

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 55

Date of Decision: 21-03-26

IN THE MATTER OF AN OPPOSITION

Bremont Homes Corporation

Opponent

and

Bremont Watch Company Limited

Applicant

1,630,866 BREMONT

Application

INTRODUCTION

[1] Bremont Homes Corporation (the Opponent) opposes registration of the trademark BREMONT (the Mark), the subject of application No. 1,630,866 (the Application), that was filed by Bremont Watch Company Limited (the Applicant).

[2] Filed on June 12, 2013, the Application is based on of use of the Mark in Canada since as early as January 2010 in association with “watches”, and since as early as March 2012 in association with the following services:

Online retail store services featuring watches, watch bands/straps, watch bracelets, letter openers, key rings, cufflinks, watch tools, business card holders, watch wallets, watch rolls, document folders, buckles, watch clasps.

[3] The Application is also based on use and registration of the Mark in the United Kingdom under registration No. 2396394, in association with a variety of jewellery, decorative, ornamental, stationery, leather and luggage-related goods (listed as goods (2), (3), and (4)) in the Application. A complete listing of the applied-for goods and services is included as Schedule A to this decision.

[4] The Application was advertised in the *Trademarks Journal* of July 5, 2017.

[5] The Opponent alleges that (i) the Application does not conform to the requirements of sections 30(b), 30(d), and 30(i) of the *Trademarks Act*, RSC 1985, c T-13 (the Act) (ii) the Mark is not registrable under section 12(1)(d) of the Act; (iii) the Applicant is not the person entitled to the registration of the Mark under section 16 of the Act, and (iv) the Mark is not distinctive under section 2 of the Act. The last three grounds of opposition revolve around confusion between the Mark and the Opponent's BREMONT-based marks (the Opponent's Marks, details of which are attached under Schedule B to this decision.

[6] As a preliminary matter, I note that the Act was amended on June 17, 2019. All references in this decision are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act as it read before it was amended (see section 70 of the Act which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised prior to that date).

[7] For the reasons that follow, I reject the opposition.

THE RECORD

[8] The Opponent filed its statement of opposition on December 5, 2017. The Applicant filed and served its counter statement on February 6, 2018 denying all of the grounds of opposition.

[9] In support of its Opposition, the Opponent filed the affidavit of Gary Breda, the President of the Opponent, sworn June 5, 2018, together with Exhibits A to Q, and a certified copy of the decision of the Registrar in the proceeding for the trademark BREMONT, which issued to registration under TMA962,781. That decision dealt with four applications of the Opponent: BREMONT (under application No. 1,557,052, now TMA962,781), BREMONT DESIGN (under

application No. 1,557,053, now TMA962,831), BREMONT HOMES DESIGNED FOR LIVING & Design (under application No. 1,557,056, now TMA962,782), and BREMONT HOMES & Design (under application No. 1,557,064, now TMA962,794) (the Opponent's Marks). All are registered in association with "Real estate development services, and construction and sale of residential homes."

[10] In support of its Application, the Applicant filed the affidavit of Giles English, co-founder of the Applicant, sworn October 4, 2018, together with Exhibits A to Q.

[11] Neither Mr. English nor Mr. Breda were cross-examined on their affidavits.

[12] The Opponent did not file reply evidence. Both parties filed written arguments and were represented at an oral hearing.

THE PARTIES' RESPECTIVE BURDEN OR ONUS

[13] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the applications comply 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].

[14] With respect to the grounds of opposition, it is the following material dates that apply:

- Sections 38(2)(a)/30 - the filing date of the application, namely, **June 12, 2013** [see *Georgia-Pacific Corporation v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *John Labatt Ltd v Molson Companies Ltd* (1990), 1990 CanLII 11059 (FC), 30 CPR (3d) 293 at 296 (FCTD) re: section 30(b); *Austin Nichols & Co, Inc v Cinnabon, Inc* (2000), 5 CPR (4th) 565 (TMOB) re: section 30(d); and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB) re: section 30(i)];

- Sections 38(2)(b)/12(1)(d) – the date of my decision [see *Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd* (1981), 37 CPR (3d) 413 (FCA)];
- Sections 38(2)(c)/16(1)(a), (b), and (c) – the date of first use claimed in the Application, namely, **January 2010** in association with “watches”, and **March 2012** in association with the services [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317 and section 16(1) of the Act];
- Sections 38(2)(c)/16(2)(a), (b), and (c) - the date of filing of the application, namely, **June 12, 2013** [see section 16(2) of the Act]; and
- Sections 38(2)(d)/2 – the date of filing of the statement of opposition, in this case being **December 5, 2017** [see *Metro-Goldwyn-Mayer supra*].

