



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

**Citation: 2015 TMOB 227**  
**Date of Decision: 2015-12-22**

**IN THE MATTER OF AN OPPOSITION**

**Les Marques Metro / Metro Brands  
S.E.N.C.  
and**

**Opponent**

**1161396 Ontario Inc.**

**Applicant**

**1,333,541 for IRRESISTIBLES**

**Application**

[1] Les Marques Metro / Metro Brands S.E.N.C. opposes registration of the trade-mark IRRESISTIBLES (the Mark) that is the subject of application No. 1,333,541 by 1161396 Ontario Inc.

[2] Filed on February 1, 2007, the application is based on use of the Mark in Canada in association with “candy and snacks, namely, candy bars, chocolate bars, all sugar confectionary, peanut brittle, caramel bars, cookies & biscuits, all gummi confectionary, chocolate confectionary, chocolate mints, assorted chocolate boxes, and marshmallow derivative candy” since at least as early as August 2001.

[3] The Opponent alleges that the application does not conform to the requirements of section 30(b) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) in that the Mark could not have been used with each of the goods set out in the application since the alleged date of first use.

[4] For the reasons that follow, I reject the opposition.

#### The Record

[5] The Opponent filed its statement of opposition on July 19, 2013. By way of letter dated October 15, 2013, the Applicant requested an interlocutory ruling on the basis that the statement of opposition should be struck in its entirety as it does not conform to section 38(3) of the Act and does not raise a substantial issue in accordance with section 38(4) of the Act. The Registrar refused the Applicant's request to strike and to reject the statement of opposition in a letter dated October 31, 2013. The Applicant then filed and served a counter statement on December 2, 2013 denying the ground of opposition set out in the statement of opposition.

[6] In support of its opposition, the Opponent filed a certified copy of the affidavit of Sarbjit Singh and exhibits thereto, previously filed as evidence under section 41 of the *Trade-marks Regulations*, SOR/96-195 (the Regulations) in a separate opposition proceeding initiated by 1161396 Ontario Inc. (the Applicant in the present case) against the registration of the trade-mark IRRESISTIBLE that is subject of application No. 1,329,344 by Les Marques Metro / Metro Brands S.E.N.C. (the Opponent in the present case).

[7] In support of its application, the Applicant filed the affidavit of Karol Pawlina which introduces into evidence certified copies of excerpts extracted from the record of the above-mentioned opposition proceeding for the trade-mark IRRESISTIBLE of application No. 1,329,344. At the hearing, the Applicant asked to place on record another copy of the amended statement of opposition for application No. 1,329,344, already attached as Exhibit A to the Pawlina affidavit, as the original attachment was incomplete. The Opponent, who was provided with a copy of the replacement document at the hearing, consented to the request. The new copy of the amended statement of opposition for application No. 1,329,344 has been placed on record.

[8] Both parties filed a written argument and attended the hearing.

## The Hearing

[9] As a preliminary matter, I will address some of the concerns set out in the October 13, 2015 letter, sent on behalf of the Applicant, regarding my ruling at the hearing pertaining to the presence of the Applicant's court reporter, and the provision of the transcript to the participants of the hearing. I will first begin with some background information on hearings held by the Trade-marks Opposition Board (the Board) and the case at hand.

[10] Hearings are held at the request of one or both parties to an opposition proceeding in accordance with section 46 of the Regulations. The Board's administrative practices regarding hearings are generally set out in the practice notice entitled *Practice in Trademark Opposition Proceedings*. Notably, section X of the practice notice states that a party must indicate in its written notice of its request to be heard, *inter alia*, the official language(s) in which representations will be made and whether simultaneous translation would be required so that the Registrar can arrange for interpreters at the hearing. Hearings are generally scheduled for two and a half hours. The Board adheres to the open court principle and has put in place teleconferencing and videoconferencing equipment to facilitate remote access to the hearings, for participants such as trade-mark agents or the parties themselves, as well as third-party observers such as associates and articling students of the trade-mark agents, in-house counsel, foreign counterparts, and the general public.

