



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

**Citation: 2010 TMOB 68**  
**Date of Decision: 2010-05-27**

**IN THE MATTER OF AN OPPOSITION  
by Dr. Allan Holmes to application  
No. 1,306,415 for the trade-mark  
Pandemic 101 in the name of The  
Pandemic 101 Corporation**

The Pleadings

[1] On June 22, 2006, Respond Solutions Inc. (Respond) filed an application to register the trade-mark Pandemic 101 (the Mark), application number 1,306,415, in association with the services of pandemic awareness training (the Services). Respond has disclaimed the right to the exclusive use of “Pandemic” apart from the trade-mark as a whole.

[2] The application is based on proposed use in Canada. The application was advertised on February 7, 2007 in the *Trade-marks Journal* for opposition purposes.

[3] Dr. Allan Holmes (the Opponent) filed a statement of opposition on March 26, 2007 which was forwarded on April 24, 2007 to the Applicant by the Registrar. On May 24, 2007 the Applicant filed a counter statement. It denied all grounds of opposition pleaded.

[4] The Opponent filed as its evidence the affidavit of Dr. Allan Holmes while the Applicant chose not to file any.

[5] Both parties filed written arguments and there was no oral hearing.

[6] The application was assigned by Respond to The Pandemic 101 Corporation (Corporation). The latter is now recorded as the current owner of this pending application. I shall hereinafter refer to either Respond or Corporation, as the case may be, as the Applicant.

### The Grounds of Opposition

[7] The grounds of opposition pleaded are:

1. The Applicant's trade-mark is not registrable pursuant to s. 38(2)(b) and s. 16(1)(a) and (c) of the *Trade-marks Act*, R.S.C. 1985 c. T-13 (the "Act") in that at the filing date of the application, the trade-mark was confusing with the Opponent's trade-mark Pandemic 101 previously used in Canada by the Opponent in association with the services of pandemic awareness training;
2. The Mark is not registrable in view of s. 12(1)(b) of the Act because it is clearly descriptive in the English language of the character or quality of the services in association with which it is proposed to be used;
3. The Applicant is not the person entitled to the registration of the Mark pursuant to s. 38(2)(c) and s. 16(1)(a) of the Act in that the alleged mark was, at the date of filing of the application namely June 22, 2006, in use or made known in Canada by the Opponent and the Opponent had not abandoned such use or making known of the trade-mark;
4. Pursuant to s. 38(2)(d) and s. 2 of the Act, the Mark is not distinctive of the Applicant's Services in that the Applicant's trade-mark does not and is not adapted to distinguish the Services from the services of others including the services of the Opponent which have been advertised and sold in Canada in association with the trade-mark Pandemic 101 since as early as March 2006.

### Burden of Proof in Trade-marks Opposition Proceedings

[8] The legal burden is upon the Applicant to show that its application complies with the provisions of the Act, but there is however an initial evidential onus 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. Once this initial onus is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company*, [2005] F.C. 722].

### Ground of opposition summarily dismissed

[9] The first ground of opposition is poorly drafted. If the Opponent intends to rely on registrability it ought to refer to a registered trade-mark which is not the case. If the Opponent intends to rely on a previously used or made known trade-mark, which appears to be the case, the ground of opposition should have referred to entitlement as opposed to registrability. The ground of opposition of entitlement is pleaded as the third ground of opposition. Consequently, as drafted I dismiss the first ground of opposition.

### Registrability of the Mark under s. 12(1)(b) of the Act

[10] The registrability of the Mark under s. 12(1)(b) of the Act must be assessed at the filing date of the application (June 22, 2006) [see *Dic Dac Holdings (Canada) Ltd v. Yao Tsai Co.* (1999), 1 C.P.R. (4th) 263, *Zorti Investments Inc. v. Party City Corporation* (2004), 36 C.P.R. (4th) 90; *Havana Club Holdings S.A. v. Bacardi & Company Limited*, (2004) 35 C.P.R. (4th) 541].

[11] What I have to determine is if the Mark, when used in association with the Services, is clearly descriptive in the English language of the character or quality of the Services. The applicable test has been well described in *242183 Ontario Ltd. v. Black Forest Inn Inc.* (1984), 3 C.P.R. (3d) 23 wherein the Court has clearly stated that one must look at the trade-mark as a whole and not dissect it into its component parts. Section 12(1)(b) does not prohibit registration of a trade-mark unless when considered as a whole it is either clearly descriptive or deceptively misdescriptive.

[12] The Mark is composed of the word “pandemic” and the number “101”. There has been no evidence filed by the Opponent that would tend to support a conclusion that the Mark, as a whole, would be clearly descriptive. I do not see how the combination of “pandemic” and “101” would constitute a trade-mark that would be clearly descriptive of pandemic awareness training services. It might be suggestive but that is not the test. For these reasons I dismiss the second ground of opposition.

