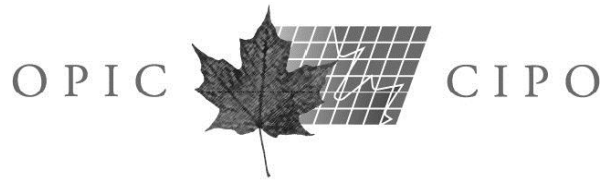


Translation/Traduction



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

Citation: 2011 TMOB 143
Date of Decision: 2011-08-15

**IN THE MATTER OF AN OPPOSITION by
Nautilus Plus Inc. and 88766 Canada Inc. to
application No. 1,264,009 for the trade-mark
CENTRES STOP in the name of Centres Stop
Inc.**

The Pleadings

[1] On June 30, 2005, Centres Stop Inc. (the Applicant) filed application No. 1,264,009 to register the trade-mark CENTRES STOP (the Mark) in association with

(1) Naturopathic support products namely homeopathic drops for weight loss, weight management, smoking cessation, appetite control, and stress reduction; (2) Educational publications, namely books, printed articles, pamphlets and workbooks and worksheets relating to weight loss, weight management, smoking cessation, appetite control, stress reduction and other health and wellness and healthy lifestyle programs; (3) Naturopathic support products namely homeopathic gel caps and pills for weight loss, weight management, smoking cessation, appetite control and stress reduction (the Wares);

(1) Health services namely auricular therapy for drug, alcohol, gambling, smoking and food addictions, stress reduction, tinnitus reduction, migraine reduction and behaviour modification; (2) Counselling, support and rehabilitation services for drug, alcohol, gambling, smoking and food addictions, stress reduction, tinnitus reduction, migraine reduction and behaviour modification; (3) Educational services namely designing and providing educational programs, materials and information relating to weight loss, weight management, smoking cessation, appetite control and other health and wellness and healthy lifestyle programs and providing educational seminars by Internet with respect to

weight loss, weight management, smoking cessation, appetite control and other health and wellness and healthy lifestyle [*sic*] programs (the Services).

[2] The application is based on use of the Mark in Canada since August 2004 in association with Wares (1); since June 2000 in association with Wares (2) and Services (1) and (2); and since January 2005 in association with Services (3); and on proposed use in association with Wares (3).

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of June 7, 2006. Nautilus Plus Inc. (Nautilus) and 88766 Canada Inc. (the Opponent) filed a joint statement of opposition on November 7, 2006, which the Registrar forwarded to the Applicant on November 23, 2006. On December 20, 2006, the Applicant filed a counter statement denying all of the grounds of opposition described below. Nautilus and the Opponent amended their statement of opposition, and the Applicant amended its counter statement accordingly.

[4] As Rule 41 evidence, Nautilus and the Opponent filed certificates of authenticity concerning the registered marks listed in their statement of opposition. As Rule 42 evidence, the Applicant filed Stephen Wallack's affidavit, dated February 20, 2008.

[5] Each of the parties filed written arguments. Both the Applicant and the Opponent were represented at an oral hearing. Three days before the scheduled hearing date, the Registrar was informed that Nautilus was withdrawing its opposition. All that remains on file therefore is the Opponent's opposition.

The Grounds of Opposition

[6] The various grounds of opposition raised by the Opponent in its statement of opposition amended on July 17, 2008, may be summarized as follows:

Regarding the compliance of the application for registration with s. 30 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) for the portion based on proposed use of the Mark in Canada,

1. on the filing date of the application, the Applicant was using or had already used the Mark in Canada, contrary to s. 30 of the Act;

2. the trade-mark proposed for use is not the Mark, but another, different trade-mark.
3. the Applicant never intended to use the Mark in Canada in association with the Wares (s. 30(e) of the Act); and
4. given the Applicant's knowledge of the rights of third parties or opponents and the illegality of any use, the Applicant falsely stated being satisfied that it was entitled to use the Mark in Canada (s. 30(i) of the Act);

regarding the portion of the application for registration based on use of the Mark in Canada,

