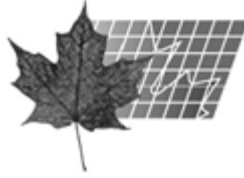


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LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 159**

**Date of Decision: 2021-02-01**

**IN THE MATTER OF OPPOSITIONS**

**Westhall Investments Ltd.**

**Opponent**

**and**

**MASTERCHEM INDUSTRIES LLC**

**Applicant**

**1,757,491 for TRIBUTE**

**Applications**

**1,757,492 for TRIBUTE and Design**

OVERVIEW OF APPL. NO. 1,757,491

[1] MASTERCHEM INDUSTRIES LLC (the Applicant) has applied-to register the trademark TRIBUTE (the Mark) with architectural protective coatings in the form of paints and primers based on the Applicant's proposed use. The application was filed on December 2, 2015 and has a priority filing date of August 24, 2015.

[2] Westhall Investments Ltd. (the Opponent) alleges that the Mark is confusing with its family of trademarks which include TRIBUTE such as TRIBUTE COMMUNITIES, TRIBUTE HOMES, and TRIBUTE URBAN LIVING. The Opponent's evidence shows that its TRIBUTE

trademarks have been extensively used in Southern Ontario with real estate development and building construction services.

[3] Notwithstanding the Opponent's longstanding and substantial use, given the differences in the nature of the applied-for goods and the Opponent's services, I find that the Applicant has met its legal onus of proving that there is no reasonable likelihood of confusion. Accordingly, the opposition is rejected.

#### BACKGROUND

[4] The Opponent opposed the application for the Mark pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on the basis of the grounds of opposition summarized below (see section 70 of the Act which states that the provisions of the Act as they existed prior to June 19, 2019 govern this case).

- (a) The application does not comply with the requirements of section 30(i) of the Act as the Applicant cannot be satisfied that it is entitled to use the Mark in Canada in view of the Opponent's prior use of its trademarks and trade names TRIBUTE COMMUNITIES and TRIBUTE HOMES and trademarks TRIBUTE URBAN LIVING and TRIBUTE COMMUNITIES BETTER BY DESIGN.
- (b) The Mark is not registrable pursuant to section 12(1)(d) of the Act as it is confusing with a registered trademark, namely the Opponent's TRIBUTE Trademarks set out below. All of these trademarks are registered with the following services:

Real estate development, building construction, single and multiple unit residential and commercial building construction, general contracting services namely contracting with sub-trades for the construction of single and multiple unit residential and commercial buildings, subdivision planning and construction.

<p>TRIBUTE COMMUNITIES TMA801,102</p>	<p>TRIBUTE HOMES TMA810,011</p>
<p>TRIBUTE URBAN LIVING TMA822,571</p>	<p>TRIBUTE COMMUNITIES BETTER BY DESIGN TMA819,936</p>

- (c) The Applicant is not the person entitled to register the Mark in view of sections 16(3)(a) and 16(3)(b) of the Act since the Mark was confusing with the Opponent’s trademarks TRIBUTE COMMUNITIES, TRIBUTE HOMES, TRIBUTE URBAN LIVING, and TRIBUTE COMMUNITIES BETTER BY DESIGN which had been previously used in Canada in respect of which trademark applications had been previously filed in Canada by the Opponent.
- (d) The Applicant is not the person entitled to register the Mark in view of section 16(3)(c) of the Act since the Mark was confusing with the Opponent’s trade names TRIBUTE COMMUNITIES and TRIBUTE HOMES which had been previously and continuously used in Canada by the Opponent.
- (e) The Mark is not distinctive as it could not distinguish and is not adapted to distinguish the applied-for goods from the goods and services associated with the Opponent’s TRIBUTE Trademarks and trade names.

[5] The Opponent filed as its evidence the affidavit of Patricia Lloyd, its Marketing Manager. The Applicant filed as its evidence the affidavits of Lindsey Van Poorten and Ravinder Dhindsa.

