



LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

**Citation: 2020 TMOB 3**

**Date of Decision: 2020-01-17**

**[UNREVISED ENGLISH  
CERTIFIED TRANSLATION]**

**IN THE MATTER OF AN OPPOSITION**

**1161396 Ontario Inc.**

**Opponent**

**and**

**Les Marques Metro / Metro Brands**

**Applicant**

**S.E.N.C.**

**1,737,612 for INVITATIONS & Design**

**Application**

INTRODUCTION

[1] 1161396 Ontario Inc. (the Opponent) opposes registration of the trademark INVITATIONS & Design (the Mark) shown below:



[2] The application is under serial No. 1,737,612 and is in the name of Les marques Metro/Metro Brands S.E.N.C. (the Applicant). It covers the following goods:

[TRANSLATION]

Food products, namely peanuts, candy bars, cookies and cupcakes, assorted chocolate boxes, candy, marshmallow-based candy, chocolate and chocolate bars, almond confectionery, peanut confectionery, chocolate confectionery, jellified confectionery, sweet confectionery, potato chips, fudge and sucre à la crème, chocolate mints, peanut brittles (the Goods).

[3] The application was filed on July 16, 2015, and is based on proposed use in Canada.

[4] The Opponent bases its opposition on the non-compliance of the application (sections 30(a), (b), (e), (h), and (i) of the *Trademarks Act*, RSC 1985, c T-13 (the Act)), section 16(3)(a) of the Act, and the non-distinctiveness of the Mark (section 2 of the Act).

[5] As the application was advertised on May 18, 2016, prior to June 17, 2019, in accordance with section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read on June 16, 2019, except the issue of confusion, which will be assessed under sections 6(2) to (4) of the Act as it reads now.

[6] I find that the opposition should be rejected.

#### THE RECORD

[7] The statement of opposition was filed on October 18, 2016. On November 4, 2016, the Applicant filed a counter statement denying the grounds of opposition pleaded by the Opponent. On April 17, 2017, the Opponent filed a request to amend its statement of opposition. In a decision by the Registrar on April 25, 2017, the Registrar refused to consider that request as it was incomplete. The Opponent never followed up on that decision.

[8] In support of its opposition, the Opponent filed as evidence in chief the affidavit of Michael Stephan, made on February 23, 2017, and a certified copy of the affidavit of Sarbjit Singh, made on July 27, 2010, filed in an opposition to application No. 1,329,344 for the trademark IRRESISTIBLE filed by the Applicant.

[9] The Applicant did not submit any evidence.

[10] Only the Applicant filed written arguments and no hearing was held.

### PRELIMINARY REMARKS

[11] I have considered all the evidence of record. However, I will limit myself to describing and referring to the excerpts from the Opponent's evidence that I find most relevant to determining the grounds of opposition to be addressed in this decision.

[12] I would note that application No. 1,329,344 for the IRRESISTIBLE trademark filed by the Applicant was declared abandoned on October 23, 2012, and is in no way part of this opposition proceeding.

[13] I note that, in its statement of opposition, the Opponent refers to its application No. 1,452,360 for the trademark IRRESISTIBLES & Design. However, the ground of opposition pleaded by the Opponent based on section 16(3)(a) of the Act makes no reference to that trademark. Moreover, the Opponent did not plead any ground of opposition based on section 16(3)(b) of the Act, i.e. the entitlement of the Applicant to register the Mark given the confusion with a trademark for which an application was previously filed.

### THE OPPONENT'S EVIDENCE

[14] Mr. Stephan is an investigator. He states that, on February 8, 2016, he went to a Metro grocery store on William Kitchen Boulevard in Toronto and purchased a product bearing the name "*Invitations Milk Chocolate Covered Maple Flavoured Caramel*" and attached photographs of the product as Exhibit A, and the cash receipt for the purchase of the product as Exhibit B.

[15] Mr. Singh describes himself as the President of the Opponent, which has been doing business under the name S & M Enterprises since 1995, and he has also been the President of One Better Inc. since 1995. I note that that affidavit was made on July 27, 2010.

[16] Mr. Singh states that, since 2000, the Opponent has used the trademark IRRESISTIBLES in Canada in association with candies and snacks.

[17] Mr. Singh states that the Opponent granted a licence to One Better Inc. for the use of the IRRESTISIBLES mark in Canada.

