



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

Citation: 2013 TMOB 70
Date of Decision: 2013-04-25

**IN THE MATTER OF AN
OPPOSITION by Starwood Group
Inc. to application No. 1,389,023
for the trade-mark SOHO HOUSE
in the name of Soho House Limited**

FILE RECORD

[1] On March 27, 2008, Soho House Limited filed an application to register the trade-mark SOHO HOUSE based on (1) proposed use of the mark in Canada and (2) use and registration of the mark in the United Kingdom, for the following services:

restaurant, bar, cafe and catering services; provision of temporary accommodation.

[2] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated June 24, 2009 and was opposed by Starwood Group Inc. (“Starwood”) on November 24, 2009. The Registrar forwarded a copy of the statement of opposition to the applicant on December 24, 2009 as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[3] The opponent’s evidence consists of the affidavits of Bruce Greenberg and Kathryn Stewart-Tiralongo as well as certified copies of trade-mark registrations the opponent relies on in the statement of opposition. Mr. Greenberg was cross-examined on

his affidavit. The transcript of his cross-examination, exhibits thereto, and replies to undertakings and questions taken under advisement form part of the evidence of record.

[4] The applicant's evidence consists of the affidavits of Dane Penney and Peter Woods; certified copies of two trade-mark registrations, both for SOHO GRAND HOTEL; and certified copies of the file histories of the opponent's abandoned trade-mark applications for SOHO METROPOLITAN HOTEL and SOHO METROPOLITAN HOTEL & CONDOMINIUM & Design.

[5] The opponent requested, and was granted, leave to file additional evidence pursuant to Section 44 of the *Trade-marks Regulations*: see the Board ruling dated November 22, 2011. The evidence consists of essentially similar affidavits of the following individuals: Heather Berti; Lanfranco Gualandi; Irene Reilly; Anjanette Hayes; Gavin Jimenez; Melissa Heslop; Oxana Ni; Kathleen Cheung.

[6] Both parties filed a written argument and both were represented by counsel at an oral hearing held on March 21, 2013.

STATEMENT OF OPPOSITION

[7] The opponent is relying on a number of its trade-marks, some registered and some not, and other marks used under a cross-licensing agreement with a third party, to support various grounds of opposition. It is therefore necessary to summarize the grounds of opposition in some detail to clearly indicate which marks are being relied on to support a particular ground of opposition: see also paragraph 25, below, for the applicant's grouping of the marks relied on by the opponent.

Grounds of Opposition Pleaded

1. *Section 30(i)*

[8] The first ground alleges that the application does not comply with the provisions of s.30(i) in that the applicant could not have been satisfied that it was, at the date of filing the application, entitled to use the mark SOHO HOUSE. In this regard, the applicant was or should have been aware of the opponent's SOHO family of trade-marks including:

SOHO BAYVIEW,

SOHO LOFTS AT 188 EGLINTON,
SOHO CONDOMINIUMS AT STARWOOD CENTRE,
SOHO PARKWAY LUXURY CONDOMINIUMS,
SOHO RESIDENCES,
SOHO LISGAR LUXURY CONDOMINIUMS and
SOHO CHAMPAGNE LUXURY CONDOMINIUMS,
which marks were previously used in Canada in association with luxury condominium
and hotel developments; luxury condominiums with hotel services and the like;
and with the opponent's trade-marks

SOHO LOFT CONDOMINIUMS,
SOHO CONDOS and
SOHO LOFT CONDOS
which marks were previously used in Canada in association with residential and hotel
developments offering hotel services and hotel management and the like. The opponent
refers collectively to its above-mentioned marks as its “SOHO-formative marks” and I
will do the same.

2. *Section 12(1)(d)*

[9] The second ground alleges that the mark SOHO HOUSE is not registrable,
pursuant to s.12(1)(d), because it is confusing with opponent's marks:

SOHO LOFT CONDOMINIUMS, registered under No. TMA 490,017 on
February 16, 1998;

SOHO CONDOS, registered under No. TMA 492,915 on April 15, 1998; and

SOHO LOFT CONDOS registered under No. TMA 496,299 on June 17, 1998.

