

TRADUCTION/TRANSLATION

IN THE MATTER OF OPPOSITION by La Cie de Batteries Commerciales R.M. Ltée to application No. 1,117,596 for the Trade-Mark EnerG + & Design filed by Les Entreprises Byroc Inc.

On October 1, 2001, Les Entreprises Byroc Inc. (“the Applicant”) filed an application for the registration of the trade-mark EnerG + & Design (“the Trade-Mark”), illustrated below, in association with batteries, based on use since September 24, 2001.



The application was advertised in the August 13, 2003, issue of the *Trade-marks Journal* for opposition purposes. On September 17, 2003, La Cie de Batteries Commerciales R.M. Ltée filed a statement of opposition alleging the grounds of opposition reproduced below:

[TRANSLATION]

- (a) The Applicant, Les Entreprises Byroc Inc., is not the person entitled to the registration of the Trade-Mark “Ener-G + & Dessin”, in that, as of the date of filing of the application, namely October 1, 2001, the Trade-Mark “Ener-G + & Design” was confusing with the trade-mark “Bio Ener-G”, which the Opponent La Cie de Batteries Commerciales R.M. Ltée made known in Canada in association with batteries, and which was registered under No. 474,988 on April 21, 1997, the whole contrary to paragraphs 38(2)(c) and 16(3)(a) of the *Trade-marks Act*.
- (b) The Trade-Mark “Ener-G + & Design” is not distinctive in that it does not distinguish the wares with which it is associated from the wares of others, particularly those of the Applicant which are sold under the trade-mark “Bio Ener-G”, and because it is not presented so to distinguish those wares, contrary to paragraphs 38(2)(d) and 2(f) of the *Trade-marks Act*.

In its counter-statement, the Applicant denies the stated grounds of opposition and adds that the ground based on paragraph 16(3)(a) of the *Trade-marks Act* (“the Act”) is inapplicable in the instant case because the application for registration is based on the use of the Trade-Mark in Canada. The Applicant

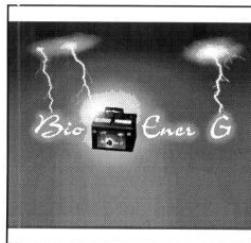
further alleges that there is no risk of confusion between the Trade-Mark and the Opponent's trade-mark. Each party produced evidence and written pleadings. No hearing was held.

The Opponent's evidence

The Opponent's evidence consists of the affidavit of the Opponent's president Jacques Castonguay and a certified copy of the record of the application that resulted in registration No. 474,988 on April 27, 1997.

I note that the statements made in paragraphs 2 and 3 of Mr. Castonguay's affidavit essentially duplicate the grounds of opposition. Paragraphs 4 and 5 of the affidavit are limited to statements to the effect that the wares associated with the trade-marks in issue are identical, and that the market in which they are sold and distributed, namely [TRANSLATION] "the Province of Quebec, Eastern Canada and the Northeastern United States", is the same. Lastly, I ascribe no significance to the statement (made in paragraph 6 of the affidavit) that the application for registration coincided with one of the Opponent's salespersons leaving and joining the Applicant, and that this departure was followed by a campaign to solicit the Opponent's customers.

Since Mr. Castonguay has referred to registration No. 474,988 for the Opponent's trade-mark BIO ENER-G, I note that, based on the certified copy of the associated record, the registered owner of the registration is La Cie de Batterie Commerciales R.M. Inc. (emphasis mine). In addition, I note that the registration is for the trade-mark illustrated below in association with automobile batteries, commercial batteries and industrial batteries.



In its written pleadings, the Opponent submits that it appears from the declaration of use, contained in the record of the registration, that its trade-mark was used since January 1, 1996. But the declaration of use in the registration record does not, in itself, constitute evidence that the trade-mark has been used in Canada since January 1, 1996. In addition, there is no material element in Mr. Castonguay's affidavit that proves use in Canada, at any time whatsoever, of the trade-mark BIO ENER-G in word or figurative form in association with batteries under section 4(1) of the Act.

Applicant's evidence

The Applicant's evidence consists of the affidavit of Jacques Lamoureux dated January 15, 2004, and the affidavit of Marc Bigeault dated January 19, 2004.

Mr. Lamoureux, the Applicant's president, says that the Applicant is engaged in the business of distributing batteries of all kinds intended for specialized businesses and professionals. He says that the Applicant has been using the Trade-Mark since September 24, 2001, in association with batteries of the "sealed" type that are mainly used in electric wheelchairs and electric vehicles, uninterrupted power supplies (UPS), alarm systems, emergency lighting and telecommunications. Annual sales of batteries associated with the Trade-Mark amount to roughly \$300,000, which, in Mr. Lamoureux's opinion, constitutes a substantial amount for this market. I ascribe no significance to Mr. Lamoureux's statements of opinion regarding the differences between the trade-marks in issue and the absence of confusion between them. For all intents and purposes, I note that his support for these opinions consists of the following documents: certificates of authenticity regarding seven registrations belonging to different owners, for trade-marks associated with batteries (Exhibits R-2(A) to R-2(G)); an excerpt from a dictionary regarding the meaning of the French word "*bionergétique*" (Exhibit R-3); an advertising flyer of the Opponent's (Exhibit R-4); and excerpts from the Opponent's website (Exhibit R-5).

