

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

Citation: 2010 TMOB 85
Date of Decision: 2010-06-10

**IN THE MATTER OF AN OPPOSITION
by Réno-Dépôt Inc. against application
No. 1,318,429 for the trade-mark
RENOVA in the name of Albi Homes Ltd.**

[1] On September 29, 2006, Albi Homes Ltd. [the Applicant] filed an application to register the trade-mark RENOVA [the Mark] based on use in Canada in association with planning, designing, estimating and completing interior and exterior repairs, remodelling, improvements and/or renovations for residential housing [the Services] since at least as early as January 31, 2003.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of June 13, 2007.

[3] On August 13, 2007, Réno-Dépôt Inc. [the Opponent] filed a statement of opposition. On October 30, 2007, the Opponent was granted leave to file an amended statement of opposition to correct some clerical errors. The grounds of opposition can be summarized as follows:

1. The application does not comply with the requirements of s. 30 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 [the Act] since at the filing date of the application (a) the Applicant had not used the Mark in association with the Services from the date claimed in the application; (b) the mark which the Applicant claims to have used is not the Mark; (c) alternatively, or cumulatively, the alleged use of the Mark in association with the Services has been discontinued in whole or in part; and (d) the statement that the

Applicant was satisfied as to its entitlement to the use of the Mark was false in view of the content of the statement of opposition.

2. The Mark is not registrable pursuant to s. 12(1)(d) of the Act because it is confusing with 11 registered trade-marks set out in Schedule A to the statement of opposition.
3. The Applicant is not the person entitled to registration of the Mark since, contrary to the provisions of s. 16(1)(a) of the Act, at the claimed date of first use, as well as at any other material time, the Mark was confusing with one or more of the Opponent's marks as set out in Schedule A to the statement of opposition, all of which were previously used or made known in Canada by the Opponent or its licensee or predecessor in title, in association with the wares, services and business of hardware, decoration and construction materials and accessories, including the sale and installation of products in the nature of hardware, renovation and decoration; providing advice to customers on matters related to hardware, renovation and decoration, including, for example providing advice on planning the construction of residential houses, planning interior home renovations (e.g. kitchen, bathroom, basements), planning exterior home renovations (e.g. shed, terrace, fence, garage, patio); and all products and services mentioned in the registration particulars attached as Schedule A to the statement of opposition.
4. The Applicant is not the person entitled to registration of the Mark since, contrary to the provisions of s. 16(1)(c) of the Act, at the claimed date of first use and at any material date, the Mark was confusing with the following trade names: RÉNO DÉPÔT INC., RENO-DEPOT, RÉNODÉPÔT INC., RENODEPOT, RÉNO DÉPÔT, RENO DEPOT which were all previously used in Canada by the Opponent or its licensee or predecessor in title, in association with the wares, services and business of hardware, decoration and construction materials and accessories, including the sale and installation of products in the nature of hardware, renovation and decoration; providing advice to customers on matters related to hardware, renovation and decoration, including, for example providing advice on planning the construction of residential houses, planning interior home renovations (e.g. kitchen, bathroom, basements), planning exterior home renovations (e.g. shed, terrace, fence, garage, patio); and all products and services mentioned in the registration particulars attached as Schedule A to the statement of opposition.

5. The Applicant is not the person entitled to registration of the Mark since, contrary to the introductory paragraph of s. 16(1) of the Act, (a) the application does not comply with the requirements of s. 30 of the Act; (b) the Mark is not a used one but rather a proposed one or one for which the use, if any, has been discontinued; and (c) the Mark is not registrable or does not function as a trade-mark.
6. The Mark is not distinctive and is not adapted to distinguish the Services from the wares or services of the Opponent in light of the contents of the statement of opposition; and the Mark was used by third parties outside the scope of licensed use provided for by s. 50 of the Act.

[4] Although the statement of opposition incorrectly identifies the claimed date of first use of the Mark as July 1, 2006 for the purposes of the grounds of opposition based on s. 16(1)(a) and (c) of the Act, they remain valid grounds of opposition.

[5] The Applicant filed and served a counter statement in which it denies the Opponent's allegations and puts the Opponent to the strict proof thereof.

[6] The Opponent did not file any evidence in support of its opposition.

