



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 047

Date of Decision: 2023-03-13

IN THE MATTER OF AN OPPOSITION

Opponent: Golden Cala Trading EST

Applicant: Florian Mack

Application: 1855282 for lens.me & Design

INTRODUCTION

[1] Florian Mack (the Applicant) has applied to register the trademark lens.me & Design (the Mark), shown below:



[2] The Application includes the following colour claim: “Colour is claimed as a feature of the trade-mark. Blue and white are claimed as a feature of the mark. Specifically, 'lens.' is in blue and 'ME' is overlaid in white on a solid blue circle.”

[3] The Mark is applied for in association with the following goods and services:

GOODS

(1) Optical goods, namely, contact lenses; glasses, sunglasses and contact lenses (the Goods).

SERVICES

(1) Online retail store services relating to cosmetic and beauty products, namely, lenses for altering or enhancing eyes and eye colour, beauty enhancing coloured contact lenses, coloured lenses (non-prescription), cosmetic contact lenses

(2) Online retail services relating to optical goods, namely, contact lenses, glasses, sunglasses and eyewear

(3) Optical services, namely, fitting of contact lenses, eyeglasses, sunglasses

(collectively, the Services).

[4] Golden Cala Trading EST (the Opponent) opposes registration of the Mark. The opposition is based on allegations that the Applicant had not used the Mark as of the claimed date of first use, that its statement that it intended to use the Mark in Canada was false, and that the Mark is confusing with the Opponent's unregistered "Lens me" design marks (the Opponent's Marks), shown below:



[5] For the reasons that follow, the application is refused in part.

THE RECORD

[6] The application was filed on August 31, 2017, on the basis of use in Canada with respect to the Goods and services (1) and (2), and proposed use in Canada with respect to services (3). The application also claims a priority filing date of April 2, 2017,

in association with the Goods and services (1) and (3), based on an EUIPO application in association with those goods and services.

[7] The application was advertised for opposition purposes in the *Trademarks Journal* on May 22, 2019. On November 22, 2019, the Opponent opposed the application by filing a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act).

[8] All references are to the Act as amended June 17, 2019, with the exception of references to the grounds of opposition which refer to the Act as it read before it was amended (see section 70 of the Act).

[9] The grounds of opposition are summarized below:

- Contrary to section 30(b) of the Act, the Applicant had not used the Mark in Canada in association with the Goods and services (1) and (2), as of the claimed date of first use.
- Contrary to section 30(e) of the Act, the Applicant's statement that it intended to use the Mark in Canada in association with services (3) was not accurate.
- Contrary to section 30(i) of the Act, the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Goods and Services.
- Contrary to sections 38(2)(c) and 16(1)(a) of the Act, the Mark was confusing with the Opponent's Marks previously used in Canada.
- Contrary to sections 38(2)(d) and 2 of the Act, the Mark is not distinctive.

[10] On February 11, 2020, the Applicant served and filed a counter statement denying each of the grounds of opposition. Both parties filed evidence, which is discussed below. No cross examinations were conducted with respect to any evidence filed in this proceeding.

[11] Both parties also filed written representations and were represented at an oral hearing.

EVIDENCE

Opponent's Evidence

[12] The Opponent filed two documents as its evidence pursuant to section 50(1) of the *Trademarks Regulations*, SOR/2018-227 (the Regulations): a document purporting to be an affidavit of Ghazi Alanazi, CEO of the Opponent (the Alanazi Document), and an affidavit sworn by Mohit Sethi, an articling student at the Opponent's agent of record, affirmed November 26, 2020 (the Sethi Affidavit). Each will be discussed in turn below.

The Alanazi Document

[13] At the outset, as noted in the Applicant's written representations, it is not clear whether the Alanazi Document was properly sworn. I first note that on November 30, 2020, the Opponent requested, and was granted, an extension of time pursuant to section 47(1) of the Act to schedule an appointment to have his affidavit executed at the Canadian Embassy in the Kingdom of Saudi Arabia. In this request, the Opponent submitted as follows:

The Affiant, Mr. Alanazi, resides in Saudi Arabia and due to the current and ongoing Covid-19 pandemic, has been unable to secure an appointment at the Canadian Embassy in the Kingdom of Saudi Arabia (KSA) to have his Affidavit sworn before a Commissioner of Oaths/Notary Public. Mr. Alanazi has made every effort to book an appointment at the Canadian Embassy but due to the second wave of the pandemic and ongoing restrictions, a timely appointment has not been available. Mr. Alanazi is hopeful that he will be able to secure an appointment within two weeks to have the Affidavit executed and commissioned or notarized. The Opponent submits the operational processes of the Canadian Embassy in the Kingdom of Saudi Arabia fall beyond the control of the Opponent and the affiant, Mr. Alanazi and, accordingly, qualify as an exceptional circumstance justifying the Opponent's request. (Emphasis added)

