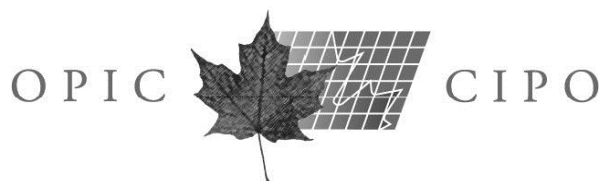


TRANSLATION/TRADUCTION



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

Citation: 2010 TMOB 193
Date of Decision: 2010-11-08

**IN THE MATTER OF AN OPPOSITION
by Manoir Pointe-Aux-Trembles inc. to
application No. 1,313,338 for the
trade-mark LES RÉSIDENCES SOLEIL
MANOIR À POINTE-AUX-TREMBLES
in the name of Eddy Savoie.**

[1] On August 17, 2006, Eddy Savoie (the Applicant) filed an application to register the trade-mark LES RÉSIDENCES SOLEIL MANOIR À POINTE-AUX-TREMBLES (the Mark) based on proposed use in association with [TRANSLATION] “the administration of residences for senior citizens”. The Applicant disclaimed the right to the exclusive use of RÉSIDENCES and POINTE-AUX-TREMBLES apart from the Mark.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* on July 18, 2007.

[3] On September 18, 2007, Manoir Pointe-Aux-Trembles inc. (formerly 9110-9496 Québec inc.) (the Opponent) filed a statement of opposition. The four allegations listed in the statement as grounds of opposition read as follows:

[TRANSLATION]

- [The Opponent] is the owner of the trade-mark “Manoir Pointe-Aux-Trembles”, registered on May 26, 2004, under number TMA611,098 . . . ;

- On July 6, 2006, the Honourable Mr. Justice Benoît Emery of the Superior Court of Québec issued a permanent injunction ordering Eddy Savoie not to use the expression “Manoir Pointe-Aux-Trembles” in association with the building located at 13900 Notre-Dame Street East, which he operates in the City of Montréal, in the borough at Pointe-aux-Trembles, or in association with any building of a similar purpose that he may operate in or near that borough;
- The applicant Eddy Savoie is not a person entitled to registration of the trade-mark “Manoir Pointe-Aux-Trembles”;
- The risk of confusion is evident despite the addition of the preposition “À” and, accordingly, the true owner would be deprived of the free and exclusive use of its trade-mark.

[4] The Applicant filed a counter statement denying all grounds of opposition invoked in the statement of opposition. Moreover, the Applicant denies that he has contravened any order whatsoever and specifically alleges the following: (i) that the Mark is registrable and that it does not create any confusion with the Opponent’s registered mark; and (ii) that he is satisfied that he is the person entitled to registration of the Mark. The Applicant also notes that the Mark is incorrectly identified in the third allegation.

[5] The Opponent’s evidence, pursuant to section 41 of the *Trade-marks Regulations*, SOR/96-195 (the Regulations) consists of copies of judgments of the Superior Court of Québec, District of Montréal, in another case between the parties, namely, an interlocutory injunction dated August 20, 2004, and the permanent injunction dated July 6, 2006, to which reference is made in the statement of opposition.

[6] The Applicant’s evidence, pursuant to section 42 of the Regulations, consists of the following:

- an affidavit by Isabelle Boisvert, researcher with C.R.A.C. Corporate Research and Analysis Centre, presenting the results of searches that she conducted in May 2008 in the SAEGIS database, which contains the trade-marks in the trade-marks register of the Canadian Intellectual Property Office, and in the databases of the Quebec Enterprise Register and the Canada411.ca telephone directory;

- certificates of authenticity for registrations TMA638,932, TMA694,081 and TMA694,089 held by the Applicant.

