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

**Citation: 2018 TMOB 125**

**Date of Decision: 2018-10-31**

**IN THE MATTER OF AN OPPOSITION**

**Innofit Inc.**

**Opponent**

**And**

**UR Concierge Services Inc.**

**Applicant**

**1714201 for UR EXCLUSIVE CONDO  
CONCIERGE**

**Application**

INTRODUCTION

[1] UR Concierge Services Inc. (the Applicant) has applied-for registration of the trade-mark UR EXCLUSIVE CONDO CONCIERGE (the Mark) for use in association with

(1) Concierge services for condominium owners and renters; advertising and promotional services, namely, promoting goods and services of third party merchants and vendors through the internet and mobile applications; online advertising the wares and services of others in the fields of personal training, cleaning services, florists, laundry, dry cleaning, meal delivery services, nutritionists, dog walking and pet care, storage and organizational solutions and moving supplies, interior design, catering, vehicle rentals, limousine services, event planning, event staffing, home and office renovations, contracting services, household repairs, painting, computer technician support, house sitting, pet sitting, massage services, real estate services, insurance services, moving services, grocery delivery, beer and liquor delivery, pet supplies delivery, pet grooming, restaurant reservations, hotel and holiday reservations, messenger and delivery services, photography services, holiday tree delivery and holiday decorating services, card writing,

chartering aircrafts and yachts; Providing a searchable on-line advertising website and directory guide featuring the goods and services of registered vendors via the Internet; business services, namely, organizing and coordinating third-party vendors, suppliers, and contractors; business services, namely, organizing and coordinating third-party vendors and providing documentation and information on behalf of others in the field of personal training, cleaning services, florists, laundry, dry cleaning, meal delivery services, nutritionists, dog walking and pet care, storage and organizational solutions and moving supplies, interior design, catering, vehicle rentals, limousine services, event planning, event staffing, home and office renovations, contracting services, household repairs, painting, computer technician support, house sitting, pet sitting, massage services, real estate services, insurance services, moving services, grocery delivery, beer and liquor delivery, pet supplies delivery, pet grooming, restaurant reservations, hotel and holiday reservations, messenger and delivery services, photography services, holiday tree delivery and holiday decorating services, card writing, chartering aircrafts and yachts; Operation of a website allowing customers to hire and book registered third-party vendors in the field of personal training, cleaning services, florists, laundry, dry cleaning, meal delivery services, nutritionists, dog walking and pet care, storage and organizational solutions and moving supplies, interior design, catering, vehicle rentals, limousine services, event planning, event staffing, home and office renovations, contracting services, household repairs, painting, computer technician support, house sitting, pet sitting, massage services, real estate services, insurance services, moving services, grocery delivery, beer and liquor delivery, pet supplies delivery, pet grooming, restaurant reservations, hotel and holiday reservations, messenger and delivery services, photography services, holiday tree delivery and holiday decorating services, card writing, chartering aircrafts and yachts (the Services).

[2] Innofit Inc.(the Opponent), has alleged used the trade-mark and trade-name CONDO CONCIERGE since at least as early as February 1, 2015, in association with similar or overlapping services in Canada and has opposed the registration of the Mark on the basis that this Mark is confusing with its trade-mark or trade-name.

[3] For the reasons that follow, I find that this application should be refused.

#### FILE RECORD

[4] The Applicant filed application No.1714201 on February 6, 2015 for registration of the Mark based on proposed use in association with the Services.

[5] The application was advertised in the December 9, 2015 issue of the *Trade-marks Journal*.

[6] The Opponent opposed it on February 5, 2016, by filing a statement of opposition under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition are based on sections 30(a), 30(b), 30(i), 16(3)(a), 16(3)(c) and 2 of the Act.

[7] The Applicant filed and served a counter statement denying all of the grounds of opposition.

[8] In support of its opposition, the Opponent filed the affidavit of Justin Dyer. The Applicant did not file any evidence. Only the Opponent filed a written argument and attended the oral hearing.

#### ONUS AND MATERIAL DATES

[9] 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 [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

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

- sections 38(2)(a)/30 - the date of filing of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB)];
- sections 38(2)(c)/16(3)(a) & (c) – the filing date of the application [section 16(3) of the Act]; and
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

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

[11] The Opponent pleads that the application does not comply with section 30(a) of the Act because the Applicant did not, at the time the application was filed, describe several of the applied for services in ordinary commercial terms.

