

IN THE MATTER OF AN OPPOSITION by Reno-Dépôt Inc. to
Application No. 1,055,676 for the trade-mark L'ENTREPÔT DE
LA RÉNOVATION DU QUÉBEC filed by Homer TLC, Inc.

[1] On April 19, 2000, Homer TLC, Inc. (the Applicant) filed an application to register the trade-mark L'ENTREPÔT DE LA RÉNOVATION DU QUÉBEC (the Mark) based upon proposed use. The Mark has been applied for registration in association with the following wares and services:

Wares: aprons, hats and rulers.

Services: operation of retail stores dealing in hardware, housewares, tools, building supplies, home and garden products, plumbing and electrical fixtures, kitchen and bathroom supplies, carpet, flooring, and paint; rendering technical aid and assistance with home improvement projects; landscape gardening design for others; interior decorating consultation; and consultation in the fields of construction and home and garden installations, repairs and maintenance.

[2] The application contains the following disclaimers:

- the right to the exclusive use of the word QUÉBEC has been disclaimed apart from the Mark;
- the right to the exclusive use of the word RÉNOVATION in respect of the services has been disclaimed apart from the Mark;
- the right to the exclusive use of the word L'ENTREPÔT in respect of the operation of retail stores has been disclaimed apart from the Mark.

[3] The application was advertised in the *Trade-marks Journal* of December 29, 2004.

[4] Réno-Dépôt Inc. (the Opponent) filed a statement of opposition on February 16, 2005. The grounds of opposition can be summarized as follows:

1. The application does not comply with the requirements of s. 30 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) since at the filing date of the application:
 - a. the Applicant was already using the Mark in Canada;
 - b. alternatively or cumulatively, the Applicant never intended to use the Mark;

- c. the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in view of the allegations contained in the statement of opposition, including the Applicant's knowledge of the Opponent's rights.
2. The Mark is not registrable pursuant to s. 12(1)(d) of the Act because it is confusing with the following registered trade-marks of the Opponent:

<u>Trade-mark</u>	<u>Registration No.</u>
RÉNO-DÉPÔT LE PREMIER ENTREPÔT DE LA RÉNOVATION	TMA430,926
RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION	TMA452,238
	TMA522,617
	TMA439,001
RENO DEPOT	TMA527,493
	TMA550,695
	TMA550,696
RENODEPOT	TMA527,494
RENO-DEPOT	TMA428,486

3. The Applicant is not the person entitled to registration of the Mark since:
- a. contrary to s. 16(3)(a) of the Act, at the filing date of the application, the Mark was confusing with the aforementioned trade-marks previously used in Canada by the Opponent or its predecessors-in-title;
- b. contrary to s. 16(3)(c) of the Act, at the filing date of the application, the Mark was confusing with the trade-names RÉNO-DÉPÔT INC., RENO-DEPOT,

- RÉNODÉPÔT INC., RENODEPOT, RÉNO DÉPÔT and RENO DEPOT previously used in Canada by or for the Opponent, or by or for its predecessors-in-title;
- c. contrary to the introductory paragraph of s. 16(3) of the Act, the application does not comply with the requirements of s. 30 of the Act; the Mark is not a proposed one but rather a used one; and the Mark is not registrable.
4. The Mark is not distinctive because:
- a. it does not distinguish the Applicant's wares and services from the wares and services of others, including those of the Opponent;
 - b. the Mark is used outside the scope of the licensed use provided by s. 50 of the Act;
 - c. as a result of a transfer of the Mark, more than one person had rights into the Mark and exercised these rights contrary to s. 48(2) of the Act.

[5] The Applicant filed a counter statement denying each ground of opposition.

[6] The Opponent's evidence consists of Certificates of Authenticity for its alleged registrations and of an affidavit of Philippe Lagacé, dated January 10, 2006. Mr. Lagacé has been cross-examined by the Applicant. The transcript of the cross-examination and exhibits thereto were filed on August 7, 2006. I shall refer to Mr. Lagacé's cross-examination only insofar as it is relevant to the analysis of the evidence and to the parties' arguments.

[7] The Applicant's evidence consists of an affidavit of Elise Vaillancourt, dated December 6, 2006. Ms. Vaillancourt has not been cross-examined.

[8] Both parties filed written arguments and were represented at an oral hearing.

MATERIAL DATES

[9] The material dates that apply to the grounds of opposition are as follows:

- s. 38(2)(a)/s. 30 – the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)];
- s. 38(2)(b)/s. 12(1)(d) – the date of my decision [see *Park Avenue Furniture*

Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks (1991), 37 C.P.R. (3d) 413 (F.C.A.);

- s. 38(2)(c)/s. 16(3) – the filing date of the application;
- s. 38(2)(d)/non-distinctiveness – the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

ONUS

[10] There is an initial evidential burden on the Opponent to establish the facts relied upon in support of the grounds of opposition. Once this initial onus is satisfied, the Applicant has the burden to prove that the particular grounds of opposition should not prevent registration of the Mark [see *John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.) and *Wrangler Apparel Corp. v. The Timberland Company* (2005), 41 C.P.R. (4th) 223 (F.C.)].