[11] In the present case, both parties requested a hearing. The agent for the Opponent indicated that representations will be made in French; the agent for the Applicant indicated that representations will be made in English and that simultaneous translation will be required. The Registrar issued a notice on July 23, 2015 setting the date, time and location of the hearing and confirming the presence of interpreters.

[12] On the morning of the hearing, the Manager of Business Operations of the Board oversaw, with the help of several technicians, the logistics for the interpretation services requested by the agent for the Applicant and her associates, as well as the logistics to connect a member of the public who had previously requested the opportunity to observe a number of opposition hearings via teleconference. Shortly before the commencement of the hearing, I was

informed for the first time, by the Manager of Business Operations, that a stenographer accompanied the agent for the Applicant.

[13] At the commencement of the hearing, I asked the agent for the Applicant to explain the presence of the stenographer in the hearing room, whom I noticed had already begun recording without seeking permission. The agent for the Applicant submitted that there is nothing that prohibits a party from appearing with its own court reporter so as to have a transcript of the proceeding and that in fact, it was common practice to have transcripts of court proceedings. The agent for the Applicant also indicated that she has previously informed the Registrar and the Opponent of the Applicant's intention to appear with a court reporter in a letter dated September 28, 2015. The agent for the Applicant added that in any case, the third party observer could easily record the entire proceeding remotely without my knowledge or permission on the phone.

[14] In response to my request for comments, the agent for the Opponent indicated that she has not been previously made aware of the Applicant's intention and that she had no knowledge of the September 28, 2015 letter. The agent for the Opponent added that she does not object to the transcription of the hearing *per se* provided that a copy of the transcript is made available to the Opponent without cost. The agent for the Opponent did however object to the use of the transcript by the Registrar in deciding the matter and any future use of the transcript by the Applicant.

[15] At the hearing, I noted that there is no legislative or regulatory requirement, nor is it the practice of the Board, to have stenographers present at or to have transcripts of hearings held. I also added that I had no prior knowledge of the Applicant's intention to appear with a stenographer at the hearing, nor did the Registrar appear to have received a copy of the September 28<sup>th</sup> letter. Nevertheless, bearing in mind the Opponent's submissions, the right of both parties to a fair hearing, and the principle that the Registrar is the master of its own proceedings, I informed the agent for the Applicant at the hearing that I would allow the transcription to continue provided that copies of the transcript are shared with all participants present at the hearing. I also indicated that since I have no control over the final product or the qualification of the person recording, the transcript will not be considered to be an official

transcript of the hearing and that it will not form part of the record of the present proceeding. Moreover, I confirmed that the transcript will not be relied upon in my decision.

[16] At the hearing, the agent for the Applicant indicated that she has no instructions from the Applicant regarding the cost of providing transcripts to the Opponent or to the Board. I then informed the agent for the Applicant that if that is the case, the hearing will proceed without the court reporter's services, at which point the agent indicated that the Applicant will provide copies of the transcript to the Opponent and the Board. The agent for the Applicant also reiterated the fact that the September 28<sup>th</sup> letter had been sent to both the Opponent and the Registrar and that the attendance of a court reporter was brought up with the Chairperson of the Board in an earlier conversation. The agent for the Applicant stated that a copy of this letter, along with the report confirming the transmission of the letter, will be provided to the Opponent and to the Registrar after the hearing. The hearing then commenced with the Opponent making its submissions.

[17] A few days after the hearing, the Registrar received a letter dated October 13, 2015, sent on behalf of the Applicant. In short, the Applicant submits that my decision to allow for the attendance of the court reporter at the hearing with the condition that copies of the transcript be provided to all participants present exceeded the Registrar's jurisdiction and represents a breach of principles of administrative law.

[18] The agent for the Applicant also raises several concerns regarding the Chairperson which has already been addressed by the latter separately. For the purpose of this decision, I note that in its letter, the agent for the Applicant alleges that I was acting under the direction of the Chairperson on the issue of the attendance of the Applicant's court reporter at the hearing. I further note that the agent for the Applicant did not provide any evidence to substantiate the allegation. Suffice it to say that I was not acting "under the direction" of the Chairperson at the hearing, I did not receive any directions from anyone regarding this opposition proceeding or the issue of the court reporter, nor is my final decision reviewed by the Chairperson before issuance, for each member and hearing officer of the Board has received specific delegated authority from the Registrar under section 63(3) of the Act to carry out certain functions set out in the Act in an impartial and independent manner, including those pertaining to opposition proceedings.

