



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2013 TMOB 101
Date of Decision: 2013-05-22

**IN THE MATTER OF AN OPPOSITION
by Asset Inc. to application No. 1,427,129
for the trade-mark REPO.COM--SMALL
ENOUGH TO CARE--LARGE
ENOUGH TO GET THE JOB DONE in
the name of Dot Net Support Inc.**

Introduction

[1] This opposition relates to an application filed by Dot Net Support Inc. (the Applicant) on February 9, 2009 to register the trade-mark REPO.COM--SMALL ENOUGH TO CARE--LARGE ENOUGH TO GET THE JOB DONE (the Mark) in association with:

operation of a retail dealership for repossessed property, namely trucks, cars, vans, minivans, sport utility vehicles, boats, recreational vehicles, snowmobiles, motorcycles, aircraft, and real estate (the Services).

[2] The grounds of opposition raised by the opponent Asset Inc. (the Opponent) are based on sections 30(e), 30(i), 12(1)(d), 16(3)(a) and 2 (distinctiveness) of the *Trade-marks Act* RSC 1985, c T-13, (the Act). The specific grounds of opposition are detailed in Schedule A annexed to this decision.

[3] The first issue is to determine if the Opponent has furnished sufficient evidence to support its grounds of opposition. Secondly I have to decide if the Mark is likely to cause confusion with the Opponent's registered Trade-marks (as defined in paragraph 14) which all contain the term REPO. On the first issue I conclude that the Opponent has failed to meet its

evidential burden with respect to the grounds of opposition based on sections 30(e), 30(i), 16(3) and 2 (distinctiveness). Finally I conclude that the Applicant has met its evidential burden to prove, on a balance of probabilities, that the Mark is registrable as it is not confusing with any of the Opponent's registered Trade-marks.

Legal Onus and Burden of Proof

[4] There is an initial evidential burden on the Opponent to file sufficient admissible evidence from which it could reasonably be concluded that there exist sufficient facts to support each ground of opposition pleaded. If those facts exist, then the Applicant must show that the application complies with the provisions of the Act and the grounds of opposition raised by the Opponent should not prevent the registration of the trade-mark applied for [see *Joseph E Seagram & Sons Ltd et al v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) and *Wrangler Apparel Corp v The Timberland Company* [2005] FC 722].

Grounds of Opposition based on Sections 30(e), 30(i), 16 and 2 (distinctiveness)

[5] The Opponent's evidence in the record consists only of the affidavit of Ms. Cindy Shattler, an administrative assistant employed by the Opponent's agent firm. She conducted a search of the Canadian Intellectual Property Office database and provided printouts of the Opponent's registrations. It does not contain any facts that would support grounds of opposition based on sections 30(e), 30(i), 16(3) and 2 (distinctiveness) of the Act. They are therefore dismissed as the Opponent failed to meet its initial burden of proof.

[6] I wish to address the Opponent's argument that the Applicant could not have stated, when it filed its application (February 9, 2009), that it intended to use the Mark in association with the Services as the Applicant was not a dealer or was not operating under a dealer licence to perform the Services as required under the *Motor Vehicle Dealers Act, 2002*.

[7] To sustain this ground the Opponent relies on a previous decision rendered by the Registrar on November 30, 2010 in an opposition involving the same parties: *Asset, Inc v Dot Net Support Inc.*, 2010 TMOB 206. In that decision the Registrar referred to statements made by

the Applicant's President, Mr. Boman, during his cross-examination where he stated that the Applicant was not a dealer and was not operating under a dealer licence at that time.

[8] The Opponent has not filed as part of its evidence in this opposition the transcript of that cross-examination. We have no evidence as to when that cross-examination was held. I cannot, as suggested by the Opponent, import findings of facts made in another file and hold them against the Applicant in this file.