[7] The Opponent's evidence, pursuant to section 43 of the Regulations, consists of the following:

- a certificate of authenticity for registration TMA611,098 for the MANOIR POINTE-AUX-TREMBLES mark;
- an affidavit dated November 6, 2008, by Pat Bradley, legal secretary employed by the Opponent's agents, presenting the results of her searches of the Quebec Enterprise Register and the Canada411.ca telephone directory for "Manoir Pointe Trembles";
- a certified true copy of an affidavit by Doris Ouellette dated May 28, 2004;
- a certified true copy of the transcript of the out-of-court examination of Doris Ouellette, held on June 22, 2004; and
- an affidavit dated November 6, 2008, by Madeleine Gauthier, accommodations advisor to the Opponent since 1996.

[8] I will return to the issue of the admissibility of the Opponent's evidence under section 43 of the Regulations.

[9] On November 6, 2008, when filing its evidence pursuant to section 43 of the Regulations, the Opponent sought leave to file an amended statement of opposition with two new allegations: (i) an allegation referring to the interlocutory injunction issued on August 20, 2004, by the Honourable Madam Justice Marie St-Pierre of the Superior Court of Québec; and (ii) an allegation that, according to the two judgments of the Superior Court of Québec, the application for registration does not meet the requirements of section 30 of the Act, in that the Applicant cannot be satisfied that he is entitled to use the Mark in Canada.

[10] On June 1, 2009, acting on behalf of the Registrar, I denied the Opponent leave to file the amended statement of opposition pursuant to section 40 of the Regulations. Having considered both parties' submissions, I concluded that in the circumstances of the case, at the stage the opposition proceedings had reached and because the Opponent had never explained why it had apparently waited for almost a year before seeking leave to amend its statement of opposition, I did not think it would be in the interests of justice to grant leave to file the amended statement of opposition.

[11] Both parties filed written submissions and participated in a hearing, during which the Opponent's agent made two requests, which I will discuss below.

Amended statement of opposition

[12] During the hearing, the Opponent's agent reiterated the request for leave to file the amended statement of opposition of November 6, 2008. It was clear that the Opponent was attempting to have me reconsider my decision of June 1, 2009, which I refused to do. I see no reason to reverse my decision of June 1, 2009, as the Opponent has not demonstrated that I committed any error of law or in my interpretation of the facts.

Certified copies of judgments of the Superior Court of Québec

[13] I must begin by noting that the folder containing the evidence filed by the Opponent under section 43 of the Regulations also contains certified copies of the above-mentioned judgments of the Superior Court of Québec. These certified copies were listed in the folder as "evidence", but not as evidence pursuant to section 43 of the Regulations. Furthermore, the accompanying letter does not mention the certified copies of the judgments.

[14] In light of the above, at the hearing, I informed the Opponent's agent that additional evidence could only be filed with the permission of the Registrar, pursuant to subsection 44(1) of the Regulations. My remarks prompted the Opponent's agent to seek leave to file the certified copies of the judgments in question as additional evidence. Without necessarily objecting to the request for leave, the Applicant's agent reiterated the comments in the Applicant's written submissions to the effect that he is not contravening the orders of the Superior Court of Québec.

At the hearing, I indicated that I saw no reason to refuse the Opponent's request in the circumstances of the case.

[15] However, the Superior Court of Québec judgments are not documents in the official custody of the Registrar. Accordingly, even if I were to grant the leave sought, to be admissible as evidence the judgments would have to be introduced by way of an affidavit or statutory declaration, rather than as certified copies. I would add that even if they were introduced in an acceptable manner, these judgments would not be admissible as proof of the material facts they contain; the most they would establish is that the Superior Court of Québec issued an interlocutory injunction ordering the Applicant not to use the expression "Manoir Pointe-aux-Trembles" and a permanent injunction ordering the Applicant not to use the indivisible expression "Manoir Pointe-aux-Trembles".

[16] In any case, it seems clear to me that I may nevertheless refer to these judgments as judicial precedents. However, the outcome of these opposition proceedings must be determined on the basis of the particular facts of the case. In other words, every case must be decided on its own merits.