[14] On December 12, 2020, the Opponent filed and served the Alanazi Document. While the document is identified as an affidavit and begins with the formula "I... MAKE THIS OATH AND SAY AS FOLLOWS", the jurats at the end of the document and on each exhibit are not complete in that they are neither dated nor signed by a notary or commissioner of oaths. The numerical date "1/12/2020" is handwritten underneath Mr. Alanazi's signature on the final page of the purported affidavit. Additionally, there is a stamp on the final page that appears to be the Opponent's corporate seal, along with two other stamps bearing signatures. I note that one such stamp bears the date

“14/12/2020”. The stamps are otherwise written in Arabic, with no English or French version of the text and no explanation provided except for the following, written in the Opponent’s covering letter:

The Opponent confirms the Alanazi affidavit has been commissioned in accordance with current practices and procedures in Saudi Arabia. Due to the ongoing Covid-19 pandemic and requirement for social distancing, the Canadian Embassy in Saudi Arabia is not currently scheduling appointments to notarize documents. Accordingly, the Opponent’s Affiant had his Affidavit commissioned by the Chamber of Commerce following proper procedure in Saudi Arabia.

Proper procedure in Saudi Arabia requires the Chamber of Commerce to verify and confirm that the signature on the Affidavit belongs to the authorized signatory. The Chamber of Commerce attests to the Affidavit and Exhibits (in its entirety) and it is the customary procedure for both the Affiant and the Chamber of Commerce to execute only the signature page of the Affidavit. The Opponent confirms that Mr. Alanazi had the complete document (Affidavit and Exhibits) present with him in front of the Chamber of Commerce when it was attested to. However, no procedure exists in Saudi Arabia to have the Exhibit cover pages signed or stamped by the Affiant or the Chamber of Commerce. (Emphasis added)

[15] As noted by the Applicant, it is not clear that the statements in the Alanazi Document were made before an individual with the power to administer oaths. I concur. In this respect, I first note that generally, the Registrar will accept affidavits (or declarations) sworn (or declared) in foreign jurisdictions as long as they meet the requirements of that jurisdiction [*88766 Canada Inc v Kabushiki Bandai Namco Entertainment (also trading as Bandai Namco Entertainment Inc)*, 2016 TMOB 74; *Orion Corporation v Cross Vetpharm Group Limited*, 2018 TMOB 8; *Dubuc v Montana* (1991), 38 CPR (3d) 88 (TMOB)]. However, foreign law is considered to be facts that must be proven [*Waterford Wedgwood PLC v Forma-Kutzscher GmbH* (2006), 50 CPR (4th) 358 (TMOB) at para 26]; in this case, the Opponent has submitted no affidavit or statutory declaration confirming that the Alanazi Document was executed in accordance with the laws of Saudi Arabia.

[16] Secondly, even if I were to consider the information set out in the covering letter attached to the Alanazi Document, I note that it is not clear whether the document was sworn before the Chamber of Commerce, or merely that Mr. Alanazi’s signature was verified. In this respect, I note that no translation of the Arabic portions of the document

were provided by the Opponent; thus, it could be that the Arabic materials merely attest to the identity of Mr. Alanazi and not that he was properly sworn in. As noted by the Applicant, verifying that a signature belongs to a signatory is not the same thing as administering an oath, and the fact that a document has been stamped and signed by a notary public does not, in itself, demonstrate that the statements contained in the document were sworn before that notary [see *88766 Canada Inc v 167407 Canada Inc*, 2010 TMOB 167; *Citadelle, Coopérative de Producteurs de Sirop d'Érable / Citadelle, Maple Syrup Producers' Cooperative v RAVINTORAIŠIO OY*, 2018 TMOB 55]. Moreover, the date appearing on one of the two stamps is subsequent to the date underneath the signature of Mr. Alanazi, thus raising a serious doubt as to whether Mr. Alanazi signed the document in the presence of whoever attested to his signature.

[17] Thirdly, I note that as its reply evidence pursuant to section 54 of the Regulations, the Opponent furnished a supplementary affidavit of Mr. Alanazi, which contains none of the deficiencies of the Alanazi Document and appears on its face to have been properly sworn before a notary public.

[18] Finally, despite the Applicant having raised the aforementioned issues with the Alanazi Document in its written representations, the Opponent chose not to furnish a properly sworn version of the Alanazi Document, or even a translation of the Arabic materials.

