



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 100

Date of Decision: 2021-05-25

IN THE MATTER OF AN OPPOSITION

Standard International Management LLC

Opponent

and

Asia Standard Management Services Limited

Applicant

1,717,141 for ASIA STANDARD

Application

INTRODUCTION

[1] Standard International Management LLC (the Opponent) opposes registration of the trademark ASIA STANDARD (the Mark), which is the subject of application No. 1,717,141 by Asia Standard Management Services Limited (the Applicant).

[2] The Mark is applied for in association with the following goods and services:

GOODS

Address stamps; advertisement boards of paper or cardboard; architects' models; bags [envelopes, pouches] of paper or plastics, for packaging; booklets; books; calendars; cards, namely namecards, greeting cards, note cards, customer loyalty membership cards and hotel room key smart cards; catalogues; envelopes [stationery]; files [office requisites]; flyers; forms, printed; greeting cards; handbooks [manuals]; indexes; magazines [periodicals]; newsletters; newspapers; note books; pictures; postcards; printed matter, namely, brochures, catering guides, flyers, menus and books and brochures in the fields of travel and tourism; printed publications, namely publications in respect of hotel

services; seals [stamps]; stationery namely office paper, writing stationery, letterhead, folio pads, note pads, labels, seals, pens, pencils, and stickers.

SERVICES

Advertising services of third parties in the field of real estate, property development, travel, hotels, restaurants, conventions, conferences, health and fitness spas and resorts; advisory services for business management; business appraisals; business information and advice relating to business management and business operations; business management assistance; business management of hotels; business organization consultancy; business research; advice and information concerning commercial and industrial business management; economic forecasting; import-export agencies; marketing research; organization of trade fairs for commercial or advertising purposes; business management consultancy and business administration consulting services; public relations; rental of advertising space; rental of advertising time on communication media; secretarial services; accommodation bureau [apartments]; apartment house management; brokerage for renting of properties, real estate and commercial properties brokerage, freight transportation brokerage; business liquidation services, financial; capital investments; charitable fund raising; clearing-houses, financial; financial analysis; financial consultancy; financial evaluation [insurance, debt market, real estate]; financial management; financing services; fund investments; financial guarantee and surety services; instalment loans; insurance consultancy; lease-purchase financing; leasing of real estate; loans [financing]; mortgage lending; mutual funds; real estate agencies; real estate appraisal; real estate brokers; real estate management; rental of offices [real estate]; renting of apartments; renting of flats; securities brokerage; stocks and bonds brokerage; trusteeship; building construction supervision; building insulating; building sealing; construction of buildings, residential and commercial properties; construction consultation, namely consultation in building construction supervision; construction information, namely construction planning; demolition of buildings; factory construction; rental of construction equipment; wallpapering; warehouse construction and repair; arranging of cruises; arranging of tours; boat rental; booking of seats for travel; bus transport; car parking; car transport; ferry-boat transport; freight brokerage [forwarding (am.)]; freight forwarding; freight transportation by rail, truck, boat, and air [shipping of goods]; pleasure boat transport; railway transportation of goods; rental of warehouses; sightseeing [tourism]; storage of goods, namely warehouse storage services; transport reservation, namely vehicle rental; travel reservation; amusement parks; amusement arcades; arranging and conducting of concerts; booking of seats for shows; bookmobile services; club services, namely, clubhouse services and comedy clubs [entertainment or education]; entertainer services, namely live performances by musical bands, singers, theatre groups, magicians, comedians, and performance artists; entertainment in the form of dance performances, singing contests, live music concerts, fashion shows, firework displays, beauty pageants; health club services [health and fitness training]; night clubs; organization of sports competitions, namely golf, tennis and badminton tournaments, football and basketball matches, swimming, fishing, sailing, and horseback riding competitions; party planning [entertainment]; presentation of live musical and dramatic performances; production of live musical and dramatic shows; providing amusement arcade services; providing casino facilities [gambling]; providing golf facilities;

providing fitness and recreational facilities, namely golf, tennis, badminton, football, basketball, exercise, boating, sailing, fishing, horseback riding, swimming, and aquatic activities; rental of sports grounds; accommodation bureau [hotels, boarding houses]; bar services; cafes; cafeterias; canteens; food and drink catering; hotel reservations; hotels; motels; rental of meeting rooms; providing temporary accommodations, namely short or long-term rental of hotel rooms, suites and service apartments; restaurants; self-service restaurants; snack-bars; tourist homes.