[7] In support of its application, the Applicant filed an affidavit of Ryan B. Atkins, sworn October 17, 2008 with Exhibits A through C and certified copies of the file histories from the Canadian Intellectual Property Office (CIPO) for each of application No. 1,318,429 (RENOVA), application No. 1,318,428 (ALBI RENOVA) and application No. 1,318,285 (ALBI RENOVA & DESIGN, shown below).



[8] Only the Applicant filed a written argument. Neither party requested an oral hearing.

Applicant's Evidence

Ryan B. Atkins

[9] Mr. Atkins is the Applicant's General Legal Counsel and Chief Financial Officer. In his affidavit, Mr. Atkins states that the Applicant has used the Mark in Canada continuously since at least as early as January 31, 2003 in association with the Services.

[10] Mr. Atkins attaches documents to his affidavit which he purports evidence use of the Mark in association with the Services. Mr. Atkins also files representative specimens of advertising for the Services. The specimens of use and advertising will be discussed in further detail below in the assessment of the s. 30(b) ground of opposition.

[11] In paragraphs five to seven and nine through ten of his affidavit, Mr. Atkins expresses his opinions on various substantive issues relating to the opposition proceeding. The merit of the opposition is the issue to be decided by the Registrar from the evidence filed in the present proceeding and accordingly, the affiant's opinions on these matters will not be considered [see *British Drug Houses Ltd. v. Battle Pharmaceuticals* (1944), 4 C.P.R. 48 at 53 and *Les Marchands Deco Inc. v. Society Chimique Laurentide Inc.* (1984), 2 C.P.R. (3d) 25 (T.M.O.B.)].

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[12] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is 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 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Section 30 Grounds

[13] The material date for considering grounds of opposition based on s. 30 of the Act is the date the application was filed [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475 and *Tower Conference Management Co. v. Canadian Exhibition Management Inc.* (1990), 28 C.P.R. (3d) 428 at 432 (T.M.O.B.)], namely September 29, 2006.

Section 30(b) Ground

[14] The Opponent did not file any evidence in support of this ground of opposition. The Opponent may, however, rely on the Applicant's evidence to meet its initial burden [see *Molson Canada v. Anheuser-Busch Inc.*, (2003), 29 C.P.R. (4th) 315 (F.C.T.D.), and *York Barbell Holdings Ltd. v. ICON Health and Fitness, Inc.* (2001), 13 C.P.R. (4th) 156 (T.M.O.B.)] in relation to this ground, however, it is under an obligation to show that the Applicant's evidence is "clearly inconsistent" with the Applicant's claims set forth in its application [see *Ivy Lea Shirt Co. v. 1227624 Ontario Ltd.* (1999), 2 C.P.R. (4th) 562 at 565-6 (T.M.O.B.), aff'd 11 C.P.R. (4th) 489 (F.C.T.D.)].

[15] None of the documents introduced by the Atkins affidavit as specimens of use of the Mark displays the word "renova" by itself.

[16] The documents set out below feature the word "Renova" in association with the word "Albi" without highlighting the word "Renova" in any way:

- Press release dated January 31, 2003 advertising the Applicant's new renovation, repair and remodelling services under a new name: ALBI RENOVA.
- Article published in the New Homes Section of the *Calgary Herald* newspaper dated February 15, 2003.
- Joist Framing Plan for a renovation dated October 2, 2002.
- Change to Renovation Project Description dated December 2003.
- City of Calgary Development Completion Permit (the Applicant is listed as agent) dated March 2004.

[17] I find that these documents do not evidence use of the Mark. If I am incorrect in this finding, only the Change to Renovation Project Description dated December 2003 amounts to use of the Mark as defined by s. 4(2) of the Act. At best, the remaining documents feature trade name use of "Albi Renova".

