

IN THE MATTER OF AN OPPOSITION  
by Choice Hotels International, Inc.  
to application No. 623,214  
for the mark CONFORTEL  
filed by Espalau Inc.

On January 13, 1989, the applicant, Espalau Inc., filed an application to register the trade-mark CONFORTEL based on proposed use in Canada for the services "opération d'hôtels, motels et restaurants; services de traiteur." The application was advertised for opposition purposes on July 5, 1989.

The opponent, Choice Hotels International Inc. (formerly Quality Inns International Inc., before changing its name), filed a statement of opposition on November 3, 1989, a copy of which was forwarded to the applicant on November 20, 1989.

The first ground of opposition is that the applied for mark is not registrable, pursuant to Section 12(1)(d) of the Trade-marks Act, because the mark CONFORTEL is confusing with the opponent's registered mark COMFORT INN, regn. No. 276,330, covering, among other things, "hotel, motel, restaurant and reservation services." The next ground of opposition is that the applicant is not entitled to registration, pursuant to Section 16(3)(a), because at the applicant's filing date namely January 13, 1989, the mark CONFORTEL was confusing with the opponent's mark COMFORT INN previously used and made known in Canada. The final ground of opposition is that the applied for mark is not distinctive of the applicant's services.

The applicant served and filed a counter statement generally denying the grounds of opposition.

The opponent requested, and was granted, the usual six months extension of time to prepare and file its evidence in chief. The opponent subsequently requested, and was also granted, two additional extensions of time (totalling three months) to file its

evidence in chief. However, the opponent's fourth request for an extension of time to file its evidence was refused: see the Board ruling dated October 31, 1990.

The applicant's evidence was timely filed and consists of a certified copy of its trade-mark registration for C & Design (covering the same services described in the subject application), and the affidavit of Normand Cliche, president and general manager of the applicant company.

It was not until nine months after the applicant completed filing its evidence that the opponent requested leave to cross-examine Mr. Cliche on his affidavit, pursuant to Rule 46(2) of the Trade-marks Regulations. Leave was denied because the opponent had not filed any evidence in support of its opposition despite obtaining three extensions of time to do so, and because the opponent had also defaulted in filing any reply evidence: see the Board ruling dated March 13, 1992. The opponent was subsequently refused a retroactive extension of time to file reply evidence: see the Board ruling dated April 16, 1992.

Both parties filed a written argument and both parties were represented at an oral hearing.

The opponent admits that because it has not filed any evidence it has not satisfied the evidential burden on it to support the second and third grounds of opposition alleging non-entitlement and non-distinctiveness.

The remaining ground of opposition, pursuant to Section 12(1)(d), is supported by the opponent's trade-mark registration for COMFORT INN. In this respect, I have inspected the trade-mark register to verify that regn. No. 276,330 relied on by the opponent is extant and covers the services as alleged in the statement of

opposition: see Quaker Oats Co. of Canada Ltd. v. Menu Foods Ltd. (1986), 11 C.P.R.(3d) 410 at pp. 411-12 (TMOB). I have also noted that the word INN has been disclaimed in the opponent's registration.

The material date to consider the issue of confusion arising pursuant to Section 12(1)(d) 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.), but see also Conde Nast Publications Inc. v. The Canadian Federation of Independent Grocers (1991), 37 C.P.R. (3d) 538 (TMOB). The legal burden is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2), between the applied for mark CONFORTEL and the opponent's registered mark COMFORT INN. In determining whether there would be a reasonable likelihood of confusion, I am to have regard to all the surrounding circumstances, including those enumerated in Section 6(5). The presence of a legal burden on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, the issue must be decided against the applicant: see Joseph E. Seagram & Sons v. Seagram Real Estate Ltd. (1984), 3 C.P.R.(3d) 325 at pp. 329-30 (TMOB), and see John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 at pp. 297-300 (F.C.T.D.).

With respect to Section 6(5)(a), neither mark possesses a high degree of inherent distinctiveness. The mark COMFORT INN is highly suggestive, if not descriptive, of an inn that provides physical ease and a sense of well-being to its clients. Although the mark CONFORTEL is a coined word, nevertheless to a bilingual or French speaking person it is suggestive of ease or comfort since "confort" is the French word for "comfort." There is no evidence that the opponent has used its mark COMFORT INN in Canada, or that the opponent's mark COMFORT INN has acquired any reputation in Canada. Even if I were to infer from the existence of former registered users of the mark COMFORT INN recorded on the register that

COMFORT INN hotels or motels were operating in Canada, I could not infer more than a minimal reputation for the mark.