[3] The application for the Mark was filed on February 27, 2015 on the basis of use in Canada since at least as early as 1997.

[4] The application was advertised for opposition purposes on March 16, 2016. Numerous amendments to the *Trademarks Act*, RSC 1985, c T-13 (the Act) came into force on June 17, 2019. Pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read immediately before June 17, 2019, an exception being that, with respect to confusion, sections 6(2) to (4) of the Act as it currently reads will be applied.

[5] On August 16, 2016, the Opponent opposed the application by filing a statement of opposition under section 38 of the Act. The grounds of opposition are based on sections 30(b), 12(1)(d), and 2 of the Act.

[6] In support of its opposition, the Opponent filed the following evidence:

- Affidavit of Lisa Bonifacio, sworn February 10, 2017 in New York [the Bonifacio Affidavit];
- Affidavit of Ahmed Eldessouki, sworn February 13, 2017 in Toronto [the First Eldessouki Affidavit];
- As leave evidence, a second affidavit of Ahmed Eldessouki, sworn April 4, 2017 [the Second Eldessouki Affidavit]; and
- As reply evidence, the affidavit of Karl Qin, sworn October 16, 2017 in Toronto [the Qin Affidavit].

[7] In support of its application, the Applicant filed the following evidence:

- Affidavit of Peter Chun Kit Lui, sworn September 12, 2017 in Vancouver (the Lui Affidavit); and
- Affidavit of Christoph Heinemann, sworn September 13, 2017 in Hamilton, Ontario (the Heinemann Affidavit).

[8] None of the affiants were cross-examined. Both parties submitted written representations and were represented at an oral hearing.

[9] Before assessing the grounds of opposition, I will first provide an overview of the parties' evidence, the evidential burden on the Opponent, and the legal onus on the Applicant.

OVERVIEW OF THE OPPONENT'S EVIDENCE

[10] The Opponent owns and operates several hotels in the United States. It is the owner of registration No. TMA529599 for the trademark THE STANDARD [the Opponent's Trademark], registered in 1982 on the basis of use in Canada since at least as early as October 31, 1980. Originally registered in association with a variety of clothing goods as well as "hotel" and various hotel-related services, the Opponent's Trademark is currently registered in association with "T-shirts" only.

Bonifacio Affidavit

[11] Ms. Bonifacio is the Associate General Counsel of the Opponent. The Bonifacio Affidavit evidences the following:

- The history of the Opponent and of its THE STANDARD hotel brand [paras 3 to 9].
- The registration and use of the Opponent's THE STANDARD trademarks, including the Opponent's Trademark [paras 10 and 11].
- Media and online references to THE STANDARD brand [paras 12 to 14 and 17].
- Information related to bookings by Canadian customers between 2014 and 2016 at THE STANDARD hotels in the United States [paras 15 and 16].

- Hotel industry naming conventions, including examples of third-party hotel chains that combine a house brand with an element describing a hotel’s geographical location (or sub-brand focusing on a specific type of clientele) [paras 19 to 25].

First Eldessouki Affidavit

[12] Mr. Eldessouki is an articling student employed by the Opponent’s agent. The First Eldessouki affidavit consists of 80 exhibits in the form of printouts from various websites, accessed in February 2017. The printouts are left to speak for themselves, but appear to relate to the Opponent’s THE STANDARD-brand hotels in the U.S. The exhibits range from third-party travel websites (such as the *tripadvisor.ca* review page for The Standard hotel in New York City [Exhibit 2]), to passing references in media articles (such as a May 2014 *huffingtonpost.ca* news article regarding an assault that occurred at The Standard hotel in New York City), to pages from the Opponent’s own websites, advertising the amenities at some its U.S. hotel locations [Exhibits 73 to 77 and 80].

Second Eldessouki Affidavit

[13] The Second Eldessouki Affidavit consists of the following:

- Search results for “ASIA STANDARD” from March 2017 using the search engines Google, Yahoo and Bing [Exhibits 1 to 3].
- Search results for “ASIA STANDARD” from third-party travel websites such as *hotels.com* [Exhibits 4 to 10]. Mr. Eldessouki states that his searches did not reveal any hotel operating under the name “Asia Standard” [paras 5 to 11].
- Printouts of the website *empirelandmarkhotel.com* from the Wayback Machine at *archive.org*, showing how the website’s homepage appeared at various dates between 2004 and 2016 [Exhibit 11]. Mr. Eldessouki asserts that the first iteration to display the trademark ASIA STANDARD was from September 2015 [para 12].

