



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

Citation: 2014 TMOB 7
Date of Decision: 2014-01-16

**IN THE MATTER OF AN OPPOSITION
by Cherry Pick Web Marketing Inc. and
Biray Giray to application No. 1,460,892
for the trade-mark CHERRYPICK in the
name of Debra Dawn Cherry**

[1] On November 27, 2009, Debra Dawn Cherry (the Applicant), filed an application for the trade-mark CHERRYPICK (the Mark) based upon use of the Mark in Canada since at least as early as November, 2005, in association with the following services: “real estate services; information and Internet services, namely the provision of real estate services information via the Internet”.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of May 5, 2010.

[3] On October 5, 2010, Cherry Pick Web Marketing Inc. and Biray Giray (the Opponent), opposed the application on several grounds. The Applicant requested that an interlocutory ruling be made on the sufficiency of a portion of the Opponent's pleadings. In this regard, several of the grounds of opposition plead that the Opponent's trade-marks and trade-name have been used or made known in Canada but the goods and services were not particularized. The Opponent was given an opportunity to respond to the Applicant's submissions that such pleadings are too vague, but elected not to do so. The Board ruled, on March 3, 2011, that paragraphs 2(a)(i), 2(a)(iii), 2(b) and 2(e) of the statement of opposition be struck in their entirety. The remaining grounds of opposition are as follows:

(i) the Applicant has not used the Mark in Canada for the specific services recited from the date of first use stated; and

(ii) the Mark does not distinguish the Applicant's services from the Opponent's services identified by the following trade-marks CHERRY PICK, CHERRY PICK (Design), CHERRY PICK, WWW.CHERYPICK.CA, CHERRY PICK WEB MARKETING or the Opponent's alleged trade-name CHERRY PICK WEB MARKETING INC.

[4] I note in passing that I may have also struck the distinctiveness ground at the interlocutory ruling stage because the Opponent's services were not identified and therefore the ground was arguably not sufficiently plead pursuant to section 38(3) of the *Trade-Marks Act*, RSC 1985, c T-13. However, in view that the proceeding is now at the decision stage and evidence has been filed, I am required to read the pleadings in conjunction with the evidence [see *Novopharm Ltd v AstraZeneca AB* (2002), 21 CPR (4th) 289 (FCA); *Novopharm Ltd v Ciba-Geigy Canada Ltd* (2001), 15 CPR (4th) 327 (FCA)].

[5] The Applicant subsequently served and filed its counter statement generally denying the grounds of opposition.

[6] As its evidence, the Opponent filed the affidavit of Biray Giray. The Applicant filed the affidavit of Debra Dawn Cherry. Only Mr. Giray was cross-examined and his cross-examination transcript and replies to undertakings form part of the record.

[7] Both the Applicant and the Opponent filed a written argument. An oral hearing was not conducted.

Onus and Material Dates

[8] 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 however 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 Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

[9] The material dates that apply to the grounds of opposition are as follows:

- Section 38(2)(a)/Section 30 - the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Section 38(2)(d)/non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Section 30(b) Ground of Opposition

[10] As noted above, the Opponent pleads that the Applicant did not use the Mark in Canada in association with the applied for services since the claimed date of first use.

[11] An opponent's initial burden under section 30(b) is light [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89] and 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 CPR (3d) (FCTD) 216 at p. 230]. However, while an opponent may rely upon the applicant's evidence to meet its evidential burden in relation to this ground, the opponent must show that the applicant's evidence is clearly inconsistent with the applicant's claims as set forth in its application.

[12] The Opponent's two main arguments under this ground may be summarized as follows:

1. the Applicant's evidence does not show use of CHERRY-PICK as a trade-mark pursuant to section 4(2); and
2. the Applicant has not used Mark in association with the applied for services since the date claimed.

[13] With respect to the Opponent's first argument, the Applicant submits that the Opponent has not filed any evidence in support of this allegation and has therefore not met its evidential burden under this ground. However, as noted, the Opponent may also rely upon the Applicant's evidence to meet its burden. While the Applicant was under no obligation to positively evidence

continuous use of the Mark since its claimed date of first use, the Applicant elected to file evidence. Ms. Cherry states the following in paragraphs 7, 8, 9 and 11 of her affidavit:

7. Immediately after I joined Royal LePage on September 7, 2005, I ordered and received 500 business cards with a cherry theme. The “cherry” theme has been used in all my marketing materials ever since I joined Royal LePage. I use cherrypick@royallegpage.ca as my business e-mail address.