OPPONENT’S EVIDENCE

Certificates of Authenticity

[11] The Certificates of Authenticity show the nine alleged trade-mark registrations standing in the Opponent’s name. Footnotes to registration pages show that the Canadian Intellectual Property Office recorded the Opponent as owner of Registration Nos. TMA430,926, TMA452,238, TMA439,001 and TMA428,486 further to a merger of May 25, 1997.

Lagacé Affidavit

[12] From the outset, I note that except for paragraph 6 of the affidavit containing a bare assertion of use of the Opponent’s corporate name Réno-Dépôt Inc. and trade-name Réno-Dépôt since 1993, none of Mr. Lagacé’s statements is directed to the use of the corporate name or trade-name. Further, Mr. Lagacé introduces the evidence by collectively referring to the Opponent’s trade-marks as “*les Marques RÉNO-DÉPÔT*”. Since any ambiguities in the affidavit should be resolved against the Opponent [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)], I find it appropriate to consider the evidence introduced by the Lagacé affidavit as only relating to the Opponent’s “*RÉNO-DÉPÔT Marks*”.

Any ambiguities resulting from the collective reference to these trade-marks will also be resolved against the Opponent. I note that any reference to the RÉNO-DÉPÔT Marks throughout my decision is a collective reference to the Opponent's trade-marks, as per the Lagacé affidavit.

[13] Mr. Lagacé has been the Marketing Director of the banner Réno-Dépôt of the Opponent since October 2005. Prior to this position, he had been Advertising Director of the Opponent starting in April 2001. Mr. Lagacé states that the Opponent is one of the most important distributors and Canadian retailers of hardware, renovation and gardening products. The Opponent operates fourteen RÉNO-DÉPÔT stores. In average, more than 12 millions consumers annually attend at one of these stores.

[14] Mr. Lagacé states that the RÉNO-DÉPÔT Marks have been continuously used in Canada in association with « *rubans à mesurer, tablier, boîte à outils, casquettes, peintures, teintures* » and « *opération, promotion et gestion de magasins spécialisés dans la vente au gros et au détail d'articles de quincaillerie, de matériaux et accessoires de constructions (sic), de rénovation et décoration, d'appareils domestiques et ménagers, d'articles et accessoires de jardinage, de meubles, de peinture, vernis et solvants; vente et installation de produits de quincaillerie, rénovation et décoration; conseil en matière de quincaillerie, rénovation et décoration; système de fidélisation de clientèle, nommément: mise sur pied d'un club permettant aux membres d'accumuler des points et des escomptes et de les utiliser en échange de biens ou services; système de coupons rabais, système de points* » since the following dates :

- June 2, 1994 : RÉNO-DÉPÔT LE PREMIER ENTREPÔT DE LA RÉNOVATION;
- March 16, 1993 : RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION and RÉNO-DÉPÔT L'ENTREPOT DE LA RÉNOVATION & Design of Registration No. TMA522,617;
- May 3, 1994 : RENO DEPOT, RENODEPOT and RENO-DEPOT;
- May 20, 1994: RÉNO-DÉPÔT L'ENTREPOT DE LA RÉNOVATION & Design of Registration No. TMA439,001;
- October 30, 1999: RÉNO DÉPÔT & Design of Registration Nos. TMA550,695 and TMA550,696.

[15] As per the Lagacé affidavit, any subsequent reference to Wares or to Services is a collective reference to the aforementioned wares and services.

[16] Mr. Lagacé states that the Opponent regularly advertises the Wares and Services associated with the RÉNO-DÉPÔT Marks in printed publications (such as newspapers, circulars, magazines, brochures) and by way of radio and television advertisement. He files the following as representative specimens of advertisement for the Wares and Services associated with the RÉNO-DÉPÔT Marks:

- a videocassette containing six commercials televised in the Province of Quebec in 1993 [Exhibit PL-2]. I note that there is no admissible evidence directed to the broadcasting of these commercials;
- an advertisement in *The Gazette* of June 14, 1997 [Exhibit PL-3]. I can take judicial notice that *The Gazette*, as a major daily newspaper published in Montreal, has a substantial circulation [see *Northern Telecom Ltd. v. Nortel Communications Inc.* (1988), 14 C.I.P.R. 104 (T.M.O.B.)];
- circulars distributed in 1998 and 2005 [Exhibit PL-4];
- three issues of the magazine *Les Idées Réno-Dépôt* (Spring 1997, Winter 1997-1998 and Winter 1998-1999) published three times a year since 1997 and available in the Opponent's retail stores and in 5000 points-of-sale in Quebec [Exhibit PL-6].

