

**IN THE MATTER OF AN OPPOSITION
by RA Brands, L.L.C. to application No.
1,045,604 for the trade-mark THE
REMINGTON GROUP & Design filed by
Calsper Developments Inc.**

On February 4, 2000, Calsper Developments Inc. (the “Applicant”) filed an application to register the trade-mark THE REMINGTON GROUP & Design (the “Mark”), which is shown below:



The application is based upon use of the trade-mark in Canada since at least as early as July 1991 in association with the following services:

Development, management, and financial lending services relating to all aspects of residential, commercial and industrial properties and real estate projects and developments; development, designing, planning, construction, and maintenance of residential, commercial and industrial real estate projects and developments; the designing, planning and production of sales presentations relating to the sale and management of residential, commercial and industrial properties and real estate projects and developments; the provision of architectural, engineering, management, development, sales and marketing consultation services relating to the residential, commercial and industrial real estate and construction industries, and to real estate projects and developments.

The application was advertised for opposition purposes in the Trade-marks Journal of November 14, 2001. On April 15, 2002, RA Brands, L.L.C. (the “Opponent”) filed a statement of opposition against the application. The grounds have been pleaded as follows:

1. The Mark is not registrable in view of s. 12(1)(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”), and the Applicant is not entitled to registration of its mark

contrary to s. 16(1)(a), (b) and (c) in view of the prior and confusing applications and registrations of the Opponent, as set out below:

Regn TMDA20942	REMINGTON
Regn. 425,798	REMINGTON
Regn. 468,948	REMINGTON
Appln. 1,001,687	REMINGTON
Regn. 489,314	REMINGTON Design
Regn. TMDA16221	REMINGTON UMC & Red Ball Design

2. In view of the facts set out in 1 above, Applicant's Mark is not distinctive of it, nor is it capable of becoming distinctive of it.
3. The Applicant's Mark has not been used by the Applicant since the date of first use alleged or at all in Canada or elsewhere.

The Applicant filed and served a counter statement in which it denied the grounds of opposition.

As rule 41 evidence, the Opponent filed certified copies of the registrations and application relied upon in its statement of opposition.

The Applicant filed the affidavit of Matthew Bratty as rule 42 evidence. The Opponent obtained an order for the cross-examination of Mr. Bratty and a transcript of the cross-examination forms part of the record.

Only the Applicant filed a written argument, but an oral hearing was held at which both parties were represented.

Applicant's Evidence

I will summarize the most pertinent portions of the evidence below.

Bratty Affidavit

Mr. Bratty is the President of both the Opponent and of Remington Homes Inc. He informs us that the Opponent is a management company that licenses the Mark to Remington Homes Inc. ("Remington Homes"), and that Remington Homes provides a wide range of services relating to

the design, construction and maintenance of real estate developments. He states that the Opponent retains control over the quality of the services provided by Remington Homes and provides, as Exhibit A, a copy of a license agreement between the parties executed August 25, 2003 (the same date as his affidavit) and stated to be effective as of that date.

Mr. Bratty states that the mark THE REMINGTON GROUP is also licensed to various companies that are created to manage the construction and sale of homes in each development site, and that the Opponent retains control over the quality of wares and services provided by these companies. (I note that THE REMINGTON GROUP is not the mark applied for.)

According to Mr. Bratty, Remington Homes, along with other licensees, has been using the Mark on a continuous basis since 1991. Remington Homes' approximate annual revenue in each of the years from 1994 through 2002 has exceeded \$4.5 million.

Sample printed material has been provided as Exhibit B, but none of it shows use of the Mark.

As Exhibit C, Mr. Bratty provides details and promotional materials concerning Remington Homes' sponsorship of community events but I do not see the Mark on any of these materials.

As Exhibit D, Mr. Bratty provides documentary evidence in support of his statement that Remington Homes has been a member of the Greater Toronto Home Builders' Association and the Ontario New Homes Warranty Program since 1992.

As Exhibit E, Mr. Bratty provides sample pages dated March and August 2003 from two websites operated by Remington Homes. The Mark does appear therein.

