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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 092

Date of Decision: 2022-05-03

IN THE MATTER OF AN OPPOSITION

Empire Communities Corp.	**Opponent**
and	
Vijay Patel	**Applicant**
1,811,012 for EMPIRE SUITES	**Application**

OVERVIEW

[1] Empire Communities Corp. (the Opponent) opposes registration of the trademark EMPIRE SUITES (the Mark), reproduced below, which is the subject of application No. 1,811,012 in the name of Vijay Patel (the Applicant).

[2] The application for the Mark was filed on November 23, 2016 on the basis of use in Canada since October 1, 1993 in association with the following goods and services:

Goods

Beverages made of coffee; beverages made of tea; breakfast cereals; caffeine-free coffee; coffee; coffee and tea; coffee based beverages

Cola drinks

Services

Administrative hotel management; business management of hotels; hotel management

Hotel accommodation services; hotel reservations; hotel room booking services; hotel services; hotels; providing temporary hotel accommodations; reservation of hotel rooms for travelers

[3] The Mark was advertised for opposition purposes in the *Trademarks Journal* of May 2, 2018 and on September 28, 2018, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). Numerous amendments to the Act came into force on June 17, 2019. In the context of opposition proceedings, the date that determines which version of the Act applies is the date on which the application being opposed was advertised. Considering that the present application was advertised before that coming into force, per the transitional provisions in section 70 of the Act, the grounds of opposition will be assessed in accordance with the Act as it read immediately before amendment.

[4] The grounds of opposition initially pleaded by the Opponent alleged that the application does not conform to section 30(b) of the Act, that the Applicant is not the person entitled to registration of the Mark under sections 16(1)(a) and (b) of the Act and that the Mark is not distinctive under section 2 of the Act. With leave of the Registrar granted on June 13, 2019, the statement of opposition was subsequently amended to also allege that the Mark is not registrable under sections 12(1)(b) and (d) of the Act.

[5] The Applicant filed and served a counter statement denying all of the allegations contained in the statement of opposition.

[6] In support of its opposition, the Opponent filed two affidavits of Andrew P. Guizzetti. In support of his application, the Applicant filed his own affidavit. Neither affiant was cross-examined.

[7] Both parties filed written arguments. I note at the outset that the Opponent raised objections with respect to the content of the Applicant's written argument. In particular, the

Opponent submitted that this document comprises multiple allegations that have not been properly introduced as evidence. I confirm in this respect having disregarded any submissions contained in the Applicant's written argument referring to matters that have not been set out in evidence.

[8] An oral hearing was conducted at which both parties were represented.

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

[9] I will begin with a consideration of the Opponent's section 30(b) ground of opposition, as in my view it is sufficient to dispose of the opposition.

[10] Section 30(b) of the Act requires there be continuous use of the Mark, in the normal course of trade, from the date claimed (October 1, 1993) to the filing date of the application (November 23, 2016) [*Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD) at 262].

[11] With respect to this ground of opposition, the Opponent has pleaded that the application for the Mark does not comply with the requirements of section 30(b) because "the statement of use is false".

[12] The initial burden on the Opponent is light respecting the issue of non-conformity with section 30(b) of the Act, as the facts regarding the Applicant's first use are particularly within the knowledge of the Applicant [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. This burden can be met by reference not only to the Opponent's evidence but also to the Applicant's evidence [*Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. The Opponent may so rely on the Applicant's evidence to meet its initial burden, if it shows that the Applicant's evidence 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 at paras 30-38].

[13] In this respect, the Opponent relies on a combination of its own evidence and the Applicant's evidence. Specifically, the Opponent contends that its burden is satisfied by the admission of the Applicant in his affidavit that he misstated the date of first use in the

application, which admission is consistent with the circumstantial evidence submitted in the Opponent's evidence in chief (outlined at paragraph 30 of the first affidavit of Andrew P. Guizzetti). The relied upon passage of the Applicant's affidavit is reproduced below:

> 11. I personally filed the application for registration of the trademark *EMPIRE SUITES & Design* on November 23rd, 2016. During the application process, I indicated October 1st, 1993 as the date from which I had so used the trademark *EMPIRE SUITES & Design*. Being a non-professional individual, I was confused by the system through which the application was registered on the *Canadian Intellectual Property Office*' s website, and I incorrectly included the date October 1st, 1993, rather than October 18th, 2016, which is the true date from which I had used the trademark *EMPIRE SUITES & Design*. This was simply a clerical error, for which I shall request the immediate amendment, correction or removal.