Admissibility of evidence pursuant to section 43 of the Regulations

[17] In light of the parties' submissions, I would like to make some formal and substantive observations regarding the admissibility of the evidence pursuant to section 43 of the Regulations.

[18] Regarding form, I note that evidence for an opposition proceeding must be filed in the form of an affidavit or statutory declaration, unless it is a document or an extract in the official custody of the Registrar, in accordance with section 54 of the Act. Regarding substance, the principle to be applied in deciding whether evidence is admissible under section 43 of the Regulations is whether it is strictly confined to matters in reply to the Applicant's evidence.

[19] In light of the above, I find that while the certificate of authenticity for registration No. TMA611,098 is admissible based on its form, it is inadmissible in substance, as it is not strictly confined to matters in reply to the Applicant's evidence.

[20] I also find that the certified true copies of the affidavit of Doris Ouellette and the transcript of her out-of-court examination are inadmissible based on their form, because the affidavit and transcript are not documents in the official custody of the Registrar. I would add that even if the copies of the affidavit and transcript had been filed in an admissible form, by way of an affidavit or statutory declaration, I would still have had to determine whether they were admissible in substance and, if so, how much weight to accord them in this case.

[21] The affidavit of Madeleine Gauthier appears to be a photocopy rather than an original. That fact aside, I note that the affidavit mainly contains one allegation to the effect that Ms. Gauthier [TRANSLATION] “reiterates her knowledge of and the veracity of all the events described in paragraphs 38 to 47 of the judgment of the Honourable Mr. Justice Benoît Emery dated July 6, 2006” [paragraph 2].

[22] According to the submissions of the Opponent’s agent, the purpose of Ms. Gauthier’s affidavit is to show the Opponent’s use of the mark MANOIR POINTE-AUX-TREMBLES and cases of confusion between it and the Mark. Without ruling on the evidentiary weight of the affidavit, I find that the Opponent is unduly splitting its case by relying on section 43 of the Regulations to file evidence that it should have introduced as evidence in chief. Accordingly, I fully agree with the Applicant that Ms. Gauthier’s affidavit is not strictly confined to matters in reply to the Applicant’s evidence and that it should therefore be ignored in analyzing the evidence in the record [see *Prouvost S.A. v. Haberdashers Ltd.* (1987), 18 C.I.P.R. 232 (T.M.O.B.)].

[23] Finally, I recognize that the affidavit of Pat Bradley describes the searches that she performed in the same databases consulted by Ms. Boisvert, whose affidavit was filed as evidence by the Applicant. During the hearing, the Applicant’s agent reiterated the arguments presented in the Applicant’s written submissions to the effect that [TRANSLATION] “Ms. Bradley’s affidavit describes the results of a search for MANOIR POINTE-AUX-TREMBLES” and that the Applicant “does not see how this constitutes a reply” to his evidence. The Applicant’s agent noted that nowhere in the Opponent’s submissions was there any attempt to show how Ms. Bradley’s affidavit replied to the Applicant’s evidence.

[24] In reply, the Opponent's agent specifically argued that the purpose of Ms. Bradley's affidavit was to demonstrate the use of the Opponent's mark. It appears to me that, by so doing, the Opponent's agent conceded that Ms. Bradley's affidavit should have been filed as evidence in chief. Without ruling on the evidentiary weight of Ms. Bradley's affidavit, I find that it is not strictly confined to matters in reply to the Applicant's evidence. Again, the Opponent is unduly splitting its case by relying on section 43 of the Regulations to file evidence that it should have introduced as evidence in chief.

[25] In short, I find that all of the evidence filed under section 43 of the Regulations is inadmissible and should be ignored in analyzing the evidence for this opposition proceeding.

Burden of proof

[26] The legal onus is upon the Applicant to show that its application complies with the provisions 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. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); *Dion Neckwear Ltd. v. Christian Dior, S.A. et al* (2002), 20 C.P.R. (4th) 155 (F.C.A.); and *Wrangler Apparel Corp. v. The Timberland Company* (2005), 41 C.P.R. (4th) 223 (F.C.)].