As Exhibits G and I, Mr. Bratty provides samples of newspaper and magazine advertisements, but I do not see the Mark displayed therein.

Similarly, I do not see the Mark in the television advertisements provided as Exhibit K, or in the

flyers or photographs of signs provided as Exhibits R and S, or on the trucks shown in Exhibit T.

Mr. Bratty has provided Remington Homes' annual advertising expenditures from 1993-2002 but I am not going to accord those figures any weight, as it is not clear that they relate solely to the Mark at issue.

Cross-examination

It is difficult to understand certain parts of the cross-examination, but I note the following points:

- Mr. Bratty does not know how many companies are licensed to use the Mark. [Question 12]
- The Opponent does not itself use the Mark. [Questions 25 and 26]
- You have to have a recordal under the Ontario New Homes Warranty Program in order to build houses. [Questions 31 – 35]
- Mr. Bratty did not gather the documents that are included in his exhibits and did not put the handwritten notes on them. [Questions 36-39]
- Exhibit A is the only signed license agreement. [Questions 45-48]

Material Dates

The material dates with respect to the grounds of opposition are as follows: s. 12(1)(d) - the date of my decision [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)]; s. 16(1) - the Applicant's date of first use; non-distinctiveness - the date of filing of the opposition [*Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.) at 324]; s. 30 - the date of filing of the application [*Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469 at 475].

Onus

Although the Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act, there is an initial 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; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.).]

Section 12(1)(d) Grounds of Opposition

The Opponent has met its initial burden with respect to its s. 12(1)(d) grounds of opposition because the registrations on which it relies are extant. The likelihood of confusion among the marks will therefore be assessed, beginning with the likelihood of confusion between the Mark and the Opponent's REMINGTON mark.

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: the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time each has 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. All factors to be considered under s. 6(5) do not necessarily have equal weight. The weight to be given to each depends on the circumstances. [See *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1966), 66 C.P.R. (3d) 308 (F.C.T.D.).]

inherent distinctiveness of the trade-marks

Since the Applicant's Mark has design features, I find that it is more inherently distinctive than the Opponent's mark.

the extent to which each trade-mark has become known

There is no evidence that the Opponent's REMINGTON mark has become known in Canada. There is only minimal evidence of the Applicant's Mark becoming known in Canada (Exhibit E, Bratty affidavit). Accordingly, I find that this factor does not favour either party.

the length of time each trade-mark has been in use

The dates of first use set out in the Opponent's registrations are as follow:

- TMDA20942 - 1857;
- 425,798 - February 1992;
- 468,948 - November 01, 1996;
- 489,314 - January 22, 1998; and
- TMDA16221 - March 01, 1911.

Based on the dates of first use set out in the Opponent's registrations, the length of time that each trade-mark has been in use favours the Opponent. [See *Cartier Men's Shops Ltd. v. Cartier Inc.* (1981), 58 C.P.R. (2d) 68 (F.C.T.D.) at 71.]

the nature of the wares, services or business; the nature of the trade

When considering the wares, services and trades of the parties under s. 12(1)(d), it is the statements of wares or services in the parties' trade-mark application or registrations that govern. [See *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe, Inc. v. Dale Bohna* (1984), 58 C.P.R. (3d) 381 (F.C.A.).]

The statement of wares in each of the Opponent's registrations reads as follows:

- TMDA20942 - Rifles, shot guns, pistols, cartridges, cartridge shells, shot gun cartridges, paper shot shells, powders, wads, percussion caps, primers, bullets, bullets and shot;
- 425,798 - Tents, backpacks, camping stools, sleeping bags, and hunter's all-purpose carry bags;
- 468,948 – bed throws;
- 489,314 - Traps for throwing targets; optical scopes or sights; and archery products, namely bows, arrows, arrow rests, quivers and cases and accessories for the foregoing wares; and
- TMDA16221 - Fire-arms and ammunition.