[17] The Applicant in written and oral arguments has made various submissions, which I am addressing throughout my decision, on the evidentiary value of exhibits to the Lagacé affidavit. Still, the Applicant has recognized that Exhibits PL-2 and PL-3 display the trade-mark RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION & Design of Registration No. TMA522,617. Further, although the Applicant has also recognized that the circular of 1998 displays the RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION & Design of Registration No. TMA522,617, it correctly notes that the circular of 2005 displays the trade-mark RÉNO DÉPÔT & Design of Registration No. TMA550,695. Insofar as the Exhibit PL-6 is concerned, the trade-mark RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION & Design of Registration No. TMA522,617 is shown on an apron worn by the Opponent's President (Spring 1997), in a drawing of the

Opponent's storefront banner (Winter 1997-1998) and in the advertisement of seminars (Winter 1998-1999).

[18] Also appended to the Lagacé affidavit are issues dated October 1993, September 1994, December 1995 and December 1997 of *L'Associé*, a bulletin dedicated to employees and distributed on a quarterly basis between between 1993 and 2003 [Exhibit PL-5]. Although these were filed as representative specimens of advertisement, I agree with the Applicant that it is reasonable to infer that the bulletin was not distributed to the general public.

[19] Appended to the Lagacé Affidavit are articles published in the newspapers *The Gazette* and *La Presse* of April 3, 1993 [Exhibit PL-7] as well as an article published in the March 2002 issue of *Revue Commerce* [Exhibit PL-8]. Even if one infers from these articles that consumers in Quebec would have been informed about the Opponent, these articles do not constitute advertisement of the RÉNO-DÉPÔT Marks [see *Williams Companies Inc. et al. v. William Tel Ltd.* (2000), 4 C.P.R. (4th) 253 (T.M.O.B.)]. I recognize however, as did the Applicant, that the trade-mark RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION & Design of Registration No. TMA552,617 appears in advertisement amongst the articles in *The Gazette* and *La Presse*.

[20] Mr. Lagacé deposes that “*Comment Faire*” seminars have been regularly offered to clients since 1993. He files a poster and an evaluation form for the seminars [Exhibit PL-9]. Both display the trade-mark RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION & Design of Registration No. TMA552,617. Although the Applicant correctly submits that “seminars” is not listed in the Services, I find it reasonable to consider that “seminars” correspond to “*conseil en matière de quincaillerie, rénovation et décoration*”.

[21] Mr. Lagacé concludes his affidavit by filing copies of various pages of the Opponent's website operated since 1997 [Exhibit PL-10.] The trade-mark RÉNO DÉPÔT & Design of Registration No. TMA550,695 is displayed at the top of all the website pages, apparently printed on January 13, 2006. The Applicant correctly notes that the trade-mark RÉNO-DÉPÔT, L'ENTREPÔT DE LA RÉNOVATION is displayed only once at the bottom of one of the website page. Nonetheless, the trade-mark, which is followed by ®, is displayed on the website.

Surely, the presence of the comma between RÉNO-DÉPÔT and L'ENTREPÔT DE LA RÉNOVATION is not sufficient to conclude that the website page does not display the trade-mark RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION of Registration No. TMA452,238. I accept the display of the trade-mark on one website page as use in advertisement on January 13, 2006. Still, there is no evidence concerning the number of Canadians, or at the very least the number of residents of the Province of Quebec, accessing the website at any given time.

[22] The Applicant argues that the cross-examination of Mr. Lagacé must lead to the conclusion that the Opponent has abandoned the use of the RÉNO-DÉPÔT Marks involving the words L'ENTREPÔT DE LA RÉNOVATION. Though the Opponent disagrees with the Applicant's contention, there is no debate that Mr. Lagacé admits in cross-examination that the Opponent began removing the words L'ENTREPÔT DE LA RÉNOVATION from its storefront signage in January 2000 to display the trade-mark RÉNO DÉPÔT & Design of Registration No. TMA550,695 [p. 26 of the transcript, Q55 and Q56]. The debate arises from each party's position about Mr. Lagacé's testimony on the use of the RÉNO-DÉPÔT Marks involving the words L'ENTREPÔT DE LA RÉNOVATION in circulars.

