

**IN THE MATTER OF OPPOSITIONS by
Alpa Wood Mouldings Inc. and Central
Lumber Limited to applications Nos.
1134448 and 1134460 for the trade-marks
CLASSIQUE SERRANA and
CLASSIQUE RODIA filed by Craftmaster
Manufacturing Inc.**

On March 15, 2002, Craftmaster Manufacturing Inc. (the “Applicant”) filed applications to register the trade-marks CLASSIQUE SERRANA and CLASSIQUE RODIA (the “Marks”) based upon proposed use of the Marks in Canada in association with “Construction and building materials, namely doors, door skins, door frames and door facings; fiberboard, composite board and particle board” (the “Wares”).

The applications were advertised for opposition purposes in the Trade-marks Journal of December 10, 2003.

On February 10, 2004, Alpa Wood Mouldings Inc. (the “Opponent”) requested extensions of time for filing a statement of opposition against each of the applications for the CLASSIQUE SERRANA and CLASSIQUE RODIA Marks. The statements of opposition against each of the applications were later filed on April 27, 2004 by Alpa Wood Mouldings Inc. and its related company and licensee Central Lumber Limited. The grounds of opposition in each statement are as follows:

1. The Marks are not registrable pursuant to s.12(1)(d) of the *Trade-marks Act*, R.C.S. 1985, c.T-13 (the “Act”) in that they are confusing with the trade-mark CLASSIC registered in Canada by the Opponent under No. 321504 in association with “doors”;
2. The Applicant is not the person entitled to registration of the Marks pursuant to s.16(3)(a) of the Act since, as their date of filing, the Marks were confusing with the CLASSIC trade-mark which had been previously used and made known in Canada by the Opponent and its predecessors-in-title, in association with doors, and which had not been abandoned by the Opponent as at advertisement of the Marks;

3. The Marks are not distinctive of the Applicant within the meaning of s.2 of the Act as they do not distinguish and are not adapted to distinguish the Wares of the Applicant from the wares of the Opponent, because of the prior use and making known of the CLASSIC trade-mark in association with doors, by the Opponent and its predecessors-in-title;
4. The applications for the Marks do not comply with s.30(i) of the Act in that the Applicant could not have been satisfied of its entitlement to use the Marks in Canada, in that the Applicant was aware of the CLASSIC trade-mark of the Opponent and initiated unsuccessful s.45 cancellation proceedings against the registration for the said mark referred to above.

The Applicant filed and served counter statements in which it denied all grounds of opposition.

The Opponent's evidence in each case consists of the affidavit of Mark Di Poce and a certified copy of application No. 1072970 for the trade-mark CLASSIQUE. The Applicant's evidence in each case consists of the affidavits of Julien Brazeau and Lisa Parliament. No cross-examinations were conducted.

Only the Opponent filed a written argument. Neither party requested an oral hearing.

Summary of Opponent's Evidence

Mark Di Poce identifies himself as the Manager of the Central Fairbank Lumber division of Central Lumber Limited ("his Company"). His Company has been in business since 1912, and is a major supplier of lumber, plywood, doors and mouldings to builders, contractors, renovators, and the retail public. Mr. Di Poce states that his Company is a related corporation to the Opponent. The Opponent is in the business of supplying and installing doors and mouldings to the new home construction market.

Mr. Di Poce states that the Opponent acquired the CLASSIC trade-mark on October 24, 1995, from the receivers for the original registrant, Oakwood Lumber & Millwork Co. Limited. His Company has been licensed by the Opponent to use the CLASSIC trade-mark in Canada, in association with doors, since the Opponent's acquisition of the mark. Mr. Di Poce states that the Opponent retains direct control of the character and quality of the doors manufactured and sold by his Company under the CLASSIC trade-mark, and that the Opponent routinely exercised that control by inspecting his Company's premises and the quality of the CLASSIC brand doors manufactured and sold by his Company. Attached as Exhibit "A" to his affidavit is a copy of a license agreement between the Opponent and his Company confirming the details of this license.