8. My cherrypick@royallegpage.ca e-mail address appears on most of my marketing materials, which include my business card, handouts, brochures and website, www.cherrypickhomes.ca. Attached to this my affidavit and marked as Exhibit D are copies of printouts from various pages of my www.cherrypickhomes.ca website, printed on May 16, 2012.

9. My realtor practice has been growing rapidly and extremely successfully over the years. From my tax return records (T2125 – Statement of Business or Professional Income) for the years 2005 to 2010, my gross income totalled at more than \$1.1 million. . . I am proud to say that the “cherrypick” idea has been working out very well for me and has allowed me to build up my brand.

11. I also spent a sizable portion of my gross revenue to advertise and promote my “cherry” theme over the years. From years 2005-2010, I spent over \$94,000 on marketing the “cherrypick” or “cherrypickhomes” or “pick deb cherry” brand. Attached to this my Affidavit and marked as Exhibit E are photographs of two “bus bench banner” ads employing the “cherrypick” theme.

[14] Section 4(2) of the Act states that a trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services. Upon review of the materials attached to Ms. Cherry’s affidavit, it is clear that a “cherry” theme has been displayed by the Applicant in the advertising of its services. The issue that needs to be decided, however, is whether the Applicant’s evidence is clearly inconsistent with its claim to have used CHERRYPICK as a trade-mark in association with such services pursuant to section 4(2).

[15] I will begin by considering the Applicant’s evidence of use of CHERRYPICK as part of its domain name www.cherrypickhomes.ca. The primary issue with this purported use of the Mark is deviation. In my view, use of www.cherrypickhomes.ca does not constitute use of the Mark CHERRYPICK per se. Although the addition of “www.” and “.ca” may be perceived as minor deviations from the Mark that are being used in order to form the website address, the Mark does not stand out from the word “HOMES” as CHERRYPICKHOMES appears together

as one word in the same type and size of font. In my view, this deviation could mislead an unaware purchaser to think that the mark allegedly being used is actually CHERRYPICKHOMES and not CHERRYPICK [see *Canada (Registrar of Trade Marks) v. Cie Internationale pour l'Informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA)].

[16] The Mark is also displayed, however, on at least some of the Applicant's advertising materials as part of the Applicant's e-mail address "cherrypick@royalpage.ca". The Opponent submits that the purported use of the Mark as incorporated into the Applicant's e-mail address merely functions to direct consumers to the Applicant and does not function as a trade-mark to distinguish the Applicant's services from those of others.

[17] It has previously been held that the display of a mark on a web page can constitute use of a trade-mark [see *Riches, McKenzie & Herbert v Source Telecomputing Corp.*[1992], 46 CPR 3d 563]. However, it is arguable whether the use of a trade-mark as part of an e-mail address may also be use as a trade-mark.

[18] In the present case, Ms. Cherry states that the Applicant's e-mail address appears on most of her marketing materials, which include her business card, handouts, brochures and website. The pages of the Applicant's website attached as Exhibit D display real estate properties for sale, and provide the Applicant's name and contact information at the top of several of the pages. The e-mail address is listed as part of the Applicant's contact information alongside her phone and fax number. It is also listed in the body of one of the website pages under the heading "How to Contact Me."

[19] I am satisfied from the evidence that the Applicant displays the Mark as part of her e-mail address to advertise her real estate services. Although I am not prepared, nor required, to find that the Applicant's evidence clearly shows use of the Mark in association with the applied for services pursuant to section 4(2), I do not find that this evidence is "clearly inconsistent" with the Applicant's claim to have used the Mark CHERRYPICK since November, 2005.

[20] The next issue to be determined under this ground is whether the Applicant has used the Mark in association with the applied for services since November, 2005. Attached as Exhibit G to Mr. Giray's affidavit is a copy of the register page for www.cherrypickhomes.ca from the

Canadian Internet Registration Authority's website. Since the copy of the register page shows that the www.cherrypick.ca website was only registered on October 27, 2006, the Opponent submits that none of the Applicant's materials that appear on its web pages could have been used on the Internet prior to this date. It is therefore the Opponent's position that the Applicant could not have used the Mark in association with "information and Internet services, namely the provision of real estate services information" for the period from November 2005 to October 27, 2006.

[21] I agree with the Opponent that it is not clear how the Applicant could have used its Mark in association with information and Internet services, namely the provision of real estate services information, from November 2005 to October 27, 2006, when its website was only created on October 27, 2006 [see *Littlewoods Ltd v Grabish* (2013), 111 CPR (4th) 438 (TMOB)]. I therefore find that this evidence is sufficient to meet the Opponent's light evidential burden under this ground. As the Applicant has not provided any evidence of use of its Mark in association with these services from the claimed date of first use, this ground succeeds with respect to those services.

