



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

Citation: 2011 TMOB 222
Date of Decision: 2011-11-14

IN THE MATTER OF AN OPPOSITION
by Bill Ray Guevin to application
No. 1,410,874 for the trade-mark TALL
DARK AND HANDY in the name of Tall
Dark and Handy Handyman Services
Ltd.

[1] On September 16, 2008, Tall Dark and Handy Handyman Services Ltd. (the Applicant) filed an application to register the trade-mark TALL DARK AND HANDY (the Mark). The application is based upon use of the Mark in Canada since 2001 in association with the following services:

Handyman services namely installing electrical fixtures including wall sockets, light switches and lights. Installing plumbing fixtures including sinks, taps and toilets. Installing doors, windows as part of small renovations including small framing jobs. Tile work, drywalling, painting and building cement forms for walkways and driveways are included as part of small renovations.
(collectively the Services)

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of July 29, 2009.

[3] On September 28, 2009, Bill Ray Guevin (the Opponent) filed a statement of opposition. On December 14, 2009, the Applicant filed and served a counter statement and amended its application. The application was amended to rely on use by the Applicant's predecessor-in-title, James Schmidt also doing business as Tall Dark and Handy and Tall Dark and Handy Services.

In order to respond to such amendment, the Opponent obtained leave to amend its statement of opposition.

[4] Affidavits of Bill Guevin and Roger Kuypers were filed in support of the opposition. An affidavit of James Schmidt was filed in support of the application. None of the affiants was cross-examined.

[5] Both parties filed a written argument. An oral hearing was not held.

Section 30(b) Ground of Opposition

[6] The Opponent has pleaded a ground of opposition based on s. 30(b) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act). It can be summarized as follows:

The Applicant and its predecessors in title have not used the Mark in Canada in association with the general category to which the Services relate as of the date of first use claimed in the application, contrary to s. 30(b) of the Act.

[7] The date of first use claimed in the application is 2001, which is interpreted as December 31, 2001.

[8] There is an initial evidential burden on the Opponent respecting the issue of the Applicant's non-compliance with s. 30(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) (F.C.T.D.) 216 at 230]. However, while the 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 [see *Ivy Lea Shirt Co. v. 1227624 Ontario Ltd.* (1999), 2 C.P.R. (4th) 562 at 565-6 (T.M.O.B.), affirmed 11 C.P.R. (4th) 489 (F.C.T.D.)].

[9] Furthermore, s. 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 date of filing 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].

[10] The evidence concerning the Applicant's first use of the Mark is provided by two sources, Mr. Schmidt and Mr. Kuypers.

[11] Mr. Schmidt is the Applicant's President. He informs us that the Applicant was incorporated on November 9, 2007. Although the application to register the Mark was amended to claim James Schmidt as the Applicant's predecessor-in-title, Mr. Schmidt makes no mention in his affidavit of any assignment. Instead, his affidavit refers to Mr. Schmidt's actions, rather than the Applicant's, regardless of whether he is referring to events before or after the incorporation.

[12] I reproduce paragraphs 2-4 and 19 of Mr. Schmidt's affidavit below (these are the paragraphs most relevant to the issue of when use of the Mark began):

2. I adopted the trade-mark TALL DARK AND HANDY when performing small weekend "handyman" jobs in about 2001. Customers responded well to the name so I continued using the name officially as a trade-mark TALL DARK AND HANDY on printed business cards since on or about 2001 to the present in association with "handyman services".
 3. My business started out as a home-based business initially at 96 West 48th Avenue, Vancouver, BC with small jobs here and there. Business grew slowly and simply primarily through word-of-mouth referrals and neighbourhood references. Advertisements showing the trade-mark TALL DARK AND HANDY consisted of business cards and periodic flyers which were posted in and around Vancouver over the years primarily through community centres, community poster boards and the like since 2001 to the present. Samples of actual business cards advertising the TALL DARK AND HANDY trade-mark at successive phone numbers are attached. The business cards were handed to customers at the time of performing the "handyman services".
 4. Exhibit A attached to this affidavit is a sample business card which clearly shows the trade-mark TALL DARK AND HANDY, and which was in use on or about 2001 until on or about 2003 at which time the telephone number was 604-321-5799. As business seemed more viable the business cards changed styles over the years.
- ...
19. Sales have been nominal and growth has fluctuated with the economic cycles and industry changes; however, I have continued to offer and provide my "handyman services" from 2001 to the present in association with the trade-mark TALL

DARK AND HANDY through at least website listings and business card advertisements.

