



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

Citation: 2010 TMOB 86
Date of Decision: 2010-06-10

**IN THE MATTER OF AN OPPOSITION
by Réno-Dépôt Inc. against application
Nos. 1,318,428 and 1,318,285 for the
trade-marks ALBI RENOVA and ALBI
RENOVA & Design in the name of Albi
Homes Ltd.**

[1] On September 29, 2006, Albi Homes Ltd. [the Applicant] filed an application to register the trade-mark ALBI RENOVA based on use in Canada in association with planning, designing, estimating and completing interior and exterior repairs, remodelling, improvements and/or renovations for residential housing [the Services] since at least as early as January 31, 2003. On September 28, 2006, the Applicant filed an application to register the trade-mark ALBI RENOVA & Design, shown below, based on use in Canada in association with the Services since at least as early as July 1, 2006.



[2] Where appropriate, ALBI RENOVA and ALBI RENOVA & Design will hereinafter be referred to together as “the Marks”.

[3] The applications for ALBI RENOVA and ALBI RENOVA & Design were advertised for opposition purposes in the *Trade-marks Journal* of July 18, 2007 and June 13, 2007, respectively.

[4] On August 29, 2007, Réno-Dépôt Inc. [the Opponent] filed a statement of opposition against the ALBI RENOV A application. On August 13, 2007, the Opponent filed a statement of opposition against the ALBI RENOV A & Design application. On October 30, 2007, the Opponent was granted leave to file an amended statement of opposition in relation to the trademark ALBI RENOV A & Design in order to correct some clerical errors. The grounds of opposition to can be summarized as follows:

1. The applications do not comply with the requirements of s. 30 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 [the Act] since at the filing date of the applications (a) the Applicant had not used the Marks in association with the Services from the dates claimed in the applications; (b) the marks which the applicant claims to have used are not the Marks; (c) alternatively, or cumulatively, the alleged use of the Marks in association with the Services has discontinued in whole or in part; and (d) the statements that the Applicant was satisfied as to its entitlement to the use of the Marks was false in view of the content of the statements of opposition.
2. The Marks are not registrable pursuant to s. 12(1)(d) of the Act because they are confusing with 11 registered trade-marks set out in Schedule A to the statement of opposition.
3. The Applicant is not the person entitled to registration of the Marks since, contrary to the provisions of s. 16(1)(a) of the Act, at the claimed dates of first use, as well as at any other material time, the Marks were confusing with one or more of the Opponent's marks as set out in Schedule A to the statement of opposition, all of which were previously used or made known in Canada by the Opponent or its licensee or predecessor in title, in association with the wares, services and business of hardware, decoration and construction materials and accessories, including the sale and installation of products in the nature of hardware, renovation and decoration; providing advice to customers on matters related to hardware, renovation and decoration, including, for example providing advice on planning the construction of residential houses, planning interior home renovations (e.g. kitchen, bathroom, basements), planning exterior home renovations (e.g. shed, terrace, fence, garage, patio); and all products and services mentioned in the registration particulars attached as Schedule A to the statement of opposition.

4. The Applicant is not the person entitled to registration of the Marks since, contrary to the provisions of s. 16(1)(c) of the Act, at the claimed dates of first use and at any material date, the Marks were confusing with the following trade names: RÉNO DÉPÔT INC., RENO-DEPOT, RÉNODÉPÔT INC., RENODEPOT, RÉNO DÉPÔT, RENO DEPOT which were all previously used in Canada by the Opponent or its licensee or predecessor in title, in association with the wares, services and business of hardware, decoration and construction materials and accessories, including the sale and installation of products in the nature of hardware, renovation and decoration; providing advice to customers on matters related to hardware, renovation and decoration, including, for example providing advice on planning the construction of residential houses, planning interior home renovations (e.g. kitchen, bathroom, basements), planning exterior home renovations (e.g. shed, terrace, fence, garage, patio); and all products and services mentioned in the registration particulars attached as Schedule A to the statement of opposition.
5. The Applicant is not the person entitled to registration of the Marks since, contrary to the introductory paragraph of s. 16(1) of the Act, (a) the applications do not comply with the requirements of s. 30 of the Act; (b) the Marks are not used ones but rather proposed ones or ones for which the use, if any, has been discontinued; and (c) the Marks are not registrable or do not function as trade-marks.
6. The Marks are not distinctive and are not adapted to distinguish the Services from the wares or services of the Opponent in light of the contents of the statement of opposition; and the Marks were used by third parties outside the scope of licensed use provided for by s. 50 of the Act.

