

## TRADUCTION/TRANSLATION

IN THE MATTER OF AN OPPOSITION by Station Touristique  
Massif du Sud (1993) Inc. to Application No. 1,212,361 filed by  
Le Massif Inc. for registration of the trade-mark LE MASSIF

[1] On March 31, 2004, Le Massif Inc. (the “Applicant”) filed an application to register the trade-mark LE MASSIF (the “Mark”) based on its use in Canada since at least as early as 1982 in association with wares and services related to the operation of a tourist resort. I will come back to the statement of wares and services in the application for registration.

[2] The application was advertised in the *Trade-marks Journal* of September 1, 2004.

[3] Station Touristique Massif du Sud (1993) Inc. (the “Opponent”) filed a statement of opposition on January 28, 2005, which the Registrar forwarded to the Applicant on February 24, 2005. The facts alleged in support of the grounds of opposition based on paragraphs 38(2)(a), 38(2)(b) and 38(2)(d) of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the “Act”), are the following:

- the application does not meet the requirements of paragraph 30(a) of the Act in that the application does not include a statement in ordinary commercial terms of the specific wares and services in association with which the Mark has been used;
- the application does not meet the requirements of paragraph 30(b) of the Act in that the Mark has not been used in Canada by the Applicant since 1982;
- the Mark is not registrable under paragraph 12(1)(b) of the Act because when depicted, written or sounded, it is either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is allegedly used. The Mark describes an aspect that is often associated with the wares and services described in the application. The word “massif” is a word that designates in the broader tourism industry products and services related to mountain activities, such as downhill skiing, snowboarding, hiking and other outdoor sports and recreational activities;

- the Mark is a mark for which the adoption is prohibited by section 10 of the Act since the Mark has by ordinary and *bona fide* commercial usage become recognized in Canada as designating a type or quality of the wares or services described in the application, and thus no person may adopt such word as a trade-mark or certification mark in association with such wares or services or others of the same general class or use it in a way likely to mislead;
- the Mark is not distinctive of the wares and services mentioned in the application and is not capable of distinguishing them from the wares and services of others, particularly those of the Opponent; based primarily on the contents of the statement of opposition, the Mark is merely an ordinary word common to the tourist industry and is thus not capable of distinguishing the Applicant's wares and services.

[4] The Applicant filed a counter statement generally and specifically negating the claims contained in the statement of opposition.

[5] The Opponent's evidence under section 41 of the *Trade-marks Regulations* (the "Regulations") comprises a statutory declaration by René Godbout, Director-General of the Opponent since August 1996, and a statutory declaration by Valérie Belle-Isle, articling student with the Opponent's trade-marks agents. Mr. Godbout and Ms. Belle-Isle were not cross-examined by the Applicant.

[6] The Applicant's evidence under section 42 of the Regulations comprises an affidavit by Marc Deschamps, an administrator at the Groupe Le Massif Inc., and an affidavit by Jean-Luc Brassard, who has worked for the Applicant since 2005 as spokesperson for the ski resort. Messrs. Deschamps and Brassard were cross-examined by the Opponent. The transcripts of the cross-examinations and answers to undertakings were filed with the Registrar on November 24, 2006. I shall only refer to the cross-examinations insofar as they are relevant to my analysis of the evidence and the parties' arguments.

[7] The Opponent's evidence under section 43 of the Regulations comprises statutory declarations by the individuals identified below, none of whom has been cross-examined by the Applicant:

- a) Henri Dorion, geographer;
- b) Alain Contant, president and CEO of the Opponent since 2005;
- c) Gaston Ouellet, one of the initiators of the project to build a ski resort in Petite-Rivière St-François and director of development for the region of Québec-Trois-Rivières at the Quebec Planning and Development Bureau at that time;
- d) Roger Nadeau, mayor of the town of Buckland from 1965 to 1973; and
- e) Gabriel Loubier, MNA for the riding of Bellechasse from 1962 to 1973.

