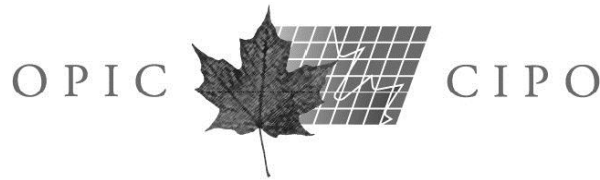


# TRADUCTION/TRANSLATION



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

**Citation: 2011 TMOB 38**  
**Date of Decision: 2011-03-01**

**IN THE MATTER OF AN OPPOSITION  
by Informatique GT 2000 Inc. to  
application No. 1259175 for the trade-  
mark PAC in the name of LesPAC s.e.n.c.**

## The Pleadings

[1] 4280407 Canada Inc. filed an application to register the trade-mark PAC (the Mark) on May 27, 2005. An examination report dated November 15, 2005, raised a number of objections. The application was amended on two occasions. The applicant is currently identified as being LesPAC s.e.n.c. (the Applicant).

[2] The amended application covers the following wares and services:

(1) Printed publications advertising products or services for sale by others, namely books, magazines, brochures, collections, periodicals, newspapers, journals, catalogues and inserts (the Wares).

(1) Promoting and distributing the products and services of others by placing advertisements and promotional matter on an Internet site; providing access to a directory of advertisements for products and services offered or for sale via the Internet; publishing and distributing virtual publications, namely advertisements.

(2) Chat forum within an Internet site accessible through a global computer network.

(3) Online gaming and entertainment services; organizing contests for advertising purposes for others; organizing and distributing contests and

opinion polls targeting consumers via an Internet site; operating an Internet site offering virtual cards, planners, calendars and address books; radio programming broadcast over the Internet; online information services concerning current events, sports, automobiles, finance, horoscopes, culture, arts and shows, the weather, information technology; editing, printing, distributing and selling printed publications advertising products or services for sale by others, namely books, magazines, brochures, collections, periodicals, newspapers, journals, catalogues and inserts (collectively referred to as the Services).

[3] The application is based on proposed use for the Wares and for the services listed under (3); on use since at least as early as November 14, 1996, in association with the services listed under (1) and since at least as early as December 31, 2004, in association with the services listed under (2).

[4] The application was advertised for opposition purposes on February 27, 2008, in the *Trade-marks Journal*. On April 24, 2008, Informatique GT 200 Inc. (the Opponent) filed a statement of opposition, which the Registrar forwarded to the Applicant on May 27, 2008. On July 28, 2008, the Applicant filed a counter statement essentially denying all of the grounds of opposition described below.

[5] The Opponent submitted a statement under section 41 of the *Trade-Marks Regulations*, SOR/2007-91, informing the Registrar that it did not intend to submit evidence. The Applicant submitted the affidavits of Suzanne Moquin, Jean Lamontagne, Jean-François Ménard, Claude Timmons and Jocelyne Genest. The Opponent filed no reply evidence. Only the Applicant filed a written argument. Neither of the parties requested a hearing.

#### The Grounds of Opposition

[6] The grounds of opposition pleaded are as follows:

1. The application for registration does not comply with the requirements of section 30(i) of the *Trade-Marks Act*, R.S.C., 1985, c. T-13 (Act), in that the Applicant could not state that it was satisfied that it was entitled to use the Mark since it knew or ought to have known at the time of the application for registration of the

registered trade-marks identified in Schedule A to the statement of opposition with which the Mark is confusing. The Applicant could therefore not be satisfied of its right to use the Mark in Canada in association with the Wares and Services;

2. The application for registration does not satisfy the requirements of section 30(b) of the Act in that the Applicant has not used the Mark in Canada as a trade-mark since the dates of first use claimed in the application for registration;
3. The Mark is not registrable having regard to the provisions of section 12(1)(b) of the Act in that the Mark, which is an acronym for “petites annonces classées” and which is used as such by the Applicant, clearly describes in a depicted, written and sounded manner the character or quality of the wares or services, in particular, the advertisements, in association with which the Mark is used or in connection with which the Applicant is proposing to use the Mark;
4. The Mark is not registrable having regard to the provisions of section 12(1)(c) of the Act in that the Mark is the French name of one of the Wares or Services, specifically the advertisements, in association with which the Mark has been used by the Applicant, or in connection with which the Applicant proposes to use the Mark;
5. The Mark is not registrable having regard to the provisions of section 12(1)(e) of the Act in that the registration of the Mark is prohibited under section 10 of the Act, since the “petites annonces classées” to which the Mark refers and the Mark as such as an acronym describing “petites annonces classées” have by ordinary and *bona fide* commercial usage become recognized as designating the kind of wares and services, namely, the advertisements, in association with which the Mark is used by the Applicant or in association which the Applicant proposes to use the Mark;
6. The Mark is not registrable having regard to the provisions of section 12(1)(d) of the Act in that the Mark is confusing with the registered trade-marks described in Schedule A to the statement of opposition;
7. The Mark is not and cannot be distinctive of the Wares and Services within the meaning of section 2 of the Act in that, as of the date of the statement of opposition, the Mark was not and is not adapted to distinguish and does not actually distinguish the Applicant’s Wares and Services from the wares and services in association with which the registered trade-marks in Schedule A to the statement of opposition are used.

