

**IN THE MATTER OF AN OPPOSITION by St.
Paul Fire and Marine Insurance Company to
application No. 1,098,992 for the trade-mark ST
PAUL Design filed by Hotel St-Paul de Montréal
Inc.**

[1] On April 9, 2001, Hotel St-Paul de Montréal Inc. (the Applicant) filed an application to register the trade-mark ST PAUL Design (the Mark) based upon use of the Mark in Canada in association with “services de l’hôtellerie” since January 1, 2001. The Mark is shown below:

S^T P A U L

[2] The application was advertised for opposition purposes in the Trade-marks Journal of December 25, 2002. In the advertisement, the services have been translated as “hotel services”.

[3] On November 17, 2003, St. Paul Fire and Marine Insurance Company (the Opponent) filed a statement of opposition. The Applicant filed and served a counter statement in which it denied the Opponent’s allegations.

[4] In support of its opposition, the Opponent filed a certified copy of registration No. TMA455,628.

[5] In support of its application, the Applicant filed an affidavit of its President, Javier Planas, and a certified copy of registration No. TMA538,986. The Opponent did not seek to cross-examine the Applicant’s affiant.

[6] Only the Applicant filed a written argument. An oral hearing was not requested.

Onus

[7] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is 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 C.P.R. (3d) 293 (F.C.T.D.) at 298].

[8] The Opponent has pleaded six grounds of opposition and has not met its initial burden with respect to the following five:

- s. 30(a): there is no evidence that the Mark has not been used by the Applicant since the date alleged in the application in connection with the services set out therein;
- s. 30(i): there is no evidence that the Applicant could not have been satisfied that it was not entitled to use the Mark in Canada;
- s. 16(1)(a): there is no evidence that the Opponent's trade-mark THE ST. PAUL had been used in Canada prior to January 1, 2001 - the mere filing of a certified copy of an opponent's registration will not support the opponent's evidential burden with respect to grounds of opposition based on allegations of non-entitlement [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.)];
- s. 16(1)(c): there is no evidence that the Opponent used the trade-name THE ST. PAUL in Canada prior to January 1, 2001;
- s. 2: there is no evidence that the Opponent's trade-mark THE ST. PAUL had been used or made known in Canada prior to November 17, 2003 - the mere filing of a certified copy of an opponent's registration will not support the opponent's evidential burden with respect to grounds of opposition based on allegations of non-distinctiveness [see *Entre Computer Centers, Inc. v. Global Upholstery Co., supra*].

[9] Accordingly, the five aforementioned grounds of opposition fail.

Section 12(1)(d) Ground of Opposition

[10] The Opponent has met its initial burden with respect to the ground that the Mark is not registrable pursuant to s. 12(1)(d) of the Act because the Mark is confusing with the trade-mark THE ST. PAUL registered under No. TMA455,628, by evidencing that such registration is extant. The services covered by the registration are "insurance services, namely, reinsurance underwriting services."

[11] The material date for assessing the likelihood of confusion under this ground is the date of my decision [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)].

[12] 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.

[13] 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 each has 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, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.).]

the inherent distinctiveness of the trade-marks and the extent to which they have become known

[14] Each mark is inherently distinctive; however, the words ST. PAUL have a geographic significance with respect to each as the Opponent is located in the city of St. Paul, Minnesota [see application] and the Applicant's hotel is located on McGill St. at the corner of St-Paul in Montreal [see Exhibit JP-3, Planas affidavit].

[15] There is no evidence that the Opponent's mark has become known to any extent whereas there is evidence that the Applicant's Mark has become known through use, advertisement and the winning of awards [see, for example, Exhibits JP-3 and JP-5, Planas affidavit].

the length of time each has been in use

[16] The Opponent's registration claims use of its mark since at least as early as 1951, whereas the Applicant claims use of its Mark since at least January 1, 2001 (see paragraph 8, Planas affidavit).

the nature of the wares, services, business and trade

[17] There is no apparent connection between hotel services and insurance services. Nor is there any evidence that the parties' channels of trade are connected in any way.

the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[18] There is a high degree of resemblance between the Applicant's Mark and the Opponent's mark in appearance, sound and ideas suggested.

conclusion re s. 12(1)(d)

[19] Having considered all of the surrounding circumstances, I am satisfied that confusion between the marks is not likely. Although the marks are very similar, the associated services are completely different. It would not be appropriate for the Opponent's registered mark to be accorded a broad scope of protection both because there is no evidence that it has any reputation in Canada at the present time and because the words ST. PAUL have a geographic significance. Overall, I am satisfied that the ordinary consumer would not, as a matter of first impression, think that THE ST. PAUL insurance services and ST. PAUL Design hotel services emanate from a common source.

[20] The s. 12(1)(d) ground of opposition is accordingly dismissed.

Disposition

[21] Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

DATED AT TORONTO, ONTARIO, THIS 21st DAY OF DECEMBER 2009.

Jill W. Bradbury
Member
Trade-marks Opposition Board