Mr. Bigeault, an administrator and sales representative with the Applicant, adduced invoices (Exhibits R-6 and R-7) showing that, on March 25, 2002 and February 24, 2003, the Opponent purchased sealed batteries from the Applicant bearing the Trade-Mark. Since the Applicant submitted no comments on the relevance of this evidence, and that relevance is not apparent to me, I share the Opponent's opinion that no conclusion can be drawn from these purchases. Lastly, Mr. Bigeault states that, since September 24, 2001, the Applicant has been making itself known by the name EBI Distribution, which name includes the same design element as the Trade-Mark, i.e. a circle with sparks emanating from it. He attached specimens (business card, letterhead and envelope) to show the use of this name (Exhibits R-8 and R-9).

In light of the foregoing, I will now consider the grounds of opposition.

Section 16

Since the first ground of opposition refers to registration No. 474,988, I note that the risk of confusion with a registered trade-mark cannot be alleged in support of a ground of opposition that is

based on section 16 of the Act. In this regard, I would note the comments Gary Partington, former Chairperson of the Trade-Marks Opposition Board, in *Unisys v. Leitch Technology Corp.* [2000] T.M.O.B. No. 10 (January 31, 2000):

The opponents next alleged that the applicant is not the person entitled to registration of the trade-mark PANEL MAPPER in that, as of the filing date of the present application, the applicant's trade-mark was confusing with the registered trade-mark MAPPER, registration No. 322,573. While an allegation of confusion between an applicant's trade-mark and a registered trade-mark supports a ground of opposition under Paragraph 12(1)(d) of the **Trade-marks Act**, such an allegation is not a basis for challenging an applicant's entitlement to registration under Subsection 16(3) of the **Act**. I have therefore dismissed the third ground of opposition.

The applicant correctly submits that the ground of opposition based on paragraph 16(3)(a) is not applicable to this case because the application for registration is based on the use, not the proposed use, of the Trade-Mark in Canada. I would add that the fact that the Opponent incorrectly argued the ground of opposition by invoking paragraph 16(3)(a) rather than paragraph 16(1)(a) was brought to its attention when the Applicant's counter-statement was filed. But despite the opportunity to seek leave to produce an amended statement of opposition to correct this deficiency well before it adduced its evidence, the Opponent undertook no efforts to this effect. I would also add that in addition to not submitting any comments in its written pleadings in an attempt to remedy this situation, the Opponent invokes the first ground of opposition while reiterating that the Trade-Mark was [TRANSLATION] "at the time of filing of the application for registration, confusing with the trade-mark previously used in Canada by the Opponent." In my opinion, the commentary of D. Savard in *Sun Squeeze Juices Inc. v. Shenkman* (1990), 34 C.P.R. (3d) 467 (T.M.O.B.) is unquestionably on point:

Further, I am of the view that where an applicant has raised at an early date objections to a statement of opposition and the opponent makes no effort to amend its statement of opposition to clarify its grounds, the Registrar should be reluctant to draw inferences on the basis of facts that do not clearly permit inferences to be made.

This being said, I am prepared to accept that the reference to paragraph 38(2)(c) enabled the Applicant to realize that paragraph 16(1)(a) of the Act was being invoked in support of the first ground of opposition. I feel it important to specify that since I am accepting, with some difficulty, that the Opponent intended to invoke paragraph 16(1)(a) in support of its first ground of opposition based on paragraph 38(2)(c), I am not prepared to accept that it invoke its registration in support of a ground of opposition available under paragraph 38(2)(b). Since it is my opinion that this ground of opposition has not been pleaded, I will make no determination regarding the risk of confusion between the Trade-Mark and the trade-mark registered under No. 474,988 [see *Imperial Developments Ltd. v. Imperial Oil Limited* (1984), 79 C.P.R. (2d) 12 (F.C.T.D.)].

As for the ground of opposition based on paragraph 16(1)(a), the onus is on the Applicant to show, on a balance of probabilities, that there is no risk of confusion between the trade-marks in issue. However, the Opponent bears the initial burden of proving that it was using its trade-mark on the date of first use alleged in the application for registration (namely September 24, 2001) and that it had not abandoned the trade-mark at the date of advertisement of the application (namely August 13, 2003) [section 16(5) of the Act]. Since there the Opponent has provided no evidence of the use of its mark, I find that it has not met its initial burden. Consequently, I dismiss the first ground of opposition.

Distinctiveness

The material date for the second ground of opposition is the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)]. While it is up to the Applicant to show that its mark is distinctive throughout Canada [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (T.M.O.B.)], the Opponent bears the initial burden of proving the allegations of fact in support of the ground of opposition, which essentially turns on the risk of confusion between the parties' trade-marks. Since there is no evidence from the Opponent regarding the use of its mark, the Opponent has not met its burden of proving that its trade-mark became known sufficiently on the material date to negate the distinctiveness of the Trade-Mark. Consequently, I dismiss the last ground of opposition.

Conclusion

By virtue of the powers delegated to me by the Registrar of Trade-marks pursuant to section 63(3) of the Act, I dismiss the opposition to the application for the Trade-Mark, the whole in accordance with subsection 38(8) of the Act.

DATED AT BOUCHERVILLE, QUEBEC, JULY 25, 2005.

Céline Tremblay
Member
Trade-marks Opposition Board