Analysis of the grounds of opposition

[27] In light of the parties' submissions, particularly at the hearing, I will begin by considering the scope of the allegations contained as grounds of opposition in the statement of opposition filed on September 18, 2007. For all intents and purposes, I note that failure to plead specific sections of the Act in the statement of opposition is not necessarily prejudicial [see *BlackIce By Design Inc. v. Molson Canada 2005*, 2010 TMOB 111 (T.M.O.B)].

[28] I have no difficulty concluding that the first, third and fourth allegations contained in the statement of opposition were sufficient to enable to Applicant to understand that the Opponent

was at least raising grounds of opposition based on paragraphs 38(2)(b) and 38(2)(c) of the Act, which state that the Mark is not registrable pursuant to paragraph 12(1)(d) of the Act and that the Applicant is not the person entitled to registration of the trade-mark pursuant to paragraph 16(3)(a) of the Act. It is also clear from the Applicant's counter statement and submissions that he understood that these were the grounds of opposition.

[29] Regarding the second allegation related to the permanent injunction issued on July 6, 2006, let me note from the outset that I agree with the Opponent's position that it is reasonable to conclude that the Applicant had knowledge of the injunction at the time of the application. That said, I also agree with the Applicant's position that the second allegation, as worded, is not a ground of opposition; it is an allegation of fact. In my view, when considered in light of all the allegations, the second allegation is equally susceptible, if not more susceptible, to being understood as an allegation of fact supporting the grounds of opposition mentioned previously. Therefore, I disagree with the Opponent's argument that the second allegation must be interpreted as a ground of opposition alleging that the application does not meet the requirements of section 30 of the Act, and more specifically of paragraph 30(i) of the Act. For the rest, the fact that the Opponent attempted to file an amended statement of opposition specifically pleading that the application did not meet the requirements of section 30 appears to support the conclusion that the statement of opposition in the record does not raise any grounds of opposition based on paragraph 38(2)(a) of the Act. I have no intention of rendering a decision on a ground of opposition that has not been raised [see *Imperial Developments Ltd. v. Imperial Oil Limited* (1984), 79 C.P.R. (2d) 12 (F.C.T.D.)].

[30] Finally, I note that in its written submissions, the Opponent argues that the registration of the Mark should not be granted to the Applicant because the Mark lacks distinctiveness. The Opponent adds, at page 5: [TRANSLATION] "This ground meets the requirements of subsection 38(2) of the Act." Although the statement of opposition does not contain any specific allegation that the Applicant's Mark lacks distinctiveness, I recognize that the allegations relating to confusion could be considered the basis for a ground of opposition under paragraph 38(2)(d) of the Act.

[31] In light of the above, I find that the statement of opposition raises grounds of opposition based on paragraphs 38(2)(b), 38(2)(c) and 38(2)(d) of the Act because of confusion between the Mark and the Opponent's MANOIR POINTE-AUX-TREMBLES mark.

[32] I will now analyze the grounds of opposition in light of the evidence filed in these proceedings.

Registrability pursuant to paragraph 12(1)(d) of the Act

[33] The relevant date for assessing the likelihood of confusion in accordance with paragraph 12(1)(d) of the Act is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

[34] My decision to exclude from the evidence in the record the certificate of authenticity of registration No. TMA611,098 has no impact on this ground of opposition. Having exercised the discretion of the Registrar [see *Quaker Oats Co. of Canada v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)], I confirm that registration No. TMA611,098 for the MANOIR POINTE-AUX-TREMBLES mark is registered in the name of 9110-9496 Québec inc. According to the statement of opposition, 9110-9496 Québec inc. is the Opponent's former business name; this fact has not been challenged by the Applicant.

[35] Because the Opponent has met its initial burden of proof, it falls to the Applicant to demonstrate, on the balance of probabilities, that there is no risk of confusion between the Mark and the MANOIR POINTE-AUX-TREMBLES trade-mark registered on May 26, 2004, in association with the operation of a residence for senior citizens.

