

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

Citation: 2019 TMOB 54

Date of Decision: 2019-06-13

IN THE MATTER OF AN OPPOSITION

Pablo Enterprise pte. Ltd.

Opponent

and

Hai Lun Tang

Applicant

1,757,501 for PABLO & Logo

Application

INTRODUCTION

[1] On December 2, 2015, Hai Lun Tang (the Applicant) filed application No. 1,757,501 (the Application) to register the trade-mark PABLO & Logo (the Mark) depicted below:



[2] The Application is based on proposed use of the Mark in Canada in association with the goods “cakes”.

[3] The Application was advertised for opposition purposes in the *Trade-marks Journal* of October 26, 2016.

[4] On November 7, 2016, Pablo Enterprise pte. Ltd. (the Opponent) filed a statement of opposition against the Application. By letter of the Registrar dated November 10, 2016, the Opponent’s statement of opposition was initially rejected pursuant to section 38(4) of the *Trade-marks Act* as not raising a substantial issue for decision. However, the Registrar granted the Opponent a three-week extension of time to submit an amended statement of opposition, which the Opponent did on November 30, 2016. The amended statement of opposition dated November 30, 2016 was accepted for filing by the Registrar and was forwarded to the Applicant pursuant to section 38(5) of the Act on December 19, 2016.

[5] The grounds of opposition in the amended statement of opposition are summarized below:

- (a) The Application does not comply with section 30(e) of the Act, in that the Applicant, by itself or through a licensee, or by itself and through a licensee, does not intend to use the Mark in Canada, since the Mark is an unauthorized copy of the Opponent’s artistic work entitled PABLO Design (Canadian copyright registration No. 1135183), published on August 1, 2011, and use of the Mark in Canada would infringe the Opponent’s copyright in the artistic work and thus be unlawful and subject to civil and criminal remedies under the *Copyright Act*.
- (b) The Application does not comply with the requirements of section 30(i) of the Act in that the Applicant could not have been satisfied that the Applicant was entitled to use the Mark in Canada in association with the specific goods listed in the Application, or any others, since the Mark is an unauthorized copy of the Opponent’s artistic work entitled PABLO Design (Canadian copyright registration No. 1135183), published on August 1, 2011, and use of the Mark in Canada would infringe the Opponent’s

copyright in the artistic work and thus be unlawful and subject to civil and criminal remedies under the *Copyright Act*.

- (c) Pursuant to section 16(3)(a) of the Act, the Applicant is not the person entitled to registration of the Mark in that, at the date of filing the Application, the Mark was and continues to be confusing with the Opponent's trade-marks identified in Schedule "B" to the amended statement of opposition, which had been made known in Canada by the Opponent in association with cakes and cookies.
- (d) Pursuant to section 2 of the Act, the Mark is not distinctive in that the Mark does not distinguish, nor has it been adapted to distinguish the Applicant's goods from the Opponent's goods, having regard to, among other things, the Opponent's trade-marks identified in Schedule "B" to the amended statement of opposition, which have been made known in Canada as described above.

[6] On April 19, 2017, the Applicant filed a counter statement denying the grounds of opposition.

[7] Only the Opponent filed evidence, which is discussed below. Both parties filed Written Arguments. An oral hearing was not requested.

EVIDENCE

[8] The Opponent's evidence is comprised of the following:

- Certified copy of Canadian copyright registration No. 1135183 registered on November 16, 2016.
- Affidavit of Amanda Hughes dated August 15, 2017 (the Hughes Affidavit). Ms. Hughes is a Patent and Trademark Clerk employed by the agent for the Opponent in this proceeding. Her affidavit states that on November 15, 2016 Ms. Hughes filed a copyright application on behalf of the Opponent for an artistic work identified as PABLO Design. Ms. Hughes includes a copy of the artistic work as Exhibit "A" to her affidavit. Ms. Hughes states that the Certificate of Registration of Copyright for this

artistic work was received on November 16, 2016, under registration No. 1135183. An uncertified copy of the Certificate of Registration for Canadian copyright registration No. 1135183 is included as Exhibit “B” to the Hughes Affidavit.

