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LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 281**  
**Date of Decision: 2021-12-14**

**IN THE MATTER OF AN OPPOSITION**

**I. Quint Group Inc.**

**Opponent**

**and**

**Quintcap Inc.**

**Applicant**

**1,770,015 for QUINT HOTELS &  
Design**

**Application**

INTRODUCTION

[1] The parties to this opposition proceeding are not strangers to one another. As will be more fully explained below, they have been involved in recent years in a few legal disputes against one another and their respective principals, who are part of the same family and share the surname Quint.

[2] In the present case, I. Quint Group Inc. (I. Quint or the Opponent) opposes application No. 1,770,015 (the Application) for registration of the trademark QUINT HOTELS & Design (the Mark), reproduced below, filed by Quintcap Inc. (Quintcap or the Applicant) on the basis of use of the Mark in Canada since at least December 30, 2013 in association with the following services, as revised by the Applicant:



Services:

(1) Operation and management of hotels.

(2) Hotel reservation services, arranging, organizing and providing facilities for banquets, providing banquet hall facilities and conference rooms for receptions, private events, conferences and meetings; restaurant services and catering services.

[3] The Opponent has opposed the Application on various grounds, including non-compliance of the Application with the requirements set out in section 30 of the *Trademarks Act*, RSC 1985, c T-13 (the Act), non-registrability of the Mark under section 12 of the Act and non-distinctiveness of the Mark under section 2 of the Act.

[4] For the reasons that follow, the opposition is rejected.

THE RECORD

[5] The Application was filed on February 29, 2016, and advertised for opposition purposes in the *Trademarks Journal* on December 20, 2017.

[6] On February 20, 2018, the Opponent filed a statement of opposition under section 38 of the Act. As the Act was amended on June 17, 2019, all references in this decision are to the Act as amended, with the exception of references to the grounds of opposition (see section 70 of the Act, which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised before this date).

[7] The grounds of opposition can be summarized as follows:

- The Application does not conform to the requirements of section 30(a) of the Act in that the Services in association with which the Mark has been used are not defined in ordinary commercial terms.

- The Application does not conform to the requirements of section 30(b) of the Act in that the Applicant has not used the Mark in association with the Services since the date of first use indicated in the Application. Moreover, the Mark has not been used as a trademark, but instead has functioned as a trade name.
- The Application does not conform to the requirements of section 30(i) of the Act in that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Services in that the Mark is not registrable and not distinctive and the Applicant is not the person entitled to registration. The principal of the Applicant and the principal of the Opponent are related and both have the same surname QUINT. Moreover, they previously carried on business together in the real estate industry and continue to do so separately. They were and are both well-known in the industry. In this respect, the Applicant and the Opponent are parties to a case instituted in Superior Court with respect to this same matter.
- The Mark is not registrable pursuant to section 12(1)(a) of the Act, which prohibits the registration of a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years. The Applicant is not entitled to the exclusive use of the word QUINT which is in fact the surname of the principals of the Applicant and the Opponent, as well as at least 34 people throughout Canada. Moreover, the principals of the Applicant and the Opponent share the same surname, they previously carried on business together in the real estate industry and continue to do so separately and, in this regard, are parties to a case now before the Superior Court.
- The Mark is not distinctive pursuant to section 2 of the Act in light of the inclusion of the surname QUINT. More specifically, the Mark does not actually distinguish nor is it adapted to distinguish the Services rendered or sold by the Applicant from the services rendered or sold by the Opponent or others with the same surname.

[8] On March 29, 2018, the Applicant filed and served a counter statement denying each ground of opposition pleaded in the statement of opposition.

[9] In support of its opposition, the Opponent filed a solemn declaration of its president, Ian Quint (Ian), dated July 27, 2018 (the Quint Declaration), and a solemn declaration of Janet

Dell'Orto, a trademark agent and translator employed by the Opponent's agent in this proceeding, dated July 18, 2018 (the Dell'Orto Declaration). They were both cross-examined on their declarations and the transcripts thereof form part of the evidence of record, as well as Exhibit IQ-1 and answer to undertaking U-1 relating to Ian's cross-examination, as will be discussed further below.

[10] In support of its Application, the Applicant filed a solemn declaration of Marylène Gendron, a secretary employed by the Applicant's agent, dated April 29, 2019 (the Gendron Declaration). Ms. Gendron was cross-examined on her declaration and the transcript thereof and answers to undertakings form part of the evidence of record, as will be discussed further below.

[11] No written representations were filed, but both parties were represented at a hearing during which the Opponent withdrew the ground of opposition based on section 30(a) of the Act. The case was heard together with two other opposition proceedings for application Nos. 1,715,193 and 1,715,419 for the word mark QUINTCAP and the trademark QUINTCAP DESIGN, respectively. Separate decisions will issue with respect to those two oppositions.

#### ANALYSIS

##### **Preliminary remarks — Previous legal disputes between the parties**

[12] As indicated above, in recent years, the parties to the present proceeding have been involved in a few legal disputes.

