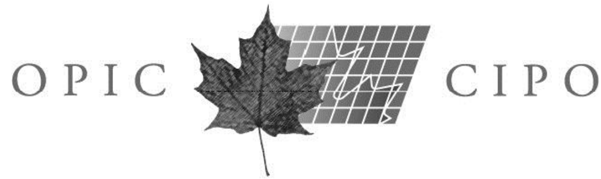

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2014 TMOB 67
Date of Decision: 2014-03-20

IN THE MATTER OF AN OPPOSITION by That Franchise Inc. to application No. 1,470,941 for the trade-mark BiN HERE… BiN THERE & Design, in the name of Saascorp Ltd.

[1] That Franchise Inc. (the Opponent) opposes registration of the trade-mark BiN HERE… BiN THERE & Design (shown below) (the Mark), that is the subject of application No. 1,470,941 by Saascorp Ltd. (the Applicant).

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[2] The Applicant filed the application on February 23, 2010, based upon use of the Mark in Canada since May 6, 2008 in association with a variety of waste management services (the Services). The statement of services is reproduced in its entirety in Schedule "A" to this decision

[3] The opposition was brought forth by the Opponent under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition are as follows:

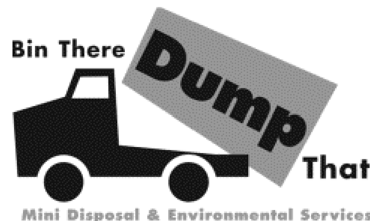
(i) the Applicant has not used the Mark in Canada with the Services since the date of first use claimed in the application;

(ii) the Mark is not registrable as it is confusing with a registered trade-mark belonging to the Opponent;

(iii) the Applicant is not the person entitled to the registration of the Mark, as the Mark is confusing with trade-marks belonging to the Opponent, which have been used in Canada prior to the Applicant's alleged date of first use; and

(iv) the Mark does not distinguish the Applicant's Services from the Opponent's services.

[4] Grounds (ii) through (iv) above turn on the likelihood of confusion between the Mark and the Opponent's registered BIN THERE DUMP THAT trade-mark (TMA642,547) and/or its BIN THERE DUMP THAT & Design trade-mark (shown below) (particulars of each of the Opponent's trade-marks are included in Schedule "B" to this decision).



[5] For the reasons that follow, I have found that this application ought to be refused.

<u>The Record</u>

[6] The Opponent filed its statement of opposition on February 15, 2011. The Applicant denied all grounds of opposition in its counter statement.

[7] In support of its opposition, the Opponent filed an affidavit of Jayda Sutton, sworn October 28, 2011, and an affidavit of Michael Kernaghan, sworn October 25, 2011.

[8] In support of its application, the Applicant filed an affidavit of Sabrina Perry, and an affidavit of Andy Brunelle, both sworn February 22, 2012.

[9] As its reply evidence, the Opponent filed an additional affidavit of Michael Kernaghan, sworn June 14, 2012.

[10] No cross-examinations were conducted.

[11] Both parties filed written arguments; however, only the Opponent requested and attended an oral hearing.

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 evidential 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 Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA et al* (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(b) – the filing date of the application [see *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 [see *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) – the Applicant's date of first use [see section 16(1)];
- Section 38(2)(d)/non-distinctiveness – the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Grounds of Opposition

Section 30(b) – Non-Compliance

[14] An opponent's initial burden under section 30(b) is light [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89], and can be met by reference not only to the opponent's evidence but also the applicant's evidence [see *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 at 230 (FCTD)]. Should an opponent rely upon the applicant's evidence to meet its evidential burden in relation to this ground, the opponent must show that the applicant's evidence is clearly inconsistent with the applicant's claims as set forth in its application [see *Ivy Lea Shirt Co v 1227624 Ontario Ltd* (1999), 2 CPR (4th) 562 at 565-6 (TMOB), aff'd 11 CPR (4th) 489 (FCTD)].

[15] As previously indicated, the Opponent pleads that the Applicant did not use the Mark in Canada in association with the Services since the date of first use claimed in the application. The Opponent's main submission under this ground is that the Applicant did not use the Mark in association with the Services within the meaning of section 4(2) of the Act.

