



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 256

Date of Decision: 2021-11-25

IN THE MATTER OF AN OPPOSITION

**Women Building Futures Society
and**

Opponent

Balraj Singh Mann

Applicant

1,806,552 for BUILDING THE FUTURE

Application

INTRODUCTION

[1] Women Building Futures Society (the Opponent) opposes registration of the trademark BUILDING THE FUTURE (the Mark), which is the subject of application No. 1,806,552 by Balraj Singh Mann (the Applicant).

[2] The Mark is applied for on the basis of use in Canada since at least as early as 2011 in association with the services, “Construction and repair of buildings”.

[3] The opposition is primarily based on an allegation that the Mark is confusing with the Opponent’s WOMEN BUILDING FUTURES trademark, previously registered and used in Canada in association with various goods and services including educational and training services related, *inter alia*, to the construction industry.

THE RECORD

[4] The application for the Mark was filed on October 26, 2016. The application includes the following disclaimer: “The right to the exclusive use of the word BUILDING is disclaimed apart from the trademark.”

[5] The application was advertised for opposition purposes on March 7, 2018. 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.

[6] On August 8, 2018, the Opponent opposed the application by filing a statement of opposition under section 38 of the Act. The grounds of opposition are based on non-registrability under section 12(1)(d) of the Act, non-entitlement under section 16(1) of the Act, non-distinctiveness under section 2 of the Act, and non-compliance with section 30(i) of the Act.

[7] The Applicant filed a counter statement denying the grounds of opposition.

[8] In support of its opposition, the Opponent filed the affidavit of Heather Markham, sworn January 18, 2019 in Edmonton (the Markham Affidavit).

[9] In support of its application, the Applicant filed the following two affidavits:

- Affidavit of Balraj Singh Mann, sworn August 20, 2019 in Coquitlam, British Columbia (the Mann Affidavit); and
- Affidavit of Deanna Shannon, sworn August 20, 2019 in Vancouver (the Shannon Affidavit).

[10] None of the affiants were cross-examined. Both parties submitted written representations; an oral hearing was not requested.

[11] 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

[12] The Opponent is the owner of registration No. TMA953,777 for the trademark "Women Building Futures" (the Opponent's Trademark), registered since October 31, 2016 in association with the following goods and services:

Goods

- (1) Educational printed material, namely, periodicals, course packs, manuals, brochures and pamphlets.
- (2) Promotional materials, namely, stickers, fridge magnets, lapel pins, coffee mugs, self-stick notes, swag, and clothing, namely, t-shirts, hats, vests, hard hats.
- (3) Pre-recorded videotapes.
- (4) Pre-recorded discs, namely CD's, DVD's, and CD-ROM's containing movies.
- (5) Educational software for women in the field of skilled trades, pre-trades, namely pre-employment trades training to enable somebody to be employed in the skilled trades, and unskilled labour.
- (6) Educational software for employers in the field of skilled trades, pre-trades, namely pre-employment trades training to enable somebody to be employed in the skilled trades, and unskilled labour.

Services

- (1) Assessment and evaluation of candidates for educational programs.
- (2) Developing educational manuals.
- (3) Driver education training in the field of heavy equipment operation.
- (4) Educational demonstrations in the field of skilled trades, pre-trades, namely pre-employment trades training to enable somebody to be employed in the skilled trades, and unskilled labour.
- (5) Educational research services.
- (6) Educational services in the field of skilled trades, pre-trades, namely pre-employment trades training to enable somebody to be employed in the skilled trades, and unskilled labour.
- (7) Educational services in the form of providing incentives to organizations to demonstrate excellence in the field of skilled trades, pre-trades, namely pre-employment trades training to enable somebody to be employed in the skilled trades, and unskilled labour.
- (8) Performance measurement evaluations in the field of skilled trades, pre-trades, namely pre-employment trades training to enable somebody to be employed in the skilled trades, and unskilled labour.
- (9) Physical education services.

