

**IN THE MATTER OF AN OPPOSITION by
Penta Mark Communications Inc. to
Application No 1093303 for the Trade-mark
PENTAMARK filed by PentaMark
Worldwide Inc.**

I The Pleadings

On February 20, 2001 PentaMark Worldwide Inc. (the “Applicant”), filed an application to register the trade-mark PENTAMARK (the “Mark”) based on proposed use in association with:

Marketing services in the automotive field; namely, providing print, television, radio, billboard, internet, direct mail, point of sale, and telephone advertising on behalf of others; public relations and advertising agency services in the automotive field; and educational services; namely, personnel training services in the field of automotive promotions and sales. (“Services”)

The application was advertised on October 16, 2002, in the Trade-marks Journal for opposition purposes. Penta Mark Communications Inc. filed on January 16, 2003, a statement of opposition raising the following grounds of opposition:

1. In virtue of s. 38(2)(c) and 16(3) of the Trade-Marks Act R.S.C. 1985, c. T-13, (the “Act”), the Applicant is not the person entitled to the registration of the Mark in that it is confusing with the opponent’s trade-name Penta Mark previously used in Canada by the opponent in association with marketing services which includes the automotive field namely: providing direct mail, print, point of sale, Internet and billboard advertising on behalf of others.
2. In virtue of s. 38(2)(d) and 2 of the Act, the Mark is not distinctive in that it is neither adapted to distinguish nor capable of distinguishing the Services of the Applicant from the wares and services of the opponent which have been used and are being used in Canada in connection with marketing services namely: providing direct mail, print, point of sale, Internet and billboard advertising on behalf of others.

The Applicant filed on February 3, 2003 a counter statement denying the grounds of opposition raised by the opponent. The latter filed the affidavit of Hunter Roberts and the Applicant filed the affidavits of Rick Phillips and Maninder Chana. The opponent produced, as reply evidence, a second affidavit of Mr. Roberts.

Both parties filed written arguments and no oral hearing was held.

II The Opponent's evidence

Mr. Roberts has been the president of Penta-Mark Communications Inc. ("Penta-Mark"). It was incorporated on October 23, 1989. The filed copy of the opponent's Articles of Incorporation clearly establishes that its corporate name should read Penta-Mark Communications Inc. As noted above the opponent's corporate name identified in the statement of opposition is spelled without a hyphen. It will become clear from the reasons of my decision that such discrepancy will not be an important factor in this case. In any event the Applicant did not argue this issue in its written arguments.

He states that Penta-Mark has been in the business of providing marketing services in the automotive field, providing across Canada print, television, radio, billboard, direct mail and point of sale advertising including but not limited to the automotive field. He provides a copy of advertising material prepared for General Motors of Canada, consisting of promotional items such as sport bag, pen, baseball cap, jacket, polo shirt, etc. all bearing the GM trade-mark. We have no information as to when such campaign was created by Penta-Mark and if those services were provided in association with the trade-name Penta-Mark or Penta Mark. He further states that Penta-Mark has made known its name in Canada without however providing any details. There are no invoices or sales figures for the opponent's services provided in association with its trade-name.

Mr. Roberts alleges that Penta-Mark has received on several occasions certificates of recognition issued by the Canadian Direct Marketing Association and has filed some of them into the record all bearing the year 1995. The first certificate bears the inscription "Hunter Roberts, Pentmark Communications Inc." while it is written on the second one "Hunter Roberts, Pentmark Communications". There is also a Merit Award certificate issued to "Pentmark Communications". As for the first two certificates, it is unclear if they were personal awards given to Mr. Roberts or to the opponent.

He also filed a copy of an article published in Marketing Magazine on which appears a handwritten annotation "June 14-23" without any reference to a calendar year. There is a reference in such article to the Applicant.

He provides a list of some of Penta-Mark's clients. Finally he does allege some instances of confusion without providing the dates he received the phone calls referred to in his affidavit.

III The Applicant's evidence

Mr. Phillips is the Applicant's Chief Legal Officer and Corporate Secretary. He alleges that the Applicant is a full-service global communications agency that provides advertising, marketing, media planning and buying support worldwide for one client, namely DaimlerChrysler Corporation. A lot of emphasis is made on the fact that the Applicant is organized to be solely devoted to DaimlerChrysler Corporation with separate divisions for the different brands of cars and trucks of DaimlerChrysler Corporation. He goes on to explain the rationale of having one and only one client and declares that, because of such corporate structure, the Applicant would be precluded from accepting business from any other clients.