I have noted that each of the opponent's registered marks is for use in association with
“real estate services for the sale of residential dwelling units” rather than for the various
uses pleaded by the opponent in the first ground of opposition, above.

3. *Section 16*

[10] The third ground, based on s.16 of the *Act*, alleges that the applicant is not entitled
to register the mark SOHO HOUSE because, at the date of filing the application, the
mark SOHO HOUSE was confusing with:

3.1 the opponent's SOHO-formative marks that had been previously used and
made known in Canada by the opponent,

3.2 the opponent's trade-marks SOHO LOFT CONDOMINIUMS, SOHO CONDOS and SOHO LOFT CONDOS in respect of which applications for registration had been previously filed in Canada by the opponent,

3.3 the opponent's SOHO-formative marks that had been previously used in Canada as trade-names by the opponent.

4. *Distinctiveness*

[11] The fourth ground alleges that the mark SOHO HOUSE is not distinctive, within the meaning of s.2, because the mark does not actually distinguish the applicant's services from the wares and services of others, namely,

4.1 the opponent's services offered in association with the opponent's SOHO-formative trade-marks; and

4.2 residential and hotel developments offering hotel services and hotel management in the promotion and sale of residential dwelling units offered in association with the following trade-marks used under cross-licence by the opponent and Liverton Hotels International Inc.:

SOHO MET HOTEL,
SOHO METROPOLITAN HOTEL,
SOHO METROPOLITAN HOTEL & RESIDENCES, and
SOHO METROPOLITAN HOTEL & CONDOMINIUMS.

OPPONENT'S EVIDENCE

Bruce Greenberg – affidavit testimony

[12] Mr. Greenberg identifies himself as President of the opponent company. His affidavit testimony, often stated in imprecise and/or broad generalities, is summarized below.

[13] The opponent has since 1993 been in the business of developing, operating and managing residential, commercial and retail properties. About 65% of the opponent's developments, in terms of market value, relate to its SOHO branded luxury hotels, condominiums and residences. This represents a market value of \$250 million. The opponent owns and manages some of Toronto's finest hotels, including The Soho Metropolitan Hotel.

[14] During the 1990s and early 2000s, the opponent converted several office buildings in Toronto to residential condominiums, including the Soho Lofts at Starwood

Centre (mixed commercial and residential), SoHo Lofts at 188 Eglinton (88 residential condominiums) and SoHo Bayview (40 condominiums).

[15] The opponent's Soho Metropolitan Hotel and Condominiums (the Soho Met) in Toronto is an example of a mixed use luxury hotel and condo development. It was completed in 2003 in conjunction with Liverton Hotels International. It is a \$125 million, 450,000 square foot building comprised of an 88 suite luxury hotel and 396 residential condos including 55 extended stay suites.

[16] As of the date of Mr. Greenberg's affidavit, the opponent was developing the Soho Parkway, a 16-storey building in Ottawa featuring 104 condominium suites and hotel concierge services. The opponent had also developed the SoHo Lisgar, a 12-storey condo building in Ottawa and begun a third development, the SoHo Champagne, a two tower condo complex with 330 units plus 11 townhouses. The projected selling value for the SoHo Champagne is over \$100 million. The opponent operates under its business name Mastercraft Starwood in the area of Ottawa.

[17] The SoHo Met contains two restaurants which are open for breakfast, lunch and dinner. The restaurants serve about 30,000 guests annually within the restaurant and about 15,000 guests via room service.

[18] Annual gross revenues for the opponent's properties operating under its SOHO-formative marks have been in excess of \$8 million annually for each of the years 2007 to 2009. The revenues from the opponent's SoHo-formative condominiums were in excess of \$200 million from 1993 – 2010.