[19] Absent such information, I do not consider these issues to be mere technicalities that can be overlooked by the Registrar, as they go to the very basis of the document being an affidavit. Accordingly, I conclude that the Alanazi Document is inadmissible in this proceeding [for similar conclusions, see *Barrette Legal Inc v Dallevigne SPA*, 2015 TMOB 12 at paras 7-12; *Shanxi Valley Tribute Grain Trading Co, Ltd v Shanxi Qinzhouhuang Millet (Group) Co Ltd*, 2022 TMOB 202 at paras 16-17]. Consequently, there is no need to summarize its content.

The Sethi Affidavit

[20] The Sethi Affidavit contains a number of printouts from the Wayback Machine internet archive of the Applicant's *lens.me* webpage as it appeared on various dates

between 2015 and 2017. The Mark appears in the top left corner of each screenshot, and the pages contain information relating to sales of contact lenses. Versions of the page dated August 1, 2015, and September 30, 2015, show an image of sunglasses along with the words “coming soon”; however, sunglasses do not appear on the later pages. Versions of the webpage from 2016 and 2017 contain a tab entitled “Worldwide Express Delivery”; however, screenshots dated May 1, 2017, and June 6, 2017, show shipping information indicating “We Currently Don’t Deliver to” Canada. A screenshot dated September 21, 2017, indicates that “LENS.ME OFFERS FREE SHIPPING TO” a list of countries including Canada.

[21] The Applicant submits that the Sethi Affidavit should not be afforded any weight on the issue of whether or not the Applicant’s website offered shipping to Canada in the past, as such evidence is contentious and should not be provided by employees of the Opponent’s agent of record, following *Kocsis Transport Ltd v “K” Line America Inc* (2008), [2008] TMOB No 37, 2008 CanLII 88277 (TMOB).

[22] While the affiant was employed by the Opponent’s agent and the evidence is directed towards whether the Applicant has used the Mark in Canada, I do not find that the evidence should be afforded diminished weight as it is not the type of opinion evidence such as that in *Cross-Canada Auto Body Supply (Windsor) Ltd v Hyundai Auto Canada*, 2006 FCA 133. In this regard, website printouts obtained by affiants who are employed by agents for parties in opposition proceedings have been accepted in numerous proceedings [see, for example, *zip.ca Inc v BBY Solutions, Inc*, 2014 TMOB 96 at para 15; *Canadian Jewellers Assn v American Gem Society*, 2010 TMOB 106].

[23] With respect to the pages from Wayback Machine, these have been found to be generally reliable [*Candrug Health Solutions Inc v Thorkelson*, 2007 FC 411 at para 21; reversed on other grounds 2008 FCA 100]. More particularly, Wayback Machine evidence in support of an opponent’s section 30(b) ground of opposition has been found admissible [*Royal Canadian Golf Assn v Ontario Regional Common Ground Alliance* (2009), 72 CPR (4th) 59 (TMOB)].

[24] Thus, even though they are hearsay, I find that the Wayback Machine evidence attached to the Sethi Affidavit is admissible. In this respect, it was necessary for the Opponent to file them to challenge the section 30(b) claim of use and they are reliable since the Applicant appears to have participated in their creation and had the opportunity to refute the evidence [see, for example, *Reliant Web Hostings Inc v Tensing Holding BV*, 2012 TMOB 48 at para 35; *Petronas Lubricants Italy SpA v Sasol Olefins & Surfactants GmbH*, 2017 TMOB 25 at paras 20-21].

Applicant's Evidence

[25] The Applicant submitted an affidavit in his own name (the Mack Affidavit), affirmed on April 12, 2021.

[26] Mr. Mack states that he is the manager, director and shareholder in Sky Optical LLC (Sky), a company to which he licenses his trademarks, copyrights and domain names. He states that he had registered the domain name *lensme.com* on March 1, 2006, and progressed to a plan to launch the LENS.ME business in or around June 2015, with the first sales of contact lenses to a customer based in Dubai, United Arab Emirates, on June 28, 2015. He states that he registered the *lens.me* website on April 9, 2015, and that the *lensme.com* website now redirects to the *lens.me* website. Also in summer and fall 2015, Mr. Mack created social media accounts for his business on Facebook, Instagram, YouTube, Pinterest, and Twitter, printouts of which are attached as Exhibit FM4.

[27] Mr. Mack states that Sky “offer[s] worldwide shipping under the [Mark]” in countries including Canada. He states that Sky “has been offering lenses and lens related products, beauty products, and the online retail of lenses, lens related products, and beauty products to consumers in Canada under the [Mark] since at least as early as 7 November 2015, when the first Canada-based order was placed through [Sky]’s website”.