(10) Streaming of audio and video via the Internet featuring movies in the field of skilled trades, pre-trades, namely pre-employment trades training to enable somebody to be employed in the skilled trades, and unskilled labour.

(11) Standardized educational testing.

(12) Vocational education in the field of skilled trades, pre-trades, namely pre-employment trades training to enable somebody to be employed in the skilled trades, and unskilled labour.

(13) Workshops and seminars in the field of skilled trades, pre-trades, namely pre-employment trades training to enable somebody to be employed in the skilled trades, and unskilled labour.

(14) Administration of cultural and educational exchange programs.

(15) Providing an interactive website in the field of skilled trades, pre-trades, namely pre-employment trades training to enable somebody to be employed in the skilled trades, and unskilled labour.

Markham Affidavit

[13] Ms. Markham is a Manager with the Opponent [para 1]. She states that the Opponent is a not-for-profit society incorporated in Alberta since August 1998 [para 2, Exhibit A]. She explains that the Opponent trains women “to acquire the skills to pursue employment in the construction, skilled trades, maintenance and driving industries” [para 6]. The Markham Affidavit evidences the following:

- The Opponent’s operations [paras 6 to 11, Exhibits C to E];
- The use and promotion of the Opponent’s Trademark in Canada since 1998 [paras 12 to 30, Exhibits F to O]; and
- In particular, the use and promotion of the Opponent’s Trademark in association with “providing education services in the construction trades, such as information sessions and workshops” [para 16], as well as the Opponent’s “Opportunities for Women in Construction Awareness Campaign” [para 20].

[14] The Markham Affidavit also includes commentary regarding the likelihood of confusion, asserting, *inter alia*, similarities between the parties’ trademarks and the nature of the parties’ businesses, services and trades [paras 31 to 37].

OVERVIEW OF THE APPLICANT'S EVIDENCE

Mann Affidavit

[15] The Applicant is the CEO of BMGroup of Companies (BMG), a company engaged in construction support services and real estate development [para 2]. In his affidavit, Mr. Mann confirms that he licenses use of the Mark to BMG [para3]. The Mann Affidavit evidences the following:

- BMG's ownership and operation of the websites *bmgrouppinternational.com* and *penmat.ca*;
- BMG's overall expenditures for promotion and advertising of its trademarks, including the Mark, since 2015 [para 7, Exhibit B];
- The Applicant's business card, which displays the Mark [para 8, Exhibit C];
- Promotion of BMG's brands, including display of the Mark, in third-party magazine advertisements in 2019 [paras 9 and 10, Exhibits D and E];
- Display of the Mark on construction site signage [para 11, Exhibit F]; and
- Display of the Mark on BMG company trucks [para 12, Exhibit G].

[16] I note that Mr. Mann does not specify dates for most of his exhibits. I further note that, throughout the exhibits, the Mark is typically displayed with the brand name PENMAT, as shown below:



Shannon Affidavit

[17] Ms. Shannon is a trademark agent employed by the Applicant's agent of record. The Shannon Affidavit evidences the following:

- The 2018 examiner's report related to the application for the Mark, which did not raise an objection based on confusion with the Opponent's Trademark registration [para 3, Exhibit B];
- Search results from the Canadian Trademarks Register database for "active" trademarks in all Nice classes that include the terms "building" and "future" [para 4, Exhibit C];
- Search results from the Canadian Trademarks Register database for "active" trademarks in International Class 37 (re: Building construction and repair) that include the terms "building" and "future" [para 5, Exhibit D];
- Search results from the Canadian Trademarks Register database for "active" trademarks in International Class 37 that include the term "woman" [para 6, Exhibit E];
- Google search results for "building+future" [para 7, Exhibit F]; and
- Google search results for "woman+building" [para 8, Exhibit G].

EVIDENTIAL BURDEN AND LEGAL ONUS

[18] In accordance with the usual rules of evidence, 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 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.

[19] 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.

