

**IN THE MATTER OF AN OPPOSITION  
by Independent Contractors and Business  
Association of British Columbia to  
application No. 1,127,813 for the trade-  
mark WE BUILD BC filed by The British  
Columbia and Yukon Territory Building  
and Construction Trades Council**

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On January 14, 2002, The British Columbia and Yukon Territory Building and Construction Trades Council (the “Applicant”) filed an application to register the trade-mark WE BUILD BC (the “Mark”). The application is based upon use of the Mark in Canada since August 31, 2001 in association with the following services:

- (1) Road building, rapid transit infrastructure construction, industrial, commercial and institutional construction of buildings, bridge construction, tunnel construction, pipeline construction, residential construction of apartment buildings, condominiums and homes, Hydro Electric dam construction and construction of sewer and water filtration facilities.
- (2) Political lobbying, consumer protection and education related to the construction industry, promotion of trades qualified workers, promotion of safe construction practices, and the promotion of democratic trade unions in the construction industry namely by means of advertising and news stories in newspapers, radio and television, on the Internet, in newsletters and magazines, on letterhead for correspondence, as part of the logo for the BCYT-BCTC, on banners, flags, buttons, leaflets and at meeting, seminars and conferences.

The Applicant has disclaimed the right to the exclusive use of the words BUILD and BC apart from the trade-mark.

The application was advertised for opposition purposes in the Trade-marks Journal of October 15, 2003.

On November 26, 2003, Independent Contractors and Business Association of British Columbia (the “Opponent”) filed a statement of opposition against the application. The Applicant filed and served a counter statement, in which it denied the allegations contained in the statement of

opposition.

The Opponent filed an affidavit of Gord Stewart in support of its opposition while the Applicant filed an affidavit of Wayne Peppard in support of its application.

No cross-examinations were conducted even though each party obtained an order for the cross-examination of the other's affiant.

Each party filed a written argument. An oral hearing was not held.

### Onus

An applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the "Act"). There is however an initial burden on an opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. [*John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)]

### Grounds of Opposition

The grounds of opposition are summarized below:

1. non-compliance with s. 30(a) because the following services are not stated in ordinary commercial terms:

industrial, commercial and institutional construction of buildings, residential construction of apartment buildings, condominiums and homes, political lobbying, consumer protection and education related to the construction industry, promotion of trades qualified workers, promotion of safe construction practices, and the promotion of democratic trade unions in the construction industry namely by means of advertising and news stories in newspapers, radio and television, on the Internet, in newsletters and magazines, on letterhead for correspondence, as part of the logo for the BCYT-BCTC, on

- banners, flags, buttons, leaflets and at meeting, seminars and conferences;
2. non-compliance with s. 30(a) because the Applicant did not use the Mark in Canada as at the date of first use set out in the application in association with each of the services applied for;
  3. non-compliance with s. 30(i) because the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the applied-for services because the Applicant knew on the day it allegedly first used the Mark of the Opponent's prior adoption of the identical trade-mark WE BUILD BC;
  4. non-entitlement under s. 16(1)(a) because at the date on which the Applicant claims first use, the Mark was confusing with the trade-mark WE BUILD BC which had been previously adopted and used or made known in Canada by the Opponent in association with road building, rapid transit infrastructure construction, construction of buildings, bridge construction, tunnel construction, pipeline construction, and construction of sewer and water filtration facilities, infrastructure development and on newspaper and magazine stories and ads, newsletters, promotional materials, including but not limited to, hats, mugs, golf shirts, vests, briefcases, banners, and display booths, letterhead, and business cards;
  5. non-distinctiveness because the Mark does not actually distinguish and is not adapted to distinguish the Applicant's services from the wares, services and business of others, including those of the Opponent.

Clearly, the Opponent ought to have referred in its second ground to s. 30(b), not s. 30(a). Neither party has pointed out this error, but instead has simply proceeded as if the correct section had been pleaded. I will therefore treat it as a typographical error.

