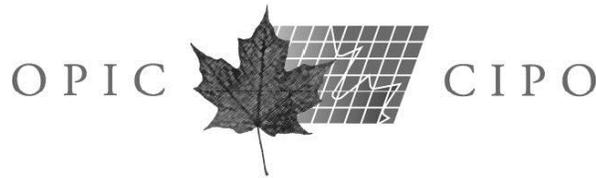


# TRANSLATION/TRADUCTION



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

**Citation: 2011 TMOB 109**  
**Date of Decision: 2011-06-10**

**IN THE MATTER OF AN OPPOSITION by  
Nautilus Plus Inc. and 88766 Canada Inc. to  
application No. 1,297,418 for the trade-mark  
STOP NIGHTSHIFT BLUES in the name of  
Centres Stop Inc.**

## Proceedings

[1] On April 11, 2006, Centres Stop Inc. (the Applicant) filed an application to register the trade-mark STOP NIGHTSHIFT BLUES (the Mark) on the basis of proposed use in association with

Naturopathic support products namely homeopathic drops, gel caps and pills for reducing stress, insomnia and depression related to lack of sunlight and a normal life schedule; Educational publications, namely books, printed articles, pamphlets and workbooks and worksheets relating to reducing stress, insomnia and depression related to lack of sunlight and a normal life schedule (the Wares);

Health services namely auricular therapy for reducing stress, insomnia and depression related to lack of sunlight and a normal life schedule; Counselling, support and rehabilitation services for reducing stress, insomnia and depression related to lack of sunlight and a normal life schedule; Educational services namely designing and providing educational programs, materials and information relating to reducing stress, insomnia and depression related to lack of sunlight and a normal life schedule and other health and wellness and healthy lifestyle programs and providing educational seminars by Internet with respect to reducing stress, insomnia and depression related to lack of sunlight and a normal life schedule. (the Services).

[2] This application was advertised for opposition purposes on April 4, 2007, in the *Trade-marks Journal*. Nautilus Plus Inc. (Nautilus) and 88766 Canada Inc. (the Opponent) filed a joint statement of opposition on June 4, 2007, which the Registrar forwarded to the Applicant on July 12, 2007. On November 6, 2007, the Applicant filed a counter statement denying all of the grounds of opposition described below. Nautilus and the Opponent amended their statement of opposition, and the Applicant amended its counter statement accordingly.

[3] As Rule 41 evidence, Nautilus and the Opponent filed certificates of authenticity concerning the registered marks listed in their statement of opposition. As Rule 42 evidence, the Applicant filed Stephen Wallack's affidavit, dated December 8, 2008.

[4] The parties filed written submissions and were represented at an oral hearing.

[5] Three days before the scheduled hearing date, the Registrar was informed that Nautilus was withdrawing its opposition. Therefore, the Opponent's opposition remains to be decided.

#### Grounds of opposition

[6] The various grounds of opposition raised by the Opponent in its statement of opposition amended on July 18, 2008, may be summarized as follows:

- 1) On the filing date of the application, the Applicant was using or had already used the Mark in Canada, contrary to s. 30 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (Act);
- 2) The trade-mark proposed for use is not the Mark, but another, different trade-mark.
- 3) The Applicant never intended to use the Mark in Canada in association with the Wares (s. 30(e) of the Act);
- 4) Given the Applicant's knowledge of the rights of third parties or opponents and the illegality of any use, the Applicant falsely stated being satisfied that it was entitled to use the Mark in Canada (s. 30(i) of the Act);
- 5) The application does not contain a statement in ordinary commercial terms of the wares or services (s. 30(a) of the Act);
- 6) The Mark is not registrable under s. 12(1)(d) of the Act, as it is confusing with the following registered trade-marks:

CARE-FREE SNORE STOPPER, registration TMA656,081, for an oral device, namely an apparatus designed and fitted for individuals to eliminate snoring;  
HEMOR-STOP, registration TMA256,558, for suppositories to treat hemorrhoids;  
BLOOD STOP, registration TMA666,933, for dressings, bandages and bands for medical use;  
SNORE STOP, registration TMA492,013, for homeopathic preparations to prevent snoring;  
STOP'N GROW and design, registration TMA162,143 for “nail biting deterrent preparations”;  
TABASTOP, registration TMA383,956, for tablets to stop smoking.

- 7) The Mark is not, and cannot be, distinctive of the Wares and Services because it does not distinguish the Applicant's Wares and Services from the wares and services of others, considering the presence on the market and in the register of STOP-type trade-marks for wares and services of the same nature as those stated in this application for registration;
- 8) The Mark is not, and cannot be, distinctive of the Wares and Services because the Applicant allowed third parties to use the Mark outside the scope of the legislative provisions governing licensed use, contrary to s. 50 of the Act;
- 9) The Mark is not, and cannot be, distinctive of the Wares and Services because as a result of its transfer, there subsisted rights in two or more persons to the use of the Mark, and those rights were exercised concurrently by those persons, contrary to s. 48(2) of the Act.

#### Burden of proof when opposing the registration of a trade-mark

[7] In proceedings to oppose the registration of a trade-mark, the opponent must present enough evidence in relation to the grounds of opposition raised to show clearly that there are facts supporting those grounds of opposition. If the opponent meets this requirement, the applicant must satisfy the Registrar, on a balance of probabilities, that the grounds of opposition should not prevent registration of the mark [see *Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 and *John Labatt Ltd. v. Molson Companies Limited* (1990), 30 C.P.R. (3d) 293].