[19] Mr. Greenberg notes that as a result of solicited and unsolicited publicity, the public, particularly in Toronto and Ottawa, has come to associate "SoHo" with the opponent's luxury hotels, condominiums and residences providing hotel services. Attached as Exhibit D attached to his affidavit are examples of favourable publicity that the opponent's SoHo-formative properties have received in various publications, including the *National Post*, the *Toronto Star*, *The Globe and Mail* and the *Ottawa Citizen*, over the period 2001 to 2010.

[20] In the four year period 2006 – 2009, the opponent expended in excess of \$600,000 annually to promote the following developments: Soho Met ; SoHo Lofts at 188 Englington; SoHo Bayview SoHo Parkway; and SoHo Lisgar. Attached as Exhibit G to Mr. Greenberg’s affidavit are advertisements in various Canadian newspapers and magazines, in the period 1996 – 2010, an example of which is shown below:



The opponent also promotes its SoHo-formative properties on its websites.

Bruce Greenberg – cross-examination testimony

[21] Some salient facts elicited at Mr. Greenberg’s cross-examination are summarized below.

[22] As of April 8, 2011 (the date of cross-examination), the only hotel “operated by the opponent” was the SoHo Metropolitan Hotel in Toronto. The hotel is in fact operated by the opponent in partnership with Liverton Hotels International Inc. (“Liverton”). The partnership which operates the hotel, SoHo Met Hotel Limited Partnership, is licensed to use the following trade-marks owned by the opponent pursuant to a license agreement dated November 10, 2006: SOHO LOFT CONDONIMIUMS; SOHO LOFT CONDOS; and SOHO CONDOS. The partnership is not licensed to use any other marks owned by the opponent. The opponent’s principal business is as a real estate developer (see p. 65 of the transcript) although the opponent provides guidance with respect to marketing campaigns and advertising for the hotel and “everything to do with the brand, Soho” see p. 38 of the transcript.

[23] The opponent filed a trade-mark application (No. 1,094,970) for the mark SOHO METROPOLITAN HOTEL on March 6, 2001. That application was opposed by Liverton

on August 24, 2004 because Liverton “wanted a license agreement:” see p.70 of the transcript. The application was abandoned on November 11, 2006 as “part of the deal with Liverton,” that is, to conclude the above mentioned license agreement dated November 10, 2006: see pp. 70-71 of the transcript. It is the cross-licensing agreement referred to in part 4.2 of the fourth ground of opposition: see paragraph 11, above.

[24] Mr. Greenberg’s transcript of cross-examination provides various other details about the opponent’s activities that are either not mentioned, or glossed over, in his affidavit. His testimony on cross-examination provides a decidedly different narrative of the opponent’s activities than what may be inferred from his affidavit. A fair synopsis of the opponent’s activities, based mostly on Mr. Greenberg’s testimony at cross-examination, is set out in paragraphs 3-6 of the applicant’s written argument, which I have summarized below:

The opponent is a real estate development and construction company that has built several condominiums in Toronto. The evidence does not show that the opponent has any involvement in the condominiums after the units were sold and the condominium corporations were created.

After building the condominiums, Starwood [the opponent] decided to develop and construct a property that would combine a luxury condominium with a hotel - the SoHo Metropolitan Hotel & Condominiums. The opponent and Liverton, which carries on business as Metropolitan Hotels, entered into a business arrangement whereby the opponent constructed and developed the SoHo Metropolitan Hotel & Condominiums, which Liverton marketed and promoted and then managed. Liverton uses the SOHO MET and SOHO METROPOLITAN trade-marks in association those services. The evidence does not show that the opponent has any ongoing involvement in the property.

The opponent next developed three luxury condominium projects in Ottawa, advertising that these condominiums will feature hotel amenities provided by Liverton similar to those offered at the Toronto property.