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

[20] Based on sections 38(2)(b) and 12(1)(d) of the Act, the Opponent pleads that the Mark is not registrable because it is confusing with registration No. TMA953,777 for the Opponent's Trademark, "Women Building Futures".

[21] 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*, 37 CPR (3d) 413 (FCA)]. As the Opponent's Trademark registration is extant on the register, the Opponent meets its initial burden.

[22] Accordingly, the Applicant must establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's Trademark.

Test to determine confusion

[23] The test to determine the issue of confusion is set out in section 6(2) of the Act which provides 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 or appear in the same class of the Nice Classification.

[24] The test to be applied is a matter of first impression in the mind of a casual consumer "somewhat in a hurry" who sees the Mark in association with the applied-for services at a time when they have no more than an imperfect recollection of the Opponent's Trademark and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[25] In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: 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 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.

[26] The criteria or factors in section 6(5) of the Act 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 at para 54]. In *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, the Supreme Court of Canada stated that section 6(5)(e), the resemblance between the trademarks, will often have the greatest effect on the confusion analysis [at para 49] and that, while the first word in the trademark may be the most important in some cases, the preferable approach is to consider whether there is an aspect of the trademark that is particularly “striking or unique” [at para 66].

Inherent Distinctiveness and the Extent Known

[27] With respect to the inherent distinctiveness of the parties’ trademarks, in its written representations, the Opponent submits that trademarks such as those of the parties “are normally considered to possess lower levels of inherent distinctiveness since they are composed of generic, descriptive or suggestive terms” [para 23].

[28] With respect to the extent to which the Applicant’s Mark has become known, the Opponent notes that, while the application for the Mark is based upon a claim of use since at least as early as 2011, the evidence of use does not predate 2015. In this respect, it notes one of the evidenced magazine advertisements from 2019 and that the “nominal advertising expenditures” from 2015 to 2019 include *all* of BMG’s trademarks [para 25, referencing the Mann Affidavit at paras 7 to 10 and Exhibits B and D].

[29] In contrast, the Opponent submits that the Opponent’s Trademark “has become reasonably well known in Canada” [para 26], noting the following evidence from the Markham Affidavit:

- References to the Opponent’s Trademark in a selection of media articles dating back to 2008 [para 14, Exhibit G];

- Radio, television and online media activities related to the Opponent’s “Opportunities for in Construction Awareness Campaign” launched in early 2005 and its 2017-2018 National Awareness Campaigns [paras 20 to 30, Exhibits M, N and O];
- The Opponent’s expenses, “that range from \$94,886 to \$591,897 for Program Awareness and Communications and Marketing and Advertising for years 2009-2013” [paras 17 and 18, Exhibit E];
- Provision of education services to the construction trades such as sessions and workshops from 2009 to 2013 [para 16]; and
- Over 300 employers and organizations “in the trades and pre-trades including the construction industry” being the Opponent’s industry sponsors, strategic partners, workforce development partners and “Women Building Futures Employers of Choice” [para 13].

[30] In its written representations, the Applicant essentially agrees with the Opponent that neither parties’ trademarks have a high degree of inherent distinctiveness, noting that both trademarks are comprised of commonly used words in the English language [para 31]. With respect to the extent the parties’ trademarks have become known, the Applicant submits that “there were many other traders concurrently using the words “building” and “future(s)” in association with construction and repair services and thus, both the Applicant’s and the Opponent’s marks are relatively weak and any acquired distinctiveness on the part of [the Opponent’s Trademark] has been lost on account of the widespread use of those words” [para 32].

[31] In addition, asserting that the Opponent’s evidence appears largely limited to Alberta, the Applicant submits that each party’s evidence is limited in geographic scope “to mostly their respective areas in which they operate”, such that neither party “can claim its mark has gained wide notoriety in the overall Canadian market” [para 33]. As such, the Applicant submits that this factor favours neither party [para 34].