[19] Attached to the October 13, 2015 correspondence are copies of two letters with similar content, both dated September 28, 2015, indicating the Applicant's intention to attend the hearing with a court reporter. One letter appeared to have been sent to the Registrar while the other appeared to have been sent to the Opponent; also included is a report confirming the transmission of the letters by facsimile to the Opponent and to the Registrar on the same date. I note that the Registrar has no record of receiving this letter via facsimile at the time indicated on the transmission report. Likewise, in response to the Registrar's request for comments with respect to the Applicant's October 13, 2015 correspondence, the Opponent states that it did not receive the Applicant's letter said to have been sent by facsimile on September 28, 2015.

[20] As mentioned earlier, I had no knowledge of the Applicant's intention to bring a court reporter to the hearing until the morning of the hearing, nor did the Opponent. Contrary to the submissions made by the agent for the Applicant, the technicians were not there to assist the court reporter with his setup. Rather, the technicians were present to ensure that the simultaneous translation and teleconferencing equipment was working properly.

[21] While I agree with the agent for the Applicant that court reporters are often present in federal and provincial court proceedings, it is simply not that case for hearings held by the Registrar, who elected not to adopt all of the rules of the Federal Court, including those for stenographers and transcription services. As noted by the Supreme Court of Canada in *Canadian Union of Public Employees, Local 301 v Montreal (City)*, [1997] 1 SCR 793, 1997 CanLII 386 (SCC), administrative bodies are normally under no obligation to make verbatim transcripts or recordings of their proceedings provided that the practice does not substantially interfere with an appellate tribunal's ability to review the initial decision on its merits.

[22] In the present case, there are no statutory requirements for the Registrar to make verbatim transcripts or recordings of its hearings. Opposition hearings are limited in scope. The record of the opposition proceeding is usually complete by the time the parties attend the hearing. The hearings do not involve any testimonies; there are generally no new evidence presented; there are rarely any last minute changes to the file on record. Opposition hearings focus on legal arguments and the application of the law to the facts of the case, which have already been made of record. There are limited rulings made during an opposition hearing, all of which are reflected

in the final written decision in any case. Thus, the absence of a transcript in an opposition hearing does not violate the rules of natural justice or any duty of fairness.

[23] I have now reviewed the Applicant's letter of September 28, 2015, in which the agent confirms her attendance as well as that of her associate for the scheduled hearing and states that the letter "shall confirm that the Applicant will also be accompanied by a bilingual court reporter" at the hearing. Having participated in numerous opposition and summary cancellation hearings, the agent for the Applicant is certainly aware that it is not the Registrar's normal practice to have court reporters present at, or to have transcripts of, the hearings.

[24] In the September 28<sup>th</sup> letter, the agent for the Applicant did not seek permission of the Registrar, did not seek to obtain the consent of the Opponent, nor did it provide any reasons, for its unilateral decision to bring its own court reporter to the hearing with the Registrar. At the hearing, the agent for the Applicant simply indicated that nothing prohibits a party from appearing with its own court reporter so as to have a transcript of the proceeding. In the October 13<sup>th</sup> letter, the agent points to the absence of any prior written "objections" from the Registrar as a form of implicit consent.

[25] Setting aside the fact that the Registrar had no prior knowledge of the Applicant's intention in this case, in order for the efficient running of hearings, a party wishing to alter the administrative practices of the Registrar would be required to provide more than a "notice" to the Registrar in its decision to disregard them; the goal of which are to ensure that the rights of the parties to a fair hearing, including procedural fairness and principles of natural justice, are respected.

[26] As for the Applicant's submission that the unrelated third-party observer may or may not be taping the public proceeding over the phone, I would simply note that the hearing is open to the public and, whether in person or by teleconference, all attendees are expected to adhere to the appropriate decorum to ensure the fair administration of justice, which includes the serenity of the hearing.

