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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 192

Date of Decision: 2022-09-29

[UNREVISED ENGLISH

CERTIFIED TRANSLATION]

IN THE MATTER OF AN OPPOSITION

9344-8462 Québec Inc.

Opponent

and

Gouverneur Inc.

Applicant

1,827,127 for INCOMPARABLE

Application

INTRODUCTION

[1] Gouverneur Inc. (the Applicant) filed an application (No. 1,827,127) for the trademark INCOMPARABLE (the Mark) based on proposed use in Canada in association with various services in the hotel and restaurant industry.

[2] 9344-8462 Québec Inc. (the Opponent) opposes registration of the Mark, arguing the likelihood of confusion with an identical trademark registered and used in Canada mainly in association with services in the construction, architecture and interior decoration industries.

[3] For the reasons that follow, I find that the application ought to be rejected in part.

RECORD

[4] The application for the Mark was filed on March 13, 2017, and advertised for opposition purposes in the *Trademarks Journal* on April 4, 2018.

[5] On August 30, 2018, the Applicant filed a revised application, which was subsequently accepted by the Registrar.

[6] On June 4, 2019, a statement of opposition was filed under section 38 of the *Trademarks Act*, RSC 1985, c. T-13 (the Act). It must be noted at this point that, because the Act was amended on June 17, 2019, all references in my decision refer to the Act as amended, except for references to the grounds of opposition (see section 70 of the Act, which provides that section 38(2) of the Act as it read applies to applications advertised before that date).

[7] The opposition is based on the following general grounds:

- In view of the provisions of section 12(1)(d) of the Act, the Mark is not registrable because it is confusing with the registered trademark INCOMPARABLE held by the Opponent, the subject of registration No. TMA962,602;
- In view of the provisions of section 16(3)(a) of the Act, the Applicant is not the person who is entitled to the registration, since, on the date the application was filed, the Mark was confusing with the trademark previously used in Canada by the Opponent, namely INCOMPARABLE; and
- In view of the provisions of section 2 of the Act, the Mark is not distinctive and/or is not adapted to distinguish the Applicant's services from the services offered by the Opponent in association with the INCOMPARABLE mark.

[8] On July 2, 2019, the Applicant filed a counter statement of opposition in which it denied the allegations found in the statement of opposition.

[9] In support of its opposition, the Opponent filed Marc-André Bovet's affidavit, dated October 29, 2019, and Exhibits O-1 to O-14 (the Bovet affidavit). On June 15, 2020, Mr. Bovet

was cross-examined on his affidavit. The transcript of the cross-examination and the undertakings that were honoured are on record.

[10] The Applicant did not file any evidence.

[11] Both parties filed written representations and attended the oral hearing.

EVIDENTIARY BURDEN

[12] It is initially up to the Opponent to establish that its opposition is well-founded. His grounds for opposition must be duly pleaded and there is an initial evidentiary burden on the Opponent to adduce sufficient evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once that evidentiary burden has been met, it is up to the Applicant to establish, on a balance of probabilities, that no grounds of opposition prevent the registration of the Mark [see *John Labatt Ltd v Molson Companies Ltd.* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al.* (2002), 20 CPR (4th) 155 (FCA)].

SECTION 12(1)(D) OF THE ACT – REGISTRABILITY

[13] The Opponent has pleaded that the Mark is not registrable under section 12(1)(d) of the Act because it is confusing with the Opponent's INCOMPARABLE trademark, registered under No. TMA962,602 in association with the following services:

(1) Professional consultation in the field of building construction, architecture and interior design

(2) Educational services in the field of building construction, architecture and interior design

(3) Advertising services of others, namely building construction services, architectural services and the interior design services

(4) Promoting the sale of goods and services for others through promotional seminars and information sessions and the distribution of related marketing materials for building materials, architectural and interior design concepts

[14] Since registration No. TMA962,602 alleged by the Opponent in support of this ground of opposition is still in effect in the Trademarks Register, the Opponent has met its initial evidentiary burden.

