothing could be concluded from the survey with respect to the incidence of voter suppression phone calls or any cause-effect relationship between such phone calls and any outcomes of the 2011 federal election.*

[222] *The IVR polling technology may be useful for some specific applications, [the Respondent's expert] acknowledges. But it is a highly impersonal survey technique with very low response rates and remains controversial within the industry. In the manner used in the [Applicant's] Survey, [she] states, it permits no verifiable control over who answers the survey. She criticized its use in this instance on a number of grounds including the following:*

- *Survey results require validation, normally through a 10% call-back to confirm responses; this was not done. There was no live follow-up.*
- *The survey was performed 11 months after the election when people's memories had faded. Memories are suggestible and the respondents may have accidentally filled in details from media reporting after the fact.*
- *There were numerous sampling errors in the survey; for instance, cell phone users were not surveyed, because according to [the Applicant Expert Witness'] hypothesis, cell phones were not targeted for misleading calls.*
- *The youngest age category offered was "under 25", which did not screen out people under 18 who were not eligible to vote. There was over-representation of women and under-representation of Conservatives.*
- *A ticket in a \$500 prize draw was offered for completing the survey, so people may have just pushed random buttons to get through and get their chance at the prize.*
- *Finally, the survey questions were confusing.*

[223] *I note that call-backs to verify the information received would run counter to the concern expressed by the Supreme Court that efforts to establish causal effects must not breach ballot secrecy. One of the features of the IVR approach was that the respondents were assured anonymity. While there were multiple call backs to obtain a response, [the Applicant survey] did not thereafter attempt to verify the responses received from those reporting non-voting behaviour. [The Respondent's expert witness] views this as a weakness but it is a point that would be problematic in any live survey that could not assure anonymity.*

[224] *[The Respondent expert witness] challenges [the Applicant expert witness'] assertions that the survey provides a reasonable basis for estimating the impact of the calls. She states that there is no scientifically defensible basis for estimating or inferring causal impacts from the report. Following a detailed analysis of the discussion of the results in the [Applicant] Survey, she found the explanations "subjective, predisposed to a hypothesis of voter suppression, and inconsistent with rigorous statistical reasoning for determining cause-and-effect."*

Ultimately the Court accepted the Applicant survey but dismissed the applications to have the results of the 2011 General Elections annulled in the Applicants' ridings.

5. *Tim Magill (Plaintiff) v. Expedia, Inc. and Expedia Canada Corporation (Defendants), (Docket 09-CV-381919CP), 2013 ONSC 683 (CanLII). January 31, 2013*

This case involved the certification of a class action against Expedia Canada Corporation and its parent company Expedia, Inc. (the Defendants) brought on by the Plaintiff on behalf of the 1.5 million Canadians who used the www.expedia.ca website annually to book accommodation. The action alleges

the Defendant charges customers, without their knowledge, "service fees when for which it is not entitled".

The Plaintiff, for the purposes of certification, "advances claims or causes of action for breach of contract, unjust enrichment, and contravention of the Consumer Protection Act, 2002 and the Competition ." [90]

[125] *The Defendants submit that in the case at bar there is no evidence that anyone other than Mr. Magill seeks to assert a claim against the Defendants, and they rely on a line of authority that establishes the proposition that the plaintiff has to establish there are enough persons willing to pursue a claim to make the whole process of a class proceeding worthwhile.*

[126] *This line of authority establishes that class action legislation is designed to provide an effective means of resolving situations where two or more people have the same or similar complaints, not to create complaints where none exist, and there must be some evidence that two or more people have a complaint that they would wish to have prosecuted[...] There must be an air of reality between the plaintiff's claim and the proposed class and an indication that the proposed class has claims that they would wish to have prosecuted [...]*

[130] *In the case at bar, it emerged during argument that the Defendants were urging on the court the approach that the requirement in s. 5 (1)(b) of the Class Proceedings Act, 1992 that there is an identifiable class of two or more persons be used as a gatekeeper mechanism to filter out class actions that would have no social utility as demonstrated by the fact that there appeared to be none or too few putative class members interested in achieving access to justice or alternatively in achieving the behaviour modification of the defendant. The Defendants submitted that the evidentiary record in the case at bar demonstrated the phenomenon that the putative class members had no interest in pursuing claims against Expedia Inc., and, therefore, Expedia Inc. should not be required to undergo the extensive process of defending a class action.*

