



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

Citation: 2014 TMOB 15
Date of Decision: 2014-01-22

**IN THE MATTER OF AN OPPOSITION
by Provide Gifts, Inc. to application
No. 1,455,819 for the trade-mark MY
JEWELRY BOX.COM & Design in the
name of MJB Marketing Inc.**

[1] On October 19, 2009, MJB Marketing Inc. (the Applicant) filed an application to register the trade-mark JEWELRY BOX.COM & Design (the Mark), shown below.



[2] The subject application claims colour as a feature of the trade-mark, wherein the words MY JEWELRY BOX.COM are in white stylized lettering, the ribbon on the gift box, which is beneath the word JEWELRY, is also white, and the background and the gift box are red.

[3] The application is based upon use of the Mark in Canada in association with the wares “jewelry” and the services “retail jewelry store sales and online retail jewelry store sales” since August 1, 2006.

[4] The application was advertised for opposition purposes in the *Trade-marks Journal* of April 21, 2010.

[5] On September 20, 2010, Provide Gifts, Inc. (the Opponent) filed a statement of opposition. Each of the grounds of opposition turn on the issue of likelihood of confusion between the Mark and the Opponent's mark BOX Design, TMA688,149, registered in association with computerized online retail services and mail order services in the field of gifts.

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

[7] In support of its opposition, the Opponent filed a certified copy of its registration No. TMA688,149. In support of its application, the Applicant filed the affidavits of David Mamane, and Jessica Rodrigues-Cerquiera. The Applicant also requested and was granted leave to file a subsequent affidavit of Jessica Rodrigues-Cerquiera as additional evidence pursuant to section 44(1) of the *Trade-mark Regulations*, SOR/96-195.

[8] Only the Applicant filed a written argument and an oral hearing was not held.

Onus and Material Dates

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act*, RSC 1985, c T-13. 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].

[10] The material dates that apply to the grounds of opposition are as follows:

- section 12(1)(d) – the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].
- section 16(1) - the Applicant's date of first use [see section 16(1)]; and
- non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc.* (2004), 34 CPR (4th) 317 (FC)].

Section 12(1)(d) Ground of Opposition

[11] An Opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if the registration relied upon is in good standing as of the date of the opposition decision. Although the Opponent had filed a certified copy of this registration as its evidence, the supplementary affidavit of Ms. Jessica Rodrigues-Cerqueira attaches to it a copy of a letter dated August 27, 2013, from the Section 45 Branch of the Trade-marks Opposition Board informing that trade-mark registration No. TMA688,149 was expunged as of August 27, 2013. Accordingly, the Opponent has not met its initial burden with respect to this ground with the result that this ground of opposition is dismissed.

Remaining Grounds of Opposition

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

- the section 16(1)(a) ground fails because the Opponent has not shown any evidence of use of its mark in Canada with its services prior to the Applicant's date of first use; and
- the distinctiveness ground fails because the Opponent has not shown that its trade-mark had become known to a sufficient extent in Canada prior to the filing date of the opposition to negate the distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD); *Re 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) 412 at 424 (FCA)].

Disposition

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

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