[13] Without getting into too much detail, I note that a judgment of the Superior Court of Quebec issued on March 15, 2021 in favor of Quintcap and its president Theodore Quint (Theodore) – who is the uncle of Ian – is presently under appeal before the Court of Appeal of Quebec [see *Quintcap inc v I. Quint Group Inc* 2021 QCCS 1932 and *I. Quint Group Inc v Quintcap inc*, 2021 QCCA 774].

[14] The Superior Court's judgment is in respect of two files that had been heard together, namely i) a statement of claim filed by Quintcap and Theodore against I. Quint, its president Ian

and three other companies related, directly or indirectly, to Ian (one of them named Devraker Real Estate Inc. (Devraker)), alleging, among other things, passing-off and unfair competition and seeking various orders and the revocation of a gift of shares for ingratitude; and ii) an oppression remedy claim instituted by Ian and Devraker against Theodore and Quintcap and several other persons or entities related to them.

[15] Not surprisingly, reference was made to the Superior Court's judgment at the hearing. However, this judgment is not necessarily determinative of the issues in the present case. Suffice it to say that this judgment is under appeal to the Court of Appeal of Quebec and, in any event, each case must be decided on its own facts.

### **The parties' respective burden or onus**

[16] The Opponent has the initial evidential burden to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once that burden is met, the Applicant bears the legal onus of establishing, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155].

### **Overview of the evidence**

#### The Opponent's evidence

##### *The Quint Declaration*

[17] As it will become apparent from my review below, the Quint Declaration essentially focuses on three things: i) Ian's former business relationship with his uncle Theodore, including through the Applicant during the years 2005 to 2015; ii) the circumstances surrounding the creation of the brand QUINTCAP; and iii) the Opponent's reputation and Ian's personal reputation in the real estate industry. As transpires from the transcript of Ian's cross-examination, and as was the case in the matter before the Superior Court, there is a debate between the parties on the characterization of that relationship, hence my added emphasis in some of the quotations reproduced below. On the one hand, the Opponent submits that they were business partners. On

the other hand, the Applicant submits that Ian was an employee of the Applicant. I will return to this issue.

[18] With this background in mind, the Quint Declaration can be summarized as follows.

[19] In the introductory paragraphs, Ian describes himself as the President of I. Quint since its inception on February 13, 2015 and as “a businessman with a law degree and considerable expertise in the fields of real estate management and development” [paras 1 and 2, see also para 20].

[20] In the following paragraphs, Ian also describes himself as “the former *business partner* of [his] uncle, [Theodore], the President of the Applicant” [my emphasis] [para 3]. More specifically, he asserts that:

4. [...] from 2005 to 2015, I worked with [Theodore] and was solely responsible for the management and development of a family real estate portfolio (the “Real Estate Portfolio”) that [Theodore] was a partner in [...].

5. During such time, I developed almost 100% of the various real estate projects in Brossard and La Prairie.

6. I was engaged in an “*incorporated partnership*” with [Theodore] and other partners *through a number of companies carrying on business in the field of real estate management and development.*

7. After completing my law degree and being called to the bar of the State of New York in 2005, I decided, *at the behest of my uncle [Theodore], the President of the Applicant, following the resignation of the previous property manager,* to pursue a career in real estate.

[My emphases]

[21] Ian thereafter further describes the context of his beginnings as a real estate manager, including how:

10. [He] updated the management office that had grown stale and was technologically far behind industry standards, particularly by investing in computers and software as none of the employees were provided computers and most paperwork was done by hand, and also by building an office website.

11. The Real Estate Portfolio flourished under [his] stewardship as [he] developed a reputation for being a project manager who was pleasant to work with and could deliver construction projects on time and on budget with 100% occupation rate usually before

construction was completed. In fact, under [his] stewardship, [he] more than doubled the size of the portfolio that [Theodore] had previously.

(See also para 12, where Ian lists the most important projects for which he was responsible).

[22] Ian goes on to assert that, “[b]y the end of 2014, [he] had an important personal stake in the real estate business and in other real estate ventures with investors outside the Quint family” [para 13]. He asserts that he “was responsible for identifying real estate opportunities and then supervising their conception, planning, construction, leasing and overall business operations, as well as managing existing real estate holdings held by the Quint family” [para 15, see also paras 14 and 17 where Ian further reiterates that he had gained a reputation in the real estate industry].

[23] Ian asserts that it is also at this time that his “disagreement with [Theodore] with regard to the future of the Real Estate Portfolio was coming to a head” [para 18]. More particularly, he asserts that when Theodore “made it clear to [him] that he had no intention of further expanding our real estate holdings, [Ian] *was forced to create [his] own real estate management and development enterprise*” [my emphasis] [para 19]. As such, he incorporated I. Quint [para 20, see also para 22 describing the expansion of the Opponent’s business].

[24] Ian thereafter relates that the Opponent attempted to register the trademark GROUPE QUINT & Design and that its application was objected to by the Examiner based on the Applicant’s prior applications for the above-mentioned trademarks QUINTCAP and QUINTCAP DESIGN, which have since been opposed to by the Opponent. Ian asserts that:

25. The Real Estate Portfolio was being held by various companies. I decided to centralize everything and therefore created one company to manage the entire portfolio. I therefore created the concept and the brand QUINTCAP as well as QUINTCAP logo, and I saw to the marketing of it all.