[13] Based on other paragraphs in Mr. Schmidt's affidavit concerning the registration of his website in 2007, I interpret paragraph 19 as not indicating that there were website listings in 2001. I also note that there is nothing further to show that the Applicant or Mr. Schmidt ever performed any services.

[14] I am concerned by Mr. Schmidt's use in the quoted paragraphs of the phrases "in about 2001" and "on or about 2001". The use of such wording suggests that he is not certain whether he began use of the Mark in 2001; if he was certain, then why would he use a phrase that is open to being interpreted as 2001 or 2002?

[15] It is of course not an easy task for an opponent to provide evidence to show that an applicant has not used a mark since a certain date. That is why the burden on an opponent is lighter respecting the issue of non-conformance with s. 30(b) of the Act [see *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.H.O.) at 89]. In the present case, the Opponent has put forth the evidence of its trade-mark agent, Mr. Kuypers, concerning the dialogue that he had with the Applicant and the Applicant's agent after he sent a demand letter to the Applicant on behalf of the Opponent. The Opponent claims use of the identical trade-mark TALL DARK AND HANDY for similar services since at least as early as 2004. Mr. Kuypers attests that the Applicant informed him in or about September 2008 that he could only find data to prove use of the Mark since 2003; despite Mr. Kuypers' requests, no evidence of any use was provided to him. Between September 24 and October 3, 2008, Mr. Kuypers corresponded and spoke with a trade-mark agent who had begun to represent the Applicant; this agent advised Mr. Kuypers that she had requested the Applicant to gather further physical evidence.

[16] Mr. Kuypers also provides evidence that on December 7, 2007, the Applicant filed an application to register the Mark based on proposed use. The Opponent filed an opposition against that application and it was deemed abandoned on February 10, 2010. One can only speculate as to why the Applicant filed an application on December 7, 2007 based on proposed use when Mr. Schmidt is now claiming that use of the Mark continued from 2001 to 2010. It may have been

because the Applicant, not being represented by a trade-mark agent, made a mistake, or it may have been because the Applicant, i.e. the incorporated company, had not yet used the Mark. Whatever the reason, I am not prepared to find that the claim in this abandoned application is itself sufficient to meet the Opponent's initial burden.

[17] However, I do find that the evidence as a whole satisfies the Opponent's initial burden. The evidence raises serious doubts both as to 1) whether the party named as the Applicant used the Mark through a predecessor as early as 2001 and 2) whether the Mark was in continuous use by the Applicant or a predecessor-in-title from 2001 until September 16, 2008.

[18] As the Opponent has met its initial burden, the Applicant was required to demonstrate that it, or its named predecessor, did use the Mark in accordance with s. 4 of the Act as early as December 31, 2001. The Applicant's evidence does not show this to have been the case; nor does its evidence show that there was continuous use from December 31, 2001 to September 16, 2008. Moreover, although the application relies on use by a predecessor, Mr. Schmidt's affidavit makes no reference at all to the assignment of any rights to the corporate Applicant. While Mr. Schmidt has attested that he is an officer, director and President of the Applicant, the fact remains that he and the corporation are two distinct legal entities and any use that he may have made prior to the incorporation of the Applicant cannot be relied upon by the Applicant in the absence of an assignment.

[19] As the Opponent has met its initial burden and the Applicant has not met its legal burden, the s. 30(b) ground succeeds. An applicant ought to be aware that if it is unable to prove a claimed date of first use with documentary evidence, it may be better off claiming a later, provable date, rather than risk having its application refused under s. 30(b).