ANALYSIS

Section 30(b) Ground of Opposition

[15] The Opponent has plead that the Application does not conform to the requirements of section 30(b) of the Act, as the Applicant did not use the Mark in association with each and every service specified in the Application, as at the date of first use claimed. Further to this, the Opponent pleads that the Application does not comply with the requirements of section 30(b), since the Applicant did not use the Mark in the normal course of trade. For the reasons that follow, the section 30(b) ground of opposition is dismissed.

[16] The Opponent relies on the Applicant’s evidence in support of meeting its burden [see *Corporativo de Marcas GJB, SA De CV v Bacardi & Company Ltd* 2014 FC 323 (*Marcas*); *Molson Canada v Anheuser-Busch Inc* 2003 FC 1287, 29 CPR (4th) 315]. In this regard, the Opponent submits that the Applicant’s only supporting evidence of use of the Mark with watches is a single invoice dated November 15, 2011. The Opponent notes that the parties to the present opposition proceeding were involved in a previous opposition proceeding wherein the Applicant’s evidence included this same November 15, 2011 invoice. The Opponent submits that the Applicant’s re-submission of a single invoice from 2011 is clearly inconsistent with the Applicant’s claim of continuous use of the Mark since January 2010 as well as use in the normal

course of trade over the course since the date of first use claimed, as it would have been easy to include even a single additional invoice to support the Applicant's claim to use in Canada. The Opponent submits that it appears that the Applicant abandoned their trademark rights as of 2015; indeed, the Opponent submits that there has not been any use of the Mark beyond the 2011 invoiced sale.

[17] In addition to the aforementioned, the Opponent also notes that in the Applicant's evidence (the English affidavit, Exhibit O), social media printouts show a posting from an individual in November 2010, which states, "I hope to see Bremont in Canada soon as well." The Opponent submits that Mr. English did not address this in his affidavit, and the appearance of this post on social media is also clearly inconsistent with the Applicant's claim to use since at least as early as January 2010. The Opponent submits it has thus met its light evidentiary burden to shift the onus onto the Applicant to prove the Application complies with section 30(b) of the Act in association with watches.

[18] With respect to the services, the Opponent submits that the English affidavit is silent as to whether *Canadians* could place an order and have any of the items specified in the class 35 online retail services shipped to Canada. None of the evidence in Exhibit B to the English affidavit (printouts from the Applicant's website at *www.bremont.com*) shows anything akin to "Add a bag" or "Add to Shopping Cart" indicating that consumers can purchase watches online. The Opponent submits that it would have been a simple matter to include screen shots of the Applicant's website showing how an order could be placed or to have included a single invoice resulting from an online watch sale shipped to a Canadian address. The Opponent submits that the fact that Canadians could access or did access the website is irrelevant to the question of whether Canadians could actually order from the Applicant's website and have the watch shipped to their Canadian address; nothing in the affidavit, nor the exhibits to the English affidavit shows that this was possible. Thus, the Opponent submits that the Applicant has therefore failed to establish compliance with section 30(b) with respect to the services.

[19] The Applicant submits that the Opponent has not discharged its initial evidential burden to establish facts relied upon by it in support of this ground of opposition. The Applicant submits that the Opponent has provided no evidence upon which to cast doubt on the veracity of the

Applicant's claimed dates of first use in relation to goods (1). I agree. In this regard, the Applicant submits that Mr. English has provided a sworn statement that the Applicant has been continuously selling its BREMONT watches in Canada through an authorized dealer (L'Oro Jewellery), and has provided a *representative* sample of an invoice dated November 15, 2011 to said authorized dealer. The Applicant submits, and I agree, that the mere fact that the Applicant does not provide an invoice going back as far as the claimed date of first use, or to support continuous sales does not satisfy the Opponent's evidential burden. Further to this, I note that the English affidavit shows that one of the Applicant's authorized Canadian dealers continued to advertise the Applicant's watches into 2012 (per Exhibit H, L'oro Jewellery's blog regarding the launch of a new BREMONT watch), which is consistent with continuous use of the Mark in Canada. With respect to the Opponent's submissions regarding the comments made by an individual on social media (Exhibit O to the English affidavit), the Applicant submits that the Opponent is now seeking to rely on evidence that it has argued is unreliable in establishing reputation in the Mark (per paragraph 53 of Opponent's written argument). In any event, while I accept that such a social media blog/forum exists, there is no basis on which to accept this evidence for the truth of its contents.