[8] Only the Opponent filed written arguments. Each party was represented at the hearing.

[9] With the Applicant's consent, I authorized the Opponent to file Exhibits I-1 and I-2, referred to in Mr. Deschamps's cross-examination, after the hearing. These exhibits, filed on August 28, 2009, form part of the record.

[10] Further to the hearing, the Applicant filed an amended application for registration. On October 20, 2009, I accepted the amended application for registration on the Registrar's behalf. Accordingly, the statement of wares and services currently on file reads as follows:

[TRANSLATION]

Wares: (1) Advertising and promotional material, namely, brochures, signs, pins, postcards, posters and photographs, prerecorded promotional videotapes, press kits, invitation cards, pens, stickers, key chains, glasses, mugs, golf equipment and accessories, namely, balls, ball markers, club covers, raincoats, visors, umbrellas, tees, divot repair tools, bottles, pens, pencils and golf-themed gift baskets, medals, playing cards, watches, corkscrews, disposable cameras, umbrellas; (2) Clothing and sportswear for men, women and children, namely, t-shirts, shirts, anoraks, caps, rain suits, blouses, fleece clothing, scarves, mittens and gloves, sweatbands, tuques, brimmed and unbrimmed hats, jackets, sports jackets, underwear, belts, socks.

Services: Operation of a four-season tourist resort offering services related to downhill skiing, snowboarding, telemark skiing, hiking and other outdoor sports,

namely: the operation of slopes for skiing, snowboarding and telemarking, skiing lessons, ski patrols, mountain guide services, ticketing services, artificial snow-making services, slope and equipment maintenance, ski-lifts, shuttle services, organization of sporting competitions; operation of restaurants, bars, banquet halls, sports equipment rental and sales shops, equipment repair, clothing and equipment for skiing, snowboarding and telemarking.

[11] For all practical purposes, I note that at the outset of the hearing, I pointed out to the parties that the name identified in the statement of opposition (Station Touristique Massif du Sud (1993) Inc.) was different from the name of the entity that had been granted an extension of time to oppose the application for registration (Station Touristique Massif du Sud). For reasons unknown to me, this difference was not detected by the Registrar before the statement of opposition was sent to the Applicant. Moreover, the Applicant did not bring the discrepancy to the attention of the Registrar at any point in the proceedings. At the hearing, the Opponent's agent stated that Station Touristique Massif du Sud (1993) Inc. and Station Touristique Massif du Sud were one and the same entity. He argued that it was merely for practical reasons that the Opponent was identified by its trade-name Station Touristique Massif du Sud in the application for an extension of time. The Applicant's agent confirmed that the Applicant had always considered the Opponent to be the entity that had obtained the extension of time and that it was not challenging the standing of the Station Touristique Massif du Sud (1993) Inc. with respect to these proceedings.

## **MATERIAL DATES**

[12] The material dates for assessing the circumstances relating to each of the grounds of opposition in this case are the following:

- paragraph 38(2)(a) - compliance with section 30 of the Act: 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.)];
- paragraph 38(2)(b) – not registrable because not in compliance with paragraph 12(1)(b) of the Act: the date of the application [see *Shell Canada Limited v. P.T. Sari Incofood Corporation* (2005), 41 C.P.R. (4th) 250 (F.C.T.D.); *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)];

- paragraph 38(2)(b) – not registrable because not in compliance with section 10 of the Act: the date of my decision [see *Olympus Optical Company Ltd. v. Canadian Olympic Association* (1991), 38 C.P.R. (3d) 1 (F.C.A.)];
- paragraph 38(2)(d) – distinctiveness: 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.)].