[23] The Applicant submits that Mr. Lagacé made contradictory statements in cross-examination. More particularly, it submits that although Mr. Lagacé stated that the RÉNO-DÉPÔT Marks involving the words L'ENTREPÔT DE LA RÉNOVATION were still used in circulars [p. 27 of the transcript, Q59], he later admitted that the trade-marks were changed around the year 2000 to remove the words L'ENTREPÔT DE LA RÉNOVATION [pp. 32 and 35 of the transcript, Q77 and Q84]. The Applicant further contends that despite testifying that the trade-mark RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION & Design of Registration No. TMA522,617 is still being used in circulars, Mr. Lagacé did not provide evidence of such use. The Applicant contends that an adverse inference should be drawn from the affiant's contradictory statements, in addition to the absence of any evidence of use of RÉNO-DÉPÔT Marks involving the words L'ENTREPÔT DE LA RÉNOVATION in circulars after 1998.

[24] The Opponent submits that Mr. Lagacé's testimony [pp. 27, 35 and 37 of the transcript, Q58, Q84 and Q91] is consistent with his affidavit. In oral argument, the Opponent submitted

that the circular of August 26, 2006 introduced by the Applicant's agent during the cross-examination displays the trade-mark RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION & Design of Registration No. TMA552,617 [Exhibit 2 to the transcript]. Given the Opponent's submission, I conclude that its agent's objection to the production of the circular no longer stands [p. 28 of the transcript].

[25] Since each party relies on Q84 to support its contention, it seems appropriate to reproduce the relevant excerpt of the cross-examination [p 35 of the transcript]:

Me BRIGITTE CHAN :

Et la deuxième série de questions, c'est concernant les circulaires, quand est-ce que les marques ont aussi été changées pour la marque qui apparaît sur vos enseignes, c'est-à-dire la marque Reno-Dépôt avec le marteau?

Me STELLA SYRIANOS :

Vous avez dit encore enseignes.

Me BRIGITTE CHAN :

84 Q- Oui, alors, qui a été changée pour celle qui est sur l'enseigne est aussi maintenant visible sur vos circulaires?

R- La page frontispice a été modifiée, je crois, au meilleur de ma connaissance, c'est l'année deux mille (2000), au niveau des circulaires et L'Entrepôt de la Rénovation, cette marque-là est encore utilisée dans les circulaires Réno-Dépôt, au moment où on se parle.

[26] Based on a fair reading of the cross-examination transcript, including the reproduced excerpt, I consider that Mr. Lagacé's testimony is to the effect that the words L'ENTREPÔT DE LA RÉNOVATION were removed from the frontispiece page of the circulars in 2000, not from the circulars. Thus, I do not agree with the Applicant's position on contradictory statements. In addition, the trade-mark RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION & Design of Registration No. TMA552,617 is displayed, though in small size, at the bottom of the second to last page of the circular of 2006 [Exhibit 2 to the transcript]. Accordingly, I cannot agree with the Applicant's position on the absence of evidence of use in circulars after 1998.

[27] That being said, considering the ambiguity resulting from the collective reference to the RÉNO-DÉPÔT Marks, I am not prepared to conclude that the Opponent has introduced reliable

evidence of use of all the RÉNO-DÉPÔT Marks involving the words L'ENTREPÔT DE LA RÉNOVATION. Specifically, I am not satisfied that the Lagacé affidavit evidences use, within the meaning of s. 4 of the Act, of the trade-marks RÉNO-DÉPÔT LE PREMIER ENTREPÔT DE LA RÉNOVATION of Registration No. TMA430,926 and RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION & Design of Registration No. 439,001. Although I am satisfied that the Lagacé affidavit introduces evidence of use of the trade-marks RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION of Registration No. TMA452,238 and RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION & Design of Registration No. TMA522,617, such evidence is restricted to use in association with services. In other words, I agree with the Applicant that the Lagacé affidavit does not evidence use of the trade-marks in association with the Wares within the meaning of s. 4(1) of the Act.

[28] In rounding up my review of the Opponent's evidence, I wish to address two remaining issues arising from the cross-examination.

[29] First, the Applicant submits that a negative inference should be drawn from Mr. Lagacé's failure to answer questions as to whether the Opponent had taken any action against the Applicant, other than the present proceedings [pp. 22 to 24 of the transcript, Q44 to Q46]. The Opponent's agent objected to this line of questioning on the ground that it was outside the scope of the affidavit. The Applicant submits that this line of questioning was within the purview of the opposition and the affiant's statements on his duties, responsibilities and functions for the Opponent. I find it unnecessary to decide on the merit of each party's position on the scope of the affidavit because I am not prepared to draw any negative inference. In my view, whether or not the Opponent has taken any action against the use of the Mark does not diminish the value of the Lagacé affidavit as evidence in the present proceeding.

