



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

Citation: 2014 TMOB 279
Date of Decision: 2014-12-16

**IN THE MATTER OF AN OPPOSITION
by Belron Canada Incorporated to
application No. 1,520,331 for the trade-
mark DECO MASCOT Design in the
name of DECO Windshield Repair Inc.**

Introduction

[1] DECO Windshield Repair Inc. (the Applicant) has applied to register the trade-mark DECO MASCOT design (the Mark), shown below, based upon use in Canada since February 13, 2006, in association with the following services: automotive services, namely windshield repair, dent repair, detailing and cleaning (the Services).



[2] Belron Canada Incorporated (the Opponent) has opposed the application primarily on the basis that the Applicant has not in fact used the Mark since the claimed date of first use. The Opponent also pleads that there is a reasonable likelihood of confusion between this trade-mark and the Opponent's previous use and making known of its registered DURO and DURO-MAN word marks as well as its DURO and Design marks, in association with, among other things, the repair and maintenance of motor vehicles, including automotive glass and windshield repair, maintenance and replacement.

[3] For the reasons that follow, I refuse the application.

Background

[4] On March 22, 2011, the Applicant filed application No. 1,520,331 for the registration of the Mark based on use in association with the Services since February 13, 2006.

[5] The application was advertised on June 13, 2012, and the Opponent filed a statement of opposition on August 10, 2012. The grounds of opposition are that the Applicant's application does not conform to the requirements of sections 30(b) and 30(i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), the Mark is not registrable pursuant to section 12(1)(d), the Applicant is not the person entitled to the Mark pursuant to section 16(1)(a) and the Mark is not distinctive. The last three grounds are based on the likelihood of confusion with the Opponent's prior use and registration of the word marks DURO (TMA 498,064) and DURO-MAN (TMA 382,435) and the following design marks shown below (collectively referred to as the DURO SUPERHERO trade-mark):





[6] The Opponent also relies on its ownership of the “full length figure” of its DURO SUPERHERO trade-mark which the Opponent states has also been extensively used, promoted and advertised in Canada in association with the Opponent’s windshield repair services since at least as early as 2006.

[7] In support of its opposition, the Opponent filed the affidavit of Denis Brossard. As its evidence, the Applicant filed the affidavit of Matthew Horne. Neither affiant was cross-examined.

[8] Both parties filed a written argument.

[9] A hearing was held at which both parties were represented.

Preliminary Issue

[10] On December 3, 2014, about a week after the oral hearing, the Applicant filed a request to amend its application to change the Applicant’s date of first use from February 13, 2006 to June, 2009.

[11] On December 16, 2014, the Applicant’s request was denied. In view that the proposed revised application attempted to change the Applicant’s date of first use from February 13, 2006

to June, 2009, it was considered to be contrary to section 32(b) of the *Trade-mark Regulations*, SOR/96-195.

Onus and Material Dates

[12] 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 [*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)].

[13] 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 [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Section 38(2)(b)/Section 12(1)(d) - the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- Section 38(2)(c)/Section 16(1)(a) – the Applicant’s date of first use;
- Section 38(2)(d)/non-distinctiveness - the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Grounds of Opposition Summarily Dismissed

Non-compliance – Section 30(i)

[14] Section 30(i) of the Act merely requires that an applicant declare in its application that it is satisfied that it is entitled to registration of its trade-mark. Where an applicant has provided the requisite statement, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155].

[15] In the present case, the Opponent submits that the Applicant could not have been satisfied as to its entitlement to use the Mark in Canada because it was aware of the Opponent's rights in the DURO SUPERHERO trade-mark. Mere knowledge of the existence of the Opponent's trade-mark or trade-name does not in and of itself support an allegation that the Applicant could not have been satisfied of its entitlement to use the Mark [*Woot, Inc v WootRestaurants Inc Les Restaurants Woot Inc* 2012 TMOB 197 (CanLII)]. Accordingly, the section 30(i) ground is dismissed.

Analysis of Remaining Grounds of Opposition

Non-compliance - Section 30(b)

[16] As its section 30(b) ground of opposition, the Opponent pleads that the Applicant has not used the Mark since at least as early as February 13, 2006 in association with the services in respect of which use in Canada has been claimed.

[17] The initial evidential burden on an opponent respecting the issue of the applicant's non-compliance with section 30(b) of the Act is light because the facts regarding an applicant's first use are particularly within the knowledge of the applicant [*Tune Masters v Mr P's Mastertune Ignition Services Ltd*, (1986), 10 CPR (3d) 84 (TMHO) at p. 89]. This burden may be met by reference not only to the opponent's evidence but also to the applicant's [*Labatt Brewing Co v Molson Breweries, A Partnership*, (1986), 10 CPR (3d) 84 (TMOB) at 89]. However, while an opponent may rely upon the applicant's evidence to meet its evidential burden in relation to this ground, in order to do so, it must show that the applicant's evidence is "clearly" inconsistent with

the applicant's claims set forth in its application [*Ivy Lea Shirt Co v Muskoka Fine Watercraft & Supply Co*, (1999), 2 CPR (4th) 562 TMOB at 565-6, aff'd 11 CPR (4th) 489 (FCTD)].