[16] In accordance with section 4(2) of the Act, a trade-mark to be deemed to be "used" in association with services, if it is used or displayed during the performance or in the advertising of those services. Absent evidence of actual performance of services, where the trade-mark owner is offering and prepared to perform the services in Canada, use of the trade-mark in advertising of those services meets the requirements of the Act [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (RTM)].

[17] In order to meet its evidential burden under this ground of opposition, the Opponent relies upon both its own evidence, as well as the Applicant's evidence. For reasons that follow, the Opponent's evidence supports that the Services were neither performed nor available to be performed in association with the Mark until several months after the Applicant's claimed date of first use. Furthermore, the Applicant's evidence supports that it had not advertised its Services in association with the Mark, performed the Services in association with the Mark, and that the Services were not available to be performed as of the date of first use claimed.

[18] In terms of its own evidence, the Opponent points to the Sutton affidavit. Exhibit A to Ms. Sutton's affidavit is a copy of a Provisional Certificate of Approval issued on August 12, 2008 by the Ministry of the Environment to the Applicant, granting the Applicant approval to operate a waste management system in the Province of Ontario. The Opponent submits that this document establishes that the Applicant was not authorized to provide any waste management services in the province until August 12, 2008; therefore, the Applicant could not have used the Mark in Canada in the normal course of trade in association with the Services until three months after the Applicant's alleged date of first use. As will be seen below, this evidence is corroborative of statements made by Mr. Brunelle in the Applicant's own evidence.

[19] In his affidavit, Mr. Brunelle attaches as Appendix A, what he refers to as "a dated chronological order of the inception of BiN HERE… BiN THERE." The Opponent submits that Mr. Brunelle's chronology shows that the Applicant's claimed date of first use corresponds to the date upon which the Applicant was incorporated. While this is true, this fact alone would be insufficient to cast doubts on the Applicant's claimed date of first use [see *Canadian Occidental Petroleum Ltd v Oxychem Canada Inc* (1990), 33 CPR (3d) 345 (TMOB)]. However, I note that there are further inconsistencies in Mr. Brunelle's affidavit and attached chronology which cast serious doubts on the accuracy of the statements made by the Applicant in its application.

[20] I have no reason to doubt that the Applicant intended on commencing the offering of its Services in association with the Mark as of the date claimed in the application. Indeed, in his affidavit, Mr. Brunelle explains that development of the BiN HERE… BiN THERE logo began in 2007, and that the logo was imagined, created and redesigned long before May 6, 2008. In support, he attaches as Exhibits E, F, and G, various renderings of the logo from the initial design to the final design selected. Further to this, he attaches as Exhibit B, a copy of the cover of the first draft of the BiN HERE…BiN THERE business plan, in which the Mark substantially appears, prepared August 2007 and revised March 2008.

[21] Moving to Mr. Brunelle's chronology of the "inception of BiN HERE…BiN THERE", it is apparent that the Mr. Brunelle deliberately chose May 6, 2008 as the Applicant's date of incorporation, as he anticipated that by this date, he would be in receipt of a fully certified truck installed with a bin lift system and tarp mechanism with which to conduct the Services.

Additionally, Mr. Brunelle's chronology describes other activities that were undertaken prior to May 6, 2008, such as the development of a business plan to obtain necessary funding for the business.

[22] However, according to Mr. Brunelle's attached chronology, due to delays, the newly incorporated Applicant did not receive the completed truck referred to above, until June 17, 2008. Further to this, the chronology indicates that the Applicant only obtained vehicle liability insurance on June 20, 2008, and general commercial liability insurance on June 24, 2008.

[23] Mr. Brunelle then indicates in his chronology that he became aware on July 14, 2008 that the Applicant required both a "Waste Management System" certificate from the Ministry of the Environment and a CVOR (Commercial Vehicle Operator's Registration) number from the Ministry of Transportation. He states that "at this time" the Applicant applied for both the certificate and the CVOR number. Consistent with the Opponent's above-noted evidence (Sutton affidavit, Exhibit A), the following entry appears in Mr. Brunelle's chronology for the date August 12, 2008:

> Received our Provisional Certificate of Approval-Waste Management System. (as attested to by the Opponent's affidavit from Jayda Sutton)

Mr. Brunelle makes no further mention of the CVOR number.