[12] There are two issues to be determined under a section 30(a) ground of opposition, first, whether the statement of goods or services is in ordinary commercial terms and, second, whether it adequately identifies the specific goods and services [*Whirlpool SA v Eurotherm Holdings Ltd*; 2010 TMOB 171 at para 39]. The Opponent’s initial evidential burden under section 30(a) is a light one and may be met simply through argument [*McDonald's Corp v M.A. Comacho-Saldana International Trading Ltd* (1984), 1 CPR (3d) 101 at 104 (TMOB)].

[13] In its statement of opposition, the Opponent highlighted four services in particular as not being in ordinary commercial terms. These services, and the Opponent’s submissions with respect to them, are as follows:

(i) With respect to “Online advertising the wares and services of others in [various fields]” the Opponent did not make any submissions with respect to these services other than that they were not in ordinary commercial terms;

(ii) With respect to “Business services, namely organizing and coordinating third-party vendors, suppliers and contractors”, the Opponent submits as follows:

the description “organizing and coordinating” is too vague and imprecise a description of the manner and the type of service the Applicant intends to offer and cannot constitute ordinary commercial terms; for example, no third party would hire the Applicant to organize and coordinate suppliers.

(iii) With respect to “business services, namely, organizing and coordinating third-party vendors and providing documentation and information on behalf of others in the field of personal training, [and other fields]”, the Opponent submits as follows:

the description “organizing and coordinating” is too vague and imprecise a description of the manner and type of service the Applicant intends to offer and cannot constitute ordinary commercial terms; for example, no third party would hire the Applicant to organize and coordinate florists.

(iv) With respect to the services “Operation of a website allowing customers to hire and book registered third-party vendors in the field of personal training, [etc]”, the Opponent submits as follows:

...the description “hire and book” is too vague and imprecise a description of the manner and type of service the Applicant intends to offer and cannot constitute ordinary commercial terms; for example, no third party would hire the Applicant to hire and book vendors in the field of pet supplies.

[14] In my view, the Opponent has not provided enough support (evidential or argument) for its claim that any of the applied for services are too vague and imprecise. While I agree that the Opponent's services, which are similar in nature, are defined more specifically in some of its evidence of use of its mark (eg. on promotional pamphlets, etc.), there is no evidence to support the Opponent's argument that the lack of specificity in part of the Applicant's description of its services is fatal to these services. Further, the Opponent's arguments amount to mere assertions that the descriptions are inadequate, without explaining why, except to baldly assert that "no third party would hire the Applicant to organize or co-ordinate vendors, suppliers... or florists, ... or hire and book registered third party vendors in [various fields]". I do not understand why such assumptions regarding the behavior of third parties should be taken at face value.

[15] In view of the above, I find that the Opponent has not met its evidential burden under this ground. The section 30(a) ground is accordingly dismissed.

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

[16] The Opponent pleads that the application does not conform to the requirements of section 30 given that the Applicant, whether by itself or through a licensee or by itself and through a licensee, does not intend to use the Mark in Canada.

[17] In this case, since the application contains a statement that the Applicant by itself and/or through a licensee intends to use the trade-mark in Canada, it formally complies with section 30(e). The issue therefore becomes whether or not the Applicant substantially complied with section 30(e), i.e. was the Applicant's statement that it intended to use the Mark true? [*Home Quarters Warehouse, Inc v Home Depot, USA, Inc* (1997), 76 CPR (3d) 219 (TMOB); *Jacobs Suchard Ltd v Trebor Bassett Ltd* (1996), 69 CPR (3d) 569 (TMOB)].

[18] The Opponent submits that as of August 16, 2016, the Applicant had changed the trade-mark on its website to UR EXCLUSIVE ONLINE CONCIERGE (Dyer, para. 8). Attached as Exhibit 4 to Mr. Dyer's affidavit is a copy of the registration information for www.urcsi.com showing the Applicant as the registrant of such domain name and exhibit 5 is a copy of the webpage appearing at www.urcsi.com.