[18] Mr. Horne identifies himself as the Founder, Principal and Chief Executive Officer of the Applicant. In his affidavit, Mr. Horne states that the Applicant was founded in or about August, 2005 and Deco Windshield Repair Inc. (Deco) was incorporated on or about February, 2006. Deco's operations consist of student-operated kiosks situated outdoors at retail outlets such as shopping centers, during the spring and summer season. Deco's business consists of repairing windshield cracks or chips rather than the replacing of windshields. Throughout 2005 until the date of his affidavit, Deco kiosks have increased in numbers from 2 in 2005 to over 200 in 2011 and 160 as of the date of his affidavit (i.e. June 12, 2013).

[19] Under the second heading of his affidavit regarding the use and promotion of the Mark, Mr. Horne states the following at paragraphs 7 and 8:

7. On or about March, 2009, the Applicant retained the services of an illustrator/designer, Ben Reynolds, to create a Deco Windshield Repair hero mascot (Deco Man) as well as a villain, Chip McCracken...Attached as Exhibit A to my affidavit is a written letter from Mr. Reynolds outlining his involvement with the Applicant, detailed drawings of Deco Man, e-mail correspondence between the Applicant and Mr. Reynolds and invoices rendered by Mr. Reynolds to the Applicant between April 2, 2009 and October 16, 2012.

8. Beginning in April, 2009, the Applicant retained Kindopp's Digital Printing (Kindopps) to print and produce a Children's Activity Book and several other pieces of Deco promotional material. Attached as Exhibit B to my affidavit are invoices rendered by Kindopp's for the production/print of the Deco Children's Activity Book and other Deco Promotional materials including a Fleet Services Brochure, thank-you cards and envelopes, e-mails between Kindopp's and the Applicant and related sample promotional Deco materials.

[20] Under the fourth heading in his affidavit regarding other promotion and advertising of the Mark, Mr. Horne states the following at paragraphs 33 and 34:

33. Since as early as 2009, Deco Man has been extensively used, promoted and advertised in Canada in association with the Applicant's services.

34. Based upon my review of the records of the Applicant, I have determined that the Applicant has used DECO trade-mark in Canada continuously since at least August 2005 and the Deco Man Superhero since 2009.

[21] Before commenting on the evidence of Mr. Horne, I consider it useful to reproduce the following paragraphs from the Opponent's written submissions at paragraphs 51-53:

51. The Opponent nevertheless bears the initial evidentiary burden of demonstrating that the Applicant's claimed date of first use precedes the actual date of first use. In this regard, the Opponent points to the Applicant's own evidence, which clearly discharges the Opponent's initial burden, and established that the Applicant first used the Mark after February 13, 2006.

52. In particular, paragraph 7 of page 3 of the Horne affidavit clearly established that the applied for trade-mark was "created" by an illustrator "on or about March, 2009", almost three years after the Applicant's claimed date of first use (i.e. February 13, 2006). Attached as Exhibit A to the Horne affidavit is a letter written by the illustrator, explaining that he was "first contacted by Matt Horne in March of 2009" to create the "Deco Winshield [sic] Repair Man" that is the subject of trade-mark application No. 1,520,331. Also, attached as Exhibit A are detailed drawings of the applied for trade-mark, as well as e-mail correspondence between Mr. Horne and the illustrator, from March, 2009, which includes the illustrator's "first e-mail to Matt showing the first pass at the Deco-Man design".

53. The Applicant therefore could not have used the applied for trade-mark in Canada in association with its windshield repair services until March, 2009, at the earliest.

[22] I agree with the Opponent that it has met its evidential burden to put the Applicant's claimed date of first use of the Mark in issue. The Applicant's affiant has clearly admitted that the Applicant did not use the Mark until it was created in 2009. While the Applicant may have shown use of the DECO word mark in Canada since August 2005, the Mark is not the word mark DECO but rather the DECO MASCOT Design. Use of the word DECO by itself is not sufficient to show use of DECO MASCOT and Design.

[23] The second ground of opposition is therefore successful.

Remaining Grounds of Opposition

[24] I would also add that the remaining grounds of opposition turn on a determination of the issue of the likelihood of confusion between the Mark and the Opponent's marks. In this regard it is unlikely that the Opponent would have succeeded on any of these grounds because of the lack of resemblance between the parties' marks. As noted in *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 92 CPR (4th) 361 (SCC), the degree of resemblance between the trade-marks is often the most crucial factor in determining the issue of confusion. While the Opponent has been using its marks for a longer period of time, and while the parties' services are almost identical, the Supreme Court of Canada has found that these factors play a subservient role in the overall surrounding circumstances that are considered when determining the issue of confusion when there is little resemblance between the parties' marks.

Disposition

[25] In view of the above, and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Cindy R. Folz
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office