[5] The Applicant filed and served counter statements in which it denies the Opponent's allegations and puts the Opponent to the strict proof thereof.

[6] The Opponent did not file any evidence in support of its oppositions.

[7] The Applicant filed identical evidence in support of its applications, that is an affidavit of Ryan B. Atkins, sworn October 17, 2008 with Exhibits A through C and certified copies of the file histories from the Canadian Intellectual Property Office (CIPO) for ALBI RENNOVA and

ALBI RENOVA & Design applications and for its application No.1,318,429 for the trade-mark RENOVA.

[8] Only the Applicant filed a written argument in each proceeding. Neither party requested an oral hearing.

[9] The statements of opposition, the evidence, and the written arguments of the Applicant are identical in both files. Thus, unless indicated otherwise, my findings with respect to the grounds of opposition apply to each application.

Applicant's Evidence

Ryan B. Atkins

[10] Mr. Atkins is the Applicant's General Legal Counsel and Chief Financial Officer. In his affidavit, Mr. Atkins states that the Applicant has used the trade-marks ALBI RENOVA and ALBI RENOVA & Design in Canada continuously since at least as early as January 31, 2003 and July 1, 2006, respectively, in association with the Services.

[11] Mr. Atkins attaches documents to his affidavit which he purports evidence use of the Marks in association with the Services. Mr. Atkins also files representative specimens of advertising for the Services. The specimens of use and advertising will be discussed in further detail below in the assessment of the s. 30(b) ground of opposition.

[12] In paragraphs five to seven and nine through ten of his affidavit, Mr. Atkins expresses his opinions on various substantive issues relating to each opposition proceeding. The merit of the oppositions is the issue to be decided by the Registrar from the evidence filed in the present proceedings and accordingly the affiant's opinions on these matters will not be considered [see *British Drug Houses Ltd. v. Battle Pharmaceuticals* (1944), 4 C.P.R. 48 at 53 and *Les Marchands Deco Inc. v. Society Chimique Laurentide Inc.* (1984), 2 C.P.R. (3d) 25 (T.M.O.B.)].

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[13] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its applications comply with the requirements 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 [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Section 30 Grounds

[14] The material date for considering grounds of opposition based on s. 30 of the Act is the date the applications were filed [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475 and *Tower Conference Management Co. v. Canadian Exhibition Management Inc.* (1990), 28 C.P.R. (3d) 428 at 432 (T.M.O.B.)], namely September 29, 2006 for ALBI RENOV A and September 28, 2006 for ALBI RENOV A & Design.

Section 30(b) Ground

[15] The Opponent did not file any evidence in support of this ground of opposition. The Opponent may, however, rely on the Applicant's evidence to meet its initial burden [see *Molson Canada v. Anheuser-Busch Inc.*, (2003), 29 C.P.R. (4th) 315 (F.C.T.D.), and *York Barbell Holdings Ltd. v. ICON Health and Fitness, Inc.* (2001), 13 C.P.R. (4th) 156 (T.M.O.B.)] in relation to this ground, however, it is under an obligation to show that the Applicant's evidence is "clearly inconsistent" with the Applicant's claims set forth in its applications [see *Ivy Lea Shirt Co. v. 1227624 Ontario Ltd.* (1999), 2 C.P.R. (4th) 562 at 565-6 (T.M.O.B.), *aff'd* 11 C.P.R. (4th) 489 (F.C.T.D.)].

[16] The documents set out below feature the trade-mark ALBI RENOV A:

- Press release dated January 31, 2003 advertising the Applicant's new renovation, repair and remodelling services under a new name: ALBI RENOV A.
- Joist Framing Plan for a renovation dated October 2, 2002.
- Article published in the New Homes Section of the *Calgary Herald* newspaper dated February 15, 2003.
- Change to Renovation Project Description dated December 2003.

- City of Calgary Development Completion Permit (the Applicant is listed as agent) dated March 2004.

[17] I find that only the Change to Renovation Project Description dated December 2003 amounts to use of the trade-mark ALBI RENOVA as defined by s. 4(2) of the Act. At best, the remaining documents feature trade name use of “Albi Renova”.

