

## TRADUCTION/TRANSLATION

**IN THE MATTER OF THE OPPOSITION  
OF Continental Tire Canada, Inc. to  
application for registration No. 1126765 for the  
trade-mark XP filed by Compagnie Générale  
des Établissements Michelin-Michelin et  
Cie.**

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### **I Proceedings**

On December 21, 2001, Compagnie Générale des Établissements Michelin-Michelin et Cie (the “Applicant”) filed an application for registration of the trade-mark XP (the “Mark”), based on its proposed use in association with the following wares:

Pneumatic tires and tubes for vehicle wheels; treads for recapping tires, tracks (the “Wares”).

The application was based on proposed use and the Applicant claims the priority provided for in s. 34 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (“Act”), based on an application for the registration of the Mark filed in France on July 16, 2001. It was published on June 25, 2003 in the *Trade-marks Journal* for purposes of opposition.

On August 29, 2003, Continental Tire Canada, Inc. (the “Opponent”) filed a statement of opposition containing the following grounds of opposition:

[TRANSLATION]

1. The Mark has not been used in France in association with the Wares (s. 38(2)(a) and 30(d) of the Act);
2. The application for registration does not meet the requirements of the Act because the Applicant could not, as of the priority date claimed, namely July 16, 2001, and as of any other relevant date, state that it was convinced that it was entitled to use the Mark in Canada in association with the Wares because:
  - i) the Applicant opposed the applications for registration of the Opponent’s Marks defined hereinbelow on the ground that they caused confusion with the following registered trade-marks of the Applicant in association with pneumatic tires and tubes for vehicle wheels:

X TMA190064      ZX TMA210318      XF TMA211567

XK TMA211568	XB TMA211569	XY TMA211570
XZZ TMA211571	XU TMA211572	XS TMA211573
XC TMA211574	XWX TMA211575	XN TMA211576
XM TMA211578	XRD TMA211579	XKD TMA211581
TRX TMA219885	XAS TMA222528	XVS TMA222529
XZA TMA228254	XZY TMA228255	XZX TMA230064
XCA TMA236258	XA TMA245045	XZU TMA291590
XZM TMA292506	XR TMA303145	XL TMA303146
MX TMA320454	XGT TMA325011	XDA TMA325041
XH TMA325164	XDU TMA325165	EP-X TMA364990
XPS TMA367552	MXM TMA380029	

(“registered Marks of the Applicant”)

In the circumstances the Applicant would be estopped from arguing that it was satisfied that it was entitled to use the Mark in Canada in association with the Wares (s. 38(2)(a) and 30(i) of the Act).

3. The Mark causes confusion with the following registered Marks of the Opponent:

XP 2000, certificate of registration TMA543259, registered on March 30, 2001 and based on use since June 1985;

XP 2000 AS, certificate of registration TMA543275, registered on April 2, 2001 and based on use since January 1988;

XP 2000H, certificate of registration TMA543257, registered on March 30, 2001 and based on use since July 1985;

XP 2000 MS, certificate of registration TMA543258, registered on March 30, 2001 and based on use since January 1990;

XP 2000V, certificate of registration TMA543278, registered on April 2, 2001 and based on use since January 1988;

XP 2000Z, certificate of registration TMA543277, registered on April 2, 2001 and based on use since January 1988

(hereinabove and hereinbelow referred to as the “Marks of the Opponent”)

(s. 38(2)(b) and 12(1)(d) of the Act).

4. The Applicant is not the person entitled to registration of the Mark because as of the date of priority claimed in the application for registration, the Mark caused confusion with one of the Marks of the Opponent previously used in Canada by the Opponent or its predecessor in title that had not been abandoned at the time this application for registration was published (s. 38(2)(c), 16(2)(a) and 16(3)(a) of the Act);
5. The Applicant is not the person entitled to registration of the Mark because as of the date of priority claimed in the application for registration, the Mark caused confusion with one of the trade-marks of the Opponent whose applications for registration had previously been filed by the predecessor in title of the Opponent and had not been abandoned at the time this application for registration was published (s. 38(2)(c), 16(2)(b) and 16(3)(b) of the Act);

6. The Mark is not distinctive within the meaning of s. 2 of the Act because it does not and is not capable of distinguishing the Wares from the wares and services of third parties, in particular the Wares of the Opponent and its predecessor in title associated with the trade-marks of the Opponent.

