



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

Reference: 2016 TMOB 157
Date of Decision: 2016-09-23
[UNREVISED ENGLISH
CERTIFIED TRANSLATION]

IN THE MATTER OF AN OPPOSITION

Canadian Tire Corporation, Limited **Opponent**

and

Gestion André Touchette Inc. **Applicant**

1,561,117 for CANADA'S SINGLE **Application**
SOURCE FOR TIRE SOLUTIONS

Introduction

[1] Gestion André Touchette Inc. (the Applicant) filed registration application No. 1,561,117 on January 24, 2012 for the CANADA'S SINGLE SOURCE FOR TIRE SOLUTIONS trade-mark (the Mark).

[2] The application is based on use of the Mark in Canada since at least November 2009 in association with services for warehousing, storage, sale and distribution of tires (the Services).

[3] The registration application was published on November 14, 2012 in the *Trade-Marks Journal* for the purposes of opposition.

[4] Canadian Tire Corporation, Limited (the Opponent), on April 12, 2013, filed a statement of opposition on the grounds of opposition based on sections 30(e) and (i), 12(1)(b) and (d), 16(3)(a) and 2 (distinctiveness) of the *Trade-marks Act*, RSC (1985), c T-13 (the Act). However, in its written argument, the Opponent withdrew the grounds of opposition based on confusion with registered marks and the previous use of these marks (sections 12(1)(d) and 16(3)(a)) and the ground of opposition based on section 30(i) of the Act.

[5] The Applicant filed a counter-statement denying each and every ground of opposition argued by the Opponent.

[6] The Opponent filed the affidavits sworn on October 24, 2013 by Andaleeb Dobson and Alexandra Scott.

[7] The Applicant filed two affidavits sworn on February 21, 2014 by Sandro Romeo and the affidavits sworn on February 24, 2014 by Frédéric Bouthillier and Roger Champoux.

[8] Messrs. Champoux and Bouthillier were cross-examined and the transcript of these cross-examinations is part of the record.

[9] Each party filed written arguments and they were represented at the hearing. The case concerning the Opponent's concurrent opposition to application no. 1,561,116 for registration of the mark CANADA'S SINGLE SOURCE FOR TIRE SOLUTIONS LEADER CANDADIEN (sic) EN SOLUTIONS DU PNEU (bilingual mark) was heard at the same time. However, the cases will be the object of distinct decisions.

[10] For the reasons more fully described hereinafter, I reject the opposition.

Evidentiary burden

[11] Under the procedure in the matter of opposition to the registration of a trade-mark, the legal onus is on the Applicant to show that the registration application does not contravene the provisions of the Act. However, the Opponent must fulfill the initial burden of proving the facts on which it bases its claims. The fact that an initial evidentiary burden is imposed on the Opponent means that a ground of opposition will be taken into consideration only if sufficient

evidence exists to allow a reasonable conclusion of the existence of the facts alleged in support of this ground of opposition [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* 2002 FCA, 29, 20 CPR (4th) 155 (FCA); and *Wrangler Apparel Corp v The Timberland Company* 2005 FC 722, 41, CPR (4th) 223].

Preliminary comments

[12] I have studied all the evidence of record identified above. However, I will refer only to what I consider relevant for the purposes of my decision.

[13] The majority of the contents of the affidavit of Ms. Dobson, the Opponent's Vice-President, Tires and Auto Service Marketing, concern the Opponent's activities during the years 2007 to 2013. However, due to the withdrawal of the grounds of opposition based on confusion with registered marks and the previous use of these marks by the Opponent, these facts will have little importance in the context of the grounds of opposition based on section 12(1)(b) and 2 (non-distinctiveness of the Mark, because it would be clearly descriptive or deceptively misdescriptive of the nature or the quality of the Services).

[14] During the hearing, the Agent for the Applicant raised an objection to the admissibility of Exhibits C and D filed in the context of the cross-examination of Mr. Champoux, National Director, Sales and Marketing of Pneus Touchette Distribution Inc (Touchette Distribution), the Applicant's licensee. These exhibits were described as excerpts from Touchette Distribution's website, obtained from the Wayback Machine website. The Applicant argued at the hearing that these exhibits constitute hearsay evidence. Moreover, the Applicant argued that the Opponent used the cross-examination of Mr. Champoux to file this evidence, when it was available to the Opponent when the Applicant's evidence-in-chief was filed. A similar objection was filed during the hearing concerning Exhibits E, F, G and H filed during the same cross-examination. These are excerpts from third-party websites.