[20] Likewise, the Applicant submits, the Opponent has not provided any evidence upon which to cast doubt on the veracity of the claimed date of first use in relation to the Applicant's services and has therefore failed to discharge its initial evidential burden. Once again, I agree. That the evidence may not show how a Canadian could order a watch online from the Applicant's website, or that the evidence does not include an invoice for the sale of goods through the Applicant's website, is not sufficient. Indeed, once again, the Applicant is under no obligation to evidence its claimed date of first use if this date is not first put into issue by an opponent meeting its evidential burden [see *Kingsley v Ironclad Games Corporation*, 2016 TMOB 19, at para 63].

[21] Accordingly, the section 30(b) ground of opposition is dismissed for the Opponent's failure to meet its initial evidential burden.

Section 30(d) Ground of Opposition

[22] The Opponent has plead that the Applicant did not use the Mark in the United Kingdom in association with each and every good specified in the Application, as at the date of first use claimed. Further to this, the Opponent pleads that the Application does not comply with the requirements of section 30(d), since the Applicant did not use the Mark in the normal course of trade.

[23] The Opponent submits that as evidence of use, the Applicant has submitted 5 invoices, one each for the years 2008-2012. The invoices include a coded description; however, paragraph 5 of the English affidavit is silent as to what each of the codes identify. The Opponent submits that the codes appear to correspond with codes shown on the printouts from the Applicant's website in Exhibit B and the second page of Exhibit O to the English affidavit which appear to represent watches and chronometers with none representing any of the other goods itemized in the Application.

[24] The Opponent submits that the Application is clearly inconsistent with the Applicant's claim of use since at least as early as 2007 in association with the majority of the goods included in classes 14, 16, and 18 in the application. For example, there is no evidence of use of the Mark in association with agates, diamonds, articles of luggage, paper, cardboard, kitchen utensils, erasers or crayons, to name a few. In paragraph 5 of the English affidavit, the Applicant has included nothing more than a bare statement they have sold all of those goods in the UK since at least as early as 2007, which is not sufficient to demonstrate use in association with all of the goods listed in those classes.

[25] The Applicant, however, correctly notes that there is no requirement to provide a date of first use under section 30(d).

[26] The Applicant further submits that the Opponent has adduced no evidence upon which to cast doubt on the Applicant's claims of use in the UK in relation to its goods. The Applicant reiterates its argument under section 30(b), specifically that there is no burden on the Applicant to demonstrate its use in the UK as the Opponent has failed to show that the Applicant's evidence is clearly inconsistent with its claims. I agree. Further, I note that the Applicant has

provided *representative* evidence of sales of its products in the UK by way of Exhibit E-1 to the English affidavit.

[27] Consequently, the section 30(d) ground of opposition is also dismissed for the Opponent's failure to meet its initial evidential burden.

Section 30(i) Ground of Opposition

[28] The Opponent has plead that the Application does not comply with the requirements of section 30(i) of the Act, since the Applicant was, at the time the Application was filed, aware of the Opponent's BREMONT trademark and formatives thereof, for use in connection with many goods and services. The Opponent further states in its pleading that primarily, the Opponent's BREMONT marks are known in Canada in association with real estate development and that the Applicant was aware that its Mark would be confused with the Opponent's BREMONT marks, and could not, therefore, have been satisfied as to its entitlement to use the Mark in Canada.

[29] Section 30(i) of the Act merely requires that an applicant include a statement in its application that it is satisfied that it is entitled to registration of its trademark. Where this statement has been provided, as in the present case, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co Ltd v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. The Applicant submits, and I agree, that no evidence of bad faith has been provided by the Opponent nor any evidence to support that this is an exceptional case. Indeed, even if the Applicant had been aware of the Opponent's trademark, the mere knowledge of the existence of the Opponent's trademark does not in and of itself support an allegation that the Applicant could not have been satisfied of its entitlement to use the Mark [see *Woot, Inc v Woot Restaurants Inc Les Restaurants Woot Inc* 2012 TMOB 197].