#### Material Dates

The dates for assessing each of the grounds of opposition are as follows:

- s. 30 grounds: the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- s. 16(1) ground: the Applicant's claimed date of first use [see s. 16(1)];
- distinctiveness ground: the date of filing of the opposition [see *Metro-Goldwyn-Mayer*

*Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

Section 30(a) Ground

No evidence or argument was filed to meet the Opponent's initial burden with respect to its claim that some of the Applicant's services are not stated in ordinary, commercial terms. Accordingly, this ground of opposition is rejected.

Section 30(b) Ground

The Opponent's initial evidential burden respecting the issue of the Applicant's non-compliance with s. 30(b) can be met by reference not only to the Opponent's evidence but also to the Applicant's evidence [see *Labatt Brewing Company Limited v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) (F.C.T.D.) 216 at 230]. However, while the Opponent may rely upon the Applicant's evidence to meet its evidential burden in relation to this ground, the Opponent must show that the Applicant's evidence is 'clearly' inconsistent with the Applicant's claims as set forth in its application.

Mr. Stewart, the Opponent's Assistant Vice President, states, "To date the [Opponent] has not seen any evidence that the Applicant used its mark on or before August 31, 2001." Although the evidential burden on the Opponent is light, I find that this statement on its own is insufficient to meet it. I will therefore consider whether the Applicant's own evidence satisfies the Opponent's burden.

Mr. Peppard, the Applicant's Executive Director, states that the Applicant began using its Mark at least as early as March 1998. In support of this statement, he provides a copy of an advertisement from that month which displays the Mark. He also provides copies of other ads, including ones that appeared in May 1998, April 1999, June 1999, and on August 31, 2001. I find that this evidence is not clearly inconsistent with the claims of use set out in the application.

The s. 30(b) ground is accordingly dismissed because the Opponent has not met its initial burden.

### Section 30(i) Ground

The Opponent has alleged that the Applicant knew on August 31, 2001 of the Opponent's prior "adoption" of the identical mark. "Adoption" is not a term defined by the Act and it is not clear to me what the Opponent means by "adoption". In any event, there is no evidence that supports a conclusion that the Opponent "adopted" or took any action with respect to WE BUILD BC before August 31, 2001. Mr. Stewart attests, at paragraphs 5 and 6:

5. In or around 2001, [the Opponent] began the process of developing a new logo and tagline to be used in association with its services, for the advertisement of these services and for enhancing our brandline.

6. Since at least as early as October 11, 2001, [the Opponent] unveiled its trademark at the Annual General meeting of its members. A representative sample of the WE BUILD BC and design mark was distributed at the Annual General Meeting on mugs, banners and other promotional material.

"In or around 2001" is too vague for me to accept that anything occurred before August 31, 2001. Mr. Stewart's evidence at best supports a conclusion that the Opponent first used WE BUILD BC on October 11, 2001. (Even if the tagline was developed before October 11, 2001, developing a tagline does not qualify as use of a mark in association with services [see s. 4(2) of the Act].)

The s. 30(i) ground is dismissed because there is no evidence that i) on August 31, 2001 the Applicant was aware of the alleged prior adoption of the Mark by the Opponent, or that ii) the alleged adoption occurred prior to August 31, 2001. (In addition, where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant. [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155])

### Section 16(1)(a) Ground

In order to meet its initial burden in support of this ground, the Opponent must evidence that it used or made WE BUILD BC known in Canada prior to August 31, 2001 (prior "adoption" does

not support a ground of opposition under s. 16). As set out under the s. 30(i) ground, there is no evidence that enables me to reach such a conclusion.

The s. 16(1)(a) ground is dismissed due to the Opponent's failure to satisfy its initial burden.

#### Distinctiveness Ground

In its written argument, the Opponent has referred to the following quote of Mr. Justice Denault in *Clarco Communications Ltd. v. Sassy Publishers Inc.* (1994), 54 C.P.R. (3d) 418 (F.C.T.D.) at 428:

While distinctiveness is quite often determined as part of an evaluation of whether the proposed trade mark is confusing with another trade-mark within the meaning of section 6 of the Act, it is possible to refuse an application for registration on the basis of non-distinctiveness independent of the issue of confusion, provided the ground is raised in opposition. This is because of the reference to "others", meaning any other person, provided in the definition and because the material dates for determining the issues are different... The quality of distinctiveness is a fundamental and essential requirement of a trade mark and the ground of lack of distinctiveness may be raised in opposition by any person and may be based on a failure to distinguish or to adapt to distinguish the proposed trade mark from the wares of any others.