[28] Mr. Mack states that more than 25,000 orders have been shipped to Canada since that date by way of the *lens.me* website, and provides figures for the number of Canadian visitors to *lens.me* website per year. These figures include 72,791 visitors in

the year 2015, with figures in the hundreds of thousands or millions in the years 2016 through 2020. He also provides figures for global followers for the aforementioned social media accounts.

[29] As Exhibit FM8, Mr. Mack attaches a redacted copy of a register kept by Sky of Canadian customers, showing over 15,000 entries for “customers in Canada that purchase optical goods, including contact lenses, under and by reference to the [Mark].” I note that the earliest contact lens-related entry shows a “Colour Lens Customer” since October 20, 2015, located in Brampton, Ontario. As Exhibit FM9, he attaches a series of invoices for customers purchasing contact lenses and related goods (including what appears to be contact lens fluid). The earliest such invoice is dated November 7, 2015, from Sky (with an address in Dubai, UAE), to a customer in Brampton, Ontario.

[30] I make the following observations about this invoice:

- the Mark appears only in the top left corner of the invoice;
- the product purchased is listed as “Solotica Hidrocor – 2 lenses”, accompanied by a small image of packaging, whose text is too small to be legible;
- the “Shipping Method” is listed as “4 Day Express Shipping – Fixed”; and
- the payment status is listed as “complete”.

[31] Mr. Mack attaches the following chart for sales figures in Canada between 2015 and the date of the affidavit:

| Year | No of orders from Canada | Sales value for orders from Canada |
|-------------|---------------------------------|---|
| 2015 | 47 | In region of USD 3,995 |
| 2016 | 1,474 | In region of USD 125,000 |
| 2017 | 4,275 | In region of USD 360,000 |
| 2018 | 6,498 | In region of USD 550,000 |
| 2019 | 6,468 | In region of USD 550,000 |
| 2020 | 7,254 | In region of USD 616,000 |
| 2021 | 1,427 | In region of USD 121,000 |

[32] With respect to advertising, Mr. Mack states that Sky began to advertise and promote the Mark in Canada at least as early as November 2015 through the *lens.me* website and social media accounts. He states that with respect to services (3), Sky “has not yet offered the physical services in Canada, but it does provide information and guidance on the fitting of lenses with each order placed by Canadian consumers”. He provides the following breakdown of advertising expenditures relating to Canada in association with the Mark:

| Year | Marketing spend relating to Canada (USD) |
|-------------|---|
| 2015 | \$2,819 |
| 2016 | \$15,646 |
| 2017 | \$31,239 |
| 2018 | \$16,818 |
| 2019 | \$34,486 |
| 2020 | \$39,332 |
| 2021 | \$14,356 |

[33] The remainder of Mr. Mack’s affidavit relates to the Opponent’s activities, including information relating to an email from a person claiming to be a representative of the Opponent, to trademark cancellation proceedings relating to the Opponent’s Marks in Saudi Arabia and elsewhere, to alleged deficiencies and inconsistencies in the Alanazi Document, and to instances of “actual confusion” between the Mark and the Opponent’s Marks. As these statements mainly relate to the Alanazi Document, which is not in evidence in this proceeding, these will not be discussed in detail.

Opponent’s Reply Evidence

[34] As its reply evidence pursuant to section 54 of the Regulations, the Opponent submitted a supplementary affidavit of Mr. Alanazi (the Alanazi Reply Affidavit), sworn July 7, 2021. The Alanazi Reply Affidavit responds to statements made in the Mack Affidavit, including with respect to trademark cancellation proceedings in Saudi Arabia relating to the Opponent’s Marks, to the email attached to Mr. Mack’s affidavit denying

any knowledge or authorization of this email, to alleged inconsistencies relating to the Opponent's website, and to Mr. Mack's cited instances of actual confusion. As the only exhibit to this affidavit, Mr. Alanazi attaches a copy of a statement from the commercial register in the Kingdom of Saudi Arabia, along with an English translation, showing that the Opponent's trade licence established in 2013 was "written off"; Mr. Alanazi states that this was done "for business restructuring purposes" and was reinstated in 2015.

ANALYSIS

Ground of Opposition: Section 30(b)

[35] The Opponent alleges that the Applicant's application does not conform to the requirements of section 30(b) of the Act, in that contrary to the allegation made in the application, the Applicant had not used the Mark, within the meaning of section 4 of the Act, in Canada in association with the Goods and services (1) and (2), as described in the application as of the claimed date of first use (November 7, 2015).