26. More specifically, [Theodore], the President of the Applicant, was managing his real estate business under many different names for 40 years. While working with [Theodore] as a manager, I obtained my general contractor’s license. *Given the various business names employed by [Theodore], I decided to create a name under which our clientele could more easily identify me and the work I was doing.* That name was QUINTCAP. *I created the name QUINTCAP after I worked at the company,* which was mainly being managed under the name PierreVillage. In fact, PierreVillage was being used by

[Theodore] before I joined him. *He ceased using that name after I created and began using the name QUINTCAP.* However, once I left and created my own real estate enterprise, namely the Opponent, [Theodore] returned to using the name PierreVillage, which can now be seen on rental sign of the Applicant and in the marketing of its portfolio of properties, as appears from sample photographs taken over the past three years of such signs which are enclosed herewith as Exhibit A. The telephone number that appears on the sign is the same number as the Applicant.

27. The Applicant's buildings are almost 100% on one small street in one small municipality. The Opponent is in almost every major region of Quebec, as well as in other areas of Canada and the United States. Furthermore, the Applicant owns no buildings and no longer even manages any properties. In fact, the company called House of Gordon is responsible for all management contracts of the Applicant. In addition, the Applicant does not manage any properties for third parties. As such, the Applicant is not creating or expanding its goodwill in the Mark, whereas, as indicated above, the Opponent has been actively and continuously expanding its real estate business in association with the trademark GROUPE QUINT & Design.

I note that Ian “corrected” paragraph 25 so that it reads: “...and therefore created one *brand* (or one *trademark*) to manage the entire portfolio...” [see pp 12 and 21 of the cross-examination transcript].

[25] In the last part of his declaration, Ian discusses how the Opponent and its trademark GROUPE QUINT & Design, reproduced below, are known in the industry. In support of his assertions, he attaches to his declaration various exhibits which will be discussed further below [paras 29 to 33; Exhibits B to H].



[26] Ian thereafter concludes his declaration providing his personal opinion with respect to the distinctiveness of the Mark, arguing among other things that:

33. [...] the name Quint is known in the greater real estate industry as a result of [Ian's] work and involvement. As such, the Applicant [...] should not be entitled to exclusive use of QUINT with respect to services offered in the real estate industry. It is equally [Ian's and Theodore's] family name and for that reason, as well as the fact that the



Opponent and [Ian] personally have taken an important place in the real estate industry, it is not distinctive of the services of the Applicant.

[see also paras 34 and 35]

[27] I will come back to this statement in my interpretation of the section 2 ground of opposition.

[28] As indicated above, Ian was cross-examined on his solemn declaration. During the cross-examination, counsel for the Applicant attempted to produce, as Exhibit IQ-1 to the cross-examination, some T-4 forms identifying Ian as an employee of the Applicant from 2006 until January 2015 (except 2008). Counsel for the Opponent objected to the production of this exhibit and to the whole line of questioning concerning Ian's status as an employee of Quintcap during those years. As a result, Exhibit IQ-1 was not listed in the Table of Contents of the transcript. However, a copy of this exhibit was filed by the Applicant along with the transcript of the cross-examination. In this regard, I note that in its letter submitting these transcript and exhibit, the Applicant submitted that an objection to the production of an exhibit should not prevent said exhibit from being presented to the Registrar. The Applicant submitted that to conclude otherwise would mean that any party could prevent an exhibit from being produced during a cross-examination by simply objecting to its production and that this would also prevent the exhibit from being filed with the Registrar, even for the purpose of permitting the Registrar to determine whether the objection is untenable. The Applicant further submitted that it is clear that Ian did examine Exhibit IQ-1 during his cross-examination, as transpired from pages 23 to 26 of the transcript. In this regard, I note that at page 24 of the transcript, Ian commenting on the T-4 forms asserted that:

[...] *this was part of a compensation where I was also being compensated as a corporation Devraker, which we've provided you proof of payments and we've provided you management contracts from [Theodore]'s Quint's company to my company Devraker.* [...] [my emphasis]

[29] During the hearing, I asked for some clarification with respect to what was part of the record and what was not. The Applicant and the Opponent each responded by letter filed with the Registrar on July 26 and August 12, 2021 respectively, commenting on the merits of their respective positions with respect to Exhibit IQ-1. However, no clarification was received with

respect to the above-mentioned “proof of payments” and “management contracts” referred to during Ian’s cross-examination.

[30] In view of the foregoing, I confirm that no “proof of payments” or “management contracts” were filed by the Opponent as exhibits *in the present file*. It is my understanding that these documents would have been produced in one of the files having led to the Superior Court’s judgment. I also accept that Exhibit IQ-1 be considered as part of the cross-examination transcript. In this regard, I disagree with the Opponent’s objection. I find the line of questioning concerning Ian’s status as an employee of Quintcap to be relevant as it seems to contradict his statements that he did start “an incorporated partnership” with his uncle back in 2005. I will return to this point below.

#### *The Dell’Orto Declaration*

[31] Ms. Dell’Orto’s declaration has been submitted for the sole purpose of providing the results of a search she carried out for the name QUINT on the Canada 411 website, listing 33 hits [Exhibit A].