[14] Both in his written argument and at the oral hearing, the Applicant conceded that there is in fact an admission on his part that he made an error claiming use since October 1, 1993 rather than October 18, 2016. Notably, in his written argument, the Applicant submits the following:

> 25. The Opponent claims that the statement of use in the Applicant's application for EMPIRE SUITES is proven to be false because the Applicant admits that he made an error himself in referring to October 1st, 1993 as the date of first use of the trademark as oppose [*sic*] to October 18th, 2016.
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> 26. In paragraph 11 of his affidavit of evidence, the Applicant explains under oath how he made this *bona fide* clerical error. This evidence was never challenged nor rebutted by the Opponent through cross-examination or other means; it thereby stands and prevails.
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> 27. This clerical error does not affect the Opponent's case since the clerical error bears on the date of first use, which is not a criteria since the amendments to the Act, dated June 16, 2019. The Applicant's affidavit of evidence was filed after the coming into force of the amendments to the Act and its Regulations.
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> 28. Under Rule 35 of the Regulations, such clerical error can be corrected but such information is no longer required pursuant to Rule 31 of the Regulations.
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> 29. Alternatively, the Applicant thereby submits that the Opponent failed to show in its pleadings that a clerical error was a ground of opposition under Section 38 of the Act, before June 16, 2019.

[15] The Opponent rightly points out that despite the Applicant's submissions in his written argument that "such clerical error can be corrected" and his statement within the final sentence of the above-mentioned paragraph 11 of his affidavit, that he "shall request the immediate amendment, correction or removal" of the error, the Applicant did not do so, whether immediately or at all.

[16] Notwithstanding the Applicant's submissions, in my view, the Applicant's admission referenced above is dispositive of the section 30(b) ground of opposition [for a similar finding see *1721502 Ontario Inc v Hing Yip Hong Ltd*, 2015 TMOB 113 at para 14]. It is therefore unnecessary to discuss the Opponent's own evidence provided in this respect by Mr. Guizzetti.

[17] As indicated above, the application for the Mark was advertised prior to the coming into force of the "new" Act and the Opponent—as it was then required—based its opposition on section 38(2)(a) of the "old" Act in combination with the applicable provisions of former section 30 of the Act. As also indicated above, the pleadings under the Opponent's first ground of opposition therefore have to be assessed in accordance with the Act as it read before it was amended on June 17, 2019. In this respect, it has been held that non-compliance with section 30(b) formed a proper basis for opposition: see for example *Canadian Occidental Petroleum Ltd v Oxychem Canada Inc* (1990), 33 CPR (3d) 345 (TMOB) at 349:

> Pursuant to S. 30(b), an applicant, whose right to registration is based on use in Canada, must state in its application the date from which the trade-mark has been used in Canada. Furthermore, such statement must be *accurate*, that is, it is necessary for the applicant to have used the trade-mark at least as of the date of use claimed in the application. However, the applicant's claimed date of use need not be the "earliest date of use" of the trade-mark (see *Marineland* supra), which means that an applicant who has used its trade mark prior to filing may claim any date subsequent to the actual date of first use (see *Sanna Inc. v. Chocosuisse union des fabricants suisses de chocolat* (1986), 14 C.P.R. (3d) 139 (T.M. Opp. Bd.), at page 142).
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> Accordingly, for an application to comply with Section 30(b) of the Act, what is required is that the applicant shall have used the mark in Canada as of the claimed date of use. Consequently, the application would not comply with the requirements of Section 30(b) of the Act if it claimed use as of a certain date when, in fact, the trade-mark had not been in use as of that date.

[18] I also make mine the following comments of the Registrar in *Chartered Professional Accountants of Canada v Michael Schemmann*, 2022 TMOB 3 at para 52 dealing with an analogous situation:

> Considering first the Applicant's submissions relating to the fact that prior use is no longer a requirement for the filing of a certification mark under the amended Act, it is to be reminded that the present ground of opposition must be assessed based on the Act as it read on June 16, 2019. In this regard, while I acknowledge the somewhat "technical" nature of grounds of opposition based under section 30 of the Act, non-compliance of an application with section 30 of the Act is not a "mere technicality" [see by analogy

Chartered Professional Accountants of Ontario v Association of International Certified Professional Accountants, a District of Columbia non-profit corporation, 2019 TMOB 120].

[19] The Applicant here claimed October 1, 1993 as the date of first use of the Mark. He subsequently admitted in his affidavit that October 18, 2016 "is the true date from which [he] had used the [M]ark". The Applicant has therefore not used the Mark as of his claimed date of use. This plainly supports a finding in favour of the Opponent under its non-compliance ground of opposition. It is therefore also unnecessary to further discuss the Applicant's evidence.

[20] In view of the above, the section 30(b) ground of opposition succeeds. As the resolution of this ground is sufficient to dispose of the opposition with respect to all of the goods and services, I will not address the remaining grounds of opposition.

DISPOSITION

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

Iana Alexova
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: 2022-04-07

APPEARANCES

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AGENTS OF RECORD

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