[24] Having regard to the above, I find that the Opponent's evidence as well as the Applicant's own evidence cast serious doubts on the accuracy of the date of first use claimed by the Applicant in its application. In particular, it appears that the Applicant did not have the equipment, insurance or proper governmental authorization to perform its Services until several months after the claimed date of first use. While it is clear that the Applicant incorporated on the date of first use claimed, mere incorporation does not qualify as use of a trade-mark pursuant to section 4 of the Act. Furthermore, the pre-launch activities referred to by Mr. Brunelle, such as the BiN HERE…BiN THERE logo creation and design, and the use of the Mark on the Applicant's business plan, also do not constitute use of the Mark within the meaning of section 4(2) of the Act [see *James v Kinder-Care Learning Centers, Inc* (1983), 76 CPR (2d) 229 (TMOB) and *Wing Nuts Café v Joyce* 2006 CanLII 80223 TMOB].

[25] In any event, even if the evidence had not been inconsistent with respect to the availability of the Services as of the claimed date of first use in the application, Mr. Brunelle's chronology shows that the Applicant neither engaged in advertising activities nor actually performed the Services until after this date. In this regard, the earliest mention of advertising in any respect in Mr. Brunelle's chronology relates to the launch of the Applicant's website on May 29, 2008. Lastly, it would appear from Exhibit "BB" to Mr. Brunelle's chronology, which he attests consists of the Applicant's first filed GST/HST return, that actual performance of the Services commenced sometime during the reporting period of July 6, 2008 to September 30, 2008.

[26] In view of the above, I find that the Opponent has discharged its initial onus through reliance on its own evidence, in addition to showing that the Applicant's evidence is clearly inconsistent with the claim that it has used the Mark in Canada since May 6, 2008. I must now assess whether the Applicant has satisfied its onus of establishing that at the time of filing, its application complied with section 30(b) of the Act. The Applicant has not filed any evidence in this regard; thus, the Applicant has failed to satisfy its legal onus. Accordingly, this ground of opposition is maintained.

[27] Lastly, I wish to note the following excerpt from paragraph 4 of Mr. Brunelle's affidavit:

> 4. I hereby emphatically state that there is a learning curve for any person, business or corporate entity when something new is created. I did not have a "how to" manual at my disposal prior to and when I launched BiN HERE…BiN THERE on May 6, 2008. There was [sic] at the outset some delays and a lack of readily available information. As a result some business information does not match May 6, 2008 and as such the Opponent has become obsessed with that date and is focusing their attention on it to discredit my Trade-mark application. […]

[28] However, to address Mr. Brunelle's above-noted remarks, I find that the following comments of Member Carrière in *Vibe Venture LLC v 3681441 Canada Inc* 2009 CanLII 82160 (TMOB) aptly explain the significance and rationale of section 30(b) of the Act:

> There is no doubt that non-compliance with the provisions of section 30(b) of the Act is a valid ground of opposition [see *Structureco Inc v Jean* (1997), 79 CPR (3d) 331 and *Lise Watier Cosmetiques Inc v Villoresi* (2009), 76 CPR (4th) 196)]. By filing an application based on a date of first use earlier than the actual date of first use, an applicant is

preventing the filing of statements of opposition by opponents who may have prior rights that arose in between the applicant's claimed date of first use and its actual date of first use

Analysis of Remaining Grounds of Opposition

[29] I will now turn to the analysis of the remaining three grounds of opposition, all of which turn on the likelihood of confusion between the Opponent's BIN THERE DUMP THAT and/or BIN THERE DUMP THAT & Design trade-marks. I will begin with an assessment of the likelihood of confusion between the Mark and the Opponent's trade-mark BIN THERE DUMP THAT & Design, as I consider it represents the best case scenario for the Opponent.

