

**IN THE MATTER OF AN OPPOSITION by
Minit Canada Ltd. to application No. 1,070,572 for
the trade-mark THINGS REMEMBERED in the
name of Things Remembered Personalized Gifts,
Inc.**

On August 10, 2000, Things Remembered, Inc. filed an application to register the trade-mark THINGS REMEMBERED (the “Mark”) in association with retail gift store services, claiming a convention priority date of May 12, 2000. The application is currently based solely upon use and registration of the Mark in the United States of America.

On June 18, 2002, recordal occurred of a December 2, 2001 assignment of the application in favour of Things Remembered Personalized Gifts, Inc. I shall use the term “Applicant” throughout to refer to the owner of the Mark at the relevant time.

The application was advertised for opposition purposes in the Trade-marks Journal of September 7, 2005. On November 7, 2005, Minit Canada Ltd. (the “Opponent”) filed a statement of opposition.

The Applicant filed and served a counter statement in which it denied the Opponent’s allegations.

In support of its opposition, the Opponent filed the affidavit of George Craw, its Property Manager. The Applicant obtained an order to cross-examine him on his affidavit and the transcript of the cross-examination has been filed. However, the six exhibits marked during the cross-examination have not been filed; nor have any answers to undertakings given been filed.

The Applicant elected to not file any evidence in support of its application.

Neither party filed a written argument but an oral hearing was held in which both parties participated.

At the oral hearing, the Opponent’s agent advised that it was withdrawing the grounds of

opposition set out in paragraphs (d) and (e) of its statement of opposition.

Onus

The 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”). 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 Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Section 12(1)(d) grounds of opposition

The Opponent has pleaded that the Mark is not registrable within the meaning of s. 12(1)(d) of the Act because it is confusing with the following registered trade-marks:

1. THINGS ENGRAVED & Design registered under No. TMA565,118;
2. THINGS ENGRAVED & Design registered under No. TMA565,058;
3. THINGS ENGRAVED Design registered under No. TMA313,846;
4. THINGS ENGRAVED registered under No. TMA313,845
5. CENTRE DE LA GRAVURE & Design registered under No. TMA561,805;
6. CENTRE DE LA GRAVURE & Design registered under No. TMA561,808;
7. CRÉATIONS PERSONNELLES & Design registered under No. TMA582,065;
8. CRÉATIONS PERSONNELLES & Design registered under No. TMA581,076;
9. PERSONALLY YOURS & Design registered under No. TMA609,455;
10. PERSONALLY YOURS & Design registered under No. TMA604,133;
11. PERSONALLY YOURS registered under No. TMA355,196.

The material date for assessing the likelihood of confusion under s. 12(1)(d) is today’s date [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)]. As each of the Opponent’s registrations remains on the register, the Opponent has satisfied its initial onus under this ground.

The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time each has been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.).]

A detailed analysis of the s. 6(5) factors is not required in the present case (neither party presented any argument with respect to this ground). Suffice it to say that although the parties' wares, services and channels of trade might overlap, the parties' marks are sufficiently different to make confusion unlikely. Even though the Mark and some of the Opponent's marks begin with the same word, that word (THINGS) is an ordinary common word and thus when the Mark is viewed as a whole it is different from each of the Opponent's marks in appearance, sound and idea suggested. (The most crucial or dominant factor in determining the issue of confusion is the degree of resemblance between the trade-marks: *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.).) I note that this is not a case where either party has established any significant reputation in association with any of the marks at issue.

The s. 12(1)(d) grounds of opposition are accordingly dismissed.

Section 16(2) grounds of opposition

The Opponent has pleaded that the Applicant is not the person entitled to registration in view of s. 16(2) of the Act, “since at the claim/priority date of the Applicant’s ... Mark, it was confusing with the Opponent’s THINGS REMEMBERED and THINGS REMEMBERED & Design trade-marks.” The only other reference to the Opponent’s THING REMEMBERED marks in the statement of opposition is a statement that the Opponent owns applications Nos. 1,194,464 and 1,194,463 for THINGS REMEMBERED and THINGS REMEMBERED & Design, respectively, copies of which have been provided as Schedule “A”. I therefore interpret the statement of opposition as pleading a s. 16(2)(b) ground, i.e. relying on the Opponent’s trade-mark applications. Assuming that my interpretation is correct, the Opponent has not met its initial burden since a s. 16(2)(b) ground must be based on a previously filed application and the Opponent’s applications were filed October 23, 2003.

At the oral hearing the Opponent took the position that a s. 16(2)(a) ground had been pleaded, i.e. that it was also relying on prior use of its THINGS REMEMBERED trade-marks. Although I do not think that such a pleading is clear from the statement of opposition, in the event that a s. 16(2)(a) ground can be inferred from the reference in the Opponent’s applications to use since at least as early as September 1, 1999 or from the evidence of use introduced by Mr. Craw, I will deal with it.