There is thus no connection at all between the Applicant's real estate-related services and any of

the Opponent's registered wares and there is no reason to conclude that there is any connection between the parties' trades.

the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

The dominant portion of the Applicant's Mark is identical to the Opponent's mark.

conclusion re likelihood of confusion

I am satisfied that, on a balance of probabilities, there is not a reasonable likelihood of confusion between REMINGTON and THE REMINGTON GROUP & Design mark. In reaching this conclusion, I acknowledge that s. 6(2) specifically indicates that confusion may be likely whether or not the wares or services are of the same general class. However, as stated by Mr. Justice Binnie in *Mattel, Inc. v. 3894207 Canada Inc.*, 2006 SCC 22 at paragraph 73, "Be that as it may, the view is correct that 'all of the surrounding circumstances' must be taken into consideration but that, in some cases, some circumstances (such as the differences in wares) will carry more weight than others." In the present case, I find that the great differences between the Applicant's services and the Opponent's wares weigh more heavily than the resemblance between the marks. My conclusion is reinforced by the facts that the parties' trades would appear to be completely disparate and the Opponent has not established any reputation within Canada.

For reasons similar to those set out above, an analysis of the likelihood of confusion between the Mark and each of the Opponent's REMINGTON Design marks also results in a conclusion that, on a balance of probabilities, there is not a reasonable likelihood of confusion. The design features of those marks simply serve to make the Opponent's case weaker.

For the foregoing reasons, all of the s. 12(1)(d) grounds of opposition are rejected.

Section 16 Grounds of Opposition

In order to meet its evidential burden with respect to its s. 16(1)(a) ground of opposition, the Opponent must provide evidence of use of its trade-mark prior to the Applicant's date of first

use. The Opponent has filed no such evidence. When an opponent only files a certified copy of its registration, the Registrar will assume only *de minimus* use of the opponent's trade-mark. [See *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.).] Therefore the mere filing of certified copies of the Opponent's registrations does not support the Opponent's evidential burden with respect to its s. 16(1)(a) grounds of opposition. The s. 16(1)(a) grounds of opposition accordingly fail.

The Opponent's application No. 1,001,687 was filed before the Applicant's application and was still pending as of the date of advertisement of the Applicant's application. The Opponent has therefore met its evidential burden with respect to its s. 16(1)(b) ground of opposition [see s. 16(4) of the Act]. However, for reasons similar to those discussed with respect to the s. 12(1)(d) grounds of opposition, the s. 16(1)(b) ground is also rejected. It is noted that application No. 1,001,687 was filed based upon proposed use of the mark REMINGTON in association with "games, namely computer games, card games, and video games; board games, and playing cards" and there is no evidence that the Opponent's mark ever acquired any reputation in Canada in association with games. Moreover, games are completely unrelated to the Applicant's services.

The s. 16(1)(c) ground of opposition is also rejected, as the Opponent's pleadings do not refer to any trade-name in support of such a ground.

Distinctiveness Ground of Opposition

This ground of opposition has been so pleaded as to rely on the likelihood of confusion between the parties' marks resulting in the Applicant's Mark not being distinctive.

In the recent decision in *Bojangles' International, LLC and Bojangles Restaurants, Inc. v. Bojangles Café Ltd.* 2006 FC 657, Mr. Justice Noël stated at paragraph 34, "A mark must be known to some extent at least to negate the established distinctiveness of another mark, and its reputation in Canada should be substantial, significant or sufficient." Because the Opponent has not filed any evidence concerning its use or promotion of its marks, I am unable to conclude that any of its marks has acquired a reputation in Canada that is "substantial, significant or

sufficient”. The Opponent has therefore not satisfied its initial burden with respect to its distinctiveness ground of opposition and that ground accordingly fails. The mere filing of certified copies of the Opponent's registrations does not satisfy the Opponent's evidential burden with respect to its allegations of non-distinctiveness. [See *Entre Computer Centers, Inc. v. Global Upholstery Co., supra.*]

Section 30 Ground of Opposition

At the oral hearing, the Opponent’s agent focused his submissions on this ground.