[27] The fact that there are no rules prohibiting a party from bringing its own court reporter into a hearing room does not imply that it should be automatically permitted. There are many

other practices that are generally observed during a hearing that are not set out in the practice notice or in the legislation, including the time allocated for each party's submissions, as well as the structure of the hearing. Parties who request and attend opposition hearings are expected to observe these practices unless there are legitimate reasons to deviate from them; providing a record of the hearing to a client who is represented by its agent in person or to have its own transcript of the hearing is not a legitimate reason to set aside the practices of the Registrar. As mentioned above, the Board has put in place teleconferencing and videoconferencing equipment to facilitate remote access to the hearings for parties who do not wish to attend in person.

[28] In *James Bauer v Regina (Canadian) Immigration Commission* [1984] 2 FC 455, 1984 CarswellNat 68, the Federal Court was asked to determine "whether the refusal of the applicant's request for the services of a court reporter or stenographer to record the detention review proceedings, at his own expense and for his own purposes, contravenes any entrenched right under the *Canadian Charter of Rights and Freedoms* or otherwise violates any principle of fundamental fairness" [para 16]. The Court determined that in the absence of a statutory provision to the contrary, an administrative tribunal is not required to make a stenographic record of its proceedings and that the refusal to allow the applicant to engage the service of its own court reporter was not a violation of any duty of fairness [para 19 and 23].

[29] I also note that a request to make an electronic recording of an opposition hearing had previously been denied by another member of the Board in a different opposition proceeding [*Gemological Institute of America, Inc v Gemology Headquarters International, LLC*, 2012 TMOB 172, 105 CPR (4th) 220].

[30] While I have no reason to question the conduct or the professionalism of the court reporter at the hearing, I do consider his presence to be a distraction and I am unaware of any jurisprudence pertaining to the fair administration of justice, which would support the unexpected attendance of a court reporter hired by one party for the sole purpose of having its own record of the hearing.

[31] Even so, in view of the Opponent's conditional consent and to maintain a level playing field with respect to all participants at the hearing having a record similar to the Applicant, I considered it reasonable to ask the Applicant to provide copies of the transcripts to all



participants, which is a less prejudicial outcome than to refuse the Applicant's court reporter's presence altogether. The agent for the Applicant was given the option to continue the hearing without the service of the court reporter. It would not have affected the Applicant's right to a just and fair hearing had the court reporter been excused, for there was no inherent or implicit right for a party to impose a court reporter onto the Registrar and onto the other party, nor that of having a personal transcript of a public hearing when such service is not made available by the Registrar.

[32] In view of the foregoing, I see no reason to reconsider my ruling and I disagree with the agent for the Applicant's submission that the ruling amounts to a *de facto* cost award, an abuse of process or a breach of fundamental principles of administrative law.

#### Interlocutory Ruling of October 31, 2013

[33] In its written argument and at the hearing, the Applicant requests the reconsideration of the interlocutory ruling of October 31, 2013 in which the Registrar refused the Applicant's request to strike and to reject the statement of opposition.

[34] In this regard, the Applicant submits that the Registrar erred in the review of the law with respect to section 30(b) of the Act when it found that the sole ground raised in the statement of opposition disclosed an arguable case. Specifically, the Applicant takes the position that section 30(b) of the Act "merely requires that an [a]pplicant prove use in association with the general class of wares and not with each product listed in an application for registration". In support, the Applicant cites *Pronuptia de Paris v Pronovias* 2007 TMOB 3, 2007 CanLII 80847 (TMOB). As such, the Applicant submits that since the statement of opposition alleges that it has not used the Mark in association with each of the goods set out in the application as of the alleged date of first use, the Opponent has not properly pled its sole ground of opposition [my emphasis].

[35] At the hearing, relying on *Produits Ménagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 482 (FCTD) for the Registrar's authority to issue a split decision, the Opponent disputes the Applicant's interpretation of the cited case and of the

section 30(b) requirements. The Opponent further submitted that there is no ground for reconsideration of the interlocutory ruling.

