



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

Citation: 2013 TMOB 197
Date of Decision: 2013-11-25

**IN THE MATTER OF AN OPPOSITION
by Reg Technologies Inc. to application
No. 1,397,117 for the trade-mark REG in
the name of ORMAT Technologies Inc.**

[1] On May 28, 2008, ORMAT Technologies Inc. (the Applicant) filed an application to register the trade-mark REG (the Mark) based on proposed use in Canada in association with various wares. By way of revised application accepted on July 4, 2012 the Applicant amended the claimed wares such that the application for the Mark now covers the following wares: waste heat recovery power plants and structural parts therefore (the Wares).

[2] The Applicant claims a priority filing date of November 28, 2007 based on an application filed in the United States of America.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of August 18, 2010.

[4] On October 18, 2010, Reg Technologies Inc. (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- pursuant to sections 38(2)(a) and 30(i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) the application does not comply with section 30(i) in view of the prior use in Canada and/or making known in Canada by the Opponent or its predecessor(s) in title, of the trade-mark REG with rotary engines and the development of rotary engine technology;

- pursuant to sections 38(2)(a) and 30(e) of the Act, the Applicant did not, and does not, intend to use the Mark in Canada in association with the wares identified as “electric power generators, electric power generating plants, namely energy recovery generation power plants and waste heat recovery power plants and structural parts therefore;
- pursuant to sections 38(2)(a) and 16(3)(a) of the Act, at the date of filing the application in Canada, as well as the priority filing date, the Mark was confusing with the Opponent’s trade-mark REG which has been previously used or made known in Canada by the Opponent or its predecessor(s) in tile well prior to both the Canadian filing date and the priority filing date;
- pursuant to sections 38(2)(c) and 16(3)(c) of the Act, the Applicant is not entitled to registration of the Mark, because at the Canadian filing date and the priority filing date the Mark was at all times confusing with the trade-name REG TECHNOLOGIES INC. for rotary engine technology which has been previously used in Canada well prior to both the date of filing and the priority filing date; and
- pursuant to sections 38(2)(d) and 2 of the Act, the Mark is not distinctive of the Wares since it does not actually distinguish nor is it adapted to distinguish the Wares from those of the Opponent or others in Canada.

[5] The Applicant served and filed a counter statement in which it denied the Opponent’s allegations and put the Opponent to the strict proof thereof.

[6] In support of its opposition, the Opponent filed an affidavit of John Robertson.

[7] In support of its application, the Applicant filed affidavits of Lucien Y. Bronicki and Gladys Tibbo Witt.

[8] None of the affiants was cross-examined on his/her affidavit.

[9] Only the Applicant filed a written argument and was represented at a hearing.

Onus and Material Dates

[10] 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 CPR (3d) 293 (FCTD) at 298].

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

- sections 38(2)(a)/30 - the date of filing the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)].
- sections 38(2)(c)/16(3) - the date of filing the application [see section 16(3) of the Act; in this case the date is November 28, 2007 considering the priority date claimed pursuant to section 34 of the Act].
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Preliminary Issue

[12] A hearing was conducted on November 19, 2013. The Applicant had requested the hearing and confirmed its attendance in person. The Opponent had not requested a hearing or responded to the notice setting down the time, date and location of the hearing to indicate its interest in participating.

[13] At the commencement of the hearing the Applicant's agent advised me that she had received an email the previous night from the Opponent's agent indicating their interest in participating in the hearing and advising that a telephone call had been placed with the Board.

[14] I adjourned the hearing and confirmed that no such telephone call was received by the Board. An attempt was made to contact the Opponent's agent by telephone as a courtesy. The individual who intended to make submissions could not be reached. Thus, I decided to go ahead with the hearing in the absence of the Opponent's agent in light of their failure to properly advise the Board of their intention to participate in the hearing.

Section 30 Grounds of Opposition

Non-compliance with section 30(e) of the Act

[15] 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. Thus the issue becomes whether or not the Applicant has substantially complied with section 30(e) of the Act. The Opponent has failed to provide any evidence or submissions in support of this ground of opposition and accordingly it is dismissed on account of the Opponent's failure to meet its evidential burden.

Non-compliance with section 30(i) of the Act

[16] 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]. The Applicant has provided the necessary statement and this is not an exceptional case; the section 30(i) ground is accordingly dismissed.

Non-entitlement Grounds – Section 16(3)(a) and (c) of the Act

[17] The Opponent is under an initial evidential burden of establishing that the pleaded REG trade-mark and REG TECHNOLOGIES INC. trade-name were used or made known in Canada prior to the priority filing date of November 28, 2007 and had not been abandoned at the date of advertisement of the application for the Mark.

[18] As submitted by the Applicant in both its written and oral submissions, most of the evidence filed by Mr. Robertson post-dates the material date for these grounds of opposition (i.e. the priority filing date of November 28, 2007). The only evidence which predates the material date is a copy of corporate records showing the Opponent's incorporation and change of name which, as will be discussed further below, do not evidence use of the pleaded trade-mark and trade-name (Exhibits A and B).

[19] In his affidavit, Mr. Robertson makes a bald assertion that the Opponent “is using the trade-mark and trade-name REG in Canada, Europe and the United States in association with pumps, compressors and engines and the design thereof”. However, none of the supporting evidence is sufficient to substantiate this bald assertion.

[20] Firstly, while the Opponent’s corporate records (Exhibits A and B) may evidence the fact that the Opponent was incorporated and had changed its name to Reg Technologies Inc. prior to the material date, this in and of itself does not evidence use by the Opponent of the trade-mark REG or the trade-name REG TECHNOLOGIES INC nor does it provide any information regarding the nature of the Opponent’s wares, services or business carried out in association with said trade-name and/or trade-mark.

[21] Secondly, the press releases mentioning the Opponent and its services (Exhibit C) are all dated after the material date (May 13, March 9, March 28, 2011).

[22] Finally, the undated website printouts (Exhibit D) can only be assumed to be current to the date of swearing the affidavit (May 2011) and thus also postdate the material date.

[23] As a result, the Opponent has failed to meet its evidential burden with respect to the non-entitlement grounds of opposition and they are dismissed accordingly.

Non-distinctiveness Ground – section 38(2)(d) of the Act

[24] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its Wares from those of others throughout Canada [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness.

[25] Pursuant to its evidential burden, the Opponent is under an obligation to show that, as of the filing of the statement of opposition, its pleaded REG trade-mark and REG TECHNOLOGIES INC. trade-name had become known sufficiently to negate the distinctiveness of the Mark [see *Bojangles’ International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FC)].

[26] As discussed in more detail above in the analysis of the non-entitlement grounds of opposition, the Opponent has not filed any evidence of use or reputation for the pleaded trade-mark and trade-name which predates the material date for this ground of opposition (i.e. October 18, 2010). The Opponent has thus failed to meet its evidential burden and the non-distinctiveness ground of opposition is dismissed accordingly.

Disposition

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

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