



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 028

Date of Decision: 2022-02-22

IN THE MATTER OF AN OPPOSITION

Mumusokr Co., Ltd.

Opponent

and

**Guangdong Saiman Investment Co.
Ltd.**

Applicant

1,839,598 for MUMUSO

Application

THE RECORD

[1] Guangdong Saiman Investment Co. Ltd. (the Applicant) filed an application for the trademark MUMUSO (the Mark) on May 29, 2017, in association with the following services:

(1) Import-export agencies; promoting the sale of goods and services through promotional contests and the distribution of related printed material; sales promotion for others provided through the distribution and the administration of privileged user cards; promoting the goods and services of others through the distribution of discount cards; purchasing agents; procurement services in the form of purchasing goods and services for businesses; marketing analysis services; providing marketing strategies for others; online department store services; commercial administration of the licensing of the goods and services of others; business management consultancy; negotiation and conclusion of commercial transactions for third parties; sales demonstration for others; business merchandising display services; rental of vending machines. (the Services)

[2] Mumusokr Co., Ltd. (the Opponent) filed its statement of opposition on August 29, 2018. The *Trademarks Act*, RSC 1985, c T-13, 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 before it was amended [section 70 of the Act].

[3] The Opponent raises grounds of opposition based on compliance with sections 30(a) and 30(b) of the Act.

[4] In support of its opposition, the Opponent filed and served the affidavits of YE Xiaozhou, President of the Opponent and Taiji Yoshino, Patent Engineer and IP Consultant employed by the firm of Nelligan O'Brien Payne LLP. The notarization of Mr. Xiaozhou's affidavit was done in accordance with the requirements of the Korean Notary Public Act. Neither of the Opponent's affiants were cross-examined. The Applicant elected not to file any evidence. Neither party filed written representations and a hearing was not requested.

EVIDENTIAL BURDEN AND LEGAL ONUS

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

PRELIMINARY REMARKS

[6] In the absence of written representations and a hearing, it is difficult to assess the position of each party in the context of an adversarial process. It is not up to the Registrar to envision all possible arguments that each party could raise under a specific ground of opposition. With this in mind, I shall limit my analysis of the grounds of opposition raised by the Opponent to those that are directly in line with the evidence filed, and will refer only to those portions of the evidence that are relevant.

GROUND OF OPPOSITION

Section 30(a) Ground of Opposition

[7] The Opponent pleads that the application does not comply with section 30(a) of the Act because the statement of Services is not sufficiently specific or set out in ordinary commercial terms. In this regard, the Opponent states the following:

“In particular, the services “procurement services in the form of purchasing goods and services for businesses” and “commercial administration of licensing of the goods and services of others” are vague and will grant the Applicant an unreasonably wide ambit of trademark protection. Further, these services are not sufficiently specific to enable the Registrar and the public to assess whether the mark is confusing with another registered or pending mark or a mark that is in use in the marketplace. In addition, these services are not services that are listed in the Trademarks Goods and Services Manual as being in compliance with section 30(a) of the Act.

[8] There are two issues to be determined under a section 30(a) ground of opposition, first, whether the statement of services is in ordinary commercial terms and, second, whether it adequately identifies the specific services [*Whirlpool SA v Eurotherm Holdings Ltd*, 2010 TMOB 171 at para 39].

[9] The affidavit of Taiji Yoshino attaches the results of searches of the *Goods and Services Manual* (the Manual) conducted on December 18, 2018, which show that it does not contain any entries with respect to “procurement services in the form of purchasing goods and services for businesses” or “commercial administration of the licensing of the goods and services of others” (Yoshino, Exh. A). Mr. Yoshino also conducted online searches to determine if these descriptions are ordinary commercial expressions. In this regard, on or about December 18, 2018, Mr. Yoshino used Microsoft Edge as the browser to verify whether the service description “procurement services in the form of purchasing goods and services” or “commercial administration of the licensing of the goods and services of others” were ordinary commercial expressions. From studying the first three pages of each of his search results, he states that he was unable see how either of these descriptions was used by any trader as an ordinary commercial expression.

[10] I will begin by noting that I have discretion to review the Manual [*Johnson & Johnson v Integra Lifesciences Corp* (2011), 98 CPR (4th) 429 at para 29 (TMOB); *Effigi Inc v ZAM Urban Dynamics Inc* (2010), 89 CPR (4th) 461 (TMOB)]. While the Manual is not exhaustive, it does include a representative list of acceptable goods and services descriptions. For those goods or services not listed in the Manual, acceptable listings can be used to indicate, by analogy, the kinds of statements that would also be acceptable to describe similar goods or services. A statement of goods or services is acceptable if it is as specific as, or more specific than, a related or similar listing. [*Trademarks Examination Manual*, section 2.4.5].

[11] In exercising my discretion, I searched the key word “procurement” and noticed that “procurement services for others [purchasing goods and services for other businesses]” was considered an acceptable description of services at the filing date of the application (*i.e.*, May 29, 2017) because it was not “retired” from the list of acceptable goods and services until October 29, 2021. In view that this was an acceptable description at the filing date of the application, I am satisfied that these services complied with section 30(a) of the Act at that time [*A. Bosa & Co Ltd v A-27 SpA*, 2016 TMOB 162].