[36] In considering the issue of confusion between the trade-marks in question, the test of first impression must be applied. In particular, the question to be asked is whether a consumer with an imperfect recollection of the Opponent's Mark can mistakenly believe that the services associated with the Mark originate from the Opponent or are authorized by it. To do so, one must have regard to all the surrounding circumstances, including the criteria stated in subsection 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 the trade-marks that have 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. All these criteria need not be attributed equal weight since, depending on its importance, one criterion can prevail over one or more of the others [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.) and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.*, (2006), 49 C.P.R. (4th) 401 (S.C.C.) for a thorough discussion of the general principles that govern the test for confusion].

The inherent distinctiveness of the trade-marks and the extent to which they have become known

[37] There is no dispute between the parties regarding the geographical sense of “Pointe-aux-Trembles”, a borough of the City of Montréal. Each of the parties has disclaimed the right to exclusive use of this term apart from their respective trade-marks.

[38] It is obvious that the term “residence” in the Mark is descriptive; indeed, the Applicant disclaimed the right to exclusive use of the term apart from the Mark. The term “manoir”, which is common to both marks, is a French-language word that evokes the idea of a residence, in that it describes a [TRANSLATION] “seigniorial dwelling; a small, old château in the countryside” [see *Le Petit Robert*, 2011 ed.]. The Applicant correctly submits that the word “soleil” [sun] has no connection with a residence or a particular place. The fact remains that in its figurative sense, the word “soleil” evokes [TRANSLATION] “that which shines, that which spreads its salutary influence like the sun” [see *Le Petit Robert*, 2011 ed.].

[39] I am of the view that the inherent distinctiveness of the trade-marks is weak and approximately equal in both cases, although it is arguable that the inherent distinctiveness of the Mark is slightly greater.

[40] The degree of distinctiveness of a trade-mark can be enhanced through use or by being made known in Canada. However, no evidence has been filed to help me assess the extent to which the marks have become known in Canada. The most I can infer from the mere existence of registration No. TMA611,098 is that there has been *de minimis* use of the mark MANOIR POINTE-AUX-TREMBLES [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1992), 40 C.P.R. (3d) 427 (T.M.O.B.)].

[41] Having regard to the foregoing, the overall consideration of paragraph 6(5)(a) does not favour either party in particular.

The length of time the trade-marks have been in use

[42] There is no evidence of use of the Mark following the filing of the application based on projected use. The Opponent's mark was registered on the basis of use in Canada since at least as early as August 1996. If I were to accept that the mark has indeed been used since the date specified in the registration, this factor would favour the Opponent. However, in the absence of evidence of use of the Opponent's mark, which as a result is presumed to be only *de minimis*, I am of the view that this is not a significant factor in this case.

The nature of the wares, services or business; the nature of the trade

[43] In considering the nature of the services and the nature of the trade, I must compare the wording of the services in the application for registration with the wording of the services in the registration alleged by the Opponent [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.)].

[44] The services associated with the trade-marks at issue are identical. Accordingly, in the absence of evidence, it is reasonable to conclude that both parties operate in the area of residences for senior citizens.

[45] At the hearing, the Applicant's agent directed my attention to *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2008), 72 C.P.R. (4th) 160 (F.C.); affirmed by (2009), 78 C.P.R. (4th) 243 (F.C.A.); on appeal to the Supreme Court of Canada (*Masterpiece*). In that case, the Court held that there was no likelihood of confusion between the MASTERPIECE LIVING mark in association with, among other services, real estate development services, real estate management services and residential building construction services, and the MASTERPIECE mark in association with the operation of residences for senior citizens and assisted-living facilities.