On December 23, 2003, the Applicant filed a counter-statement of opposition denying the grounds of opposition raised by the Opponent.

The Opponent introduced in evidence on July 20, 2004 a certified copy of affidavits of Michel Savard and Jeff Hazelgrove, dated March 9, 1993 and October 8, 1993 respectively, filed as part of an opposition by the Applicant to the registration of the trade-mark XP2000 of the Opponent, which now bears registration number TMA543259. On November 5, 2004, the Applicant objected to the introduction of this evidence. On January 11, 2005, the Registrar referred the adjudication of this objection to the stage of a decision on the merits. The Applicant did not introduce any evidence in the record and the Opponent did not consider it appropriate to correct the purported deficiencies in its evidence.

The parties did not file written arguments and a hearing was held at which they were represented.

## **II Preliminary objection to the introduction of the Opponent's evidence**

I must accordingly determine whether the contents of the affidavit of Mr. Hazelgrove, representing the Opponent, and that of Mr. Savard, counsel in the Applicant's employ at the time, filed as part of other opposition proceedings, are admissible in evidence in this case.

The Opponent referred to the provisions of s. 54 of the Act, Rule 41(1) of the *Trade-mark Regulations (1996)*, the common-law rules of evidence, especially the conditions governing exceptions to the hearsay rule, and, finally, the decision in *Tradition Fine Foods Ltd. v. Groupe Tradition'l Inc.*, [2006] F.C. 588, to support its claims that the contents of these affidavits are admissible in evidence for the purposes of this opposition.

S. 54(1) of the Act permits evidence of any document in the official custody of the Registrar to be given by the production of a certified true copy of this document by the Registrar. As a result of this section, I may conclude that the certified true copy of these affidavits is a copy of the originals introduced in an opposition to registration of the trade-mark XP2000 of this Opponent. However, this subsection does not create a presumption that the contents of these affidavits are true. Such a presumption exists only for any entry in the register if a copy certified to be true by the Registrar of an extract from the register is introduced. An affidavit is certainly not a record in the register referred to in s. 54(2) of the Act. Thus, the contents of these affidavits remain fully admissible.

There can be no question of hearsay evidence in this case because the contested affidavits were not filed as exhibits in support of an affidavit signed by someone else.

I am aware that in some quite specific cases, the introduction of a certified true copy of an affidavit filed in other opposition proceedings has been permitted. However, I refer to the following passage from the decision in *Springwall Sleep Products Ltd. v. Ther-A-Pedic Associates, Inc* (1984), 79 C.P.R. (2d) 227, where my colleague David Martin stated the following on this issue:

As its *Trade Marks Rules*, P.C. 1954-692, SOR Con. 1955, vol. 3, p. 2838, Rule 43 [now Rule 41] evidence in each opposition, the opponent filed a certified copy of the affidavit of Philip Kornblum dated June 25, 1969 which was filed in support of the opposition by Beverly Bedding & Upholstery Co. to application No. 303, 593 for the trade mark MED-I-COIL. The certified copy of the Kornblum affidavit filed in each opposition is inadmissible. Although the registrar has accepted certified copies of affidavits filed in other opposition proceedings where the circumstances justify such a course of action (see e.g. *Beachcombers Restaurant Ltd. v. Vita-Pakt Citrus Products Co.* (1976), 26 C.P.R. (2d) 282), the opponent has not made any submissions justifying such an approach in this case. Among the circumstances that have been considered in the past are:

- (1) whether or not the parties to the current proceedings are the same as in the previous proceedings;
- (2) whether or not the trade-mark applied for was the same in both proceedings;
- (3) the availability of the affiant for cross-examination; and,
- (4) whether or not all, or most, of the issues in the two proceedings are the same.