[30] The section 30(i) ground of opposition is therefore dismissed for the Opponent's failure to meet its initial evidential burden.

Non-entitlement Grounds of Opposition

[31] The Opponent has plead that the Applicant is not entitled to registration of the Mark because at the date of first use or making known of the Mark, namely, January 2010 in association with watches, and March 2012 in association with the services [per 16(1)(a), (b), and (c)], and at the date of filing of the Application, namely, June 12, 2013 [per 16(2)(a), (b), and (c)], the Mark was confusing with:

- the Opponent's BREMONT Marks shown in Schedule B, which had been previously continuously used and made known in Canada by the Opponent in association with the listed services;
- the Opponent's BREMONT Marks shown in Schedule B, for which applications for registration had been previously filed in Canada by the Opponent; and
- the Opponent's trade name, namely, BREMONT, which had been previously used and made known in Canada by the Opponent.

[32] With respect to the ground of opposition based on section 16(1)(a) of the Act, the Opponent has an initial burden of establishing that one or more of its trademarks alleged in support of this ground of opposition was used or made known prior to the Applicant's claimed dates of first use, namely, January 2010 in association with watches, and March 2012 in association with the services, and was not abandoned at the date of advertisement of the Application for the Mark (July 5, 2017) [section 16(5) of the Act]. Similarly, with respect to the ground of opposition based on section 16(1)(c), the Opponent must show that its trade name BREMONT had been used in Canada prior to the claimed dates of first use of the Mark. The Opponent must also demonstrate that it had not abandoned its trade name at the date of advertisement of the Mark.

[33] With respect to the ground of opposition based on section 16(2)(a) of the Act, the Opponent's initial burden is to establish that it had used one or more of the Opponent's Marks in Canada prior to the filing date of the application for the Mark, namely, June 12, 2013, and that it had not abandoned its mark(s) as of the date of advertisement of the application for the Mark

[section 16(5) of the Act]. Once again, similarly, with respect to the ground of opposition based on section 16(2)(c), the Opponent must show that its trade name BREMONT had been used in Canada prior to the filing date of the application for the Mark, and that it had not abandoned its trade-name at the date of advertisement of the Mark.

[34] As previously indicated, with respect to use of the Opponent's Marks and trade name regarding the sections 16(1)(a), 16(2)(a), 16(1)(c), and 16(2)(c), the Opponent provides the affidavit of Mr. Breda.

[35] Mr. Breda attests that the Opponent is the owner of several BREMONT-based marks (the Opponent's Marks), which are listed in Schedule B to this decision, and pertain to real estate development, construction and sales of residential homes. He states that the Opponent has been using BREMONT in association with the services associated with the Opponent's Marks since at least as early as October 31, 2004. He provides substantial sales revenues for the Opponent's services rendered in association with the various Opponent's Marks for the years 2008 to 2013, and states that the Opponent spends approximately \$60,000 to \$100,000 annually on advertising and promotion of its services.

[36] Mr. Breda attests that the Opponent advertises and promotes its services through its website at *www.bremonthomes.com*, a website that was registered in 2004, and has been in continuous operation since then. In support, he provides printouts of the Opponent's website as of 2014 (Exhibit A), archived printouts of the website as it appeared on September 26, 2011 (Exhibit B), printouts of a new community developments dated 2014 (Exhibit C), archived printouts of past community developments from 2004 to 2013 (Exhibit D), and screenshots from the Opponent's current website, dated May 31 and June 1, 2018, still accessible at *www.bremonthomes.com* (Exhibit D-1). The various Opponent's Marks and trade-name are clearly visible on the Opponent's website.