[18] Some documents feature the words “Albi” and “Renova” as part of the following design:



In the case of the trade-mark ALBI RENOVA, the Applicant is not under a restriction to use the trade-mark ALBI RENOVA in any particular format. As such, the use of the words ALBI and RENOVA as part of the design shown above can be considered use of the trade-mark ALBI RENOVA. The following documents and advertising specimens, as of the material date, feature the trade-mark ALBI RENOVA in this form:

- Renovation Project Descriptions, Selection Sheets, Contract Agreements and associated project documentation including invoices dated February 2003, April 2003, June 2003, July 2003, September 2003 and November 2003.
- Advertisements in Calgary Renovations Home Improvement and Design Magazine dated Summer 2004, Winter 2004 and Winter 2005.

[19] The Atkins affidavit attaches the following specimens of use of the trade-mark ALBI RENOVA & Design, as of the relevant date:

- Renovation Project Specifications and Contract Agreements dated September 2006.

[20] All specimens of advertising for the Services displaying the trade-mark ALBI RENOVA & Design adduced in the Atkins affidavit are dated after the material date.

[21] On a fair reading of Mr. Atkins’ affidavit as a whole, I am satisfied that the evidence adduced therein is not clearly inconsistent with the Applicant’s claimed dates of first use for the

Marks. In his affidavit, Mr. Atkins attests to the use of the Marks since the dates claimed in the applications and provides specimens of use and advertisements which I have accepted as showing use of the Marks. Given that the Applicant is not under a burden to prove continuous use of the Marks since the date claimed in each application, I find that the Opponent has not met its burden to show that the Applicant's evidence is clearly inconsistent with the claimed dates of first use, namely, January 31, 2003 for ALBI RENOVA and July 1, 2006 for ALBI RENOVA & Design.

[22] The Opponent has failed to meet its initial evidential burden and accordingly, the s. 30(b) ground is dismissed.

Section 30(i) Ground

[23] The requirement under s. 30(i) of the Act is to include, in the application, a statement that the applicant is satisfied that it is entitled to use the mark in Canada in association with the services. The Applicant provided such statements in its applications.

[24] Where the relevant statement is provided, a s. 30(i) ground of opposition should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of the Applicant [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 at 155 (T.M.O.B.)].

[25] As these are not such exceptional case as there is no evidence of bad faith, I am dismissing this ground of opposition.

Section 12(1)(d) Ground of Opposition

[26] The material date for assessing confusion pursuant to s. 12(1)(d) of the Act is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

[27] Pursuant to s. 12(1)(d) of the Act, the Opponent has pleaded that the Marks are not registrable because the Marks are confusing with the following registered trade-marks:

Trade-mark	Registration No.
RENO DEPOT	TMA527,493
	TMA550,695
	TMA550,696
RENO-DEPOT	TMA428,486
	TMA439,001
RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION	TMA452,238
	TMA522,617
RÉNO-DÉPÔT LE PREMIER ENTREPÔT DE LA RÉNOVATION	TMA430,926
RENODEPOT	TMA527,494
RENODEPOT.COM	TMA601,880
WWW.RENODEPOT.COM	TMA601,878

Unless indicated otherwise, I will hereafter collectively refer to these registered trade-marks as the “Cited Marks”.

[28] I have considered it appropriate in this case to exercise the Registrar’s discretion to check the Register to determine whether the Cited Marks are in good standing as of today’s date [see *Quaker Oats Co. of Canada Ltd. / La Compagnie Quaker Oats du Canada Ltée. v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 at 411 (T.M.O.B.)]. Since the Opponent has discharged its initial burden with respect to this ground of opposition, the burden of proof lies on the Applicant to convince the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Marks and the Cited Marks.

[29] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or

services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[30] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 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 each has 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. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.)]

[31] Prior to assessing the surrounding circumstances of this case, I will first to address two general submissions made by the Applicant in its written argument.

[32] The Applicant submits an argument based on the state of the register with respect to the element “depot”, arguing that the word “depot” appears in more than 252 pending or registered marks on the register. No evidence supporting this claim was filed. In opposition proceedings, the Registrar does not exercise her discretion to have regard to anything appearing on the register that is not properly proved by evidence, except to verify whether properly pleaded trade-mark registrations and applications are extant, as I have done in this case. Without evidence, I am unable to make a determination on this submission.