[18] I find that instances of the word “Renova” being featured as part of the following do not constitute use of the Mark but rather are use of the ALBI RENOVA & Design mark which is the subject of application No. 1,318,285:



[19] Some documents and advertising specimens feature the word “Renova” as part of the following:



Here, the word “Renova” is highlighted, in a different font with a large stylised “R”, separate and apart from the word “Albi” with the words on top of one another as opposed to side by side. As a result, I consider that the following documents and advertising specimens featuring the word Renova in this form constitute evidence of use of the Mark within the meaning of s. 4(2) of the Act as of the material date [see *Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535, *Munsingwear Inc. v. Promafil Canada Ltd.* (1984), 44 C.P.R. (3d) 59 (F.C.A.), and *Playboy Enterprises Inc. v. Germain* (1978), 39 C.P.R. (2d) 32 (F.C.T.D.)]:

- Renovation Project Descriptions, Selection Sheets, Contract Agreements and associated project documentation including invoices dated February 2003, April 2003, June 2003, July 2003 and September 2003.
- Renovation Project Description and Contract Agreement dated November 2003.
- Advertisements in *Calgary Renovations Home Improvement and Design* Magazine dated Summer 2004, Winter 2004 and Winter 2005.

[20] The fact that the Atkins affidavit does not provide specimens of use of the word “Renova” on its own is not fatal. On a fair reading of Mr. Atkins’ affidavit as a whole, I am satisfied that the evidence adduced therein is not clearly inconsistent with the Applicant’s claimed date of first use for the Mark. In his affidavit, Mr. Atkins attests to the use of the Mark since the date claimed in the application and provides specimens of use and advertisement which I have accepted as showing use of the Mark. Given that the Applicant is not under a burden to

prove continuous use of the Mark since the date claimed in the application, I find that the Opponent has not met its burden to show that the Applicant's evidence is clearly inconsistent with the claimed date of first use, namely, January 31, 2003.

[21] The Opponent has failed to meet its initial evidential burden and accordingly, the s. 30(b) ground is dismissed.

Section 30(i) Ground

[22] The requirement under s. 30(i) of the Act is to include, in the application, a statement that the applicant is satisfied that it is entitled to use the mark in Canada in association with the services. The Applicant provided such a statement in its application.


[23] Where the relevant statement is provided, a s. 30(i) ground of opposition should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of the Applicant [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 at 155 (T.M.O.B.)].

[24] As this is not such an exceptional case as there is no evidence of bad faith, I am dismissing this ground of opposition.

Section 12(1)(d) Ground of Opposition

[25] The material date for assessing confusion pursuant to s. 12(1)(d) of the Act is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

[26] Pursuant to s. 12(1)(d) of the Act, the Opponent has pleaded that the Mark is not registrable because the Mark is confusing with the following registered trade-marks:

Trade-mark	Registration No.
RENO DEPOT	TMA527,493
	TMA550,695

	TMA550,696
RENO-DEPOT	TMA428,486
	TMA439,001
RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION	TMA452,238
	TMA522,617
RÉNO-DÉPÔT LE PREMIER ENTREPÔT DE LA RÉNOVATION	TMA430,926
RENODEPOT	TMA527,494
RENODEPOT.COM	TMA601,880
WWW.RENODEPOT.COM	TMA601,878

Unless indicated otherwise, I will hereafter collectively refer to these registered trade-marks alleged in the statement of opposition as the “Cited Marks”.

[27] I have considered it appropriate in this case to exercise the Registrar’s discretion to check the Register to determine whether the Cited Marks are in good standing as of today’s date [see *Quaker Oats Co. of Canada Ltd. / La Compagnie Quaker Oats du Canada Ltée. v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 at 411 (T.M.O.B.)]. Since the Opponent has discharged its initial burden with respect to this ground of opposition, the burden of proof lies on the Applicant to convince the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Cited Marks.

[28] 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.

[29] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in 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 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 in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.)]

[30] Prior to assessing the surrounding circumstances of this case, I will first address two general submissions made by the Applicant in its written argument.

[31] The Applicant submits an argument based on the state of the register with respect to the element “depot”, arguing that the word “depot” appears in more than 252 pending or registered marks on the register. No evidence supporting this claim was filed. In opposition proceedings, the Registrar does not exercise her discretion to have regard to anything appearing on the register that is not properly proved by evidence, except to verify whether properly pleaded trade-mark registrations and applications are extant, as I have done in this case. Without evidence, I am unable to make a determination on this submission.

[32] The Applicant has also submitted that the fact that the Cited Marks were not raised as objections to the registrability of the Mark at the examination stage is proof that there is no likelihood of confusion between the Mark and the Cited Marks. This argument is of no assistance to the Applicant’s case. A decision by an Examiner does not have precedential value for the Board because both the onus and evidence before an Examiner differs from that before the Board [see *Thomas J. Lipton Inc. v. Boyd Coffee Co.* (1991), 40 C.P.R. (3d) 272 (T.M.O.B.) at 277 and *Procter & Gamble Inc. v. Morlee Corp.* (1993), 48 C.P.R. (3d) 377 (T.M.O.B.) at 386].