[32] I agree with the parties that both trademarks have a low degree of inherent distinctiveness. However, with respect to the extent to which the parties' trademarks have become known, in my view, the evidence favours the Opponent. In this respect, the evidence of use of the Mark or the extent to which it has become known is nominal at best.

[33] Accordingly, overall, this factor favours the Opponent.

Length of Time in Use

[34] In its written representations, the Applicant concedes that this factor favours the Opponent [para 35]. Indeed, the Opponent notes that it began using its trademark in 1998, earlier than the claimed date of first use in the application (as early as 2011), as well as earlier than any actual evidence of use of the Mark as shown in the Mann Affidavit [Opponent's written representations at paras 28 and 29].

[35] Accordingly, this factor favours the Opponent.

Nature of the Services or Business / Nature of the Trade

[36] When considering the nature of the goods and services of the parties in respect of the issue of confusion, it is the statements of goods and services in the subject application and registration that govern [*Mr Submarine Ltd v Amandista Investments Ltd*, 1987 CarswellNat 749, 19 CPR (3d) 3 (FCA); *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[37] In its representations, the Opponent submits that while the nature of the applied-for services and those associated with the Opponent's Trademark are "arguably different", there is an overlap in the nature of the parties' trades in that the Opponent "provides training and vocational education to trade, pre-trades and unskilled labour in the construction industry" [para 31]. Furthermore, the Opponent submits that the Markham Affidavit provides evidence of "the Opponent's significant focus on engaging those in the construction industry for the provision of its services and that, by virtue of the nature of its business, the Applicant likely interacts with these same entities [para 41].

[38] In its representations, the Applicant notes that the parties' services are not in the same international class [para 38]. Further, it submits that the parties' services "are highly specialized and expensive purchases for which the average consumer would take care and research before purchasing", making it less likely for consumers to be confused when encountering the Mark with imperfect recollection of the Opponent's Trademark [para 39].

[39] More significantly, the Applicant notes that the Opponent's goods and services are marketed specifically towards women seeking training and education in the trades, whereas the Applicant's services are marketed to all individuals seeking construction and repair building services [para 40]. As such, the Applicant submits that the goods and services of the Opponent would not be sold through the same channels of trade as the services of the Applicant [para 42].

[40] Although the evidence shows that the Opponent's education and training services have a relation to the construction industry, ultimately, the Applicant does not provide educational services and the Opponent does not provide construction services. Based on the evidence before me, I agree with the Applicant that the channels of trade for the parties' services do not overlap in a significant manner.

[41] Accordingly, I find that these factors favour the Applicant.

Degree of Resemblance

[42] In its representations, the Opponent submits that the parties' trademarks "bear similarity to one another in appearance, sound, form and suggested idea" [para 35]. In particular, the Opponent submits that WOMEN BUILDING FUTURES sounds and looks similar to BUILDING THE FUTURE, especially at a preliminary glance [para 38]. With respect to the idea suggested, the Opponent further submits that each trademark "contains prospective, forward looking, and idealistic sentiments rooted in building or creating something" [para 36].

[43] In its representations, the Applicant submits that, when the parties' trademarks are viewed in their entirety, there is a low degree of resemblance in appearance and when sounded. In this respect, it notes the "particularly striking" use of the word WOMEN before – and modifying – the words BUILDING FUTURES in the Opponent's Trademark, whereas the Mark is non-gender specific and has fewer syllables [para 53]. With respect to the idea suggested, the

Applicant submits that the Mark “evokes the general idea of building a singular (the) future, whereas [the Opponent’s Trademark] suggests particularly women building multiple futures”, emphasizing that “the Applicant’s construction and repair services relates to a customer’s particular future, whereas, the Opponent’s educational trade services enable each woman to build their own future depending on her chosen trade and curriculum” [para 55].