5. on the filing date of the application, the Applicant was not using the Mark on the various dates of first use claimed in the application for registration, or each alleged date of first use is wrong, contrary to s. 30(b) of the Trade-marks Act, R.S.C. 1985, c. T-13 (the Act);
6. the trade-mark of which use is claimed is not the Mark, but another, different trade-mark;
7. the alleged use of the Mark in association with the Wares and Services is discontinuous, in whole or in part;
8. given the Applicant's knowledge of the rights of third parties or opponents and the illegality of any use, the Applicant falsely stated being satisfied that it was entitled to use the Mark in Canada (s. 30(i) of the Act); and
9. the application does not contain a statement in ordinary commercial terms of Wares (2) and the Services (s. 30(a) of the Act);

and regarding the application to register the Mark in general,

10. the Mark is not registrable under s. 12(1)(d) of the Act, as it is confusing with the following registered trade-marks:

CARE-FREE SNORE STOPPER, registration TMA656,081, for an oral device, namely an apparatus designed and fitted for individuals to eliminate snoring;
HEMOR-STOP, registration TMA256,558, for suppositories for hemorrhoids;
SMOKE STOPPERS & DESIGN, registration TMA369,169, for brochures, pamphlets, and booklets relating to cessation of smoking; informational brochures dealing with smoking; and planning, supervising and conducting smoking cessation programs;
SNORE STOP, registration TMA492,013, for homeopathic formulations for the relief of the symptoms of snoring;

STOP'N GROW and design, registration TMA162,143, for nail biting deterrent preparations;
TABASTOP, registration TMA383,956, for tablets to stop smoking.

11. the Mark is not, and cannot be, distinctive of the Wares and Services because it does not distinguish the Applicant's Wares and Services from the wares and services of others than the Applicant, considering what has been mentioned herein and the presence on the market and in the Register of STOP-type trade-marks for wares and services of the same nature as those stated in this application for registration;
12. the Mark is not, and cannot be, distinctive of the Wares and Services because the Applicant allowed third parties to use the Mark in Canada outside the scope of the legislative provisions governing licensed use, contrary to s. 50 of the Act; and
13. the Mark is not, and cannot be, distinctive of the Wares and Services because as a result of its transfer, there subsisted rights in two or more persons to the use of the Mark, and those rights were exercised concurrently by those persons, contrary to s. 48(2) of the Act.

Burden of Proof When Opposing the Registration of a Trade-mark

[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, 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 (T.M.O.B.), and *John Labatt Ltd. v. Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.)].

Grounds of Opposition Summarily Dismissed

[8] The only evidence filed by the Opponent to support its grounds is the certificates of authenticity for the registered trade-marks listed under ground of opposition 10. As for grounds of opposition 5 and 6, it is recognized that the opponent can meet its initial burden of proof by relying on the evidence filed by the applicant [see *Labatt Brewing Company v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.)]. However, this evidence must raise serious doubt. In the circumstances, I dismiss grounds of opposition 1, 2, 3, 7, 9, 12 and 13, since the Opponent has failed to meet its initial burden of proof.

[9] As for grounds of opposition 4 and 8, s. 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. Section 30(i) of the Act can be argued, among other things, where it is alleged that the applicant's statement was made in bad faith [see *Sapodilla Co. Ltd. v. Bristol Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.)]. This was neither alleged nor proved. The fourth and eighth grounds of opposition are therefore dismissed.

[10] As for ground of opposition 11, there is no evidence of use of the trade-marks in the Register and cited by the Opponent under ground of opposition 10 and on which the Opponent is relying. Yet, the Opponent must demonstrate that one of the marks cited in support of the claim that the Mark cannot be distinctive was known sufficiently as of the filing date of the statement of opposition [see *Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.T.D.)]. Filing a certificate of registration for each of the marks cited is not sufficient to meet this initial burden of proof [see *Classical Remedia Ltd. v. 1404568 Ontario Ltd.* (2010), 81 C.P.R. (4th) 317 (T.M.O.B.)]. For these reasons, ground of opposition 10 is also dismissed.

Registrability of the Mark under s. 12(1)(d) of the Act

[11] In ground of opposition 10, the Opponent alleges that the Mark is confusing with the registered trade-marks listed above. The Opponent filed a certificate of authenticity for each of these marks, except for the SMOKE STOPPERS & DESIGN mark. I nonetheless checked the Register, exercising my discretion to do so [see *Quaker Oats Co. of Can. v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)]. All the registrations referred to are current except for registration Nos. TMA256,558 and TMA369,169, which have been expunged. They can therefore not be considered in support of this ground of opposition. The Opponent has therefore met its initial burden regarding the four trade-marks still in the Register.

