



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

**Citation: 2013 TMOB 104**  
**Date of Decision: 2013-05-29**

**IN THE MATTER OF OPPOSITIONS**  
**by Chery Automobile Co. Ltd. to**  
**application No. 1,402,824 for the trade-**  
**mark A & Design in the name of Baoli**  
**Wang**

[1] On July 10, 2008, Baoli Wang (the Applicant) filed an application to register the trademark A & Design (the Mark), under application No. 1,402,824, as shown below.



The application is based upon proposed use in association with the following wares:

Cars; motor vehicles, namely, cars, trucks, vans; automobiles; pickup trucks; locomotives; electric vehicles, namely, railway cars, motorized scooters, electrical buses; motors for automobiles; land vehicle part, namely, drive gears; motorcycles; automobile bodies; vehicles for locomotion by land, air, water or rail, namely, automobiles and structural parts, boats, railway cars; automobile tires (the Wares)

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of March 23, 2011.

[3] On May 18, 2011, Chery Automobile Co. Ltd. (the Opponent) filed a statement of opposition. The Applicant responded by filing and serving a counter statement. The Opponent subsequently requested and was granted leave to file an amended statement of opposition. The grounds of opposition, as amended, can be summarized as follows:

- Pursuant to sections 38(2)(a) and 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), the application does not comply with the requirements of section 30(e) of the Act. In particular, at the time of filing the application, the Applicant did not intend to use the Mark in Canada in association with all of the Wares, since sales of automobiles, locomotives, railway cars and electrical buses, for example, require significant capital investment and business activity.
- Pursuant to sections 38(2)(a) and 30 of the Act, the application does not comply with the requirements of section 30(i) of the Act, since:
  - at the time of filing the application, the Mark was confusing, within the meaning of subsection 6(2) of the Act, with the Opponent’s A & Design trade-mark (shown below), which had been previously used or made known in Canada in association with “cars, automotive motor vehicles, trucks, vans, automotive engines, automotive transmissions and related automotive vehicle parts and accessories” (the Opponent’s Wares) since at least as early as February 2008; and
  - the applicant is not the owner of copyright in the design that is the subject of application No. 1,402,824. Rather, the Opponent is the owner of the copyright in a design that is identical to the Mark (shown below).



- Pursuant to sections 38(2)(c) and 16(3)(a) of the Act, the Applicant is not the person entitled to registration of the Mark, since at the date of filing the application, the Mark was confusing with the Opponent’s A & Design trade-mark, which had been previously used or made known in Canada since at least as early as February 2008 in association with the Opponent’s Wares.
- Pursuant to sections 38(2)(d) and 2 of the Act, the Mark is not distinctive since it does not distinguish nor is it adapted to distinguish the Applicant’s Wares from those of others. Furthermore, the Mark is not distinctive of the Applicant because the Applicant is not the owner of copyright in the design that is the subject of the Mark. Rather, the Opponent is the owner of such copyright and has not granted permission for such use or registration by the Applicant.

[4] In support of its opposition, the Opponent filed two affidavits of Alexandra Andersen (dated December 5 and 6, 2011, respectively), as well as a certified copy of Canadian copyright registration No. 1090977. Ms. Andersen was not cross-examined on her affidavits.

[5] The Applicant, in turn, filed the affidavit of Baoli Wang, the Applicant himself. Mr. Wang’s affidavit consists only of printouts of the first six pages of the results of a Google search

conducted on March 23, 2012 for “A & Design”. Mr. Wang was not cross-examined on his affidavit.

[6] Only the Opponent filed a written argument; an oral hearing was not conducted. I have considered all of the submissions and the evidence of record. Reference will only be made in my decision to those parts of the submissions and evidence which I consider directly relevant to my findings.