### Entitlement ground of opposition

[13] The relevant date associated with this ground of opposition, when the application is based on proposed use, is the filing date of the application (June 22, 2006) [see s. 16(3) of the Act]. Moreover the Opponent must show that it had not abandoned its prior use at the advertisement date of the application (February 7, 2007) [see 16(5) of the Act]. Therefore the Opponent has an initial evidential burden to prove that it has used its trade-mark Pandemic 101 within the meaning of s. 4 of the Act prior to June 22, 2006.

[14] I note that the Opponent is referring to s. 16(1) of the Act. Such ground of opposition should be raised when the application is based on prior use. In this case the Applicant has filed an application based on proposed use. The Opponent should have relied on s. 16(3) of the Act instead of s. 16(1). I will nevertheless analyze this ground of opposition as if any reference to s. 16(1) should read s. 16(3) of the Act.

[15] Dr. Holmes' affidavit is quite succinct. He states that he is the Opponent and he is filing his affidavit in the context of this opposition. He then defines the term "use". No matter what the definition given to such term in his affidavit, it remains a legal term defined in the Act and the evidence must establish use of a trade-mark in association with services within the meaning of s. 4(2) of the Act.

[16] He makes a bald statement that he has been using the term Pandemic 101 in connection with the presentation of information concerning pandemic influenza preparedness planning and has advertised and sold such presentations in Canada in association with the trade-mark Pandemic 101 since as early as March 2006. He states "that the majority of uses by me of the mark Pandemic 101 were verbal in nature". On this issue of verbal use of a trade-mark it has been ruled that it would not be sufficient to constitute proper use of a trade-mark within the meaning of s. 4(2) of the Act [see *Kelly v. Alexander* (2001), 14 C.P.R. (4th) 567]. In addition, there is no documentary evidence to prove the sale of the Opponent's services in association with the trade-mark Pandemic 101.

[17] He concludes his affidavit by referring to two documents as evidence of his use of the trade-mark Pandemic 101. The first document appears to be a guide for the prevention of

pandemic influenza. It was presented to the Canadian Helicopters Corporation. It is dated March 15, 2006. As pointed out however by the Applicant, in its written argument, the document appears to have been drafted by an entity by the name of Global Consulting and it bears a copyright notice “© Global Consulting 2006”. There is no information provided by Dr. Holmes in his affidavit as to the relationship between the Opponent and Global Consulting.

[18] There is a second document entitled “Pandemic Influenza Preparedness Planning Stage I Follow-up”. It appears to be a document prepared for the benefit of an entity called Osler. It is on the letterhead of an entity identified as Global Consulting and has the same copyright notice that appears on the previous document. It does contain some information on Global Consulting. It is described as a consulting arm of Global Medical Services. Dr. Holmes is described as the President and founder of Global Medical Services and Global Consulting. Therefore it would appear that Global Medical Services and Global Consulting are separate entities from Dr. Holmes.

[19] In the absence of an allegation in Dr. Holmes’ affidavit that Global Consulting had a license from the Opponent to use the trade-mark Pandemic 101, the Opponent cannot claim the benefit of the provisions of s. 50 of the Act. Therefore those two documents do not establish use of the trade-mark Pandemic 101 by the Opponent.

[20] In view of these major flaws in the Opponent’s evidence I do not need to determine if the reference to Pandemic 101 in the documents filed by the Opponent constitutes proper evidence of use of a trade-mark in Canada in association with services within the meaning of s. 4(2) of the Act.

[21] I wish to add that in his written argument Dr. Holmes has made numerous allegations of facts, mainly with respect to a previous relationship that may have existed between Respond and the Opponent but those allegations (paragraphs 3, 4, 7, 8 and 9 of the Opponent’s written argument) should have been included in Dr. Holmes’ affidavit, not in the written argument. I disregarded them.

[22] In his written argument Dr. Holmes alleges that since he has started using the trade-mark Pandemic 101 in association with his services of pandemic influenza awareness and

preparedness planning presentations, his trade-mark Pandemic 101 has become well known. There is no evidence in Dr. Holmes' affidavit that would support such contention.

[23] I conclude that the Opponent failed to meet his initial onus of proving that he has used the trade-mark Pandemic 101 in Canada, prior to the relevant date, in association with the services of pandemic influenza awareness and preparedness planning presentations or that it was known in Canada at that date. Consequently the third ground of opposition is also dismissed.

#### Distinctiveness

[24] The relevant date with respect to this ground of opposition is the filing date of the statement of opposition (March 26, 2007) [see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 and *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317].

[25] The Opponent had to prove that its trade-mark Pandemic 101 had become sufficiently known at the relevant date to negate any distinctiveness of the Mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58].

[26] The evidence described in paragraphs 15 to 19 above enables me to conclude that the Opponent has not met his initial onus. Therefore the last ground of opposition is also dismissed.

#### Conclusion

[27] 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.

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Jean Carrière  
Member of the Trade-marks Opposition Board  
Canadian Intellectual Property Office