[22] The Opponent also submits that the Applicant has failed to submit any examples of advertising for its real estate services for the period from November 2005 to October 27, 2006. However, I note that Ms. Cherry states that she joined Royal LePage as a realtor on September 7, 2005, and immediately ordered and received business cards with a "cherry theme". She further states in the same paragraph that she uses cherrypick@royalpage.ca as her business e-mail address. She also states that she spent \$94,000 on marketing from 2005 to 2010. Although the Applicant may not have submitted any examples of advertising specifically for the period November 2005 to October 27, 2005, I do not find that the Applicant's evidence with regard to these services to be clearly inconsistent with her claimed date of first use. I therefore find that the Opponent has not satisfied its initial evidential burden regarding this ground with respect to these services.

[23] Having regard to the foregoing, the section 30(b) ground succeeds with respect to "information and Internet services, namely the provision of real estate services information via the Internet" but fails with respect to "real estate services".

Distinctiveness Ground of Opposition

[24] The Opponent has also pleaded that the Mark is not distinctive and is not capable of distinguishing the Applicant's services from the services of the Opponents identified by the Opponents' trade-marks CHERRY PICK, CHERRY PICK (Design), CHERRY PICK, WWW.CHERRY PICK.CA, CHERRY PICK WEB MARKETING or its trade-name CHERRY PICK WEB MARKETING INC.

[25] In order to meet its evidential burden with respect to this ground, the Opponent must show that as of the filing of the opposition (i.e. October 5, 2010) one of its CHERRY PICK trade-marks or its trade-name had become known sufficiently to negate the distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD); *Re Andres Wines Ltd and E & J Gallo Winery* (1975), 25 CPR (2d) 126 at 130 (FCA); and *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 412 at 424 (FCA)]. 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; it need not be well known in Canada [see *Bojangles' International, LLC v Bojangles Café Ltd* 2006 FC 657 (CanLII), (2006), 48 CPR (4th) 427 (FCTD)].

[26] The evidence relevant to the Opponent's initial burden can be summarized as follows.

[27] Mr. Giray identifies himself as the owner of Cherry Pick Web Marketing Inc. He explains that his company provides an on-line real estate related listings service for homes for sale, homes for rent, open houses, land for sale, commercial properties, garage sales, vacation properties and cottages for sale primarily using the website www.cherrypick.ca. Attached as Exhibit A to his affidavit is an e-mail dated June 27, 2005, from the Canadian Internet Registration Authority confirming that his cherrypick.ca domain name registration was activated June 27, 2005.

[28] Mr. Giray states at paragraph 8 of his affidavit that between June 2005 and September 2005 the on-line real estate listing service was actively promoted and paid listings solicited.

[29] Attached as Exhibit E to his affidavit is what Mr. Giray states is a copy of a screen shot of the initial website of www.cherrypick.ca dated September 2, 2005, showing an active listing.

Attached as Exhibit F is a copy of the current web pages from the company's website dated June 30, 2011, showing listings of various houses for sale.

[30] On cross-examination, Mr. Giray was asked to define the actual number of listings, paid and unpaid, from 2005 to the present. His answer to undertaking number one shows that there was a total of 2 listings, only 1 of which was paid in 2005. However, between 2006 and 2010, the number of total listings ranged between 15 and 32 and the number of paid listings ranged between 3 and 8.

[31] In his answers to undertakings number four and five, Mr. Giray provided details of marketing efforts and advertising to promote the cherrypick.ca website. This information shows that between 2005 and 2010, less than \$1300 in total was spent on such efforts.

[32] Based on the evidence, I am not satisfied that Opponent has met its initial evidential burden under this ground. In this regard, the mere registration of a domain name does not constitute use of a trade-mark for purposes of section 4 of the Act [see *Sun Media Corporation v The Montreal Sun (Journal Anglophone) Inc*, 2011 TMOB 15 (CanLii)]. Further, any use that has been shown by the Opponent of its mark in the Ottawa area in association with real estate and related services is minimal at best. I therefore do not consider that the use shown or reputation associated with the Opponent's mark is sufficient to negate the distinctiveness of the Mark. This ground is therefore unsuccessful.

Disposition

[33] In view of the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to “information and Internet services, namely the provision of real estate services information via the Internet” but I reject the opposition with respect to “real estate services” pursuant to section 38(8) of the Act [see *Produits Ménagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 482 (FCTD) as authority for a split decision].

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