[37] Mr. Breda also attests that the Opponent advertises its services in various trade magazines, newspapers, radio advertisements and on the internet through third party websites. In support, he provides:

- a selection of printouts of the Opponent’s internet advertising from 2014 (Exhibit E – YouTube, various third party publications, Twitter, Google+, and Facebook account advertisements), and advertisements from 2018 (Exhibit E1 – Facebook, Twitter, Instagram, and YouTube account advertisements);
- Printouts from the Opponent’s website from 2014 (Exhibit E2);
- Copies of advertisements in *New Homes* magazine regarding various residential real estate projects of the Opponent in Canada, as well as photographs of real estate presentation centres for the projects, posters, articles regarding the projects (Toronto Sun and Toronto Star), brochures, letterhead, envelopes, and booklets provided to customers during the promotion and sales of new residential homes spanning 2004 to 2013 (Exhibits F to M);
- invoices for advertising and promotional services provided to the Opponent by an advertising agency, including an invoice for tool kits to be provided as promotional gifts to new homeowners and to industry-associated service providers (Exhibit J-1);
- a picture of a door hanger of the type left at Bremont homes during service visits following a sale, which have been used since 2007; and
- a representative invoice for the sale of a Bremont home, representative of those used by the Opponent since 2005.

All of the aforementioned advertisements, promotional materials, etc. clearly display the various Opponent’s Marks as well as the Opponent’s trade-name.

[38] Lastly, Mr. Breda attests that as part of the Opponent’s advertising and promotion efforts, the Opponent also distributes promotional items bearing the Opponent’s Marks. He states that these items are distributed in connection with, and during the course of the sale of a new home, such as in the form of a gift basket. He attests that promotional items distributed include t-shirts (since 2005), jackets (since 2006), gift baskets containing chocolates, sandwiches, toy watches, costume jewellery, flowers, baseball caps, t-shirts, sweaters, jackets and gloves; blankets, robes and towels (since 2007). The list of promotional items changes from time to time (per Breda

affidavit, para 28) and can include items such as cutting board sets, slippers, umbrellas and watches (Exhibit Q). He states that the watches have been distributed during the promotion and sales of new homes since 2007.

[39] Having regard to the above, I am satisfied that the Opponent has met its initial burden of establishing that one or more of the Opponent's Marks as well as its trade name alleged in support of these grounds of opposition were used prior to the claimed dates of first use set out in the Applicant's Application, as well as the filing date, and was not abandoned at the date of advertisement of the application for the Mark. I now have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with one or more of the Opponent's Marks or its trade name.

The test for confusion

[40] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[41] 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 trademarks 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 trademarks in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and it is not necessary to give each one of them equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, 1 SCR 772 (SCC) at para 54; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361].

Section 6)(5)(a) – the inherent distinctiveness and the extent to which the marks have become known

[42] The overall consideration of the section 6(5)(a) factor, involves a combination of inherent and acquired distinctiveness of the parties' marks.

[43] Further, the strength of a trademark may be increased by means of it becoming known in Canada through promotion or use.

[44] The Opponent submits that its BREMONT Marks are inherently distinctive, as BREMONT is an invented word and, otherwise, is neither descriptive nor suggestive. Mr. Breda states that he "chose the name BREMONT based on the first three letters of his family name, BREDA, and the first four letters of MONTANA, which is the Italian word for mountain."

[45] Further to this, the Opponent submits that the Opponent's BREMONT Marks have been used extensively and continuously since at least as early as 2005. In contrast, the Opponent submits, the Applicant offers scant evidence of its distinctiveness or reputation in Canada.

[46] The Applicant, on the other hand, submits that its Mark is also an invented word, and accordingly is inherently distinctive. Further to this, the Applicant submits that Mr. English has attested that the Applicant has sold its BREMONT watches in Canada since at least as early as January 2010 through its authorized Canadian dealer, L'Oro Jewellery and has expended in excess of GBP16,000 (British Pounds) since 2010 on the advertising and promotion of its BREMONT watches in North America. The Applicant submits that Applicant's website (Exhibit C to the English affidavit) which advertises BREMONT watches, was viewed by Canadians and that there were 15,360 visits to the Opponent's website originating from Canada between December 2008 and 2011.

[47] While the inherent distinctiveness factor does not favour either party, the acquired distinctiveness appears to favour the Opponent, but with respect to real estate development services. The fact that the Opponent distributes toy watches in the course of sales of new homes as promotional items, is distribution in relation to promoting the Opponent's services and is not part of a transfer in the normal course of trade as required to constitute use under section 4(1) of

the Act [see *Brownlee LLP v 555,129 Ontario Limited*, 2013 TMOB 23 and *Osler, Hoskin & Harcourt LLP v Ontario Teachers Insurance Plan*, 2016 TMOB 53 re: normal course of trade].