## Onus

[7] In proceedings to oppose the registration of a trade-mark, the Opponent must present enough evidence concerning the grounds of opposition raised to show that there are facts supporting those grounds. If the Opponent meets this requirement, the Applicant must persuade the Registrar that the grounds of opposition raised, on a balance of probabilities, should not prevent registration of the mark [see *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].

## Grounds of Opposition Summarily Dismissed

[8] The first ground of opposition is not a ground of opposition per se. Section 30(i) of the Act does not require the Applicant to state that it is satisfied that it is entitled to register the Mark. This statement appears in the application for registration. The allegation that there is a likelihood of confusion with the registered marks is covered in the statement of opposition under the sixth and seventh grounds of opposition. Section 30(i) of the Act may be raised in cases where there is bad faith on the part of the Applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152]. This was not alleged in the Opponent's statement of opposition. The first ground of opposition is therefore dismissed.

[9] As mentioned above, the Opponent has filed no evidence. It has therefore not discharged its initial burden of proof regarding the third, fourth, fifth and seventh grounds of opposition. Therefore those grounds of opposition are dismissed.

[10] As to the second ground of opposition, it is recognized that the Opponent can meet its initial burden of proof by relying on the evidence filed by the Applicant. However, nothing in the Applicant's evidence can support such a ground of opposition. The second ground of opposition is also dismissed since the Opponent failed to discharge its initial burden of proof.

[11] I would like to point out that despite the Opponent's failure to meet its initial burden of proof, the Applicant submitted, among other things, an affidavit dealing with the descriptiveness of the Mark. Claude Timmons, a lecturer in linguistics at the Université du Québec à Montréal and a project leader in linguistics at the Université de Montréal, is of the view that, based on his research, the word PAC is not recognized in French or English as a word with a particular meaning in the field of classified advertising or as the acronym for "petites annonces classées" as alleged by the Opponent in its statement of opposition.

Ground of Opposition under Section 12(1)(d)

[12] The ground of opposition based on paragraph 12(1)(d) of the Act presupposes the existence of a registered mark on the filing date of the statement of opposition. In this file, the Opponent failed to submit any evidence proving the existence of the registered trade-marks listed in Schedule A to its statement of opposition. I am fully aware of the state of the case law which instructs that the Registrar may (emphasis added) exercise his or her discretion to verify the state of the Register [see *Quaker Oats Co. of Canada/La Cie Quaker Oats du Canada v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)].

[13] However, the circumstances of this case do not justify my exercising my discretion to verify each and every trade-mark listed by the Opponent, for the following reasons. First, the Opponent is not alleging that it owns the trade-marks listed in Schedule A to its statement of opposition. Second, Schedule A does not contain only one or only a few registered trade-marks, as is usually the case when the Registrar exercises his or her discretion, but 23 registered trade-marks, some of which, at face value, bear no relevance. As examples, I mention the following marks: PALM, PAXPRO, ACCPAC ETRANSACT, PACIFIC CENTURY CYBERWORKS, PAC-MAN COLLECTION.

[14] Third, the Opponent did not file a written argument to explain how each of the registered marks is relevant to this matter. Last, the Opponent did not request a hearing where it could have explained the relevance of each of the marks to the Registrar.

[15] I will therefore limit my verification of the state of the Register to the mark referred to by the Opponent that seems the most relevant in my view, namely PUBLIPAC, registration number TMA626363. I verified whether this registered mark still appeared in the Register, and I confirm that this is the case. The certificate of registration covers on-line job posting services, on behalf of others, on specialized employment sites on the Internet; establishment and maintenance of a network of posting and job search sites on the Internet.