Qin Affidavit

[14] The Qin Affidavit, filed as reply evidence, consists of the following:

- Printouts from *whois.domaintools.com* showing WHOIS information for the Applicant's websites *asiastandard.com*, *asiastandardhotelgroup.com*, *empirehotelsandresorts.com*, and *empirelandmarkhotel.com* [Exhibits 2 to 5].
- Printouts of the aforementioned four websites from the Wayback Machine at *archive.org*, showing various search results [Exhibits 6 to 14], including how the website *asiastandard.com* appeared on December 12, 1998, which Mr. Qin identifies as the earliest available date [para 12, Exhibit 18].
- News articles discussing the closure of Vancouver's Empire Landmark Hotel in 2017 [paras 23 to 26, Exhibits 16 to 19].

OVERVIEW OF THE APPLICANT'S EVIDENCE

Lui Affidavit

[15] Mr. Lui is the Financial Controller of Global Gateway Corp., a licensee and related company of the Applicant. He provides that Asia Standard International Group Limited (ASI) is the parent company of the Applicant and develops, manages and invests in commercial, residential, retail and hotel properties, primarily in Hong Kong and China [para 2]. He explains that Global Gateway Corp. operates five hotels worldwide, including Vancouver's Empire Landmark Hotel [para 3]. He confirms that any use of the Mark by ASI or its related companies was under license from the Applicant or its predecessor-in-title [para 4]. The Lui Affidavit evidences the following:

- The history of the Empire Landmark Hotel and the associated use of the Mark and the ASIA STANDARD trade name, including purported examples of such use [paras 9 to 13, Exhibits E to L].
- The amenities and features of the Empire Landmark Hotel [paras 14 to 26].

- Printouts from the website *asiastandard.com* dated August 2017 as well as from 1998 (as taken from the Wayback Machine at *archive.org*) [Exhibits A and B].
- Printouts dated August 2017 from the websites *asiastandardhotelgroup.com*, *empirehotelsandresorts.com*, and *empirelandmarkhotel.com* [Exhibits C to E].
- The anticipated closing of the Empire Landmark Hotel in September 2017. Mr. Liu states that ASI and its affiliated companies intend to replace the hotel with a new development, proposed to include condominiums, social housing, as well as retail and office space, “which will continue to be associated with the ASIA STANDARD brand and trademark” [para 27].

Heinemann Affidavit

[16] Mr. Heinemann is a law clerk employed by the Applicant’s agent. The Heinemann Affidavit consists of the following:

- Printouts from July 2017 of the Applicant’s Empire Landmark website (*empirelandmarkhotel.com*), Asia Standard Hotel website (*asiastandardhotelgroup.com*), and Asia Standard International website (*asiastandard.com*) [paras 3 and 5, Exhibits A to C].
- Definitions of the word “standard” from *merriam-webster.com* [para 7, Exhibit D].

EVIDENTIAL BURDEN AND LEGAL ONUS

[17] In accordance with the usual rules of evidence, there is an evidential burden on an opponent to prove the facts inherent in the allegations pleaded in its statement of opposition [*John Labatt Ltd v Molson Companies Ltd*, 1990 CarswellNat 1053, 30 CPR (3d) 293 (FCTD)]. The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

[18] For those allegations for which the opponent has met its evidential burden, the legal onus is on the applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. The presence of a legal onus on an applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, then the issue must be decided against the applicant.

SECTION 30(B) GROUND OF OPPOSITION – DATE OF FIRST USE

[19] In its statement of opposition, the Opponent pleads that neither the Applicant nor any claimed predecessor-in-title has used the Mark in connection with each of the stated goods and services, in Canada, since at least as early as the claimed date of first use, namely 1997.

[20] With respect to a ground of opposition based on section 30(b) of the Act, to the extent that the relevant facts are more readily available to the applicant, the evidential burden on an opponent is not onerous [*Tune Master v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]; however, its burden is not eliminated altogether [*John Labatt, supra; Dion Neckwear Ltd v Christian Dior SA et al*, 2002 FCA 29]. While an opponent can meet its initial burden by reference to its own evidence, its burden can in some cases be met with reference to the applicant's evidence [*Molson Canada v Anheuser-Busch Inc*, 2003 FC 1287, 29 CPR (4th) 315; *Corporativo de Marcas GJB, SA De CV v Bacardi & Company Ltd*, 2014 FC 323 (*Marcas*)], and an opponent can rely upon cross-examination of an applicant's affiant to meet the evidential burden upon it [see *Coca-Cola Ltd v Compagnie Francaise de Commerce International Cofci, SA* (1991), 35 CPR (3d) 406 (TMOB)]. However, an opponent may only successfully rely upon the applicant's evidence to meet its initial burden if the opponent shows that the applicant's evidence puts into issue the claim set forth in the application [*Marcas, supra* at paras 30 to 38].