[33] The Applicant has also submitted that the fact that the Cited Marks were not raised as objections to the registrability of the Marks at the examination stage is proof that there is no likelihood of confusion between the Marks and the Cited Marks. This argument is of no assistance to the Applicant’s cases. A decision by an Examiner does not have precedential value for the Board because both the onus and evidence before an Examiner differs from that before the Board [see *Thomas J. Lipton Inc. v. Boyd Coffee Co.* (1991), 40 C.P.R. (3d) 272 (T.M.O.B.) at 277 and *Procter & Gamble Inc. v. Morlee Corp.* (1993), 48 C.P.R. (3d) 377 (T.M.O.B.) at 386].

6(5)(a) – *the inherent distinctiveness of the trade-marks and the extent to which they have become known*

[34] The Applicant has conceded that “reno” is a well-known shortened form for the word “renovation”. Furthermore, I am aware that the word “renova” is essentially the simple past conjugation of the verb “rénover” (to renovate) in French. While the word RENOVA in the Marks is suggestive of the Services, the ALBI element, which is the first word of both of the Marks, is a coined word that is neither descriptive nor suggestive of the Services and thus serves to add some measure of inherent distinctiveness to the Marks.

[35] The trade-mark ALBI RENOVA & Design features design elements in the form of graphical representations of columns which, together, give the appearance of a coliseum. These design elements serve to add further inherent distinctiveness to the trade-mark ALBI RENOVA & Design.

[36] The Applicant’s evidence does not allow me to determine the extent that the Marks have become known. Specifically, the Atkins affidavit does not include sales figures or advertising expenditures. Furthermore, we have no evidence of circulation figures for the advertisements adduced as exhibits, or any other evidence which would provide insight into the extent to which the Marks have become known in the Canadian marketplace.

[37] The Applicant submits that the Cited Marks possess little inherent distinctiveness because a significant part of each is descriptive of the Opponent’s services. Specifically, the Applicant submits that “reno” is a well-known shortened form for “renovation” and “depot” is a dictionary word which means “place”, “warehouse” or “repository”. However, while “réno” (reno) may be suggestive of “rénovation” (renovation) and “dépôt” (depot) is a word of the ordinary language, the coined word “réno- dépôt” (reno-depot) does add some measure of inherent distinctiveness to the Cited Marks.

[38] The Opponent has filed no evidence. Under these circumstances, the mere existence of the registrations can establish no more than *de minimus* use and cannot give rise to an inference

of significant and continuous use of the Cited Marks [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.)]. As such, I am unable to determine the extent to which the Cited Marks have become known.


[39] Ultimately, I find that both ALBI RENOV A and ALBI RENOV A & Design possess a higher degree of inherent distinctiveness than the Cited Marks. By virtue of its additional distinctive design elements, ALBI RENOV A & Design possesses the highest degree of inherent distinctiveness.




6(5)(b) – the length of time each has been in use

[40] The applications for ALBI RENOV A and ALBI RENOV A & Design claim use since January 31, 2003 and July 1, 2006, respectively. The earliest specimen of use of the trade-mark ALBI RENOV A attached to the Atkins affidavit is dated February 2003 and the one for the trade-mark ALBI RENOV A & Design is dated September 2006. In addition to the specimens discussed under the s. 30(b) ground of opposition, given the later material date for the s. 12(1)(d) ground of opposition, the following specimens of use and advertisement of the trade-mark ALBI RENOV A & Design are relevant:

- Renovation Project Specifications and Contract Agreements dated October and November 2006.
- Advertisement in the January – March 2008 issue of *Renovations: Home Improvement & Design Magazine*.
- Advertisement in the Calgary Sun New Homes Publication *Saluting Sam* dated 2007.
- Advertisement in the January – March 2008, May – June 2008 and July – August 2008 issues of *Renovations: Home Improvement & Design Magazine*.