[36] An opponent's initial burden with respect to section 30(b) is a lighter one, given that the relevant information regarding use is more readily available to the applicant [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. Moreover, an opponent's burden can be met by reference not only to the opponent's own evidence but also to the applicant's evidence [see *Labatt Brewing Co v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. To meet its burden by relying on the applicant's evidence, an opponent must show that an applicant's evidence is "clearly inconsistent" with or "casts doubt" on the claims set forth in the application [see *Ivy Lea Shirt Co v Muskoka Fine Watercraft & Supply Co* (1999), 2 CPR (4th) 562 (TMOB), aff'd 2001 FCT 252; and *Bacardi & Co v Corporativo de Marcas GJB, SA de CV*, 2014 FC 323 at paras 33, 50 and 54].

[37] If an opponent succeeds in discharging its initial burden, then the applicant must, in response, substantiate its use claim. However, an applicant is under no obligation to do so if the date of first use is not first put into issue by an opponent meeting its evidential burden [see *Kingsley v Ironclad Games Corp*, 2016 TMOB 19].

Licensing

[38] The Opponent submits that there is no indication that the Applicant controlled the character and quality of goods and services provided in association with the Mark pursuant to section 50(1) of the Act, noting that there is no such provision for control in the licence attached to the Mack Affidavit as Exhibit FM5. However, I concur with the Applicant that it is reasonable to infer that the requisite control exists where the same person is the licensor and a director of the licensee [see, e.g., *Petro-Canada v 2946661 Canada Inc* (1998), 83 CPR (3d) 129 (FCTD); *Mohammed Azhar Khan v BAR B Q TONIGHT GLOBAL PTE LTD*, 2017 TMOB 73 at para 34]. As such, I am prepared to infer in this case that the requisite control exists pursuant to section 50(1) of the Act.

Goods

[39] With respect to the Goods, the Opponent submits that the only evidence relating to use as of the claimed date of first use is the November 7, 2015, invoice attached as part of Exhibit FM9 to the Mack Affidavit. The Opponent submits that customers would be more likely to view the Mark on that invoice as a trade name, rather than as a trademark, citing *Hortilux Schreder BV v Iwasaki Electric Co*, 2011 FC 967, aff'd 2012 FCA 321. In this respect, the Opponent notes that the Mark appears only in the top left corner of the invoice, that the product is listed as "Solotica Hidrocor" lenses, and that the archived screenshots attached as Exhibits A and B to the Sethi Affidavit include the statement "lens.me is an official distributor of Solotica".

[40] Moreover, the Opponent submits that there is no indication that the invoices were delivered with the shipped goods, and that in any event, the evidence indicates that the order was placed on November 7, 2015, with a shipping method of "4 Day Express Shipping", such that it is not possible that the transfer of property in or possession of the contact lenses took place as of November 7, 2015.

[41] In response, the Applicant submits that the Mark is prominently displayed on the *lens.me* screenshots attached to the Sethi Affidavit, and that because a customer would view the Mark on this webpage in the course of ordering the Goods, the Mark would be associated with the Goods within the meaning of the Act and that such association

would be continued upon receipt of the Goods. In this respect, the Applicant submits that the association with the Goods and the Mark on the website is comparable to the display of a trademark in a catalog from which consumers may place orders, following *Rosenstein v Elegance Rolf Offergelt GmbH* (2005), 47 CPR (4th) 196 (TMOB) at paras 14-15, and *Cook Inc v Applied Medical Resources Corp*, 2011 TMOB 151 at paras 39-41.

[42] I find that the Applicant's evidence is inconsistent with the claimed date of first use in association with the Goods. Even if I were satisfied that the invoice accompanied the order of November 7, 2015, I would not be satisfied that the invoice shows the requisite notice of association between the Mark and the goods listed in the invoice. It is well established that display of a trademark on an invoice that accompanies the goods at the time of transfer *may* satisfy the requirements of section 4(1) of the Act, if it provides the requisite notice of association between the trademark and the goods [see *Hortilux Schreder BV v Iwasaki Electric Co* 2012 FCA 321 (*Hortilux*); and *Riches, McKenzie & Herbert v Pepper King Ltd* (2000), 8 CPR (4th) 471 (FCTD)]. The major consideration is "whether the trademark is being used as a trademark in describing the wares" and "whether appropriate notice of such use is being given to the transferee of the wares. [...] If a trademark is placed at the top of an invoice, with no use in the body of the invoice, the use will not generally be in association with the invoiced wares" [see *Tint King of California Inc v Canada (Registrar of Trade Marks)*, 2006 FC 1440 at para 32].