[131] *However, the approach suggested by the Defendants about the requirement in s. 5 (1)(b) that there is an identifiable class of two or more persons is problematic. Social utility is not a juristic element and is more a matter of policy or political debate. Measuring social utility would be difficult and it would be inconsistent with the design of the certification criteria, which are not designed to probe the social utility of any particular class proceeding any more than they are to probe the merits of the proposed class action.*

[132] *Using numerosity [sic] as a measure of social utility is also unreliable. Particularly where putative class members have very small individual claims, the social utility of the class action becomes debatable, because it will be behaviour modification that will be the rationale for the class action. Where the claims are small, the number of interested claimants provides little reliable information. From an access to justice prospective class members may be indifferent to the class action; indeed, putative class members may have good reason to be indifferent because even their small claims may be distributed cy-pres.*

[133] *Also problematic is that were the court to vigorously impose numerosity as a precondition to the certification of a class action, one can anticipate that plaintiffs and defendants will, practically speaking, conduct campaigns for supporters or opponents to certification of the class action. In this regard, it*

would appear that that is what the Defendants attempted to do in the case at bar by commissioning survey evidence [...] about the attitudes of putative class members. However, the certification of a class action is not an election campaign, but a juridical exercise of determining whether certain criteria specified by the Legislature have been satisfied.

[134] It must be kept in mind that the certification criteria are designed to filter out claims which as a matter of procedure are not suitable for a class action. The certification criteria do not involve an evaluation of the merits or likely merits of the plaintiff's claim. Although the certification criteria may involve some analysis of the social utility of a class action because of the underlying policies of promoting access to justice and of encouraging behaviour modification, and although as the line of cases mentioned above demonstrate, the criteria will from time to time filter out a class action that has no social utility, the criteria remain procedural and juridical, and the pre-conditions to certification are not meant to determine the merits or the social utility of the proposed class action.

The court granted a motion of certification of the Defendant's class action.

6. *Empresa Cubana Del Tabaco (Applicants) v. Tequila Cuervo, S.A. Dec. V. (Respondent), (Docket T-1867-08) 2013 FC 1010 (CanLII). October 4, 2013.*

This case deals with an appeal of a decision stemming from a January 2007 Empresa Cubana Del Tabaco (referred to as Habanos or the Applicants) opposition to a trade-mark application filed by Tequila Cuervo, S.A. Dec. V. (Cuervo or the Respondent) in February 1996 to register the trade-mark LAZARO COHIBA based on proposed use in Canada with “alcoholic beverages, namely rum”.

The Applicant's opposition to the registration of the trade-mark was on various grounds, but most important in the 2013 appeal was the claim that the “*mark was not registrable based on likelihood of confusion with Habanos's COHIBA registered trade-marks.*” [2]

Habanos's registered trade-marks included COHIBA (in association with Wares including Leaf tobacco, manufactured tobacco for smoking and chewing, snuff and cigarettes) and COHIBA LA HABANA CUBA (in association with Wares including raw tobacco, cigars, cigarillos, cigarettes, cut tobacco, tobacco pipes, ashtrays, match boxes and cigar cases and humidors amongst others).

In 2008, based on evidence filed by and arguments made by both parties, the Trade-marks Opposition Board rejected all of the Applicants' grounds of opposition. The decision highlighted the differences between the wares and trades of “*the parties and the fact that the opponents have not established an extensive reputation for their marks...[the Respondent] has satisfied the onus to show, on a balance of probabilities that its mark is not confusing with the two registered marks relied on by the opponents.* [10]”

In the appeal, Habanos (the Applicants) submitted “substantial” new evidence, including expert testimony on brand identity, pop culture and COHIBA's status as an iconic brand (including media content, television shows, and films in which COHIBA appears); an expert affidavit stating that users of

tobacco and alcohol often consume both products; and an affidavit of an articling student who conducted a telephone survey of 15 restaurants or clubs demonstrating that these institutions served both products; as well as several other pieces of testimony and expert opinions.