[12] The Applicant must therefore show that there is no likelihood of confusion between the Mark and any of the marks cited by the Opponent that are still in the Register. The applicable test in this case is described at s. 6(2) of the Act. Thus, the use of the Mark will cause 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 and services associated with those trade-marks are manufactured, sold, hired or performed by the same person, whether or not the wares or services are of the same

general class. A non-exhaustive list of relevant circumstances appears at s. 6(5) of the Act. In the recent decision *Masterpiece Inc. v. Alavida Lifestyles Inc.*, 2011 SCC 27, the Supreme Court of Canada interpreted s. 6(2) and clarified the scope of the various criteria listed at s. 6(5) of the Act. This analysis shows that the most important factor is still the degree of resemblance between the marks at issue.

[13] I must point out that in the [TRANSLATION] “ARGUMENTS” section of its written submissions, the Opponent limits its comments to the fifth and sixth grounds of opposition described above. It does not submit any arguments to support ground of opposition 10. The same was true at the oral hearing. I am not planning to go into an exhaustive analysis of the factors listed at s. 6(5) of the Act to deal with this ground since the Opponent shows little interest in discussing this issue.

[14] The marks cited by the Opponent are different not only phonetically and visually but also in terms of the ideas they suggest, despite the presence of the word STOP, which has very little inherent distinctiveness. Moreover, the registration certificates of the marks cited by the Opponent cover different wares from the Wares and Service, with the exception of the registration certificate for the mark TABASTOP. In the latter case, its little resemblance with the Mark is sufficient in itself to support the absence of a likelihood of confusion.

[15] Even if the other factors listed at s. 6(5) of the Act favoured the Opponent, their weight would not be sufficient to counter the effect of the lack of any or of the little resemblance between the Mark and the registered marks cited by the Opponent.

[16] In the circumstances, ground of opposition 10 is also dismissed.

Use of the Mark

[17] At the hearing, the agent for the Opponent stated that she would limit to the Wares its arguments on grounds of opposition 5 and 6. In fact, as appears from the Applicant's evidence described below, the Mark was used in association with the Services. Clearly, these grounds of opposition cannot apply to Wares (3) since use of the Mark for these wares is being proposed. Therefore I must first determine whether the various marks used by the Applicant qualify as use

of the Mark. If this is the case, I will then have to determine whether the Mark was used in association with Wares (1) and (2) at the dates claimed.

[18] For the purposes of this decision, I need only to say of the Applicant that Mr. Wallack is its president and founder. The Applicant was incorporated on April 4, 2000. Mr. Wallack stated that the Applicant began using the Mark in May 2000, in association with treatments for people suffering from weight and appetite problems, stress, and alcohol and cigarette addiction.

[19] The Opponent submits that Mr. Wallack states on several occasions that the Mark has been used since May 2000 (see paragraphs 5, 7, 8, 10 and 13 of Mr. Wallack's affidavit) in association with some of the Wares and Services, and not June 2000 as alleged in the application for registration. In fact, as a cautionary measure, an applicant may base its application for registration on a date subsequent to the actual date of first use of its mark [see *Marineland Inc. v. Marine Wonderland and Animal Park Ltd.* (1974), 16 C.P.R. (2d) 97, F.C.T.D.)].

[20] Mr. Wallack filed documents on which the Mark clearly appears; I am referring here to Exhibits SW-2, SW-3, SW-6 and SW-15. I also note that the STOP CENTRES mark can be seen on Exhibits SW-4, SW-5, SW-13, SW-14 and SW-16. I consider this use to qualify as use of the Mark. [see *Registrar of Trade Marks v. Compagnie L'informatique CII Honeywell Bull, Société Anonyme et al.* (1985), 4 C.P.R. (3d) 523 (F.C.A.), and *Nightingale Interlock Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535 (T.M.O.B.)].

[21] What remains to be determined therefore is whether these exhibits demonstrate use of the Mark in association with Wares (1) and (2) within the meaning of s. 4 of the Act at the dates claimed in the application for registration.

Whether the Mark Was Used in Association with Wares (1) and (2) at the Dates Claimed

[22] The Opponent argues that the exhibits listed above do not show use of the Mark in association with the Wares within the meaning of s. 4(1) of the Act since there is no association between the Mark and a product. The best way to demonstrate this association would be to affix the Mark on the product itself or on its packaging [see *Farside Clothing et al. v. Caricline Ventures Ltd.*, 2002 F.C.A. 446].

[23] Mr. Wallack states in his affidavit that Exhibits SW-2, SW-3 and SW-15 are promotional brochures. This does not constitute use of the Mark in association with Wares (1). None of the evidence filed by Mr. Wallack shows Wares (1), with the exception of Exhibit SW-13, which I will deal with at greater length below.