[44] Overall, notwithstanding that both trademarks share the elements BUILDING and FUTURE, the resemblance between the trademarks in appearance and when sounded is diminished by the WOMEN element present only in the Opponent’s Trademark. In this respect, it is well established that comparatively small differences will suffice to distinguish between inherently weak trademarks [see, for example, *Provigo Distribution Inc. v Max Mara Fashion Group SRL*, 2005 FC 1550 at para 31; and *Swatch AG (Swatch SA) (Swatch Ltd) v Hudson Watch, Inc*, 2018 FC 853 at paras 42 to 44].

[45] This difference is also prevalent with respect to the ideas suggested. While both trademarks may broadly invoke “idealistic sentiments rooted in building or creating something”, I do not consider any such resemblance to be any stronger than that of the trademarks in appearance or when sounded.

[46] Accordingly, overall, this factor favours the Opponent.

Additional Surrounding Circumstance – State of the Register

[47] In its representations, the Applicant refers to the Shannon Affidavit regarding the existence of “active” third-party trademarks bearing the words “building” and “future” in international class 37 (re: Building construction and repair) [para 60]. The Applicant further submits that there is “widespread adoption and use of the words “building” and “future” by a variety of different parties ... so no one can claim a monopoly on these words” [para 61].

[48] However, I do not consider the exhibits to the Shannon Affidavit to be of much value, as they present only basic search results of the register and from Google. Neither Ms. Shannon nor Mr. Mann speak directly to the significance of any of these search results; there is no evidence regarding the extent to which any third-party trademarks have been used or become known in Canada. In particular, I note that the Exhibit D search results include only five registered

trademarks that incorporate the words BUILDING and FUTURE. However, state of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [*Ports International Ltd v Dunlop Ltd*, 1992 CarswellNat 1431 (TMOB); and *Welch Foods Inc v Del Monte Corp*, 1992 CarswellNat 178 (FCTD)]. Such inferences can only be drawn from state of the register evidence where large numbers of relevant registrations are located [*Maximum Nutrition Ltd v Kellogg Salada Canada Inc*, 1992 CarswellNat 124 (FCA)].

[49] Whatever value was intended by this evidence, I consider it no stronger than the fact that BUILDING and FUTURE are descriptive or suggestive words in relation to the parties' respective services and, further, that the parties' services and channels of trade differ.

[50] Accordingly, I do consider the state of the register evidence to be a significant surrounding circumstance.

Additional Surrounding Circumstance – No Evidence of Actual Confusion

[51] In its representations, the Applicant also submits that it is “noteworthy that over the years of co-existence, there is a lack of evidence of actual confusion” between the parties' trademarks [para 62].

[52] As there is only nominal evidence of use of the Mark before me, I do not consider the absence of evidence of actual confusion to be significant.

[53] Accordingly, this factor favours neither party.

Conclusion – Confusion with the Opponent's Trademark

[54] Having considered all of the surrounding circumstances, I find that the Applicant has met its legal burden with respect to the likelihood of confusion between the parties' trademarks. I reach this conclusion due to the differences in the nature of the parties' goods, services and channels of trades and the low degree of resemblance between the parties' trademarks given the descriptiveness or suggestiveness of the shared elements BUILDING and FUTURE, and notwithstanding the relatively greater extent known and length of time in use of the Opponent's Trademark.

[55] In view of the foregoing, the section 12(1)(d) ground of opposition based on confusion with the Opponent's Trademark registration is rejected.

SECTION 16(1)(A) GROUND OF OPPOSITION – CONFUSING WITH A PREVIOUSLY USED TRADEMARK

[56] Based on section 38(2)(c) of the Act, the Opponent pleads that the Applicant is not the person entitled to registration of the Mark in view of section 16(1)(a) of the Act. In particular, the Opponent pleads that the Mark is confusing with the Opponent's Trademark, which had been previously used and made known in Canada by the Opponent or the previous owner of the Opponent's Trademark, and was not abandoned at the date of advertisement of the application for the Mark.

[57] The material date with respect to confusion with a previously used trademark is the claimed date of first use in the application, being 2011 in this case.

[58] As the Opponent has evidenced use of the Opponent's Trademark since 1998, the Opponent meets its initial burden under this ground.