[9] The Opponent cites the decision of the Registrar in *Bacardi & Co v Corporativo De Marcas GJB, SA DE CV*, (2012), 99 CPR (4th) 244 (TMOB) to support its contention that the Opponent can meet its initial burden by referring to a prior decision of the Registrar. In that decision, the opponent filed certified copies of a decision of the Registrar in a section 45 proceeding and certified copies of the affidavits filed by the registrant. As such my colleague Jill W. Bradbury was able to refer to portions of the affidavit evidence to substantiate her finding of non-use of the mark in issue at the claimed date of first use and therefore concluded that the opponent had met its initial burden with respect to a section 30(b) ground of opposition. In our case the evidence filed before the Registrar in *Asset, Inc* above is not part of the record.

[10] The Opponent argues that the burden was on the Applicant to prove that, at the time it filed its application, it had the proper licence to offer the Services since a previous application was refused on that basis. Firstly, as stated earlier, the initial burden is on the Opponent to submit facts that would support its grounds of opposition. The reference to a prior decision does not evidence the facts described in that earlier decision. Also, as pointed out by the Applicant, the prior application was based on use while the present application is based on proposed use.

[11] As for section 30(i) of the Act, it only requires the Applicant to declare that it is satisfied that it is entitled to use the Mark in Canada in association with the wares and services described in the application. Such a statement is included in this application. An opponent may rely on section 30(i) in specific cases such as where fraud by the applicant is alleged [see *Sapodilla Co Ld v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. There is no allegation of that nature in the statement of opposition or any evidence in the record to that effect.

[12] The Opponent argues that the finding of fact made by the Registrar in *Asset Inc* above, that the Applicant was not a dealer is sufficient to meet its initial burden of proof under section 30(i) of the Act. According to the Opponent, the Applicant could not have stated at the time of filing of the present application that it was satisfied that it was entitled to use the Mark as it did not have the dealer licence required to perform the Services.

[13] Firstly, there is no evidence before me that the Applicant did not have the dealer licence it required to perform the Services at the filing date of this application. Specifically, Mr. Boman did not state in his affidavit that the Applicant is now a dealer and is operating under a dealer licence. In the absence of such statement, the Opponent would like me to infer that the Applicant is still not a dealer or is not operating under a licence. I am not prepared to make that inference. The Opponent chose not to file any evidence to support this ground of opposition. Consequently the Applicant was under no obligation to make any statement about its business activities. Secondly, since this application is based on proposed use, the Applicant could still have filed its application without having the proper requirements to provide the Services and obtain afterward whatever licence is necessary to perform the Services.

Registrability of the Mark under Section 12(1)(d) of the Act

[14] The Opponent argues that the Mark is confusing with its following registered trade-marks:

REPO DEPO, TMA 458282
REPOHIGHWAY.COM, TMA568326
100% PURE REPO, TMA 580006
REPOMAN, TMA569549 (collectively referred to as the Opponent's registered trade-marks)

[15] The relevant date for this ground of opposition is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 at 424 (FCA)].

[16] As stated earlier Ms. Shattler conducted a search of the Canadian Intellectual Property Office database. She provided printouts of the registrations listed above. I checked the register and these registrations are extant. Consequently the Opponent has met its initial burden of proof.

[17] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trade-marks are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the wares, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [See *Clorox Co v Sears Canada Inc* (1992), 41 CPR (3d) 483 (FCTD) and *Gainers Inc v Marchildon* (1996), 66 CPR (3d) 308 (FCTD)].

[18] Mr. Justice Binnie of the Supreme Court of Canada commented on the assessment of these criteria [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 and *Mattel Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321]. The most important factor amongst those is the degree of resemblance [see *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 96 CPR (4th) 361 (SCC)].

[19] The Opponent has a better chance of success under this ground of opposition with its trade-mark REPOHIGHWAY.COM as the Mark does contain the elements ‘Repo’ and ‘com’. I will therefore proceed by comparing that trade-mark with the Mark. If the Opponent does not succeed under this ground with this registration it would not be successful with any of its other registered trade-marks.