[46] Aside from the fact that *Masterpiece* is currently being appealed to the Supreme Court of Canada, I note that because the case involves an expungement action under section 57 of the Act,

it is distinguishable from an opposition proceeding [see *Unilever Canada Inc. v. Sunrider Corp.*, 2006 CarswellNat 2018 (T.M.O.B)]. Also, each case must be decided on its own facts. For example, in *Masterpiece*, the Court noted that both companies operated in the area of expensive retirement residences and services. In this case, there is no evidence regarding the cost of the services associated with the parties' marks.

[47] That said, I am of the view that the Applicant has some basis for submitting that a consumer seeking a residence for senior citizens will carefully research the characteristics of the place and the services offered there and will become familiar with the providers of those services; the consumer will not make a hasty decision. Contrary to the Opponent's claims, the evidence in the record does not demonstrate that senior citizens are more vulnerable or more likely to be confused, nor does it demonstrate any cases of confusion between the marks at issue. However, it is well established that it does not fall to the opponent to prove confusion. It falls to the applicant to prove the unlikelihood of confusion. In other words, a lack of evidence of confusion does not relieve applicants of their burden of proof.

The degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them.

[48] The Applicant submits that when the marks are considered together, [TRANSLATION] "an average consumer with an imperfect recollection would not confuse the two marks because there are sufficient differences to distinguish them." According to the Applicant, [TRANSLATION] "the average consumer will retain that LES RÉSIDENCES SOLEIL MANOIR are located in Pointe-aux-Trembles." The Opponent, on the other hand, submits [TRANSLATION] "that considering the whole from the perspective of an 'imperfect recollection' . . . it is unreasonable to believe that the average consumer who is not on guard would notice a difference" between the marks.

[49] I recognize that the presence of the words "LES RÉSIDENCES SOLEIL" in the Mark creates a distinction between the marks in their appearance and sound when they are considered as a whole. However, the words "LES RÉSIDENCES SOLEIL" are attached to the words "MANOIR À POINTE-AUX-TREMBLES" and are not more dominant. The mere presence of "À" between "MANOIR" and "POINTE-AUX-TREMBLES" in the Mark does not alter the fact that it reproduces the Opponent's mark in its entirety.

[50] The Applicant submits that the ideas suggested by the marks are different in that the Opponent's mark suggests a residence in a place, while the Mark suggests a residence full of salutary warmth. I recognize that I myself noted that the word "soleil" suggests salutary warmth. However, I do not think it would be reasonable to conclude that there is no resemblance between the ideas suggested by the marks when considered as a whole. Even though the word "soleil" qualifies the residence, a residence where salutary warmth can be found, the two marks suggest the idea of a residence located in Pointe-aux-Trembles.

[51] Ultimately, I find that the visual and phonetic differences between the marks do not overcome the resemblance between the ideas suggested. In other words, I do not think it would be reasonable to conclude that there is no resemblance between the marks when considered as a whole.

Additional surrounding circumstances

[52] Given the evidence filed in the record, I will now consider the parties' submissions regarding the additional surrounding circumstances in this case.

State of the register and marketplace

[53] State of the register evidence is usually adduced to show the commonality of a trade-mark or a portion of a trade-mark in relation to the register as a whole. Since it is only relevant insofar as one can make inferences from it about the state of the marketplace, it should be comprised of trade-marks that both include the mark or portion of the mark and that are used in association with wares or services similar to those at issue [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.)]. Inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located [see *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

[54] Ms. Boisvert filed as evidence the results of her search of the trade-marks register for all active marks including the word "MANOIR" or "MANOR" [Exhibit A]. The Applicant notes that 20 of the 80 marks identified in the register are associated with residences and

accommodations. According to my review of the marks invoked by the Applicant, once the marks registered in the Applicant's name are excluded, 14 registered trade-marks remain; 10 of these 14 marks are specifically associated with residences for senior citizens and are held by 9 distinct entities.