[25] The applicant, at paragraph 7 of its written argument, shown below, groups the marks relied on by the opponent into three main categories:

In this opposition, Starwood [the opponent] is attempting to rely on

(a) Starwood's use of SOHO-formative marks with condominiums and real estate services,

(b) Liverton's use of the SOHO MET and SOHO METROPOLITAN trade-marks in connection with the SoHo Met Hotel & Condominium in Toronto,

(c) Starwood's intention to use, and its advertising of SOHO-formative marks, with not-yet-completed condominiums that will feature hotel amenities provided by Liverton,

in order to stop the applicant, Soho House, from registering its name in Canada as a trade-mark in association with services relating to the provision of food, drink and temporary accommodation . . .

Kathryn Stewart-Tiralongo

[26] Ms. Tiralongo identifies herself as a technical consultant employed by the firm representing the opponent. On June 4, 2010, she conducted a computer search of the United States Patent and Trademark Office to locate active trade-mark registrations and pending applications owned by the applicant Soho House Limited. The results of her search are attached as Exhibit A to her affidavit. From my review of Exhibit A, I note that five marks were located namely, (1) the registered mark CECCONI'S, for catering services, (2) a pending design mark consisting of a wavy line in a rectangle, for real estate services, (3) the pending mark SOHO BEACH HOUSE, for real estate and ancillary services, (4) the registered mark SOHO HOUSE, for essentially the same services as in the subject Canadian application, (5) the registered mark SOHO HOUSE providing social club services which services are essentially the same as those specified in the subject Canadian application.

[27] Attached as Exhibit B is a business names report for "Mastercraft Starwood" from the records of the Ontario Ministry of Consumer and Commercial Relations database. I note that Mastercraft Starwood is a business name of the opponent herein.

APPLICANT'S EVIDENCE

Peter Woods

[28] Mr. Woods identifies himself as a student-at-law employed by the firm representing the applicant. His affidavit is intended to introduce into evidence, by way of

Exhibits A to K, summarized below, printouts of web pages from the Internet produced between April 4 and April 11, 2011.

Exhibit A

SOHO HOUSE NEW YORK is a private member's club and hotel in Manhattan.

Exhibit B

SOHOGRANDHOTEL is a hotel located on West Broadway Street in New York City.

Exhibit C

SOHO HOUSE is an exclusive, private night club in Toronto frequented by celebrities and people well known in the movie industry.

Exhibit D

SOHO METROPOLITAN HOTEL is an exclusive hotel operating in Toronto, and is affiliated with a group of hotels operating under the name Metropolitan Hotels.

Exhibit E

Starwood Hotels and Resorts is one of the world's largest hotel and leisure companies whose brand names include WESTIN and SHERATON.

Exhibit F

TRUMP SOHO is a large hotel operating in New York City.

Exhibit G

The SOHO METROPOLITAN HOTEL and the TRUMP SOHO are affiliated with the entity Preferred Hotel Group.

Exhibit H

SoHo is a neighbourhood in Manhattan, New York City, known for being an example of inner-city regeneration and gentrification.

Exhibit I

The exhibit is a New York City map showing the locations of three of the above mentioned hotels.

Exhibit J

SOHO is the name of (i) a hair style salon in Edmonton, (ii) a bar and grill restaurant in Vancouver and in Burnaby, (iii) a licensed general contacting firm in Calgary specializing in full restoration services, (iv) a bistro in Toronto, (v) a real estate and project marketing agency in Vancouver.

Exhibit K

SOHO is the name of a fashionable area in the West End of London long established as an entertainment district. It was formerly known for its sex shops.

Dane Penney

[29] Ms. Penney identifies herself as a searcher employed by the firm representing the applicant. Her affidavit is intended to introduce into evidence the following exhibit material.

Exhibit A

A search of the trade-marks register for applications and registrations comprised of or including the word SOHO, as of March 22, 2011. Seventy-three marks were located. The register pages have been filed *en liasse*. From my review of the exhibit material, it appears that (i) 26 of the marks have been abandoned and 5 have been expunged, (ii) the search was not restricted with respect to the wares or services covered by the marks.