The CLASSIC doors are manufactured and sold with a number of different profiles that are identified as CLASSIC I, CLASSIC II, and so on. Since they are intended for use in consumers' homes, they are not stamped or embossed with the CLASSIC trade-mark. Instead, Mr. Di Poce explains that the doors have been installed in his Company's showrooms, where they are displayed with a sign that bears the CLASSIC trade-mark and model number, the whole as shown on copies of photographs produced as Exhibit "B" to his affidavit. Purchasers wishing to buy doors from his Company indicate their choice by identifying the desired brand and model number. The doors have been displayed and sold in this manner by his Company since shortly after the Opponent acquired the CLASSIC trade-mark in October of 1995. Mr. Di Poce further states that the doors continue to be so displayed and sold.

Mr. Di Poce states that in each of the past five years from 1999 to 2003, his Company has sold approximately 200 CLASSIC brand doors. Attached as Exhibit "C" to his affidavit are sample copies of invoices evidencing sales of the CLASSIC doors by his Company during that period of time. The invoices accompanying the doors refer to them as CLASSIC doors, or use the abbreviations CLS or CLSC.

Mr. Di Poce further explains that since the CLASSIC trade-mark was acquired by the Opponent out of receivership, the Opponent has little evidence of use of the mark prior to October 1995. He nevertheless encloses as Exhibit "D" to his affidavit, a price list from the Opponent's predecessor-in-title, dated 3 January 1995. This price list relates to the CLASSIC doors and was

located in the Opponent's business records.

Mr. Di Poce also produces as Exhibit "E" to his affidavit, a copy of a Certificate of Authenticity from the Canadian Trade-marks Office entitled "*(...) extracts from file No. 557,281 relating to an application for registration of the trade-mark "CLASSIC", which issued to registration under No. 321,504 on the 5th day of December, 1986: Letter from Sim & McBurney dated June 14, 1993 and attachments thereto*". This extracts includes an affidavit by one Wayne Vaters, which is dated June 11, 1993. In the affidavit, Mr. Vaters identifies himself as the Credit Manager for the Opponent's predecessor-in-title, Oakwood Lumber Millwork Co. Ltd. This affidavit was filed on behalf of the said predecessor in defending against s.45 cancellation proceedings initiated on December 15, 1992, against the CLASSIC trade-mark registration. Mr. Vaters states that the CLASSIC trade-mark was used continuously from at least October 1985 to the date of his affidavit. Such use is evidenced with product catalogues, labels, invoices, and promotional material from, variously, 1990, 1991, 1992, and 1993.

The Opponent also filed a certified copy of the Applicant's related co-pending application No. 1072970 for the trade-mark CLASSIQUE.

I will address the question of relevancy and admissibility of the Opponent's evidence later on in my decision.

Summary of Applicant's Evidence

Julien Brazeau identifies himself as a summer law student at the law firm representing the Applicant in the present opposition proceedings.

Mr. Brazeau states that he conducted searches of the online trade-marks office database using the search terms SERRANA and RODIA in the search field "TM lookup" and that the only marks that appeared were the Applicant's applications being the subject of the present opposition proceedings.

Lisa Parliament identifies herself as an associate at the same law firm. In paragraph 2 of her affidavit, Ms. Parliament reports the following:

“I am advised by Julie Beeton, another associate at McMillan Binch Mendelsohn LLP, who is presently out of the country, that on Monday, June 16, 2003 she personally attended Central Fairbank Lumber’s locations at 2296 Gerrard St. E. and 1900 Steeles Ave. W. to observe certain products on display. I am further advised by Ms. Beeton that:

- (a) At the Gerrard St. location, there were approximately 10 doors on display and Ms. Beeton verified with an employee that these were the only display models. None of the display models were labelled as “Classic”.*
- (b) (...)*
- (c) Included in the display was the “Classique” door manufactured by Premdor and designed by Craftmaster.*
- (d) At the Steeles Ave. location there were two display areas. The main display area had approximately 20 doors on display. The “CLASSIC II” door was labelled and prominently displayed at the front of the display area.*
- (e) Included in the other doors on display was the “CLASSIQUE” door manufactured by Premdor and designed by Craftmaster”.*
- (f) The other display area had approximately 25 doors and 3 doors were prominently displayed on the wall. Beside each of the 3 doors was a sign indicating that the door was available in “Colonial” and “Classique”.*
- (g) (...).”*

Ms. Parliament attaches as Exhibit “A” to her affidavit copies of *“the advertising and promotional literature relating to doors manufactured by Premidor [sic], Royal Door Ltd. and Madawaska Doors Inc. that Ms. Beeton obtained.”*

As for the Opponent’s evidence, I will address the question of relevancy and admissibility of the Applicant’s evidence later on in my decision.