Confusion – Section 16 ground of opposition

[30] The material date for assessing a section 16(1)(a) ground of opposition is typically the claimed date of first use [section 16(1)(a)]. However, where an opponent has successfully challenged an applicant's claimed date of first use under a section 30(b) ground of opposition, the material date for assessing a section 16(1) ground of opposition becomes the applicant's filing date [see *American Cyanamid Co v Record Chemical Co Inc* (1972), 6 CPR (2d) 278 (TMOB); *Everything for a Dollar Store (Canada) Inc v Dollar Plus Bargain Centre Ltd*, (1998), 86 CPR (3d) 269 (TMOB)]. Accordingly, the material date for determining the likelihood of confusion between the Mark and the Opponent's BIN THERE DUMP THAT & Design trade-mark is February 23, 2010.

[31] In both its written argument and its evidence, the Applicant appears to challenge the Opponent's right to raise a ground of opposition based upon an unregistered trade-mark. In particular, Mr. Brunelle states in his affidavit that "the Opponent only has been granted the right to the trade-mark […] which consists of the four words Bin There Dump That". Further to this, he states: "I submit that the designation "Bin There Dump That and Design" (TM application # 1516819) has no bearing on our trade-mark application as the "Bin There Dump That and Design" application # 1516819 has not been granted or registered by CIPO as of today's date".

[32] However, a ground of opposition based upon section 16(1)(a) enables an Opponent to rely on common law rights to a trade-mark; that is, rights to a trade-mark that are independent of registration. The Opponent has relied upon common law rights to its BIN THERE DUMP

THAT & Design trade-mark, as pleaded under a ground of opposition based upon section 16(1)(a) of the Act. This ground of opposition is separate and distinct from a ground of opposition based upon section 12(1)(d) of the Act, which deals specifically with confusion with a registered trade-mark.

[33] That being said, the Opponent has an initial onus under this ground of opposition to evidence use of its BIN THERE DUMP THAT & Design trade-mark prior to the Applicant's filing date, namely, February 23, 2010, and non-abandonment as of the date of advertisement of the Mark, namely, September 15, 2010.

[34] Evidence regarding use of the Opponent's BIN THERE DUMP THAT & Design trade-mark has been filed within Mr. Kernaghan's affidavit. In his affidavit, Mr. Kernaghan explains that the services associated with the BIN THERE DUMP THAT and BIN THERE DUMP THAT & Design trade-marks have been performed in Canada extensively and continuously since 2003 by franchisees under license by the Opponent. He states that at all times, the Opponent has, under these licenses, exercised control over the franchisees' use of these trade-marks and the character and quality of the services performed in association with these trade-marks. He further states that all franchises have entered into a comprehensive franchise agreement through which the Opponent exercises strict control over the franchisees' use of these trade-marks and the character and quality of the services performed in association with these trade-marks. He provides as Exhibit C to his affidavit, a sample franchise agreement which he states is representative of the quality control provisions and type of agreements that the Opponent has entered into with each franchisee. Having regard to such evidence, I accept that any use shown by such franchisees is licensed use that accrues to the benefit of the Opponent, pursuant to section 50 of the Act.

[35] Mr. Kernaghan states that there were 16 franchises operating prior to the date of first use alleged by the Applicant. He attests that of the licensed services performed in association with the BIN THERE DUMP THAT and the BIN THERE DUMP THAT & Design, approximate annual sales exceeded $500,000 as early as 2003, exceeded $1,000,000 as early as 2007 and exceeded $5,000,000 by 2010.

[36] As further evidence of use of the Opponent's BIN THERE DUMP THAT trade-marks, Mr. Kernaghan attaches the following relevant evidence:

- screen captures from the Opponent's *www.bintheredumpthat.com* website (Exhibit D), which include photographs of trucks and bins clearing bearing the trade-marks, which Mr. Kernaghan attests show the prominent manner that these trade-marks have been displayed by the Opponent's franchisees since 2003;
- Yellow Pages™ advertising as used by the Opponent's franchisees since 2004, which clearly bear the BIN THERE DUMP THAT trade-marks (Exhibit E); and
- samples of advertising materials clearly bearing the trade-marks, of which several hundred thousand were distributed to Canadians through residential mailboxes since 2003 (Exhibit F).