[21] If an opponent succeeds in discharging its initial evidential burden, the applicant must then, in response, substantiate its claim of use. However, as noted above, while an opponent is entitled to rely on the applicant's evidence, 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].

[22] In this case, the Opponent's evidence is found in the Eldessouki Affidavits and the Qin Affidavit, as the Bonifacio Affidavit does not address this ground. I also note that the Opponent's evidence is largely concerned with the applied-for "hotels" services and any hotel-related goods and services, albeit the scope of such was not clearly articulated.

[23] In any event, I agree with the Applicant that the Opponent's evidence with respect to this ground is merely speculative, as it appears to be premised on an assumption that any use of the Mark had to be in association with the name of a hotel and/or that such use had to be reflected online (and particular websites at that). For example, the printouts from the Empire Landmark Hotel website [First Eldessouki Affidavit, para 12 and Exhibit 11] appear to be limited to the homepages of that website. The fact that the Applicant did not operate a hotel by the name of ASIA STANDARD is not in question. As such, the significance of Mr. Eldessouki's observation that his searches on third-party travel websites "did not reveal any hotel operating under the trademark or trade name, or doing business as 'ASIA STANDARD'" [*e.g.*, First Eldessouki Affidavit at para 10] as it relates to this ground is at best unclear, especially given that i) he is an employee of the Opponent's agent; ii) he conducted his searches in 2017; and iii) he does not appear to have any specialized knowledge of the hotel trade or the scope of information typically provided on such third-party websites.

[24] Similarly, one is left to speculate as to the significance of the search results in the Qin Affidavit. The Opponent's evidence – while voluminous – appears to be limited to online searches, narrow in scope, and there was no information that searches were conducted to assess whether the applied-for services were offered otherwise (*e.g.* through a different website or offline). None of the Opponent's affidavits includes so much as an assertion that the Mark was not in use in association with the applied-for services – granted, as employees of the Applicant's agent, it is understandable that those two affiants would likely not have been in a position to make such an assertion. However, it speaks to the probative value of the evidence furnished and the limited inferences I am prepared to make from such evidence.

[25] As for the Applicant's evidence, I find that nothing in it puts into issue the claimed date of first use "since as early as 1997" set forth in the application. While the Opponent took issue with the Opponent's website evidence dating only from 1998 at the earliest [Lui Affidavit at para

5 and Exhibit B], the Applicant was not obligated to evidence examples of use from 1997 in the circumstances. Indeed, Mr. Liu asserts continuous use since 1997 of the Mark and the ASIA STANDARD trade name in association with the Empire Landmark Hotel [Liu Affidavit at para 13]. It was open to the Opponent to cross-examine Mr. Liu on his affidavit if it wished to explore the details of the Applicant's use further, but it chose not to do so [see *Canada Safeway Limited v Delca Enterprises Ltd*, 2011 TMOB 51 at para 9; and *The Black & Decker Corporation v Piranha Abrasives Inc*, 2020 TMOB 57 at para 45].

[26] Accordingly, as the Opponent has not met its burden, the ground of opposition based on section 30(b) of the Act is rejected.

SECTION 12(1)(D) GROUND OF OPPOSITION – CONFUSING WITH A REGISTERED TRADEMARK

[27] The Opponent pleads that, contrary to sections 12(1)(d) and 38(2)(b) of the Act, the Mark is not registrable because it is confusing with the Opponent's registration No. TMA529599 for the trademark THE STANDARD (the Opponent's Trademark).

[28] The material date with respect to confusion with a registered trademark is the date of this decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd et al*, 1991 CarswellNat 1119, 37 CPR (3d) 413 (FCA)].

[29] I have exercised my discretion and have checked the Register to confirm that the Opponent's registration is extant [per *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. However, as noted above, following a March 2020 decision of the Registrar in a section 45 expungement proceeding [*Gowling WLG (Canada) LLP v Standard International Management, LLC*, 2020 TMOB 24], the registration is now limited to "T-shirts".