[32] As indicated above, Ms. Dell’Orto was cross-examined on her declaration. The questions asked during her cross-examination were essentially to confirm the methodology used for her searches.

#### The Applicant’s evidence

#### *The Gendron Declaration*

[33] Ms. Gendron’s declaration has been submitted for the sole purpose of providing the results of her searches on various English and French dictionaries databases for the word QUINT [Exhibits MG-1 and MG-2] and a “*Declaration de mise à jour courante*” [FREE TRANSLATION]: “Current update statement” showing that the company name 3084388 Canada Inc. (identified as “employer” in the above-mentioned T-4 forms for the years 2006-2012) is the former name of Quintcap [Exhibit MG-3].

[34] As indicated above, Ms. Gendron was cross-examined on her declaration. The questions asked dealt mainly with the nature and source of the online dictionaries consulted. Two questions relating to the instructions given by counsel for the Applicant to Ms. Gendron [undertakings EMG-1 and EMG-2 (under reserve)] were objected to by counsel for the Applicant on the basis of privilege [see Applicant's letter dated May 1, 2020]. I find it is not necessary for me to rule on these objections as nothing turns on the nature of the instructions given by counsel for the Applicant.

### **Analysis of the grounds of opposition**

#### Section 30(b) ground of opposition (Mark not used since the claimed date and trade name use)

[35] The section 30(b) ground of opposition pleaded by the Opponent has two prongs, namely that the Mark has not been used since the claimed date of first use (that is, since at least as early as December 30, 2013); and that the Mark has not been used as a trademark, but instead has functioned as a trade name.

[36] The relevant date for considering the circumstances concerning this ground of opposition is the filing date of the Application [*Georgia-Pacific Corporation v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)]. In this regard, section 30(b) of the Act requires that there be continuous use of the Mark since the date claimed [*Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD)]. To the extent that the relevant facts pertaining to a ground of opposition based on section 30(b) of the Act are more readily available to the applicant, the evidential burden on an opponent with respect to such a ground of opposition is less onerous [*Tune Master v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. Furthermore, this burden can be met by reliance on the applicant's evidence [*Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. However, an opponent may only successfully rely upon the applicant's evidence to meet its initial burden if the opponent shows that this evidence is clearly inconsistent or puts into issue the claims set forth in the applicant's application [*Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd* 2014 FC 323]. In this regard, while an opponent is entitled to rely on the applicant's evidence to meet its evidential burden, 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 [*Kingsley v Ironclad Games Corporation*, 2016 TMOB 19].

[37] In this case, the Opponent relies on paragraph 27 of the Quint Declaration, where Ian asserts, among other things, that “the Applicant owns no buildings and no longer even manages any properties” as well as Ian’s cross-examination [pp 31 line 10; 43 line 1, and 45 line 6]. The Opponent further submits that the Applicant did not file any evidence whatsoever showing use of the Mark, be it as of the claimed date of first use of the Mark or any other time.

[38] I disagree with the Opponent’s position.

[39] As per my review above of the Quint Declaration, and as stressed by the Applicant at the hearing, the Opponent’s evidence does not, properly speaking, put into issue the Applicant’s claimed date of first use of the Mark in association with the applied-for Services. Rather, the Quint Declaration focusses on Ian’s alleged partnership with his uncle in the real estate industry broadly speaking. In this regard, I note that “the most important projects for which [Ian] was responsible” that are listed at paragraph 12 of his declaration do not relate to the hotel industry but to residential, commercial and industrial real estate construction and renovation projects [see also page 32 of the cross-examination transcript where Ian asserted that: “[...] that’s what the partnership did: when we were to buy a property after, we made a company, we bought the land, I changed the zoning, I put the services, and then we sold the land to a builder”].

[40] Furthermore, I am not prepared to give weight to Ian’s bald assertions to the effect that the Applicant owns no buildings and no longer even manages, either by itself or through a licensee, any properties as I find these assertions lack specificity, are too vague and fail to be substantiated by relevant and supporting exhibits, not to mention that I also have some reservations with respect to the credibility of Ian’s testimony relating to the particular business of the Applicant, especially in view of the Opponent’s refusal to clarify Ian’s former status as an employee of the Applicant as put into issue by the T-4 forms of Exhibit IQ-1. I do not mean to say by this that part of Ian’s remuneration when he was working for the Applicant could not *also* have come from various service contracts entered into between one or more companies belonging to Ian (*e.g.*, Devraker) and Quintcap or other real estate holdings/companies held by Theodore or the Quint family. However, in the absence of any satisfactory explanation and

supporting exhibits, I find the vagueness surrounding the past relationship between Ian and the Applicant somewhat suspicious. In this regard, it is worth noting Ian's oral testimony that "[he does not] know what the Applicant is because, to [Ian], Quintcap is a trademark that [he] created" and that "his uncle [Theodore], surreptitiously, without [Ian's] permission, took the name [Quintcap] that [Ian] created, [...] and changed the name of [one of his company] to Quintcap" [cross-examination transcript, pp 25 and 29], which I find to be particularly surprising and puzzling in view of the express identification of the Applicant as "employer" on the T-4 forms for the years 2013 to 2015.

