

**IN THE MATTER OF AN OPPOSITION  
by Starving Students, Inc. to application  
No. 1,040,109 for the trade-mark  
STARVING STUDENTS MOVING LTD.  
filed by Starving Students Moving Co. Ltd.**

**On December 20, 1999, the applicant, Starving Students Moving Ltd., filed an application to register the trade-mark STARVING STUDENTS MOVING LTD. for “residential and commercial moving and cartage services” and “courier and light delivery services” based on use in Canada since October 25, 1999. The application was amended to include a disclaimer to the word MOVING and was subsequently advertised for opposition purposes on August 20, 2003.**

**The application was erroneously filed in the name of Starving Students Moving Ltd. and a request dated January 18, 2005 was filed requesting that the applicant’s name be corrected to read Starving Students Moving Co. Ltd. By letter dated March 1, 2005, the Examination Section entered the correction of the applicant’s name.**

**The opponent, Starving Students, Inc., filed a statement of opposition on September 16, 2003, a copy of which was forwarded to the applicant on October 28, 2003. The first ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(1)(a) of the Trade-marks Act because, as of the applicant’s claimed date of first use, the applied for trade-mark was confusing with the trade-mark STARVING STUDENTS previously used or made known in Canada by the opponent with “the services of moving and storing goods and personal property of others.”**

**The second ground of opposition is that the applicant's application does not conform to the requirements of Section 30(i) of the Act because the applicant could not have been satisfied that it was the person entitled to registration of the applied for mark in view of the prior adoption and use of the trade-mark STARVING STUDENTS by the opponent. The third ground is that the applicant's application does not conform to the requirements of Section 30(b) of the Act because the application does not contain the correct date of first use of the applied for trade-mark.**

**The fourth ground of opposition is that the applicant is not the person entitled to registration of the applied for mark pursuant to Section 16(1)(a) of the Act because the mark had not been used in Canada by the applicant. The fifth ground is that the applied for trade-mark is not distinctive of the applicant because it is confusing with the opponent's trade-mark STARVING STUDENTS previously used and made known in Canada.**

**The applicant filed and served a counter statement. As its evidence, the opponent submitted the affidavits of Bear Barnes and Katherine Busse. As its evidence, the applicant submitted an affidavit of Richard Allen Cooper. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.**

#### **THE OPPONENT'S EVIDENCE**

**In his affidavit, Mr. Barnes identifies himself as the Chief Executive Officer of the opponent, Starving Students, Inc. Mr. Barnes states that the founder of the opponent began using the trade-mark STARVING STUDENTS for moving services in the United States in**

November of 1973. Since January of 1979, the opponent has been using a design version of the trade-mark wherein the two words are separated by the design of a heart.

Mr. Barnes states that the opponent employs more than 1,000 people across the United States. Total revenues for the period 1999-2003 were in excess of \$125 million. However, Mr. Barnes did not attest to any sales in Canada in association with the opponent's trade-marks at any time. The opponent has maintained a website since 1999 but there is no evidence that it has been accessed by any Canadian residents, much less a significant number of Canadian residents.

In her affidavit, Ms. Busse identifies herself as a trade-mark searcher employed by the firm of trade-mark agents representing the opponent. She conducted various searches which revealed that there was no company registered in British Columbia under the name Starving Students Moving Ltd. although there was an active company registered under the name Starving Students Moving Co. Ltd. Ms. Busse also evidenced the contents of the opponent's website in 2004 and in 1999.

#### THE APPLICANT'S EVIDENCE

In his affidavit, Mr. Cooper identifies himself as a director and the Secretary of the applicant, Starving Students Moving Co. Ltd. He states that the company was incorporated on September 8, 1999. The predecessor proprietorship began using the trade-mark STARVING STUDENTS prior to that date and the mark was written in hand on invoices and bills of lading at that time. After the incorporation of the applicant, printed bills of lading were

used bearing a design version of the mark STARVING STUDENTS wherein the two words were separated by the design of a heart in the same fashion as the opponent's design mark. The design version of the mark is the trade-mark that has been in continuous use since the claimed date of October 25, 1999. Mr. Cooper did not provide any evidence of use of the applied for mark STARVING STUDENTS MOVING LTD.