Exhibit B

A search for Canadian business names, carried out on the NUANS Pre-Search system, comprised of or including the word SOHO. Numerous such names were located covering a wide variety of businesses.

OPPONENT'S ADDITIONAL EVIDENCE

[30] The opponent's additional evidence is from several employees of the Soho Metropolitan Hotel. Each affidavit is more or less to the same effect: in the time period September 8 – 18, 2011, during the Toronto International Film Festival, the hotel received numerous telephone calls and walk-ins inquiring if the hotel was in fact the Soho House - presumably the establishment referred to in Exhibit C of Mr. Woods' affidavit: see para. 29, above.

CONSIDERATION OF THE GROUNDS OF OPPOSITION

[31] The grounds of opposition will be considered in the order in which they are pleaded in the statement of opposition.

1. First Ground of Opposition - Section 30(i)

[32] Section 30(i) is not a catch all clause but it can be used as a ground of opposition if fraud is alleged on the part of the applicant or if specific federal statutory provisions prevent the registration of the mark applied for: see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 CPR (2d) 152 (TMOB) at 155 and *Canada Post Corporation v. Registrar of Trade-marks* (1991), 40 CPR (3d) 221. In the instant case, no such allegations have been made. As a result, there are no substantive allegations of fact to support the s.30(i) ground of opposition, which is therefore rejected.

2. Second Ground of Opposition - Section 12(1)(d)

[33] The second ground of opposition alleges that the applied-for mark SOHO HOUSE, for use in association with "restaurant, bar, cafe and catering services; provision of temporary accommodation" is confusing with one or more of the opponent's registered marks SOHO LOFT CONDOMINIUMS; SOHO CONDOS; and SOHO LOFT CONDOS for use in association with "real estate services for the sale of residential dwelling units."

[34] The material time to consider the first ground of opposition is the date of my decision: see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 CPR (2d) 126 at 130 (FCA) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991),

37 CPR (3d) 413 at 424 (FCA). The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of s.6(2) of the *Act*, shown below:

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 . . . or performed by the same person, whether or not the wares or services . . . are of the same general class.

[35] Thus, s.6(2) concerns confusion of goods or services from one source as being from another source. In the instant case, the question posed by s.6(2) is whether there would be confusion of the applicant's services, to be sold in association with the mark SOHO HOUSE, as being sold, licensed or endorsed by the opponent owing to the opponent's activities under its registered marks SOHO LOFT CONDOMINIUMS; SOHO CONDOS; and SOHO LOFT CONDOS.

Test for Confusion

[36] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are "all the surrounding circumstances including" those specifically mentioned in s.6(5)(a) to s.6(5)(e) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive and all relevant factors are to be considered. Further, all factors do not necessarily have equal weight as the weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 CPR(3d) 308 (FCTD). However, as noted by Mr. Justice Rothstein in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 CPR(4th) 361 (SCC), although the degree of resemblance is the last factor cited in s.6(5), it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

Consideration of s.6(5) Factors

Inherent and Acquired Distinctiveness

[37] The applied-for mark SOHO HOUSE does not possess a high degree of inherent distinctiveness in relation to the applicant's services. In this regard, the component SOHO is a fairly well known neighbourhood in the cities of London and in New York, and has the laudatory connotation of fashionable or trendy. The second component HOUSE is a common dictionary word and has the connotation of a dwelling or an establishment. Both meanings are suggestive of the applicant's services. The mark SOHO HOUSE is therefore a relatively weak mark. Further, there is no evidence showing that the applicant's mark acquired any distinctiveness at any material time. Similarly, the opponent's marks are relatively weak marks as their suffix components (LOFT, CONDOS, CONDOMINIUMS) are descriptive of dwelling units.