#### Grounds of opposition summarily decided

[8] The Opponent failed to submit any evidence to prove the allegations made in its statement of opposition except for the certificates of authenticity for the registered trade-marks listed under the sixth ground of opposition. In the circumstances, I dismiss all of the grounds of opposition except for the sixth ground, which I will address in greater detail below.

[9] I must point out that in the [TRANSLATION] “ARGUMENTS” section of its written submissions, the Opponent simply submits that the Mark is not distinctive because it is descriptive. The Opponent also contends that the Applicant is abusively placing the symbols “MC” and “TM” close to what the Opponent considers to be descriptive expressions rather than trade-marks. The grounds of opposition concerning the distinctiveness of the Mark (grounds 7, 8, and 9) are limited in scope because of the alleged facts they set forth. Therefore, I do not see how the arguments made by the Opponent in its submissions can fall under any of these grounds of opposition.

[10] Despite the fact that the Opponent met its initial burden of proof concerning the sixth ground of opposition, that ground should be dismissed summarily for the reasons that follow.

[11] First, the Opponent’s written submissions contain no argument in support of this ground of opposition. Furthermore, at the hearing, the agent for the Opponent made no representations concerning this point of opposition, stating only that he was relying on the written submissions, which are silent on this ground of opposition.

[12] The applicable test in this case is described at s. 6(2) of the Act. Thus, the use of the Mark will cause 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 and services associated with those trade-marks are manufactured, sold, hired or performed by the same person, whether or not the wares or services are of the same general class. A non-exhaustive list of relevant circumstances appears at s. 6(5) of the Act. In the recent decision *Masterpiece Inc. v. Alavida Lifestyles Inc.*, 2011 SCC 27, the Supreme Court of Canada interpreted s. 6(2) and clarified the scope of the various criteria listed at s. 6(5) of the Act. This analysis shows that the most important factor is still the degree of resemblance between the marks at issue.

[13] However, in this case, not only are the marks referenced by the Opponent different phonetically, visually and in terms of the ideas they suggest, but the wares and services covered by those registrations are different from the Wares and Services.

[14] For these reasons, I have no qualms about dismissing the sixth ground of opposition.

Abusiveness of the proceedings

[15] At the hearing, the Applicant further argued that the opposition proceedings in this case were without merit and abusive. Consequently, the Applicant asked the Registrar to find that they were an abuse of right within the meaning of the civil code and that the opposition should therefore be dismissed, applying the legal principle of “fin de non-recevoir”.

[16] To properly grasp the Applicant’s position, I think it necessary to reiterate certain facts. First, the Opponent has not filed any evidence in the record except for the evidence described above. This file is one of ten files that were heard at a joint hearing. However, since the evidence in each file is not the same and the grounds of opposition may differ from one file to the next, they will be dealt with in separate decisions. As stated above, three days before the hearing, Nautilus withdrew its opposition, leaving one opponent in the file.

[17] I should also note that, well before the hearing, the Applicant filed a request for leave to amend its counter statement of opposition to add an argument of abuse of right. Attached to this request was a request for leave to file additional evidence to present facts in support of the allegation that these proceedings were an abuse of right. These requests were refused by the Registrar on October 13, 2009.

[18] The Applicant contends that when an opposition has no legal basis, the Registrar has jurisdiction to reject the opposition on the ground that it is an abuse of right. The Applicant has brought to my attention the Registrar’s decision in *Elysium Technology Investments Inc. v. Rogers Communications Inc.* (2004), 44 C.P.R. (4th) 357 (T.M.O.B.), in which my colleague Jill W. Bradbury stated the following in a case where the applicant presented substantially the same argument:

The applicant also submits that the Registrar has the necessary jurisdiction to prevent abuse of its process. I do not contest this; rather, I do not find that these opposition proceedings are an abuse of the opposition process.

[19] I do not challenge that statement. However, it is necessary that the Registrar exercise this power within the limits of the Registrar’s jurisdiction as established by the Act. The mechanism adopted by the Parliament to prevent abuses through opposition proceedings that are frivolous

and without merit is set out at s. 38(4) of the Act. This subsection provides that when the Registrar receives a statement of opposition, the Registrar must read it to determine whether there is at least one ground of opposition that, on its face, appears to raise a substantial issue. By serving the statement of opposition on the Applicant, the Registrar considered that, on its face, the statement of opposition was not frivolous. The Registrar is a statutory creation, whose powers with regard to oppositions are clearly set out at s. 38 of the Act. The Registrar has no inherent power [see *Molson Canada 2005 v. Anheuser-Busch Incorporated*, 2010 FC 283 (F.C.T.D.)].

[20] Concerning the Applicant's argument that the Opponent has no interest to oppose this application for registration, I agree with the statements by the agent for the Opponent. The opposition process is, to a certain degree, in the "public interest". At s. 38 of the Act, Parliament uses the expression "any person . . ." to identify the persons who may file a statement of opposition. However, some grounds of opposition are limited to persons who can claim certain rights. As an example, I refer to s. 17 of the Act.

### Decision

[21] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

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Jean Carrière  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

Certified true translation  
Sarah Burns