[18] Mr. Singh states that the Opponent's wholesale sales figures for the sale of candies and snacks in association with the IRRESISTIBLES mark in Canada since 2000 were in excess of \$25 million. These products have been sold in particular at Walmart, Giant Tiger, Sobeys, Loblaws, Shoppers Drug Mart and Toys R Us. He produced as Exhibit 1 examples of labels and packaging for these products, all bearing the IRRESISTIBLES mark, and as Exhibit 2 samples of invoices and purchase orders regarding the sale of these products in Canada in association with the IRRESISTIBLES mark.

[19] I would note that I do not see the relevance of the content of this affidavit, as the mark that is the subject of this opposition proceeding is INVITATIONS & Design. I will come back to this later.

#### ANALYSIS

[20] It is initially up to the Opponent to establish that its opposition is well-founded. However, the legal onus of showing that the Mark is registrable rests with the Applicant, according to the balance of probabilities [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

#### **Grounds of opposition based on section 30 of the Act (compliance)**

[21] Nothing in the evidence presented by the Opponent directly or indirectly affects the grounds of opposition regarding the compliance of the present application.

[22] Thus, there is nothing on the record to suggest that the statement of Goods is not in ordinary commercial terms (section 30(a) of the Act). Moreover, the present application is based on proposed use in Canada. Therefore, there can be no issue regarding an incorrect date of first use in Canada (section 30(b) of the Act). Moreover, the facts described by Mr. Stephan in his affidavit are after the date of filing of the present application, which is the relevant date for any ground of opposition challenging the compliance of the present application [see *Georgia-Pacific Corp. v Scott Paper Ltd.* (1984), 3 CPR (3d) 469 (TMOB)].

[23] As for the grounds of opposition based on section 30(e) of the Act, again there is no allegation on record that would call into question the fact that the Applicant, at the time of filing

its application, intended to use the Mark in Canada in association with the Goods. On the contrary, the facts described in Mr. Stephan's affidavit seem to confirm the Applicant's intention of using the Mark in Canada.

[24] As for the ground of opposition based on section 30(h) of the Act, there is nothing in the evidence that raises any non-compliance with the requirement to produce a drawing of the Mark.

[25] Finally, with respect to the ground of opposition based on section 30(i) of the Act, that section requires only that the Applicant state that he is satisfied that he is entitled to use the Mark in Canada in association with the Goods. That statement is included in the present application.

[26] However, that section of the Act can be cited in support of a ground of opposition in very specific cases, such as when that statement by the Applicant may have been made in bad faith [see *Sapodilla Co Ltd v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. However, there is no evidence of that nature on record.

[27] Accordingly, all grounds of opposition based on section 30 of the Act are rejected, since the Opponent has not discharged its initial evidentiary burden.

### **Ground of opposition based on section 16(3) of the Act**

[28] This ground of opposition must be analyzed as of the date of filing of the application (July 16, 2015) [see section 16(3) of the Act].

[29] According to this ground of opposition, the Opponent had to show that, prior to the relevant date, it used its IRRESISTIBLES trademark as alleged in its statement of opposition and that it had not abandoned such use as of the date of advertisement of the present application (May 18, 2016) [see section 16(5) of the Act].

[30] The Applicant raises two main arguments regarding this ground of opposition:

- The Opponent abandoned use of its IRRESISTIBLES mark at the date of advertisement of the present application (May 18, 2016) [see section 16(5) of the Act];

- Even if the Opponent had demonstrated its intention to not abandon its trademark as of May 18, 2016, there is no likelihood of confusion between the parties' marks.

[31] It is difficult to analyze a party's position when the party does not submit written arguments and does not present arguments at a hearing. I will therefore rely solely on the evidence on record.

[32] To dispose of this ground of opposition, there is no need to meticulously review the contents of Mr. Singh's affidavit filed as part of another opposition between the same parties. As noted previously, that affidavit is dated July 27, 2010. There is a period of almost six years between the date of that affidavit and the date of advertising of the present application and almost seven years if we consider the date of filing of the Opponent's evidence.

[33] There is no other affidavit from Mr. Singh or from another representative of the Opponent referring to that affidavit and/or providing an update on the evidence of use of the IRRESISTIBLES trademark by the Opponent.

[34] Assuming, for the purposes of my analysis, that the Opponent has shown use of the IRRESISTIBLES mark prior to July 16, 2015 (relevant date for this ground of opposition), there is no evidence of its use after March 31, 2010 (most recent invoice attached to Mr. Singh's affidavit).