Section 30(b) requires that there be continuous use of the applied for trade-mark in the normal course of trade from the date claimed to the filing date of the application. [See *Labatt Brewing Co. v. Benson & Hedges (Canada) Ltd.* (1996), 67 C.P.R. (3d) 258 (F.C.T.D.) at 262.] The evidential burden on the Opponent respecting the issue of the Applicant’s non-compliance with s. 30(b) of the Act is a light one [see *Tune Masters v. Mr. P's Mastertune* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.) at 89 and *Canadian National Railways Co. v. Schwauss* (1991), 35 C.P.R. (3d) 90 (T.M.O.B.)]. This burden can be met by reference not only to the Opponent's evidence but also to the Applicant's evidence [see *Labatt Brewing Company Limited v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.) at 230]. In such a case however, the Opponent must show that the Applicant’s evidence is ‘clearly’ inconsistent with the claims set forth in its application.

Initial onus

The Applicant emphasized that the initial burden is on the Opponent with respect to s. 30(b) and submitted that the Opponent has not satisfied such burden, with the result that the Applicant is not obliged to answer its legal burden.

The Opponent submitted that it has met its evidential burden through Mr. Bratty’s evidence. Mr. Bratty evidenced that Remington Homes was first registered under the Ontario New Homes Warranty Program in 1992 and on cross-examination he attested that it is illegal to build houses without being so registered. The Opponent’s agent wants me to conclude that such evidence is

clearly inconsistent with the Applicant's alleged date of first use. However, the Applicant's agent pointed out that there is no evidence that the Ontario New Homes Warranty Program was in existence prior to 1992 and Mr. Bratty's statements concerning the legality of building without registering were stated in the present case, namely as of 2004.

If the Ontario New Homes Warranty Program had been shown to predate 1992, it is possible that I might have found that the Opponent had met its initial burden with respect to the residential portions of the Applicant's statement of services. However, there is no reason to conclude that registration under the Ontario New Homes Warranty Program would affect the Applicant's ability to perform its other services at any point of time. In addition, even if there was evidence that the Ontario New Homes Warranty Program applied as of July 1991, it is questionable if failure to register would prevent the Applicant from using the Mark in association with its services. This is because use of a mark with services does not require the services to be performed immediately; use may be found to have occurred at the point of time when a mark has been advertised in association with services provided that the mark's owner is in a position to perform the services if and when required to do so. [See *Wenward (Canada) Ltd. v. Dynaturf Co.*, 28 C.P.R. (2d) 20; s. 4(2) of the Act.]

The Opponent also made oral submissions with respect to the following additional issues.

Issues relating to licensees

The Opponent pointed out that the written license agreement with Remington Homes is only effective as of August 25, 2003. For this reason, it submitted that any use by Remington Homes that predates August 25, 2003 does not accrue to the benefit of the Applicant. It further pointed out that Mr. Bratty stated during cross-examination that the Applicant does not itself build homes.

Use by a licensed party is addressed in s. 50 of the Act, as follows:

50. (1) For the purposes of this Act, if an entity is licensed by or with the authority of the owner of a trade-mark to use the trade-mark in a country and the owner has, under the licence, direct or indirect control of the character or quality of the wares or services,

then the use, advertisement or display of the trade-mark in that country as or in a trade-mark, trade-name or otherwise by that entity has, and is deemed always to have had, the same effect as such a use, advertisement or display of the trade-mark in that country by the owner.

(2) For the purposes of this Act, to the extent that public notice is given of the fact that the use of a trade-mark is a licensed use and of the identity of the owner, it shall be presumed, unless the contrary is proven, that the use is licensed by the owner of the trade-mark and the character or quality of the wares or services is under the control of the owner.

Section 50(2) does not apply to the present case, based on its facts. It therefore remains to decide if the Applicant's evidence is clearly inconsistent with the Mark having been used by the Applicant through a controlled licensee.

Based on the following exchange during the cross-examination (at pages 3-5), I conclude that the evidence is not so clearly inconsistent:

Q. Mr. Bratty, what does the president of Calsper Developments do?

A. Builds houses.

Q. Pardon?

A. Builds houses.

Q. Builds houses. Do you have any other responsibilities as –

A. Calsper?

Q. Yes.

A. No.

Q. So is Calsper an active building company or is it a holding company?

A. It's a – well, it builds under Remington Homes, right?

Q. Okay. And what does Remington Homes Inc. do? It's a separate company? Let me separate that out. Remington Homes Inc. is a separate company to Calsper Developments Inc.?