6(5)(a) – *the inherent distinctiveness of the trade-marks and the extent to which they have become known*

[33] The Applicant has conceded that “reno” is a well-known shortened form for the word “renovation”. Furthermore, I am aware that the word “renova” is essentially the simple past conjugation of the verb “rénover” (to renovate) in French. The Mark is suggestive of the Services and as a result I find that the Mark possesses little inherent distinctiveness.

[34] The Applicant’s evidence does not allow me to determine the extent to which the Mark has become known. Specifically, the Atkins affidavit does not include sales figures or advertising expenditures. Furthermore, we have no evidence of circulation figures for the advertisements adduced as exhibits, or any other evidence which would provide insight into the extent to which the Mark has become known in the Canadian marketplace.





[35] The Applicant submits that the Cited Marks possess little inherent distinctiveness because a significant part of each is suggestive of the Opponent’s services. Specifically, the Applicant submits that “reno” is a well-known shortened form for “renovation” and “depot” is a dictionary word which means “place”, “warehouse” or “repository”. However, while “réno” (reno) may be suggestive of “rénovation” (renovation) and “dépôt” (depot) is a word of the ordinary language, the coined word “réno- dépôt” (reno-depot) does add some measure of inherent distinctiveness to the Cited Marks.

[36] The Opponent has filed no evidence. Under these circumstances, the mere existence of the registrations can establish no more than *de minimus* use and cannot give rise to an inference of significant and continuous use of the Cited Marks [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.)]. As such, I am unable to determine the extent to which the Cited Marks have become known.

6(5)(b) – *the length of time each has been in use*

[37] The application claims use of the Mark since at least as early as January 31, 2003. The earliest specimen of use of the Mark attached to the Atkins affidavit is dated February 2003.

[38] The Cited Marks claim the following first use dates:

Trade-mark	Registration No.	First Use Date
RENO DEPOT	TMA527,493	At least as early as May 3, 1994
	TMA550,695	At least as early as October 30, 1999
	TMA550,696	At least as early as October 30, 1999
RENO-DEPOT	TMA428,486	Declaration of use filed May 3, 1994
	TMA439,001	Declaration of use filed May 20, 1994
RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION	TMA452,238	At least as early as March 16, 1993
	TMA522,617	At least as early as March 16, 1993
RÉNO-DÉPÔT LE PREMIER ENTREPÔT DE LA RÉNOVATION	TMA430,926	Declaration of use filed June 2, 1994
RENODEPOT	TMA527,494	At least as early as May 3, 1994
RENODEPOT.COM	TMA601,880	At least as early as April 27, 1997
WWW.RENODEPOT.COM	TMA601,878	At least as early as April 27, 1997

[39] As previously noted, the mere existence of the registrations can establish no more than *de minimus* use and cannot give rise to an inference of significant and continuous use of the Cited Marks.

6(5)(c) – *the nature of the services*

[40] It is the Applicant's statement of services as defined in its application versus the Opponent's registered wares and services that govern my determination of this factor [see *Esprit International v. Alcohol Countermeasure Systems Corp.* (1997), 84 C.P.R. (3d) 89].

[41] The Applicant applied to register the Mark for “planning, designing, estimating and completing interior and exterior repairs, remodelling, improvements and/or renovations for residential housing”. The registrations for the Cited Marks cover various wares and services, however, I will analyse only the services I consider most relevant to the Services.

[42] With the exception of RENODEPOT.COM (TMA601,880) and WWW.HOMEDEPOT.COM (TMA601,878), the registered statements of services all feature services of the following nature, which I find to be most relevant to the determination of this factor under s. 6(5)(c) of the Act:

operation, promotion and management of stores specializing in the wholesale and retail sale of hardware, materials and accessories for construction, renovation and decoration, domestic and household appliances, articles and accessories for gardening, furniture, paint, varnish and solvents;

sale and installation of hardware products and products for renovation and decoration;

advice related to hardware, renovation and decoration;

[43] Of the Opponent’s services set out above, those most similar to the Services are the installation of products for renovation and the provision of advice related to renovation. To the extent that the Mark and the Cited Marks are associated with renovation services, there is some overlap in the nature of the services.