[15] I pointed out to the Agent for the Applicant that no objection to the filing of these exhibits had been formulated during the cross-examination of Mr. Champoux. In the circumstances, I dismiss the objections because they were not formulated at the time these

exhibits were filed during the cross-examination. These documents are therefore part of the record. However, I will later discuss the eligibility of their contents, in view of the relevant dates associated with the grounds of opposition argued.

[16] Apart from the ground based on section 30(b), the other two grounds of opposition to be resolved are based on the argument that the Mark is clearly descriptive or deceptively misdescriptive of the nature or the quality of the Services. Consequently, the Mark would not be registrable and thus would be non-distinctive. It is self-evident that if the ground of opposition based on section 12(1)(b) is rejected, the same will apply to the ground based on the non-distinctiveness of the Mark.

Ground of opposition based on section 30(b) of the Act

[17] The Opponent argues that the registration application does not comply with the provisions of sections 38(2)(a) and 30(b) of the Act, in that the Mark has not been used in Canada since as early as November 2009 in association with the Services as claimed in the registration application. During the hearing, the Opponent submitted that the evidence of record does not prove a continuous use of the Mark since the date of first use alleged in the registration application. Finally, the Opponent argues that if there is evidence of use of a mark, this is not the Mark.

[18] This ground of opposition must be analyzed as of the filing date of the registration application (January 24, 2012) [see *Georgia-Pacific Corporation v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)]. The Opponent has the initial evidentiary burden. However, this burden is light [see *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)], and the Opponent can refer to the Applicant's evidence to discharge this light evidentiary burden [see *Labatt Brewing Co. v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD)].

[19] The Opponent refers to the contents of the cross-examination of Mr. Champoux (pages 10 to 13, 18 and 19 of the cross-examination), some of the exhibits filed during this cross-examination and a previous registration application, filed by the Applicant for the bilingual mark based on use in Canada since November 1, 2009. It was discontinued subsequently. I will

analyze each of these pieces of evidence to determine whether the Opponent has discharged its initial evidentiary burden.

[20] First of all the Opponent bases its position on the contents of Exhibit 1 to Mr. Champoux's affidavit, namely an excerpt from Touchette Distribution's *tirelink.ca* website. This excerpt contains the bilingual mark and the mention 'Droit d'auteur 2010...' (Copyright 2010...). I must point out that during the cross-examination of Mr. Champoux, two excerpts from the same site, obtained from the Wayback Machine site, were filed (Exhibits C and D), and we also find the notice 'Copyright 2010...'.

[21] Although all these excerpts were obtained after the relevant date (January 24, 2012), the Opponent refers to the date of the copyright notice, namely 2010. Thus, the Opponent claims that the Applicant could not have started using the Mark on the date of first use alleged (November 2009), because the Web page refers to a copyright dating from 2010.

[22] The reference to a month of the year as the data of first use of the Mark signifies, in the absence of a precise date, that the date of first use is the last day of the month, or in our case, November 30, 2009 [see *Khan v Turban Brand Products Ltd* (1984), 1 CPR (3d) 388 (TMOB)]. Yet the indication of the year 2010 in the copyright notice does not necessarily mean that we must presume that the excerpt from the website was created on December 31, 2010. This reference year simply signifies that the work was created in 2010. Since the date of first use is very close to the beginning of 2010, it is very possible that the Applicant started using the Mark in November 2009, but that its licensee's website was modified to include a reference to the Mark only at the beginning of 2010. Thus, there must be other evidence raising a serious doubt regarding the veracity of the date of first use of the Mark.

[23] The Opponent also refers to the contents of paragraph 7 of Mr. Champoux's affidavit. He alleges that the Mark is used on promotional material to promote the Services to Canadian automobile dealers. He filed two photos he took during a BMW dealers convention held in Blue Mountain, Ontario in September 2010, in which a banner on which the Mark is inscribed can be seen.

[24] The Opponent argues that a period of nearly one year elapsed between the date of the alleged first use of the Mark and the holding of this convention. Thus, there would be serious doubts as to the veracity of the date of first use of the Mark.

[25] I must mention that the Opponent's evidence-in-chief does not contain evidence that could raise doubts about the date of first use of the Mark claimed by the Applicant. Thus, the Applicant did not have to file detailed evidence proving the use of the Mark effective from November 2009.

[26] Consequently, the allegations obtained from Mr. Champoux's affidavit concerning the use of the Mark are taken out of context. Mr. Champoux does not present this evidence to prove the use of the Mark since November 2009, but simply to prove the use of the Mark in Canada.