## **ANALYSIS OF THE GROUNDS OF OPPOSITION**

[13] The Opponents have the burden of ensuring that each of their grounds of opposition is duly argued and of discharging their initial evidentiary burden by establishing the facts supporting their grounds of opposition. Once this initial burden is met, the onus is on the Applicant to prove, on the balance of probabilities, that none of the grounds of opposition impedes the registration of the Mark [see *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.); and *Wrangler Apparel Corp. v. The Timberland Company* (2005), 41 C.P.R. (4th) 223 (F.C.)].

[14] Before proceeding to an analysis of the grounds, I shall make a few preliminary remarks about the evidence in the record. At the same time, I shall deal with some of the arguments raised by the parties.

### **Preliminary remarks**

#### ***Evidence under section 43 of the Regulations***

[15] The Applicant submits that the statutory declarations filed as evidence under section 43 of the Regulations are inadmissible because they are not confined strictly to matters in reply. Generally speaking, the Applicant argues that the Opponent is unduly splitting its evidence by relying on section 43 of the Regulations to file evidence that it should have introduced as evidence in chief. For the reasons below, the Opponent submits that the statutory declarations were properly introduced under section 43 of the Regulations. At page 14 of its written arguments, the Opponent wrote, [TRANSLATION] “the golden rule with respect to admissibility of evidence in an administrative context is that of relevance. Thus, anything that is relevant to a

proceeding is admissible in principle.” The principle to be applied in deciding whether evidence is admissible under section 43 of the Regulations is whether it is strictly confined to matters in reply to the Applicant's evidence. It is with that principle in mind that I reviewed the statutory declarations.

[16] The Opponent submits that Henri Dorion’s statutory declaration responds to paragraphs 37 to 39 of Mr. Deschamps’s affidavit, which states that the word “massif” is neither descriptive nor generic, as well as Mr. Brassard’s testimony to the effect that the Applicant’s ski resort is located on three mountains that form a massif [p. 41 of the transcript]. I cannot accept the Opponent’s submissions. I fully agree with the Applicant that the Opponent is attempting to use the statutory declaration of Mr. Dorion, an expert witness, to introduce evidence that it should have introduced as evidence in chief. Accordingly, I find Mr. Dorion’s statutory declaration inadmissible as evidence under section 43 of the Regulations, and it should therefore be ignored [see *Prouvost S.A. v. Haberdashers Ltd.* (1987), 18 C.I.P.R. 232 (T.M.O.B.)].

[17] As for Alain Contant’s statutory declaration, the Opponent submits that (i) paragraphs 1 to 6 respond to the claims made at paragraphs 37 to 39 of Mr. Deschamps’s affidavit; (ii) paragraph 7 responds to the testimony of Messrs. Deschamps and Brassard [TRANSLATION] “with respect to the various names by which the [Applicant’s] ski resort is known”; and (iii) paragraphs 8 to 11 respond to Mr. Brassard’s testimony to the effect that he knows of no other places bearing the name “massif”. First, the mere statement by Mr. Contant that he has read paragraphs 37 to 39 of Mr. Deschamps’s affidavit is clearly insufficient to find that his declaration responds to the Applicant’s evidence. Second, the evident purpose of the declaration is to introduce evidence in support of the descriptive and generic use of “massif” in the recreational tourism sector, which in itself confirms the Applicant’s submission that Mr. Contant’s statutory declaration is inadmissible. Having considered the arguments of both parties, I find that only paragraphs 7 to 11 of this statutory declaration are admissible as evidence under section 43 of the Regulations.

[18] According to the Opponent, Mr. Ouellet’s statutory declaration responds to the testimony of Messrs. Deschamps and Brassard, who stated under cross-examination that the Applicant’s ski

resort had never been known by any name other than “Le Massif”. The Opponent submits that the statutory declarations of Roger Nadeau and Gabriel Loubier respond to paragraph 40 of Mr. Deschamps’s affidavit because they demonstrate the Opponent’s use of the name “Massif du Sud” prior to 1989. Having considered the arguments of both parties, I am prepared to accept the declarations of Messrs. Ouellet, Nadeau and Loubier as evidence under section 43 of the Regulations.