[41] As the Opponent's evidence failed to put into issue the Applicant's date of first use of the Mark, the Applicant was under no obligation to evidence its claimed date of first use.

[42] Accordingly, the section 30(b) ground of opposition is rejected with respect to each prong.

Section 30(i) ground of opposition (Applicant could not be satisfied that it is entitled to use the Mark)

[43] The section 30(i) ground of opposition, as pleaded by the Opponent, seems to have four prongs, namely that the Applicant could not have been satisfied that it is entitled to use the Mark in Canada in association with the Services because (i) the Mark is not registrable; (ii) the Mark is not distinctive; (iii) the Applicant is not the person entitled to registration; and (iv) the principal of the Applicant and the principal of the Opponent are related and both have the same surname QUINT. Moreover, they previously carried on business together in the real estate industry and continue to do so separately. They were and are both well-known in the industry.

[44] I find that the first three prongs must be rejected as they are not valid grounds of opposition under section 30(i) of the Act and instead fall respectively under section 12 of the Act (non-registrability – discussed below), section 2 of the Act (non-distinctiveness – discussed below), and section 16 of the Act (person not entitled to registration – not pleaded by the Opponent).

[45] With respect to the fourth prong, it is not clear whether the Opponent is again pleading the Applicant's non-entitlement to registration (which, as indicated above, is not in itself a valid ground of opposition under section 30(i) of the Act) or bad faith of the Applicant. Regardless, I find this fourth prong must also be rejected.

[46] Section 30(i) of the Act requires that an applicant include a statement in its application that it is satisfied that it is entitled to use the trademark in Canada, as has been done by the Applicant in this case. It is well established in the jurisprudence that a ground of opposition based on section 30(i) should only succeed in exceptional circumstances such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co. Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. However, there is no evidence that the present case is an exceptional case or that the Applicant acted in bad faith at the filing date of the Application, or at any other time. The mere fact that Ian may have been involved in the creation of the brand QUINTCAP (be it as an employee of the Applicant or through his alleged partnership with Theodore) does not in and of itself support an allegation that the Applicant could not have been satisfied of its entitlement to use the Mark. Suffice it to note that the mere creation of a word or design that becomes a trademark does not in itself provide trademark rights.

Section 12(1)(a) of the Act (Mark not registrable as it is the name or surname of an individual)

[47] Section 12(1)(a) of the Act stipulates that a trademark is registrable if it is not a word that is primarily merely the name or the surname of an individual who is living or who has died within the preceding thirty years.

[48] The relevant date for deciding a section 12(1)(a) ground of opposition is the filing date of the application [see *Calvin Klein Trademark Trust v Wertex Hosiery Inc.*, (2004), 41 CPR (4th) 552 (TMOB); and *Jurak Holdings Ltd v Matol Biotech Laboratories Ltd.*, (2006), 50 CPR (4th) 337 (TMOB)].

[49] The leading cases pertaining to section 12(1)(a) are *Canada (Registrar of Trademarks) v Coles Book Stores Ltd* (1972), 4 CPR (2d) 1 (SCC); *Gerhard Horn Investments Ltd v Registrar of Trademarks* (1983), 73 CPR (2d) 23 (FCTD); and *Standard Oil Co v Canada (Registrar of*

*Trade Marks*) (1968), 55 CPR 49 (Ex CR), which have enunciated the test under section 12(1)(a) as two-fold:

- The first condition is whether the trademark is the name or surname of a living individual or an individual who has died in the preceding thirty years;
- If the answer to the first question is affirmative, then the Registrar must determine if, in the mind of the average Canadian consumer, the trademark is "primarily merely" a name or surname, rather than something else.

[50] The Opponent's initial burden is to satisfy the first condition of the test, that is to provide sufficient evidence that the trademark is the name or surname of a living individual or individual who has died in the preceding thirty years (*e.g.* telephone listings) [see *Image Intellectual Property Law Professional Corporation v Pinnacle Foods Group LLC*, 2013 TMOB 62].

[51] In the present case, I am satisfied that the Opponent's evidence filed through the Dell'Orto Declaration is sufficient to meet its initial evidential burden. While the surname QUINT appears to be a relatively rare surname throughout most of Canada (only 33 hits revealed by Ms. Dell'Orto's searches on the Canada 411 website), some minor recognition of the Mark as a surname may be inferred based on the said telephone listings. That said, and contrary to the Opponent's position, I am not prepared to infer that the surname QUINT had, as of the material date of February 29, 2016, become known to any significant extent as a result of Ian's alleged personal reputation in the real estate industry, if not only because none of the Exhibits B to H (discussed below) are dated prior to the material date to assess the present ground of opposition.

[52] The question thus becomes whether a person in Canada of average intelligence and of average education in English or French would be more likely to respond to the Mark by thinking of it as a name or surname, rather than as something else.

[53] In the present case, I note that in addition to its surname significance, the word QUINT is defined in the *American Heritage dictionary of the English language* (5<sup>th</sup> edition, 2011) as: "1. A sequence of five cards of the same suit in one hand in piquet. 2. A quintuplet" and in French dictionary *Multidictionnaire de la langue française* (4th edition, 2003) as: "*QUINT- préf. Élément du latin signifiant "cinquième". Quintuple.*" [See *Tradall SA v Devil's Martini*

*Inc*, 2011 TMOB 65 (CanLII) at para 29, which provides that the Registrar can take judicial notice of dictionary definitions]. These dictionary definitions are in line with the ones attached as Exhibits MG-1 and MG-2 to the Gendron Declaration.