[36] The Registrar can only reconsider a ruling if that ruling was made without jurisdiction, was based on an error of law, or was based on an error in the interpretation of the facts before the Registrar at the time that the ruling was made (see *Jalite Public Ltd v Lencina* (2001), 19 CPR (4th) 406 (TMOB) and *Simmons Ltd v A to Z Comfort Beddings Ltd.* (1987), 18 CPR (3d) 84 (TMOB)).

[37] In its ruling of October 31, 2013, the Registrar determined that the statement of opposition disclosed an arguable case considering that “the application is not for wares of one general class but for individually named specific wares” by virtue of the use of the term “namely” and that “whether the wares are separated by a comma or a semi-colon is not determinative of whether the wares are specified as a general class or a separate class”.

[38] As the Registrar has noted in its ruling of October 31, 2015, the facts of the *Pronuptia* case can be distinguished from those of the present case given the different constructions of the statements of goods in question. The *Pronuptia* decision determined that evidence of use of “ready-made clothing namely wedding dress” cannot serve as evidence of use for a set of goods identified as “lace and embroidery, artificial flowers adornment for hair nets”, which was separated by a semi-colon from the former; it did not discuss whether individually named specific goods separated by commas after “namely” in a statement still form part of a general class of goods.

[39] Since I am unable to conclude that the Registrar has committed any clear error of law or erred in the appreciation of the facts of the case at that time that the ruling was made, I am not prepared to reconsider the October 31, 2013 ruling.

[40] I also note that the Registrar has, on numerous occasions recently, determined that an applicant failed to substantiate a claimed date of first use for *some* of the applied for goods or services in a statement of goods or services appearing to fall in the same general class, notwithstanding the fact that use has been shown with other goods or services in a statement that includes the term “namely” [see for example *MAPA GmbH v 2956-2691 Quebec Inc*, 2013

TMOB 22, 111 CPR (4th) 281, and *Sky Solar Holdings Co, Ltd v Skypower Global*, 2014 TMOB 262, 2014 CarswellNat 6175].

### The Opposition – The Parties’ Respective Burden or Onus

[41] 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 Ltd v Molson Companies Ltd*. (1990), 30 CPR (3d) 293 (FCTD) at 298].

### Does the Application Conform to the Requirements of Section 30(b) of the Act?

[42] The Opponent alleges that contrary to section 30(b) of the Act, the Applicant has not used the Mark in association with each of the goods set out in the application as of the alleged date of first use. In its written argument and at the hearing, the Opponent restricts its section 30(b) pleading to the applied for goods “candy and snacks, namely, [...] cookies & biscuits [...]” (the Opposed Goods). My decision will therefore focus on the Opposed Goods only.

[43] At the outset of its submissions, the Applicant contends that the section 30(b) pleading in the statement of opposition is incorrect in that it alleges that the Mark has not been used with the applied for goods “depuis au moins août 2001”, which could be translated as “since at least August 2001”, even though the application sets the date of first use in Canada to “since at least as early as August 2001”, not “since at least August 2001” [my emphasis].

[44] Having reviewed the statement of opposition in its entirety, I am satisfied that the section 30(b) ground was set out in sufficient detail to enable the Applicant to reply thereto and to understand the case it had to meet, notwithstanding the discrepancy in the wording of the pleading when compared to that of the subject application.

[45] The issue under section 30(b) is whether the Applicant had continuously used the Mark in the normal course of trade from the alleged date of first use to the material date [see *Immuno AG v Immuno Concepts, Inc* (1996) 69 CPR (3d) 374 (TMOB); *Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD) at 262 and *Corporativo de Marcas GJB*,

*SA de CV v Bacardi & Company Ltd* 2014 FC 323, 122 CPR (4th) 389]. The material date for assessing a section 30 ground is the filing date of the application, February 1, 2007 [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475].

[46] As mentioned above, there is an initial evidential burden on the Opponent to adduce sufficient evidence to support its allegation of the application's non-conformity to section 30(b) of the Act, bearing in mind that the facts regarding the Applicant's first use are particularly within the knowledge of the Applicant [see *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1996), 10 CPR (3d) 84 (TMOB) at 89 and *Corporativo de Marcas, supra*]. If the Opponent succeeds in discharging its initial evidential burden, the Applicant must then, in response, substantiate its claim of use during the material time.