- Affidavit of Mona Poggione dated August 15, 2017 (the Poggione Affidavit). Ms. Poggione is a Paralegal and Administrative Assistant employed by the agent for the Opponent in this proceeding. The Poggione Affidavit includes printouts of various webpages from the website www.pablo3.com, archived webpages from that website dating back to 2011, as well as printouts from various other websites. I will discuss these website printouts in further detail, below, only to the extent they are relevant to my disposition of the matter.

[9] Neither Ms. Hughes nor Ms. Poggione were cross-examined on their respective affidavits.

[10] On December 15, 2017, the Applicant filed a letter with the Registrar stating that the Applicant did not wish to submit evidence pursuant to Rule 42 of the *Trade-marks Regulations*.

ONUS AND MATERIAL DATES

[11] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the Application complies with the requirements of the Act. This means that if a determinate conclusion cannot be reached in favour of the Applicant after a consideration of all of the evidence, then the issue must be decided against the Applicant. 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 CPR (3d) 293 (FCTD) at 298].

[12] The material dates with respect to the grounds of opposition are as follows:

- Sections 38(2)(a)/30 of the Act - the filing date of the Application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];

- Sections 38(2)(c)/16(3) of the Act – the filing date of the Application; and
- Sections 38(2)(d) of the Act - the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 2004 FC 1185, 34 CPR (4th) 317 (FC)].



SECTION 30(I) GROUND OF OPPOSITION

[13] I will begin with a consideration of the Opponent’s section 30(i) ground of opposition, as in my view this is sufficient to dispose of the opposition.

[14] Section 30(i) of the Act requires an applicant to include a statement in the application that the applicant is satisfied that it is entitled to use the trade-mark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant's statement untrue such as evidence of bad faith or non-compliance with a federal statute [see *Sapodilla Co v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (Reg TM) at 155; and *Canada Post Corp v Canada (Registrar of Trade Marks)* (1991), 40 CPR (3d) 221 (Fed TD)].

[15] In the present case, the Opponent alleges that the Applicant could not have been satisfied that the Applicant was entitled to use the Mark in association with the goods listed in the Application because such use would violate the Opponent’s copyright in the artistic work entitled PABLO Design and thus be in violation of the Canadian *Copyright Act*.

[16] For reference, set out below is a side-by-side comparison of the applied-for Mark and the artistic work PABLO Design in which the Opponent asserts copyright (the Artistic Work).

Applicant’s Mark	Opponent’s Artistic Work
	

[17] In determining whether an opponent has met its initial evidential burden for a ground of opposition based on section 30(i) of the Act in conjunction with non-compliance with a federal statute, this Board in the past has considered whether the opponent has made out a *prima facie* case of contravention of the federal statute, as opposed to determining that there has actually been contravention. For example, section 30(i) grounds of opposition were successful in *E Remy Martin & Co SA v Magnet Trading Corp (HK) Ltd* (1988), 23 CPR (3d) 242 (TMOB) (“*E Remy Martin*”) and *Ace Cafe London Ltd v Ace Cafe Toronto Ltd*, 2012 TMOB 219, 107 CPR (4th) 427 after a *prima facie* case of copyright infringement under the *Copyright Act* was found. Oppositions by Canada Post Corporation have succeeded under section 30(i) after a finding of *prima facie* contravention of the *Canada Post Corporation Act* [see for example, *Canada Post Corp v Metromail Corp* (1997), 84 CPR (3d) 511 (TMOB)]. In addition, *prima facie* contravention of the *Food and Drugs Act* supported the success of a section 30(i) ground of opposition in *Institut National des Appellations d'Origine v Brick Brewing Co* (1995), 66 CPR (3d) 351 (TMOB).