EVIDENTIAL BURDEN AND LEGAL ONUS

[6] While there is an initial evidentiary burden on an opponent; the legal burden or onus remains on the applicant, on a balance of probabilities [*John Labatt Ltd v Molson Co*, [1990] FCJ No 533, aff’d [1992] FCJ No 525 (FCA)].

## ANALYSIS OF THE GROUNDS OF OPPOSITION

[7] I will now consider the grounds of opposition beginning with the section 12(1)(d) ground of opposition.

### **Section 12(1)(d) Ground of Opposition**

[8] The material date for a section 12(1)(d) ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[9] The Opponent has pleaded that the Mark is not registrable because it is confusing with registration Nos. TMA801,102; TMA810,011; TMA822,571; TMA819,936 all of which are in good standing.

[10] I have to determine, on a balance of probabilities, if there is a reasonable likelihood of confusion with one or more of the Opponent's registered trademarks.

[11] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold or leased by the same person, whether or not the goods and services are of the same general class or Nice Class. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5). The criteria in section 6(5) are not exhaustive and different weight will be given to each one in a context-specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772 at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the trademarks, will often have the greatest effect on the confusion analysis.

*Analysis of the Section 6(5) Factors*

[12] I will first consider the inherent distinctiveness of the trademarks and the degree of resemblance between them before moving on to the remaining section 6(5) factors and other surrounding circumstances.

*Inherent Distinctiveness*

[13] Both the Mark and the Opponent's trademarks are inherently distinctive. The word tribute is defined in *www.dictionary.com* as set out below and does not appear to be connected to the applied-for goods or the Opponent's registered services.

- [1] a gift, testimonial, compliment, or the like, given as due or in acknowledgment of gratitude or esteem.
- [2] a stated sum or other valuable consideration paid by one sovereign or state to another in acknowledgment of subjugation or as the price of peace, security, protection, or the like.
- [3] a rent, tax, or the like, as that paid by a subject to a sovereign.
- [4] any exacted or enforced payment or contribution.
- [5] obligation or liability to make such payment.

*Degree of Resemblance*

[14] When considering the degree of resemblance between trademarks, the trademarks must be considered in their totality; it is not correct to lay the trademarks side by side and compare and observe similarities or differences among the elements or components of the trademarks [*Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée*, 2006 SCC 23 at para 20].

[15] There is a significant degree of resemblance between the trademarks at issue in appearance and sound as the Mark consists of TRIBUTE which is the distinctive component of each of the Opponent's registered trademarks. Further, the Opponent emphasizes this component throughout its marketing materials as shown in the affidavit of Ms. Lloyd. The degree of resemblance with respect to idea suggested is somewhat limited since while the Mark and the Opponent's trademarks suggest the idea of a tribute, the Opponent's trademarks also suggest a designer or builder of communities and homes.

*Extent Known and Length of Time in Use*

[16] The strength of a trademark may be increased by means of it becoming known through promotion or use.

[17] There is no evidence that the Mark has been used in Canada or that it has become known to any extent whatsoever in Canada.

[18] In contrast, it is clear that the Opponent's TRIBUTE trademarks have become well known in at least Southern Ontario in association with its real estate development and building construction services. Ms. Lloyd, the Marketing Manager of Westhall Limited Partnership, provides the following evidence:

- (a) The Opponent directly, or through its authorized licensee Westhall Limited Partnership, engages in real estate development, single and multiple unit residential and commercial building construction, general contracting services including contracting with sub-trades for the construction of single and multiple unit residential and commercial buildings, and, subdivision planning and construction (para 12).
- (b) The Opponent began developing residential properties in association with the trademarks and trade names TRIBUTE HOMES and TRIBUTE COMMUNITIES in about June 1983 (para 15).
- (c) Marketing of new housing from the 1980s through the 2000s occurred through newspaper print advertising, onsite signage, and brochures and literature distributed to prospective purchasers at on site sales offices or model homes (para 19; Exhibits 5-15). The marketing material attached to the Lloyd affidavit prominently features the TRIBUTE HOMES or TRIBUTE COMMUNITIES trademarks. Furthermore, the element TRIBUTE is emphasized with TRIBUTE appearing in larger font.

