



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

**Citation: 2010 TMOB 194**  
**Date of Decision: 2010-11-18**

**IN THE MATTER OF AN  
OPPOSITION by Trader  
Corporation to application  
No. 1,207,891 for the trade-mark  
NEW HOME BUYER'S  
NETWORK in the name of New  
Home Buyer's Inc.**

FILE RECORD

[1] On March 1, 2004, the applicant Paper City Mag Inc. filed an application to register the trade-mark NEW HOME BUYER'S NETWORK, based on proposed use in Canada, in association with the following wares and services:

*wares*

internet website devoted to the search for and purchase of new residential homes and condominiums,

*services*

publication of an Internet website devoted to the search for and purchase of new residential homes and condominiums.

[2] The application disclaims the right to the exclusive use of the term NEW HOME BUYER'S apart from the mark as a whole. The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated November 10, 2004 and was opposed by Classified Media (Canada) Holdings Inc. on January 10, 2005. The Registrar of Trade-marks forwarded a copy of the statement of opposition to the applicant on January 27, 2005 as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13.

The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition. The opponent was subsequently granted leave to file and serve an amended statement of opposition (see the Board ruling dated April 25, 2008) and the applicant was similarly granted leave to submit an amended counter statement (see the Board ruling dated October 31, 2008).

[3] During the course of this proceeding, the subject application was assigned to New Home Buyer's Network Inc., the current applicant of record. Also during the course of this proceeding, the original opponent merged with another company and continued as Trader Corporation, the current opponent of record.

[4] The opponent's evidence consists of the affidavit of Gordon Trembath. The applicant's evidence consists of the affidavit of Sam Reiss (sworn July 18, 2006). Mr. Reiss was cross-examined on his affidavit. The transcript thereof, exhibits thereto and answers to undertakings form part of the evidence of record. The opponent's evidence in reply consists of the affidavit of Saroja Kuruganty. The applicant was granted leave to submit a further affidavit of Sam Reiss (sworn September 20, 2007) as additional evidence: see the Board ruling dated October 23, 2007. Saroja Kuruganty was cross-examined on her affidavit, however, the transcript of her cross-examination does not form part of the evidence of record as it was filed out of time: see the Board ruling dated August 26, 2008. Both parties submitted written arguments, however, neither party responded to the Registrar's notice, dated September 17, 2009, to participate in an oral hearing.

#### STATEMENT OF OPPOSITION

[5] The first and second grounds of opposition, pursuant to s.30(i) of the *Trade-marks Act*, allege that the applicant could not have been satisfied that it was entitled to use the applied for mark NEW HOME BUYER'S NETWORK as the applicant had knowledge of the opponent's prior use of the confusingly similar trade-mark NEW HOME BUYER'S GUIDE in association with (i) magazines concerning condominiums, townhouses and single family homes, (ii) providing a medium of advertising namely, a magazine and (iii) internet websites relating to new residential homes and condominiums.

[6] The third ground of opposition, pursuant to s.30(e) of the *Act*, alleges that the applicant used the applied for mark prior to the filing date, that is, the application is falsely based on proposed use in Canada when it should be based on prior use.

[7] The fourth ground of opposition, pursuant to s.30(a) of the *Act*, alleges that the applicant's wares and services are not described in ordinary commercial terms.

[8] The fifth ground, pursuant to s.16(3)(a), alleges that the applicant is not entitled to register the applied for mark NEW HOME BUYER'S NETWORK because, at the date of filing the application, the applied for mark was confusing with the opponent's mark NEW HOME BUYER'S GUIDE previously used in Canada.

[9] The sixth ground, pleaded in the alternative to the third ground, alleges that pursuant to s.16(1)(a), the applicant is not entitled to register the applied for mark NEW HOME BUYER'S NETWORK because, at the date of first use of the applied for mark, it was confusing with the opponent's mark NEW HOME BUYER'S GUIDE previously used in Canada.

[10] The seventh and final ground alleges that the applied for mark is not distinctive of the applicant's wares and services.

#### SECTION 30(E) GROUND OF OPPOSITION

[11] The applicant, at paragraph 7 of its written argument, admits that while the subject application

. . . was for proposed use in Canada, however the evidence filed herein demonstrates use in Canada since at least as early as 1995 in respect of wares . . . and use in Canada since at least as early as 1995 for services . . .

At paragraph 29 of its written argument, the applicant submits that:

The second[sic] ground of opposition is based on non-compliance with Section 30(e) of the *Trade-marks Act* in that the application is for intended use when the Applicant has in fact been using the Trade-mark. This ground is not sufficient to disallow the Applicant's application and there is no legal basis to this ground.

[12] The evidence that is referred to in paragraph 11 above is Mr. Reiss' affidavit sworn July 18, 2006 and the transcript of his cross-examination (see, for example, p.11 of the transcript).

[13] The opponent, at paragraphs 8.2 and 8.3 of its written argument, takes a position directly contradicting the applicant's position concerning the legal effect of the applicant's prior use of its mark NEW HOME BUYER'S NETWORK:

8.2 When filing an application on a proposed use basis, the applicant must not have used the trade-mark prior to the filing date with the wares or services claimed in the application. It is well established that if the applicant used the trade-mark prior to the filing date, the application should be refused for non-compliance with Section 30(e).

8.3 . . . the evidence filed [by the applicant] demonstrates use of the mark in Canada since at least 1995 in association with the Applicant's Wares and Services. This evidence clearly contradicts the proposed use claim in the Application and is fatal to the Application.  
(emphasis added)

[14] The opponent cites various cases in support of its above submissions, including *Calvin Klein Trademark Trust v. Calvin Corporation* (2000), 68 C.P.R.(4<sup>th</sup>) 397 at 405-406, a decision of a former Chairman of this Board. The *Calvin Klein* case, above, fully supports the opponent's submissions and is conclusive of the ground of opposition based on s.30(e) as pleaded in the instant case.

[15] As the opponent succeeds on the third ground of opposition, it is not necessary to consider the remaining grounds.

#### DISPOSITION

[16] The application is refused as the opponent succeeds on the ground of opposition pursuant to s.30(e) of the *Trade-marks Act*.

[17] This decision has been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

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Myer Herzig  
Member  
Trade-marks Opposition Board