

**IN THE MATTER OF AN OPPOSITION by
Central City U-Lock Ltd. against application
No. 1242654 for the trade-mark U LOCK and
Design in the name of JCM Professional Mini-
Storage Management Ltd.**

[1] On January 5, 2005, JCM Professional Mini-Storage Management Ltd. (the “Applicant”) filed an application to register the trade-mark U LOCK & Design (the “Mark”), which is shown below:



The application is based upon use of the Mark in Canada since at least as early as May 1, 2004, in association with the following services, as revised, “the leasing and operation of self-service mini-storage facilities.” The Applicant disclaims the right to the exclusive use of the word LOCK apart from the Mark.

[2] The application was advertised for opposition purposes in the Trade-marks Journal of October 19, 2005. On November 14, 2005, Central City U-Lock Ltd. (the “Opponent”) filed a statement of opposition. The grounds of opposition are that the Applicant’s application does not conform to the requirements of s. 30(a), s. 30(b) and s. 30(i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (“the Act”), the Mark is not registrable pursuant to s. 12(1)(b) because it is either clearly descriptive or deceptively misdescriptive of the character or quality of the Applicant’s services and the Mark is not distinctive.

[3] The Applicant filed and served a counter statement.

[4] In support of its opposition, the Opponent filed the affidavit of Lisa Saltzman and certified copies of Canadian trade-mark registration no. TMA245,975 and application no. 1,283,150. In support of its application, the Applicant filed the affidavit of Robert Madsen. As evidence in

reply, the Opponent filed the affidavit of Dulce De Jesus Queiroga Campos. No cross-examinations were conducted.

[5] Only the Opponent filed a written argument. An oral hearing was held at which only the Opponent was represented.

Onus and Material Dates

[6] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies 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].

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

- s. 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- s. 12(1)(b) - the filing date of the application [see *Fiesta Barbeques Ltd. v. General Housewares Corp.* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)].
- non-distinctiveness - 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.)].

Section 30(a) Ground

[8] With respect to the test to be applied under s. 30(a) of the Act, the Registrar of Trade-marks stated in *Dubiner and National Yo-Yo and Bo-Lo Ltd. v. Heede Int'l Ltd.* (1975), 23 C.P.R. (2d) 128 that an applicant in its application “must clearly set forth wares or services as they are customarily referred to in the trade.” Further, in *McDonald's Corporation and McDonald's Restaurants of Canada Ltd. v. M.A. Comacho-Saldana International Trading Ltd. carrying on business as Macs International* (1984), 1 C.P.R. (3d) 101 at 104, the Hearing Officer

concluded that it was only necessary for the opponent in that case to present sufficient argument in order to meet its initial burden in respect of a s. 30(a) ground.

[9] The Opponent has alleged that the Applicant's services are not described in ordinary commercial terms. In this regard, the Opponent submits that the Applicant failed to clarify its type of storage and it is therefore ambiguous as to what types of storage the Applicant is referring to. Further, the Opponent notes that the Wares and Services Manual, as kept by the Canadian Intellectual Property Office, contains no listing for the term "mini-storage facilities".

[10] The Applicant's evidence, on the other hand, include pages from Canadian telephone directories which make reference to "mini-storage" as self storage meaning that the renter/leaser stores his/her own goods. Further, the Opponent's own evidence shows the term "mini-storage" in several of the directory listings for storage services.

[11] Having regard to the evidence furnished, it appears that the term "self-service mini-storage" is a term customarily referred to in the trade as designating the services of self storage where the renter/leaser stores his/her own goods. I therefore find that the services described as "the leasing and operating of self-service mini-storage facilities" sufficiently define the nature of the services being rendered without the necessity of the Applicant identifying the nature of "mini-storage" in more specific terms. This ground is therefore unsuccessful.

Section 30(b) Ground of Opposition

[12] The Opponent pleads that the application does not conform to the requirements of s. 30(b) in that the Mark has not been used in Canada in association with the services listed in the application since the date of first use alleged in the application. To the extent that the relevant facts with respect to this ground of opposition are more readily available to the Applicant, the evidentiary burden on the Opponent with respect to this ground of opposition is lower, and can be met by reference to the Applicant's own evidence [see *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.); *Labatt Brewing Company Limited v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.)]. In such a case,

however, the Opponent must show that the evidence is clearly inconsistent with the Applicant's claim [see *York Barbell Holdings Ltd. v. ICON Health & Fitness, Inc.* (2001), 13 C.P.R. (4th) 156 (T.M.O.B.)].

[13] From the evidence furnished, I am not satisfied that the Opponent has met its initial burden with respect to s. 30(b). In this regard, the Opponent submits that neither the Applicant's name nor its Mark appears in the results of the corporate and Internet searches conducted by Ms. Saltzman and Mr. Campos. The Opponent further submits that the Applicant's own advertisement in the 2003/2004 Langley-North Delta- Surrey – White Rock Yellow Pages does not show use of the Mark.

[14] In order to meet its burden under this ground, it was up to the Opponent to either file evidence that raises doubt with respect to the Applicant's claim that the Mark was first used on May 1, 2004, or point to enough ambiguities or inconsistencies in the Applicant's evidence to cast doubt on the veracity of the Applicant's claimed date of first use.