[47] The Court has noted that the Opponent's initial burden under section 30(b) can be met by reference not only to its own evidence but also that of the Applicant's [see *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD) at 230]. In the present case, the Applicant has elected not to file any evidence of use of its Mark. I will therefore determine whether the evidence presented by the Opponent satisfies its initial evidential burden.

[48] The Opponent relies on the certified copy of the affidavit of Sarbjit Singh sworn July 27, 2010, and exhibits thereto, previously filed as Rule 41 evidence by the Applicant in a separate opposition proceeding between the parties, albeit in reversed roles. Before addressing the Applicant's objections to the evidence in question, it will be useful to provide a summary of the Singh affidavit.

[49] Mr. Singh is the President and the sole owner of the Applicant. In his affidavit, Mr. Singh states that he is also the President and the sole owner of One Better Inc. since 1995. According to Mr. Singh, the Applicant has continuously and extensively used the Mark in Canada "since at least as early as 2000" in association with "candy and snacks". Mr. Singh also states that the Applicant licenses the use of the Mark in Canada to One Better Inc.

[50] Mr. Singh goes on to provide the wholesale figures for the candy and snacks offered by the Applicant in association with the Mark in Canada since 2000 and its channels of trade across Canada. Mr. Singh attaches as Exhibit 1 “representative labels and packaging of the candy and snacks” of the Applicant as evidence of use of the Mark, and as Exhibit 2 “representative invoices and purchase orders” of those sales in Canada.

[51] Exhibit 1 of the Singh affidavit consists of more than 100 sample labels and packaging of various candy and snack products bearing the Mark. Exhibit 2 of the Singh affidavit consists of more than a dozen sample invoices dated between 2000 and 2010 for various candy and snack products.

[52] The Applicant submits that the Opponent’s evidence is irrelevant and should not be considered as the Singh affidavit does not provide the full picture of the evidence filed by the Applicant in that separate opposition proceeding. In support, the Applicant points to Exhibit B to the Pawlina affidavit, which consists of a letter dated August 16, 2010 sent by the Applicant to the Office in the context of that separate opposition proceeding, identifying four affidavits filed as its Rule 41 evidence, including the Singh affidavit. The Applicant also questions the admissibility of the Singh affidavit as it was filed in a separate proceeding between the parties where the Opponent’s applied for trade-mark was the subject of the opposition.

[53] In terms of the relevance of the evidence, as the Opponent has pointed out, the Court has stated in many occasions that the Opponent’s initial evidential burden with respect to a section 30(b) ground is a relatively light one [see *Tune Master, supra*, and *Molson Canada v Anheuser-Busch Inc*, 2003 FC 1287, 29 CPR (4th) 315 (FCTD)]. Based on a fair reading of the certified copy of the Singh affidavit, I am of the view that the evidence deals directly with questions pertaining to the use of the Mark as of the alleged date of first use in the subject application and as such is relevant.

[54] As for the Applicant’s submission that the evidence filed by the Opponent does not provide a full picture of its evidence in that case, the Applicant was not precluded from filing a certified copy of the remaining of its Rule 41 evidence to put the Singh affidavit into the proper context. Instead, the Applicant chose to provide numerous documents from that other opposition

proceeding, including the Opponent's application, its own amended statement of opposition and excerpts of exchanges between the Office and the parties in that proceeding, but not the "missing" evidence.

[55] As for the Applicant's hearsay objection to the certified copy of the Singh affidavit, citing *Hardee's Food Systems, Inc v Foodcorp Ltd* (1980) 48 CPR (2d) 29 (FCTD) at para 7, the Opponent submits that the certified copy of the Singh affidavit is admissible evidence against the Applicant in the present proceeding as it was first filed in an earlier proceeding that involves the same parties regarding substantially similar questions. In this regard, the Opponent refers to Exhibit A to the Pawlina affidavit where the Applicant's prior use of the Mark and references to the subject application are pleaded in support of its section 30(i) non-conformity ground, its entitlement grounds, as well as its non-distinctiveness ground, in the amended statement of opposition to the Opponent's application for the trade-mark IRRESISTIBLE of application No. 1,329,344.