The opponent has failed to file submissions respecting any of the above circumstances and I would especially note that the opponent failed to file a bridging affidavit of Mr. Kornblum covering the period subsequent to his original affidavit. This failure on the part of the opponent effectively precluded the applicant from cross-examining Mr. Kornblum and this fact alone is enough to conclude that the certified copies of the Kornblum affidavit are inadmissible in these proceedings. (Emphasis added)

Although our situation is not identical, we may still refer to the criteria set out there. First of all, there is no affidavit of Mr. Hazelgrove covering the period between the two affidavits. If there were such an additional affidavit, Mr. Hazelgrove would become compellable for cross-examination. Although it seems that the parties are the same, the Mark is not identical to that which was the subject of the other opposition. Furthermore, I do not have any evidence that the issues were essentially the same as those raised in these proceedings. It may be added that the relevant dates (the date on which the application was filed, the date on which the statement of opposition was filed and the date of the decision) were clearly not the same. Since the role of the parties was reversed, the onus of proof is different. Finally, the fact situation in this case differs from the opposition to the registration of the trade-mark XP2000 since this trade-mark is now included in the register.

For all these reasons, I find that the contents of Mr. Hazelgrove's affidavit are inadmissible in evidence in the context of these opposition proceedings. For the same reasons, Mr. Savard's affidavit is also inadmissible in evidence. In the latter case, I would add that I adopt the comments of my colleague Jill W. Bradbury in the decision dated November 4, 2005 in the case of the opposition by *Direct Plus Food Group Ltd.* to the application for registration No. 1,027,831 of the trade-mark GOODLIFE & Design filed by Hong Rock Trading Co., Ltd.:

The opponent anticipated that the applicant might point out that the opponent took the position that the marks at issue are not confusing when it defended the applicant's opposition against its application No. 1,045,773 for GOODLIFE. Those pleadings are part of the present record because they were filed by the applicant. The opponent need not be concerned that I would treat this as an admission against interest for two reasons. First, as indicated in the case relied upon by the opponent, *California Fashion Industries, Inc. v. Reitmans (Canada) Ltd.* (1991), 38 C.P.R. (3d) 439 (F.C.T.D.), the decision as to whether or not a trade-mark is confusing within the meaning of s. 6 of the Act involves a judicial determination of a practical question of

fact and the facts in the present case are not identical to those in the opposition with respect to application No. 1,045,773. Even though the marks at issue are the same, there are important differences such as the relevant material dates. In *Molson Breweries v. Labatt Brewing Co.* (1996), 68 C.P.R. (3d) 202 (F.C.T.D.), where one party argued that a prior inconsistent position taken by the other party was a relevant surrounding circumstance in assessing the likelihood of confusion, the Court said: “In my view, this circumstance is not relevant in determining whether the two trade-marks at issue are confusing. Regardless of the previous positions taken by Labatt, I must come to a determination as to confusion that is in accordance with the law and relevant jurisprudence.” A second reason why the positions taken in the earlier opposition are irrelevant is that a decision has recently been issued with respect to that opposition, refusing application No. 1,045,773 on the basis of a likelihood of confusion. If this had not been the case, I would have considered the fact that in the opposition proceedings with respect to application No. 1,045,773, both parties, not just Direct Plus Food Group Ltd., took positions that are opposite to those taken in the present proceedings. If I were to treat the opponent’s prior position against it, it would seem fair that the applicant’s prior position also be held against it, with the possible outcome that the two “admissions against interest” would cancel each other out. (Emphasis added)

### **III Analysis of the different grounds of opposition**

In proceedings concerning an opposition to the registration of a trade-mark, an Opponent must adduce sufficient evidence concerning the grounds of opposition it raises in order to make it clear that there are facts that may support these grounds of opposition. If the Opponent meets this initial requirement, the Applicant must subsequently convince the Registrar, on a balance of probabilities, that the grounds of opposition should not prevent the mark from being registered. [See *Sunshine Biscuits Inc. v. Corporate Foods Ltd.* (1982), 61 C.P.R. (2d) 53, *Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 and *John Labatt Ltd. v. Molson Companies Limited*, (1990), 30 C.P.R. (3d) 293.]

Since I consider the contents of the affidavits of Mr. Hazelgrove and Mr. Savard inadmissible in evidence, there is no evidence in the record from either side. The Opponent did not therefore discharge its initial onus of establishing the existence of facts that would support each of the grounds of opposition set out above. Thus, I must reject each and every one of these grounds of opposition, except for the third ground of opposition (registrability), for the reason given below

in light of the Opponent's failure to discharge its initial onus of proof. As far as the third ground of opposition is concerned, the case law has established that the Registrar enjoys a certain amount of discretion and may consult the register to check whether the Opponent is in fact the owner of the registered marks referred to in support of this ground of opposition. [See *Quaker Oats Co. of Canada v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 at page 411 (TMOB).]