A. No.

Q. Okay. You want to explain how they interact?

A. Calsper runs Remington Homes, is that not right?

Ms. Coutts: I can't answer the question for you. It's –

Mr. McKay: Yes, she's...

The Deponent: Remington builds under – Calsper builds under Remington.

Q. Okay. So I take it Calsper Developments Inc. is not the active company in terms of the building? It's Remington Homes Inc. that does the building?

A. Yes.

Q. And they use the name Remington Homes?

A. Yes.

Q. And do you know how many companies are licensed to use the trade-mark?

A. No.

Q. Do you have any idea?

A. No.

Q. And is it you that has the control over the quality control of the use of the marks?

A. Yeah.

Q. And what procedures do you have in place in order to make sure the marks are being properly used?

A. I'm the only one that allows these things to go out. I have all the signing rights to this company.

Despite the lack of clarity at some points of the evidence, it appears to me that Mr. Bratty, the President of both the Applicant and Remington Homes Inc. since their inception, has controlled the character and quality of the services performed by Remington Homes Inc. in association with the Mark, pursuant to a license from the Applicant. The absence of evidence of a written license prior to August 25, 2003 is not clearly inconsistent with an oral license having been in place prior to that. To put it another way, an oral license may be inferred from the evidence. [See *Lindy v. Canada (Registrar of Trade Marks)* (1999), 241 N.R. 362 (F.C.A.), *Dominion Automotive Group Inc. v. Firebolt Engine Installation Centres Inc.* (1998), 86 C.P.R. (3d) 403 and *Petro-Canada v. 2946661 Canada Inc.* (1998), 83 C.P.R. (3d) 129 (F.C.T.D.)]

Issue re residential, commercial and industrial properties

The majority of the Applicant's evidence relates to residential developments but the application's statement of services also refers to commercial and industrial properties. The Opponent therefore argued that if use has been shown of the applied for mark, then such use is not in association with all of the applied-for services. However, in the absence of the Opponent satisfying its initial

burden, the Applicant need not demonstrate its use. In any event, I note that the ground as pleaded did not specifically focus on the individual services and that there is some evidence of THE REMINGTON GROUP & Design mark being associated with the non-residential services [see Exhibit “E”, Bratty affidavit].

Issue re use as of July 1991

The Opponent’s agent pointed out that the sales and advertising figures provided by Mr. Bratty all begin later than 1991. However, I do not consider this sufficient basis on which to conclude that the Opponent has met its initial burden, as such evidence is not clearly inconsistent with the Applicant’s claim of use since July 1991.

In the February 6, 2006 opposition decision in *Screenlife Productions Limited v. Rock Whitney, dba Flightpath, Film, Video & Stills*, re application No. 1010728, Board Member Carrière pointed out that the opponent therein could have clarified any ambiguities that it perceived in the applicant’s evidence through a cross-examination; ambiguities do not constitute a clear contradiction to the claims of use made in an application. It is not unusual for a party to not provide all of its sales figures; it is inappropriate to conclude that this means there was no use of the trade-mark outside those time periods, especially where the affiant has attested that there was (paragraph 5, Bratty affidavit) and the Opponent chooses not to pursue this point further during cross-examination.

Overall, I find that the Opponent has not met its initial burden with respect to its s. 30 ground of opposition and such ground accordingly fails. Although the Applicant evidenced only one example of use of its Mark, and that in 2003, Mr. Bratty did attest that there was continuous use since 1991. The latter is a bald statement that is not supported by the rest of the evidence but, at the same time, the evidence does not contradict it. The Opponent did not explore this further on cross-examination and the Applicant was not required to provide supporting evidence.

Disposition

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

DATED AT TORONTO, ONTARIO, THIS 23rd DAY OF AUGUST 2006.

Jill W. Bradbury
Member
Trade-marks Opposition Board