The Opponent subsequently made the following three submissions in support of its distinctiveness ground of opposition:

1. The construction related services alleged to be provided by the [Applicant] are also provided by the members of the [Opponent]. As detailed in Mr. Stewart's affidavit, those construction related services overlap. The members of the [Opponent] also provide the enumerated construction and construction related services.
2. The claim of the Applicant that WE BUILD BC is "distinctive" cannot, therefore, be so. It is clear that it is not a "trade-mark that actually distinguishes the wares or services in association with which it is used by its owner from the wares or services of others or is adapted so to distinguish them". There is simply no evidence that the alleged services of

the [Applicant] in construction or construction related services are of any different nature or type from the construction or construction related services provided by members of the [Opponent].

3. WE BUILD BC is not a mark which is adapted to distinguish the services of the Applicant from the services of others. Even if the services provided by the Applicant were different or distinctive from the services provided by the members of the [Opponent], which is not admitted but is specifically denied, the phrase WE BUILD BC would not be capable of sufficiently distinguishing those services from any other service provider in the construction industry based in British Columbia, including the members of the [Opponent].

In order for the distinctiveness ground of opposition to succeed based on the Opponent's activities with respect to WE BUILD BC, the Opponent need only have shown that as of November 26, 2003, its trade-mark WE BUILD BC had become known sufficiently to negate the distinctiveness of the applied-for mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.)]. However, the only evidence with respect to the Opponent's WE BUILD BC mark is that set out at paragraphs 5 and 6 of the Stewart affidavit (see above), plus his paragraph 7, namely:

7. The Opponent's mark has been used on letterhead banners, envelopes, benefit plans, business cards, hard hat stickers and mugs. A sample of promotional materials, namely letterhead, is attached hereto as Exhibit "A".

Exhibit "A" is a blank, undated letterhead that displays WE BUILD BC in small letters under IBCA in the upper left hand corner.

The Opponent's evidence is insufficient for me to conclude that its WE BUILD BC mark had become sufficiently known as of November 26, 2003 to negate the distinctiveness of the Applicant's Mark. The Opponent's failure to satisfy its initial burden in this regard means that the opposition cannot succeed on this basis.

If the Opponent's argument is that WE BUILD BC is not distinctive because "others" use such

mark, the ground fails because there is no evidence that WE BUILD BC was either in common use in the industry as of the material date, or that parties other than the Applicant had used it to such an extent as to negatively impact the distinctiveness of the Mark. In this regard, I am aware that Mr. Stewart has evidenced that others own registered marks that incorporate either BUILD or BC, but such marks cannot make WE BUILD BC incapable of being distinctive as they are not similar to the Mark in its entirety. I also note the Opponent's references to the fact that Mr. Peppard has attested that the Applicant is an umbrella organization for construction unions, that there are 20 unions affiliated with the Applicant, and that the Applicant and its affiliated unions provide services, including those services listed in the application. However, Mr. Peppard does not state that the affiliated unions use WE BUILD BC in association with such services, and there is no evidence that they do. It matters not whether the services provided by these affiliates or by other un-related entities are similar to the services listed in the statement of services; the issue is whether others use words that are similar to WE BUILD BC in association with similar services.

If the Opponent's argument is that WE BUILD BC is not inherently capable of distinguishing one party's construction services from those of another, then the distinctiveness ground of opposition still fails. A suggestive mark is not necessarily incapable of distinguishing a party's services.

#### Request for Disclaimer

In the alternative, the Opponent has submitted that the Applicant ought also to disclaim the use of WE apart from the Mark. However, the issue of whether or not a disclaimer should be filed is not an issue to be dealt with in opposition proceedings [see *Coranco v. Swissmar*, 2000 CarswellNat 4032 (T.M.O.B.)].

#### Disposition

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).



DATED AT TORONTO, ONTARIO, THIS 12th DAY OF FEBRUARY 2008.

Jill W. Bradbury  
Member  
Trade-marks Opposition Board