[19] I find it curious that the Applicant may have changed the trade-mark appearing on its website after filing its application for the Mark. However, I do not find this evidence sufficient by itself to show that the Applicant did not intend to use the Mark at the filing date of the application (i.e. February 6, 2015) because to do so would be making an unsubstantiated assumption that the use of the Mark by the Applicant would necessarily include reference by the Applicant to the Mark on the internet. I do not consider this to be the case, and therefore find that the Opponent has not met its burden. This ground is accordingly dismissed.

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

[20] The Opponent alleges that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada because it was aware of the previous use in Canada by the Opponent of its trade-mark and trade-name CONDO CONCIERGE.

[21] Where an applicant has provided the statement required by section 30(i) of the Act, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of an applicant [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. There is no evidence of bad faith or exceptional circumstances in this case. Further, mere knowledge of the existence of the Opponent's trade-mark or trade-name does not in and of itself support an allegation that the Applicant could not have been satisfied of its entitlement to use the Mark [*Woot Inc v WootRestaurants Inc Les Restaurants Woot Inc*, 2012 TMOB 197].

[22] This ground of opposition is accordingly dismissed.

#### SECTION 16(3)(A) GROUND OF OPPOSITION

[23] The Opponent pleads that the Applicant is not the person entitled to registration under section 16(3)(a) of the Act because the Mark is confusing with the Opponent's trade-mark CONDO CONCIERGE which had previously been used in Canada by the Opponent in association with similar or overlapping services

[24] The Opponent has an initial evidential burden of establishing use of its trade-mark CONDO CONCIERGE prior to the filing date of the application (February 6, 2015) as well as non-abandonment of its trade-mark at the date of advertisement (December 9, 2015).

[25] The evidence of Mr. Dyer, Director and President of the Opponent, includes evidence dated prior to and after the relevant dates for this ground. His evidence of the Opponent's alleged use prior to the relevant dates may be summarized as follows:

- The Opponent is a business that provides security and concierge services;
- The Opponent owns the domain name *condoconcierge.ca* registered July 30, 2010, as well as the domain name *condoconcierge.com* (registered August 6, 2010);
- The Opponent has used CONDO CONCIERGE as a trade-mark since at least as early as February 1, 2015;
- At least as early as September 30, 2010, the Opponent had commenced to provide its services in association with the CONDO CONCIERGE mark in two condominium corporations;
- Since July 10, 2010, the Opponent has distributed approximately 2000 business cards displaying the Opponent's domain name to customers and potential clients in Canada; samples of such cards are attached as Exhibit 6;
- The Opponent has also used or displayed the mark in the performance or advertising of the services since July 31, 2010, by way of marketing packages; a copy of a cover page of the marketing package is attached as Exhibit 7;
- The Opponent has used or displayed its mark in the advertisement and performance of its services since at least as early as August 31, 2010, by way of its website; attached as Exhibits 9 and 10 are copies of the homepage of the website located at the domain name as of March 13, 2014 and December 17, 2014;

- Since September 30, 2010, the Opponent has distributed and the Opponent's condominium clients have used approximately 2,500 appointment and service cards; a copy of an appointment and service card is attached as Exhibit 11;
- Since in and around September 30, 2010, the Opponent has distributed at least two thousand flyers branded with its mark to clients and potential clients in condominiums, at trade shows, networking events, and in respect of inquiries; a copy of 4 versions of the flyer is attached as Exhibit 12; and
- Since in and around March 2012, the Opponent has made accessible online an electronic presentation advertising various services in association with its mark; a copy of 4 pages of the presentation is attached as Exhibit 22.

[26] In its statement of opposition, the Opponent had identified a large number of services that the Opponent had purportedly used its mark in association with. The evidence furnished was not sufficient to show prior use of the mark in association with all of these services nor does it clearly show which of the services were available to be performed by the Opponent as opposed to a third party.

[27] In any event, I am satisfied from the Opponent's evidence as a whole, that the Opponent's mark had been used in association with at least some similar or overlapping concierge services as those of the Applicant. In this regard, the Opponent's evidence shows that the CONDO CONCIERGE mark appeared on flyers distributed to potential clients, as well as at trade shows and on the Opponent's website prior to the Applicant's filing date. I am therefore satisfied that the Opponent has met its burden under this ground.