[37] Having regard to the foregoing, I accept that the Opponent has met its initial burden under this ground of opposition with respect to the services of dropping off an empty garbage/recycling bin at a residence and thereafter picking up the filled bin and disposing of the waste. As such, I now have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with the Opponent's BIN THERE DUMP THAT & Design trade-mark.

The test for confusion

[38] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that the 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.

[39] In applying the test for confusion, the Registrar must have regard to all surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: 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 each has 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 above-noted criteria are not exhaustive and it is not necessary to give each one of them equal weight [see, in general,

Mattel, Inc v 3894207 Canada Inc (2006), 49 CPR (4th) 321 (SCC) and *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC)].

Section 6(5)(a) – inherent distinctiveness and the extent to which the marks have become known

[40] The overall consideration of the section 6(5)(a) factor, which involves a combination of inherent and acquired distinctiveness of the parties' trade-marks, favours the Opponent. With respect to inherent distinctiveness, both parties' marks have some measure of inherent distinctiveness, owing to the apparent play on words employed in both marks. Nevertheless, as discussed above, the Opponent has shown evidence of extensive use of its trade-mark BIN THERE DUMP THAT & Design in Canada since 2003. The Applicant, on the other hand, as discussed in the section 30(b) ground of opposition, appears to have only commenced use of the Mark at some point in the months following its claimed date of first use.

[41] Having regard to the foregoing, I accept that the Opponent's BIN THERE DUMP THAT & Design trade-mark has become known in Canada with respect to waste management services to a much greater extent than the Mark. Consequently, I consider this factor favours the Opponent.

Section 6(5)(b) – the length of time of use

[42] Notwithstanding that the Applicant may have commenced use of the Mark at some point in the months following its claimed date of first use, the Opponent has evidenced use of its BIN THERE DUMP THAT & Design trade-mark in Canada since 2003. Therefore, I find the Opponent's BIN THERE DUMP THAT & Design trade-mark has been in use in Canada for longer than the Mark and as a result, this factor favours the Opponent.

Section 6(5)(c) and (d) – the nature of the wares and services and business or trade

[43] The waste management services of the Applicant are substantially similar to the waste management services of the Opponent, and thus overlap. Furthermore, it is apparent from the evidence and given the overlap in the nature of the parties' services that the channels of trade of the parties also overlap.

[44] Having regard to the foregoing, sections 6(5)(c) and (d) favour the Opponent.

Section 6(5)(e) – degree of resemblance in appearance, when sounded, or in idea suggested

[45] When considering the degree of resemblance between the marks, the law is clear that the marks must be considered in their totalities; it is not correct to lay the trade-marks side by side and compare and observe similarities or differences among the elements or components of the marks. The Supreme Court in *Masterpiece, supra* advised that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique.

[46] For the reasons that follow, I find that there is a substantial degree of resemblance between the parties' marks in appearance, sound and in the ideas suggested. This factor therefore favours the Opponent.

[47] In his affidavit, Mr. Brunelle aptly describes the Mark as follows:

> The design for BiN HERE…BiN THERE […], clearly depicts two rectangle shapes which represent a typical roll off bin or waste container. In the logo, one bin is shown off the truck and contains the words "BiN HERE…" and the second bin is on the truck and contains the words "BiN THERE".

[48] At paragraph 7 of his affidavit, Mr. Brunelle describes what he believes may have been the inspiration behind the Mark. In particular, he references a song performed by Johnny Cash, and attaches the lyrics as Exhibit H to his affidavit. He explains that the song's main chorus is "I've been everywhere man", and states "simply put, my inspiration is "I've got bins here… and I've got bins there (man)"." However, there is no evidence to support that the average consumer would associate the Mark with this song. Moreover, I find that it is readily apparent that the Mark is a play on words for the phrase "been here… been there", with the use of the words here and there in the phrase suggestive of having been "all over" or "everywhere".

[49] The Opponent's BIN THERE DUMP THAT & Design trade-mark also consists of ordinary dictionary words together with a truck design. As in the Mark, the Opponent's mark is a play on words; in this case, for the phrase "been there, done that".