[19] My acceptance of paragraphs 7 to 11 of Mr. Deschamps’s statutory declaration and the statutory declarations of Messrs. Ouellet, Nadeau and Loubier as evidence under section 43 of the Regulations should not be taken to mean that I necessarily agree with the Opponent’s arguments with respect to the weight to be accorded to the evidence in question. I shall consider the probative value of this evidence under the relevant grounds of opposition, as necessary.

***Expertise of Jean-Luc Brassard***

[20] In addition to acting as spokesperson for the Applicant’s ski resort, Mr. Brassard is a sports columnist. A member of the Canadian National Freestyle Team (moguls) from 1990 to 2002, he has won fifty medals on the World Cup circuit, is a three-time overall world champion, and won a gold medal at the Lillehammer Olympic Games in 1994. Mr. Brassard states that law firm Desjardins Ducharme asked him to submit his opinion [TRANSLATION] “on the fame and distinctiveness of the mark and the name LE MASSIF” [paragraph 10].

[21] While acknowledging that Mr. Brassard is an expert on high-level skiing, the Opponent argues that his affidavit is inadmissible on account of Mr. Brassard’s lack of expertise in trade-marks, marketing or any other subject qualifying him to give the opinion sought.

[22] In my view, the Applicant has not presented Mr. Brassard as anything but an expert on skiing. That said, acting as an expert requires an independence from the parties with respect to the outcome of the opposition proceedings. While I see no reason not to consider Mr. Brassard’s affidavit in this case, under the circumstances, it would be inappropriate for Mr. Brassard to appear as an expert witness. Mr. Brassard has been employed by the Applicant since 2005 as a

spokesperson for its ski resort. He receives an annual salary from the Applicant in consideration for performing this function [p. 8 of the transcript of his cross-examination].

[23] I would add that even if I had agreed to consider Mr. Brassard's affidavit as expert evidence, I would not have had to accept Mr. Brassard's opinion on the basis of his expertise. I would still have considered the facts and assumptions upon which his opinion was based in order to assess both its validity and the process by which it was reached [see *William H. Rorer (Canada) Ltd. v. Johnson & Johnson* (1980), 48 C.P.R. (2d) 58 (F.C.T.D.)].

***Registration No. TMA360,352 for the trade-mark LE MASSIF & Design***

[24] During the hearing, the Applicant's agent referred to *Station Touristique Massif du Sud (1993) Inc. v. Massif Inc.* 2008 CarswellNat 4512 with respect to a procedure under section 45 of the Act against Registration No. TMA360,352 for the Applicant's trade-mark LE MASSIF & Design. The burden of proof under section 45 of the Act differs from the burden borne by the Applicant in this proceeding. In any case, the ownership of Registration No. TMA360,352 [Exhibit MD-7 of the Dansereau affidavit] does not automatically guarantee the Applicant's the right to register the Mark.

***Use of trade-name and trade-mark Le Massif du Sud by the Opponent***

[25] A relatively important part of the evidence, including the cross-examinations of Messrs. Deschamps and Brassard, involves the use of the trade-mark and trade-name "Le Massif du Sud" by the Opponent, or his predecessors in title, in association with the operation of a recreational tourism business in the Massif du Sud Regional Park. Without commenting for the moment on this evidence or on the parties' submissions regarding its weight, I note that none of the grounds of opposition is based on confusion between the Mark and the Opponent's "Le Massif du Sud" trade-mark or trade-name.

***Other dispute between the parties***

[26] Mr. Deschamps relates in his affidavit that the Applicant brought infringement proceedings against the Opponent in the Superior Court of Québec [paragraph 36, Exhibit MD-8]. He also commented on a cease-and-desist letter that had previously been addressed to the

Opponent [paragraph 35, Exhibit MD-13]. Mr. Godbout's statutory declaration refers to the cease-and-desist letter received by the Opponent [paragraph 21, Exhibit RG-5]. In my view, it would be inappropriate in the context of this opposition to attach any significance whatsoever to the allegations of either affiant with respect to a proceeding currently before the Superior Court of Québec. My remarks and findings in this case shall be expressed solely within the context of the opposition before me.