[28] As I am satisfied that the Opponent has met its evidential burden I must now determine whether the Applicant has met its onus of proving that there is no reasonable likelihood of confusion between the parties' marks on a balance of probabilities.

[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 goods or



services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods 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 section 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 goods, 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 CPR (4th) 321 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC).] Below, I consider each of the circumstances enumerated in section 6(5) of the Act.

#### **inherent distinctiveness and extent known**

[31] Neither of the parties' marks is inherently strong. In this regard, both are comprised of ordinary dictionary words that are suggestive of the services they are used or proposed to be used in association with. The Mark may be slightly stronger than the Opponent's mark because there is no obvious meaning associated with the component UR, although I agree with the Opponent that it could be seen as an abbreviation for the word "your".

[32] A trade-mark may acquire distinctiveness by becoming known through use or promotion. There is no evidence that the Mark has acquired distinctiveness. In contrast, Mr. Dyer states that the Opponent has been providing its services in association with its mark since at least as early as September 30, 2010. Further, the evidence shows that the Opponent has used or displayed its mark in the advertisement of its services on its website and marketing packages since at least July, 2010.

[33] Although the Opponent could have provided more fulsome details pertaining to the particular services its CONDO CONCIERGE trade-mark has been used in association with, the Opponent's evidence as a whole permits me to find that the Opponent has advertised and been able to provide a range of concierge services in association with its mark since September, 2010.

I am therefore satisfied that the Opponent's mark has become known to at least some extent in Canada.

#### **length of time each has been in use**

[34] Mr. Dyer states that the Opponent began to provide its services in association with its mark at least as early as September 2010. On the other hand, there is no evidence that the Applicant has used the Mark. This factor therefore favours the Opponent.

#### **degree of resemblance**

[35] In *Masterpiece*, the Supreme Court stated that the degree of resemblance between the marks is often likely to have the greatest effect on the confusion analysis [see also *Beverley Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2d) 145 (FCTD) at 149, affirmed 60 CPR (2d) 70 ]. While the Court also observed that, for the purpose of distinctiveness, the first word of a trade-mark may be the most important [see *Conde Nast Publications Inc v Union des éditions modernes* (1979), 46 CPR (2d) 183 (FCTD)], it opined that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique.

[36] In the present case, I find the dominant feature of the Opponent's mark to be the combination of the words CONDO CONCIERGE together and the Mark incorporates both of these words in the same order. While the Mark also includes the words UR and EXCLUSIVE as its first components, I agree with the Opponent that these words modify the words CONDO CONCIERGE and do not serve to diminish the degree of resemblance between the marks. In this regard, the differences between the marks in this case may compound rather than eliminate confusion since consumers may well regard the Mark as a modification of the Opponent's brand (i.e. your exclusive brand versus the standard brand).

#### **nature of goods, business and trade**

[37] Given that the parties' services are either identical or overlapping, the nature of the business and trade of each would also presumably overlap.

## **conclusion**

[38] Based on the foregoing, I find that the Applicant has not satisfied its legal onus on a balance of probabilities of establishing that there is no reasonable likelihood of confusion as between the Mark and the Opponent's CONDO CONCIERGE trade-mark.

[39] The section 16(3)(a) ground therefore succeeds.

### Section 16(3)(c) Ground of Opposition

[40] The Opponent has an initial evidential burden of establishing use of its trade-name prior to the Applicant's filing date (February 6, 2015) as well as non-abandonment of its trade-name at the date of advertisement (December 9, 2015). Since the Opponent's evidence relates almost exclusively to the use of the trade-mark CONDO CONCIERGE rather than the trade-name CONDO CONCIERGE, this initial burden has not been satisfied. Consequently, the ground of opposition based on section 16(3)(c) of the Act is rejected.

### DISTINCTIVENESS GROUND OF OPPOSITION

[41] In order to meet its evidential burden, the Opponent must show that its CONDO CONCIERGE trade-mark or trade-name had become sufficiently known to negate the distinctiveness of the Mark [*Bojangles' International, LLC v Bojangles Café Ltd* 2006 FC 657 (CanLII) at paras 33-34]. I am not satisfied that the evidence furnished by the Opponent in this case meets this burden.

DISPOSITION

[42] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

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Cindy R. Folz  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE** 2018-09-12

**APPEARANCES**

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FOR THE OPPONENT

No one appearing

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