[15] It is now for the Applicant to show, on a balance of probabilities, that there is no risk of confusion between the Mark and this INCOMPARABLE mark registered by the Opponent.

Test for confusion

[16] The test for confusion is one of first impression and imperfect recollection. According to section 6(2) of the Act, 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.

[17] Therefore, section 6(2) of the Act does not deal with confusion between the marks themselves but with the likelihood that the goods or services from one source will be perceived as being from another source.

[18] In determining whether trademarks cause confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time the trademarks have been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them. This list is not exhaustive, and each of these factors can be assigned a different weight depending on the context [see *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al*, 2006 SCC 23; and *Masterpiece Inc. v Alavida Lifestyles Inc.*, 2011 SCC 27].

Degree of resemblance between the marks

[19] The factor stated at section 6(5)(e) of the Act favours the Opponent, since the parties' marks are identical.

Inherent distinctiveness of the trademarks and the extent to which they have become known

[20] Since both trademarks here consist of the same common dictionary term, which has a laudatory character, they have the same low degree of inherent distinctiveness.

[21] With respect to the extent to which the trademarks have become known, the Applicant did not present any evidence of use or promotion. Therefore, it is not possible for me to draw a conclusion on the extent to which the Mark has become known in Canada.

[22] The Opponent argues that its trademark has over the years acquired distinctiveness in Canada because the Opponent has used it intensively, continuously and consistently, and has cultivated its goodwill in association with this mark—under which its services are known and reputed to the public—and because the Opponent has carried out extensive publicity for this mark in association with its activities. Specifically, the Opponent argues that:

- In recent years, the Opponent's INCOMPARABLE mark has been widely and regularly featured in well-known, high-circulation magazines, publications and newspapers in Canada, thus benefiting from high media exposure and a high presumption of public recognition (according to Exhibits O-8 to O-13 and its replies to undertakings E-4 to E-10);
- The evidence on record demonstrates the significant marketing efforts made and expenses incurred by the Opponent over the years to ensure visibility for its INCOMPARABLE mark (according to its reply to undertaking E-11); and
- The evidence on record shows that the Canadian public has been widely exposed to the Opponent's INCOMPARABLE mark through various media outlets (according to Exhibit O-7 and its replies to undertakings E-1 to E-3).

[23] The Opponent's evidence should therefore be reviewed.

The Bovet affidavit and Mr. Bovet's cross-examination

[24] Mr. Bovet is the founding president of the Opponent, which specializes in the construction, architecture and design of housing projects [paras 1 and 3].

[25] Mr. Bovet argues that the Opponent's INCOMPARABLE mark has been used in Canada at least as early as December 2010 [para 7]. He states that the Opponent's mark, as used in the exercise of its trade activity, refers to a faster and smarter way of constructing housing that is high-performance, solid, comfortable and energy-efficient by addressing the shortcomings of traditional construction [para 10]. Mr. Bovet states that it is a leading figure in the Opponent's patented technology, a modular construction structure [para 28].

[26] As Exhibit O-4, Mr. Bovet produced an excerpt from the Internet site *bonestructure.ca*, which displays the INCOMPARABLE trademark, and stated that the Opponent's site was accessible to the Canadian public at all times. Mr. Bovet also alleges that this site was visited by 450,000 visitors per year [paras 11 and 12]. Mr. Bovet's cross-examination revealed that the total number of Canadian visitors to the Opponent's Internet site from January 1, 2010 to August 9, 2020 was 1,060,708, which is an average of slightly more than 106,000 Canadian visitors per year [transcript, pp 12 and 13; reply to undertaking E-1].

[27] As Exhibit O-5, Mr. Bovet produced an excerpt from the Opponent's YouTube page, which features a video that he alleges demonstrates the Opponent's INCOMPARABLE mark in association with the Opponent's services [para 13]. However, Mr. Bovet did not provide any information about the number of Canadians who visited the Opponent's YouTube page or have viewed this video.