[38] The opponent used its registered marks for the purpose of selling residential dwelling units, however, such use appears to have ceased by the late 1990s (or early 2000s) when the majority of the dwellings in the developments were sold. There is no evidence that the opponent continued to use its registered marks after the development was sold. Whatever distinctiveness the opponent's marks had acquired in the late 1990s and early 2000s has dissipated since then. Accordingly, I do not attribute any significant acquired distinctiveness to the opponent's registered marks at the present time. The first factor in s.6(5) therefore favours neither party.

length of time in use

[39] The applicant has not shown any use of its mark SOHO HOUSE at any material date. The opponent used its registered marks beginning in 1996 and such use continued for about three or four years thereafter. In such circumstances, I do not see that the second factor in s.6(5) favours the opponent to any significant extent at the present time.

nature of the parties' services, businesses, and trades

[40] With respect to the third and fourth factors in s.6(5), I agree with the applicant's submissions that the real estate services of the opponent, as set out in its registrations, and the food, drink and temporary accommodation services of the applicant, as set out in its

application, are significantly different. Accordingly, the third and fourth factors favour the applicant.

degree of resemblance

[41] There is necessarily a fair degree of resemblance between each of the opponent's registered marks and the applied-for mark SOHO HOUSE owing to the first component SOHO. In this regard, the first portion of a mark is usually considered the more important for the purposes of distinction: see *Conde Nast Publications Inc. v. Union Des Editions Modernes* (1979) 26 CPR(2d) 183 at 188 (FCTD). However, when the marks are considered in their entireties, the suffix components of the parties' marks act to distinguish the marks, more so visually and aurally and less so in ideas suggested. In this regard, there is a fair degree of overlap in the ideas suggested by the opponent's suffix components LOFT, CONDOS, CONDOMINIUMS and the applicant's suffix component HOUSE.

surrounding circumstances

[42] The opponent has relied on the evidence of eight employees of the Soho Metropolitan Hotel (see paragraph 31, above) to argue that the applied-for mark SOHO HOUSE is confusing with the opponent's marks SOHO LOFT CONDOMINIUMS; SOHO CONDOS; and SOHO LOFT CONDOS. As mentioned earlier, their evidence relates to telephone calls and walk-ins asking if the Soho Metropolitan Hotel was the Soho House. The applicant's position is that such evidence is inapplicable because, at best, it only relates to the issue of confusion between the applied-for mark SOHO HOUSE and the mark SOHO METROPOLITAN HOTEL, which is not in issue in the second ground of opposition. I am reluctant to give much weight to the evidence for two reasons. Firstly, the opponent's registered marks cover real estate services. It is inappropriate to extrapolate evidence of confusion for marks associated with similar services, that is, temporary accommodation services (the applicant's services) and hotel services to marks associated with dissimilar services, that is, temporary accommodation services and the real estate services specified in the opponent's registrations. Secondly, the alleged instances of "confusion" are confined to a short period of time - during the

2011 Toronto International Film Festival. It was a highly publicized event. It is reasonable to assume that the general public was actively seeking to locate the Soho House night club (see Exhibit C, para. 29 above) because it was known to be frequented by film industry celebrities. My sense of the evidence is not that the Soho Metropolitan Hotel was being confused with the Soho House night club but rather that any establishment with SOHO in its name, and which might be a suitable venue for celebrities to gather, was on the radar for investigation.

Jurisprudence

[43] I have also taken into consideration the discussion in *Coventry Inc. v. Abrahamian* (1984), 1 CPR (3d) 238 (FCTD) at para. 6. In that case the opponent was relying on its mark SARAH which was not inherently strong and had not acquired distinctiveness through use or advertising or other means:

The trade mark SARAH is a commonly used female Christian name and as such offers little inherent distinctiveness: *Bestform Foundations Inc. v. Exquisite Form Brassiere (Canada) Ltd.* (1972), 34 C.P.R. (2d) 163. Such marks are considered to be weak marks and are not entitled to a broad scope of protection: *American Cyanamid Co. v. Record Chemical Co. Inc.* (1972), 7 C.P.R. (2d) 1, [1972] F.C. 1271; and *GSW Ltd. v. Great West Steel Industries Ltd. et al.* (1975), 22 C.P.R. (2d) 154. In the case of a weak mark, small differences will be sufficient to distinguish it from another mark: *American Cyanamid Co., supra*, at p. 5. Zaréh, which is also a Christian name, but the name of a male Lebanese, is not commonly used in this country. Obviously, there are at least small differences to distinguish those two names. However, the degree of distinctiveness attributed to a weak mark may be enhanced through extensive use: *GSW Ltd. v. Great West Steel, supra*. Most of the evidence led by the appellant show considerable use and publicity for the trade name Sarah or Sarah Coventry or Sarah Fashion Show, etc., but very limited use of the trade mark SARAH. And it has been well established that it is not sufficient for the owner of the trade mark to make a statement of use, he must show use: *Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (2d) 62, [1981] 1 F.C. 679, 34 N.R. 39.

(underlining added)

[44] Similarly, in the instant case, the marks relied on by the opponent are inherently weak. Further, I am unable to conclude, on the basis of the evidence before me, that the distinctiveness of the opponent's marks has been so enhanced by prior use and

advertising (in the late 1990s and early 2000s) that they are entitled to a broad scope of protection at the present time.

[45] In view of the foregoing I find that the applicant has met the legal onus on it to show, on a balance of probabilities, that as of the present time there is no reasonable likelihood of confusion between the applied-for mark SOHO HOUSE and any of the opponent's registered marks. The second ground of opposition is therefore rejected.

3. Third Ground of Opposition - Section 16

3.1 Reliance on the opponent's "SOHO-formative marks" that had been previously used and made known in Canada

[46] The material date to consider the issue of confusion between one or more of the opponent's SOHO-formative marks and the mark SOHO HOUSE is the date of filing the application, that is, March 27, 2008.

[47] In addition to the usual evidential burden on the opponent to prove the facts inherent in its allegations (see *John Labatt Limited v. The Molson Companies Limited*, 30 CPR (3d) 293 at 298 (FCTD)), the *Trade-marks Act* imposes further requirements on an opponent. First, the opponent must show use of its mark prior to the date of the filing of the opposed application, that is, prior to March 27, 2008. Second, the opponent must show non-abandonment of the mark it is relying on as of the date of advertisement of the opposed mark, in this case November 24, 2009: see s.16(5) and 17(1) of the *Trade-marks Act*.

[48] With respect to the marks SOHO PARKWAY LUXURY CONDOMINIUMS; SOHO LISGAR LUXURY CONDOMINIUMS; and SOHO CHAMPAGNE LUXURY CONDOMINIUMS, I agree with the applicant's submissions that the opponent has not filed sufficient evidence to establish use of those marks prior to March 27, 2008. Rather, the evidence indicates that use of those marks did not begin until some time after October 2009: see paragraph 10 of Mr. Greenberg's affidavit. Accordingly, the above mentioned marks cannot be relied on to sustain a ground of opposition pursuant to s.16.

[49] Mr. Greenberg confirmed at cross-examination that use of the mark SOHO CONDOMINIUMS AT STARWOOD CENTRE began in about 1996, that use of the mark SOHO LOFTS AT 188 EGLINTON began in about 1996 or 1998, and that use of

the mark SOHO BAYVIEW began in about 2000. However, there is no evidence that the opponent continued to use those marks, or the mark SOHO RESIDENCES, after the developments associated with the marks were sold. Given the nature of the opponent's business activities at that time, that is, to sell a finished development project and to move on to the next one, I conclude that the opponent has not met the onus on it to show that it had not abandoned its above-mentioned marks as of November 24, 2009. Neither has the opponent met the onus on it to show that its marks SOHO LOFTS AT 188 EGLINTON and SOHO BAYVIEW were in use prior to March 27, 2008. Accordingly, the above mentioned marks cannot be relied on to sustain a ground of opposition pursuant to s.16.

