

**IN THE MATTER OF AN OPPOSITION  
by Hola, S.A., to application No. 1 164 867  
for the trade-mark HELLO & Design filed  
by Rui Pereira**

On January 20, 2003, Rui Pereira (the “Applicant”) filed an application to register the trade-mark HELLO & Design (the “Mark”) as illustrated below,



based upon proposed use of the Mark in Canada in association with the following services as amended on March 17, 2004, namely, *“streaming video and media production services including satellite MPEG-4 video streaming and broadcasting”*.

The application was advertised for opposition purposes in the *Trade-marks Journal* of May 12, 2004. On October 12, 2004, Hola, S.A. (the “Opponent”) filed a statement of opposition against the application. The Applicant filed and served a document entitled “statement of reply” which has been accepted as his counter statement. On July 19, 2007, the Opponent was granted leave to file an amended statement of opposition. I note that the Applicant in his counter statement has not expressly denied the allegations against him regarding the grounds of opposition based on lack of requisite intention to use his Mark or the lack of distinctiveness, however appears to generally deny the other grounds of opposition.

The Opponent’s evidence consists of the affidavit of Sally Amanda Cartwright, the affidavit of Stefan Picard and the affidavit of Aaron Edgar. The Opponent also filed the affidavit of Margaret Kruszewski as reply evidence. The Applicant’s evidence consists of an affidavit on his

own behalf. Only the Applicant was cross-examined on his affidavit to which the Opponent timely filed the transcript and undertakings thereto which for part of the evidence of record.

Both the Applicant and the Opponent filed a written argument. Attached to the Applicant's written argument are two exhibits, however, as per the Registrar's ruling on this issue dated October 17, 2007, these exhibits are inadmissible as they were not submitted as evidence. I will therefore disregard the paragraphs in the Applicant's written argument, which refer to them.

Both parties requested a hearing, which was conducted on December 12, 2008.

#### *The Grounds of Opposition*

The Opponent is the owner of the following registered trade-marks, namely HELLO! & Design, TMA484,633 for magazines and periodical publications and HOLA, TMA251,915 for agendas, livres, revues, publications litteraires et artistiques (diaries/agendas, books, magazines, literary and artistic publications).

The grounds of opposition are summarized as follows:

1. The Opponent relies on s. 38(2)(b) of the *Trade-marks Act*, R.S.C. 1985, c.T-13 (the "Act") and states that the Applicant's Mark is not registrable in view of s. 12(1)(d) of the Act because it is confusing with the Opponent's aforementioned registered trade-marks.
2. The Opponent relies on s. 38(2)(c) of the Act and states that the Applicant is not the person entitled to the registration in view of s. 16(3) of the Act, since at the date of filing of the Applicant's application, the Applicant's trade-mark was confusing with the Opponent's aforesaid trade-marks which had been previously used in Canada.

3. The Opponent relies on s. 38(2)(d) of the Act and states that the Applicant's aforementioned trade-mark is not distinctive and does not actually distinguish nor is it adapted to distinguish the services of the Applicant from the wares of the Opponent.
4. The Opponent relies on s. 38(2)(a) of the Act and states that the Applicant's application 1,164,867 did not conform to the requirements of s. 30(e) of the Act because the Applicant never intended, by itself or through a licensee, to use the trade-mark in Canada.

### Decision

The Applicant has made several admissions throughout these proceedings, as well as during the course of the hearing, stating and re-stating that the Mark as shown in the application as filed and as advertised in the *Trade-mark Journal* is not the Mark he intends or ever intended to use. Based on the evidence adduced, the ground of opposition pursuant to s. 38(2)(a) and s. 30(e) of the Act is successful, and the application for the registration of HELLO & Design (1,164,867) is refused pursuant to s. 38(8) of the Act.

My detailed reasons for decision follow.

### Section 30(e) Ground of Opposition

The material date with respect to a s. 30 ground is the filing date of the application (January 20, 2003) [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475]. The legal burden or onus is on the Applicant to show that its application complies with s. 30 of the Act. There is however an initial evidential burden on the Opponent to prove the allegations of fact alleged in its statement of opposition. [*Joseph E. Seagrams & Sons Ltd. v. Seagrams Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325]. To meet the evidential burden upon it in relation of a particular issue, the Opponent must adduce sufficient admissible evidence from

which it could reasonably be concluded that the facts alleged to support that issue exist [*John Labatt Ltd. v. Molson Cos.* (1990), 30 C.P.R. (3d) 293]. The Opponent's burden is however lighter with respect to the issue of non-compliance with s. 30(e) because the facts supporting no intention to use the Mark are particularly within the knowledge of the Applicant [*Molson Canada c. Anhauser-Busch Inc.* (2003), 29 C.P.R. (4<sup>th</sup>) 315, *Labatt Brewing Co. v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 ]. While an Opponent may rely upon the Applicant's evidence to meet its evidential burden in relation to this ground, the Opponent must show that the Applicant's evidence is "clearly" inconsistent with the Applicant's claims as set forth in its application.