[28] Mr. Bovet states that, "during the course of the past few years", the Opponent has adopted a marketing strategy to ensure the presence and development of its INCOMPARABLE mark in the Canadian construction and housing landscape. Specifically, he states that the advertising expenses related to the Opponent's mark are \$75,000 per year [paras 14 and 27]. During his cross-examination, Mr. Bovet committed to provide, for each year since 2010, the marketing expenses associated with the Opponent's registered mark separated by communication medium. Although the document produced in response to undertaking E-11 entitled [TRANSLATION] "BONE Structure – Annual expenses per account" shows some of the marketing expenses incurred by the Opponent (such as those related to its Web page or printed advertisements), it must be noted that it did not include any clear and unequivocal breakdown of marketing expenses associated with the Opponent's INCOMPARABLE mark.

[29] As Exhibit O-6, Mr. Bovet produced photographs of [TRANSLATION] “open house” events held in Canada between 2015 and 2017 for which he states that the Opponent’s mark was displayed to the public to promote the Opponent’s services. In addition, Mr. Bovet claims that these “events and conferences” attracted approximately 2,000 to 2,500 people per year [paras 15 and 16]. It must be noted that the participation data alleged here seem to cover both the references [TRANSLATION] “open house” events and conferences, on which Mr. Bovet did not provide any details in his affidavit.

[30] Mr. Bovet’s cross-examination revealed that the number of event registrations (information and open house sessions) organized by the Opponent between 2012 and 2019 includes a total of 2,666 “contacts” and 17,999 “leads” [transcript, pp 14 and 15; reply to undertaking E-2]. To the extent that the [TRANSLATION] “leads” in question are included in the number of “registrations”, it seems likely to me that these are potential clients of the Opponent who were present at the events (as opposed to “contacts”, who may represent current clients or even purely networking contacts). That said, in the absence of any additional details on these events and their participants, I tend to agree with the Applicant’s representations that the reference to “leads” remains somewhat ambiguous.

[31] As Exhibit O-7, Mr. Bovet produced an excerpt from the Opponent’s newsletter and alleges that it is received by 53,500 subscribers [paras 17 and 18]. Mr. Bovet’s cross-examination revealed that the total number of Canadian [TRANSLATION] “leads” who had subscribed to the Opponent’s newsletter in 2019/2020 was 32,503 [transcript, pp 15 to 17; reply to undertaking E-3].

[32] Mr. Bovet alleges that, “over the past few years”, the Opponent’s mark has been displayed in many well-known magazines, publications and newspapers, and, as Exhibits O-8 to O-13, he produced what he describes as hard copies of Canadian magazines and newspapers for the years 2012 to 2014 and 2016 to 2018. He argues that due to the “publications’ size and readership”, the estimated reach of the Opponent’s INCOMPARABLE mark is more than 50 million people since its creation [paras 19 to 26]. It must be noted that the frequency, quantity or specific date of publication of the advertisements are not indicated. In addition, Exhibits O-8 to O-13 do not show newspaper hard copies but instead show advertisements and print samples

that Mr. Bovet claims were published in the newspapers and magazines referenced in paragraphs 19 to 25 of his affidavit.

[33] During his cross-examination, Mr. Bovet committed to produce a copy of the newspaper and magazine excerpts showing advertisements bearing the Opponent's mark, mentioned in paragraphs 20 to 25 of his affidavit and referenced in Exhibits O-8 to O-13. He also committed to provide, for each of the newspapers and magazines mentioned in these exhibits, the publication date for each of the advertisements mentioned therein and the circulation of each copy in Canada in which the advertisements appeared [transcript, pp 17 to 26; undertakings E-4 to E-10]. In that regard, it must be noted that:

- The advertisements originally found in Exhibit O-8 (allegedly published in *La Presse*, *The Globe and Mail*, and *Ottawa Magazine*) do not appear in the documents produced in reply to undertaking E-4. These documents do not mention any advertising that appeared in *The Globe and Mail* or *Ottawa Magazine*. The reply to undertaking E-4, however, contains other advertisements by the Opponent that appeared in 2012, notably in *La Presse* and *Le Journal de Montréal*.
- Some of the advertisements that were originally found in Exhibit O-9 (allegedly published in *The Globe and Mail*, the *Toronto Star*, the *National Post*, *La Presse*, *Architecture Canada* and in *Audi*, *BMW* and *Mercedes* magazines) are not present in the documents that were produced in reply to undertaking E-5 and, except for advertisements that were published in 2013 in *The Globe and Mail*, it is not possible to determine in which publication(s) the other provided advertisements would have been published.
- Several of the advertisements initially found in Exhibit O-10 (allegedly published in 2014 in *The Globe and Mail*, *The Vancouver Sun*, *Audi*, *BMW* and *Mercedes* magazines, *Builder Magazine* and *In The Hills Magazine*) are not among the documents produced in reply to undertaking E-6 and, aside from *The Globe and Mail*, the *Toronto Star* and the *Vancouver Sun*, it is not possible to determine in which publication(s) the other provided advertisements were published,

- Mr. Bovet did not provide any reply to undertakings E-7 or E-8 regarding the Opponent’s advertisements that were allegedly published in 2016/2017 in *Toronto and Vancouver Home Magazine*, *Dwell Magazine*, *Montreal Home Magazine*, *Air Canada Magazine*, *Maison Birks Magazine* and *Toronto Life*.
- The advertisements initially found in Exhibit O-13 (allegedly published in 2018 in *Prestige Design Magazine* and *Halton News*) are not among the documents that were produced in reply to undertaking E-9. However, the reply to undertaking E-9 contains another advertisement from the Opponent that was published in *The Globe and Mail*.
- The document produced in reply to undertaking E-10 does not show the publication dates of the Opponent’s advertisements. It is simply a copy of a Wikipedia article entitled “List of newspapers in Canada by circulation”.

[34] On the latter point, the Opponent refers to the decision *Hilton Worldwide Holding LLP v. Solterra (Hastings) Limited Partnership*, 2019 TMOB 132, in which the Registrar learned that the *Toronto Star*, the *National Post* and *The Globe and Mail* are widely distributed in Canada and that newspapers like *The Vancouver Sun*, the *Winnipeg Free Press*, the *Montreal Gazette*, the *Vancouver Province*, and the *Calgary Herald* are widely distributed in their respective regions.

Conclusion on the extent to which the mark is known

[35] I concur with the Applicant’s representations, both in writing and at the hearing, that the Opponent’s evidence summarized above is flawed and that the documents produced in reply to the undertakings made during Mr. Bovet’s cross-examination reveals the inaccuracy of certain allegations in his affidavit.

[36] Considering this evidence as a whole, I am nevertheless prepared to accept Mr. Bovet’s assertions that the Opponent’s INCOMPARABLE mark has been used since December 2010, that it is displayed on the Opponent’s Internet site (visited on average by a bit over 106,000 Canadians per year) and that the Opponent has held open house events where this mark was displayed to the public (in which at least a certain number of Canadians registered). In addition,

the Opponent's INCOMPARABLE mark seems to have been advertised in certain newspapers and publications that are widely distributed across Canada (such as *The Globe and Mail*) and across their respective regions (such as *La Presse*, *Le Journal de Montréal* or the *Toronto Star*). However, in my view, the evidence in this regard lacks the precision and substance needed to establish that the public and media exposure of this mark is as broad or significant as the Opponent argues in its representations. Furthermore, the Opponent's evidence does not establish usage in association with all the services covered by its registration. In my view, the evidence on record at best demonstrates the use of the INCOMPARABLE trademark in association with construction, architecture and house design services, as well as in association with the provision of information in the construction and architecture industries. As a result, I am at best able to conclude that the Opponent's mark has become somewhat known in Canada in association with these services.

[37] I therefore find that the factor set out in section 6(5)(a) of the Act, which encompasses both the inherent distinctiveness and the acquired distinctiveness of the trademarks, favours the Opponent.

Length of time in use

[38] In light of the above discussion, the factor set out in section 6(5)(b) of the Act also favours the Opponent.