3.2 Reliance on a previously filed application

[50] In order for an opponent to rely on a previously filed application, the application must be pending as the date of advertisement of the opposed mark, in this case June 24, 2009: see s.16(4) of the *Trade-marks Act*. The applications relied on by the opponent for the marks SOHO LOFT CONDOMINIUMS, SOHO CONDOS and SOHO LOFT CONDOS had all proceeded to registration well before June 22, 2009: see paragraph 9, above. Accordingly, the above mentioned applications cannot be relied on to sustain a ground of opposition pursuant to s.16.

3.3 Reliance on the opponent's "SOHO-formative marks" that had been previously used and made known as trade-names

[51] The discussion in paragraphs 46 to 49 above concerning the use and acquired distinctiveness of the opponent's trade-marks also applies to the opponent's trade-names, and the same results follow. That is, the opponent's trade-names cannot be relied on to sustain a ground of opposition pursuant to s.16.

[52] In view of the foregoing, each of the grounds of opposition based on s.16 is rejected.

4. *Fourth Ground of Opposition – Distinctiveness*

Material Date and Evidential Standard

[53] The material time for considering the circumstances respecting the issue of distinctiveness is as of the filing of the opposition, in this case November 24, 2009: see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 CPR(2d) 126 at 130 (FCA); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 CPR(3d) 412 at 424 (FCA).

[54] In *Bojangles' International LLC v. Bojangles Café Ltd.* (2004), 40 CPR (4th) 553, this Board considered where the evidential bar must be set in order for the distinctiveness of one mark to negate the distinctiveness of another mark:

Spanada and *Motel 6*, above, are the leading cases to examine the extent to which a mark must be known if it is to negate the distinctiveness of another mark. The bar set by those cases is that the opponent's mark must be well known in at least one part of Canada or widely known.

On appeal to the Federal Court, Trial Division (see 48 CPR (4th) 427), Noel J. found that the Board applied an erroneous evidential standard and set the bar in the following terms:

it is necessary that the evidence clearly indicate that the mark [the opponent's mark] is known to some extent at least, i.e., that the reputation of the mark in Canada is substantial, sufficient or significant.

However, the Court upheld the Board's finding that the opponent's evidence was not adequate to negate the distinctiveness of the applied-for mark.

4.1 *Reliance on the opponent's SOHO-formative trade-marks*

[55] Given my earlier discussion of the opponent's use of its SOHO-formative trade-marks, I am unable to find that, as of the material date November 24, 2009, their reputation was substantial, significant or sufficient to negate the distinctiveness of the applied-for mark SOHO HOUSE. The ground of opposition alleging non-distinctiveness and relying on the opponent's SOHO-formative trade-marks is therefore rejected.

4.2 *Reliance on trade-marks used under cross-licence by the opponent and Liverton Hotels International Inc.*

[56] The cross-licence agreement referenced by the opponent is attached as Exhibit B to Mr. Greenberg's affidavit. The marks used under cross-licence by the opponent and by Liverton Hotels International Inc. are set out in Schedules A and B of the agreement.

Seven marks are listed, however, none of the marks

SOHO MET HOTEL,
SOHO METROPOLITAN HOTEL,
SOHO METROPOLITAN HOTEL & RESIDENCES, and
SOHO METROPOLITAN HOTEL & CONDOMINIUMS

is found in Schedules A or B. The opponent is, of course, confined to relying on marks used under the cross-licence agreement as pleaded in the statement of opposition. As none of the marks relied on has been used under the agreement, there is no factual support for the final ground, which is therefore rejected.

DISPOSITION

[57] As each of the grounds of opposition has been rejected, the opposition is rejected. This decision has been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

Myer Herzig
Member, Trade-marks Opposition Board
Canadian Intellectual Property Office