[55] Ms. Boisvert also filed as evidence the results of her search of the database of the Quebec Enterprise Register for all business names including the word "MANOR" [paragraph 5, Exhibit 5]. Ms. Boisvert notes that a similar search for the word "MANOIR" did not produce any hits [TRANSLATION] "because the word is too general to be accepted as a single-word search" [paragraph 6, Exhibit C]. The Applicant submits that the details of the resulting business names show that 5 businesses use "MANOR" as a component of a name associated with residents for senior citizens or retirees. Again according to the Applicant, Exhibit C shows that several businesses also use "MANOIR".

[56] Finally, Ms. Boisvert filed as evidence the results of her search of the [TRANSLATION] "database of the Canada411.ca telephone directory using the word 'MANOIR', in the Province of Quebec, in the category of 'retirement residences'" [paragraph 7, Exhibit D], as well as the results of her search of the Quebec Enterprise Register for about fifty of the residences found in the Canada 411 telephone directory [paragraph 8, Exhibit E].

[57] The Applicant notes that the search of the telephone directory resulted in 201 entries, and that only 4 of the 50 or so businesses searched for in the Quebec Enterprise Register have been expunged. The Applicant submits that it is possible to infer from the large number of entries in the telephone directory and the large number of active companies found that there is extensive use of marks and business names incorporating the word MANOIR in association with residences and accommodations for senior citizens and retirees. During the hearing, the Applicant's agent brought to my attention the remarks of Mr. Justice Pelletier in *Canadian Memorial Services v. Personal Alternative Funeral Services Ltd.* (2000), 4 C.P.R. (4th) 440. (F.C.T.D.) (*Canadian Memorial*) at paragraphs 32 and 34:

[32] The Affidavit of Craig Ashe shows the result of a corporate name search and discloses 138 registered business names or corporate names containing the phrase alternative or alternatif, of which 22 relate, on their face, to funeral services. Because these are not registered trade-marks, they may not come within

the principle in *Kellogg*, but they are, at the very least some evidence of surrounding circumstances.

...

[34] It is my view that the word alternative is descriptive of funeral services. I conclude from the fact that there is a section in the Yellow Pages designated Funeral Alternatives that this term is meaningful to consumers. Both parties have put evidence of Yellow Pages listings before me (though not necessarily for the same purpose). I believe that I am entitled to draw the inference that it is implicit in the tendering of such evidence that the significance of the Yellow Pages is that it is a listing of businesses by category so that consumers can quickly locate businesses of the same kind. If this designation was arrived at by the publishers of the Yellow Pages, then it suggests that persons who have nothing to do with the funeral industry are aware of the distinction. If, as suggested by Ms. Fitzpatrick in her cross-examination, it was dictated by the Ontario Funeral Board, then it is evidence that the industry recognizes the use. In either case, it is evidence that alternative has a descriptive use in relation to funeral services.

[58] I accept that Ms. Boisvert's affidavit enables me to infer that "MANOIR" is commonly adopted as a component of marks or commercial names used in association with senior citizens' residence services. Accordingly, the state of the marketplace is an additional surrounding circumstance that favours the Applicant.

Associated marks held by the Applicant

[59] I do not attribute any weight to the fact that the Applicant holds registrations for the trade-marks LES RÉSIDENCES SOLEIL MANOIR (No. TMA638,932), LES RÉSIDENCES SOLEIL MANOIR LAVAL (No. TMA694,081) and LES RÉSIDENCES SOLEIL MANOIR BROSSARD (No. TMA694,089). The ownership of these registrations does not automatically grant the Applicant the right to obtain registration of the Mark [see *American Cyanamid Co. v. Stanley Pharmaceuticals Ltd.* (1996), 74 C.P.R. (3d) 571 (T.M.O.B.); *Ralston Purina Canada Inc. v. H.J. Heinz Co. of Canada* (2000), 6 C.P.R. (4th) 394 (T.M.O.B.)].

[60] I would add that in the absence of evidence of use of the Applicant's three registered marks, I cannot conclude that the Applicant holds a family of marks related to "LES RÉSIDENCES SOLEIL MANOIR" [see *MacDonald's Corporation v. Yogi Yogurt Ltd.* (1982), 66 C.P.R. (2d) 101 (F.C.T.D.)].

