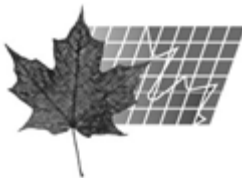


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LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 129

Date of Decision: 2021-06-26

IN THE MATTER OF OPPOSITION

BuildDirect.com Technologies Inc.

Opponent

and

Sean Wark

Applicant

1,811,354 for BLACK BEAR TRADES

Application

OVERVIEW

[1] Sean Wark (the Applicant) has applied to register the trademark BLACK BEAR TRADES (the Mark) with a variety of trade services and franchising of trade services (the Services). The application is based on the Applicant's proposed use of the Mark in Canada with services (1), (4), (5) and (6) and use of the Mark in Canada with services (2) and (3) since at least as early as November 10, 2016 and November 23, 2016, respectively.

Class	Services
35	(1) Franchising of trades services, namely, carpentry services, electrical contracting services, plumbing services, drywall installation services, building insulation installation services, roofing services, residential property and commercial property

painting services, cabinet installation services, glass installation services, and flooring services; offering technical assistance in the establishment and operation of franchises of trades services, namely, carpentry services, electrical contracting services, plumbing services, drywall installation services, building insulation installation services, roofing services, residential property and commercial property painting services, cabinet installation services, glass installation services, and flooring services; advice in the running of establishments as franchises.

- 37 (2) Carpentry services.
- (3) Electrical contracting services; plumbing services; drywall installation services.
- (4) Building insulation installation services; roofing services; house painting; paint stripping services; residential property painting; commercial property painting; cabinet installation services; glass installation services; flooring installation services; floor buffing and polishing services; floor sanding services; refinishing of floors.
- 40 (5) Cabinet making services.
- 44 (6) Landscape design; landscape gardening; landscape gardening design for others.

[2] BuildDirect.com Technologies Inc. (the Opponent) alleges that the Mark is confusing with its use and registration of the trademark BLACK BEAR set out below:

TMA926,348	BLACK BEAR	Manufactured stone veneer, stone veneer panels, stone veneer accessories, namely, accent stone, cap stone, electrical box, header stone, hearth stone, key stone, light box, outlet box, pyramid caps, pyramid wall coping, quoin corners, trim stone, water box and window sills (Opponent's Goods).
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[3] For the following reasons, I find that the Applicant has failed to prove that there is no reasonable likelihood of confusion between the Mark and the Opponent's registration. Accordingly, the section 12(1)(d) ground of opposition based on the Opponent's registration succeeds.

FILE HISTORY

[4] The application was filed on November 25, 2016. The application was advertised for opposition purposes in the *Trademarks Journal* dated January 31, 2018.

[5] The Opponent opposed the application on the basis of the grounds of opposition summarized below on April 3, 2018 pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (Act). This Act was amended on June 17, 2019. All references are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act before it was amended (section 70 of the Act).

- (a) The Applicant could not have been satisfied that he was entitled to use the Mark.
- (b) The Mark is not registrable pursuant to section 12(1)(d) of the Act as it is confusing with registration No. TMA926,348 for BLACK BEAR.
- (c) The Applicant is not the person entitled to register the Mark in view of sections 16(1)(a) and 16(3)(a) of the Act since the Mark is confusing with the Opponent's trademark BLACK BEAR.
- (d) The Mark is not distinctive of the Applicant, within the meaning of section 2 of the Act.

[6] The Applicant filed and served a counter statement.

[7] The Opponent did not file any evidence. The Applicant filed as its evidence the affidavit of Jane Buckingham, a senior trademark searcher employed by its agent. Neither party filed a written argument. A hearing was not held.

EVIDENTIAL BURDEN AND LEGAL ONUS

[8] While there is an initial evidential burden on an opponent, the legal burden or onus remains on an applicant, on a balance of probabilities [*John Labatt Ltd v Molson Cos* (1993), 30 CPR (3d) 293 (FCTD)].

MATERIAL DATES

[9] The material dates that apply to the grounds of opposition are:

- sections 38(2)(a)/30 - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- sections 38(2)(b)/12(1)(d) - 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)];
- sections 38(2)(c)/16(1) – the dates of first use in the application;
- sections 38(2)(c)/16(3) – the filing date of the application;
- sections 38(2)(d)/2 - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

GROUND OF OPPOSITION

Section 12(1)(d) Ground of Opposition

[10] The Opponent has pleaded that the Mark is not registrable because it is confusing with registration No. TMA926,348 for BLACK BEAR. I have exercised my discretion and have checked the Register to confirm that this registration is extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. As the Opponent has met its evidential burden, I now have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with this registration.

Test to Determine Confusion

[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 inherent distinctiveness of the trademarks and the extent to which

they have become known; the length of time the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them. 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, 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

Inherent Distinctiveness

[12] A trademark is inherently distinctive if it is not suggestive of a characteristic of the associated goods and services. In this case, the BLACK BEAR trademark of the Opponent and the BLACK BEAR component of the Mark are inherently distinctive as they do not suggest any characteristics of the parties' associated goods and services. The Mark as a whole has less inherent distinctiveness because the component TRADES is descriptive of the Services.

Extent Known and Length of Time in Use

[13] There is no evidence that either the Opponent or Applicant have used their respective trademarks.

Nature of Goods, Services and Trade

[14] In the absence of evidence from either party, I find that the Services in **bold** below (the Overlapping Services) directly overlap with the Opponent's Goods as these services may involve the installation of one or more of the Opponent's Goods.