[43] Similarly, with respect to the Applicant's submission that the display of the Mark on its website is analogous to the display of a trademark in a catalog, I note that where and how a trademark is displayed on a website is relevant to determining whether the requisite notice of association has been established [see, for example, *McMillan LLP v SportsLine.com, Inc*, 2014 TMOB 51 at para 12; *Imex Systems Inc v Pinnacle Webworx Inc*, 2015 TMOB 163 at para 14].

[44] In this case, given that the Mark appears in the top left corner of the invoice and a different trademark appears in association with the listed goods, I find that the display

of the Mark on the invoice is a trade name or at best a trademark in association with services, as discussed below, and does not provide the requisite notice of association with the listed goods. I reach the same conclusion with respect to the display of the Mark on the website screenshots shown in Exhibits A and B of the Sethi Affidavit, given that the Mark appears in the top left corner of the website. In this respect, I note that several of the screenshots include the words “lens.me is an official distributor of Solotica”.

[45] In any event, it is well-established that placing an order for goods is not sufficient to establish use within the meaning of section 4(1) of the Act. As set out in *Ridout & Maybee LLP v HJ Heinz Co Australia Ltd*, 2014 FC 442 at para 42, “the ‘critical point in time’ for the analysis of trade-mark use is the time at which a transfer occurs, either of property or of possession; the *required* elements of use must all be present at this time.” In that case, the Federal Court stated that “the transfer in property associated with the wares occurred when they were placed in the custody of the shippers for transportation to Canada” [see also *Estee Lauder Cosmetics Ltd v Loveless*, 2017 FC 927 at paras 31-33]. In this case, there is no indication that any such transfer of property or possession occurred on the date of the order shown on the invoice dated November 7, 2015. Indeed, the reference on the invoice to “4 Day Express Shipping” raises serious doubt that any such transfer would have occurred on November 7, 2015.

[46] As such, the Applicant’s evidence is inconsistent with the claimed date of first use; accordingly, I find that the Opponent has met its initial burden for the section 30(b) ground of opposition with respect to the Goods. Therefore the burden shifts on the Applicant to prove its claimed date of first use in association with the Goods.

[47] As the Applicant did not discharged its burden to prove that the Mark was first used in Canada in association with the Goods on the claimed date of first use, this ground of opposition therefore succeeds with respect to the Goods.

Services

[48] With respect to services (1) and (2), the Opponent submits that there is no performance of those services as the transaction noted above did not take place on

November 7, 2015. Further, the Opponent submits that there was no evidence of the manner in which the Mark was marketed, advertised, and promoted through the *lens.me* webpage and social media accounts as described in the Mack Affidavit. In this respect, the Opponent notes that the Mack Affidavit provides yearly figures for Canadian visitors to the *lens.me* website and for Canadian marketing expenditures for the year 2015, but submits that there is no indication that any such visitors or expenditures occurred prior to November 7, 2015. In this respect, the Opponent refers to the screenshots attached to the Sethi Affidavit and submits that these demonstrate that the Applicant was not shipping its Goods to Canada on or before the material date.

[49] In response, the Applicant submits that the order placed November 7, 2015, demonstrates that it was performing services (1) and (2) as of that date, stating that “The consumer who placed an order that day clearly saw the Mark because they placed their order via the website” as set out in the Mack Affidavit. The Applicant submits that use of a trade name in association with services does not exclude use of that trade name as a trademark within the meaning of section 4(2) of the Act, citing *Robinson Sheppard Shapiro SENCRL/LLP v Exo Inc*, 2017 TMOB 132 at paras 37-39.

[50] I concur with the Applicant with respect to the retail services in general. Use of a trade name in association with services does not exclude use of that trade name as a trademark within the meaning of section 4(2) of the Act [*Consumers Distributing Co / Cie Distribution aux Consommateurs v Toy World Ltd*, 1990 CarswellNat 1398 (TMOB) at para 14]. Whether a word is used as a trademark or a trade name is a question of fact. The question is whether the Applicant has shown use of its trademark in such a way that it is identifiable as a trademark and not merely as a corporate name or corporate identifier. Relevant factors to decide whether use is as a trademark or trade name include whether the trademark stands apart from the corporate address and other corporate identifier information to the extent that the public would perceive such use as a trademark in association with services, and not merely as identification of a legal entity [see *Road Runner Trailer Manufacturing Ltd v Road Runner Trailer Co* (1984), 1 CPR (3d) 443 (FCTD) at para 16; *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2

CPR (3d) 535 (TMOB) at para 7; *Borden Ladner Gervais LLP v GDC Communities*, 2015 TMOB 50 at para 20].