- (d) TRIBUTE COMMUNITIES uses social media, including FACEBOOK, Twitter, YouTube, and Instagram to interact with its perspective clientele (para 35).
- (e) On November 1, 2016 the downtown arena in Oshawa, Ontario previously named the General Motors Centre was renamed the Tribute Communities Centre. The Tribute Communities Centre is a multi-purpose arena used for a variety of events including ice hockey (OHL), lacrosse, concerts and other sporting events (para 36).
- (f) The Opponent has received multiple awards and third party recognition (para 38, Exhibit 20).
- (g) The Opponent has built more than 30,000 homes across Southern Ontario and its revenues are in the hundreds of millions dollars (para 30).

[19] The Applicant submitted that the evidence of use in the Lloyd affidavit did not enure to the Opponent on the basis of deficiencies and discrepancies in Ms. Lloyd’s cross-examination including the excerpts from the examination set out below this paragraph. I propose to approach the assessment of confusion by assuming that the use of the Opponent’s TRIBUTE Trademarks enures to the Opponent. I will only consider the issue of whether the Opponent’s evidence fails to demonstrate this, if the Applicant fails to meet its legal onus of proving there is no reasonable likelihood of confusion when the Opponent is permitted to put its best foot forward and have all of the evidence set out in the Lloyd affidavit considered.

Q51	... there’s a statement here that the opponent, which is Westhall Investments, has authorized Westhall Limited Partnership to use [and] sub-license the Tribute trademarks...
	Mm-hmm.
Q55	... you’re not actually privy to whatever authorization was made between Westhall Limited Partnership and Westhall Investments?
	I know the two partnerships. I’m not privy to the detail of that information, no.

Q56	... So you wouldn't know what the terms of the authorization were?
	Not the terms, no.
Q57-58	... There's a reference to these building management agreements ... and a sub-license from Westhall Limited Partnership to an owner.
	Mm-hmm.
Q61	And are you aware of – or have you seen these building management agreements before?
	Yes.
Q62	... And do they contain a license?
	I don't recall.

*Nature of Goods and Services and Trade*

[20] When considering sections 6(5)(c) and (d) of the Act, it is the statement of goods and services as defined in the registrations relied upon by the Opponent and the statement of goods in the application for the Mark that governs the assessment of the likelihood of confusion under section 12(1)(d) of the Act [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[21] With respect to the nature of the parties' goods, services or business, the parties target different consumers and operate in different channels. For the Opponent, it targets consumers wishing to purchase a new condominium or house. For the Applicant, the applied-for paints and primers target consumers wishing to purchase paints or primers. One of the Opponent's brochures explains (Exhibit 15):

Buying a new home is easily one of life's most important decisions. At Tribute Communities, we understand that, which is why we do everything possible to make this important step the right one for our customers. With groundbreaking innovation,



outstanding design and award-winning service, we create landmark communities and buildings that families are proud to call home. Over the years, Tribute Communities has won the trust and satisfaction of thousands of homeowners across Southern Ontario. Every day, new customers are joining the growing family of Tribute homeowners. We are happy to make their dream home a reality.

[22] While paint and primers are used in new home construction and purchasers are able to select their own unique décor or upgrade their paint choices as between different paint manufacturers (Q157), I do not find this overlap to be determinative. Products required in new home constructions is a very broad category of products and there is limited overlap in the particular interests of the parties. Further, there is no evidence that the applied-for goods would be considered by the average consumer as a natural extension of the Opponent's business. Rather, Ms. Lloyd's evidence is that she is unaware of builders or subcontractors working on new home construction making paint or selling it through a retail store (Q156, 160, 162).

*Surrounding Circumstance – Décor Studio*

[23] The Opponent submits that the evidence of its TRIBUTE DÉCOR STUDIO increases the likelihood of a consumer believing that TRIBUTE branded paints and primers emanate from the Opponent. Ms. Lloyd's evidence is that since 1995, TRIBUTE COMMUNITIES home purchasers are able to personalize their home décor by visiting the Tribute Décor Studio in Pickering. The Tribute Décor Studio is currently a 9000 square foot facility which includes fully furnished kitchens, bathrooms, flooring options, tile options, paint colours and interior surface finishes (para 31). The brochure at Exhibit 15 includes a page on the Tribute Décor Studio which includes the following.