Class	Services
35	(1) Franchising of trades services, namely , carpentry services, electrical contracting services , plumbing services, drywall installation services, building insulation installation services, roofing services , residential property and

commercial property painting services, cabinet installation services, **glass installation services, and flooring services**; offering technical assistance in the establishment and operation of franchises of trades services, namely, carpentry services, **electrical contracting services**, plumbing services, drywall installation services, building insulation installation services, **roofing services**, residential property and commercial property painting services, cabinet installation services, **glass installation services, and flooring services**; advice in the running of establishments as franchises.

- 37 (2) Carpentry services.
- (3) **Electrical contracting services**; plumbing services; drywall installation services.
- (4) Building insulation installation services; **roofing services**; house painting; paint stripping services; residential property painting; commercial property painting; cabinet installation services; **glass installation services; flooring installation services; floor buffing and polishing services; floor sanding services; refinishing of floors.**
- 40 (5) Cabinet making services.
- 44 (6) **Landscape design; landscape gardening; landscape gardening design for others.**

[15] I find that the nature of the remaining Services somewhat overlaps with the Opponent's Goods as they are all (i) construction and renovation related and (ii) a consumer doing a renovation or construction project may purchase both the Opponent's Goods and the Services at the same time for the same project. For example, a person finishing a basement may purchase stone veneer panels, drywall installation services, and painting and flooring services.

Degree of Resemblance

[16] There is a high degree of resemblance between the trademarks in appearance, sound and idea suggested. The Applicant has incorporated the Opponent's trademark in its entirety. The addition of TRADES does not effectively diminish the resemblance as it is descriptive of the type of services provided [*Reno-Dépôt Inc v Homer TLC Inc*, 2010 TMOB 11 at para 58].

Surrounding Circumstance – State of the Register

[17] State of the register and marketplace evidence favours an applicant when the presence of a common element in trademarks causes purchasers to pay more attention to the other features of the trademarks, and to distinguish between them by those other features [*McDowell v Laverana GmbH & Co KG*, 2017 FC 327 at para 42]. In this case, the evidence filed by the Applicant does not show that the elements BLACK BEAR or BEAR are common to the trade such that purchasers pay more attention to the other features of the Mark. With respect to BLACK BEAR trademarks there are only two third party registrations including this component. With respect to the remaining BEAR trademarks identified, they include additional material such that they appear and sound different and evoke ideas different from the parties' BLACK BEAR trademarks, for example POLAR BEAR (TMA816,573), BearPaw (TMA760,321), and BEARFOOT (TMA488,775). Further, there is no evidence that any of the trademarks are in use in the marketplace by third parties.

Conclusion

[18] Having considered all of the surrounding circumstances, I find that the Applicant has not met the legal onus to prove, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's registered trademark.

[19] I reach this conclusion due to the high degree resemblance between the trademarks, the inherent distinctiveness of the trademarks and the overlap between the Services and the Opponent's Goods. While I acknowledge that only the Overlapping Services directly overlap with the Opponent's Services, given the breadth of the remaining Services and the fact that these Services may potentially be purchased at the same time as the Opponent's Goods for use in the same renovation or construction projects, I find that an average consumer seeing the Mark in association with these Services and having only a vague recollection of the Opponent's trademark, may infer that the Services were performed, sold or otherwise emanate from or were licensed, approved or sponsored by the owner of the BLACK BEAR registration. As such, the Applicant has failed to prove on a balance of probabilities that there is no reasonable likelihood of confusion. Accordingly, this ground of opposition is successful.

Section 30(i) Ground of Opposition

[20] The Opponent alleges that the application does not conform to the requirements of section 30(i) as the Applicant could not have been satisfied that he was entitled to use the Mark in Canada in view of the Opponent's prior use and making known of its BLACK BEAR trademark. Where an applicant has provided the statement required by section 30(i) of the Act, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of an applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. There is no evidence of bad faith or exceptional circumstances. This ground of opposition is therefore rejected.

Sections 16(1)(a) and 16(3)(a) Grounds of Opposition

[21] The Opponent alleges in its statement of opposition that the Applicant is not the person entitled to register the Mark because it is confusing with the Opponent's use of its trademark BLACK BEAR in association with the Opponent's Goods. In order to meet its initial burden in support of the non-entitlement grounds of opposition based upon sections 16(1)(a) and 16(3)(a) of the Act, the Opponent is required to show that its trademark BLACK BEAR had been previously used in Canada prior to the dates of first use in the application for services (2) and (3) and the application's filing date for the remainder of the applied-for services. As the Opponent has filed no evidence, it fails to meet its evidential burden and these grounds of opposition are rejected.

Section 2 Ground of Opposition

[22] The Opponent alleges in its statement of opposition that the Mark is not distinctive of the Applicant because it does not distinguish and is not adapted to distinguish the Services from the Opponent's trademark BLACK BEAR. In order to meet its initial burden in support of the non-distinctiveness ground of opposition, the Opponent was required to show that as of the date of filing its statement of opposition, April 3, 2018, that its trademark BLACK BEAR was known to some extent at least and the reputation of this trademark in Canada was substantial, significant or sufficient [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles'*

International LLC v Bojangles Café Ltd 2006 FC 657]. It has not done so. This ground of opposition is therefore rejected.

DISPOSITION

[23] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application, pursuant to section 38(12) of the Act.

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

No hearing held.

Agents of Record

Gowling WLG (Canada) LLP

For the Applicant

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

For the Opponent