Section 6(5)(b) – the length of time of use

[48] As discussed in the section 6(5)(a) factor above, as well as in the discussion regarding the Opponent's burden being met under these grounds, I accept that the Opponent has shown prior use of the Opponent's Marks and trade name in Canada, but in association with real estate development services, and the construction and sale of residential homes. The Opponent, however, has not shown use in the normal course of trade of the Opponent's Marks or trade name in association with watches. Indeed, the Applicant submits that each party's BREMONT mark has been co-existing for their very different goods and services in their very different fields of expertise for an extended period of time; accordingly, the length of time the trademarks have been in use is therefore of minor importance.

Sections 6(5)(c) and (d) - the nature of the goods, services or business; and the nature of the trade

[49] The Opponent submits that it is a real estate development company that constructs and sells residential homes in Ontario. While the goods listed in the Opponent's registrations appear to be dissimilar, the Opponent submits that it has generated a reputation and goodwill in the items the Opponent distributes as part of its sales and construction of homes as detailed in the Breda affidavit and exhibits. The Opponent submits that the average consumer faced with a BREMONT branded watch would be confused about the source of the watch and/or the relationship between the Applicant and the Opponent.

[50] The Opponent further submits that although the Applicant's watches are high end luxury items that can only be purchased through authorized dealers, they are often used for co-branding of luxury products and services. The Opponent submits that this practice of co-branding increases the likelihood that the Opponent's customers may become confused about the source of the Applicant's watches since the Opponent regularly distributes watches as part of its branding strategy.

[51] The Applicant submits that it produces luxury chronometers and timepieces, including watches, which are sold in Canada through distributors and retailers, as well as online. In addition, the Applicant also produces clocks which are installed in luxury vehicles, including Jaguar automobiles. The Applicant does not provide any goods or services similar to the Opponent's services listed in its registered trademarks.

[52] Furthermore, the Applicant submits that it does not offer services even remotely similar to the services offered by the Opponent and accordingly, there is no potential for overlap in the trades of the Opponent and that of the Applicant. I agree with the Applicant. The Opponent only distributes toy watches as a mechanism to generate goodwill with respect to the sale of homes, and is used to promote the Opponent's services, rather than as objects of trade, in and of themselves. The Opponent is attempting to expand its protection to encompass goods in which it does not trade; if I were to accept the Opponent's arguments regarding confusion based on promotional distribution of these goods, the Opponent could equally claim protection with respect to any promotional item that it so chooses to distribute.

[53] Having regard to the foregoing, I find the section 6(5)(c) and (d) factors overwhelmingly favour the Applicant.

Section 6(5)(e) - degree of resemblance in appearance, when sounded, or in idea suggested

[54] I find that there is a significant degree of resemblance between the parties' marks in appearance, when sounded and the ideas suggested. Indeed, the striking portion of each party's marks and the trade name of the Opponent is identical, namely, BREMONT.

Conclusion

[55] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection.

[56] While *Masterpiece Inc v Alavida Lifestyles* (2011), 2011 SCC 27 (CanLII), 92 CPR (4th) 361, the Supreme Court of Canada highlighted the importance of the section 6(5)(e) factor in the analysis of the likelihood of confusion I find that on a balance of probabilities, the Mark is not confusing with the Opponent's Marks and trade name. The difference in the nature of the parties'

goods, services, and channels of trade is just too significant to conclude otherwise. Furthermore, there is no evidence before me which would support the conclusion that the Opponent's Marks and trade name have transcended its services, to include the Applicant's goods.

[57] Having regard to the foregoing, I reject the grounds of opposition based on sections 16(1)(a), 16(2)(a), 16(1)(c) and 16(2)(c) of the Act.

Sections 16(1)(b) and 16(2)(b) Grounds of Opposition

[58] The Opponent has plead that the Applicant is not entitled to registration of the Mark because at the date the Applicant first used or made known the Mark, namely, January 2010 in association with "watches", and March 2012 in association with the services, the Mark was confusing with one or more of the Opponent's Marks, for which applications for registration had been previously filed by the Opponent and were not abandoned.