[30] Second, the Applicant submits that no significance should be afforded to Mr. Lagacé's belief that there had been instances of confusion between the trade-marks [pp. 16 and 17 of the transcript, Q29 and 32]. I agree with the Applicant. For one thing, it is apparent that Mr. Lagacé's statements were not based on his knowledge of actual instances of confusion, but

rather on his opinion that the trade-marks at issue are confusing [pp. 17-18 of the transcript, Q33-Q34]. His statements are conclusions in law to be determined by the Registrar.

APPLICANT'S EVIDENCE

Vaillancourt Affidavit

[31] Ms. Vaillancourt has been the Marketing Manager for Home Depot of Canada Inc. (Home Depot Canada) since 2003.

[32] Home Depot Canada and the Applicant are subsidiaries of The Home Depot, Inc., which Ms. Vaillancourt describes as the world's largest home improvement retailer and one of the largest retailers in North America. The Applicant owns the trade-marks used in the Home Depot business. Home Depot Canada operates the HOME DEPOT stores in Canada and is a licensee of the Applicant. There are 149 retail stores across Canada. Appended as Exhibit "A" to the Vaillancourt affidavit is a listing of most of Home Depot Canada's retail stores in Canada.

[33] Ms. Vaillancourt provides information with respect to the products and services available in the HOME DEPOT retail stores. She describes Home Depot Canada's advertising activities as including: monthly catalogues distributed by mail or as newspaper inserts; advertising flyers included as inserts with newspapers of major Canadian cities and in promotional polybags; radio and television advertisement.

[34] Ms. Vaillancourt deposes that Home Depot Canada has been using the Mark on storefront signage and store entrance doors since approximately August 2000 following the opening of the first store in Quebec. She deposes that all retail stores across the Province of Quebec (20 stores at the date of the affidavit) bear the Mark on storefront signage and/or entrance doors. Ms. Vaillancourt files photographs of a storefront signage and of entrance doors [Exhibit "B"]. She goes on to opine on the impression created by the display of the Mark along with the trade-marks HOME DEPOT and HOME DEPOT Design. Ms. Vaillancourt states that each store in Quebec has received an average of 8,100 customer transactions per week since 2003 and in the past four years the stores in total have received in excess of 23,916,188 customer transactions.

[35] Ms. Vaillancourt concludes her affidavit by stating that Home Depot Canada is unaware of any instances of confusion between the Mark and any trade-marks or names of the Opponent.

[36] In rounding-up my review of the Vaillancourt Affidavit, I have to address the issue surrounding the licensed use of the Mark in Canada. Specifically, the question arises whether the Applicant has evidenced either direct or indirect control over the activities of Home Depot Canada so that the use of the Mark amounts to use by the Applicant pursuant to the provisions of s. 50(1) of the Act.

[37] The fact that no license agreement has been filed with the Vaillancourt affidavit is not detrimental to the Applicant's case. Section 50 of the Act does not require a written agreement. Evidence of control by an owner of a trade-mark can support the existence of an implied license agreement [see *Well's Dairy Inc. v. UL Canada Inc.* (2000), 7 C.P.R. (4th) 77 (F.C.T.D.)]. However, the corporate relationship between the Applicant and Home Depot Canada is insufficient to establish the existence of a license within the meaning of s. 50 of the Act. There must also be evidence that the Applicant controls the use of the Mark and takes steps to ensure the character and quality of the wares and services provided [see *MCI Multinet Communications Corp. v. MCI Multinet Communications Inc.* (1995), 61 C.P.R. (3d) 245 (T.M.O.B.); *Loblaws Inc. v. Tritap Food Broker* (1999), 3 C.P.R. (4th) 108 (T.M.O.B.)]. There is no statement whatsoever in the Vaillancourt affidavit regarding the Applicant's control. There is no documentary evidence to show that the presumption created by s. 50(2) of the Act may apply. Since no evidence has been introduced to show that the Applicant has either direct or indirect control over the activities of Home Depot Canada, I conclude that the Applicant cannot benefit from the use of the Mark in Canada pursuant to the provisions of s. 50(1) of the Act.

ANALYSIS OF THE GROUNDS OF OPPOSITION

[38] From the outset, I dismiss the ground of opposition based upon the introductory wording of s. 16(3) of the Act as I consider it to be without legal basis under s. 38(2)(c) of the Act. There would seem to be no cases in which allegations that an application does not comply with s. 30 of the Act and that a trade-mark is not registrable could not be more directly and appropriately raised as grounds of opposition under s. 38(2)(a) and s. 38(2)(b) of the Act respectively.

Non-compliance with s. 30 of the Act

[39] The first and second pleadings of the ground of opposition relate to non-compliance with s. 30(e) of the Act whereas the third pleading relates to non-compliance with s. 30(i) of the Act. The Opponent did not expand on this ground of opposition in written or oral argument.