[30] While the Opponent has technically met its initial burden under this ground, I do not consider it necessary to provide an exhaustive analysis regarding the test to determine confusion. Indeed, at the hearing, the Opponent largely limited its submissions to the other grounds at issue. Suffice to say, in view of the factors set out in section 6(5) of the Act and the guidance of the Supreme Court of Canada [see *Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée*, 2006 SCC 23; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22; and *Masterpiece Inc v Alavida Lifestyles*

Inc, 2011 SCC 27], I find that, on a balance of probabilities, the Applicant has met its legal burden with respect to all of the applied-for goods and services.

[31] Noting that the parties' trademarks are not highly distinctive and that the application does not include any clothing goods, I reach this conclusion primarily due to the absence of overlap in the nature of the applied-for goods and services as compared to the Opponent's "T-shirts".

[32] In view of the foregoing, the section 12(1)(d) ground of opposition is rejected.

SECTION 2 GROUND OF OPPOSITION – NON-DISTINCTIVENESS

[33] The Opponent pleads that, contrary to sections 2 and 38(2) of the Act, the Mark is not distinctive of the Applicant, nor is it adapted to distinguish the goods and services of the Applicant from those of the Opponent as the Opponent has extensively used, and has developed a significant reputation and goodwill, in connection with its trademark THE STANDARD, in association with hotel, hotel reservation and hotel booking services.

[34] The material date for this ground of opposition is the filing date of the opposition, August 16, 2018 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

[35] Section 2 of the Act, as it then was, defined "distinctive" as follows:

distinctive, in relation to a trademark, means a trademark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or is adapted so to distinguish them.

[36] A trademark "actually distinguishes" by acquiring distinctiveness through use, resulting in distinctiveness in fact. On the other hand, a trademark that is "adapted so to distinguish" is one that does not depend upon use for its distinctiveness because it is inherently distinctive [see *Astrazeneca AB v Novopharm Ltd*, 2003 FCA 57 at para 16].

[37] As noted above, there is an evidential burden on the Opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Ltd, supra*]. The initial burden is on the Opponent to prove that, as of the material date, its trademark was known to some extent in Canada and has a reputation in Canada that is "substantial, significant or

sufficient” so as to negate the distinctiveness of the Mark [see *Bojangles’ International, LLC v Bojangles Café Ltd*, 2006 FC 657 at paras 33 and 34 (*Bojangles*); and *Ontario Dental Assistants Association v Canadian Dental Association*, 2013 FC 266 at para 42, aff’d 2013 FCA 279].

[38] At the hearing, the Opponent submitted that its evidence of reputation of the Opponent’s Trademark in Canada was sufficient to meet its initial burden and that whether the Applicant meets its legal onus essentially turns on a “popularity contest” regarding the reputation of the parties’ respective trademarks in association with the relevant services.

[39] However, I agree with the Applicant that such an approach is inconsistent with the jurisprudence as well as the overall regime of the Act. In my view, the Opponent’s approach oversimplifies the non-distinctiveness ground – and the ground as pleaded, in particular – to a question of magnitude of reputation rather than a question of negation of distinctiveness. Furthermore, it leaves rather vague what level of evidence of reputation is necessary to constitute “substantial, significant or sufficient”.

[40] In this respect, I first acknowledge that the jurisprudence has established that neither use within the meaning of section 4 of the Act nor “made known” within the meaning of section 5 of the Act are strictly necessary to satisfy the Opponent’s evidential burden [see, for example, *Bojangles* at para 29; and *Motel 6 Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FC) at paras 44 and 45]. The Federal Court of Appeal has also stated that “infringing prior use may cause a mark to lose its distinctiveness, although the extent or degree to which distinctiveness is eroded by infringing use remains a question of fact to be considered in each case [*Sadhu Singh Hamdard Trust v Navsun Holdings Ltd*, 2019 FCA 19 at para 15 (*Navsun*)].

[41] However, it is this “question of fact” that is key; indeed, in *Navsun*, the Federal Court of Appeal also stated that the question of distinctiveness is primarily one of fact [at para 14]. Accordingly, I do not consider the Opponent’s burden satisfied merely by showing some evidence that its trademark was known to some extent in Canada, nor do I consider a ground based on non-distinctiveness to turn simply on a question of which parties’ trademark was better known.

[42] In this case, I accept that the Opponent's evidence establishes that the Opponent's Trademark was known to some extent in Canada in association with the pleaded hotel and hotel booking and reservation services as of the material date [*e.g.*, Bonifacio Affidavit at paras 15 and 16 with respect to bookings at the Opponent's U.S. hotels by Canadian customers]. However, I agree with the Applicant that the Opponent has not put into evidence anything to establish the non-distinctiveness of the Mark such that the reputation of the Opponent's Trademark was substantial, significant or sufficient so as to *negate* the distinctiveness of the Mark as of that date.

