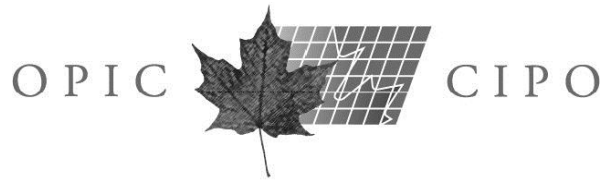


TRADUCTION/TRANSLATION



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

Citation: 2010 TMOB 87
Date of Decision: 2010-05-19
TRANSLATION

**IN THE MATTER OF AN OPPOSITION
by Imperial Parking Canada Corporation
to application No. 1276156 for the
trade-mark NET PARKING.NET &
Design in the name of 6338925 Canada
Inc.**

Proceedings

[1] On October 18, 2005, 6338925 Canada Inc. (the Applicant) filed an application to register the trade-mark NET PARKING.NET & Design as illustrated below:



The application was based on proposed use in association with the following:

Telemangement system for computer and electronic equipment and mechanical devices used in the operation of parking lots namely: access control and payment collection systems namely: guard offices and monitoring stations, detectors, barriers, access and payment modules; on-line security, surveillance and client service systems, namely: cameras, screens, microphones, speakers; data management and processing software for telemangement of data via telephone and telematics in the operation of parking lots; software for electronic commerce used for remote processing of parking

reservations, passes and payments via a telephone and telematics system namely: transactional Internet sites; (“Wares”) and

sale and leasing of software and computer, electronic and mechanical equipment for the operation and management of parking facilities. Operation and management of automobile parking lots and parking equipment. Consulting and technical support services related to the operation and management of parking lots. (“Services”)

[2] This application was advertised for opposition purposes on August 30, 2006, in the *Trade-marks Journal*. On January 30, 2007, Imperial Parking Canada Corporation (“the Opponent”) filed a statement of opposition, which the Registrar forwarded to the Applicant on February 15, 2007. On May 25, 2007, the Applicant filed a counter statement essentially denying all of the grounds of opposition described below.

[3] The Opponent filed the affidavit of Jane Zsigmond in evidence. The Applicant adduced no evidence. Only the Opponent filed written arguments. The Applicant was not represented at the oral hearing, even though the hearing had been held at the Applicant’s request.

Grounds of opposition

[4] The grounds of opposition pleaded are as follows:

1. The Mark is not registrable under paragraph 12(1)(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (Act), because it is confusing with the Opponent’s trade-mark P & Design, application for registration No. 1,277,933, soon to be registered;

2. The Applicant is not the person entitled to registration of the Mark under paragraph 16(3)(a) of the Act because, on the filing date of the application, the Mark was confusing with the trade-mark P & Design previously used in Canada by the Opponent in association with management and operation services of parking lots and facilities;

3. The Mark is not distinctive within the meaning of section 2 of the Act because it does not actually distinguish and is not adapted to distinguish the Applicant’s Wares and Services from the Opponent’s wares and services.

Burden of proof when opposing the registration of a trade-mark

[5] In proceedings to oppose the registration of a trade-mark, the Opponent must present enough evidence concerning the grounds of opposition raised to show that there are facts

supporting those grounds. If the Opponent meets this requirement, the Applicant must then satisfy the Registrar, on the balance of probabilities, that the grounds of opposition raised should not prevent the Mark from being registered [see *Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325, and *John Labatt Ltd. v. Molson Companies Limited* (1990), 30 C.P.R. (3d) 293].

Registrability of the Mark under paragraph 12(1)(d) of the Act

[6] The ground of opposition based on paragraph 12(1)(d) of the Act presupposes the existence of a registered mark on the filing date of the statement of opposition. If registration is secured after the filing of the statement of opposition, the statement must be amended accordingly. However, the Opponent never amended its statement of opposition to allege the registration of its trade-mark. As worded, the ground of opposition based on paragraph 12(1)(d) of the Act is invalid. It is therefore rejected [see *Caribbean Cultural Committee – Caribana v. Khan* (1999), 3 C.P.R. (4th) 101].

Right to register the Mark

[7] The relevant date for analyzing the second ground of opposition is the filing date of the application for registration [see subsection 16(3) of the Act].