The Tribute Décor Studio is the place where dreams take shape. No detail is too great or too small to be included in our customers' new home. Everything from fully furnished kitchens and bathrooms to staircases and decorative columns are right here for our customers to peruse, allowing them to make the right personal decisions. ...

We understand the importance of making every home a unique expression of our customers, a representation of their hopes and dreams, a striking metaphor of their individual personality. Our professional design consultants listen to their ideas and advise them on the latest styles and trends. They make sure that every choice our customers make co-ordinates perfectly with one another, so that their home looks tasteful and elegant. ...

[24] Mr. Dhindsa, a private investigator, visited the Décor Studio and submits an affidavit detailing his conversation with an unidentified receptionist. I do not find his evidence diminishes Ms. Lloyd's evidence.

[25] I find that the evidence of Ms. Lloyd about the DÉCOR STUDIO shows that there is a connection between the Opponent's registered services and the Applicant's goods. That being said, it is a loose connection given the range of different items required in the construction of a new home.

*Surrounding Circumstance – Partnership with Debbie Travis*

[26] Ms. Lloyd's evidence is that in 2008 TRIBUTE COMMUNITIES partnered with Debbie Travis, a Canadian popular design expert and TV host, to develop a line of Debbie Travis Designed Homes in eight Tribute projects across the GTA. The brochure at Exhibit 18 includes the following:

Debbie adds her original design style to your Tribute Communities Home. Bringing you the latest from wallcoverings to tiles to the most unique flooring ideas. It's put together just for you.

[27] Similar to the evidence regarding the Tribute Décor Studio, this evidence shows that there is a loose connection between the Opponent's registered services and the Applicant's goods in that décor choices including paints and primers are required in the finishing of new homes.

*Surrounding Circumstance – State of the Register and State of the Marketplace Evidence*

[28] The Applicant has filed evidence of the results of a search by a law clerk employed by its agent to locate all registered or pending trademarks containing or comprising TRIBUTE (Van Poorten affidavit, para 2). State of the register evidence can be used to make inferences about the state of the marketplace, but only where large numbers of relevant registrations are located [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432; *Del Monte Corporation v Welch Foods Inc* (1992), 44 CPR (3d) 205 (FCTD); *Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)]. While there are over 30 TRIBUTE trademark registrations on the Register, the vast majority of these are for unrelated goods and services. There is

insufficient evidence to conclude that consumers are used to distinguishing such similar trademarks in the parties' fields of interest.

### *Conclusion*

[29] Section 6(2) of the Act is not concerned with confusion between the trademarks themselves, but rather confusion as to the source of the Opponent's services and the applied-for goods. Further, as the Supreme Court of Canada explains in *Mattel, supra* at para 57, the ordinary consumer is owed a certain amount of credit:

... I fully agree with Linden J.A. in *Pink Panther* that in assessing the likelihood of confusion in the marketplace "we owe the average consumer a certain amount of credit" (para. 54). A similar idea was expressed in *Michelin & Cie v. Astro Tire & Rubber Co. of Canada Ltd.* (1982), 69 CPR (2d) 260 (FCTD), at 263:

... one must not proceed on the assumption that the prospective customers or members of the public generally are completely devoid of intelligence or of normal powers of recollection or are totally unaware or uninformed as to what goes on around them.

[30] In this case, an assessment of confusion asks whether a consumer confronted with the Mark in association with architectural protective coatings in the form of paints and primers would be confused and think that they emanate from the Opponent. On a balance of probabilities, I find that they would not.