[27] I shall now consider the grounds of opposition.

### **Compliance with paragraph 30(a) of the Act**

[28] This ground of opposition essentially reproduces paragraph 30(a) of the Act. The Opponent has neither introduced any evidence nor submitted any arguments on this point.

[29] I find that the Opponent has not discharged its burden of proof, and I therefore dismiss the ground of opposition based on lack of compliance with section 30(a) of the Act.

### **Compliance with section 30(b) of the Act**

[30] Since the facts are more readily available to the Applicant, the Opponent's initial burden of proof with respect to the ground of opposition based on non-compliance with paragraph 30(b) of the Act is lighter [see *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.)]. The Opponent has introduced no evidence in support of this ground of opposition, but rather relies on the Applicant's evidence, in particular Mr. Deschamps's affidavit and cross-examination. The Opponent is entitled to rely on the Applicant's evidence to discharge its burden of proof. However, the Opponent must demonstrate that such evidence is clearly inconsistent with the alleged use of the Mark by the applicant since 1982 in association with the wares and services identified in the application [see *York Barbell Holdings Ltd. v. ICON Health & Fitness, Inc.* (2001), 13 C.P.R. (4th) 156 (T.M.O.B.)].

[31] Mr. Deschamps states that in his capacity as an administrator since 2003 for the Groupe Le Massif Inc., he attends meetings of the board of directors [TRANSLATION] "dealing with issues related to the operation to the *Le Massif* ski centre" [paragraph 2]. He adds that the company

Groupe Le Massif Inc. is the sole shareholder in the Applicant. Mr. Deschamps states that between 1982 and 2000, he held the position of director-general of the Société de développement du Massif de Petite-Rivière-Saint-François Inc., which he identifies as the Applicant's predecessor in title [paragraph 3].

[32] According to the Opponent, the gaps in the evidence of use presented at paragraphs 6 to 17 of Mr. Deschamps's affidavit, as well as his admissions under cross-examination, demonstrate that the evidence is clearly inconsistent with the alleged use of the Mark by the Applicant since 1982. During the hearing, the Applicant's agent correctly pointed out that the Applicant did not bear the initial burden of proving use of the Mark in association with the wares and services listed in the application since the date of first use claimed. In any case, the Applicant's agent submitted that the evidence demonstrates use of the Mark by the Applicant and its predecessor in title since the date of first use claimed in the application.

[33] According to paragraphs 4 and 6 of Mr. Deschamps's declaration, reproduced below, the first user of the Mark is allegedly the Société de développement du Massif de Petite-Rivière-Saint-François Inc., the Applicant's predecessor in title:

[TRANSLATION]

4. The company Le Massif Inc. has operated the *Le Massif* ski centre located in the Charlevoix region, in the village of Petite-Rivière-Saint-François, since 2002. Prior to this, the *Le Massif* ski centre was operated by the Société de développement du Massif de Petite-Rivière-Saint-François Inc. (predecessor of the company Le Massif Inc.).

...

6. The MASSIF trade-mark has been used in association with the operation of a ski centre by the Applicant's predecessor since at least as early as the early 1980's.

[34] While being cross-examined on the significance of his reference to the Société de développement du Massif de Petite-Rivière-Saint-François Inc. as a "predecessor", Mr. Deschamps stated the following [p. 7 of the transcript]:

[TRANSLATION]

R. That was who operated the Le Massif ski resort before it was sold to the Groupe Le Massif, and thereby to Le Massif Inc.