[41] The Cited Marks claim the following first use dates:

Trade-mark	Registration No.	First Use Date
RENO DEPOT	TMA527,493	At least as early as May 3, 1994
	TMA550,695	At least as early as October 30, 1999

	TMA550,696	At least as early as October 30, 1999
RENO-DEPOT	TMA428,486	Declaration of use filed May 3, 1994
	TMA439,001	Declaration of use filed May 20, 1994
RÉNO-DÉPÔT L'ENTREPÔT DE LA RÉNOVATION	TMA452,238	At least as early as March 16, 1993
	TMA522,617	At least as early as March 16, 1993
RÉNO-DÉPÔT LE PREMIER ENTREPÔT DE LA RÉNOVATION	TMA430,926	Declaration of use filed June 2, 1994
RENODEPOT	TMA527,494	At least as early as May 3, 1994
RENODEPOT.COM	TMA601,880	At least as early as April 27, 1997
WWW.RENODEPOT.COM	TMA601,878	At least as early as April 27, 1997

[42] As previously noted, the mere existence of the registrations can establish no more than *de minimus* use and cannot give rise to an inference of significant and continuous use of the Cited Marks.

6(5)(c) – *the nature of the services*

[43] It is the Applicant’s statements of services as defined in its applications versus the Opponent’s registered wares and services that govern my determination of this factor [see *Esprit International v. Alcohol Countermeasure Systems Corp.* (1997), 84 C.P.R. (3d) 89].

[44] The Applicant applied to register the Marks for “planning, designing, estimating and completing interior and exterior repairs, remodelling, improvements and/or renovations for residential housing”. The registrations for the Cited Marks cover various wares and services, however, I will analyse only the services I consider most relevant to the Services.

[45] With the exception of RENODEPOT.COM (TMA601,880) and WWW.HOMEDEPOT.COM (TMA601,878), the registered statements of services all feature services of the following nature, which I find to be most relevant to the determination of this factor under s. 6(5)(c) of the Act:

operation, promotion and management of stores specializing in the wholesale and retail sale of hardware, materials and accessories for construction, renovation and decoration, domestic and household appliances, articles and accessories for gardening, furniture, paint, varnish and solvents;

sale and installation of hardware products and products for renovation and decoration;

advice related to hardware, renovation and decoration;

[46] Of the Opponent's services set out above, those most similar to the Services are the sale and installation of products for renovation and the provision of advice related to renovation. To the extent that the Marks and the Cited Marks are associated with renovation services, there is some overlap in the nature of the services.

[47] The services associated with RENODEPOT.COM (TMA601,880) and WWW.HOMEDEPOT.COM (TMA601,878) relate to the operation of a website dealing with the sale of hardware items, materials and accessories for building, renovation and decoration and the posting of advice in relation to hardware, renovation and decoration. These website services are similar to the Services but only insofar as they relate to renovation.

6(5)(d) – nature of the trade

[48] With respect to the first and third categories of the Opponent's services as set out above in paragraph 45, the Applicant submits that the Opponent's trade involves the operation of stores selling products for, and offering advice to customers ("do-it-yourselfers") regarding, renovation and construction activities which the customers intend to carry out themselves. In the absence of evidence from the Opponent and based on a fair reading of the registered statements of services, I agree with the Applicant's submission.

[49] The Applicant submits that, by contrast, its trade involves the provision of repair and renovation services which are planned, managed and conducted by the Applicant's employees

without participation from the customers aside from minor involvement in the early planning stages of projects. I agree.

[50] Of the Opponent's services, those which are most similar to the Services are the "sale and installation of ... products for renovation...". There is some overlap between the Opponent's "sale and installation of ... products for renovation..." services and the Services. The Opponent has not provided any evidence of the nature of the trade associated with its services. In other words, it is not clear whether the "sale and installation of ... products for renovation..." services are merely incidental to the Opponent's wholesale and retail store trade, which I have accepted is of a different nature than the Applicant's trade, or whether they are offered independently from the wholesale and retail store services. In light of the fact that the Opponent's "sale and installation of ... products for renovation..." services are not identical to the Services and in the absence of evidence regarding the nature of the Opponent's trade, I am not prepared to infer a direct overlap in the parties' channels of trade.

[51] Notwithstanding any possible overlap in the nature of the services or channels of trade, the Applicant submits that its services are expensive and that given that they involve customers inviting strangers into their homes to carry out renovations, they are such that customers will likely devote a considerable amount of attention to researching the service providers, which decreases the likelihood of confusion between the Marks and the Cited Marks. My review of the Atkins affidavit reveals sample contracts between the Applicant and its customers which demonstrate fees for the Services in the range of \$30,000 to \$256,000. I agree with the Applicant's submissions that where services are expensive and purchased only after careful consideration, confusion will be less likely [see *General Motors Corp. v. Bellows* (1949), 10 CPR 101 at 116-117 and *United Artists Corp. v. Pink Panther Beauty Corp.* (1998), 80 C.P.R. (3d) 247 (F.C.A.)].