[50] The overall suggestion of both marks is a play on words relating to the idea of the placement of waste bins. Furthermore, not only do both marks incorporate the words "bin there", the inclusion of a truck design element in both parties' marks further heightens the overall visual resemblance between the parties' marks.

Conclusion

[51] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. In *Masterpiece Inc v Alavida Lifestyles* (2011), 92 CPR (4th) 361, the Supreme Court of Canada highlighted the importance of the section 6(5)(e) factor in the analysis of the likelihood of confusion. In the present case, I have found the parties' marks share similarities in appearance, when sounded and in ideas suggested.

[52] Further to this, the parties' services are the same or overlapping, as are the channels of trade. Lastly, the evidence demonstrates that the Opponent's mark has become better known in Canada, through longer and more substantial use.

[53] Thus, having regard to the foregoing, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there was no reasonable likelihood of confusion between the Mark and the Opponent's BIN THERE DUMP THAT & Design trade-mark as of February 23, 2010. Accordingly, the ground of opposition based on section 16(1)(a) of the Act is successful with respect to the Opponent's BIN THERE DUMP THAT & Design trade-mark. As such, I will not consider the likelihood of confusion between the Mark and the Opponent's BIN THERE DUMP THAT word mark (TMA642,547) also alleged in support of this ground of opposition.

Remaining Grounds of Opposition

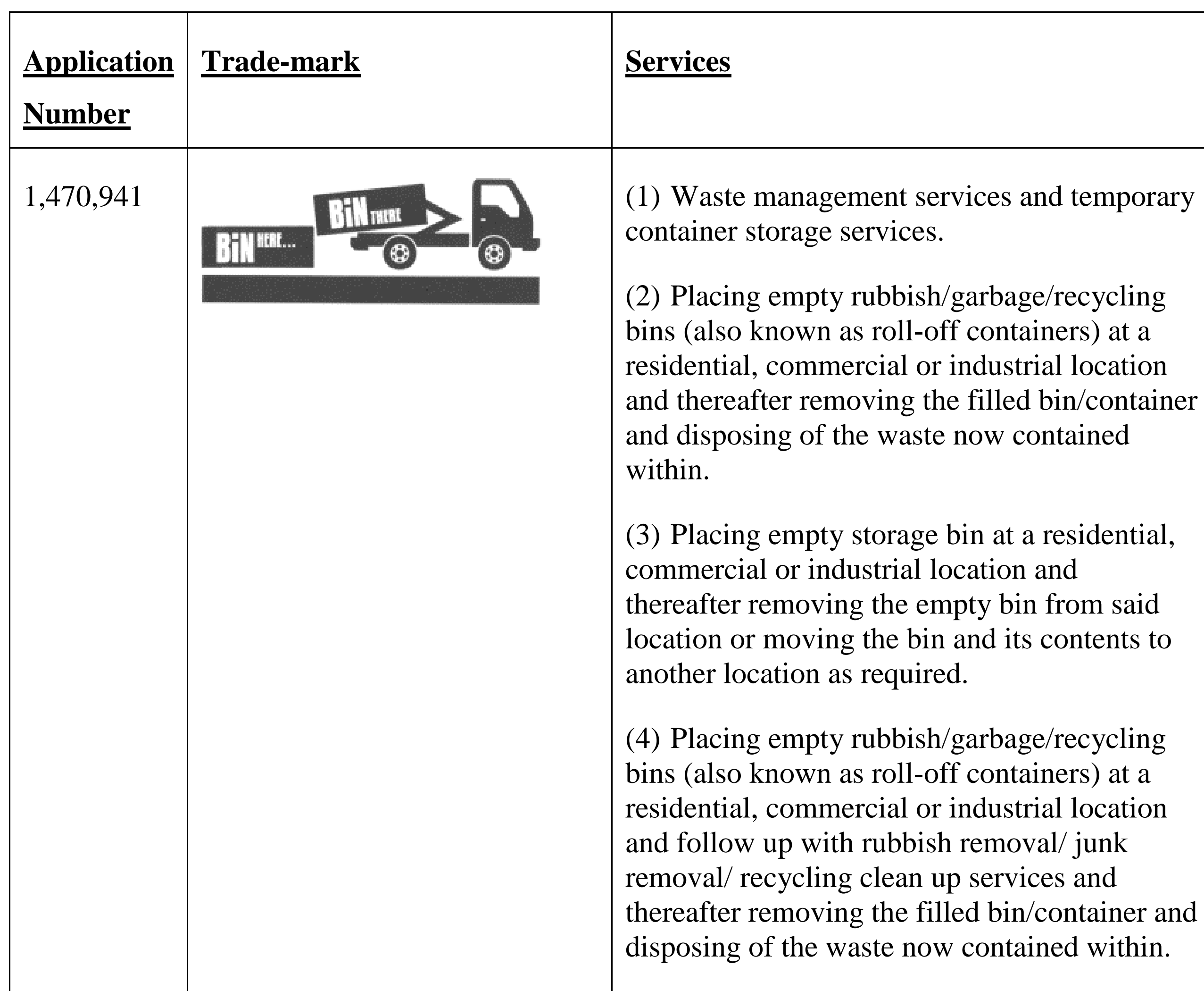
[54] As I have already decided in favour of the Opponent under two grounds of opposition, I do not find it necessary to consider the remaining grounds of opposition.