[27] Moreover, Mr. Champoux filed a business card bearing the Mark and clearly mentions in paragraph 8 of his affidavit that this unilingual English business card was distributed to customers in 2009. On this matter, the Opponent argues this evidence does not constitute evidence of use of the Mark in association with the Services, since these Services are not identified on the business card. However, Mr. Champoux clearly says in paragraph 8 of his affidavit that this business card is given to the customers when accounts are opened and therefore during the offer or provision of Services.

[28] What remains is the Opponent's argument regarding the relevance of the fact that the sales figure alleged in Mr. Champoux's affidavit would be identical to the sales figures alleged in Mr. Champoux's affidavit filed in the case of the bilingual mark. However, the latter affidavit by Mr. Champoux was not brought into evidence in this case.

[29] Concerning the argument that the Mark was not used continuously since 2009, the Opponent also refers to the contents of the cross-examination of Mr. Champoux, and more specifically to pages 18 and 19, where he mentions that it is impossible for him to break down the sales figure by mark (the Mark and the bilingual mark). The fact that Mr. Champoux, at the time of the cross-examination, could not break down the sales by mark and by service, does not necessarily mean there were no sales in association with the Mark in 2013. The Opponent did not ask Mr. Champoux for an undertaking to provide such a breakdown.

[30] I remind the parties that the Opponent had the initial evidentiary burden. Yet it did not file evidence that could have called into question the continuous use of the Mark since November 2009. Thus, the Applicant would not have to prove this continuous use of the Mark. Mr. Champoux's allegation concerning sales in 2013 is thus taken out of context. The impossibility for Mr. Champoux to break down the sales by mark during his cross-examination does not raise serious doubts about the continuous use of the Mark in Canada since November 2009.

[31] The Opponent argues that, if the Applicant has used a trade-mark since November 2009, it is not the Mark but rather the bilingual mark, such as it appears from the excerpts from Touchette Distribution's website (Exhibits C and D in cross-examination of Mr. Champoux and Exhibit 1 to his affidavit). The Opponent adds that the Applicant cannot use the same evidence to support an allegation of use of both marks.

[32] On this last argument, I must point out that the Opponent did not file, as evidence in this case, the evidence filed in the bilingual mark case. Thus, I cannot refer to evidence contained in another case record that is not part of the present case. Regarding the evocation that the same evidence cannot support an allegation of use of two different trade-marks, there is no jurisprudence cited by the Opponent on this matter. On the contrary, it has been ruled in the past that it is possible for a party to use two distinct marks at the same time [*A W Allen Ltd v Canada (Registrar of Trade-marks)* (1985), 6 CPR (3d) 270 (FCT)].

[33] In the website excerpts identified above, we find the Mark on a first line with the words 'single source' written in yellow and the other words in blue. Below the Mark, there is the inscription 'Leader canadien en solutions du pneu' (Canadian leader in tire solutions), where 'Leader canadien' (Canadian leader) is written in yellow and the rest in blue. I do not consider that the presence on a second line of the mention 'Leader canadien en solutions du pneu' (Canadian leader in tire solutions) causes the Mark to lose its identity and that the consumer would be led to believe that the source of the services offered in association with the bilingual mark differs from the source of the Services offered in association with the Mark [see *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull, SA*, (1985) 4 CPR (3d) 523 (FCA)].

[34] The ground of opposition based on section 30(b) of the Act is therefore rejected.

Ground of opposition based on section 12(1)(b) of the Act

[35] The relevant date to rule on this ground of opposition is the filing date of the registration application (January 24, 2012) [see *Shell Canada Limited v PT Sari Incofood Corporation* 2005 FC 1040, 41 CPR (4th) 250 (FCT)].

[36] It is good to recall the guiding principles that help us determine whether a mark is clearly descriptive or deceptively misdescriptive within the meaning of section 12(1)(b) of the Act.

Thus, Mr. Justice Cattanach set out the following procedure to follow in *GWG Ltd v Registrar of Trade-marks* (1981), 55 CPR (2d) 1:

It has been repeatedly stated based on the authority of numerous decided cases: (1) that whether a trade mark is clearly descriptive is one of first impression; (2) that the word "clearly" in para. 12(1)(b) of the Act is not a tautological use but it signifies a degree and is not synonymous with "accurate" but means in the context of the paragraph "easy to understand, self-evident or plain", and (3) that it is not a proper approach to the determination of whether a trade mark is descriptive to carefully and critically analyse the words to ascertain if they have alternate implications or alternate implications when used in association with certain wares and to ascertain what those words in the context in which they are used would represent to the public at large who will see those words and will form an opinion as to what those words will connote: see *John Labatt Ltd. v. Carling Breweries Ltd.* (1974), 18 CPR (2d) 15 at p. 19.