Section 16 Ground of Opposition

[20] The Opponent has also pleaded a ground of opposition based on s. 16(1) of the Act. The Opponent has pleaded that the Mark is likely to be confused with the trade-mark/trade-name that it has used in Canada since at least as early as 2004 in association with "planning, designing, estimating and completing interior and exterior repairs, remodelling, improvements and renovations for residential housing", namely TALL DARK AND HANDY.

[21] Where an opponent successfully challenges an applicant's claimed date of first use under a s. 30(b) ground of opposition, the material date for assessing a s. 16(1) ground of opposition may become the applicant's filing date [see *American Cyanamid Co. v. Record Chemical Co. Inc.* (1972), 6 C.P.R. (2d) 278 (T.M.O.B.); *Everything for a Dollar Store (Canada) Inc. v. Dollar Plus Bargain Centre Ltd.* (1998), 86 C.P.R. (3d) 269 (T.M.O.B.)].

[22] The Opponent has successfully challenged the Applicant's claimed date of first use under s. 30(b). In addition, there is no evidence of use of the Mark that has been shown to accrue to the benefit of the Applicant. Therefore, it is appropriate to consider the filing date of the application as the date on which to assess the likelihood of confusion under s. 16(1).

[23] In order to meet its initial burden under s. 16(1), the Opponent must show that it did in fact use its mark/name in Canada prior to September 16, 2008 and had not abandoned it when the application was advertised on July 29, 2009 (see s. 16(5)). Mr. Guevin's evidence, which is discussed below, satisfies the Opponent's initial burden.

[24] Mr. Guevin, who identifies himself as the sole proprietor of Tall Dark & Handy, attests that he has been using the trade-name and trade-mark TALL DARK & HANDY since at least as early as 2004 in the greater Vancouver area in association with his home repair, maintenance and renovation business. He provides the following to evidence such claim:

- an advertisement from the August 7, 2004 edition of *The Now Newspaper* advertising his services in association with TALL DARK AND HANDY;
- two invoices dated October 4, 2004 and November 10, 2004 for his services, which display TALL, DARK & HANDY dominantly at the top;
- an invoice dated July 2, 2005 for advertisements offering handyman services to be run in two publications – the invoice indicates that the ad text features TALL DARK AND HANDY;
- three invoices dating from 2005 and 2006 for advertisements offering home renovation services to be run in the *Langley Advance News* – the invoices indicate that the ad text features TALL, DARK & HANDY (a

fourth invoice for an ad to hire an assistant, without reference to TALL DARK AND HANDY, is not relevant); and

- revenue generated by Mr. Guevin in association with TALL DARK & HANDY for the fiscal years 2005, 2006, 2007 and 2008 was approximately \$190,000.

[25] I note that the fact that Mr. Guevin's mark/name sometimes appears as TALL DARK & HANDY or TALL, DARK & HANDY as opposed to TALL DARK AND HANDY is of no consequence. The differences between the versions are so minor that they may all be considered to be one and the same mark/name [see *Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535 and *Registrar of Trade Marks v. Compagnie Internationale Pour L'Informatique CII Honeywell Bull Societe Anonyme et al.* (1985), 4 C.P.R. (3d) 523 (F.C.A.)]. I also note that the Opponent's case is as strong based on its trade-mark as it is based on its trade-name. For ease of convenience, I will refer simply to the Opponent's trade-mark below.

[26] In order to meet its legal burden, the Applicant must satisfy me that there was not a reasonable likelihood of confusion between the Mark and the Opponent's trade-mark as of September 16, 2008.

[27] Section 6 of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both in the same area would be likely to lead to the inference that the associated services are performed by the same person, whether or not the services are of the same general class.

[28] 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. However, the enumerated factors need not be attributed equal weight and case law makes it clear that the most important factor in determining the issue of confusion is the degree of resemblance between the trade-marks [see *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.) at 149, affirmed 60 C.P.R. (2d) 70, and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.)].

[29] In the present case, the parties' marks are identical. In addition, the parties use their marks in association with very similar services. Therefore, one can only conclude that confusion would be likely. The other surrounding circumstances do not detract from such a conclusion.

[30] The s. 16 ground of opposition accordingly succeeds.

Disposition

[31] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

Jill W. Bradbury
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office