Onus and relevant dates

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its applications comply 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 C.P.R. (3d) 293 (F.C.T.D.); *Dion Neckwear Ltd. v. Christian Dior,*

S.A. et al. (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

The relevant dates for appreciating the circumstances in regard to each of the grounds of opposition in this case are the following:

- Ground based on s.12(1)(d) of the Act: the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- Ground based on s.16(3)(a) of the Act: the filing date of the applications;
- Ground based on non-distinctiveness of the Marks: generally accepted as being the filing date of the statements of opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)];
- Ground based on s.30(i) of the Act: the filing date of the applications [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)].

I will now analyze these grounds of opposition in turn in regard to the evidence filed in record.

Section 12(1)(d) ground of opposition

The Opponent has not filed a certified copy of registration No. 321504 for the CLASSIC trade-mark. In its written argument, the Opponent has asked that I exercise my discretion to review the Register and confirm the details of that registration, which I did. Accordingly, the Opponent has satisfied its initial evidential burden in regard to this first ground of opposition.

Because of this evidence by the Opponent, the Applicant must establish on a balance of probabilities that there is no risk of confusion between the Marks and the Opponent's 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 listed at s. 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time the trade-marks 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 in appearance or sound or in the ideas suggested by them. This list is not exhaustive and different weight will be attributed to different factors according to the context [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (C.S.C.); and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée and al* (2006), 49 C.P.R. (4th) 401, [2006] 1 S.C.R. 824 (C.S.C.) for a thorough discussion of the general principles that govern the test for confusion].

(a) the inherent distinctiveness of the trade-marks and the extent to which they have become known

As argued by the Opponent in its written argument, the CLASSIC and CLASSIQUE components of the marks under review have some measure of inherent distinctiveness, but are somewhat suggestive of products that are of a traditional nature, or are accepted models of their kind.

The Marks contain the additional elements SERRANA and RODIA, which elements do not appear to have any meaning in English or French, and are therefore somewhat more inherently distinct than the Opponent's mark. Presumably, the Brazeau affidavit was meant to support a finding of inherent distinctiveness of such elements.

The strength of a trade-mark may be increased by means of it becoming known through promotion or use.

The subject applications are based on proposed use. In addition, the Applicant did not file reliable evidence of subsequent use or promotion of the Marks CLASSIC SERRANA and CLASSIC RODIA in Canada. The only evidence filed in this respect consists of the Parliament affidavit, which

contains vague statements of use of “*the CLASSIQUE door manufactured by Premdor and designed by Craftmaster*”, presumably the Applicant, and which more importantly does not satisfy the criteria of necessity and reliability for overcoming hearsay [see *Labatt Brewing Co. v. Molson Breweries, A Partnership*, (1996) 68 C.P.R. (3d) 216 (F.C.T.D.)].

Indeed, as quoted above, Ms. Parliament did not attend at the Opponent’s licensee’s places of business. She instead relates what she was told by Ms. Beeton, about what Ms. Beeton saw when she attended the licensee’s places of business. As stressed by the Opponent in its written argument, the Applicant had seven months to prepare its Rule 42 evidence, and there is absolutely no necessity for it to rely upon the second hand report of a conversation one attorney (Ms.Parliament) had with another attorney (Ms. Beeton), about a visit the latter made to two places of business located in the same city as the attorneys and the Applicant’s agent. The information is also unreliable as Ms. Beeton was never sworn, and one has no way of knowing how Ms. Beeton arrived at the conclusions reported by Ms. Parliament, or how and in what manner Ms. Beeton obtained the documents included as Exhibit “A” to Ms. Parliament’s affidavit.