[54] In view of the foregoing, I find that the evidence of record does not support the conclusion that the average Canadian would be more likely to respond to the Mark by thinking of it as a surname, rather than as a fanciful trademark. This is particularly the case given the significant and elaborate design element made of the stylized letter “Q” comprising the Mark and the additional word HOTELS.

[55] Accordingly, the section 12(1)(a) ground of opposition is rejected.

Section 2 ground of opposition (Mark not distinctive of the Applicant)

[56] As a preliminary matter, I find the ground, as pleaded, to be ambiguous. That said, I have to read the pleading in conjunction with the evidence [*Novopharm Ltd v Astrazeneca AB*, 2002 FCA 387]. With this in mind, I find the ground can be construed as alleging that the Mark is not distinctive pursuant to section 2 of the Act in view of i) the Opponent’s trade name Groupe Quint and/or trademark GROUPE QUINT & Design that would have become known in the real estate industry; and ii) the fact that QUINT is the surname of both Ian and Theodore (and other individuals), as well as the fact that Ian personally would have taken an important place in the real estate industry and rendered or sold services under his surname [per paragraph 33 of the Quint Declaration].

[57] 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.

[58] 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].



[59] I will start my analysis by considering the first prong of the ground, as construed.

*First prong of the ground of opposition*

[60] In order to meet its evidential burden with respect to this ground, the Opponent has to demonstrate that the Opponent's trade name Groupe Quint and/or trademark GROUPE QUINT & Design in association with relevant goods or services, was sufficiently known at the date on which the statement of opposition was filed (i.e. February 20, 2018) to negate the distinctiveness of the Mark [*Motel 6, Inc v No. 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International, LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)]. More particularly, the Opponent has to show that its trade name and/or trademark in association with relevant goods or services were known in Canada to some extent, having a "substantial, significant or sufficient" reputation to negate distinctiveness, or else "well known in a specific area of Canada" [*Bojangles, supra*, at para 33]. In this regard, an opponent's evidence is not restricted to the sale of goods or services in Canada. It may also be based on evidence of knowledge or reputation of an opponent's trademark or trade name including that spread by means of word of mouth or newspaper and magazine articles [*Motel 6, Inc v No 6 Motel Ltd, supra*, at 58-59].

[61] This brings me to take a closer look at the Opponent's evidence of use of its trade name Groupe Quint and trademark GROUPE QUINT & Design, including Exhibits B to H attached to the Quint Declaration.

The Opponent's evidence of use of its trade name and trademark

*Exhibit B*

[62] Ian describes this exhibit as samples of "advertisements placed over the year in various publications, including *Le Journal l'Information d'Affaires Rive-Sud* and Goss". However, upon review of this exhibit, I note that except for an advertisement displaying the trademark GROUPE QUINT & Design, along with a description of the Opponent's services, dated March 13, 2017 in the journal *L'Information d'Affaires Rive-Sud*, none of the very few alleged advertisements reproduced in Exhibit B are dated. In fact, except for a handwritten note added at the bottom of a

page to identify “Goss Magazine”, none of the remaining exhibited advertisements provide any information with respect to the media in which they would have been published and their corresponding publication dates, if any.

[63] Returning to the journal *L’Information d’Affaires Rive-Sud*, I note that no circulation figures have been provided. I further note that Exhibit B also includes a copy of a publicity contract (“*contrat publicitaire*”) between the said journal and an entity named 551 Bériault Investments Limited located at 3755 Place de Java, in the city of Brossard, Quebec. I note that the same address is found in a undated advertorial identifying the Opponent. The contract provides for the publication of 12 advertisements spread over the period dated April 2016 to March 2017. I am prepared to infer that these advertisements would have been identical or similar to the one published in the March 13, 2017 edition. However, in the absence of any further information, I am not prepared to infer that there would have been widespread circulation of this journal in the South Shore of Montreal or elsewhere.

#### *Exhibit C*

[64] Ian describes this exhibit as sample publications of “interviews in various real estate and non-real estate publications, radio stations, local and national newspapers, magazines, including online versions, such as Goss magazine and GOSSCLUB.com, one of the most prominent business magazine”, which have “provided the Opponent with frequent exposure as a major real estate player in the industry”. However, upon review of this exhibit, I note that except for a very few articles that were published in the online versions of *Le Soleil de Châteauguay* (2017/4/10 and 2017/3/31), *The Gazette* (January 19, 2016), and *Viva-media.ca* (March 16, 2016 and September 20, 2017), the remaining sample publications are either undated or dated after the material date of February 20, 2018. Here again, no circulation figures have been provided. Furthermore, the articles published in the three above-identified online newspapers merely refer to the Opponent (and its president Ian) as the owner of the local shopping malls featured therein (namely *Le Faubourg de l’Ile* in Pin court and the *Centre régional de Châteauguay* (both located in the greater Montreal area)).