Conclusion re likelihood of confusion

[61] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. I am of the view that the nature of the services, the nature of the trade and the degree of resemblance between the marks are all circumstances that tip the balance of probabilities in favour of the Opponent. Even though I accepted that the state of the marketplace with respect to marks incorporating the word “manoir” used in association with the relevant services is an additional surrounding circumstance favouring the Applicant, because of the circumstances of the case, I do not consider this additional circumstance to be sufficiently important to tip the balance of probabilities in the Applicant’s favour. At best for the Applicant, this additional surrounding circumstance equalizes the balance between a finding of confusion and a finding of no confusion between the marks at issue.

[62] Having regard to the foregoing, and having examined all the circumstances of the case, I find that the balance of probabilities is equally divided between a finding of confusion and a finding of no confusion between the marks at issue. Since the burden of proof rests on the Applicant, I find that he has not met his burden of demonstrating that there is no likelihood of confusion between the Mark and the Opponent’s MANOIR POINTE-AUX-TREMBLES mark. Accordingly, I find that the ground of opposition based on paragraph 12(1)(d) of the Act is successful.

Entitlement to register pursuant to paragraph 16(3)(a) of the Act

[63] I must begin by discussing the argument by the Opponent’s agent that the Applicant is not the person entitled to the registration of the Mark because the Applicant is contravening a court order. More specifically, during the hearing, the Opponent’s agent argued that it was not open to the Applicant to declare that he is satisfied that he is entitled to the registration of the Mark.

[64] As I pointed out to the Opponent’s agent, a ground of opposition under paragraph 16(3)(a) of the Act may only be considered in relation to the likelihood of confusion between the marks at issue, in this case the Mark and the Opponent’s MANOIR POINTE-AUX-TREMBLES mark, and not in relation to an allegation of a contravention of a court order. In

other words, without ruling on the merits of the Opponent's position that the Applicant is contravening a court order, an allegation of contravention of a court order is not an appropriate allegation on which to base a ground of opposition under paragraphs 38(2)(b) and 16(3)(a) of the Act; it would probably constitute an appropriate allegation on which to base a ground of opposition under paragraphs 38(2)(a) and 30(i) of the Act.

[65] The relevant date for assessing the likelihood of confusion for this ground of opposition is the filing date of the application, in this case August 17, 2006 [subsection 16(3) of the Act]. Despite the burden of proof on the Applicant, the Opponent must first establish that it used its trade-mark prior to the relevant date and that it had not abandoned such use at the advertisement date of the application, in this case July 18, 2007 [subsection 16(5) of the Act]. In the absence of evidence establishing use of its trade-mark within the meaning of section 4 of the Act, I find that the Opponent has failed to meet its burden of proving use of its mark prior to the relevant date.

[66] Having regard to the foregoing, I dismiss the ground of opposition based on the lack of entitlement to register the Mark.

Distinctiveness

[67] It is generally recognized that the relevant date to assess the ground of opposition based on lack of distinctiveness is the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

[68] Although it falls to the Applicant to demonstrate that the Mark is distinctive, the Opponent must establish that its MANOIR POINTE-AUX-TREMBLES mark had become sufficiently known at the relevant date to negate any distinctiveness of the Mark [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.); *Bojangles' International, LLC and Bojangles Restaurants, Inc. v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)].

[69] Given that there is no evidence indicating that the Opponent's mark has acquired a reputation as a result of its use or the promotional activities devoted to it, I find that the Opponent has not discharged its initial onus.

[70] Having regard to the foregoing, I dismiss the ground of opposition based on the Mark's lack of distinctiveness.

Decision

[71] Pursuant to the authority delegated to me under subsection 63(3) of the Act, I refuse the application for registration pursuant to s. 38(8) of the Act.

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
Francie Gow, BCL, LLB