[18] Thus, in the present case with the Opponent’s section 30(i) ground of opposition, the first issue is whether the Opponent has met its initial evidential burden of demonstrating a *prima facie* case of copyright infringement. In order to do so, an opponent must establish (i) copyright in the work, and (ii) that the trade-mark applied for is a substantial copying of the work [see *Jones v Dragon Tales Production Inc* (2002), 27 CPR (4th) 369 at para 13 (TMOB)].

[19] With respect to the Opponent’s ownership of copyright in the Artistic Work, the Opponent has included as part of its evidence a certified copy of the registration certificate for Canadian copyright registration No. 1135183. While Canadian copyright registrations do not include a copy of the work itself, in this case, the Hughes Affidavit identifies the Artistic Work as the work which is the subject of copyright registration No. 1135183; Ms. Hughes being the individual that filed the application for the copyright registration on behalf of the Opponent. Ms. Hughes was not cross-examined on her affidavit, and so her evidence that it is the Artistic Work that is the subject of the Opponent’s copyright registration is uncontroverted.

[20] A Canadian copyright registration entitles the owner of that registration to certain rebuttable presumptions under the *Copyright Act*. In particular, section 53 of the *Copyright Act* reads in part as follows:

Register to be evidence

53 (1) The Register of Copyrights is evidence of the particulars entered in it, and a copy of an entry in the Register is evidence of the particulars of the entry if it is certified by the Commissioner of Patents, the Registrar of Copyrights or an officer, clerk or employee of the Copyright Office as a true copy.

Owner of copyright

(2) A certificate of registration of copyright is evidence that the copyright subsists and that the person registered is the owner of the copyright.

[...]

Admissibility

(3) A certified copy or certificate appearing to have been issued under this section is admissible in all courts without proof of the signature or official character of the person appearing to have signed it.

[21] In view of the above provisions, the certified copy of Canadian copyright registration No. 1135183, together with the Hughes Affidavit, constitutes evidence of the particulars entered in that registration, and constitutes evidence that copyright subsists in the Artistic Work and that the Opponent is the owner of copyright in the Artistic Work. I note that it is certainly possible for a responding party to rebut the presumptions that arise from a copyright registration under section 53 of the *Copyright Act*. However, in the present case, the Applicant has not filed any evidence to rebut these presumptions that arise from the Opponent's copyright registration.

[22] The relevant date for the section 30(i) ground of opposition is the date of filing the Application, namely, December 2, 2015. As noted by the Applicant in its written argument, the Opponent's Canadian copyright registration did not issue until November 16, 2016 and thus did not exist as of the filing date of the Applicant's Application.

[23] However, it is well established under Canadian law that copyright protection arises automatically upon the making of a work and a copyright registration is not required in order for there to be a finding of infringement under the *Copyright Act*, though the registration entitles the owner to certain rebuttable presumptions as discussed above [see *Moreau v. St. Vincent* [1950]

Ex CR 198, 12 CPR 32; see also John S. McKeown, *Fox on Canadian Law of Copyright and Industrial Designs*, 4th Edition, Chapter 20:2]. In the present case, the particulars of Canadian copyright registration No. 1135183 indicate that the Artistic Work was first published in Osaka, Japan on August 1, 2011, over four years prior to the filing date of the Application. As mentioned above, section 53(1) of the *Copyright Act* provides that the certified copy of the registration certificate is evidence of the particulars set out in the registration, which would include the first publication date. The Applicant has filed no evidence to contest the date of first publication of the Artistic Work identified in the Opponent's copyright registration, and the Applicant does not contest that date in its Written Argument.