*Exhibit D*

[65] Ian describes this exhibit as “sample copies of programs, Websites and social media pages” relating to “invitations to speak at a plethora of local, national and international real estate forums and conferences amongst all the major global real estate players”. I note that a few of these forums and conferences are dated after the material date of February 20, 2018. This leaves us with the Canadian Real Estate Forum (November 28-30, 2017), the Montreal Real Estate Strategy & Leasing Conference (October 25, 2016), the Montreal Real Estate Conference (February 3, 2018), and the *Sommet immobilier de Montréal* (March 28, 2017).

[66] In this regard, I note that while Ian indicates that “the Opponent has been a sponsor at the foregoing real estate forums and conferences, as appears from the sample copies of programs for such forums and conferences enclosed herewith as Exhibit D” [para 29d)], the only actual specimen arguably attesting to some kind of “sponsorship” by the Opponent is for the *Sommet immobilier de Montreal* held on March 28, 2018 (that is, after the material date) and consists of a photograph of a stand displaying the Opponent’s trademark GROUPE QUINT & Design and identifying a working space (“*Espace de travail*”) or “Networking Lounge”.

[67] Returning to the four above-identified forums or conferences that are dated within the material date, I note that the city, in which was held the Canadian Real Estate Forum for the year 2017, is not indicated in the exhibited copy of the program. While the 2017 program apparently indicates that the 2018 Canadian Real Estate Forum is to be held in Toronto, it is my understanding, based on the general information found on the last page of the brochure, that the location of the forums can vary across Canada and include, for instance, Quebec City and Montreal. All that to say that I am not prepared to infer that the 2017 Canadian Real Estate Forum was held in Toronto as opposed to Montreal, for instance.

[68] Finally, I note that Ian, as President of the Opponent (identified by either the French trade name Groupe Quint or its corresponding English version Quint Group), was a speaker at all of the above-identified forums and conferences. While there is no information as to the number of people having attended these forums and conferences and as to the extent to which they have been advertised, I am prepared to infer, given the nature of these forums and conferences and the number and quality of people comprising the panels of speakers identified in the programs, that

these forums and conferences have provided the Opponent with some exposure as a real estate player in the industry in the greater Montreal area, as of the material date of February 20, 2018.

*Exhibit E*

[69] Ian describes this exhibit as “sample copies of programs” for the International Council of Shopping Centers (ICSC) conference. More particularly, he asserts that “the Opponent has been a sponsor and has a booth every year at the [ICSC] conference, where the Opponent is seen as a major player in the industry and one of the top three active developers in Quebec, the whole as appears from the sample copies [of Exhibit E]”. However, upon review of this exhibit, I note that the only sample copy of program provided is with respect to the ICSC Quebec Conference held in Montreal on June 11-13, 2018 (that is, after the material date), wherein Group Quint is only identified as an “exhibitor” together with the number of its booth.

*Exhibit F*

[70] Ian describes this exhibit as an email confirming that he was nominated, as President of the Opponent, for the Promies Awards, “a celebration of Montreal’s best and brightest young Jewish entrepreneurs”, which took place in Montreal on September 7, 2017. Here again, while there is no information as to the number of people having attended this event and as to the extent to which it has been advertised, I am nonetheless prepared to infer that it has provided the Opponent with some exposure as a real estate player in the greater Montreal area, as of the material date of February 20, 2018.

*Exhibit G*

[71] Ian describes this exhibit as “a picture of the arena” of the hockey club *Les Draveurs de Trois-Rivières*, in Quebec, for which the Opponent has been a sponsor in 2017-2018. Upon review of this exhibit I note that the trademark GROUPE QUINT & Design is indeed displayed on the ice rink. However, no other information, such as with respect to the nature of the Opponent’s services, is provided.

*Exhibit H*

[72] Ian describes this exhibit as examples of signs and/or banners that clearly identify the Opponent and which are “always included” at the Opponent’s “various properties”. Upon review of this exhibit I note that all of the signs and/or banners pictured therein do indeed display the trademark GROUPE QUINT & Design, which use I find could also be perceived as use of the trade name Groupe Quint in that particular context, given the display of the Opponent’s telephone number beneath the mark; trade name use and trademark use are not mutually exclusive, especially in association with services [see *Consumers Distributing Co/Cie Distribution aux Consommateurs v Toy World Ltd*, 1990 CasrwellNat 1398 (TMOB)]. I further note that on most of the signs and/or banners, the Opponent’s mark is accompanied by a short description in French of the Opponent’s services, such as “*location*” or “*espaces à bureaux à louer*”, “*espace commercial à louer*”, “*nouvelle construction travaux en cours – espaces à louer*”, “*futur centre d’achat – espaces commerciaux à louer*”, etc. However, except for the signs relating to the above-mentioned two shopping malls *Centre regional Chateauguay* and the *Faubourg de L’île*, and a third one named *La Citière* located in the city of La Prairie on the South Shore of Montreal, none of the exhibited pictures of signs and/or banners provide any indication as to either their geographical location (presumably within the province of Quebec, having regard to the French descriptors used) or date of display.