Nature of the services, business and trade

[39] In considering the factors set out in sections 6(5)(c) and (d), the wording of the services in the application for the Mark must be compared with that of the registration pleaded by the Opponent [*Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr. Submarine Ltd v. Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[40] The application for the Mark covers the following services, as revised:

(1) Operation of convenience stores; management services in the area of hotels and restaurants, namely planning, monitoring and management of renovation of integrated hotel complexes and catering services for third parties.

(2) Hall rental services for banquets, meetings, seminars and conventions; operation, management, leasing and sale of commercial buildings, retirement housing and long term care facilities and property management services.

(3) Temporary accommodation services, namely: operation of hotel, motel, resort and apartment complexes, operation of restaurants, bars, piano-bars, discothèques and cafés; management services for others and for the applicant of a network for making hotel reservations.

(4) Fitness and health spa services.

[41] At the hearing, the Opponent conceded that its objection is in fact limited to the services at para (1) set out above. My analysis will therefore be strictly limited to these opposed services.

[42] The Opponent argues that although the services covered by each of the marks at issue are not identical, the complementarity of these services in the fields of housing, building, construction, architecture, development and interior design must be an important factor in assessing the likelihood of confusion.

[43] The Applicant argues that the Opponent cannot, simply because the statement of services in its registration includes the terms “construction”, “architecture” and “interior design”, claim a monopoly on any service that may affect these three fields either directly or indirectly. The Applicant also notes that the fields of housing and development do not appear in the services covered by the Opponent’s registration and, furthermore, that this registration does not cover building *construction* services but, rather, *consultation, education and advertising* services, along with *promotion* in the building construction field. The Applicant therefore argues that the marks of the parties relate to very different services, with one being in the field of consultation, education, advertising (for third parties) and promotion (for third parties) related to the fields of construction, architecture and interior design, while the other is in the general hotel and restaurant business.

[44] The Opponent’s mark is actually registered in association with professional consultation services, education services and advertising and promotion services for third parties in the fields of construction, architecture and interior decoration. However, I find that there is an overlap,

similarity or, at least, a link between the consultation services in the fields of construction and architecture in the Opponent's registration and the planning and renovation management services covered by the Mark (despite the specification in the application that these services of the Applicant relate specifically to hotel complexes). However, I would not say the same about the Applicant's convenience store operation services or its catering services for third parties, the nature of which is fundamentally different from the services covered by the Opponent's registration.

[45] It seems to me that providing a professional opinion or advice on building construction may include related aspects of planning, administration or organization (management). Moreover, the link between the fields of construction and architecture and that of renovation seems clear to me and I note that the wording of the Opponent's registration does not contain any restriction on the affected buildings (residential or commercial) and is therefore sufficiently broad to possibly include professional consultation services for constructing a hotel complex. In that regard, although genuine trade must be taken into account, I also recall that we must consider a party's right to take a given path rather than focus solely on whether or not it does so.

Conclusion on the likelihood of confusion

[46] In view of the foregoing, and in particular the fact that the parties' marks are identical and a link does exist between some of their services, I find that the Applicant has not established, on a balance of probabilities, the absence of any likelihood of confusion with respect to the following services covered by its application: "management services in the area of hotels and restaurants, namely planning, monitoring and management of renovation of integrated hotel complexes". Consequently, it has not met its ultimate evidentiary burden regarding them and the section 12(1)(d) ground of opposition is allowed in part.

REMAINING GROUNDS OF OPPOSITION

[47] Since the Opponent has already been partially successful in its ground of opposition under section 12(1)(d) of the Act, I will not examine the grounds of opposition under sections 16(3)(a) and 2 of the Act. However, I will add that these other grounds also deal with the issue of confusion and that the Opponent's position is no stronger regarding these grounds or

their respective relevant dates than it is with respect to the ground of opposition under section 12(1)(d) as of today's date.

DISPOSITION

[48] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to “*management services in the area of hotels and restaurants, namely planning, monitoring and management of renovation of integrated hotel complexes*” and I reject the opposition with respect to the remainder of the services pursuant to section 38(12) of the Act.

Iana Alexova
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Certified translation
Tony Santin
The English is WCAG compliant

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

HEARING DATE 2022-06-09

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