For the reasons outlined above, I rule as inadmissible the Parliament affidavit.

Turning to the Opponent’s mark, the Opponent contends that the CLASSIC trade-mark has been registered and used on doors by the Opponent and its predecessors for more than twenty years - since at least as early as October 1985 – and therefore well before any of the material dates for determining confusion in this case.

The Di Poce affidavit attests to fact that the Opponent has been, through its licensee, using the CLASSIC trade-mark on doors since shortly after the Opponent acquired the CLASSIC trade-mark in October of 1995. As outlined above, such use is evidenced with a copy of the licence agreement as well as copies of photographs and invoices dated from, variously, 1999 to 2003.

The Opponent has also introduced into evidence use of the CLASSIC trade-mark by its predecessor. As outlined above, the Di Poce affidavit introduces into evidence a price list dated January 3, 1995, which was used by the said predecessor as well as a certified copy of an affidavit sworn by one

Wayne Vaters, which is dated June 11, 1993 and was filed on behalf of the said predecessor in defending against s.45 cancellation proceedings brought against the CLASSIC trade-mark registration. As admitted by the Opponent, this prior affidavit is hearsay as regards Mr. Di Poce. However, the Opponent submits that it satisfies the criteria of necessity and reliability for overcoming hearsay.

The Opponent argues in its written argument that it is necessary for it to rely on the Vaters affidavit for evidence of its predecessor's use of the CLASSIC trade-mark, because the Opponent acquired the CLASSIC trade-mark and registration out of the receivership of its predecessor. That predecessor is now defunct, and the Opponent has no way of contacting that company or its former employees. The Opponent further argues that the evidence is reliable since it has been filed by way of a certified copy of the records of the Trade-marks Office, and the affidavit is properly sworn for use as evidence before the latter.

I am reluctant to conclude that this prior affidavit satisfies the criteria of necessity and reliability for overcoming hearsay. There is no evidence that the Opponent tried to locate the original affiant. The Di Poce affidavit does not convince me that it was necessary for the Opponent to take the approach that it did.

In any event, regardless of my finding regarding the inadmissibility of the Vaters affidavit, I am satisfied that the Opponent has evidenced use of its CLASSIC mark since at least as early as 1995. Based on the foregoing, I conclude that the Opponent's mark has become known to some extent in Canada. Since the Applicant has not provided any evidence of use of its CLASSIC SERRANA trade-mark as well as of its CLASSIC RODIA trade-mark, the overall consideration of the factor set forth in s.6(5)(a) favours the Opponent.

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

For the reasons given above, this factor also favours the Opponent.

(c) the nature of the wares, services or business; and (d) the nature of the trade

Considering the type of wares and the nature of the trade, I must compare the Applicant's statement of wares with the statement of wares in the registration referred to by the Opponent [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.); *Procter & Gamble Inc. v. Hunter Packaging Ltd.* (1999), 2 C.P.R. (4th) 266 (T.M.O.B.); *American Optional Corp. v. Alcon Pharmaceuticals Ltd.* (2000), 5 C.P.R. (4th) 110 (T.M.O.B.)].

The trade-marks under review cover the identical wares "doors". The opposed applications also covers wares closely related to doors, namely, "door skins, door frames and door facings", and "fiberboard, composite board and particle board", from which materials the Opponent contends doors can be manufactured. I agree. The fact that doors can be made from "fiberboard, composite board and particle board", and the fact that the Applicant intends making doors from such materials, is supported by the Applicant's related co-pending application No. 1072970 for the trade-mark CLASSIQUE. The wares covered by this application are described as "*Molded doors and door facings made from various substrate materials including hardboard, particleboard, fiberboard and composite board for use in the manufacture of doors intended for interior use.*"

The Di Poce affidavit evidences the manner in which the Opponent's CLASSIC doors are sold and displayed in its licensee's business premises. Mr. Di Poce also states that his Company is a major supplier of lumber, plywood, doors and mouldings to builders, contractors, renovators, and the retail public. It is fair to assume that the Applicant's Wares and those of the Opponent could travel through the same channels of trade. These third and fourth factors thus favour the Opponent.