[56] In response, the Applicant submits that those principles do not apply to the present case since the parties are in reversed roles and the grounds of opposition in the two cases are different. The Applicant also questions the Opponent's interpretation of the *Hardee's* case and points to the Court of Appeal decision in which the decision from the Trial Division was reversed [see *Foodcorp Ltd v Hardee's Food Systems Inc* (1982) 61 CPR (2d) 37 (FCA)].

[57] The *Hardee's* decisions deal with an application to strike certain paragraphs of an affidavit, along with related portions of the originating notice of motion, in an expungement proceeding made pursuant to sections 57 to 59 of the Act, a proceeding that is governed by Federal Courts Rules regarding the admissibility of the affidavits and of the evidence. In reference to the Trial Division's decision where the judge indicated that he was satisfied that "the evidence tendered by each party to the opposition proceedings is admissible against it in the application" [para 7], the Court of Appeal stated that "the admissibility or non-admissibility of material submitted in an expungement proceeding would normally be a matter for the Judge hearing the expungement proceeding and should not be dealt with in a preliminary way before the expungement proceeding is being decided by the Court" [para 4].

[58] Turning to the Opposition Board, the Registrar has previously accepted certified copies or photocopies of affidavits filed in other opposition proceedings where the circumstances justify such a course of action [see for example *Beachcombers Restaurant Ltd v Vita-Park Citrus Products Co* (1976), 26 CPR (2d) 282 (TMOB) and *Barbara's Bakery Inc v Sparkles Photo Ltd* 2011 TMOB 28, 91 CPR (4th) 457]. In *Springwall Sleep Products Ltd v. Ther-a-Pedic Associates, Inc* (1984), 79 CPR (2d) 227 (TMOB), Member Martin also pointed to factors that have been considered in doing so, including (a) whether or not the parties to the proceedings are the same; (b) whether or not the trade-mark applied for is the same in both proceedings; (c) the availability of the affiant for cross-examination; and (d) whether or not all, or most, of the issues in both proceedings are the same.

[59] Even though the circumstances under which the certified copy of the Singh affidavit was filed in the present proceeding are not identical to those found in earlier Board decisions which have dealt with similar evidence in the past, I am prepared to give weight to the Opponent's evidence filed in the present case as I consider the evidence reliable and necessary in the context of the Opponent's initial evidential burden under section 30(b) of the Act.

[60] The parties are identical, albeit in reversed roles. As mentioned above, the earlier affidavit was filed by the Applicant, as the opponent in that other proceeding, as evidence of use of the Mark in support of its prior use and entitlement pleadings. Such prior use, in particular the date of such first use, is at issue in the present proceeding. There is no indication that the information contained in the Singh affidavit can no longer be relied upon for the truth of its content or that it is taken out of context. It would have been easy for the Applicant to file evidence to correct any distortion if that was the case. None was filed. As the facts regarding the Applicant's first use are particularly within the knowledge of the Applicant, not of the Opponent, I am satisfied that it was necessary for the Opponent to file the certified copy of the Singh affidavit for the purpose of its section 30(b) ground of opposition and that it is reliable since the Applicant had the opportunity to refute the evidence [see *Reliant Web Hostings Inc v Tensing Holding BV*, 2012 TMOB 48, 106 CPR (4th) 294 at para 35 and *Zillow Inc v HomeZilla Inc*, 2014 TMOB 131, 123 CPR (4th) 345].

[61] In view of the foregoing, I will have regard to the certified copy of the Singh affidavit filed by the Opponent in the present case, even though it does not represent the entirety of the Applicant's Rule 41 evidence in that other opposition proceeding, in determining whether the Opponent has met its initial evidential burden for its section 30(b) ground of opposition.