Disposition

[55] 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.

Kathryn Barnett
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule "A"

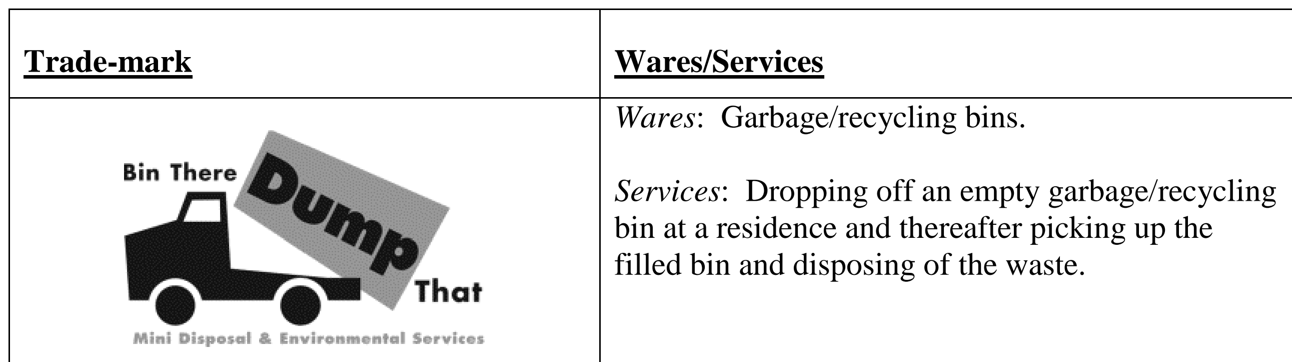


Application Number	**Trade-mark**	**Services**
1,470,941	BiN HERE... BiN THERE	(1) Waste management services and temporary container storage services. (2) Placing empty rubbish/garbage/recycling bins (also known as roll-off containers) at a residential, commercial or industrial location and thereafter removing the filled bin/container and disposing of the waste now contained within. (3) Placing empty storage bin at a residential, commercial or industrial location and thereafter removing the empty bin from said location or moving the bin and its contents to another location as required. (4) Placing empty rubbish/garbage/recycling bins (also known as roll-off containers) at a residential, commercial or industrial location and follow up with rubbish removal/ junk removal/ recycling clean up services and thereafter removing the filled bin/container and disposing of the waste now contained within.

Schedule "B"

Registration Number	**Trade-mark**	**Wares/Services**
TMA642,547	BIN THERE DUMP THAT	*Wares*: Garbage/recycling bins. *Services*: Dropping off an empty garbage/recycling bin at a residence and thereafter picking up the filled bin and disposing of the waste.

Other:

Trade-mark	**Wares/Services**
	*Wares*: Garbage/recycling bins. *Services*: Dropping off an empty garbage/recycling bin at a residence and thereafter picking up the filled bin and disposing of the waste.