



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

Citation: 2011 TMOB 47
Date of Decision: 2011-03-16

**IN THE MATTER OF AN OPPOSITION
by Artic Jungle Media to application
No. 1,305,926 for the trade-mark HTC
Smart Mobility and Design in the name of
HTC Corporation**

[1] On June 19, 2006, HTC Corporation (the Applicant), filed an application for the trade-mark HTC SMART MOBILITY and Design (the Mark), shown below, based upon proposed use of the Mark in Canada.



[2] The statement of wares currently reads:

Mobile phones; mobile phones with data transmission function; video phones; smart phones; personal digital assistants (PDA); PDAs with global positioning system (GPS); PDAs with wireless communication function; voice over internet protocol (VoIP) phones; camera phones; tablet computers; slim computers; ultra mobile personal computers (UMPC); headsets, headsets with wireless transmission function, synchronization cables, cradles, batteries, AC adaptors, chargers, cases for mobile phones, cases for PDAs, memory cards, in-car chargers for mobile phones or PDAs, in-car holders for mobile phones or PDAs.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of May 16, 2007.

[4] On July 25, 2007, Arctic Jungle Media (the Opponent) filed a statement of opposition against the application. The Opponent has pleaded four grounds of opposition pursuant to the *Trade-Marks Act* R.S.C. 1985, c. T-13 (the Act), which are summarized below:

1. the application does not comply with the provisions of s. 30(i) of the Act in that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada having regard to the Opponent's prior use of its trade-mark SMART MOBILITY, application No. 1,336,948;

2. the applied for mark is not registrable having regard to the provisions of s. 12(1)(d) of the Act in that it is confusing with the Opponent's trade-mark;

3. the applicant is not the person entitled to registration pursuant to s. 16(3)(a) of the Act, in that, at the filing date the trade-mark HTC SMART MOBILITY was confusing with the Opponent's trade-mark SMART MOBILITY that had previously been used in Canada by the Opponent.

4. the trade-mark HTC SMART MOBILITY is not and cannot be distinctive of the wares of the Applicant within the meaning of section 2 of the Act because at the date of the opposition, the trade-mark did not distinguish the wares and services of the Applicant from the wares and services of the Opponent.

[5] The Applicant filed and served a counter statement, in which it denied the Opponent's allegations.

[6] Neither the Applicant nor the Opponent filed any evidence.

[7] Both the Applicant and the Opponent filed a written argument. While an oral hearing was requested by both parties, an oral hearing was conducted at which only the Applicant was represented.

Onus

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (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.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

Section 16(3)(a) Ground of Opposition

[9] In order for the Opponent to meet its burden under the s. 16(3)(a) ground in particular, the Opponent must show evidence of use of its mark in Canada with its applied for wares or services prior to the Applicant's date of filing its application. In this regard, s. 16(3)(a) of the Act reads as follows:

(3) Any applicant who has filed an application in accordance with s. 30 for registration of a proposed trade-mark that is registrable is entitled, subject to sections 38 and 40, to secure its registration in respect of the wares or services specified in the application, *unless at the date of filing of the application* it was confusing with:

(a) a trade-mark that had been previously used in Canada or made known in Canada by any other person; (emphasis added).

[10] The Opponent has not evidenced any use or making known of its mark. In its written argument, the Opponent requested that I take judicial notice of various facts including, *inter alia*, "facts available on CIPO's Canadian trade-mark database". I interpret this to specifically mean the Opponent's trade-mark application No. 1,336,948, for the mark SMART MOBILITY pleaded in the statement of opposition. While I am prepared to exercise the Registrar's discretion to check the trade-marks register to confirm that the application was extant as of the Applicant's filing date [see *Royal Appliance Mfg. Co. v. Iona Appliances Inc.* (1990), 32 C.P.R. (3d) 525 (TMOB) at 529], I cannot accept as a fact that the Opponent's SMART MOBILITY mark has been used since the date claimed in the application (i.e. December 15, 2005). In this regard, I considered the comments of Member Herzig in *Dimo's Tool & Die Ltd. v. Quantum Electronics Inc.* (2009), 72 C.P.R. (4th) 209 wherein Mr. Herzig dealt with a similar situation as follows:

In particular, the opponent has not evidenced any use of its marks. At the oral hearing, counsel for the opponent requested that I take judicial notice of its two trade-mark applications for the marks MODEL 919 and 919 pleaded in the statement of opposition. I indicated that I would exercise the Registrar's discretion to check the trade-marks register

to confirm that the applications were extant: see *Royal Appliance Mfg. Co. v. Iona Appliances Inc.* (1990), 32 C.P.R. (3d) 525 (TMOB) at 529. However, counsel for the opponent also requested that I accept as fact that its marks MODEL 919 and 919 have been used in Canada since 1952 and 1977, respectively, as claimed in the opponent's trade-mark applications. I decline to do so because the Registrar's discretion does not extend so far. Rather, it is the responsibility of the opponent to establish that it has in fact used its marks and to establish the time period of such use. In other words, while the Registrar's discretion may be exercised to take cognizance of the filing of a trade-mark application to support a ground of opposition pursuant to Section 16(3)(b), the Registrar will not take cognizance, on the basis of the application, that a party has in fact been using the mark which is the subject of the application.

[11] I agree with Member Herzig that it is the responsibility of the Opponent to establish that it has in fact used or made known its mark and to establish the time period of such use or making known. I therefore do not consider that the Opponent has met its evidential burden under this ground and it is therefore dismissed.

Remaining Grounds of Opposition

[12] As the Opponent has not filed any evidence, it has not met its initial burden with respect to any of the remaining grounds of opposition either. In particular:

- the s. 30(i) ground fails because there is no evidence of bad faith on the part of the Applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155];
- the s. 12(1)(d) ground fails because the Opponent's mark is not a registered mark; and
- the distinctiveness ground fails because the Opponent has not shown that its trade-mark had become known to a sufficient extent in Canada prior to the filing date of the opposition to negate the distinctiveness of the Mark [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.); *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.)].

Disposition

[13] In view of the above, and pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Cindy R. Folz
Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office