[62] Turning to the probative value of the information contained in the Singh affidavit, the Opponent submits that since the affidavit is purported to show use of the Mark with the applied for goods in the subject application, it is reasonable to believe that if evidence of use of the Mark with the Opposed Goods was available, that the Applicant would have produced it as it was in its best interest to do so. Yet, the Singh affidavit is silent in that regard. As such, the Opponent submits that it is reasonable to conclude that the Mark has not been used with the Opposed Goods in view of the absence of any evidence of such use in that other opposition proceeding. The Opponent adds that it is the Applicant who bears the legal onus of establishing, on a balance of probabilities that its application complies with the requirements of the Act.

[63] In response, the Applicant submits that "there is not a scintilla of evidence" in support of the Opponent's sole ground of opposition. In particular, the Applicant contends that "at no point in the Singh Affidavit does the Affiant state that the Applicant has NOT used the [Mark] in association with the [goods] applied for".

[64] Having reviewed the certified copy of the Singh affidavit, I am not satisfied that the Opponent has met its initial evidential burden with respect to its section 30(b) ground, even if it has been characterized as a light burden. In particular, the Opponent failed to put into question the veracity of the alleged date of first use of the Mark in association with the Opposed Goods. As both parties have pointed out, the Singh affidavit provides numerous examples of use of the Mark with a wide variety of candy and snacks, but it does not mention use of the Mark with "cookies and biscuits". Even so, the fact that the Singh affidavit is silent on such use is insufficient to put into question the alleged date of first use of the Mark with these particular goods.

[65] In his affidavit, Mr. Singh states that the Applicant "has continuously and extensively used [the Mark] in Canada in association with candy and snacks" "since at least as early as 2000". In support of his testimony, Mr. Singh attaches "representative labels and packaging of



the candy and snacks [of the Applicant] showing use of [the Mark] in Canada” as well as “representative invoices and purchase orders” of the candy and snacks. The Singh affidavit does not claim to show use of the Mark with each of the applied for goods in the subject application; it does not claim to provide photos of an exhaustive list of labels or packaging of candy or snack items that bear the Mark. Mr. Singh did not make any specific mention regarding use of the Mark with any particular candy or snack in his affidavit. The sample labels and packaging simply supported Mr. Singh’s assertion regarding use of the Mark with “candy and snacks”.

[66] There is no inconsistency in the evidence provided by Mr. Singh in his affidavit. The Singh affidavit does not cast doubt, put into question, or even speak to the claimed date of first use of the Mark with “cookies and biscuits”. The Singh affidavit simply does not address use of the Mark with these particular goods. The only finding I can make with respect to the absence of any specific reference or sample labels or packaging for “cookies and biscuits” in the Singh affidavit is that I am unable to determine whether the Mark was used, within the meaning of section 4 of the Act, with “cookies and biscuits”. I am however unable to conclude that the evidence suggests non-use of the Mark with the Opposed Goods, as of the alleged date of first use or otherwise.

[67] While the Opponent submits that it was in the Applicant’s best interest to produce evidence of use of the Mark with “cookies and biscuits” to substantiate its allegations of prior use in that other proceeding, I cannot reasonably infer from the absence of such evidence that the Mark has not been used with the Opposed Goods as of the alleged date of first use.

[68] In the end, I cannot speculate as to the reason why the Applicant elected not to file sample use of the Mark with “cookies and biscuits” in the context of its opposition against the Opponent’s trade-mark and I refuse to draw an adverse inference in the present case from the Applicant’s failure to do so in that separate proceeding. In the absence of any evidence suggesting that the Applicant has not used the Mark in Canada as of the alleged date of first use in association with “cookies and biscuits”, the Applicant is under no obligation to positively evidence such use. Consequently, I dismiss the section 30(b) ground of opposition for the Opponent’s failure to meet its initial burden.

Disposition

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

---

Pik-Ki Fung  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

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

---

**HEARING DATE:** October 9, 2015

**APPEARANCES**

JOANNE CHRQUI

FOR THE OPPONENT

KERI JOHNSTON

FOR THE APPLICANT

**AGENTS OF RECORD**

Norton Rose Fulbright Canada LLP/S.E.N.C.R.L.,S.R.L.

FOR THE OPPONENT

Johnston Law

FOR THE APPLICANT