#### Onus and Material Dates

[7] The Applicant bears the legal onus of establishing, on a balance of probabilities, that his application complies with the requirements of the Act. There is, however, an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

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

- sections 38(2)(a) and 30 – the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- sections 38(2)(c) and 16(3) – the filing date of the application [see section 16(3)];
- sections 38(2)(d) and 2 – the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

#### Non-compliance Ground of Opposition - Section 30(e) of the Act

[9] Since the application contains a statement that the Applicant by itself or through a licensee intends to use the Mark in Canada, it formally complies with section 30(e) of the Act.

[10] There is no evidence of record to suggest a lack of intention to use the Mark on the part of the Applicant. As a result, I dismiss the ground of opposition based upon non-compliance with section 30(e) for the Opponent having failed to meet its evidential burden.

## Non-compliance Ground of Opposition – Section 30(i) of the Act

[11] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155].

[12] The Opponent pleads two grounds of opposition based on non-compliance with section 30(i) of the Act. The first is based upon an allegation that the Mark was confusing with the Opponent's trade-mark A & Design which it alleged to have previously used or made known in Canada since at least as early as February 2008 in association with automobile vehicles and parts and accessories therefore. The Opponent's evidence deals exclusively with use and reputation for the Opponent's mark in foreign jurisdictions. There is no evidence of use or making known for the Opponent's mark in Canada. Even if the Opponent had established use or making known of its mark in Canada at the relevant time, the Applicant's awareness of the Opponent's allegedly confusing mark is not sufficient to support a ground of opposition based on non-compliance with section 30(i) of the Act. The first ground of opposition based on non-compliance with section 30(i) is accordingly dismissed.

[13] The second ground of opposition based on non-compliance with section 30(i) of the Act is based on an allegation that the Mark infringes copyright which exists in the Opponent's A & Design mark (the Work).

[14] Non-compliance with section 30(i) can be found where a *prima facie* case of non-compliance with a federal statute is made out [see for example *Interprovincial Lottery Corp v Monetary Capital Corp* (2006), 51 CPR (4th) 447 (TMOB) and *Canadian Bankers' Assn v Richmond Savings Credit Union* (2000), 8 CPR (4th) 267 (TMOB)]. In this case, the Opponent has alleged a violation of the *Copyright Act* RSC, 1985, c C-42. In order to succeed in this ground of opposition, the Opponent must establish a *prima facie* case of copyright infringement [see *E Remy Martin & Co SA v Magnet Trading Corp (HK) Ltd.* (1988), 23 CPR (3d) 242 (TMOB)].

[15] I agree with the Opponent that the following evidence and submissions are sufficient to make out a *prima facie* case of copyright infringement:

- (a) the Work is an artistic work created by Yin Tongyue, Board Chairman of the Opponent and a Chinese national (Andersen affidavit No. 1, Exhibit F);
- (b) the Work was first published on March 18, 1999 in China (Andersen affidavit No. 1, Exhibit F);
- (c) the author and first owner of copyright in the Work (Mr. Tongyue) assigned all right, title and interest in and to the Work and all copyright in Canada and all other countries of the world relating thereto to the Opponent effective April 18, 1999 (Andersen affidavit No. 1, Exhibit F);
- (d) both Canada and China were signatories to the *Berne Convention for the Protection of Literary and Artistic Works* as of the date the Work was published and assigned. By virtue of the reciprocity and national treatment provisions of the *Berne Convention* copyright also subsisted in the Work in Canada as of the date of publication of the work (March 18, 1999) (Andersen affidavit No. 2, Exhibits A and B);
- (e) trade-marks comprising the Work have been used extensively throughout the world (although notably, not in Canada) by the Opponent in association with automotive vehicles, parts and accessories (Andersen affidavit No. 1, Exhibit D); and
- (f) the Mark is identical to the Work.

[16] While the Work is the subject of a formal copyright registration which issued on November 2, 2011 under No. 1090977 (Andersen affidavit No. 1, Exhibit F and certified copy of the copyright registration No. 1090977), this registration post-dates the material date for this ground of opposition. However, this does not prevent the Opponent from making out a *prima facie* case of copyright infringement. I am satisfied that the evidence shows that at the material date copyright existed in the Work, the Opponent owned said copyright, and the Mark is an identical copy of the Work.