[35] The Applicant submits that the lack of evidence of use of the IRRESISTIBLES mark by the Opponent over a period of more than six years (period between the most recent invoice and the date of advertisement of the present application) must lead us to conclude that the Opponent abandoned the use of its trademark within the meaning of section 16(5) of the Act. Thus, the Opponent would not have discharged its initial evidentiary burden under this ground of opposition.

[36] In *Bristol-Myers Squibb Company v Mentholatum Company of Canada, Limited*, 1991 CanLII 6790 (CA TMOB), the Registrar set forth the principle that, in general, in the absence of any other evidence, a five-year period without evidence of the use of a trademark is sufficient to conclude that the trademark has been abandoned.

[37] I would add that, in *Iwasaki Electric Co Ltd v Hortilux Schreder B V*, 2012 FCA 321, the Federal Court of Appeal upheld the principle that the Registrar can, in the absence of any other evidence, rely on the fact that a party has not used its trademark for a long time to conclude that it has been abandoned.

[38] In the circumstances, I find that the Opponent did not discharge its initial evidentiary burden, as it did not demonstrate that it had not abandoned the use of its IRRESISTIBLES trademark as of May 18, 2016.

[39] For these reasons, this ground of opposition is rejected.

[40] I would add that, if I am mistaken in finding that the use of the IRRESISTIBLES mark had been abandoned as of May 18, 2016, I would nonetheless reject the ground of opposition, as there is no risk of confusion between the Mark and the Opponent's IRRESISTIBLES trademark.

[41] There is no need for a comprehensive analysis of the criteria set out in section 6(5) of the Act. Indeed, as stated by the Supreme Court of Canada in *Masterpiece Inc v Alavida Lifestyles Inc et al* 2011 SCC 27, 92 CPR (4th) 361 (SCC), in most cases, the most important criterion is the degree of resemblance between the marks in question.

[42] However, in this case, there is no resemblance in sound, appearance or the ideas suggested by the INVITATIONS and IRRESISTIBLES marks. There is therefore no need to review the other criteria set out in section 6(5) of the Act to dispose of this issue.

[43] One could believe that the Opponent meant to refer to its IRRESISTIBLES & Design trademark (shown below), the subject of its application 1,452,360.



[44] Indeed, the design and font of the Mark have some similarities to those shown above. However, I do not need to address this issue because, as stated previously, the Opponent did not plead a ground of opposition based on past use of that trademark (section 16(3)(a) of the Act) or past filing of that application (section 16(3)(b) of the Act).

### **Ground of opposition based on the non-distinctiveness of the Mark**

[45] It should first be noted that this ground of opposition is based not on the use of the IRRESISTIBLES trademark, but rather on the IRRESISTIBLES & Design trademark shown above.

[46] However, none of the packaging or labels attached to Mr. Singh's affidavit refer to that design in terms of the font used or the rectangular design.

[47] To discharge its initial evidentiary burden under the ground of opposition based on the non-distinctiveness of the Mark, the Opponent needed to demonstrate that its IRRESISTIBLES & Design mark was known in Canada or well-known in a specific region of Canada at the date of filing of its statement of opposition (October 18, 2016), such that the Mark could not distinguish the Applicant's Goods at that date [see *Bojangles' International, LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427 (FC)].

[48] I find that the Opponent did not discharge its initial evidentiary burden. Indeed, there is no evidence on record that the Opponent used this trademark in Canada such that it was known in Canada or well-known in a specific region of Canada as of October 18, 2016.

[49] Even if I found that use of the IRRESISTIBLES mark under a different stylized signature than the one shown in the design above, as found in the exhibits attached to Mr. Singh's affidavit, is equivalent to use of the IRRESISTIBLES & Design trademark, the mark on which the Opponent bases this ground of opposition, there is no evidence of use of either of these marks in Canada since September 2010, as explained earlier. As such, I cannot conclude that either of these marks was known in Canada or well-known in a specific region of Canada as of October 18, 2016.

[50] I therefore reject this ground of opposition because the Opponent did not discharge its initial evidentiary burden.



DISPOSITION

[51] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

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Jean Carrière  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

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| Certified translation |
| Gerald Woodard        |

**TRADEMARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**NO HEARING**

**AGENT(S) OF RECORD**

None

FOR THE OPPONENT

Norton Rose Fulbright Canada LLP/S.E.N.C.R.L.

FOR THE APPLICANT