[59] However, notwithstanding the earlier material date, I do not find my conclusions above with respect to the confusion analysis to substantially differ under this ground.

[60] In view of the foregoing, the section 16 ground of opposition based on confusion with the Opponent's Trademark is rejected.

SECTION 2 GROUND OF OPPOSITION – NON-DISTINCTIVENESS

[61] Based on section 38(2)(d) of the Act, the Opponent pleads that the Mark is not distinctive within the meaning of section 2 of the Act because it does not distinguish, and is not adapted to distinguish, the Applicant's applied-for services from the services associated with the Opponent's Trademark.

[62] The material date for this ground is the filing date of the opposition, August 8, 2018 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

[63] 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.

[64] 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].

[65] In its written representations, the Opponent submits that the Mark “actually distinguishes through its use since 2011, resulting in distinctiveness in fact”, such that the Mark is distinctive within the meaning of section 2 of the Act in that “it does distinguish the Applicant’s applied-for services from the services associated with [the Opponent’s Trademark]” [paras 80 and 81].

[66] For its part, the Applicant does not make any significant submissions specifically directed to this ground.

[67] 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*]. In this case, the initial burden is on the Opponent to prove that, as of the material date, its trademark was known to some extent in Canada in association with the relevant services and had a reputation in Canada that was “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; and *Ontario Dental Assistants Association v Canadian Dental Association*, 2013 FC 266 at para 42, *aff’d* 2013 FCA 279]. In *Suzanne’s Inc v Auld Phillips Ltd*, 2005 FCA 429, in the context of an expungement proceeding under section 57 of the Act, the Federal Court of Appeal 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].

[68] In this case, while there is evidence of use of the Opponent’s Trademark as of the material date, I note that, at best, any use or reputation appears largely limited to Alberta and British Columbia. In any event, I do not consider the Markham Affidavit to evidence substantial, significant or sufficient reputation in the Opponent’s Trademark so as to negate the distinctiveness of the Mark.

[69] In this respect, to the extent this ground in part ultimately turns on the issue of confusion, I would come to the same conclusion as above with respect to the section 12 and section 16 grounds, notwithstanding the differing material date.

[70] Accordingly, the section 2 ground of opposition is rejected.

SECTION 30 GROUND OF OPPOSITION – NON-COMPLIANCE

[71] Based on section 38(2)(a) of the Act, the Opponent pleads that the application does not comply with the requirements of section 30(i) of the Act. In particular, the Opponent pleads that the Applicant has acted in bad faith because it could not have been satisfied as at the date of the application as to its entitlement to use the Mark in association with the applied-for services having regard to the Opponent's Trademark and the prior use thereof by the Opponent or the previous owner of the Opponent's Trademark.

[72] The Opponent submits that the Applicant "knew or ought to have known of the Opponent's Trademark and its use in Canada" and that "an inference can be drawn that the Applicant is a sophisticated entity that ought to have conducted sufficient due diligence so as to discover the use of [the Opponent's Trademark] in Canada before the Applicant filed [the application]" [Opponent's written representations at paras 16 and 19].

[73] Section 30(i) of the Act merely required that an applicant include a statement in its application that it is satisfied that it is entitled to use its trademark in Canada in association with the goods or services described in the application.

[74] Where this statement has been provided, 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) CarswellNat 476, 15 CPR (2d) 152 (TMOB)]. Knowledge of the existence of an opponent's trademark does not in and of itself support an allegation that an applicant could not have been satisfied of its entitlement to use its trademark [*Woot, Inc v WootRestaurants Inc*, 2012 TMOB 197].

[75] In this case, the requisite statement was provided, and there is no evidence that this is an exceptional case or that the Applicant applied for the Mark in bad faith.

[76] Accordingly, the ground based on section 30(i) of the Act is rejected.

DISPOSITION

[77] In view of all of the foregoing, 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: No hearing held

AGENTS OF RECORD

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