[37] The jurisprudence also indicates that their common meaning must be applied to the appreciation of the facts [see *Neptune SA v Canada (Attorney General)* 2003 FCT 715, 29 CPR (4th) 497(FCT) and *Ontario Teachers' Pension Plan Board v Canada (Attorney General)* 2011 FC 58, conf 2012 FCA 60]. Also, the descriptiveness of the Mark must be assessed by accounting for the services associated with it [see *Mitel Corporation v Registrar of Trade Marks* (1984), 79 CPR (2d) 202 at page 208 (FCTD)].

[38] Alexandra Scott is a trade-mark agent employed by the firm of agents representing the Opponent. On October 16, 2013 she proceeded with several searches to obtain the definitions of the words: 'Canada', 'single', 'source', 'tire', and 'solution' in the following dictionaries: *The Canadian Oxford Dictionary*, *The New Shorter Oxford English Dictionary*, *The Random House*

Dictionary of the English Language. On October 22, 2013 Ms. Scott also conducted searches for the same words on the website at *www.merriam-webster.com*.

[39] She filed each of the relevant excerpts from these dictionaries concerning these words.

[40] In light of this evidence, it is clear that each of the words that form the Mark is a common word in the English language. However, the Mark taken as a whole must be considered.

[41] Without seeking to break down the Mark, the essential issue is to determine whether ‘tire solutions’ is clearly descriptive of the nature and quality of the Services. The word ‘solution’ in English, according to the Opponent's evidence, means: ‘the act or a means of solving a problem or difficulty’ or ‘an explanation, answer, or decision’.

[42] The Opponent presented excerpts from websites on which the expression ‘tire solutions’ appears to prove this expression is used in the industry. It refers, more specifically, to Exhibits E, F and G of the cross-examination of Mr. Champoux. I rejected the Applicant's objection based on the argument that the Opponent should have filed these exhibits as an integral part of its evidence-in-chief. However, the ground of opposition under section 12(1)(b) must be analyzed as of the filing date of the registration application (January 24, 2012). Yet all these documents were printed on October 20 and 23, 2014, i.e. after the relevant date. I therefore cannot take their contents into account under this ground of opposition.

[43] During the cross-examination of Mr. Champoux, the Opponent tried to get him to admit that each of the Services could be considered a ‘tire solution’. Mr. Champoux admitted that the tire warehousing and storage services were ‘tire solutions’ but that this was not the case for tire sales (page 23).

[44] It is very possible that, for people working in the tire industry, like Mr. Champoux or Ms. Dobson, the use of the expression ‘tire solutions’ can refer to services related to tires. The Mark thus could be considered highly suggestive or even descriptive of these services. However, this does not mean it is clearly descriptive of the nature or the quality of these services for the average consumer. I have no evidence that the average consumer, on the basis of a first impression, would associate these expressions with the nature or the quality of the Services.

[45] Finally, the Opponent refers to Ms. Dobson's allegation to the effect that other merchants offer tire solution services. However, Ms. Dobson does not explain what she means by 'tire solutions'. Moreover, I agree with the Applicant that such an allegation, without other evidence, constitutes hearsay.

[46] In the circumstances, I conclude that the Mark, taken as a whole, although highly suggestive of the nature of the Services, is not clearly descriptive of them. Since it is not clearly descriptive of the nature or the quality of the Services, it cannot be considered a deceptive misdescription of the Services.

[47] I therefore reject this ground of opposition.

Ground of opposition based on non-distinctiveness of the Mark

[48] During the hearing, the Opponent indicated that this ground of opposition was based on the fact that the Mark, being clearly descriptive, could not serve to distinguish the Services from third-party services. However, I concluded that the Mark was not clearly descriptive of the Services.

[49] In the circumstances, I also reject this ground of opposition.

Disposal

[50] In exercising the authority delegated to me pursuant to the provisions of section 63(3) of the Act, I reject the opposition according to the provisions of section 38(8) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified translation
Arnold Bennett

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

DATE OF HEARING: 2016-08-30

APPEARANCES

Steven N. Kennedy

FOR THE OPPONENT

Johanne Muzzo

FOR THE APPLICANT

AGENT(S) IN THE CASE

Cassels Brock & Blackwell LLP

FOR THE OPPONENT

Guy & Muzzo Inc.

FOR THE APPLICANT