[24] I note that the Poggione Affidavit includes printouts of numerous webpages which display the Artistic Work (and designs with very small variations). Many of these webpages include information regarding a restaurant chain operating in multiple countries under the name PABLO, including details such as restaurant locations and menu items. These webpages were located and attested to by Ms. Poggione, a Paralegal and Administrative Assistant employed by the agent for the Opponent, rather than from a representative of the Opponent with first-hand knowledge of the ownership and content of the webpages. Consequently, with respect to the specific factual information regarding the restaurant described in these webpages, I cannot give this evidence much weight because it is hearsay and in my view does not meet the criteria of admissibility of hearsay evidence set out by the Supreme Court in *R v Khan* [1990] 2 SCR 531.

[25] That being said, I am prepared to accept part of the Poggione Affidavit as admissible for a more limited purpose, namely, the fact that Ms. Poggione located archived versions of webpages which display the Artistic Work [see Exhibit "B" to the Poggione Affidavit], many of which pre-date the filing date of the Applicant's Application and appear consistent with the date of first publication of the Artistic Work identified in the Opponent's copyright registration. I am prepared to accept the Poggione Affidavit as admissible for this more limited purpose because the existence of these archived webpages displaying the Artistic Work is a fact to which Ms. Poggione can attest with first-hand knowledge because she visited those archived webpages, and it has been held that webpages obtained from the Internet archives database give a generally reliable representation of the websites as they existed in the past [see *Candrug Health Solutions Inc. v. Thorkelson*, 2007 FC 411; rev'd on other grounds *Candrug Health Solutions Inc. v.*

Thorkelson, 2008 FCA 100; see also *London Life Insurance Company v Groupe Leblanc Syndic Inc* 2017 TMOB 81 at para 100].” . Again, the Applicant has filed no evidence and made no submissions to contest the date of first publication of the Opponent’s Artistic Work identified in the Opponent’s copyright registration.

[26] With respect to the question of whether the Applicant’s Mark constitutes a substantial copying of the Opponent’s Artistic Work, I am satisfied that the Opponent has demonstrated a *prima facie* case of copyright infringement. In particular, the design component of the Applicant’s Mark is identical to that shown in the Opponent’s Artistic Work, as is the font used for the word “PABLO”. There is no evidence from the Applicant to suggest anything other than a substantial copying, such as evidence of independent creation of the Mark by the Applicant.

[27] Consequently, with respect to the Opponent’s section 30(i) ground of opposition, I am satisfied that the Opponent has demonstrated a *prima facie* case of copyright infringement under the *Copyright Act* as of the Application filing date sufficient to meet its initial evidential burden for this ground of opposition.

[28] As the Applicant has not filed any evidence to support its Application, the Applicant has not met its legal onus to demonstrate that the Application is in compliance with section 30(i) of the Act. Indeed, in the absence of evidence from the Applicant, I am left in the dark as to how the Applicant could have been satisfied that it was entitled to use the Mark which is effectively identical to the Opponent’s Artistic Work. In this regard, I find the following passage from paragraph 9 the Registrar’s decision in *E Remy Martin* instructive:

[...] That is not to say that the applicant has, in fact, infringed the opponent's copyright. However, the applicant has done nothing to evidence the contrary such as, for example, providing evidence of independent creation. If, in fact, the applicant has infringed the opponent's copyright, then it could not have been satisfied that it was the person entitled to registration of its two applied for marks incorporating the virtually identical design as a dominant feature thereof. Since the onus or legal burden is on the applicant to show its compliance with Section 29(i) of the Act, I must find that the opponent's first ground in each opposition is successful.

[29] In view of the above, I find that the section 30(i) ground of opposition is successful.

[30] As I have held that the Opponent succeeds in respect of the section 30(i) ground of opposition, I do not consider it necessary to address the remaining grounds of opposition raised by the Opponent, including those relating to an alleged likelihood of confusion in association the Opponent's unregistered trade-marks identified in Schedule "B" to the amended statement of opposition.

DISPOSITION

[31] 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.

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

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

HEARING DATE No Hearing Held

AGENT(S) OF RECORD

Ridout & Maybee LLP

FOR THE OPPONENT

No Agent Appointed

FOR THE APPLICANT