6(5)(e) – the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[52] In most instances, the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in

the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2) 145, conf. 60 C.P.R. (2d) 70 (F.C.T.D.)].

[53] As a preliminary matter, I note that I do not find that there is any distinguishable difference between the English and French versions of the RENO-DEPOT (RÉNO-DÉPÔT) element of the Cited Marks.

[54] However, when assessing confusion it is not proper to dissect trade-marks into their component parts, rather, marks must be considered in their entirety [see *British Drug Houses Ltd. v. Battle Pharmaceuticals*, [1944] Ex. C.R. 239, at 251, affirmed [1946] S.C.R. 50 and *United States Polo Assn. v. Polo Ralph Lauren Corp.* (2000), 9 C.P.R. (4th) 51 at para 18, aff'd [2000] F.C.J. No. 1472 (C.A.)]. Furthermore, confusion will be unlikely in situations where marks share common features but also feature dominant differences [see *Foodcorp Ltd. v. Chalet Bar B Q (Canada) Inc.* (1982), 66 C.P.R. (2d) 56 at 73 (F.C.A.)]. On this basis, the mere fact that the Marks and the Cited Marks share a common element (RENO) will not be determinative.

[55] It is a well-accepted principle that the first portion of a trade-mark is the most relevant for the purposes of distinction [*Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) at 188]. The word ALBI is a coined word with no meaning which is inherently distinctive; by contrast, the word RENO is suggestive of renovation. It is clear that the word ALBI is significantly different in appearance, sound and idea suggested, from the word RENO.

[56] Ultimately, when considering the Marks and the Cited Marks as a whole, I am not convinced that the mere fact that the Marks contain the suggestive RENO element is sufficient to find that the Marks share any significant degree of similarity in either appearance or sound with the Cited Marks. The first and most important elements of the Marks and the Cited Marks are entirely different (i.e. ALBI vs. RENO) in terms of sound and appearance and ideas suggested. Furthermore, the word components of the Marks, namely ALBI and RENOVA, are significantly different in terms of sound and appearance from the dominant RENO-DEPOT element common to the Cited Marks. In addition, some of the Cited Marks (TMA550,695; TMA550,696) feature

design elements which serve to further distinguish them from the Marks. Finally, the design elements associated with the trade-mark ALBI RENOVA & Design serve to further distinguish it from the Cited Marks, including those involving design elements. In fact, there are no common features between the design element of the trade-mark ALBI RENOVA & Design and the design elements found in some of the Cited Marks.

[57] The Cited Marks all feature the RENO-DEPOT element which suggests the idea of a renovation warehouse. Some of the Cited Marks (TMA452,238; TMA522,617; TMA430,926) also include the word RÉNOVATION which further strengthens the “renovation” idea.

[58] When the trade-mark ALBI RENOVA is considered as a whole, the word ALBI takes away from the idea of renovation suggested by the word RENOVA. The trade-mark ALBI RENOVA & Design is even less suggestive of the idea of renovation due to its additional design elements in the form of graphical representations of columns which together, make up an image of a coliseum which may suggest a link to architecture.

[59] Based on the foregoing, I conclude that the important differences between ALBI RENOVA and the Cited Marks in terms of sound and appearance are significant enough to outweigh any similarities in terms of the ideas suggested. With respect to the trade-mark ALBI RENOVA & Design, I find that in addition to the differences in sound and appearance, the associated design elements serve to create a distinction between the ideas suggested by the ALBI RENOVA & Design and the Cited Marks [see *General Housewares Corp. v. Fiesta Barbeques Ltd.* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.) and Practice Notice: Paragraph 12(1)(b): "Sounded" Test Applied to Composite Marks Which Include Words That Are the Dominant Feature of the Mark, Publication Date: 2005-02-16].