[59] With respect to the ground of opposition based upon section 16(1)(b) of the Act, the Opponent has an initial burden of establishing that one or more of its applications for the Opponent's Marks were filed prior to the date of first use alleged in the subject application, namely, January 2010 in association with "watches" and March 2012 in association with services, and but also that they were pending at the date of advertisement of the present application (July 5, 2017) [section 16(4) of the Act].

[60] With respect to the ground of opposition based upon section 16(2)(b) of the Act, in order to meet its initial burden, the Opponent must establish that one or more of the applications for the Opponent's Marks were filed prior to the filing date of the Applicant's application (June 12, 2013), and also were pending at the date of advertisement of the Applicant's application (July 5, 2017) [section 16(4) of the Act].

[61] I have exercised my discretion to inspect the trademark register to confirm the existence of the Opponent's Marks [see *Royal Appliance Mfg, supra*]. In doing so, I note that the Opponent's initial burden is not met regarding its section 16(2)(b) ground because each of the Opponent's Marks either issued to registration prior to June 12, 2013, and therefore were not pending as of the date of advertisement of the Mark, or were filed after the subject Application

was filed. Furthermore, the Opponent's initial burden with respect to its section 16(1)(b) ground is similarly not met as the Opponent's Marks were either filed after the date of first use alleged in the subject application, or they were no longer pending as of the date of advertisement of the Application for the Mark.

[62] Accordingly, the section 16(1)(b) and 16(2)(b) grounds are dismissed.

Section 12(1)(d) Ground of Opposition

[63] The Opponent has plead that the Mark is not registrable under section 12(1)(d) because it is confusing with any or a combination of the Opponent's prior registered BREMONT marks (shown in Schedule B to this decision), registered for use in association with the listed services.

[64] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if one or more of the registrations relied upon are in good standing. The Registrar has the discretion to check the register in order to confirm the existence of any registrations relied upon by an opponent [see *Quaker Oats of Canada, supra*]. I have exercised the Registrar's discretion to confirm that the Opponent's registrations are in good standing as of today's date, which, as previously indicated, is the material date for assessing a section 12(1)(d) ground of opposition [per *Park Avenue Furniture Corp, supra*]. The Opponent has therefore satisfied its evidential burden.

[65] I now have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with the Opponent's registered BREMONT trademarks.

[66] The difference in material date under this ground of opposition does not affect my ultimate conclusion regarding confusion between the parties' marks. As such, my findings under the grounds of opposition based on section 16(1)(a) and 16(2)(a) are equally applicable.

[67] Accordingly, the ground of opposition under section 12(1)(d) is also rejected.

Section 2 Ground of Opposition

[68] The Opponent has plead that the Mark is not, and cannot be, distinctive of the Applicant within the meaning of section 2. The Opponent's BREMONT marks (shown in schedule B to

this decision) have been extensively and continuously used in Canada in association with the listed services. The Opponent alleges that as there is a likelihood of confusion between the Opponent's BREMONT marks and the Mark, the Mark does not distinguish, and is not adapted to distinguish, the Applicant's goods and services from the Opponent's goods and services. Furthermore, the Opponent has not abandoned its use of the Opponent's BREMONT marks or the BREMONT tradename, and uses them continuously in association with the listed goods and services.

[69] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its goods from those of others throughout Canada [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd*, (1985) 4 CPR (3d) 272 (TMOB)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of its non-distinctiveness ground.

[70] In order to meet its initial burden with respect to this ground, the Opponent must establish that as of the filing date of the statement of opposition, namely, December 5, 2017, the Opponent's BREMONT mark had become known sufficiently to negate the distinctiveness of the Mark, and that the reputation of the BREMONT mark in Canada was substantial, significant, or sufficient [see *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427].

[71] The Opponent submits that it has met its burden on the ground that the Opponent continued to promote and use its BREMONT Marks in Canada between at least as early as 2005 and December 5, 2017. The Opponent submits that the Applicant has not presented any evidence to establish distinctiveness and as such, the Opponent should succeed on this ground as well.

[72] The Applicant submits that it must be duly noted that the statement of opposition failed to provide any "listed goods" and any alleged goods referred to in the Breda affidavit are merely promotional items distributed in connection with, and during the sale of a new home, and as such is not "use" in accordance with section 4.

