

IN THE MATTER OF AN OPPOSITION  
by EMTWO Properties Inc. to  
application No. 538,954 for the  
trade-mark YORK MILLS CENTRE  
filed by The York Trillium  
Development Group Ltd.

On March 26, 1985, the applicant, The York Trillium Development Group Ltd., filed an application to register the trade-mark YORK MILLS CENTRE based on use in Canada since October 13, 1984 with the following services:

planning, construction, development, managing,  
leasing, servicing, promotion and operation of  
real estate projects comprising retail stores,  
commercial, professional and office facilities.

The application was amended to include a disclaimer to the word CENTRE and was subsequently advertised for opposition purposes on December 18, 1985.

The opponent, EMTWO Properties Inc., filed a statement of opposition on April 28, 1986 and a revised statement on May 29, 1986. A copy of the revised statement of opposition was forwarded to the applicant on June 16, 1986. On July 22, 1988, the opponent was granted leave pursuant to Rule 42 of the Trade-marks Regulations to amend its statement of opposition.

The first ground of opposition is that the application does not comply with the provisions of Section 30(b) of the Trade-marks Act because the claimed date of first use is incorrect. The second ground is that the applicant is not the person entitled to registration pursuant to Section 16(1) of the Act because, as of the applicant's claimed date of first use, the applied for trade-mark was confusing with the trade-marks and trade-names YORK MILLS SHOPPING CENTRE and YORK MILLS CENTRE previously used by the opponent and its predecessor in title The Cadillac Fairview Corporation Limited in association with the following services:

the development, operation, management and  
marketing of a real estate project comprising  
retail stores, restaurants, recreational  
facilities and space for commercial purposes.

The third ground is that the applied for trade-mark is not distinctive in view of the opponent's use of its trade-marks and trade-names.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavits of David Nicol, Ralph Champion, Barry Haberman, Alexander Henry and Lorraine King and a certified copy of trade-mark registration No. 335,890. As its evidence, the applicant filed the affidavits of Edwin Brown, Deanna Goldstein, Hyke Goren, Riichiro Akazaki and Martti Paloheimo. Mr. Paloheimo was cross-examined on his affidavit. Both parties filed written arguments and an oral hearing was conducted at which both parties were represented.

As for the opponent's first ground of opposition, the onus or legal burden is on the applicant to show its compliance with the provisions of Section 30(b) of the Act. There is, however, an evidential burden on the opponent respecting its allegations of fact in support of that ground: see Joseph Seagram & Sons v. Seagram Real Estate (1984), 3 C.P.R.(3d) 325 (T.M.O.B.) and John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 (F.C.T.D). Furthermore, that burden is lighter respecting the issue of

non-compliance with Section 30(b) of the Act: see the opposition decision in Tune Masters v. Mr. P's Mastertune (1986), 10 C.P.R.(3d) 84.

The applicant submits that the Paloheimo affidavit clearly establishes that the applicant had used its trade-mark with the applied for services since October 13, 1984, if not earlier. In paragraph 2. of his affidavit, Mr. Paloheimo makes the bare assertion that the applicant's trade-mark had been used since the claimed date. He goes on to state that the applicant used the trade-mark YORK MILLS CENTRE as the name of a building complex located at the corner of Yonge Street and York Mills Road in the City of North York.

The cross-examination of Mr. Paloheimo casts doubt on the applicant's claimed date of first use. At pages 12 ff. of the transcript, Mr. Paloheimo states that the purchase of the land for the proposed YORK MILLS CENTRE complex was not completed until November of 1984. He goes on to discuss the opponent's first tenant for the complex and, in fulfillment of an undertaking, a copy of the lease was obtained. It is dated October 12, 1984 which suggests that the applicant has relied on it in support of its claimed date of first use of October 13, 1984.

The lessee or tenant was a company called Ultrasecure Tempest Research Corporation or UTRC. The lease appears to cover at least a portion of a parcel of land at the north-east corner of the intersection referred to by Mr. Paloheimo in his affidavit. It goes on to provide that the tenant UTRC will construct a building on that portion of the land and that UTRC will own and operate the building itself. This suggests that the applicant would not be performing those functions.