[24] As to the educational publications (Wares (2)), the promotional brochures produced by Mr. Wallack are distributed to promote the Applicant's Services in association with the Mark. I agree with the Opponent that these documents do not prove use of the Mark in association with Wares (2). The brochure filed as Exhibit SW-11 refers to the Mark, but in association with the Services. This does not constitute use of the Mark in association with wares within the meaning of s. 4(1) of the Act.

[25] Exhibits SW-4, SW-5, SW-6, SW-8 and SW-9 are advertisements that appeared in various publications and in the media and that promote the Services in association with the Mark. Exhibits SW-14 and SW-16 are photographs of an exterior sign and a car, both of which display the Mark. Here, too, the Mark is being used in association with the Services. None of these exhibits can constitute evidence of use of the Mark in association with Wares (1) and (2).

[26] There is Exhibit SW-13, which is a photograph of a container for homeopathic drops on which the STOP CENTRES mark has been affixed. I have already concluded that use of that trade-mark constitutes use of the Mark. However, is it correct to conclude that the Mark has been used in association with Wares (1) since the date of first use claimed in the application for registration, that is, since August 2004?

[27] Mr. Wallack alleges at paragraph 19 of his affidavit that the Applicant offers its clients a variety of homeopathic products to lose and control weight, stop smoking, control one's appetite and reduce stress, and has done so since March 2003. For the same reasons as those set out above, I do not find that the reference in Mr. Wallack's affidavit to an earlier date than the one alleged in the application for registration is fatal to the Applicant.

[28] Despite the abundance of evidence filed by the Applicant, none of that evidence can be considered to be evidence of use of the Mark in association with Wares (1) and (2) at the dates claimed, except for Exhibit SW-13, which demonstrates use of the Mark in association with

Wares (1). I have no documentary evidence proving use of the Mark in association with Wares (2). This leads me to conclude that there is a substantial doubt regarding the Applicant's allegation that it used the Mark in association with Wares (2) at the dates claimed.

[29] I therefore allow the fifth ground of opposition solely with regard to Wares (2).

Abuse of process

[30] At the hearing, the Applicant argued that the opposition proceedings in this case were without merit and abusive. Consequently, the Applicant asked the Registrar to find that they were an abuse of right within the meaning of the Civil Code and asked me to reject the opposition.

[31] The mechanism adopted by Parliament to prevent abuse of process through frivolous and meritless opposition proceedings is set out at s. 38(4) of the Act. Under this provision, when the Registrar receives a statement of opposition, the Registrar must read it to determine whether there is at least one ground of opposition that, on its face, appears to raise a substantial issue. In serving the statement of opposition on the Applicant, the Registrar deemed that, on its face, the statement of opposition was not frivolous. Moreover, as appears from this decision, one of the grounds of opposition has been allowed in part.

Disposition

[32] Pursuant to the authority delegated to me under s. 63(3) of the Act and considering the principles stated in *Produits Ménagers Coronet Inc. v. Coronet Werke Heinrich SCH*, 10 C.P.R. (3d) 482 (F.C.T.D.), I reject the opposition with respect to the following wares and services:

(1) Naturopathic support products namely homeopathic drops for weight loss, weight management, smoking cessation, appetite control, and stress reduction; (3) Naturopathic support products namely homeopathic gel caps and pills for weight loss, weight management, smoking cessation, appetite control and stress reduction;

(1) Health services namely auricular therapy for drug, alcohol, gambling, smoking and food addictions, stress reduction, tinnitus reduction, migraine reduction and behaviour modification; (2) Counselling, support and rehabilitation services for drug, alcohol, gambling, smoking and food addictions, stress reduction, tinnitus reduction, migraine reduction and behaviour modification; (3) Educational services namely designing and

providing educational programs, materials and information relating to weight loss, weight management, smoking cessation, appetite control and other health and wellness and healthy lifestyle programs and providing educational seminars by Internet with respect to weight loss, weight management, smoking cessation, appetite control and other health and wellness and healthy lifestyle [*sic*] programs;

however, I refuse the application for registration of the Mark in association with the following Wares:

(2) Educational publications, namely books, printed articles, pamphlets and workbooks and worksheets relating to weight loss, weight management, smoking cessation, appetite control, stress reduction and other health and wellness and healthy lifestyle programs;

the whole by operation of s. 38(8) of the Act.

Jean Carrière
Member, Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
Johanna Kratz