#### THE GROUNDS OF OPPOSITION

As for the first ground of opposition, there was an initial evidential burden on the opponent to evidence use or making known of its trade-mark STARVING STUDENTS in Canada prior to the applicant's claimed date of first use. As noted, the Barnes affidavit does not evidence use of that mark in Canada by the opponent at any time. Furthermore, the opponent has failed to evidence any activities which establish that the opponent's mark had been made known in Canada at any time. Thus, the first ground of opposition is unsuccessful.

The second ground does not raise a proper ground of opposition. The prior use and adoption of the opponent's mark did not preclude the applicant from truthfully making the statement required by Section 30(i) of the Act. Thus, the second ground is also unsuccessful.

As for the opponent's third ground of opposition, the onus or legal burden is on the applicant to show that its application conforms to the requirements of Section 30(b) of the Act: see the opposition decision in Joseph Seagram & Sons v. Seagram Real Estate (1984), 3 C.P.R.(3d) 325 at 329-330 and the decision in John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 (F.C.T.D.). There is, however, an evidential burden on the opponent

respecting its allegations of fact in support of that ground. That burden is lighter respecting the issue of non-conformance with Section 30(b) of the Act: see the opposition decision in Tune Masters v. Mr. P's Mastertune (1986), 10 C.P.R.(3d) 84 at 89. Furthermore, Section 30(b) requires that there be continuous use of the applied for trade-mark in the normal course of trade since the date claimed: see Labatt Brewing Company Limited v. Benson & Hedges (Canada) Limited and Molson Breweries, a Partnership (1996), 67 C.P.R.(3d) 258 at 262 (F.C.T.D.). Finally, the opponent's evidential burden can be met by reference to the applicant's own evidence: see Labatt Brewing Company Limited v. Molson Breweries, a Partnership (1996), 68 C.P.R.(3d) 216 at 230 (F.C.T.D.).

As noted, the Cooper affidavit does not evidence any use of the applied for mark STARVING STUDENTS MOVING LTD. Mr. Cooper has evidenced continuous use of the design version of the mark STARVING STUDENTS as of the claimed date of first use but that is not the mark applied for. The applicant contends that the mark actually used is simply an insignificant variation of the mark applied for. In considering this issue, I have relied on the decision in Registrar of Trade Marks v. Compagnie Internationale pour L'Informatique CII Honeywell Bull, S.A. (1985), 4 C.P.R.(3d) 523 (F.C.A.) and the second principle set out at page 538 in the reported decision in Nightingale Interloc Ltd. v. Prodesign Ltd. (1984), 2 C.P.R.(3d) 535 (T.M.O.B.). The applicant relied on the decision in Alibi Roadhouse Inc. v. Grandma Lee's International Holdings Ltd. (1997), 76 C.P.R.(3d) 327 where it was held that use of one design version of the trade-mark ALIBI constituted use of another design version of that mark. However, as noted by Mr. Justice Teitelbaum at page 339 of the reported decision, "...the final determination in each case is a question of fact." In the present case, the addition of the words

**MOVING LTD.** and the removal of the heart design comprise more than minor changes. Thus, I find that the opponent has met its evidential burden and the applicant has failed to satisfy the onus on it to evidence continuous use of the applied for mark since the date of first use claimed. Thus, the third ground of opposition is successful.

The fourth ground is not a proper ground of opposition. The provisions of Section 16 of the Act detail the various bases for a ground of prior entitlement and failure to use the mark is not included within them. Such an allegation should be made in support of a ground of non-conformance with Section 30(b) of the Act. Thus, the fourth ground is unsuccessful.

As for the fifth ground, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its services from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - September 16, 2003): see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.).

As previously noted, the opponent has failed to evidence any use of its marks in Canada. Furthermore, it has failed to evidence any reputation for its marks in this country. Thus, the opponent has failed to meet its evidential burden and the fifth ground is also unsuccessful.

**In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.**

**DATED AT GATINEAU, QUEBEC, THIS 18<sup>th</sup> DAY OF SEPTEMBER, 2006.**

**David J. Martin,  
Member,  
Trade Marks Opposition Board.**