[44] The services associated with RENODEPOT.COM (TMA601,880) and WWW.HOMEDEPOT.COM (TMA601,878) relate to the operation of a website dealing with the sale of hardware items, materials and accessories for building, renovation and decoration and the posting of advice in relation to hardware, renovation and decoration. These website services are similar to the Services but only insofar as they relate to renovation.

s. 6(5)(d) – the nature of the trade

[45] With respect to the first and third categories of the Opponent’s services as set out above in paragraph 42, the Applicant submits that the Opponent’s trade involves the operation of stores selling products for, and offering advice to customers (“do-it-yourselfers”) regarding, renovation

and construction activities which the customers intend to carry out themselves. In the absence of evidence from the Opponent and based on a fair reading of the registered statements of services, I agree with the Applicant's submission.

[46] The Applicant submits that, by contrast, its trade involves the provision of repair and renovation services which are planned, managed and conducted by the Applicant's employees without participation from the customers aside from minor involvement in the early planning stages of projects. I agree.

[47] Of the Opponent's services, those which are most similar to the Services are the "sale and installation of ... products for renovation...". There is some overlap between the Opponent's "sale and installation of ... products for renovation..." services and the Services. The Opponent has not provided any evidence of the nature of the trade associated with its services. In other words, it is not clear whether the "sale and installation of ... products for renovation..." services are merely incidental to the Opponent's wholesale and retail store trade, which I have accepted is of a different nature than the Applicant's trade, or whether they are offered independently from the wholesale and retail store services. In light of the fact that the Opponent's "sale and installation of ... products for renovation..." services are not identical to the Services and in the absence of evidence regarding the nature of the Opponent's trade, I am not prepared to infer a direct overlap in the parties' channels of trade.

[48] Notwithstanding any possible overlap in the nature of the services or channels of trade, the Applicant submits that its services are expensive and that given that they involve customers inviting strangers into their homes to carry out renovations, they are such that customers will likely devote a considerable amount of attention to researching the service providers, which decreases the likelihood of confusion between the Mark and the Cited Marks. My review of the Atkins affidavit reveals sample contracts between the Applicant and its customers which demonstrate fees for the Services in the range of \$30,000 to \$256,000. I agree with the Applicant's submissions that where services are expensive and purchased only after careful consideration, confusion will be less likely [see *General Motors Corp. v. Bellows* (1949), 10

CPR 101 at 116-117 and *United Artists Corp. v. Pink Panther Beauty Corp.* (1998), 80 C.P.R. (3d) 247 (F.C.A.).

6(5)(e) – the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[49] In most instances, the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2) 145, conf. 60 C.P.R. (2d) 70 (F.C.T.D.)].

[50] As a preliminary matter, I note that I do not find that there is any distinguishable difference between the English and French versions of the RENO-DEPOT (RÉNO-DÉPÔT) element of the Cited Marks.

[51] However, when assessing confusion it is not proper to dissect trade-marks into their component parts, rather, marks must be considered in their entirety [see *British Drug Houses Ltd. v. Battle Pharmaceuticals*, [1944] Ex. C.R. 239, at 251, affirmed [1946] S.C.R. 50 and *United States Polo Assn. v. Polo Ralph Lauren Corp.* (2000), 9 C.P.R. (4th) 51 at para 18, aff'd [2000] F.C.J. No. 1472 (C.A.)]. Furthermore, confusion will be unlikely in situations where marks share common features but also feature dominant differences [see *Foodcorp Ltd. v. Chalet Bar B Q (Canada) Inc.* (1982), 66 C.P.R. (2d) 56 at 73 (F.C.A.)]. On this basis, the mere fact that the Mark and the Cited Marks share a common element (RENO) is not determinative.

[52] Ultimately, when considering the marks as a whole, I am not convinced that the mere fact that the Mark contains the suggestive RENO element is sufficient to find that the Mark shares any significant degree of similarity in either appearance or sound with the Cited Marks. The word RENOVA is significantly different in terms of sound and appearance from the Cited Marks, all of which feature the dominant RENO-DEPOT element. Furthermore, some of the Cited Marks feature design elements which serve to further distinguish them from the Mark (TMA550,695; TMA550,696).