[8] To discharge its initial burden of proof, the Opponent must establish that its mark P & Design was used or was known in Canada prior to October 18, 2005.

[9] Ms. Zsigmond is a paralegal who has been employed by the Opponent since August 15, 2006. She states that the Opponent is one of the three largest parking lot management companies in North America. However, this territory includes not only Canada but also the United States and Mexico. She states that the Opponent operates approximately 1,570 parking lots in Canada, but she does not specify when the Opponent began operations in Canada. (emphasis added)

[10] Ms. Zsigmond filed a document (Exhibit A of her affidavit) describing Impark Parking Corporation's history. I note that, in her affidavit, she defined the Opponent as Impark but did not explain the alleged connection between the Opponent and Impark Parking Corporation. I cannot infer that the Opponent and Impark as identified in Exhibit A constitute one and the same

corporate entity. Moreover, there is no information on the origin of this document. The contents of this document are hearsay evidence. Lastly, this evidence refers to other corporate entities such as Impark Parking Management, LLC and The Gates Group, LLC.

[11] The affiant filed photographs of signs found in parking lots operated by Impark. I have already commented on the ambiguity created by the use of the term IMPARK in the text of the evidence filed by Ms. Zsigmond. This term also appears on the signs. In the photographs filed (Exhibit B of her affidavit), the mark P & Design can be seen as illustrated below:



“IMPARK” appears underneath this mark. The corporate entity using this trade-name is not identified. Lastly, there is no information on who took these photographs, and when and where they were taken. Are they parking lots located in Canada?

[12] The Opponent’s sales figures in association with the use of the Mark in Canada were not provided. The Opponent’s evidence does not clearly show use of the trade-mark P & Design by the Opponent in Canada (emphasis added) prior to the relevant date. Furthermore, on the basis of this evidence, I am unable to conclude that the Opponent had not abandoned the use of the trade-mark P & Design at the date of advertisement of the Applicant’s application (August 30, 2006) as required by subsection 16(5) of the Act.

[13] Therefore, the Opponent has not discharged its initial burden of proof. Nevertheless, in case I am mistaken in finding that the Opponent has not discharged its initial burden of proof, I will analyze the factors listed at subsection 6(5) of the Act to determine whether there is a likelihood of confusion between the marks at issue.

[14] Assuming that the Opponent has discharged its initial burden of proof, the Applicant must then prove, on the balance of probabilities, that the Mark is not confusing with the Opponent’s mark P & Design [see *Christian Dior, S.A. v. Dion Neckwear Ltd.*, [2002] 3 F.C. 405].

[15] The likelihood of confusion between two trade-marks must be analyzed in light of the specific circumstances of each case. The applicable test is described at subsection 6(2) of the Act. Thus, the use of the Mark will cause confusion with the Opponent's mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares and services associated with those trade-marks are manufactured, sold, hired or performed by the same person, whether or not the wares or services are of the same general class. A non-exhaustive list of the relevant circumstances appears at subsection 6(5) of the Act: (a) the inherent distinctiveness of the trademarks or trade-names and the extent to which they have become known; (b) the length of time the trade-marks or trade-names 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 or trade-names in appearance or sound or in the ideas suggested by them. For an analysis of these factors, I refer to the Supreme Court of Canada's decision in *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321.

[16] The Mark is inherently distinctive. It consists of original design elements such as the image of a computer mouse inside the letter P. However, the Mark on the whole, owing to the presence of the word "parking" as an element, is suggestive of the field of activity (parking lot operations) in relation to which the wares and services will be offered.

[17] The Opponent's mark is less inherently distinctive than the Mark. The Opponent's mark consists of a graphic representation of a letter of the alphabet. However, trade-marks consisting of mainly one or more letters of the alphabet do not possess great inherent distinctiveness [see *GSW Ltd. v. Great West Steel Industries Ltd.* (1975), 22 C.P.R. (2d) 154]. I also consulted the dictionary *Le Robert*, as it was within my discretion to do so [see *Rowntree Co. v. Paulin Chambers Co.*, [1968] S.C.R. 134], and it is indicated that the letter P is used as an abbreviation and a symbol for "parking lot". The same may also be said for the letter P in the Mark.