I have checked the register and can confirm that each of the trade-marks mentioned in the third ground of opposition set out above is still included in the register and in the Opponent's name. In the circumstances, I consider that the initial onus on the Opponent has been discharged and that it is now the responsibility of the Applicant to establish, on a balance of probabilities, that the Mark does not cause confusion with any of the Opponent's marks.

The relevant date in determining the merits of this ground of opposition is that on which the Registrar's decision was made. [See *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at page 424 (F.C.A).]

The applicable test in determining whether there is a likelihood that confusion will be caused between the Mark and any of the Opponent's marks is set out in s. 6(2) of the Act:

(2) The 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.

The Registrar must consider all relevant circumstances including the inherent distinctiveness of the trade-marks or trade-names, and the extent to which they have become known, the length of time the trade-marks or trade-names have been in use, the nature of the wares, services or business, the nature of the trade and the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them.

I consider that if I were to conclude that there was no likelihood of confusion between the Mark and the Opponent's XP 2000 trade-mark, then *a fortiori* there would be no likelihood of

confusion between the Mark and the other trade-marks filed by the Opponent referred to in paragraph 3 above. I shall accordingly analyse the different relevant circumstances by comparing the Mark with the Trade-mark XP 2000.

These trade-marks do not have an inherent distinctiveness. In fact, it has been indicated on many occasions that a trade-mark consisting of letters of the alphabet is a weak mark. [See, for example, *GWS Ltd. v. Great West Steel Industries Ltd. et al.* (1975), 22 C.P.R. (2d) 154 at page 163.] Furthermore, there was no evidence of use anywhere that might have enhanced the degree of their distinctiveness. In the circumstances, this factor does not favour either of the parties.

Under the principles set out in *Cartier Men's Shops Ltd. v. Cartier Inc.* (1981), 58 C.P.R. (2d) 68, the Registrar may refer to the date of use mentioned in the register to determine the length of time the mark referred to in the certificate of registration has been used. However, I can find only minimal use that would be insufficient to give this factor a pronounced importance in the circumstances.

The XP 2000 mark was registered in association with tires and there is accordingly an overlap between the wares of the parties. I have no evidence concerning the channels of trade but since the wares are, for all essential purposes, identical, it is logical to assume that they would be the same. These factors accordingly favour the Opponent.

Concerning the degree of resemblance between the trade-marks being considered, we should note the comments of Mr. Justice Cattanach in *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145, aff'd. 60 C.P.R. (2d) 70:

Realistically appraised it is the degree of resemblance between the trade-marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a subservient role in the over-all *surrounding* circumstances.

The marks must be considered as a whole and not be taken apart to look for similarities or differences. The test remains that of the ordinary consumer with an imperfect memory. [See



*Canadian Schenley Distilleries Ltd. v. Canada's Manitoba Distillery Ltd.* (1975), 25 C.P.R. (2d) 1.] Finally, the first part of a trade-mark is the most important when we compare the marks in question. [See *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183.] It is undeniable that there is a resemblance between the marks in terms of both appearance and sound. The Mark incorporates the first part of the Opponent's trade-mark in an identical manner. I conclude that this factor slightly favours the Opponent.

I find that the Applicant did not discharge its onus of proving, on a balance of probabilities, that there was no likelihood of confusion between the Mark and the trade-mark XP2000. In fact, the wares are the same and there is a certain resemblance between the marks. At best for the Applicant, I would conclude in light of the low degree of distinctiveness in the Opponent's mark XP 2000 that the probabilities were equal. There would then be a doubt that would also have to be resolved in the Opponent's favour. [See *Christian Dior S.A. v. Dion Neckwear Ltd.* (2002), 20 C.P.R. (4th) 155.]

I accordingly maintain the third ground of opposition.

#### **IV Conclusion**

By virtue of the powers conferred on me by the Registrar of Trade-marks under s. 63(3) of the Act, I maintain the opposition of the Opponent and accordingly refuse the application for registration of the Mark XP by the Applicant in association with the Wares, all in accordance with the provisions of s. 38(8) of the Act.

DATED AT MONTRÉAL, QUEBEC, THIS 12<sup>th</sup> DAY OF JANUARY 2007.

Jean Carrière

Member of the Trade-marks Opposition Board