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

As discussed above, the test for confusion is a matter of first impression. As stated by Mr. Justice Deneault in *Pernod Ricard v. Molson Breweries* (1992), 44 C.P.R. (3d) 359 (F.C.T.D.), at 369, the first portion of a trade-mark is the most relevant for purposes of distinction:

“The test of confusion is one of first impression. The trade marks should be examined from the point of view of the average consumer having a general and not a precise recollection of the earlier mark. Consequently, the marks should not be dissected or subjected to a microscopic analysis with a view to assessing their similarities and differences. Rather, they should be looked at in their totality and assessed for their effect on the average consumer as a whole: *Ultravite Laboratories Ltd. v. Whitehall Laboratories Ltd.* (1965), 44 C.P.R. 189 at pp. 191-2, 53 D.L.R. (2d) 1, [1965] S.C.R. 734; *Oshawa Group Ltd. v. Creative Resources Co.* (1982), 61 C.P.R. (2d) 29 at p. 35, 46 N.R. 426 sub nom. *Oshawa Group Ltd. v. Registrar of Trade Marks* (F.C.A.); *Cantine Torresella S.r.l. v. Carbo* (1987), 16 C.P.R. (3d) 137 at p. 146, 14 C.I.P.R. 234 (F.C.T.D.).

Although the marks are not to be dissected when determining matters of confusion, it has been held that the first portion of a trade mark is the most relevant for purposes of distinction: *Molson Companies Ltd. v. John Labatt Ltd.* (1990), 28 C.P.R. (3d) 457 at p. 461, 32 F.T.R. 152, 19 A.C.W.S. (3d) 1369 (F.C.T.D.); *Conde Nast Publications Inc. v. Union Des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) at p. 188. I believe the following words of President Thorson in the case of *British Drug Houses Ltd. v. Battle Pharmaceuticals* (1944), 4 C.P.R. 48 at pp. 57-8, [1944] 4 D.L.R. 577, [1944] Ex.C.R. 239 (Ex. Ct.), to be particularly useful in explaining why attention should be drawn to the first portion of the appellant’s mark in this case:

... the Court should rather seek to put itself in the position of a person who has only a general and not a precise recollection of the earlier mark and then sees the later mark by itself; if such a person would be likely to think that the goods on which the later mark appears are put out by the same people as the goods sold under the mark of which he has only such a recollection, the Court may properly conclude that the marks are similar.”

The Marks consist of two words, the first of which is the French word CLASSIQUE, whereas the Opponent’s mark consists of the single English word CLASSIC.

As ruled by the Federal Court of Appeal in *Pierre Fabre Médicament v. SmithKline Beecham Corp.*, (2001) 11 C.P.R. (4th) 1, where French and English language marks are in question, the perception of the Francophone consumers warrants just as much attention as that of the Anglophone consumers, and confusion will be found if either of them is likely to find the marks confusing. Regard will also be had to how a bilingual consumer would perceive the marks, in circumstances where a monolingual French-speaking or English-speaking consumer might not be confused.

I consider there to be a fairly high degree of resemblance between the marks of the parties. The first portion of each of them is almost identical. Indeed, the meaning of the words CLASSIQUE and CLASSIC is the same, since they are direct translations of one another, and their pronunciation does not differ significantly, especially when both are voiced by a monolingual French or English speaker.

As mentioned earlier in the assessment of the inherent distinctiveness of the marks under review, the addition of the elements SERRANA and RODIA to the Marks enhances the distinctiveness of the Marks. However, I do not consider such additions sufficient in the circumstances, to distinguish the Marks from the Opponent's mark.

It is worth reproducing below the remarks made by Mr. Justice Cattanach in *Conde Nast Publications Inc. v. Union des Éditions Modernes*, (1976) 46 C.P.R. (2d) 183 (F.C.T.D.):

"In *J. B. Stone & Co., Ltd. v. Steelace Mfg. Co. Ltd.* (1929), 46 R.P.C. 406, Lawrence, L.J., said at p. 418 that it was no answer for a person to say:

Oh, yes, we use the whole of your trade mark, but we are using it in such a way as we consider will not cause deception or interfere with your trade.