I find that the Opponent has met its initial burden, the evidence showing clear admissions on the part of the Applicant that he never intended to use the Mark as applied-for, this being clearly inconsistent with his claims in the application.

The Opponent having met its evidential burden, the onus shifts to the Applicant who must establish, on a balance of probabilities, that his mark is registrable. The presence of an onus on the Applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant [*John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293].

### Analysis

The legal burden or onus is on the Applicant to show that his application complies with s. 30(e) of the Act. This includes both the question as to whether or not the Applicant has filed an application that formally complies with the requirements of s. 30(e) and the question as to

whether or not the statements contained in the application are true [*Home Quarters Warehouse, Inc. v. Home Depot, U.S.A., Inc.* (1997), 76 C.P.R. (3d) 219].

The Applicant has formally complied with the requirements of s. 30(e) by including a statement that he intends to use the Mark in Canada by himself or through a licensee, the issue then becomes whether the Applicant has substantively complied with s. 30(e), that is, is the statement true?

The Applicant admits that the applied-for Mark is not the Mark he intends to use or ever intended to use. These admissions are revealed recurrently in the evidence, namely in the cross-examination of the Applicant's affidavit and by way of the Applicant's own evidence. These admissions are further noted in the Applicant's counter statement and *viva voce* at the hearing.

*Cross-examination of Mr. Rui Pereira*

Mr. Pereira (the Applicant) was cross-examined without the benefit of legal counsel, although this may explain some of the statements made by him during cross-examination, it does not justify them.

On cross-examination the Applicant admits on several occasions that the Mark applied for at the time of filing is not the Mark he ever intended to use.

To this end, the following excerpts are the most relevant portions of the cross-examination:

[108]       **Q.** Sir, I've reviewed these portions of your website that are shown in Exhibit RP2 that I can read. Am I correct that on all occasions you're using the trademark TVHello and Design?

**A.** It's TVHello, as the logo for the station.

- [109] Q. So, the logo that you're using is TVHello?  
A. Yes
- [110] Q. And that includes the words TVHello and some design elements, if I can refer to them as such?  
A. As a graphic they are design elements, yes.
- [111] Q. So the record is clear, what I believe you're referring to is shown on the first page at the top-right-hand corner?  
A. Yes
- [112] Q. That's the TVHello logo that you're talking about?  
A. That's correct
- [113] Q. So, I take it you're not using "hello" itself as a mark or as a logo?  
A. No, that was never our intent.
- [114] Q. It's always been your intention to use TVHello as part of the logo?  
A. That's right.
- [115] Q. Am I correct in thinking that it's the logo TVHello that you want to register as a trade-mark?  
A. That's correct.
- [116] Q. Not the "Hello" logo by itself?  
A. Not Hello, no.

The Applicant's own evidence further corroborates these statements. In this regard, I refer to the Applicant's affidavit sworn March 10, 2006 at paragraph 8 where the Applicant refers to exhibit "C" which is a printout of the Applicant's TVHello website pages. It is clear from this exhibit that the trade-mark illustrated therein is not the mark as applied-for and advertised. At paragraph 10, the Applicant admits the following "*TVHello's trade-mark application is for TVHello and not Hello (...)*". Moreover, the relevant portions to the Applicant's counter statement are found in paragraph f. "*the intended use of the proposed mark is to advertise a television programme, as indicated by the use of "tv" before the word "Hello" (...)*". These admissions support a finding

that the statements made by the Applicant in his application regarding his intent to use the Mark as applied-for are not correct, nor are they true. Consequently, the Applicant has failed to meet his legal burden showing that his application complies with s. 30(e) of the Act. I might add that the failure by the Applicant to meet his burden in these circumstances cannot be considered to be a mere technicality, which is clerical in nature, nor can it be said to be a simple oversight. Non-compliance with s. 30(e) of the Act is not a mere technicality and Mr. Pereira's false statement makes the present application void from the outset, as such the application is refused solely on that ground [*Cellular One Group, a Partnership v. Brown* (1996), 69 C.P.R. (3d) 236].

In view of the foregoing, it is unnecessary to consider the remaining grounds of opposition. I would say however, that the remaining grounds of opposition essentially turn on the single issue of confusion between the Mark and the Opponent's trade-marks previously listed. If I had considered those additional grounds of opposition, I would have been inclined to conclude that the Mark is confusing with at least the Opponent's registered trade-mark HELLO! & Design, TMA484,633 for magazines and periodical publications. Such a finding would have followed, in large part, from the inherent distinctiveness of the Opponent's mark, the striking resemblance between the marks in appearance, sound and ideas suggested, as well as the evidence of use of the Opponent's mark over the years and the extent to which its mark has become known in Canada, and the overlapping channels of trade.

In view of the above, I refuse the Applicant's application.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the application pursuant to s. 38(8).

DATED AT GATINEAU, QUÉBEC, THIS 23rd DAY OF DECEMBER 2008.

Lynne Pelletier  
Member  
Trade-marks Opposition Board