[73] Indeed, once again, the difference in material date is not significant and as a result, my findings under the grounds of opposition based on sections 16(1)(a) and 16(2)(a) of the Act are equally applicable here.

[74] Accordingly, the non-distinctiveness ground is also rejected.

DISPOSITION

[75] Having regard to the aforementioned, 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.

Kathryn Barnett
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

BREMONT – application No. 1,630,866

Goods

(1) Watches

(2) Precious metals and their alloys; jewellery, precious and semi-precious stones; parts and fittings for watches and clocks; agates; amulets, badges of precious metal and their alloys; boxes of precious metal; bracelets, brooches, buckles, busts, candlesticks, cases for watches and clocks, chains, charms, chronographs (watches), chronometers, cigar boxes, clips, clock cases, clock hands, clocks, clocks and watches, coffee service, coins, containers adapted for storing watches, crowns, cruet stands, cruets, cuff links, cups, dials for watches and clocks, earrings, egg cups, figurines, flasks, goblets, hat ornaments, ingots, jugs, key rings, kitchen utensils, matchboxes, medallions, medals, napkin holders, necklaces, purses, rings, salt cellars and shakers, saucers, tableware services, shoe ornaments, snuff boxes, bowls, statues, statuettes, straps for wrist watches, sun dials, tankards, tobacco jars, tokens, toothpick holders, trays for household purposes, tiaras, trinkets, urns, vases, watch bands, watch cases, watch chains, watch crystals, watch glasses, watch straps, watches, wire, wrist watches, all of precious metals and their alloys; diamonds; jewellery containing diamonds; gold and silverware; gold; gold thread; gold unwrought and beaten; ivory; unwrought and semi-wrought jet; jewellery of yellow amber; olivine gems; osmium; palladium; paste jewellery; pearls; pearls made of ambroid; rhodium; platinum; powder compacts of precious metals and their alloys; precious metals unwrought and semi-wrought; precious stones; erodium, ruthenium, silver ornaments; silver thread; silver unwrought or beaten; silver jewellery; spinel; spin silver; threads of precious metals and their alloys; copper tokens; trinkets; wires of precious metals and their alloys; works of art of precious metals and their alloys.

(3) Paper, cardboard; printed matter, namely periodical publications, magazines, leaflets, brochures, pamphlets, guides, prospectuses, and price lists all relating to watches and clocks; books; writing paper; greeting cards; calendars; teaching and instructional materials (other than apparatus), namely manuals and instructions for watches and clocks; diaries; pens and pencils, pencil sharpeners, pencil cases, erasers, rulers, crayons, bookmarkers.

(4) Articles of luggage; bags adapted for protecting and storing watches and clocks, trunks, rucksacks, knapsacks, satchels, haversacks, travel bags, backpacks, sports bags, valises, holdalls; belts and straps; wallets, purses, watch pouches and hand bags; bags for campers and climbers; key cases; beach bags; covers for books made of leather and imitation leather.

Services

(1) Online retail store services featuring watches, watch bands/straps, watch bracelets, letter openers, key rings, cufflinks, watch tools, business card holders, watch wallets, watch rolls, document folders, buckles, watch clasps.




Claims

Used in CANADA since as early as January 2010 in association with watches.

Used in Canada since as early as March 2012 in association with the services.

Use and registration in the UK in association with goods (2), (3), and (4).

SCHEDULE B

<u>Trademark</u>	<u>Registration or Application No.</u>	<u>Goods/Services</u>
BREMONT	TMA704,139	Real estate development services, and construction and sale of residential homes.
BREMONT	TMA962,781	Real estate development services, and construction and sale of residential homes.
 BREMONT	TMA962,831	Real estate development services, and construction and sale of residential homes.
 BREMONT HOMES	TMA962,794	Real estate development services, and construction and sale of residential homes.
 BREMONT HOMES Designed for Living	TMA962,782	Real estate development services, and construction and sale of residential homes.
BREMONT	TMA977,251, application No. 1,787,773	Real estate development services.
BREMONT	1,787,782	(1) Construction, development and sales of residential properties; and (2) Construction, development and sales of condominiums, commercial and industrial properties.

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

HEARING DATE 2020-11-26

APPEARANCES

Tapas Pain For the Opponent

Ashley Burk For the Applicant

AGENTS OF RECORD

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Burk Law PC For the Applicant