Conclusion re s. 12(1)(d)

[60] Having considered all of the surrounding circumstances, in particular the degree of inherent distinctiveness of the trade-mark ALBI RENOVA, the length of time the trade-marks have been in use, the nature of the trade and the differences between the trade-marks in sound and in appearance, I am satisfied that the Applicant has discharged its burden of showing, on a

balance of probabilities, that there is no reasonable likelihood of confusion between the trade-mark ALBI RENOV A and any of the Cited Marks.

[61] Likewise, having considered all of the surrounding circumstances, in particular the degree of inherent distinctiveness of the trade-mark ALBI RENOV A & Design, the length of time the trade-marks have been in use, the nature of the trade and the differences between the trade-marks in sound, appearance and ideas suggested, I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the trade-mark ALBI RENOV A & Design and any of the Cited Marks.

[62] Having regard to the foregoing, I dismiss the ground of opposition based on s. 12(1)(d) of the Act.

Entitlement Grounds of Opposition

[63] The material date for considering the entitlement grounds of opposition is the Applicant's claimed date of first use, namely, January 31, 2003 for ALBI RENOV A and July 1 2006 for ALBI RENOV A & Design [see s. 16(1) of the Act].

[64] Despite the burden of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Marks and the Opponent's trade-marks or trade names, the Opponent has the initial onus of proving that the trade-marks and trade names alleged in support of its grounds of opposition based on s. 16(1)(a) and 16(1)(c) of the Act were being used at the Applicant's claimed dates of first use and had not been abandoned at the date of advertisement of the application [s. 16(5) of the Act].

Section 16(1)(a) of the Act

[65] The Opponent has based the ground of opposition under s. 16(1)(a) of the Act on the same registered trade-marks alleged in support of the s. 12(1)(d) registrability ground of opposition, namely, the Cited Marks.

[66] As I have previously noted, the Opponent did not adduce any evidence of use of the Cited Marks. Accordingly, the Opponent has not discharged its burden of showing prior use of any of the Cited Marks. Accordingly, I dismiss the ground of opposition based on s. 16(1)(a) of the Act.

Section 16(1)(c) of the Act

[67] Since the Opponent has not filed any evidence, I find that the Opponent did not discharge its burden of showing prior use of any of its alleged trade names, namely, RÉNO DÉPÔT INC., RENO-DEPOT, RÉNODÉPÔT INC., RENODEPOT, RÉNO DÉPÔT, RENO DEPOT. Accordingly, I dismiss the ground of opposition based upon s. 16(1)(c) of the Act.

Introductory Paragraph of Section 16(1) of the Act

[68] The Opponent alleges that the Applicant is not entitled to registration of the Marks since, contrary to the introductory paragraph of s. 16(1) of the Act, (a) the applications do not comply with the requirements of s. 30 of the Act; (b) the Marks are not used ones but rather proposed ones; (c) the Marks are not registrable or do not function as trade-marks.

[69] The introductory paragraph of s. 16(1) of the Act does not form the basis of a ground of opposition as defined in s. 38(2) of the Act since s. 16(1) of the Act as a whole relates to the entitlement ground of opposition. Accordingly, I dismiss this ground of opposition based solely upon the introductory paragraph of s. 16(1) of the Act.

Distinctiveness Ground of Opposition

[70] While there is a legal onus on the Applicant to show that the Marks are adapted to distinguish or actually distinguish its wares from those of others throughout Canada [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (T.M.O.B.)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness. The material date for assessing distinctiveness is the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

[71] The Opponent appears to have pleaded the non-distinctiveness ground of opposition as a two-pronged ground of opposition with the first prong relating to the Opponent's trade-mark rights, the second prong relating to un-licensed trade-mark use of the Marks. The Opponent has not alleged any facts supporting the second prong of this ground of opposition and as such I find that it has not met its burden and I reject it accordingly.

[72] With respect to the first prong of the ground, pursuant to its evidential burden, the Opponent is under an obligation to show that, as of the filing date of the statements of opposition, the Cited Marks had become known sufficiently to negate the distinctiveness of the Marks [see *Bojangles' International, LLC v. Bojangles Café Ltd.* (2004), 40 C.P.R. (4th) 553, affirmed (2006), 48 C.P.R. (4th) 427 (F.C.T.D.)]. The Opponent has not filed any evidence to support this ground of opposition. I therefore dismiss the first prong of the ground of opposition based upon non-distinctiveness.

[73] Based on the foregoing, I reject the non-distinctiveness ground of opposition in its entirety.

Disposition

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

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office