[53] The idea suggested by the Mark is renovation. The Cited Marks all feature the RENO-DEPOT element which suggests the idea of a renovation warehouse. Some of the Cited Marks (TMA452,238; TMA522,617; TMA430,926) also include the word RÉNOVATION which further strengthens the “renovation” idea.

[54] Based on the foregoing, I conclude that the important differences between the Mark and the Cited Marks in terms of sound and appearance are significant enough to outweigh any similarities in terms of the ideas suggested.

Conclusion re s. 12(1)(d)

[55] Having considered all of the surrounding circumstances, in particular the length of time the trade-marks have been in use, the nature of the trade and the differences between the trade-marks in sound and in appearance, I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and any of the Cited Marks.

[56] Having regard to the foregoing, I dismiss the ground of opposition based on s. 12(1)(d) of the Act.

Entitlement Grounds of Opposition

[57] The material date for considering the entitlement grounds of opposition is the Applicant’s claimed date of first use, namely, January 31, 2003 [see s. 16(1) of the Act].

[58] Despite the burden of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent’s trade-marks or trade names, the Opponent has the initial onus of proving that the trade-marks and trade names alleged in support of its grounds of opposition based on s. 16(1)(a) and 16(1)(c) of the Act were being used at the Applicant’s claimed date of first use and had not been abandoned at the date of advertisement of the application [s. 16(5) of the Act].

Section 16(1)(a) of the Act

[59] The Opponent has based the ground of opposition under s. 16(1)(a) of the Act on the same registered trade-marks alleged in support of the s. 12(1)(d) registrability ground of opposition, namely, the Cited Marks.

[60] As I have previously noted, the Opponent did not adduce any evidence of use of the Cited Marks. Accordingly, the Opponent has not discharged its burden of showing prior use of any of the Cited Marks and I dismiss the ground of opposition based on s. 16(1)(a) of the Act.

Section 16(1)(c) of the Act

[61] Since the Opponent has not filed any evidence, I find that it did not discharge its burden of showing prior use of any of its alleged trade names, namely, RÉNO DÉPÔT INC., RENO-DEPOT, RÉNODÉPÔT INC., RENODEPOT, RÉNO DÉPÔT, RENO DEPOT. Accordingly, I dismiss the ground of opposition based upon s. 16(1)(c) of the Act.

Introductory Paragraph of Section 16(1) of the Act

[62] The Opponent alleges that the Applicant is not entitled to registration of the Mark since, contrary to the introductory paragraph of s. 16(1) of the Act, (a) the application does not comply with the requirements of s. 30 of the Act; (b) the Mark is not a used one but rather a proposed one; (c) the Mark is not registrable or does not function as a trade-mark.

[63] The introductory paragraph of s. 16(1) of the Act does not form the basis of a ground of opposition as defined in s. 38(2) of the Act since s. 16(1) of the Act as a whole relates to the entitlement ground of opposition. Accordingly, I dismiss this ground of opposition based solely upon the introductory paragraph of s. 16(1) of the Act.

Distinctiveness Ground of Opposition

[64] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its wares 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.)], there is an initial evidential burden on the Opponent to establish the facts relied

upon in support of the ground of non-distinctiveness. The material date for assessing distinctiveness is the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

[65] The Opponent appears to have pleaded the non-distinctiveness ground of opposition as a two-pronged ground of opposition with the first prong relating to the Opponent's trade-mark rights, the second prong relating to un-licensed use of the Mark. The Opponent has not alleged any facts supporting the second prong of this ground of opposition and as such I find that it has not met its burden and I reject it accordingly.

[66] With respect to the first prong of the ground, pursuant to its evidential burden, the Opponent is under an obligation to show that, as of the filing of the statement of opposition, the Cited Marks had become known sufficiently to negate the distinctiveness of the Mark [see *Bojangles' International, LLC v. Bojangles Café Ltd.* (2004), 40 C.P.R. (4th) 553, affirmed (2006), 48 C.P.R. (4th) 427 (F.C.T.D.)]. The Opponent has not filed any evidence to support this ground of opposition. I therefore dismiss the first prong of the ground of opposition based upon non-distinctiveness.

[67] Based on the foregoing, I reject the non-distinctiveness ground of opposition in its entirety.

Disposition

[68] 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.

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office