The Court allowed the submission of all of the new evidence with the exception of the articling student's affidavit detailing his telephone survey of restaurant and club owners, on the grounds that the "[...] Affidavit is simply too unreliable to be admitted." [18]

Further on the subject of survey evidence,

[39] *The Applicants could have done more to establish direct knowledge of the COHIBA brand; they could have carried out a survey of Canadian consumers. However, the strength of the references and of the opinion of [the Applicant's expert witness on brand identity and pop culture] satisfies me that the COHIBA brand is well known in Canada. There is no doubt in my mind that television shows such as "Sex and the City" and "The Simpsons"; the magazine "Cigar Aficionado"; and the movie "Hotel Rwanda" were widely seen by Canadians. Similarly, Canadians have listened to the music available in the United States. Surveys to establish the fame of the COHIBA brand in Canada, in this case and in view of the strength of the evidence before me, are not necessary.*

The Court concluded based on the evidence submitted to the TMOB and the new evidence submitted on appeal, the test for confusion was met and likelihood of confusion was apparent, "the casual consumer, somewhat in a hurry, seeing the applied-for mark on a bottle of rum, would be likely to think that that the rum was from the same source as COHIBA-brand tobacco products." [45]

Noted absence of survey evidence

7. Continental Teves AG & Co (Applicant) v. Canadian Council of Professional Engineers (Respondent), (Docket T-789-12) 2013 FC 801 (CanLII). July 23, 2013.

This case was an appeal from a January 2012 decision of a Hearing Officer of the Trade Marks Opposition Board where the Applicant sought, and was refused, the registration of the words ENGINEERING EXCELLENCE IS OUR HERITAGE for "brake pads for land vehicles, brake rotors for land vehicles".

[3] *The application was based on use in Canada by that corporation since at least as early as January 31, 2007 and claimed priority from an application filed in the United States of America by that corporation on March 1, 2007.*

[4] *The application was assigned by that US corporation to the Applicant in this appeal, Continental Teves AG & Co. oHG, by a document signed by the US corporation on February 9, 2009; and by the Applicant on August 8, 2008. The assignment stated that it was nunc pro tunc effective as of March 1, 2007, which was the date of filing the US application; hence, the Canadian priority date.*

The Respondent Canadian Council of Professional Engineers (CCPE) filed an Opposition to the registration of this trade-mark on in May 2008, on a number of grounds.

Both the Applicant and the Opponent filed as evidence affidavits on the use of the word ENGINEERING in various contexts.

The original application was denied on the grounds that: *“the trade-mark is not registrable because, as set out in s. 12(1)(b), it is clearly descriptive or deceptively misdescriptive of the character or quality of the wares in association with which it is used or proposed to be used, or of the persons employed in the production of the wares. Without limiting the generality of the foregoing, in view of the fact that the applied-for trade-mark includes the term “engineering”, which is regulated in Canada, it follows that:*

- i. *if members of the profession of engineering in Canada are involved in the production of the wares, the applied-for mark is clearly descriptive of both the character and quality of the wares and of the persons employed in their production;*
- ii. *if members of the profession of engineering in Canada are not involved in the production of the wares, then the applied-for mark is deceptively misdescriptive of both the character and quality of the wares and of the persons employed in their production. [5]*

[10] *The Hearing Officer refused the application. The Officer found [...] that the mark cannot be found to be clearly descriptive of the persons employed in the production of the wares in question; brake pads and rotors. The Officer found [...] that the mark was deceptively misdescriptive of the persons employed in the production of the wares [...]*

[11] *In brief, the Officer held that the mark was unregistrable because it was deceptively misdescriptive and did not distinguish the Applicant’s wares from those of others.*

In the Appeal, the Court found that *“what we don’t have is as important as what we do have [29]”* and noted the absence of survey evidence in the original application and the appeal.

[31] *Importantly, we have no evidence as to what members of the public in Canada actually think when confronted with the use of words such as “engineering” and the like; whether on wares, services, or otherwise. While the use of surveys has, in my view correctly, been disparaged by the Supreme Court of Canada in Masterpiece Inc v Alavida Lifestyles Inc, 2011 SCC 27 (CanLII), [2011] 2 SCR 387, as it was getting well out of hand, there are many ways besides expensive surveys in which the Court may be informed as to actual public reaction.*

[32] *Here, the Hearing Officer and the Court, relying only on fragments from the internet and the like, are left to determine whether the mark at issue is “distinctive” or “clearly descriptive” or “deceptively misdescriptive” with lawyers for the parties adding their rhetoric in an endeavour to pull the decision-maker this way or that.*

Ultimately the Court upheld the decision of the Trade-marks Opposition Board.