Mandiner Charna was an associate at the Applicant's agents firm at the time of execution of her affidavit. She conducted a search of the Canadian Trade-marks Registry using the STRATEGIS database to ascertain the number of occurrences of trade-marks having the prefix PENTA. She alleges having located 58 occurrences (allowed applications and registrations) that can be grouped into ten (10) categories. Only the broad category of marketing services is relevant in this case. There are three (3) citations included in such broad category.

IV The Reply evidence

In his second affidavit executed on August 5, 2004, Mr. Roberts provides the details of another instance of confusion that occurred "recently" without providing the date. One has to presume that it took place after the execution of his first affidavit otherwise it would have been included in it.

He alleges working by contract with Volvo and as such the opponent would be providing marketing services to the motor vehicle industry. He filed a copy of a photograph appearing on the Applicant's website displaying the reception area of the Applicant's place of business wherein the name PentaMark appears behind the reception desk, written in large letters. The affiant alleges that the font used by the

Applicant on such sign is identical to the font it uses on its letterhead and he filed a sample of such letterhead.

V The Law

The material time for considering the issue of non-entitlement based on s.16 (3) of the Act is the filing date of the application (February 20, 2001) [s.16 of the Act]. The material date for assessing the issue of distinctiveness is generally accepted to be the date of filing of the statement of opposition (January 16, 2003) [see *Andres Wines Ltd. and E&J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A)].

There is no definition in the Act of what constitutes proper use of a trade-name. On this issue I refer to Madam Justice Simpson's comments in *Mr. Goodwrench Inc. v. General Motors Corp.*, (1994) 55 C.P.R. (3d) 508 wherein she stated:

“There are no provisions in the Act which define and describe the use of a trade name. However, in his decision in *Professional Publishing Associates Ltd. v. Toronto Parent Magazine Inc.* (1986), 9 C.P.R. (3d) 207_Mr. Justice Strayer considered the problem and held that the principles in ss. 2 and 4(1) of the Act apply to trade name use. In this regard, His Lordship said:

While there is no definition in the Trade Marks Act of "use" in relation to trade names, I am satisfied that consistent with the purposes of the Act such "use" would have to be in the normal course of trade and in relation to the class or classes of persons with whom such trade is to be conducted.

Accordingly, use in the normal course of trade will be the test applied in these reasons.”

It has been determined that the mere incorporation of a company does not constitute evidence of use of a trade-name as of the date of issuance of the Letters of Incorporation. [See *Opus Building Corp. v. Opus Corp* (1995), 60 C.P.R. (3d) 100 and *Pharmx Rexall Drug Stores Inc. v. Vitabrin Investments Inc.* (1995) 62 C.P.R. (3d) 108].

VI Analysis of the grounds of opposition

There is no evidence in the record that would enable me to conclude that there has been use of the opponent's trade-name prior to the filing date of the application in association with marketing services in the automotive field across Canada which includes print, television, radio, billboard, direct mail, point of sale advertising. There has been no mention as to when the advertising services were rendered for General Motors of Canada. There is no evidence that such services were rendered in association with the trade-name Penta-Mark or Penta Mark.

We have no information as to when the alleged instances of confusion occurred. In order for those facts to be relevant, assuming that they do not constitute hearsay evidence, they had to occur prior to the relevant dates mentioned hereinabove. Moreover, in order to be successful under the non-entitlement ground of opposition, the opponent had to prove that it had not abandoned the use of its trade-name PENTA-MARK or PENTA MARK at the date of publication of the Applicant's trade-mark in the Trade-marks Journal [s.16(5) of the Act]. Therefore, the discrepancy between the trade-name identified in the statement of opposition and the actual trade-name used by the opponent does not have any impact on my decision.

As for the distinctiveness issue, the evidence of the issuance of articles of incorporation by itself is not sufficient to establish prior use of the opponent's trade-name prior to the filing date of the statement of opposition.

The opponent failed to discharge its initial onus to prove use of its trade-name prior to the relevant dates associated with each ground of opposition pleaded. Such failure is fatal to the opponent's case. Consequently, both grounds of opposition are dismissed.

VII Conclusion

Having been delegated authority by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I dismiss the opposition filed by the opponent against the Applicant's application for the registration of the Mark, the whole pursuant to s. 38(8) of the Act.

DATED, IN BOUCHERVILLE, QUEBEC, THIS 19th DAY OF OCTOBER 2005.

Jean Carrière,

Member of the Trade-marks Opposition Board