Non-compliance with s. 30(e) of the Act

[40] As it is difficult to prove a negative, and certainly more so in a case of a proposed use application, the initial evidential burden upon the Opponent with respect to this ground of opposition is a relatively light one [see *Molson Canada v. Anheuser-Busch Inc.*, (2003) 29 C.P.R. (4th) 315 (F.C.T.D.)]. Yet, the Opponent did not file any evidence in support of the ground of opposition. Although the Opponent may rely upon the Applicant's evidence to meet its initial burden, the Opponent must show that the evidence is clearly inconsistent with the Applicant's claim [see *York Barbell Holdings Ltd. v. ICON Health & Fitness, Inc.* (2001), 13 C.P.R. (4th) 156 (T.M.O.B.)]. As this is not the case, I find that the Opponent did not satisfy its initial evidential burden and I dismiss the ground of opposition based on non-compliance with s. 30(e) of the Act.

Non-compliance with s. 30(i) of the Act

[41] The mere fact that the Applicant may have been aware of the existence of the Opponent's trade-marks or trade-names does not preclude it from truthfully making the statements required by s. 30(i) of the Act. Where an applicant has provided the statement required by s. 30(i) of the Act, in my opinion the ground of opposition should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of an applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. As this is not such a case, I dismiss the ground of opposition based upon non-compliance with s. 30(i) of the Act.

Registrability

[42] I have exercised the Registrar's discretion to confirm that the Opponent's alleged registered trade-marks are in good standing as of today's date. Since the Opponent has discharged its initial burden with respect to this ground of opposition, the burden of proof lies on

the Applicant to convince the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion between the trade-marks at issue.

[43] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[44] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time the trade-marks have been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.) and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401 (S.C.C.) for a thorough discussion of the general principles that govern the test for confusion].

[45] In my view, the Opponent's case under the registrability ground of opposition is strongest when considering the following registered trade-marks:

- RÉNO-DÉPÔT LE PREMIER ENTREPÔT DE LA RÉNOVATION (TMA430,926)
- RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION (TMA452,238)
- RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION & Design (TMA522,617)
- RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION & Design (TMA439,001)

[46] Given the focus of the Opponent's submissions in written and oral arguments, I conclude that it agrees that the determination of the issue of confusion between the Mark and the above identified registered trade-marks will effectively decide the ground of opposition based upon s. 12(1)(d) of the Act.

[47] Unless indicated otherwise, any reference to the registered trade-marks throughout my assessment of the surrounding circumstances is a collective reference to the Opponent's trade-marks of Registration Nos. TMA430,926, TMA452,238, TMA522,617 and TMA439,001.

- *s. 6(5)(a) - inherent distinctiveness of the trade-marks and the extent to which they have become known*

[48] As recognized by the Applicant, the words L'ENTREPÔT, RÉNOVATION and QUÉBEC are descriptive. In my view, the Mark is inherently weak. Further since the use of the Mark did not enure to the benefit of the Applicant, such use does not add to the distinctiveness of the Mark in the hands of the Applicant.

[49] The Opponent has disclaimed the right to the exclusive use of the words ENTREPÔT et RÉNOVATION apart from each of the registered trade-marks. It has also disclaimed the right to the exclusive use of the word PREMIER apart from the trade-mark of Registration No. TMA430,926. Though "réno" is suggestive of "rénovation" (renovation) and "dépot" (depot) is a word of the ordinary language, the coined word "réno-dépôt" does add some measure of inherent distinctiveness to the registered trade-marks. Further, and notwithstanding the collective reference to the Opponent's trade-marks in the Lagacé affidavit, I can satisfactorily conclude that the trade-mark RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION & Design of Registration TMA522,617 is known in the Province of Quebec, and by the same token so is the trade-mark RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION of Registration No. TMA452,238.

- *s. 6(5)(b) - the length of time the trade-marks have been in use*

[50] Although the Vaillancourt affidavit evidences use of the Mark by Home Depot Canada since August 2000, the Applicant has failed to evidence that such use enures to its benefit. Thus the use of the Mark becomes of no significance.

[51] Registration No. TMA430,926 shows that the declaration of use was filed on June 2, 2004. Registration No. TMA439,001 shows that the declaration of use was filed on May 20, 2004. Registration Nos. TMA452,238 and TMA522,617 claim use since March 16, 1993. I remark that the dates of first use stated in the Lagacé affidavit are the same as the filing date of

the declaration of use or the date of first use identified in each of the corresponding registrations. In any event, in the absence of supporting evidence of use, Registration Nos. TMA430,926 and TMA439,001 can establish no more than “de minimis” use and cannot give rise to an inference of significant or continuing use of the corresponding trade-marks. However, when considering the trade-marks of Registration Nos. TMA452,238 and TMA522,617, it must be recognized that the Opponent did file evidence of use in advertisement going back to 1993.