Inherent distinctiveness of the trade-marks and the extent to which they have become known

[20] The word ‘repo’ is defined in *The Oxford Canadian Dictionary*, 2d as a noun meaning: ‘an instance of repossession, e.g. of a car etc.: [also *attributive*,] : *repo man*.’

[21] The Opponent’s trade-mark is registered in association with:

Computer software for use in the financial services industry, namely, software for receiving and processing personal and commercial financial information; software for the recovery, management and sale of securities; software for providing credit history information; software of customer profiling for financial institutions; software for title, lien and securities registration and searching; computer software

for use in property appraisal, recovery and liquidation; software for providing data communication between lenders and insurers, governing agencies, dealers or brokers; computer software for generating financial and collection documentation; software for payment processing; software for filing and processing bankruptcy claims; software for analysis of secured and unsecured transactions; software for providing and retrieving creditor and debtor information; computer software for the recordal and tracking of liens and security interests; and

Paralegal services; insurance claims administration services; insurance claims processing services; insurance services; salvage services; legal research services; legal services; leasing of vehicles; property liquidation services; property storage and transportation services; bailiff services; lease-purchase financing services; operation of an online database for the registration and tracking of liens and security interests; operation of an online database for the tracking of stolen moveable property; operation of an Internet website featuring the sale of movable and immovable property.

[22] The Opponent's trade-mark is composed of three elements 'repo', 'highway' and '.com'. The combination of these elements suggests that the Opponent's wares and services are somewhat related to the repossession of assets ('repo') through the Internet ('.com'). The Opponent's trade mark REPOHIGHWAY.COM is therefore not inherently distinctive. The Mark is also not inherently distinctive being formed of 'repo', '.com' and a slogan portion: 'small enough to care-LARGE enough to get the job done'. One trade-mark is not more inherently distinctive over the other.

[23] The distinctiveness of a trade-mark can be enhanced through its use or promotion. However in this case there is no evidence of use of any of the Opponent's registered Trade-marks in Canada. Mr. Boman's affidavit does not make reference to any use of the Mark in Canada by the Applicant.

[24] Consequently this factor does not favour either of the parties.

The length of time the trade-marks or trade-names have been in use

[25] It has been held that the Registrar can refer to the certificate of registration to establish a period of use of the Opponent's registered trade-mark [see *Cartier Men's Shops Ltd v Cartier Inc* (1981), 58 CPR (2d) 68]. However I can only presume from such evidence a minimal use. There is no evidence of use of the Mark.

The nature of the wares, services, or business; the nature of the trade

[26] I must compare the Services to the wares and services covered by the Opponent's registration. There is some overlap between the Services and the Opponent's operation of an Internet website featuring the sale of movable and immovable property. In the absence of evidence on the parties' respective channels of trade and businesses with respect to those services, I can infer, from the use of '.com' in each of the marks in issue, that the parties' services are offered through the Internet.

[27] Consequently these factors favour the Opponent.

The degree of resemblance

[28] 'Repo' is the first component of both marks in issue. Both marks have the component '.com'. The Applicant tried to convince me that the slogan portion is the dominant portion. I disagree. I do not think that the consumer will focus on the long slogan but rather on 'repo.com'. The slogan puts the emphasis on 'repo.com' as it follows that portion of the Mark.

[29] Both trade-marks suggest that they are websites associated with repossessed goods. However the term 'highway' has a different meaning than 'small enough to care-LARGE enough to get the job done'. Therefore the marks differ phonetically, visually and in the ideas suggested by them.

[30] Consequently the most important factor favours the Applicant.