[73] That said, I find that the signs for the three above-identified shopping malls do support to some extent Ian’s general assertion found at paragraph 32 of the Quint Declaration according to which “the Opponent deals with all of the major national and international tenants on a regular basis, including but not limited to, Walmart, Costco, Canadian Tire, Giant Tiger, Jean Coutu, Pharmaprix, Metro, Sobey’s Loblaws, Couche Tard, Lowes, Smuckers, Brambbles [*sic*], [...]”.

[74] Finally, I note that Ian asserts at paragraphs 22 and 31 of his declaration that:

22. [...] the business of the Opponent has expanded throughout the province of Quebec, is moving into other areas of Canada and has moved into the United States. In fact, the Opponent is managing over five times as much square footage of properties as the Applicant and expanding by approximately 1.5 to 2 million square feet per year, which is larger than the Applicant’s entire portfolio of properties.

[...]

31. The Opponent does business with most of the major real estate companies in the world, including Riocan, Blackstone, Elad, Cominar, BTB, Choice Reit, Crombie, Smart Reit, Ivanhoe Cambridge, FTQ, Dream, GWL and many others. [...]

[75] However, these assertions fail to provide any precise indication as to the geographical location of the properties managed by the Opponent as of the material date of February 20, 2018.

The Opponent has not met its initial burden

[76] In view of all the foregoing, I am prepared to accept that the Opponent has demonstrated that its trade name Groupe Quint and/or trademark GROUPE QUINT & Design had become known to some extent at least in the province of Quebec, especially the greater Montreal area, as of the material date of February 20, 2018. However, given the imprecisions noted above, I am not satisfied that the Opponent's evidence conclusively demonstrates that the Opponent's trade name and/or trademark had a reputation that was "substantial, significant, or sufficient" in Canada to negate the distinctiveness of the Mark, or alternatively, that the Opponent's trade name and/or trademark was "*well known* in a specific area of Canada" (i.e. in this case, the province of Quebec or the greater Montreal area) as required by *Bojangles, supra*.

[77] In this regard, I find that many of the examples provided by the Opponent do not speak to the impact on the consumers. For example, it is unclear how seeing the Opponent's trade name and/or trademark on a rink or referenced as one in a group of sponsors impacts consumers and had any notable effect on the reputation of the Opponent's trade name and/or trademark. Moreover, many of Ian's assertions fail to provide any precise indication in terms of geographical location and/or extent of exposure of the Opponent's trade name and/or trademark as of the material date of February 20, 2018. Again, it is the Opponent's responsibility to provide information to allow the Registrar to find that it met its burden.

[78] Accordingly, the first prong of the section 2 ground of opposition, as construed, is rejected for the Opponent's failure to meet its evidential burden.

*Second prong of the ground of opposition*

[79] At the hearing, the Opponent relied on section 4.9 of the *Trademarks Examination Manual*, relating to when an objection as to the inherent distinctiveness of a trademark shall be

raised by the Examiner pursuant to section 32(1)(b) of the Act. More particularly, the Opponent drew a parallel between the Mark and the examples of trademarks that would be considered not inherently distinctive listed in section 4.9.5.11 of the Manual. The listed examples lack inherent distinctiveness because they consist of a combination of unregistrable elements (e.g. ALFREDSON'S CARROTS (in association with the goods "carrots"), which consists of a word that is primarily merely a surname and a word that is the name of the goods). The Opponent further relied on the allegations contained in the Quint Declaration purporting to establish Ian's personal reputation in the real estate industry.

[80] For the reasons below, I am not satisfied that the Opponent has met its burden.

[81] First, as per my analysis above of the section 12(1)(a) ground of opposition, the element QUINT comprising the Mark is both a dictionary word (in English and French) and a surname. Furthermore, the Mark is not primarily merely a surname.

[82] Second, the evidence of record fails to show that the use of QUINT by any of the individuals in this case as a surname negates the distinctiveness of the Mark. While I find that Ian had acquired some reputation in the real estate industry broadly speaking, personally or as President of the Opponent, the evidence falls short of his use of Quint or Ian Quint negating the distinctiveness of the Mark. My comments also apply to the evidence concerning the use of Quint or Theodore Quint whether personally or through other entities within the Quint family real estate portfolio.

[83] A trademark's distinctiveness resides in its ability "to indicate the source of a particular product, process or service in a distinctive manner, so that, ideally, consumers know what they are buying and from whom" [*Kirkbi AG v Ritvik Holdings Inc*, 2005 SCC at para 39]. Here, the Mark is still adapted to distinguish the Services despite the fact that QUINT is a surname due to various other meanings of this word and the elaborate and significant design element made of the stylised letter "Q" comprising the Mark. In this way, this case is distinguishable from other cases in which the registration of a surname was expunged for lack of distinctiveness such as *CIBC World Markets Inc v Stenner*, 2010 FC 397 and *General Motors of Canada v Décarie Motors Inc*, [2001] 1 FC 665 (FCA).

[84] In making this finding, I make no comment on Ian's right to use his personal name or surname as part of a trademark or trade name, as this is not before me.

[85] Accordingly, the second prong of the section 2 ground of opposition, as construed, is also rejected.

DISPOSITION

[86] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

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Annie Robitaille  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office



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

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**HEARING DATE** 2021-07-13

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