[18] The distinctiveness of a mark may nevertheless be enhanced by its use or promotion. However, since the Applicant adduced no evidence, there is no way of knowing to what extent the Mark might have become known in Canada, especially since the application for registration was filed on the basis of proposed use.

[19] In light of the evidence described above, I am unable to conclude that the Opponent's mark P & Design was known in Canada on any date relevant to the case. Since the Mark is more inherently distinctive than the Opponent's trade-mark, the first factor listed at subsection 6(5) of the Act favours the Applicant.

[20] As for the second factor set out at subsection 6(5), as indicated above, I am not satisfied that the Opponent has demonstrated use of its trade-mark in Canada prior to October 18, 2005. Given that there is no evidence of use of the Mark in Canada, this factor favours neither of the parties.

[21] The third and fourth factors favour the Opponent, for there is an overlap between the Wares and Services and the Opponent's parking lot management services. I have no evidence that the nature of the Applicant's trade differs from that of the Opponent's. On the contrary, given the similarity between the parties' wares and services in this case, I can only assume that the nature of their respective trades is similar, if not identical.

[22] The degree of resemblance between the marks at issue has on numerous occasions been considered to be one of the most important factors to assess when analyzing the likelihood of confusion between two trade-marks [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145, aff'd 60 C.P.R. (2d) 70].

[23] In its written arguments, the Opponent claims that the Mark incorporates a "P" that is similar in appearance to its registered trade-mark. It also notes that the square that is part of its design appears on the vertical bar in front of the "P" in the Mark's design. To point out these similarities, it placed the parties' marks side by side.

[24] It has been held countless times that the applicable test is not to dissect the marks and draw up a table with the similarities and differences. Rather, one must imagine the average consumer with an imperfect recollection of the Opponent's mark. Faced with the Mark, would the consumer be likely to think that the Wares and Services come from the Opponent?

[25] The Opponent's mark is the letter P with a design. The average consumer will remember that the Opponent's mark is a "P" with at most a cross separating the vertical part from the spherical part of the letter. The word portion of the Mark is "net parking dot net". The Mark also

has a design portion that includes the image of a computer mouse. Accordingly, the Mark suggests a certain technological aspect to the Wares and Services. Even though a “P” appears in the design of the Mark and may be associated with a parking lot, the parties’ marks, taken as a whole, are nonetheless not similar in appearance or sound or in the ideas suggested by them. This factor favours the Applicant.

[26] I find that the Applicant has discharged its burden of proving, on the balance of probabilities, that the Mark is not confusing with the Opponent’s mark P & Design. I base my decision on the fact that the Mark is more inherently distinctive than the Opponent’s mark, the marks bear little resemblance to each other, and the only element that the two marks here have in common is the letter P, which is, to say the least, highly suggestive when used in association with parking lot operations.

[27] Therefore, regardless of whether or not the Opponent has discharged its initial burden of proof, the second ground of opposition is rejected.

[28] I would add that, if I had interpreted the first ground of opposition as if it had been worded as a ground of opposition based on paragraph 16(3)(b) of the Act (to take into account the reference to the Opponent’s application for registration pending at the time of the filing of the statement of opposition), the outcome of the analysis of the subsection 6(5) factors would have been the same, and this ground would also have been rejected.

Distinctiveness of the Mark

[29] The distinctiveness of the Mark must be considered from the filing date of the statement of opposition [see *Andres Wines Ltd. and E&J Gallo Winery* (1975), 25 C.P.R. (2d) 126, and *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317]. The Opponent must first show that its trade-mark P & Design had become sufficiently known in Canada by January 30, 2007 [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44]. I am unable to make that finding based on the evidence described above. Once again, if this conclusion had been wrong, I would then have been required to determine whether the Mark is confusing with the Opponent’s trade-mark P & Design. The result of that analysis would have

been identical to the one obtained in the analysis of the first ground of opposition, even though the relevant dates are different.

[30] I also reject the third ground of opposition.

Conclusion

[31] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Jean Carrière
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
Tu-Quynh Trinh