[51] In this case, as shown in the screenshots attached to the Sethi Affidavit, the Applicant's website displayed the Mark both before and after the material date. Given that the Mark is a design mark and was displayed prominently in the top left corner of the webpage, I find that it stands out from the surrounding material such that the public would perceive it as a trademark rather than merely as the identification of a legal entity [see *Fraday Yacoub v E-source, Inc*, 2020 TMOB 11 at paras 27-28]. As the Applicant's evidence establishes that a customer in Canada placed an order for contact lenses through this website on the material date, I find that the evidence is not inconsistent with the Applicant's claim of use with respect to the general classes of services described in services (1) and services (2).

[52] Accordingly, for the reasons set out above, the Opponent has failed to meet its initial burden under this ground of opposition with respect to services (1) and services (2). This ground of opposition is therefore dismissed with respect to these services.

Ground of Opposition: Section 30(e)

[53] The Opponent alleges that at the time the application was filed on August 31, 2017, the statement that the Applicant, by itself or through a licensee, or by itself and through a licensee, intends to use the Mark in Canada in association with services (3), was false and not accurate, as at the time the application was filed, the Applicant did not intend, by itself and/or through a licensee, to use the Mark in association with services (3) in Canada. In particular, the Opponent notes that Mr. Mack states at paragraph 12 of his affidavit that Sky "provide[s] information and guidance on the fitting of lenses with each order placed by Canadian consumers". The Opponent submits that this statement establishes that the Applicant was performing services (3) in Canada as of the material date, and that the statement that the Applicant intended to use the Mark in association with services (3) in Canada was therefore false.

[54] The material date for this ground of opposition is the priority filing date of the application (April 2, 2017), since it pertains only to services (3) [see *SmithKline Beecham Corp v Pierre Fabre Médicament*, [1998] TMOB No 141 at para 6 (*SmithKline Beecham*)]. However, for the reasons discussed below, this ground would not succeed regardless of whether the material date was the priority filing date, or the filing date of August 31, 2017, given that the Opponent has not met its initial burden.

[55] As with section 30(b) of the Act, an opponent's initial burden with respect to section 30(e) is a lighter one, given that the relevant information regarding use is more readily available to the applicant, and an opponent's burden can be met by reference to the applicant's evidence. To meet its burden by relying on the applicant's evidence, the opponent must show that the applicant's evidence is "clearly inconsistent" with or "casts doubt" on the claims set forth in the application [see *Bacardi & Co, supra*].

[56] Further, a proposed use application will be refused where the evidence points to use of the applied-for mark in advance of the filing date [*Tone-Craft Paints Ltd v Du-Chem Paint Co* (1969), 62 CPR 283 (Reg TM), *Airwick Industries Inc v Metzner* (1982), 74 CPR (2d) 55 (TMOB), *Société Nationale Elf Aquitaine v Spex Design Inc* (1988), 22 CPR (3d) 189 (TMOB) and *Frisco-Findus SA v Diners Delite Foods Ltd* (1989), 26 CPR (3d) 556 (TMOB)].

[57] With respect to the statement from the Mack Affidavit cited above by the Opponent, the Applicant submits that this statement was made in 2021, and that in any event, it "can be interpreted as an assertion that although [Sky] has not started providing fitting services in Canada as of yet, it plans to do so in the future, and this intention is *corroborated* by the fact that [Sky] already offers fitting information and guidance to its customers". As such, the Applicant submits that its evidence is not clearly inconsistent with the proposed use claim as of the material date.

[58] Other than the aforementioned statement in the Mack Affidavit, there is no information whatsoever on the nature of the "information and guidance" provided by the Applicant or Sky. Further, as noted by the Applicant, Mr. Mack's statement that Sky provides this "information and guidance" is in the present tense, with no indication as to

how long Sky would have been providing such information and guidance. In the absence of any such information, I am not prepared to conclude that the Applicant performed the services “Optical services, namely, fitting of contact lenses, eyeglasses, sunglasses” in association with the Mark within the meaning of the Act, prior to the material date. Accordingly, I do not find that the evidence is “clearly inconsistent” with or “casts doubt” on the proposed use claims set forth in the application.

[59] Consequently, the Opponent failed to meet its initial burden under this ground of opposition. It is therefore dismissed.