In order to meet its initial burden under s. 16(2)(a), the Opponent must evidence that it had used its marks prior to May 12, 2000 and had not abandoned its marks as of September 7, 2005.

Mr. Craw’s evidence concerning the THINGS REMEMBERED marks in the period of time prior to May 12, 2000 is as follows:

- 1988: The Cadillac Fairview Corporation Limited and National Key Canada Ltd. entered into a lease agreement for a location in Lethbridge, Alberta, which provided that National Key would “only use the advertised name ‘THINGS REMEMBERED’ for its business in the Premises”. (Exhibit “C”) Although the affidavit states that Exhibit “E” is a

photograph of the Lethbridge THINGS REMEMBERED location, on cross-examination Mr. Craw indicated that there is no photograph of the Lethbridge location and that the photograph provided is that of the Calgary location, which was opened in 2003. (Questions 168-174)

- 1993: The last time that a THINGS REMEMBERED location existed prior to the Opponent's 2003 store was in 1993 (cross-examination, Questions 116-118).
- 1994: Cadillac Fairview issued a rental notice to National Key regarding the Lethbridge location. (Exhibit "D") Although the document refers to the period 11/01/1994 to 10/31/1995, as noted by the Applicant's agent, this document is prospective and there is no indication that its terms were agreed to or fulfilled by National Key. In fact, the Applicant's concerns about the meaning of this document have been substantiated by Mr. Craw's statement during cross-examination that there were no locations under the THINGS REMEMBERED trade-mark between December 1, 1993 and 2003 (Questions 175-176).
- 1999: Based on information and belief, Mr. Craw states, "National Key Canada Ltd. assigned its trade-mark rights to Merchandising International S.A. which entity subsequently assigned its trade-mark rights to Minit Canada Ltd." (paragraph 8 of affidavit and Questions 8-12 of cross-examination) Merchandising International S.A. subsequently entered into a licensing agreement dated November 24, 1999 with the Opponent. (Exhibit "F") The agreement sets out the licensed marks in Appendix "A" but the one page appendix included in the exhibit does **not** list the THINGS REMEMBERED marks. (The Opponent's applications, which were filed by its predecessor Merchandising International S.A. claim use of the THINGS REMEMBERED marks since at least as early as September 1, 1999, but as noted earlier, Mr. Craw attested during cross-examination that there was no use of the Opponent's marks between December 1, 1993 and 2003.)

The evidence does not show use in accordance with s. 4 of the Act of either of the Opponent's THINGS REMEMBERED marks prior to May 12, 2000. If the evidence had shown use of the marks, then it is the Applicant's position that any such use could not be relied upon by the

Opponent since we only have Mr. Craw's bald statement, based on information and belief, that National Key Canada Ltd. assigned its trade-mark rights to the Opponent's predecessor (Merchandising International S.A.). The Applicant's agent requested evidence of the assignment during Mr. Craw's cross-examination (Questions 121-132) and asks that a negative inference be drawn as a result of the Opponent not producing documentation supporting the alleged assignment.

The s. 16(2)(a) grounds, if pleaded, would therefore fail on the basis that the Opponent did not meet its initial burden.

Distinctiveness ground of opposition

The Opponent has pleaded that the Mark is not distinctive in that it is not adapted to distinguish and does not actually distinguish the Applicant's services from the wares and services of the Opponent, having regard to the use by the Opponent of its THINGS REMEMBERED trade-marks. The material date with respect to this ground is the date of filing of the opposition. [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)]

The Opponent meets its initial burden under this ground if it shows that its trade-marks had become known sufficiently as of November 7, 2005 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.)] As indicated above, the Opponent has admitted that there was no use of its THINGS REMEMBERED marks between 1993 and 2003. In September 2003, the Opponent, operating as "Things Remembered", entered into a lease agreement for a location in Calgary. (Exhibit "G") In November 2003, the Opponent received a rental notice regarding such location. (Exhibit "H") A sales receipt dated 11/01/2003 has been provided that displays THINGS REMEMBERED at the top; the receipt is for sales worth \$2.66. (Exhibit "I") A photograph has also been provided showing THINGS REMEMBERED displayed at the Calgary location, which was taken when the store opened in 2003. (Exhibit "E"; Questions 168-174) In addition, there is a statement that the Opponent has operated a website featuring on-line shopping since August 25, 2000; however

there is no evidence showing how the THINGS REMEMBERED marks have been displayed on that website prior to November 7, 2005 or that any Canadians visited that website at any time, including prior to November 7, 2005. (paragraph 13 of affidavit; Questions 221-240)

The Opponent's evidence is insufficient to meet its initial burden. Accordingly, the distinctiveness ground of opposition is dismissed.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I dismiss the opposition pursuant to s. 38(8) of the Act.

DATED AT TORONTO, ONTARIO, THIS 31st DAY OF MARCH 2009.

Jill W. Bradbury
Member
Trade-marks Opposition Board