Even if the lease with UTRC could somehow support performance of any of the services claimed by the applicant, there is no indication in the lease or otherwise that the trade-mark YORK MILLS CENTRE was displayed or advertised in the course of that transaction. Furthermore, even if the applicant had been the party constructing, owning, operating and managing the building complex, such activities would not appear to support the claimed date of first use for the services claimed. In other words, the "planning, construction, development..." of a real estate project by the applicant would be services performed for its own benefit and not for the benefit of others. It may be that the applicant did lease some land to another company but that would not appear to qualify as the "leasing...of real estate projects comprising retail stores, commercial, professional and office facilities." In any event, as discussed, there is no evidence that the trade-mark YORK MILLS CENTRE was in any way associated with that leasing transaction.

There is some suggestion in the Paloheimo transcript that the applicant erected a sign featuring the applicant's trade-mark in late 1984 on the site where the building complex was to be constructed (see page 13 of the transcript). However, even if this was so, I do not consider that such an activity supports the applicant's claim to use of its trade-mark for any of the services as set out in its application. Any such sign would have functioned simply to identify the name of the proposed building: see the opposition decision in 114662 Canada Inc. v. Société Immobilière Place du Parc Inc. (1990), 29 C.P.R.(3d) 378 at 382-383.

In view of the above, I find that there is sufficient evidence from which I could

conclude that the applicant did not use its trade-mark as claimed. The opponent has therefore met its evidential burden. Since the applicant's evidence in support of its claimed date of first use consists of little more than bare assertions to that effect in the Paloheimo affidavit, I find that the applicant has failed to meet the onus or legal burden on it to show its compliance with Section 30(b) of the Act.

As for the second ground of opposition, there was an evidential burden on the opponent to show prior use of its trade-marks and trade-names by itself and any predecessors in title. This the opponent has failed to do. Any evidenced use of the marks and names appears to have been by The Cadillac Fairview Corporation which Mr. Nicol describes in his affidavit as the agent of the opponent. The evidence suggests that the various services performed in association with the real estate project referred to in evidence (namely, the York Mills Shopping Centre) were performed by The Cadillac Fairview Corporation and that the public would have perceived that company to have been performing those services on its own behalf and not as an agent for some other company. In the absence of a trade-mark registration and a registered user registration on behalf of The Cadillac Fairview Corporation as of the relevant times, the opponent cannot rely on use by that company in support of its second ground. It is therefore unsuccessful.

As for the third ground of opposition, the opponent is not restricted to its own activities in relation to a ground of non-distinctiveness. Furthermore, the material time for considering the circumstances respecting this ground is as of the filing of the opposition. Finally, the onus or legal burden is on the applicant to show that its trade-mark is adapted to distinguish or actually distinguishes its services from those of others throughout Canada.

The evidence of record establishes the following:

- (1) For a number of years, The Cadillac Fairview Corporation has been operating, managing, leasing and marketing a real estate project known as York Mills Shopping Centre. The shopping center has had fairly extensive sales for many years.
- (2) The York Mills Shopping Centre has sometimes been identified as York Mills Centre (see Exhibits A, B and BB to the Champion affidavit).
- (3) The applicant's applied for services are similar to (if not identical to) the services performed by The Cadillac Fairview Corporation.
- (4) The building complex constructed in association with the trade-mark YORK MILLS CENTRE does, in fact, have some similarities to the York Mills Shopping Centre since both facilities have retailers and restaurants, and the former is sometimes advertised as a shopping centre (see Exhibits C and DD to the Nicol affidavit).
- (5) The two complexes are only about one mile apart and there have been some incidents of misdirected enquiries (see paragraph 4 of the Nicol affidavit).

The applicant submits that no one would mistake one building complex for the other. I'm not sure that's entirely true but, in any event, the applicant has misconstrued the issue at hand. The issue is not whether a consumer would mistake one building for another

but whether he or she would assume a common connection between the trade-marks at issue used in association with the services claimed. On that score, I must agree with the opponent that the applicant has failed to satisfy the onus on it to show that its trade-mark YORK MILLS CENTRE when used with the various services set out in the application actually distinguishes those services from the similar services associated with the York Mills Shopping Centre. Although, as submitted by the applicant, York Mills would appear to be inherently weak as having a geographical significance and although there were several other business entities in the area using the same words as of the material time, the virtual identity between the applicant's mark and the designation York Mills Shopping Centre together with the other factors discussed above strongly suggest that the applicant's mark is not distinctive. I therefore find that the third ground is also successful.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 31<sup>ST</sup> DAY OF JANUARY 1991.

David J. Martin,  
Member,  
Trade Marks Opposition Board.