

**IN THE MATTER OF AN OPPOSITION
by Alexander K. Arthur to application No. 670,379
for the trade-mark RENTERS NEWS & Design
filed by Auto Mart Magazine Limited**

On November 13, 1990, the applicant, Auto Mart Magazine Limited, filed an application to register the trade-mark RENTERS NEWS & Design (illustrated below) based on use in Canada since July of 1990 with the following wares:

periodical publications featuring advertisements for apartments, homes, condominiums [sic], co-op rooms and shared accommodations.

The application includes a disclaimer to the right to the exclusive use of the words RENTERS and NEWS apart from the applied for mark. The application was advertised for opposition purposes on November 27, 1991.

The opponent, Alexander K. Arthur, filed a statement of opposition on March 26, 1992 and a revised statement of opposition on June 2, 1992. A copy of the revised statement was forwarded to the applicant on June 23, 1992. The first ground of opposition is that the application does not comply with the provisions of Section 30(i) of the Trade-marks Act because the applicant could not have been satisfied that it was the person entitled to use the applied for trade-mark in Canada. In support of this ground, the opponent alleged that he met with the applicant in the fall of 1989 and revealed details of his business plan in relation to his trade-name The Toronto Rental News.

The second ground of opposition is that the applicant is not the person entitled to registration of its applied for mark pursuant to Section 16(1)(c) of the Act because, as of the

applicant's claimed date of first use, the applied for mark was confusing with the trade-name The Toronto Rental News previously used by the opponent. The third ground is that the applied for trade-mark is not registrable pursuant to Section 12(1)(b) of the Act because it is clearly descriptive of the character or quality of the applicant's wares. The fourth ground of opposition is that the applied for mark is not distinctive in view of the opponent's use of its trade-name and in view of use by others of the name Renter's News.

The applicant filed and served a counter statement. The opponent's evidence consists of an affidavit of Alexander Kojo Arthur. As its evidence, the applicant filed an affidavit of its President, William F. Francis. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

As for the first ground of opposition, the applicant has formally complied with the provisions of Section 30(i) of the Act by including the required statement in its application. The issue then becomes whether or not the applicant has substantively complied with that subsection - i.e. - was the statement true when the application was filed? Although the onus or legal burden is on the applicant to show its compliance with Section 30(i), there is an evidential burden on the opponent to prove the facts he has alleged in support of this ground.

The opponent contends that the applicant could not have truthfully made the statement required by Section 30(i) as a consequence of a meeting that took place between him and Mr. Francis on or about October 5, 1989. In paragraph six of his affidavit, Mr. Arthur states that he presented a business proposal to Mr. Francis for a renter's news advertising publication called Renter's News. In paragraph seven of his affidavit, Mr. Arthur states that Mr. Francis photocopied an ad board displaying Mr. Arthur's proposed front cover for Renter's News. Appended as Exhibit B to Mr. Arthur's affidavit is a copy of that ad board which, contrary to Mr. Arthur's statement, does not show the name Renter's News but rather the name The Toronto Rental News. The other examples of the opponent's advertising and promotional materials appended to his affidavit (Exhibits C to F) also do not use the name Renter's News but refer to different names and, in fact, do not refer to a publication but rather to a telephone

service. Furthermore, two of the examples refer to an entity other than the opponent, namely a company identified as either Conrentad Inc. or Comrentad Inc.

Although there is no doubt that a meeting took place between Mr. Arthur and Mr. Francis (as confirmed by Mr. Francis in his affidavit), Mr. Arthur's version of what occurred at that meeting is not fully supported by his own affidavit. Consequently, I find that the opponent has failed to meet his evidential burden and the first ground of opposition is therefore unsuccessful. Thus, it was unnecessary to consider Mr. Francis' version of the meeting although it should be noted that his affidavit is to be preferred since it contains fewer discrepancies.

As for the second ground of opposition, there was an evidential burden on the opponent to evidence use of his trade-name The Toronto Rental News prior to the applicant's claimed date of first use. Mr. Arthur evidences an Ontario business name registration for the name The Toronto Rental News Publication on September 21, 1989 but he failed to evidence that he carried on any business under that name or his claimed trade-name at any time. Thus, Mr. Arthur failed to evidence prior use of his trade-name and the second ground of opposition is therefore also unsuccessful.

As for the third ground of opposition, Section 12(1)(b) of the Act reads as follows:

- 12. (1) Subject to section 13, a trademark is registrable if it is not....
- (b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin.... (emphasis added)

The material time for considering the circumstances respecting this issue is the date of my decision: see the decision in Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers (1992), 41 C.P.R.(3d) 243 (F.C.A.). The issue is to be determined from the point of view of an everyday user of the wares. Furthermore, the trade-mark in question

must not be carefully analyzed and dissected into its component parts but rather must be considered in its entirety and as a matter of first impression: see Wool Bureau of Canada Ltd. v. Registrar of Trade Marks (1978), 40 C.P.R.(2d) 25 at 27-28 and Atlantic Promotions Inc. v. Registrar of Trade Marks (1984), 2 C.P.R.(3d) 183 at 186.

The words RENTERS NEWS clearly describe the character of the applicant's publication, namely a newspaper that provides information in the form of advertisements directed at renters. The applicant's own promotional brochure (Exhibit B to the Francis affidavit) emphasizes the descriptiveness of its mark by using such phrases as "Renters News is tailored to the renters market...." and "...it is the #1 Rental Guide in Metro...." Furthermore, the applicant has disclaimed both words from its mark.

The applicant's position is that there is sufficient design matter in its mark to render it registrable even if the words RENTERS NEWS are clearly descriptive. To the extent that the mark is viewed, I agree with the applicant's contention. However, Section 12(1)(b) of the Act also prohibits the registration of trade-marks that are clearly descriptive when sounded and the only way that consumers would sound the applicant's mark is by using the clearly descriptive words RENTERS NEWS. Thus, the applied for mark offends Section 12(1)(b) of the Act and the third ground is successful. The applicant relied on the decision in Lake Ontario Cement Ltd. v. Registrar of Trade Marks (1976), 31 C.P.R.(2d) 103 (F.C.T.D.) where a disclaimer of the descriptive word PREMIER was held sufficient to allow registration of a mark due to the additional design matter included in the mark. However, the issue of the sounding of the mark was not considered in that case. Furthermore, that case is distinguishable because the additional design matter included a large stylized letter P apart from the word PREMIER which presumably could be sounded instead of, or together with, the word PREMIER.

As for the fourth ground of opposition, the material time for considering the circumstances respecting the issue of distinctiveness is as of the filing of the opposition. The

onus or legal burden is on the applicant to show that its applied for trade-mark actually distinguishes or is adapted to distinguish its wares from those of others throughout Canada. There is, however, an evidential burden on the opponent to prove his supporting allegations of fact.

As discussed, the opponent has failed to evidence use of his trade-name The Toronto Rental News. More importantly, he failed to evidence any reputation of note for that name. As for alleged third party uses of the name Renter's News, the only evidence Mr. Arthur provided is Exhibit G to his affidavit which he describes as the front page of the Winnipeg Renter's News. However, Mr. Arthur failed to evidence the extent to which this publication has been circulated. Thus, I cannot assume any acquired reputation for that third party mark. The opponent has failed to satisfy his evidential burden respecting both heads of his fourth ground of opposition and it is therefore unsuccessful.

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

DATED AT HULL, QUEBEC, THIS 8th DAY OF DECEMBER 1995.

**David J. Martin,
Member,
Trade Marks Opposition Board.**