The applicant's evidence establishes that it has expended \$135,000 on advertising for two motels operating under the mark CONFORTEL, one in Val d'Or and the other in l'Ancienne-Lorette, Quebec. I therefore infer that the applicant's mark has acquired some reputation in Canada for motel services. The applicant's evidence also shows use of its mark CONFORTEL together with its mark C & Design but that is not particularly relevant in the circumstances of this case.

With respect to Section 6(5)(b), the length of time that the parties' marks have been in use favours the applicant but only to a limited extent. The applicant has not shown more than limited use of its mark, beginning October 1, 1989 (see paragraph 11 of Mr. Cliche's affidavit), while the opponent has not established any use of its mark.

With respect to Sections 6(5)(c) and (d), the nature of the parties' services and trades, as described in the subject application and in the opponent's registration, are essentially the same. Both parties provide hotel and motel services.

The critical factor in the circumstances of this case, given that neither party has established a significant reputation for its marks in Canada, is the degree of resemblance between the marks COMFORT INN and CONFORTEL. I find that there is some visual and aural resemblance between the marks in issue, accounted for by the resemblance between the first portion namely, "confort" of the applied for mark and the first component namely, "comfort" of opponent's mark. The applied for mark CONFORTEL would not suggest any idea in particular to an English speaking person; the idea, if any, suggested by the mark to a bilingual or French speaking person would be "comfort" or "ease" in the abstract. The idea suggested

by the opponent's mark COMFORT INN is "a comfortable inn." Thus, there may be some overlap, to a limited extent, in the ideas suggested by the marks in issue. However, I find that the differences between the marks COMFORT INN and CONFORTEL outweigh their similarities when the marks are considered in their totality. In considering the marks in their totality, it is of no consequence that the word INN has been disclaimed in the opponent's registration.

The opponent argues that the mark CONFORTEL is a translated version of the mark COMFORT INN, and relies on the relationship between the French and English languages as discussed by Marceau J. in Produits Freddy Inc. v. Ferrero S.p.A. (1988), 22 C.P.R.(3d) 346 at p. 350 (F.C.A.):

I do not agree with the opponent's submission that the mark CONFORTEL is a translated version of the mark COMFORT INN. In the absence of evidence to the contrary, I assume that the translated version of "comfort inn" would be either "auberge confort" or "hostellerie confort" or "hôtel confort." Further, the learned Judge, in continuing the above commentary, distinguished between translated versions of words and mere corresponding sounds of the two languages:

Similarly, in the instant case, the mark CONFORTEL is a coined word that does not belong to the French language and it is incapable of being translated. In the absence of evidence to the contrary, I conclude that CONFORTEL would not be readily recognized as a French version of COMFORT INN. In the instant case I have been guided by the principle enunciated in Sealy Sleep Products Ltd. v. Simpson's-Sears Ltd. (1960), 33 C.P.R. 129 (Ex.C.) and approved in Ultravite Laboratories Ltd. v. Whitehall Laboratories Ltd. (1965), 44 C.P.R. 189 at p. 192 (S.C.C.), reproduced below:

I would also mention that at the oral hearing, counsel for opponent provided me with a package of what appears to be summaries of various of the opponent's trade-mark registrations and applications, apparently derived from a computer data base. Counsel for the opponent invited me to accept the above as evidence in this proceeding, or alternatively, to confirm the above mentioned documentation by inspecting records in the Registrar's care. I have declined to do either. Firstly, the documentation

provided is not in affidavit or statutory declaration form as required by the Trade-marks Regulations, nor does it consist of certified copies as permitted by Section 54 of the Trade-marks Act. Secondly, it is only in limited circumstances that the Board will exercise its discretion to check records in the Registrar's care: see Quaker Oats, above; see also Molson Breweries v. Pernod Ricard S.A. (1990), 31 C.P.R.(3d) 42 at p. 46 (TMOB), rev'd on another point, (1991), 40 C.P.R.(3d) 102 (F.C.T.D.); John Labatt Ltd. v. W.C.W Western Can. Water Enterprises (1991), 39 C.P.R.(3d) 442 at pp. 445-446 (TMOB). Further, it would be unfair to allow the opponent to rely on state of the register evidence without allowing the applicant an opportunity to test that evidence or reply to it: see Realestate World Services v. Realcorp Inc. (1993), 48 C.P.R.(3d) 397 at pp. 403-404 (TMOB); Unitron Industries Ltd. v. Miller Electronics Ltd. (1983), 78 C.P.R.(2d) 244 at p. 253 (TMOB).

Considering the above, I am satisfied that the applicant has met the legal burden on it to show that, as a matter of first impression and imperfect recollection, there would not be a reasonable likelihood of confusion between the marks in issue.

In view of the foregoing, the opponent's opposition is rejected.

DATED AT HULL, QUEBEC, THIS 31<sup>st</sup> DAY OF JANUARY , 1994.

Myer Herzig,  
Member,  
Trade-marks Opposition Board