[16] The risk of confusion between two trade-marks must be analyzed on the basis of the specific circumstances in each case. These circumstances are described at section 6(5) of the Act. The Honourable Mr. Justice Binnie, writing on behalf of the Supreme Court of Canada, ruled on the scope of this section in *Mattel Inc. v. 3894207 Canada Inc.*, (2006) 49 C.P.R. (4th) 321, stating the following:

Within the “all the surrounding circumstances” test, s. 6(5) of the Act lists five factors to be considered when making a determination as to whether or not a trade-mark is confusing. These are: “(a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; (b) the length of time the trade-marks or trade-names have been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them”. The list of circumstances is not exhaustive and different circumstances will be given different weight in a context-specific assessment. See *Gainers Inc. v. Marchildon* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.).

[17] I will briefly analyze the various relevant criteria as neither of the parties have made submissions in this regard. In fact, the Applicant argued that the Opponent had not discharged its initial burden of demonstrating the existence of these marks. It therefore argued that the ground of opposition should be dismissed outright.

[18] The Mark possesses little inherent distinctiveness. As mentioned previously, Mr. Timmons stated in his affidavit that his research led him to conclude that PAC was not a term that referred to the field of classified advertising or to “petites annonces classées”. However, Mr. Simmons told us that the Web site Acronym Finder provided 397 references for the word PAC, all English expressions, such as “Pan-African

Congress”, “Parent Action Committee” and “Private Access Code”. Moreover, his research on the Web revealed that the word PAC also exists as a French acronym. He provided the following examples: “pratique administrative du commercial”, “pile à combustible”, “pompe à chaleur”, “parti action canadienne” and “programme d’action communautaire”. As for the mark PUBLIPAC, this was a coined word.

[19] A trade-mark’s distinctiveness may be enhanced by its use and its reputation. There is of course no evidence of use of the mark PUBLIPAC on file. Before me, however, is voluminous and exhaustive evidence of use of the Mark. I refer in particular to the affidavit of Suzanne Moquin, the Applicant’s president.

[20] Ms. Moquin stated that the Mark had been used by the predecessors-in-title to the Applicant and by the Applicant in association with the services listed under (1) since November 14, 1996. The Applicant offers the services listed under (1) on its Web site on which the Mark is featured. The Web site has over 1,600,000 members, lists over 370,000 active classified ads, to which over 30,000 new ads are added every week. The site has over 2 million visitors a month, and over 7 million pages are visited a day. She states that it has been Quebec’s busiest classifieds site since it was created. She provided the sums of money spent annually on promotion and advertising since April 2003. For example, in 2008, \$620,000 was spent.

[21] Ms. Moquin provided a list of Internet guides and directories from Quebec in which the Mark appears. She also listed the prizes the Applicant has won for the quality of its Web site. She submitted copies of newspaper and magazine articles published since 2005 mentioning the Applicant’s Web site.

[22] For the purposes of this decision, it is not necessary to describe in detail the voluminous evidence of use of the Mark. I will refer to paragraphs 30 to 56 and exhibits SM-12 to SM-38 inclusively. Among other things, the Mark appears on e-mails sent to users of the Applicant’s Web sites, on advertisements that have appeared on the home page of the Sympatico MSN Web site and on that of the RDS network; in advertisements broadcast by radio stations across Quebec; in advertisements broadcast on television, on roadside billboards and at sponsored events.

[23] I conclude from that evidence that the Mark is known in Quebec in association with the services listed under (1).

[24] As regards the duration of use of the trade-marks, this factor also favours the Applicant. As to the nature of the wares and services and the nature of the trades, they are different. First, registration certificate TMA626363 covers specialized online services for jobseekers while the Wares and Services are quite different. The Wares include printed publications advertising products or services of all kinds. The services listed under (2) and (3) are different from the specialized services described in the registration certificate in question. The services listed under (1) could overlap with those specialized services in that they might include them.

[25] As for the degree of resemblance, although the Mark is contained in PUBLIPAC, the marks have to be considered as a whole. Moreover, the first portion of a trade-mark is generally the most relevant for the purposes of distinguishing the marks in question [see *Pernod Ricard v. Molson Breweries* (1992), 44 C.P.R. (3d) 359 (F.C.T.D.)]. The first portion of the mark PUBLIPAC is distinguishable from the Mark.

[26] In the circumstances, I conclude that the Applicant has discharged its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the trade-mark PUBLIPAC.

[27] As I find that the Opponent had its best chance of succeeding by raising the likelihood of confusion with the trade-mark PUBLIPAC and that it did not succeed, I conclude that the Opponent cannot win by comparing the Mark to any of the other registered marks listed in Schedule A to its statement of opposition.

[28] I therefore dismiss the sixth ground of opposition.



Conclusion

[29] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition under section 38(8) of the Act.

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Jean Carrière  
Member  
Opposition Board  
Canadian Intellectual Property Office

Certified true translation  
Johanna Kratz