Additional Surrounding Circumstances

[31] Mr. Boman filed as exhibit C to his affidavit a search report done by Gowling LaFleur Henderson performed in September 2003 for the trade-mark REPO in Canada. He alleges that the results of that search show that REPO is extensively used as a shortened form of the word "repossession". The search also shows that other entities have used "REPO" as part of their corporate or business name. He filed as exhibit D a similar search done by Thompson on behalf of the Applicant in September 2003 in the United States. He alleges that the search also shows substantial use of the word REPO in trade-marks, corporate or business names and domain

names, but that would be in the United States. Finally Mr. Boman filed the results of a search he performed himself using Google search engine in order to establish the wide use of ‘repo’ as a generic term. The Opponent argues that those reports constitute inadmissible hearsay evidence. Moreover the Opponent claims that we have no idea if the services described in these websites are still provided in Canada, and if so since when.

[32] I agree with the Opponent that exhibit C to E constitute inadmissible hearsay evidence. Mr. Boman did not conduct the searches and did not provide the parameters of those searches. Moreover exhibit D is a search conducted on a US database which makes the results irrelevant to this case. Finally, exhibit E is a Google search results. This evidence is not admissible since there is no evidence of its reliability. [see *Envirodrive Inc v 836442 Alberta Ltd*, 2005 ABQB 446 (*AltaQB*); *Institut National des Appellations d’Origine v. Kohler Co* 2010 TMOB 162 at para 11]. Should I be wrong in excluding exhibit E as evidence in this file, it would further support the fact that the term ‘repo’ is used as a generic term to describe the business of repossession of property.

Conclusion

[33] The test to determine if the Mark is confusing with the Opponent’s trade-mark REPOHIGHWAY.COM is the imperfect recollection of the Opponent’s trade-mark by a consumer when being offered the Services in association with the Mark. Would that consumer associated those Services with the Opponent? I do not think so. The dominant portion of the parties’ trade-marks is ‘repo.com’ but it is not inherently distinctive. Any small differences between them will be sufficient to distinguish them. The consumer who has a vague recollection of the Opponent’s trade-mark REPOHIGHWAY.COM who sees the Mark would not think that, in my opinion, the Services are offered by the Opponent. Phonetically, visually and in the ideas suggested, the marks are different.

[34] I therefore dismiss the ground of opposition based on section 12(1)(d) of the Act.

Disposition

[35] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule A

The grounds of opposition now presently pleaded can be summarized as follow:

1. The Application does not comply with the requirements of section 30(e) of the *Trade-marks Act* RSC 1985, c T-13, (the Act) in that the Applicant does not have the intention to use the Mark by itself or through a licensee. In particular, the Applicant could not have intended to use the Mark with the Applicant's Services and according to the *Motor Vehicle Dealers Act, 2002*, the Applicant is required to be a dealer or operate under a dealer licence to perform the Services and the Applicant is not a dealer or operating under a dealer licence;
2. The Application does not comply with the requirements of section 30(i) of the Act in that the Applicant could not have been satisfied at the filing date of its application that it was entitled to use the Mark in Canada in association with the Services as accordingly to the *Motor Vehicle Dealers Act, 2002* the Applicant is required to be a dealer or operate under a dealer licence to perform the Services and the Applicant is not a dealer or operating under a dealer licence;
3. The Mark is not registrable in view of section 12(1)(d) since the Mark is confusing with the Opponent's reregistered trade-marks:
REPO DEPO, TMA 458282
REPOHIGHWAY.COM, TMA568326
100% PURE REPO, TMA 580006
REPOMAN, TMA569549
(collectively referred to as the Opponent's registered Trade-marks)
4. The Applicant is not the person entitled to the registration of the Mark pursuant to section 16(3)(a) of the Act in that at the date of filing of the application the Mark was confusing with each of the Opponent's Trade-marks which were previously used and made known in Canada by the Opponent;
5. The Mark is distinctive within the meaning of section 2 in that it does not actually distinguish the wares and services in association with which it has been used by the Applicant from the wares and services, nor is it adapted so to distinguish them, and in particular from the wares and services previously sold and performed in Canada by the Opponent and made known in Canada by the Opponent in association with the Opponent's Trade-marks individually and as a family, both as of the filing date of the application and to date.