He continued to say:

In my opinion such an answer affords no defence to an action by a registered owner of a trade mark whose mark is being used by a rival trader upon or in connection with the goods of the latter for whatever purpose it may be so used.

This, in my view, is precisely what the respondent has done. It has appropriated the appellant's mark in its entirety and added thereto as a suffix the words "age tendre". It is axiomatic that the first word or the first syllable in a trade mark is far the more important for the purpose of distinction. Here the first and most important word in the mark which the respondent seeks to register is identical to the mark registered by the appellant.

If there is doubt whether the registration of a trade mark would cause confusion with a prior mark the doubt must be resolved against the newcomer. In this instance the result is that the doubt must be resolved in favour of the appellant."

The Di Poce affidavit evidences that the Opponent sells different profile doors under its CLASSIC trade-mark. These profiles have been sold under different names in the past, and are currently identified as CLASSIC I, CLASSIC II, and so on. I agree with the Opponent that in the particular circumstances of this case, consumers aware of the Opponent's CLASSIC series of doors could interpret doors marketed as CLASSIQUE SERRANA and CLASSIQUE RODIA as new and different profiles of the Opponent's CLASSIC series of doors.

Additional surrounding circumstances

As ruled above, the Parliament affidavit and exhibits are inadmissible. As I must render my decision according to the admissible evidence filed in record, and since no admissible evidence has been filed to demonstrate that the word “CLASSIC” is a common component of trade-marks used in association with various types of building supplies, I come to the conclusion that no additional surrounding circumstances have been established which are relevant to this case.

Based on the foregoing analysis, I find that the Applicant has failed to discharge the legal burden upon it to show that, on a balance of probabilities, confusion between the marks under review is unlikely. Accordingly, the s.12(1)(d) ground of opposition succeeds in respect of each application.

Section 16(3)(a) ground of opposition

The Opponent has also pleaded that the Applicant is not the person entitled to registration pursuant to s. 16(3)(a) of the Act on the basis that the Marks are confusing with the mark CLASSIC, which had been previously used and made known in Canada by the Opponent and its predecessor-in-title, in association with doors, and which had not been abandoned by the Opponent as at advertisement of the Marks.

With respect to this ground of opposition, there is an initial burden on the Opponent to evidence use of its trade-mark prior to the date of filing of the Applicant’s applications and non-abandonment of its mark as of the date of advertisement of the Applicant’s applications [s. 16]. As outlined above, the Opponent has met this burden as well. This ground of opposition therefore remains to be decided on the issue of confusion between the Applicant’s Marks and the Opponent’s mark as of March 15, 2002.

As the difference between the relevant dates for the grounds of opposition based on s.12(1)(d) and s.16(3)(a) does not affect my earlier analysis following which I determined that there is a

likelihood of confusion between the marks under review, the s.16(3)(a) ground of opposition also succeeds in respect of each application.

Non-distinctiveness ground of opposition

As stated above, the relevant date for considering this ground of opposition, which is also based on the issue of confusion between the Marks and the Opponent's trade-mark, is generally accepted to be the filing date of the statements of opposition.

The Opponent can discharge its initial evidential burden in regard to the Marks' non-distinctiveness by establishing that its trade-mark had become sufficiently known in Canada at the date of the statements of opposition that it negated the distinctiveness of the Marks [see *Motel 6, Inc. v. No.6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.)].

As I came to the conclusion that, based on the evidence filed in record, the CLASSIC SERRANA and CLASSIC RODIA Marks are confusing with the Opponent's mark and because the difference in relevant dates does not affect my analysis, the non-distinctiveness ground of opposition therefore succeeds in respect of each application.

Section 30(i) ground of opposition

As I have already refused the applications under three grounds, it is superfluous to examine that other ground of opposition.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse application No. 1134448 for the CLASSIC SERRANA trade-mark and application No. 1134460 for the CLASSIC RODIA trade-mark pursuant to s. 38(8).

DATED AT Montréal, Quebec, THIS 15th DAY OF November 2007.

Annie Robitaille
Member
Trade-marks Opposition Board