Q. And it was sold to the Groupe Le Massif in what year?

R. In two thousand and two (2002).

[35] It has been clearly established in the case law that an application for registration shall identify any predecessor(s) in title that have used the applied for trade-mark. I have only to cite my colleague D. Martin in *R.W.S. Hoists & Crane Inc. v. Richard Wilcox Canada Inc.* (2004), 41 C.P.R. (4th) 258:

Although it is not necessary to include amalgamating companies as predecessors (see the opposition decision in *Molson Breweries, a Partnership v. John Labatt Ltd.* (1994), 56 C.P.R. (3d) 107 (T.M. Opp. Bd.), at 113), where there has been an actual change in ownership, predecessors in title must be included covering the period of use claimed in the application: see the opposition decisions in *Hardee's Food Systems Inc. v. Hardee Farms International Ltd.* (1984), 1 C.P.R. (3d) 417 (T.M. Opp. Bd.), at 430 and *Sanna Inc. v. Chocosuisse union des fabricants suisses de chocolat* (1986), 14 C.P.R. (3d) 139 (T.M. Opp. Bd.), at 142.

[36] The application for registration does not describe the use of the Mark by the Applicant's predecessor in title during the period of use claimed in the application, a fact I pointed out to the parties during the hearing. The Applicant's failure to list the name of its predecessor in title in the application for registration means that the application is not compliant with paragraph 30(b) of the Act. Accordingly, it is not necessary for me to consider the parties' submissions on the evidence of use to find that the Applicant's evidence is clearly inconsistent with its claimed use of the Mark in association with the wares and services identified in the application since at least as early as 1982.

[37] In view of the above, I find that the Opponent has failed to meet its burden of proof with respect to the ground of opposition based on non-compliance with paragraph 30(b) of the Act.

### **Registrability and distinctiveness**

[38] In its written arguments [pp. 15-16], the Opponent concludes with the ground of opposition based on lack of compliance with paragraph 30(b) of the Act, stating as follows:

[TRANSLATION]

Although the Opposition Board could end its analysis here, since there is no need to proceed to the remaining grounds of opposition, given that the application is not compliant with the requirements of the Act and Regulations, the Opponent would like

to draw attention to the other grounds of opposition, which acquire a particular importance in light of the fact that the Applicant has already filed a new application for registration for a mark similar to the one that is the subject of these opposition proceedings and that is still pending (application number 1327102) and, moreover, the Applicant is seeking a monopoly in the word “massif” in all its uses, for instance as part of a trade-name or Internet domain name, in proceedings brought against the Opponent in the Superior Court of Québec (court file no. 300-17-000018-067).

[39] The Opponent seems to be suggesting that my decision on the grounds of opposition based on the registrability and distinctiveness of the Mark are relevant to other pending, or even future, proceedings between the parties. I disagree with the Opponent on this point. Even setting aside the difference in nature between these proceedings and those before the Superior Court of Québec, decisions on the grounds of opposition raised under paragraphs 38(2)(b) and 38(2)(d) of the Act are questions of probability based on the circumstances of each case. In other words, my decision on these grounds of opposition shall be based on the relevant evidence on the record in this case. I would even go so far as to venture that if I were to reject any one of the grounds of opposition based on paragraphs 38(2)(b) and 38(2)(d) of the Act, the Opponent would doubtless attempt to distinguish my decision in any other proceeding pending between the parties.

[40] Because I have accepted the ground of opposition based on lack of compliance with paragraph 30(b) of the Act with respect to all of the wares and services identified in the application for registration, I do not intend to deal with the ground of opposition that the Mark is not registrable or distinctive.

## **CONCLUSION**

[41] In view of the above, and with the authority delegated to me by the Registrar under subsection 63(3) of the Act, I refuse the application for registration pursuant to subsection 38(8) of the Act.

DATED AT MONTRÉAL, QUEBEC, THIS 9TH DAY OF DECEMBER.

Céline Tremblay  
Member

Trade-marks Opposition Board

Certified true translation  
Francie Gow, BCL, LLB