[31] Having regard to all of the surrounding circumstances and, in particular, to the differences in the nature of the Opponent's services and the Applicant's goods and the expansive breadth of materials used in the construction of a new home, I conclude that the Applicant has met the legal burden upon it of establishing that there is no reasonable likelihood of confusion between its Mark and each of the Opponent's TRIBUTE trademarks. Accordingly, I reject this ground of opposition. Finally, given that the Applicant has succeeded in proving that there is no reasonable likelihood of confusion when the evidence of use in Ms. Lloyd's affidavit is presumed to enure to the Opponent, it is unnecessary for me to consider the Applicant's submissions on this issue.

### **Section 16(3) and Section 2 Grounds of Opposition**

[32] With respect to the grounds of opposition based on section 16(3) of the Act, the material date is the applicant's priority date (August 24, 2015). The material date for assessing the non-distinctiveness ground is the date of opposition (February 28, 2017). The Opponent's section 16(3)(a) ground of opposition relies on use of the same trademarks pleaded with respect to the section 12(1)(d) ground of opposition. The Opponent's section 16(3)(c) ground of opposition relies on use of the trade names TRIBUTE COMMUNITIES and TRIBUTE HOMES. The Opponent's section 2 ground of opposition relies on the Opponent's use of the trade names and trademarks TRIBUTE COMMUNITIES and TRIBUTE HOMES and the trademarks TRIBUTE URBAN LIVING and TRIBUTE COMMUNITIES BETTER BY DESIGN.

[33] The Opponent's case regarding confusion is strongest under its section 12(1)(d) ground of opposition because the later material date allows all of the Opponent's evidence concerning its reputation to be considered. As the Opponent has not succeeded under this ground, it will also not succeed under its section 16(3) and section 2 grounds of opposition which rely on the same trademarks and trade names.

### **Section 16(3)(b) Ground of Opposition**

[34] The Opponent alleges that the Applicant is not the person entitled to registration pursuant to section 16(3)(b) of the Act, because the Mark is confusing with the previously filed applications for the Opponent's TRIBUTE Trademarks. This ground of opposition fails because section 16(4) of the Act requires that applications relied upon be pending as of the advertisement date of the opposed application. As each of the relied-upon trademarks was registered prior to the advertisement date, the Opponent fails to meet its evidential burden [*Governor and Co. of Adventurers of England trading into Hudson's Bay, commonly called Hudson's Bay Co. v Kmart Canada Ltd.* (1997), 76 CPR (3d) 526 (TMOB) at 528]. This ground of opposition is therefore rejected.

### Section 30(i) Grounds of Opposition

[35] The material date for this ground of opposition is the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)] or the priority filing date [*Agrifoods International Cooperative Ltd v Pacific Foods of Oregon* (1996), 70 CPR (3d) 334 (TMOB)]. In this opposition, the difference between the dates would not impact my assessment of this ground.

[36] I reject the section 30(i) ground of opposition because the allegation that the Applicant could not state it was entitled to use the Mark in view of confusion with the Opponent's TRIBUTE Trademarks and trade names does not raise a proper ground of opposition. Section 30(i) of the Act only requires that an applicant declare itself satisfied that it is entitled to use the applied-for mark. Such a statement is included in the application for the Mark. Section 30(i) of the Act can be the basis of a ground of opposition in exceptional cases, such as where bad faith by the applicant is alleged or if specific statutory provisions prevent the registration of the applied-for mark [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) and *Canada Post Corporation v Registrar of Trade-marks* (1991), 40 CPR (3d) 221 (FCTD)]. However, no such facts or allegations are included here. Accordingly, this ground of opposition is rejected.

APPL. NO. 1,757,492

[26] Application No. 1,757,492 is for the trademark TRIBUTE & Design set out below:



TRIBUTE

[27] The applied-for goods, grounds of opposition, issues, material dates and evidence are entirely analogous to those discussed with respect to application No. 1,757,491. For the grounds of opposition based on confusion, with respect to the section 6(5)(e) factor degree of resemblance, I do not find that the design changes the degree of resemblance. It follows that I

make the same findings with respect each of the grounds of opposition as in application No. 1,757,491 for TRIBUTE. Accordingly, all of the grounds of opposition are rejected.

DISPOSITION

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

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Natalie de Paulsen  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

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

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**HEARING DATE** 2020-10-19

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