[43] In my view, the extent to which any use, made known, or reputation otherwise of the Opponent's Trademark in Canada has eroded or negated the distinctiveness of the Applicant's Mark in fact as of the material date or otherwise has simply not been established by the Opponent. For example, in her affidavit, Ms. Bonifacio asserts that, upon encountering the applied-for Mark, a customer "will be misled into thinking that the ASIA STANDARD hotel is part of [the Opponent's] collection of hotels, or a hotel operated by [the Opponent] that has an Asian twist or is marketed to Asian customers" [Bonifacio Affidavit at para 25]. However, Ms. Bonifacio's assertion is simply speculative and not supported by the evidence before me. In this respect, Ms. Bonifacio provides examples of third-party hotel chains (*e.g.*, Hilton and Marriott) that have naming conventions combining house brands with descriptive geographical location elements. However, it would appear that the Opponent essentially expects the benefit of a THE STANDARD family of trademarks despite not evidencing such and despite likely not existing.

[44] Accepting that the Opponent has met its initial burden in this case is problematic given the dictionary definition of "standard" and the consequent low inherent distinctiveness of the parties' trademarks. Indeed, the Opponent treads a fine line arguing that the Mark is not distinctive, when the Mark arguably has nominally but nonetheless more inherent distinctiveness than the Opponent's Mark due to the additional term ASIA.

[45] It is also problematic in cases such as this, where the applied-for Mark is not merely a proposed mark but rather one for which there is some evidence of prior use in Canada. In this respect, while not overwhelming, I accept that the Applicant has evidenced at least some use of the Mark in association with hotel services in Canada prior to the material date, such as on letterhead and hotel key card covers related to the operation of the Empire Landmark Hotel [Liu

Affidavit, paras 9 to 13, Exhibits F and H]. Although the Opponent submitted that any display of “Asia Standard” in the Liu Affidavit was, at best, that of a trade name, as stated in *Consumers Distributing Co/Cie Distribution aux Consommateurs v Toy World Ltd*, 1990 CarswellNat 1398 (TMOB), “trade-mark and trade-name usage are not necessarily mutually exclusive” [at paragraph 14]. While not apparently a so-called “primary” trademark, I accept that the evidenced display at least to some extent constitutes use as a secondary trademark, and is therefore nonetheless use of the Mark.

[46] Even if I were to accept that the Opponent had met its initial evidential burden to some extent under this ground, I first note it would be limited to such hotel and hotel-related services. Indeed, at the hearing, the Opponent acknowledged that, in any event, it likely did not meet its initial burden with respect to any of the applied-for goods or services not clearly related to hotels, such as the applied-for “entertainment in the form of ... beauty pageants”, as an example.

[47] Otherwise, while the evidence of actual use of the Applicant’s Mark in Canada is limited, I would find that it is sufficient to meet the Applicant’s legal onus to establish that the Mark is distinctive with respect to the Applicant’s applied-for goods and services that would be at issue, within the meaning of section 2 of the Act.

[48] While I do not consider it appropriate to speculate as to what evidence would be sufficient to meet the Opponent’s burden under this ground as pleaded in this case, I note the Applicant’s observation at the hearing that the parties’ trademarks have co-existed for years without any apparent instances of actual confusion. It would be one thing to potentially find that the parties’ trademarks are confusing within the meaning of section 6(5) of the Act, but it is another to find that the distinctiveness of the Applicant’s Mark – within the meaning of section 2 of the Act – has been negated, in particular given such co-existence and the evidenced manner in which the Applicant has used the Mark prior to the material date in association with its hotel services.

[49] In my view, this approach is more consistent with *Navsun* and the comments of the Federal Court of Appeal in *Suzanne’s Inc v Auld Phillips Ltd*, 2005 FCA 429 where, in the context of an expungement proceeding under section 57 of the Act, it stated that “Obviously, it will be a rare occurrence when one party is in a position to cause a mark to lose its

distinctiveness, but nothing in principle prevents this result” [at para 7]. In my view, the Opponent’s evidence in this case falls short of that principle.

[50] Accordingly, as the Opponent has not met its initial burden, the ground of opposition based on non-distinctiveness is rejected.

DISPOSITION

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

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: 2021-02-16

APPEARANCES

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