[12] I also searched the key word “licensing” in the Manual. My review of the Manual showed that the description “commercial administration of the licensing of the goods and services of others” was not considered as an acceptable description of services at the material date for this ground. However, as noted above, it is not because a word or phrase is *not* found in the Manual at the material date that this must necessarily lead to a finding that such word or phrase was not defined in ordinary commercial terms at the material date. Further, the search results of Mr. Yoshino do not speak to the description of services that ordinary traders were using at the material date for this ground. Finally, in view that “commercial administration of the licensing of the goods and services of others” is *currently* accepted by the Manual, I would have expected the Opponent to have explained how or why this description was not sufficiently specific at the filing date of the application. Consequently, as I am not satisfied that the Opponent has met its evidential burden under this ground, this ground of opposition is rejected.

Section 30(b) Ground of Opposition

[13] The initial burden on an opponent is light respecting the issue of non-conformance with section 30(b) of the Act, because the facts regarding an applicant's first use are particularly within the knowledge of an applicant [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89]. Having said that, the opponent must still produce evidence to support its objections or adduce evidence from which it may reasonably be concluded that the facts alleged to support this ground of opposition exist [*Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd*, 2014 FC 323 at para 34].

[14] In the present case, the application is based on a claim of use in Canada with the Services since March 21, 2017.

[15] Mr. Xiaozhou states that the Opponent has engaged in the business of trading and wholesale services for daily necessities and food products since its formation in 2014. The Opponent currently has stores all over the globe covering nearly more than 30 countries and regions on 5 continents. He explains that the Applicant is one of his company's competitors, and he is aware that the Applicant operates a chain of retail stores under the name MINISO.

[16] Mr. Xiaozhou further states that the fundamental reason for the Opponent's opposition to the Applicant's Mark is that the Applicant does not have any products or services under the MUMUSO trademark. He further states that he believes that, "besides taking advantage of my company's goodwill", the Applicant has applied for the trademark MUMUSO "in order to frustrate and to block my company from obtaining the trademark "MUMUSOKR" or "MUMUSO.KR".

[17] At paragraph 11 of his affidavit, Mr. Xiaozhou states that, as someone who "regularly and diligently monitors global business activities by my company's competitors", he believes that the Applicant could not have offered the services in Canada in March, 2017. To corroborate this assertion, he carried out the following investigations on August 2, 2018:

- Google searches of the Applicant and the Mark which fail to identify any link in which a consumer can see what services are being offered by the Applicant under the Mark anywhere in the world, including Canada;

- Google searches of the Mark which show “hits” pointing to the Opponent company but nothing that points to the Applicant;
- Searches for goods and services under the Mark within the Applicant’s websites *www.miniso.ca* and *www.miniso.com* did not turn up anything;
- Wayback machine searches for *www.miniso.ca* conducted on August 2, 2018, failed to show use of the Mark at or near the claimed date of first use, i.e., March 21, 2017;
- Wayback machine searches for *www.miniso.com* conducted May 17, 2014, November 29, 2016, and March 30, 2017, did not show any use of the Mark.

[18] I do not find that the Opponent has met its burden under this ground with respect to any of the Services except online department store services for the following reasons. First, with the exception of the Wayback Machine evidence, Mr. Xiaozhou conducted the Google searches on August 2, 2018, which does not speak at all to the claimed date of first use of the Mark. Second, the evidence of the Wayback machine is not sufficient on its own to lead to the inference that the Applicant has not used the Mark in Canada in association with almost all of the Services in Canada since the date claimed in the application. The Opponent’s allegation implies an unsubstantiated assumption that use of the Mark by the Applicant necessarily will include reference to the Applicant on the Internet [*Heather Ruth McDowell v 2103214 Ontario Inc*, 2012 TMOB 227]. While I agree that one would expect to find the Applicant’s “online department store services” on the Internet, the possession of an active website is not necessarily a precondition to offering the Applicant’s other services, such as promoting the sale of goods and services through promotional contests and the distribution of related printed material in Canada. Rather, it is conceivable that the Applicant was offering most of its services in association with the Mark prior to developing an active website [*Littlewoods Limited v Allyson Grabish*, 2013 TMOB 34].

[19] Based on the foregoing, I find that the Opponent has failed to meet its evidential burden with respect to all of the Services except online department store services.

[20] For the online department store services, I am of the view that the absence of an active website at the relevant date is sufficient to put into issue the Applicant’s statement that it had used the Mark in association with the online department store services continuously since the

claimed date. As a result, I am satisfied that the Opponent has met its evidential burden with respect to these services.

[21] As the Applicant has not filed any evidence or argument, this ground is successful in part.

DISPOSITION

[22] In view of the above, and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to “online department store services” and I reject the opposition with respect to the remainder of the Services pursuant to section 38(12) of the Act.

Cindy R. Folz
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

Nelligan O'Brien Payne

For the Opponent

Neomark Ltd.

For the Applicant