[17] The Opponent has thus succeeded in meeting its evidential burden and the Applicant has failed to provide any evidence in response. Specifically, the Opponent points out that the Applicant failed to provide any evidence disputing the Opponent's claim of ownership of copyright in the work or evidence of independent creation of the Mark.

[18] I find that the Applicant has not met his onus of demonstrating that he was satisfied that he had the right to use the Mark in Canada. This ground of opposition is therefore successful.

Non-Entitlement Ground of Opposition – Section 16(3)(a) of the Act

[19] The Opponent has the initial onus of proving that its A & Design trade-mark alleged in support of its ground of opposition based on section 16(3)(a) of the Act, was used or made known in Canada prior to the filing date of the Applicant's application (July 10, 2008) and was not abandoned at the date of advertisement of the application for the Mark (March 23, 2011) [section 16(5) of the Act].

[20] The Opponent has provided significant evidence of use and reputation for its A & Design mark in foreign countries. Specifically, Ms. Andersen provides evidence of use and advertising of the A & Design mark in Argentina, Chile, Dubai, Egypt, Indonesia, Panama, Peru, Russia, Singapore, South Africa, Thailand, Turkey, Ukraine, Uruguay, Venezuela and Vietnam (Andersen affidavit No. 1, Exhibit D). That said, there is no evidence that the use and advertising in these foreign countries has spilled over in any way into Canada. Ms. Andersen also provides printouts from the Opponent's website which displays the A & Design mark (Andersen affidavit No. 1, Exhibit B) but there is no evidence that any Canadians have accessed this website.

[21] While I am satisfied that the Opponent has established a significant reputation for its A & Design mark in foreign countries, the evidence is not sufficient to establish use or making known of the A & Design mark in Canada. The Opponent has thus failed to meet its evidential burden and this ground of opposition is dismissed.

Non-Distinctiveness Ground of Opposition – Section 38(2)(d) of the Act

[22] The Opponent pleads a two-pronged non-distinctiveness ground of opposition. The first prong is based on a broad allegation that the Mark does not distinguish and is not adapted to distinguish the Wares from those of others. The Opponent has not specifically pleaded the identity of the "others" although when the pleadings are considered in conjunction with the evidence I am willing to infer that "others" relates to the Opponent and its A & Design mark [see *Novopharm Limited v AstraZeneca AB* (2002), 21 CPR (4th) 289 (FCA)].

[23] With respect to this first prong of the non-distinctiveness ground, the Opponent must show that as of the filing of the statement of opposition, namely May 18, 2011, its A & Design mark had become known sufficiently to negate the distinctiveness of the Mark [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC); *Motel 6, Inc v No. 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD)]. As discussed in more detail above in the analysis of the non-entitlement ground of opposition, the Opponent has failed to provide any evidence showing a reputation for its A & Design mark in the Canadian marketplace. The Opponent has failed to meet its evidential burden and the first prong of the non-distinctiveness ground of opposition is dismissed.

[24] The second prong of the non-distinctiveness ground of opposition alleges that the Mark is not distinctive of the Applicant because the Applicant is not the owner of copyright in the design that is subject of the Mark. Rather, the Opponent is the owner of such copyright and it has not granted permission for use or registration of the Work by the Applicant.

[25] I am not satisfied that the existence of a copyright in the Work and an allegation that the Applicant has not been granted permission to use this copyright, as has been pleaded, would be sufficient to find that the Mark is not distinctive or cannot distinguish the Applicant's Wares from those of others in the marketplace. Thus I find that this is not a proper ground of opposition and I reject the second prong of the non-distinctiveness ground accordingly.

### Disposition

[26] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

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Andrea Flewelling  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office