- *s. 6(5)(c) and (d) - the nature of the wares, services or business and the nature of the trade*

[52] It is the statement of wares and services in the application and the statement of wares and services in the registrations that govern the assessment of the likelihood of confusion under s. 12(1)(d) of the Act [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe, Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)].

[53] The wares and services associated with the Mark are either identical or overlapping with wares and services listed in the Opponent’s registrations. Clearly the parties are in the same business and their clientele is the same.

- *s. 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them*

[54] In most instances, the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145, conf. 60 C.P.R. (2d) 70 (F.C.T.D.)].

[55] The Applicant’s submission with respect to differences between the trade-marks in appearance, sound and in the ideas suggested by them is based on the importance of the first component of a trade-mark for the purpose of distinction. Specifically, the Applicant contends that the use of the Opponent’s house mark RÉNO-DÉPÔT, as the first portion of the registered trade-marks, precludes any reasonable likelihood of confusion.

[56] In its written argument, the Applicant sought support from the decision *Merril Lynch & Co. v. Bank of Montreal* (1996), 66 C.P.R. (3d) 150 (F.C.T.D.) where Justice Gibson approved the Registrar conclusion that the public, already familiar to some extent with the applicant's house mark FIRSTBANK would not believe that there was any connection between the financial services associated with its mark FIRSTBANK CASH MANAGEMENT ACCOUNT and the financial services offered by the opponent. However, I agree with the Opponent that the present case is distinguishable, if only because each party's house mark was the first portion of the trade-marks at issue in the *Merril Lynch* case.

[57] In oral argument, the Applicant referred to a few decisions in which trade-marks were found not to be confusing. Suffice it to say that the issue of confusion between the Mark and the registered trade-marks of the Opponent is a question of probabilities and surrounding circumstances based on the particular facts of this case. In other words, each case must be decided upon its own merit. For example, I do not consider the decision *Questor Commercial Inc. v. Discoverer Services Ltd.* (1976), 46 C.P.R. (2d) 58 (F.C.T.D) to be of assistance to the Applicant. In *Questor Commercial*, the evidence established that the words "muffler centre", which were the shared feature of the trade-marks, were generic and common to the trade. Even if I recognize the descriptive connotation attaching to the words L'ENTREPÔT DE LA RÉNOVATION, there is no evidence here that these words are commonly used in the trade.

[58] Notwithstanding the prefix RÉNO-DÉPÔT in the registered trade-marks, I am of the view that the trade-marks at issue, when considered as a whole, resemble each other to a fairly high degree. Although the Applicant has added "DU QUÉBEC" to "L'ENTREPÔT DE LA RÉNOVATION", the added words are descriptive and thus cannot serve to distinguish the Mark from the Opponent's registered trade-marks in any significant manner. Furthermore, I do not consider that the presence of RÉNO-DÉPÔT in the registered trade-marks result in significant difference between the ideas suggested.

- *Additional surrounding circumstances*

[59] The Applicant submits that the use of the Mark in close proximity to its trade-marks HOME DEPOT and HOME DEPOT & Design on storefront signage and entrance doors serves

to further distinguish the Mark from the registered trade-marks. The Applicant also relies on the evidence that no confusion has occurred as a further additional surrounding circumstance supporting its case. In reply, the Opponent argued that the use of the Mark in close proximity to the HOME DEPOT marks is not relevant and that there was no burden upon the Opponent to evidence instances of confusion between the Mark and the registered trade-marks.

[60] The Applicant's argument based on the use of its trade-marks HOME DEPOT and HOME DEPOT & Design in close proximity to the Mark would be more suitable in a passing off action. In fact, the manner the Mark appears on storefront signage might explain the lack of instances of confusion alleged by Ms. Vaillancourt. That being said, when considering the ground of opposition based upon s. 12(1)(d) of the Act, I must determine whether the Mark as applied for registration, not the Mark as appearing on storefront signage, may be confusing with the Opponent's registered trade-marks [see *Groupe Fruits & Passion Inc./ The Fruits & Passion Group Inc. v. Clarke*, 2007 CarswellNat 2319 (T.M.O.B.)].

Conclusion on the likelihood of confusion

[61] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. In view of my analysis above, I find that the Applicant has not discharged its burden of showing, on a balance of probabilities, that the Mark is not confusing with the Opponent's registered trade-marks.

[62] Having regard to the foregoing, the registrability ground of opposition based upon Registration Nos. TMA430,926, TMA452,238, TMA522,617 and TMA439,001 is successful.