[15] While I agree with the Opponent that it is curious that neither the Applicant's name nor its trade-mark appeared in any of the common law and domain search results conducted by the Opponent's affiants, this fact alone in my view does not raise any doubt about the veracity of the Applicant's claim that it has used its Mark since as early as May 1, 2004. Further, while the Mark may not appear on the yellow pages advertisement submitted as an exhibit to Mr. Madsen's affidavit, Mr. Madsen did not state that the Mark had been used in such advertisement. Further, the Mark does appear on the sample of a "customer referral card" handed and mailed out to customers in 2003 attached as Exhibit B to Mr. Madsen's affidavit. I therefore have no reason to doubt that when Mr. Madsen says the Applicant's Mark has been used in association with the applied for services, he understands what qualifies as use pursuant to s. 4.

[16] As a result, since the Opponent did not raise any doubt about the veracity of the Applicant's claim that it had used its Mark since as early as May 1, 2004, the Applicant was not obliged to evidence the use of the Mark since such date. If the Opponent wished to pursue this

issue, it could have chosen to cross-examine Mr. Madsen. This ground of opposition is therefore unsuccessful.

Section 30(i) Ground of Opposition

[17] 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. Such a statement has been provided. Where an Applicant has provided the statement required by s. 30(i), a s. 30(i) ground 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 (T.M.O.B.) at 155]. As this is not such a case, I am dismissing this ground of opposition.

Section 12(1)(b) Ground of Opposition

[18] The issue as to whether the Applicant's Mark is clearly descriptive or deceptively misdescriptive of the character or quality of the applied for services must be considered from the point of view of the average purchaser of those services. Further, "character" means a feature, trait or characteristic of the services and "clearly" means "easy to understand, self-evident or plain" [*Drackett Co. of Canada Ltd v. American Home Products Corp.* (1968), 55 C.P.R. 29 at 34]. Finally, the Mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression [*Wool Bureau of Canada Ltd. v. Registrar of Trade Marks* (1978), 40 C.P.R. (2d) 25 (F.C.T.D.) at 27-8; *Atlantic Promotions Inc. v. Registrar of Trade Marks* (1984), 2 C.P.R. (3d) 183 (F.C.T.D.) at 186].

[19] In its written argument, the Opponent provides dictionary definitions from the Merriam-Webster on-line dictionary for the words "you" and "lock". A definition for the word "you" is as follows: the one or ones being addressed – used as the pronoun of the second person singular in any grammatical relation except that of a possessive. Definitions for the word "lock" include: 1. to fasten the lock of b: to make fast with or as if with a lock. 2. a. to fasten in or out or to make secure or inaccessible by or as if by means of locks.

[20] The Opponent also relied on results of corporate, trade-mark and Internet searches in its evidence which located third party uses of the term “U LOCK” or its phonetic equivalent to describe storage services where the customer is responsible for locking the goods that they store.

[21] Relying on the decision in *Best Canadian Motor Inns Ltd. v. Best Western International Inc.* (2004), 30 C.P.R. (4th) 481 (F.C.T.D.) (“*Best Canadian Motor Inns*”), the Opponent submits that the descriptive phrase “U LOCK” is clearly the dominant and most influential feature of the Mark in both font, shape and first impression. It further argues that the visual impressions created by the background lines in the Applicant’s design are inferior in their appearance to the descriptive words “U” and “LOCK”.

[22] I can conclude from the dictionary definitions for the words “you” and “lock” that such words, when used together, are descriptive of a feature, trait or characteristic of the Applicant’s services, namely storage facilities where the customer has the ability to lock their own goods. Further, there is evidence showing that other traders use such phrase to describe their storage services.

[23] Having found that the phrase “U LOCK”, when sounded, is clearly descriptive or deceptively misdescriptive of the applied for services, the question is whether the Mark is still registrable in view of the other design components. The design component of the Mark is a building, upon which the words “U LOCK” appear. The letter “U” appears in a larger, thicker font on an angle above the word “LOCK” on what appears to be the front of the building.

[24] In my view, the representation of a building cannot be distinctive of any particular trader. Further, even though the letter “U” appears in a different font and style of lettering than what is used for the word “LOCK”, the words “U” and “LOCK” are still the dominant words forming the Mark. Applying the “clearly descriptive when sounded” test as set out in the *Best Canadian Motor Inns* decision, I would expect the average person to sound the Mark as “YOU LOCK”. I therefore find that the Mark as a whole, and as a matter of immediate impression, is clearly

descriptive, or deceptively misdescriptive, when sounded, of the Applicant's services in Canada and therefore offends s. 12(1)(b) of the Act. This ground of opposition is therefore successful.

Section 38(2)(d) Ground of Opposition

[25] The Opponent submits that a mark cannot be distinctive if it is a descriptive term which is in use by traders in similar lines of business to describe a quality and/or characteristic of their services. I agree. It has been previously held in *Imperial Tobacco Ltd. v. Benson and Hedges (Canada) Inc.* (1983), 75 C.P.R. (2d) 115 that a purely descriptive mark is necessarily non-distinctive. As I have already concluded that the Mark, when sounded, is clearly descriptive or deceptively misdescriptive of the applied for services, it follows that the Mark is also non-distinctive. Further, in view that the Applicant has not shown use of the Mark in association with the applied for services pursuant to s. 4(2) of the Act, the Mark has not acquired any distinctiveness to distinguish the Applicant's services from those of others throughout Canada. This ground of opposition is therefore also successful.

Disposition

[26] Having been delegated authority by the Registrar of Trade-marks pursuant to s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

DATED AT Gatineau, THIS 5th DAY OF November, 2009.

C.R. Folz
Member,
Trade-marks Opposition Board