Ground of Opposition: Section 30(i)

[60] The Opponent alleges that contrary to section 30(i) of the Act, at the time the application was filed and at all material times, the Applicant could not have been satisfied that it was entitled to use the Mark in Canada because:

- (a) the Applicant knew, is deemed to have known or should have known of the rights attaching to the Opponent’s Marks, the copyright for which is Owned by the Opponent, and the use and proposed use of the Mark was likely to contravene the *Copyright Act*, RSC 1985, c C-42; and
- (b) the Applicant knew, is deemed to have known or should have known of the rights and reputation attaching to the Opponent’s Marks which had been used in Canada since well prior to the date the Applicant first started using the Mark in Canada, and further, that the use of the Mark is therefore unlawful as it contravenes or is likely to contravene section 7 of the Act.

[61] The material date for this ground of opposition with respect to the Goods and services (1) and (3) is the priority filing date (April 2, 2017), and with respect to services (2), the material date is the filing date of the application (August 31, 2017) [*SmithKline Beecham, supra*]. Again, however, for the reasons discussed below, this ground fails regardless of which material date is considered, given that the Opponent has not met its initial burden.

[62] Where an applicant has provided the required statement, the jurisprudence states that non-conformance with section 30(i) of the Act can be found only where there are exceptional circumstances that render an applicant's statement untrue [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. It has previously been held that mere knowledge of the existence of an opponent's trademark does not in and of itself support an allegation that the applicant could not have been satisfied of its entitlement to use its mark [*Woot, Inc v WootRestaurants Inc Les Restaurants Woot Inc*, 2012 TMOB 197].

[63] In its written representations, the Opponent states that "While this ground of opposition is not being withdrawn, it will not be pursued by the Opponent in these submissions." Similar representations were made at the hearing. I note that the Opponent has provided no evidence of copyright ownership with respect to the Opponent's Marks, and no admissible evidence that it had used the Opponent's Marks in Canada prior to the material dates.

[64] Consequently, the Opponent failed to meet its initial burden under this ground of opposition. It is therefore dismissed.

Ground of Opposition: Sections 38(2)(c) and 16(1)(a)

[65] The Opponent alleges that contrary to sections 38(2)(c) and 16(1)(a) of the Act, that at the time the application was filed, and at all material times, the Mark was confusing with the Opponent's Marks, previously used in Canada by the Opponent. I note that because the Opponent has not raised a ground of opposition pursuant to section 16(3) of the Act, the Applicant's applied-for services (3), based on proposed use in Canada, are not at issue with respect to the section 38(2)(c) ground of opposition.

[66] The relevant date for a ground of opposition based on section 16(1)(a) is the date of first use of the trademark claimed in the applicant's application. However, in circumstances where that claimed date of first use is successfully challenged under section 30(b), the relevant date becomes the filing date of the application [see *American Cyanamid Co v Record Chemical Co* (1972), 6 CPR (2d) 278 (Reg TM) at 280; *Everything for a Dollar Store (Canada) Inc v Dollar Plus Bargain Centre Ltd* (1998), 86

CPR (3d) 269 (TMOB) at 282]. In any event, for the reasons discussed below, this ground would not succeed regardless of whether the material date was the date of claimed first use, the priority filing date, or the filing date, given that the Opponent has not met its initial burden.

[67] In order to meet its initial burden under a ground of opposition based on section 16(1)(a) of the Act, the Opponent must show that the trademark alleged in support of this ground of opposition was used or made known prior to the material date(s), and was not abandoned at the date of advertisement of that application (May 22, 2019) (section 16(5) of the Act). As the Opponent has not furnished any evidence demonstrating that the Opponent's Marks were used or made known in Canada prior to the Applicant's claimed date of first use, the filing date of the application, or the priority filing date, the Opponent has not met its initial burden with respect to this ground regardless of the material date.

[68] Accordingly, this ground is dismissed.

Ground of Opposition: Section 38(2)(d) and 2

[69] The Opponent has also pleaded that contrary to sections 38(2)(d) and 2 of the Act, the Mark is not distinctive of the Applicant's Goods and/or Services, and/or is not adapted to distinguish the Applicant's Goods and/or Services from the goods and services of the Opponent.

[70] The material date for a ground of opposition based on non-distinctiveness is the filing date of the opposition (November 22, 2019) [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185 at para 25].

[71] There is an initial burden on the Opponent to establish that, as of the material date, the Opponent's Marks were known to a sufficient extent that could negate the distinctiveness of the applied-for Mark [see *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657]. As the Opponent has filed no evidence demonstrating the extent to which the Opponent's Marks have become known in Canada at the material date, the Opponent has not met its initial burden with respect to this ground.

[72] Accordingly, this ground is dismissed.

DISPOSITION

[73] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to the Goods. I reject the opposition with respect to the Services pursuant to section 38(12) of the Act.

Jean Carrière
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-01-23

APPEARANCES

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