Non-entitlement

[63] Despite the burden of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-marks or trade-names, the Opponent has the initial onus of proving that the trade-marks and trade-names alleged in support of its grounds of opposition based upon s. 16(3)(a) and s. 16(3)(c) of the Act were being used at the material date and had not been abandoned at the date of advertisement of the application [s. 16(5) of the Act].

Section 16(3)(a) the Act

[64] Once again, I consider that the Opponent's case under this ground of opposition is strongest when considering the RENO-DÉPÔT Marks involving the words L'ENTREPÔT DE LA RÉNOVATION. However, I have previously concluded that the Opponent did not introduce reliable evidence of use of its trade-marks RÉNO-DÉPÔT LE PREMIER ENTREPÔT DE LA RÉNOVATION of Registration No. TMA430,926 and RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION & Design of Registration No. TMA439,001 [see paragraph 27]. Accordingly, I find that the Opponent has failed to meet its initial onus under the non-entitlement ground of opposition when considering these two trade-marks.

[65] In oral argument, the Applicant submitted that the removal of the words L'ENTREPÔT DE LA RÉNOVATION from the Opponent's storefront signage in January 2000 showed that at the filing date of the application, the Opponent had the intention to abandon the trade-marks. Since the Applicant has sought support from the decision *Labatt Brewing Co. v. Molson Breweries, a partnership* (1992), 42 C.P.R. (3d) 481 (F.C.T.D.), I would remark that this decision clearly confirms the principle that the issue of abandonment of a trade-mark is a question of facts to be decided on the merits of each case in view of all the surrounding circumstances.

[66] I recognize that the evidence of use of the trade-marks RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION of Registration No. TMA430,926 and RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION & Design of Registration No. TMA522,617 is not overwhelming. In fact, I have previously concluded that the Opponent did not file evidence of use of these two trade-marks in association with the Wares within the meaning of s. 4(1) of the Act. Still, based on the evidence before me and given the particular facts of this case, I am not prepared to conclude that the Opponent had the intention to abandon these two trade-marks at the filing date of the application. Further, I am satisfied that the Opponent has met its initial onus with respect to its trade-marks RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION of Registration No. TMA430,926 and RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION & Design of Registration No. TMA522,617. Therefore, the burden of proof rests upon the Applicant to

establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the trade-marks.

[67] My conclusions under the registrability ground of opposition are applicable to the non-entitlement ground of opposition. Indeed, the difference in relevant dates does not affect my assessment with respect to the probabilities of confusion, nor does the fact that the Opponent's evidence of use is restricted to services. Surely, the wares identified in the application are related to the services.

[68] Having regard to the foregoing, I find that the non-entitlement ground of opposition based upon confusion with the previously used marks RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION of Registration No. TMA430,926 and RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION & Design of Registration No. TMA522,617 is successful.

[69] For all intent and purpose, I note that even if I had accepted the Applicant's argument on the abandonment of the Opponent's trade-marks, the overall outcome of the opposition would be the same as it would still be successful on the registrability ground of opposition. I would also note that, at the oral hearing, the Applicant has acknowledged that its contention on the abandonment of the Opponent's trade-marks is of no significance under the ground of opposition based upon s. 12(1)(d) of the Act, as the registrations are extant. I would add that the validity of the Opponent's registrations is not at issue in this proceeding.

Section 16(3)(c) of the Act

[70] Although the Opponent alleged various trade-names in support of this ground of opposition, it is apparent that they are variations of either its corporate name Réno-Dépôt Inc. or of its trade-name Réno-Dépôt. In fact, the ground of opposition appears to be a "boilerplate" pleading. As stated by Board Member Herzig in *3103-2964 Quebec Inc. v. Philhobar Design Canada Ltd.*, 2009 CarswellNat 1688: "Such pleadings are to be discouraged because, among other things, they distract from a party's legitimate concerns."

[71] As Mr. Lagacé's assertions of use of the Opponent's corporate name and trade-name since 1993 does not by itself constitute evidence of use, I find that the Opponent did not discharge its burden of showing prior use of either the corporate name Réno-Dépôt Inc., the trade-name Réno-Dépôt or of any variations thereof. Accordingly, I dismiss the ground of opposition based upon s. 16(3)(c) of the Act. I would add that even if the Opponent had discharged its initial burden under this ground of opposition, the outcome would have been the same as I would have found the differences between the Opponent's corporate name or trade-name and the Mark were more than sufficient to make confusion unlikely.

Distinctiveness

[72] As I have already found in favour of the Opponent under two grounds of opposition, I will not discuss the last ground of opposition, which was pleaded as a three-prong ground of opposition.

DISPOSITION

[73] Having regard to the foregoing, and with the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

DATED AT MONTREAL, QUEBEC, THIS 12th DAY OF NOVEMBER 2009.

Céline Tremblay
Member
Trade-marks Opposition Board